

Case IPR2024-01312
U.S. Patent No. 11,697,028

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIOFRONTERA INC., BIOFRONTERA BIOSCIENCE GMBH,
BIOFRONTERA PHARMA GMBH, AND BIOFRONTERA AG
Petitioner

v.

SUN PHARMACEUTICAL INDUSTRIES, INC.
Patent Owner

Case IPR2024-01312

U.S. Patent No. 11,697,028

MANDATORY NOTICES FOR PATENT OWNER

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Patent Owner Sun Pharmaceutical Industries, Inc. (“Sun”). hereby files its mandatory notices pursuant to 37 C.F.R. § 42.8. These notices are being timely filed within 21 days of service of the Petition, which service occurred on August 21, 2024.

I. REAL PARTY-IN-INTEREST (37 C.F.R. § 42.8(b)(1))

The real party-in-interest for the Patent Owner is Sun Pharmaceutical Industries, Inc.

II. RELATED MATTERS (37 C.F.R. § 42.8(b)(2))

U.S. Patent No. 11,697,028 (“the ’028 patent”) is a patent-in-suit in the litigations *In Re Certain Photodynamic Therapy Systems, Components Thereof, And Pharmaceutical Products Used In Combination With The Same*, Investigation No. 337-TA-1411 (U.S. International Trade Commission), and *Sun Pharmaceutical Industries, Inc. v. Biofrontera Bioscience GmbH, Biofrontera Pharma GmbH, Biofrontera AG, and Biofrontera Inc.*, Civil Action No. 1:24-cv-11637 (D. Mass). U.S. Patent Nos. 11,697,028 and 11,446,512 are asserted in the aforementioned litigations.

Petitioners previously filed a petition for *inter partes* review against the ’028 patent, proceeding no. IPR2024-00874.

The ’028 patent is a continuation of U.S. Application No. 16/791,004, granted as U.S. Pat. No. 11,446,512 (“the ’512 patent”), which is a divisional of U.S. Application No. 15/292,731, granted as U.S. Pat. No. 10,589,122 (“the ’122

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patent”), each of which claims the benefit of priority to U.S. Provisional Application No. 62/241,902 (“the ’902 application”). U.S. Pat. No. 11,179,574 and pending U.S. Application No. 17/889,115 claim the benefit of priority to the ’902 application and the applications that became the ’512 patent and the ’122 patent. U.S. Pat. No. 10,603,508, U.S. Pat. No. 11,904,180 and pending U.S. Application No. 17/506,849 claim the benefit of priority to the ’902 application and the application that became the ’122 patent.

III. DESIGNATION OF LEAD AND BACK-UP COUNSEL (37 C.F.R. § 42.8(b)(3))

Patent Owner hereby designates the following lead counsel and back-up counsel:

Lead Counsel	Back-up Counsel
Gabrielle E. Higgins (Reg. No. 38,916) ghiggins@desmaraisllp.com DESMARAIS LLP 101 California Street, Suite 3000 San Francisco, CA 94111 415-573-1902 (telephone) 415-573-1901 (facsimile)	Yung-Hoon Ha (Reg. No. 56,368) yha@desmaraisllp.com DESMARAIS LLP 230 Park Avenue New York, NY 10169 212-351-3400 (telephone) 212-351-3401 (facsimile)
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IV. SERVICE INFORMATION (37 C.F.R. § 42.8(b)(4))

Please direct all correspondence regarding this proceeding to lead and back-up counsel at the addresses listed above. Sun also consents to electronic service at:

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Dated: September 11, 2024

Respectfully submitted,

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*Lead Counsel for Patent Owner,
Sun Pharmaceutical Industries, Inc.*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that a complete copy of the foregoing was caused to be served on counsel of record for the Petitioner by filing this document through PTACTS and by sending this document via electronic mail to the following addresses:

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