

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 No. IPR2025-00287
Patent 11,446,512

**PETITIONER'S REQUEST FOR REHEARING OF DECISION DENYING
INSTITUTION**

Pursuant to 37 CFR § 42.71(d)(2), Biofrontera Inc., Biofrontera Bioscience GmbH, Biofrontera Pharma GmbH, and Biofrontera AG (collectively, “Petitioner”) hereby respectfully request a rehearing of the July 2 decision denying institution (“Denial Decision”) invoking the Director’s discretion under 35 U.S.C. § 314(a). See Paper No. 10. The Denial Decision conflicts with recent discretionary denial decisions, overlooks the demonstrated vulnerability of the challenged claims, and risks inconsistent outcomes with parallel proceedings. Accordingly, referral to the merits panel is warranted to ensure consistency, correct material errors, and promote the efficient use of Office resources.

As set forth in Petitioner’s Discretionary Denial Brief, the Board instituted IPR2025-01312 against claims that are nearly identical to those at issue in the present proceeding. Paper No. 8 at 6-7 (claim chart comparing claims at issue in IPR2025-01312 with those at issue in the instant IPR). Given the overlapping issues, “[i]t is an appropriate use of Office resources to provide consistency and predictability to the public, and to ensure that a patent applicant or owner does not take action inconsistent with the judgment in a prior Office proceeding.” *Posco Co., Ltd. v. Arcelormittal*, IPR2025-00370, Paper 10 at 3 (Director June 25, 2025). Absent an institution, the Office risks issuing conflicting decisions on substantively similar claims, precisely the inconsistency the Director sought to avoid in *Posco*.

Here, the Denial Decision primarily cites the fact that the underlying ITC proceeding will conclude before this IPR. *Id.* at 2. The Denial Decision, however, is at odds with other recent decisions that have refused to discretionarily deny in view of an earlier ITC or District Court decision when Petitioner has shown the challenged claims are “highly vulnerable” or the Office “materially erred” in issuing the claims. *Posco*, Paper 10 at 2-3 (“Petitioner’s arguments regarding settled expectations—namely that Patent Owner’s claims were ‘highly vulnerable to invalidation based on prior art’—tip the balance against discretionary denial” even when an ITC proceeding would complete before the IPR); IPR2025-00318, *Microsoft Corp. v. Pa3 (Cluster Competence Center GMBH*, Decision Denying Request for Discretionary Denial, Paper No. 9 at 33 (Director June 12, 2025) (“Ordinarily, a scheduled district court trial date that precedes the date projected for a Board final written decision weighs in favor of exercising discretion to deny the Petition. Here, however, the Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error.”). Both of these facts are present here.

Like the *Posco* matter, Petitioner’s brief here explained how the ’512 Patent is “highly vulnerable” to invalidation since the Board has already determined in another IPR that the subject matter claimed by the ’512 Patent at issue here is likely unpatentable. Paper No. 8 at 1 (“The Board has already instituted IPR2024-01312

challenging claims of the '028 Patent that are substantially the same scope as those challenged here. This is strong evidence that the merits of the instant IPR are particularly strong...” (citing *Biofrontera Inc. et. al., v Sun Pharmaceutical Industries, Inc.*, IPR2024-01312, Paper No. 9 at 2 and 23 (PTAB Feb. 24, 2025)). Like the *Microsoft* matter, Petitioner also showed that the examiner erred in allowing the '512 Patent based on substantially the same claim limitations as recited in the '028 Patent, which the Board has now instituted IPR to review. Paper No. 2 at 12-13.

As can be seen in the chart below, the similarity between the claims of the '028 Patent in IPR2024-01312 and the '512 Patent in this case are readily apparent. Any differences between the claims at issue are not material:

'512 Patent, Claim 1	Claim being already being reviewed in IPR2024-01312 ('028 Patent, Claim 1)
1. A system for photodynamically diagnosing or treating a patient, comprising: an illuminator comprising at least five panels connected by nested hinges on inner side surfaces of adjacent panels, light sources disposed on surfaces of the at least five panels, the illuminator being configured to uniformly illuminate a treatment surface of the patient via the light sources,	1. A system for photodynamically diagnosing or treating a patient, comprising: an illuminator comprising five panels connected by hinged structures on inner side surfaces of adjacent panels; and light sources disposed on surfaces of the five panels, the illuminator being configured to uniformly illuminate a treatment surface of the patient via the light sources,

one of the at least five panels positioned as a center panel configured to face the treatment surface, and two or more of the at least five panels being configured to be angled relative to the center panel, wherein each of the at least five panels has two first edges and two second edges shorter than the two first edges, and the light sources are arranged such that a higher intensity of light is emitted proximate the second edges compared to the intensity of light emitted not proximate the second edges.	one of the five panels being positioned as a center panel configured to face the treatment surface, and two or more of the five panels being configured to be angled relative to the center panel, wherein the five panels are positioned to allow treatment within approximately four inches of the treatment surface, and wherein each of the five panels has two first edges and two second edges shorter than the two first edges, and the light sources are arranged such that a higher intensity of light is emitted proximate the second edges compared to the intensity of light emitted not proximate the second edges.
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See Paper No. 8 at 6-7; *see also Padagis US LLC v Neurelis, Inc.*, IPR2025-00464, Paper No. 12 (Director July 16, 2025) (IPR referred in part because “Petitioner, however, provides a persuasive comparison of the claims challenged in the present proceeding and those involved in [another IPR] that demonstrates significant overlap in claimed subject matter.”)

Indeed, in light of the already instituted IPR, Petitioner argued that institution of this proceeding would “avoid inconsistent outcomes” (Paper No. 8 at 19) which is a rationale the Acting Director cited in *Posco*. *Posco*, Paper 10 at 3 (“It is an appropriate use of Office resources to provide consistency and predictability to the

public,...”). This is particularly true given the recent issuance of the ’512 Patent in September of 2022 greatly lessens any concerns with settled expectations.

Reconsideration and referring to the PTAB assures that the decision here does not conflict with prior Director Review decisions in which institution was granted under comparable circumstances. Accordingly, the Denial Decision should be reconsidered and referred to a PTAB panel for consideration on the merits, given the strong showing that the claims of the ’512 are highly vulnerable and that the Office materially erred in issuing the ’512 Patent, notwithstanding an ITC decision will issue before this IPR concludes.

Dated: August 1, 2025,

Respectfully submitted,
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the accompanying Petitioner's Rehearing Request is being served via electronic mail on August 1, 2025, upon the following:

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