

Case IPR2025-00287
U.S. Patent No. 11,446,512

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 IPR2025-00287

U.S. Patent No. 11,446,512

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 December 27, 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. 11,446,512 (“the ’512 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). The ’512 patent and U.S. Patent No. 11,697,028 (“the ’028 patent”) are asserted in the aforementioned litigations.

Petitioners previously filed petitions for *inter partes* review of the ’028 patent in IPR2024-00874 and IPR2024-01312. The Board denied institution of IPR2024-00874 on November 12, 2024.

The '028 patent is a continuation of U.S. Application No. 16/791,004, granted as U.S. Pat. No. 11,446,512, which is a divisional of U.S. Application No. 15/292,731, granted as U.S. Pat. No. 10,589,122 ("the '122 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: January 17, 2025

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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Dated: January 17, 2025

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