

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RIMFROST AS

Petitioner

v.

AKER BIOMARINE ANTARCTIC AS

Patent Owner

Case No. IPR2020-01532

U.S. Patent 9,644,169

Issue Date: May 9, 2017

Title: Bioeffective Krill Oil Compositions

**PATENT OWNER'S MANDATORY NOTICES PURSUANT TO
37 C.F.R. § 42.8**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450**

PATENT OWNER'S MANDATORY NOTICES UNDER

37 C.F.R. § 42.8

1. Real Party-In-Interest under 37 C.F.R. § 42.8(b)(1).

Aker BioMarine Antarctic AS is the Patent Owner and the real party-in interest in this proceeding.

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

The following judicial or administrative matters may affect or be affected by a decision in this proceeding:

Aker previously asserted the '877 and '905 patent in a lawsuit captioned Aker Biomarine Antarctic AS v. Olympic Holding AS; Rimfrost AS; Emerald Fisheries AS, Rimfrost USA, LLC; Avoca Inc.; and Bioriginal Food & Science Corp. Case No. 1:16-CV-00035-LPS-CJB (D. Del.). This litigation was initially stayed in view of Investigation No. 337-TA-1019 instituted by the United States International Trade Commission on September 16, 2016 as noticed in the Federal Register. The ITC proceeding was entitled In the Matter of Certain Krill Oil Products and Krill Meal for Production of Krill Oil Products and involved to the '877 and '905 patents, as well as Patent Owner's related '765, '453 and '752 patents. The ITC investigation identified Olympic Holding AS, Rimfrost AS,

Emerald Fisheries AS, Avoca Inc., Rimfrost USA, LLC, Rimfrost New Zealand Limited and Bioriginal Food & Science Corp. as respondents. Exhibit 1023.

On May 23, 2017, ITC Investigation No. 337-TA-1019 was terminated. Exhibit 1054. In addition, a Stipulation of Dismissal as to Avoca, Inc. was granted by the Delaware District Court on May 30, 2017.

On January 27, 2017, Petitioner filed petitions in IPR2017-00745 and IPR2017-0747 requesting review of claims 1-20 of the '905 patent. On February 3, 2017, Petitioner filed petitions in IPR2017-0746 and IPR2017-00748 requesting review of claims 1-19 of the '877 patent. Each was instituted on August 16, 2017. On September 6, 2017, the Delaware District Court action was stayed pending resolution of these IPRs. On August 24, 2018, the Board ruled that claims 1-20 of the '905 patent and claims 1-19 of the '877 patent are unpatentable. 905 FWD (Exhibit 1103); 877 FWD (Exhibit 1104).

On October 3, 2019, the U.S. Court of Appeals for the Federal Circuit, in a consolidated opinion, affirmed the Board's Final Written Decisions in IPR2017-00745 and IPR2017-00746 finding all claims of the '877 and '905 patents unpatentable. *Aker Biomarine Antarctic AS v. Rimfrost AS*, 786 F. App'x 251 (2019) (Exhibit 1154). On October 28, 2019, based on the Federal Circuit's affirmance of 877 FWD and 905 FWD, the Delaware District Court action was dismissed with prejudice.

In March 2020, the Patent Office issued Inter Partes Review Certificates cancelling claims 1-20 of the '905 patent and claims 1-19 of the '877 patent. Exhibits 1155, 1156.

On December 15, 2017, Petitioner filed a petition in IPR2018-00295 requesting review of claims 1-48 of the '765 patent. This IPR was instituted on June 14, 2018. On June 12, 2009, the Board issued its Final Written Decision finding all claims of the '765 patent unpatentable. 765 FWD (Exhibit 1129). As part of its Final Written Decision, the PTAB also denied Patent Owner's contingent Motion to Amend that sought to replace claims 25-32 with substitute claims 49-56. On July 12, 2019, Patent Owner filed a Request for Rehearing limited exclusively to the Board's denial of the Motion to Amend. On November 22, 2019, the Board ordered further briefing related to the Request for Rehearing (Order, Conduct of the Proceeding Relating to Request on Rehearing of Final Written Decision, Paper 40). On October 1, 2020 the Board issued a decision denying the request for rehearing.

On February 9, 2018, Petitioner filed a petition in PGR2018-0033 requesting review of claims 1-20 of U.S. Patent No. 9,644,170 ("the '170 patent"). On August 29, 2018, the Board determined that the '170 patent was not eligible for post grant review.

On June 26, 2018, Petitioner filed petitions in IPR2018-01178 and IPR2018-01179 requesting review of claims 1-31 and claims 32-61 of the '453 patent, respectively. Both proceedings were instituted on January 14, 2019. On January 13, 2020, the Board issued Final Written Decisions finding claims 1-31 and claims 32-61 unpatentable. 453 FWD I (Exhibit 1157); 453 FWD II (Exhibit 1158). The Board also denied Patent Owner's contingent motions to amend. Patent Owner did not appeal either of these Final Written Decisions.

On September 21, 2018, Petitioner filed a petition in IPR2018-01730 requesting review of claims 1-20 of the '752 patent. This IPR was instituted on May 12, 2019. On March 6, 2020, the Board issued a Final Written Decision finding claims 1-20 unpatentable, and denied Patent Owner's contingent motion to amend. 765 FWD (Exhibit 1159). Patent Owner did not appeal the Board's decision.

On September 30, 2020, Petitioner filed a petition in IPR2020-01533 requesting review of claims 1-19 of U.S. Patent No. 9,816,046 ("the '046 patent"). The '046 patent, like the '169 patent, is in the same patent family and shares a common specification with the '877, '905, '765, '453 and '752 patents.

3. Lead and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3).

The Patent Owner designates the following lead and back-up counsel.

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