

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NALOX-1 PHARMACEUTICALS, LLC,  
Petitioner,

v.

ADAPT PHARMA OPERATIONS LIMITED, and  
OPIANT PHARMACEUTICALS, INC.,  
Patent Owners.

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Case No. IPR2019-00685  
U.S. Patent No. 9,211,253

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**PATENT OWNERS' UNOPPOSED MOTION TO WITHDRAW AND  
SUBSTITUTE COUNSEL**

**I. STATEMENT OF RELIEF REQUESTED**

Pursuant to 37 C.F.R. § 42.10(e) and the Board’s November 19, 2019, email authorizing this motion, Patent Owners Adapt Pharma Operations Limited (“Adapt”) and Opiant Pharmaceuticals, Inc. (“Opiant”) respectfully request that the Patent Trial and Appeal Board (“the Board”) authorize the withdrawal of attorney Robert F. Green as Lead Counsel. Patent Owners also respectfully request that the Board authorize the substitution of current Backup Counsel for Adapt, Jessamyn S. Berniker, as new Lead Counsel.

**II. STATEMENT SHOWING GOOD CAUSE FOR THE BOARD TO AUTHORIZE WITHDRAWAL AND SUBSTITUTION OF COUNSEL**

Adapt has recently become an assignee of U.S. Patent Nos. 9,211,253, 9,468,747, and 9,629,965, which are the subject of Case Nos. IPR2019-00685, -00688, and -00694. Adapt and Opiant have filed joint amended mandatory notices in these cases, which have identified both Adapt and Opiant as Patent Owners, and permitted Williams & Connolly LLP, including Jessamyn S. Berniker, to enter appearances as Adapt’s counsel. Jessamyn S. Berniker is lead counsel for Adapt in the district court proceedings involving these patents. Patent Owners therefore request that Robert F. Green be permitted to withdraw from the current proceeding. Opiant will remain represented in the current proceeding by Jessica Tyrus Mackay, who will remain as Opiant’s First Backup Counsel, and Ann K. Kotze, who was named as Opiant’s Backup Counsel in the

Patent Owners' joint amended mandatory notices and is familiar with the current proceeding.

No change to the schedule would be required based on the proposed change in counsel. Patent Owners will file updated mandatory notices under 37 C.F.R. § 42.8(a)(3) should this motion be granted. Opiant represents that it would not be prejudiced by this proposed withdrawal and substitution of counsel. In identifying and designating new counsel who are ready and able to take over the representation, "reasonable steps have been taken to avoid foreseeable prejudice to the rights of the client." *See* 37 C.F.R. § 10.40(a).

### **III. REASONS FOR RELIEF REQUESTED**

"Counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal." 37 C.F.R. § 42.10(e). Given that Adapt's counsel has been identified as Lead Counsel, and that Opiant remains represented by First Backup Counsel and Backup Counsel who are ready and able to maintain Opiant's representation, it is appropriate to allow Robert F. Green to withdraw from the proceeding. Counsel for Petitioner has been consulted and has indicated that Petitioner does not oppose the motion for substitution and withdrawal. Thus, Patent Owners believe that granting this motion will not hinder the economy, the integrity of the patent system, the

efficient administration of the Office, or the ability of the Office to timely complete this proceeding. *See* 35 U.S.C. § 316(b).

#### IV. CONCLUSION

Patent Owners respectfully request that the Board grant their motion to withdraw Robert F. Green as Lead Counsel, and to substitute Adapt's counsel, Jessamyn S. Berniker, as new Lead Counsel in this proceeding.

Date: November 26, 2019

Respectfully submitted,

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