

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NALOX-1 PHARMACEUTICALS, LLC,
Petitioner,

v.

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

Case No. IPR2019-00694
U.S. Patent No. 9,629,965

**JOINT AMENDED MANDATORY NOTICES OF PATENT OWNERS
ADAPT PHARMA OPERATIONS LIMITED AND
OPIANT PHARMACEUTICALS, INC.**

Pursuant to 37 C.F.R. § 42.8(a)(3), Patent Owners Adapt Pharma Operations Limited (“Adapt”) and Opiant Pharmaceuticals, Inc. (“Opiant”) jointly submit the following amended mandatory notices:

I. Real Parties in Interest, 37 C.F.R. § 42.8(b)(1)

Adapt and Opiant are the assignees of U.S. Patent Nos. 9,211,253; 9,468,747; and 9,629,965.

Adapt is a wholly owned subsidiary of Adapt Pharma Limited, which is a wholly owned subsidiary of Emergent Acquisition Limited. Emergent Acquisition Limited is a wholly owned subsidiary of Emergent International Inc., which is a wholly owned subsidiary of Emergent BioSolutions Inc. Emergent BioSolutions Inc. is a publicly held company, and no publicly held company owns 10% or more of Emergent BioSolutions Inc.’s stock.

Opiant is a publicly held company, and no publicly held company owns 10% or more of Opiant’s stock.

II. Related Matters, 37 C.F.R. § 42.8(b)(2)

Petitioner Nalox-1 Pharmaceuticals, LLC (“Nalox-1”) has filed the following related petitions for *inter partes* review:

U.S. Patent No.	Case No.
9,211,253	IPR2019-00685
9,211,253	IPR2019-00686
9,211,253	IPR2019-00687
9,468,747	IPR2019-00688

U.S. Patent No.	Case No.
9,468,747	IPR2019-00689
9,468,747	IPR2019-00690
9,561,177	IPR2019-00691
9,561,177	IPR2019-00692
9,561,177	IPR2019-00693
9,629,965	IPR2019-00694
9,629,965	IPR2019-00695
9,629,965	IPR2019-00696
9,775,838	IPR2019-00697
9,775,838	IPR2019-00698
9,775,838	IPR2019-00699

The Board has denied institution of Nalox-1's petitions in Case Nos. IPR2019-00686, IPR2019-00687, IPR2019-00689, IPR2019-00690, IPR2019-00691, IPR2019-00692, IPR2019-00693, IPR2019-00695, IPR2019-00696, IPR2019-00697, IPR2019-00698, and IPR2019-00699.

U.S. Patent No. 9,211,253; U.S. Patent No. 9,468,747; U.S. Patent No. 9,561,177; U.S. Patent No. 9,629,965; and U.S. Patent No. 9,775,838 have been asserted in *Adapt Pharma Operations Ltd., et al. v. Teva Pharmaceuticals USA, Inc., et al.*, Case 2:16-cv-07721-JLL-JAD (D.N.J.) (consolidated), filed October 21, 2016 ("the Teva Action"); and *Adapt Pharma Operations Ltd., et al. v. Perrigo UK FINCO Limited Partnership*, Case 2:18-cv-15287-JLL-JAD (D.N.J.) (consolidated), filed October 25, 2018 ("the Perrigo Action"). On March 2, 2020, all claims in the Perrigo Action were dismissed with prejudice pursuant to a Consent Judgment. On June 26, 2020, the district court entered final judgment in the Teva Action holding the following claims invalid: Claims 7 and 9 of U.S.

Patent No. 9,468,747; Claim 4 of U.S. Patent No. 9,561,177; Claims 21, 24, and 25 of U.S. Patent No. 9,629,965; and Claims 2, 24, 33, and 38 of U.S. Patent No. 9,775,838. Patent Owners intend to appeal this judgment.

Administrative matters that would be or could be affected by this proceeding include pending U.S. Patent Application No. 16/868,816.

III. Lead & Backup Counsel, 37 C.F.R. § 42.8(b)(3)

Adapt designates the following attorney as lead counsel:

Jessamyn S. Berniker
Reg. No. 72,328
WILLIAMS & CONNOLLY LLP
725 Twelfth Street, N.W.
Washington, DC 20005
jberniker@wc.com

Opiant designates the following attorney as first backup counsel:

Jessica Tyrus Mackay
Reg. No. 64,742
GREEN, GRIFFITH & BORG-BREEN, LLP
676 North Michigan Avenue, Suite 3900
Chicago, IL 60611
jmackay@greengriffith.com

Adapt designates the following attorneys as backup counsel:

Ana C. Reyes
(Admitted *Pro Hac Vice*)
725 Twelfth Street, N.W.
Washington, DC 20005
areyes@wc.com

David M. Krinsky
Reg. No. 72,339
WILLIAMS & CONNOLLY LLP
725 Twelfth Street, N.W.
Washington, DC 20005
dkrinsky@wc.com

Anthony H. Sheh
Reg. No. 70,576
WILLIAMS & CONNOLLY LLP
725 Twelfth Street, N.W.
Washington, DC 20005
asheh@wc.com

Opiant designates the following attorney as backup counsel:

Ann K. Kotze
Reg. No. 76,570
GREEN, GRIFFITH & BORG-BREEN, LLP
676 North Michigan Avenue, Suite 3900
Chicago, IL 60611
akotze@greengriffith.com

Powers of attorney appointing these attorneys to transact all business in this proceeding on behalf of Adapt or Opiant, respectively, have been submitted or will be submitted with this amended mandatory notice information.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.