

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

SUN PHARMACEUTICAL INDUSTRIES, INC.,
Petitioner,

v.

BIOFRONTERA INC.,
Patent Owner.

PGR2026-00021
Patent 12,280,146 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review

Biofrontera Inc. (“Patent Owner”) filed a request for discretionary denial (Paper 8, “DD Req.”) in the above-captioned case, and Sun Pharmaceutical Industries, Inc. (“Petitioner”) filed an opposition (Paper 10, “DD Opp.”). On May 19, 2026, after considering the parties’ arguments and the record, and in view of all relevant considerations, I issued a Notice indicating that institution was denied in this proceeding. Paper 11.

Patent Owner argues that Sun Pharmaceutical Industries, *Inc.* (“SPI Inc.”) (“Petitioner”) is 100% owned by its parent company, Sun Pharmaceutical Industries *Ltd.* (“SPI Ltd.”). DD Req. 2–3 (citing Ex. 2013). Also, Patent Owner asserts that SPI Ltd. consolidates its financial statements with SPI Inc. and other related subsidiaries, issues press releases in the name of SPI Inc., and otherwise shares common interests. *See id.* at 3–4. Accordingly, Patent Owner contends Petitioner fails to properly identify all real parties in interest (“RPI”) and the Petition should be denied. *Id.* at 5; *see also* Director’s Memorandum dated October 28, 2025, designating precedential *Corning Optical Communications RF, LLC v. PPC Broadband Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015)).

Petitioner responds that “[t]here is a clear corporate distinction between SPI Inc. and SPI Ltd. and other Sun Pharma entities as it relates to the instant PGR proceeding.” DD Opp. 8. Specifically, Petitioner presents declaration evidence that SPI Inc. is solely funding and controlling the instant proceeding. *See id.* at 8–11 (citing Ex. 1021 ¶¶ 1, 16–18, 20, 22, 25, 28). Petitioner asserts that “SPI Ltd.’s mere status as SPI Inc.’s parent company does not make it an RPI to this matter.” *Id.* at 12.

As I previously explained, RPIs are not limited to entities that are actually funding and controlling the proceeding, but include entities that have the *ability* to control the proceeding. *See Tianma Microelectronics*

Co., Ltd. v. LG Display Co., Ltd., IPR2025-01579, Paper 12 at 9–10 (Director Mar. 18, 2026) (precedential) (“With its identification of RPIs in dispute, it is Petitioner’s burden to bring forth evidence or arguments demonstrating that it had named all RPIs—and that none were foreign governments or entities a foreign government had the ability to control.”); *see also Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1244–45 (Fed. Cir. 2018) (remanding to the Board to further consider RPI where the patent owner identified an unnamed party with the “opportunity to control” the proceeding). Petitioner has not provided sufficient evidence that SPI Ltd., the corporate parent and 100% owner of SPI Inc., does not have the ability to control the proceeding. Rather, Petitioner’s declaration evidence is focused on whether SPI Inc. is *actually* funding or controlling the proceeding. *See* Ex. 1021 ¶ 4 (“SPI Inc. is an indirect wholly-owned subsidiary of Sun Pharmaceutical Industries, Ltd.”). On this record, Petitioner fails to carry its burden to establish that it has identified all RPIs.

Petitioner recognizes this possibility and requests adding SPI Ltd. as an RPI if it will moot the issue. *See* DD Opp. 15, n.2. Petitioner acknowledges that adding SPI Ltd. may require a new filing date that places the Petition outside the 9-month window for filing a PGR. *Id.* (citing *Curium US LLC v. Universität Heidelberg*, IPR2025-01582, Paper 11 (PTAB Feb. 25, 2026) (informative)). Thus, Petitioner requests that the instant PGR petition be converted into an IPR petition if the addition of SPI Ltd. requires a new filing date. *Id.* Adding an RPI requires according a new filing date to the Petition. *See Corning Optical*, Paper 68 at 23. There

is no statutory provision or rule for converting a PGR into an IPR.

Accordingly, this Petition is denied and Petitioner may file an IPR petition.¹

In consideration of the foregoing, it is:

ORDERED that the Petition is *denied*, and no trial is instituted.

¹ If Petitioner chooses to file an IPR petition, that petition will not be considered a repeat challenge for discretionary purposes.

PGR2026-00021
Patent 12,280,146 B2

FOR PETITIONER:

Yung-Hoon Ha
Bridget Belcher
Desmarais LLP
yha@desmaraisllp.com
bbelcher@desmaraisllp.com

FOR PATENT OWNER:

James Murphy
Kendall Gurule
Polsinelli PC
jpmurphy@polsinelli.com
kgurule@polsinelli.com