

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**BIOFRONTERA INCORPORATED,
BIOFRONTERA BIOSCIENCE GMBH,
BIOFRONTERA PHARMA GMBH,**

AND

BIOFRONTERA AG

Petitioner

v.

DUSA PHARMACEUTICALS, INC.

Patent Owner

***Inter Partes* Review No. IPR2022-00056
U.S. Patent No. 10,357,567**

**RENEWED UNOPPOSED MOTION TO DISMISS
PETITION FOR INTER PARTES REVIEW**

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

I. INTRODUCTION

On December 28, 2021, the Board authorized Petitioner to file a renewed motion to dismiss the present petition for *inter partes* review together with a true and correct copy of any settlement agreement, and thereby terminate IPR2022-00056 directed to U.S. Patent No. 10,357,567 (“the ’567 Patent”). Paper No. 7 at 4. Petitioner and Patent Owner have conferred via email, and Patent Owner does not oppose the relief requested in this motion. Petitioner now so moves and respectfully requests that the Board dismiss the present petition and terminate IPR2022-00056 consistent with Board’s precedent allowing petitioners to withdraw IPR petitions pre-institution. This proceeding is in its preliminary phase, Patent Owner has not yet filed a Preliminary Response, and the Board has not yet reached the merits by issuing a decision on institution.

II. BACKGROUND AND RELATED IPR PROCEEDINGS

The present petition was filed less than three months ago on October 19, 2021. The parties have entered into a confidential settlement agreement (“Settlement Agreement”) that will resolve the parties’ instant dispute regarding the challenged ’567 Patent, as well as other disputes in the District of Massachusetts in a lawsuit originally captioned as *Dusa Pharmaceuticals, Inc. v. Biofrontera Inc. et al.* (Civil Action No. 1:18-cv-10568) involving U.S. Patent No. 9,723,991 (“the ’991 Patent”) and U.S. Patent No. 8,216,289 (“the ’289 Patent”), neither of which is in the same

family as the '567 Patent. This Settlement Agreement has been made in writing, and a true and correct copy shall be filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) (Ex. 1101). There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. Pursuant to the terms of the Settlement Agreement, the parties have filed a Joint Notice of Settlement in the aforementioned district court case, and the parties' disputes have been dismissed by the court.

Further, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Patent Owner and Petitioner are concurrently filing a Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Be Kept Separate, which asks the Board to treat the Settlement Agreement as business confidential information, and to keep it separate from the files of this proceeding and the files of the '567 Patent.

III. ARGUMENT

Good cause exists to dismiss the present petition and terminate IPR2022-00056. The proceeding is in its preliminary stage and Patent Owner has not yet filed a Preliminary Response. "The Board may . . . dismiss any petition." 37 C.F.R. 42.71(a); *see also* 37 C.F.R. § 42.72 (The Board "may terminate a trial without rendering a final written decision, where appropriate."). Further, the rules governing

IPR proceedings “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *Id.* § 42.1(b). In determining whether a termination request is “appropriate,” the Board primarily examines the stage and nature of the proceedings. *See, e.g., Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015-01270, Paper 12 at 3 (PTAB Dec. 9, 2015). Here, dismissal will preserve both Board and party resources, particularly in view of the early stage of the proceeding.

The Board has precedent for allowing petitioners to withdraw IPR petitions pre-institution when proceedings are in a similar posture. *See, e.g., Ericsson Inc. v. Electronics and Telecommunications Research Institute*, IPR2020-00241, Paper 13 (PTAB March 9, 2020); *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01221, Paper 21 (PTAB Jan. 13, 2020); *Huawei Technologies Co. Ltd v. Harris Global Communications, Inc.*, IPR2019-01512, Paper 8 (PTAB Jan. 10, 2020); *Pfizer, Inc., v. Biogen, Inc.*, IPR2018-00231, Paper No. 11 (PTAB June 6, 2018); *Darfon Electronics Corp. v. Lite-On Technology Corp.*, IPR2018-01797, Paper No. 8 (PTAB Jan. 9, 2019); *Turner Sports Interactive, Inc. v. Tagi Ventures, LLC*, IPR2017-01010, Paper No. 7 (PTAB July 31, 2017). Moreover, withdrawal of the present petition does not prejudice the Patent Owner, who does not oppose the filing of this motion.

IV. CONCLUSION

For the reasons set forth herein, Petitioner Biofrontera respectfully requests that the Board grant the Renewed Unopposed Motion to Dismiss Petition for Inter Partes Review in Case Number IPR2022-00056 and dismiss the proceeding in its entirety.

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