

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

PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE
REGARDING PARALLEL PETITIONS

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

The two petitions filed by the Petitioner against a single patent almost four months apart represent an abuse of the IPR process. Petitioner does not explain why it could not have filed a single petition to challenge only thirteen total claims. Rather than pursuing a single petition (or even requesting termination of IPR2024-00874 (the “First Petition”)), Petitioner filed and maintained the First Petition and delayed filing this Second Petition with overlapping grounds against the *same* patent on the *same* claims. Petitioner is merely seeking to maximize the burden on the Patent Owner and evade the word limits set by the Board by asserting multiple separate grounds of attack. Petitioner’s unexplained delay of *nearly four months* in filing the Second Petition raises “fairness, timing, and efficiency concerns.” *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) (“CTPG”) at 59-60.

Petitioner asserts that it filed a “parallel” petition¹ on the ’028 patent because the Second Petition (1) uses a “modified POSITA definition requiring medical

¹ Although Petitioner refers to its two petitions as “parallel” petitions, they are anything but. The circumstances of the filings, including the time and content, illustrate that the Second Petition is the type of “serial” petition that the Board should exercise its discretion to deny under *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*. IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential).

treatment education and experience,” and (2) “focuses only on the claims asserted” in litigation. However, Petitioner provides no justification for filing a Second Petition—nearly four months after the First Petition—which the Board considered and denied on the merits. IPR2024-00874, Paper 9 (PTAB Nov 12, 2024).

First, Petitioner’s “modified” definition of the POSITA does not justify filing a second petition. Petitioner asserts that “the 1312 IPR petition modifies the level of skill in the art proposed in the 874 IPR to more clearly account for the medical treatment aspects of the ’028 Patent.” Paper 2, 4. However, Petitioner fails to explain why the Second Petition, which addresses the *same* prior art in the background and grounds for the *same* ’028 claims, would need a *different definition* of a POSITA. Petitioner unilaterally *changed* its proposed definition of the POSITA to require an engineering degree *and* a medical degree or at least four years medical experience. *Compare* IPR2024-00874, Paper 1, 8; IPR2024-01312, Paper 3, 23-24. There is no basis for Petitioner’s inconsistent shift in position. The ’028 specification states “[t]he invention relates generally to an adjustable illuminator that provides a uniform distribution of visible light in a number of configurations.” EX1001, 1:19-22. The problem in prior illuminators that the ’028 patent was trying to solve was insufficient uniformity of light on a treatment surface. *Id.*, 2:23-64. Thus, the POSITA would be an engineer or scientist in the field of optical

engineering, photodynamic therapy, or a related field *as Petitioner originally proposed*. IPR2024-00874, Paper 1, 8 (citing EX1003, ¶37); *see also* Paper 7, 16.

Petitioner fails to articulate how the requirements it added meaningfully changed the patentability analysis of the challenged claims for the prior art at issue. Indeed, Petitioner in its First Petition did not require the POSITA to have an engineering degree *and* a medical degree—Petitioner relied solely on an engineering expert, and not a medical doctor. IPR2024-00874, EX1003, ¶¶6-37. Petitioner’s new insistence that an engineering degree *and* a medical degree is required would exclude the inventors as POSITAs on their own patents—as none of the inventors has a medical degree or four years of medical experience. *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*) (referring to “the well-settled understanding that inventors are typically persons skilled in the field of the invention”); *Byrne v. Wood, Herron & Evans, LLP*, 450 F. App’x 956, 964 (Fed. Cir. 2011); EX2007-EX2009. Indeed, modifying a POSITA definition as the basis for filing a second petition, if tolerated, could open the floodgates to unwarranted serial petitions raising “fairness, timing and efficiency concerns.” CTPG at 59-60 (citing 35 U.S.C. §316(b)).

Second, Petitioner’s argument that the Second Petition “focuses only on the claims asserted” in litigation provides no justification for filing a second petition. The First Petition already challenged *every one of the challenged claims of the 1312*

IPR. It is of no moment that the Second Petition challenges *fewer* dependent claims. Petitioner misleadingly suggests the burden on the Board and parties is reduced because it narrowed the claims to “allow the parties and Board to focus their resources on the most relevant claims.” Paper 2, 1, 4-5. But, Petitioner ignores that the Second Petition asserts *double* the grounds on the *same* five independent claims (First Petition asserted Larsen/Bansal against independent claims 1, 5, 16, 20, and 21; Second Petition asserts Lundahl/Larsen and Lundahl/Larsen/Bansal against independent claims 1, 5, 16, 20, and 21). And the Board and Patent Owner have already expended considerable effort addressing the First Petition, which the Board has now denied on the merits. Had Petitioner really wanted to reduce the burden they could have requested termination of the First Petition instead of having the Board author a lengthy Institution Decision. This is simply a second bite at the apple under the guise of “parallel petition” that should be denied under 35 U.S.C. §316(b).

Petitioner also argues that it is presenting “different grounds,” but “[the CTPG] nowhere indicates that mere alternative arguments that are different from each other constitute sufficient justification for filing multiple petitions.” *Square, Inc. v. 4361423 Canada Inc.*, IPR2019-01628, Paper 14 at 11 (PTAB Mar. 31, 2020).

Moreover, significant portions of the First Petition and Second Petition are nearly identical. For example, approximately 4 pages directed to the overview of the '028 patent and prosecution history, 4 pages directed to the overview of Larsen

and Bansal, and 27 pages directed to the claim limitation mappings for Larsen and Bansal are nearly identical. *Compare* 874 Petition, 4-7, 9-12, 26-37, 43-44, 48-56, 59-62 *with* 1312 Petition, 9-12, 17, 21-23, 35-39, 41-43, 45, 55, 58-66, 69-72, 75-77.

Petitions with highly duplicative arguments, especially when sections are wholesale copy-pasted, evidence that multiple petitions challenging the same patent are unnecessary. *Nalox-1 Pharm., LLC v. Opiant Pharm., Inc.*, IPR2019-00689, Paper 11 at 9 (PTAB Sep. 9, 2019) (denying institution as redundant because “the two petitions present similar arguments, and that in many cases, they exhibit word-by-word sameness”); *LONGi Green Energy Tech. Co., Ltd. v. Hanwha Solutions Corp.*, IPR2020-00047, Paper 18 at 11-12 (PTAB Apr. 27, 2020) (denying institution of second petition that “block-copied entire portions of analysis from the prior petition” resulting in “duplication of analysis”). Petitioner’s necessity for filing two petitions, therefore, does not stem from the complexity of the novel features of the ‘028 patent but rather from Petitioner’s inefficient use of space and resources.

Therefore, in addition to the reasons set forth in Patent Owner’s Preliminary Response, the Board should exercise its discretion under 35 U.S.C §314(a) to deny the institution of the second IPR2024-01312 Petition.

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Dated: November 27, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on November 27, 2024, a complete copy of the foregoing was served on counsel of record for Petitioner by filing this document through P-TACTS and by sending this document via electronic mail to the following addresses:

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