

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**

**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

The Board authorized Petitioner to file a motion to dismiss the present Petition for *inter partes* review in IPR2022-00056 directed to U.S. Patent No. 10,357,567 (“the ’567 Patent”). (Board email dated December 2, 2021.) 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 in 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.

As explained in more detail below, dismissal of the instant *inter partes* review Petition under 37 C.F.R. § 42.71 is the appropriate mechanism for addressing the Petition under the circumstances giving rise to this motion, as the Petition is presently pending and awaiting a decision on institution, and dismissal would preserve the Board’s and parties’ resources, promote efficiency, and minimize costs, without prejudicing Patent Owner. *See Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257 Pap. 16, 3 (PTAB Jan. 2, 2020) (granting petitioner’s unopposed motion to dismiss “to promote efficiency and minimize unnecessary costs”); *Samsung Electronics Co., Ltd. v. Telefonaktiebolaget LM Ericsson*, IPR2021-00446

Pap. 7, 5 (PTAB Aug. 3, 2021) (noting “Petitioner has shown good cause for dismissal of its Petitions” and granting motion to dismiss without requiring parties to file settlement agreement); 37 C.F.R. § 42.71(a) (“The Board . . . may grant, deny, or dismiss any petition or motion . . .”).

Accordingly, Petitioner hereby moves unopposed for dismissal of the pending Petition.

II. BACKGROUND AND RELATED IPR PROCEEDINGS

The present petition was filed less than two months ago on October 19, 2021, and Patent Owner has yet to submit its Preliminary Response. The parties have recently 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. Pursuant to the terms of the Settlement Agreement, the parties have filed a Joint Notice of Settlement in the aforementioned civil action, and the parties’ disputes have been dismissed by the court. Pursuant to the terms of the Settlement Agreement, the parties have also agreed that the filing of the present motion would not limit Petitioner’s ability to refile a petition for *inter partes* review of the ’567

Patent at a later date. There are no district court proceedings between the parties related to the '567 Patent that is the subject of the Petition, and there are no other currently pending related IPR or district court proceedings between the parties.

III. ARGUMENT

A. PTAB Rules Provide for Dismissal of a Pending Petition for *Inter Partes* Review Before Reaching the Merits

To request *inter partes* review of a patent, “a person who is not the owner of a patent may file with the Office *a petition to institute an inter partes review* of the patent.”¹ 35 U.S.C. § 311(a). Thereafter, if it reaches the merits, the Board either grants the petition, which yields institution of an *inter partes* review, or denies the petition, which results in non-institution of an *inter partes* review. In rendering its decision on institution, the Board evaluates whether “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

Notably, prior to such a decision on institution, no *inter partes* review has commenced. *See, e.g.*, 35 U.S.C. §§ 311-313. Statutes addressing pre-institution procedures therefore consistently refer to “the petition” rather than an “*inter partes*

¹ Unless indicated, emphases in quotes throughout this motion are added.

review” proceeding. *Id.*; see also *Intellectual Ventures II LLC v. JPMorgan Chase & Co.*, 781 F.3d 1372, 1376 (“The AIA differentiates between a petition for a CBMR proceeding (which a party files) and the act of instituting such a proceeding (which the Director is authorized to do).”). This stands to reason, as its name—institution decision—confirms that *inter partes* review does not commence until a decision to institute has been rendered. See also *Institution*, Black’s Law Dictionary (11th ed. 2019) (“The commencement of something, such as a civil or criminal action.”).

With respect to a petition, therefore, the PTAB rules provide that the Board may reach the merits through grant or denial of institution, in the manner noted above. And importantly, the PTAB rules recognize one more option—dismissal. 37 C.F.R. § 42.71(a) (“the Board . . . may grant, deny, or **dismiss** any petition or motion”); see also, e.g., 37 CFR § 42.12(b)(8) (describing sanctions including “**dismissal of the petition**”); 37 CFR § 42.106(b) (in the case of an incomplete petition, “the Office will **dismiss the petition** if the deficiency in the petition is not corrected within one month from the notice of an incomplete petition.”).

In contrast, no rule or statute authorizes the Board to “dismiss” a trial on an instituted *inter partes* review. Instead, “the Board may **terminate a trial**” or an “instituted” *inter partes* review. 37 C.F.R. § 42.72; 35 U.S.C. § 317(a); see also, e.g., 37 C.F.R. § 42.2 (a “[t]rial” is “a contested case instituted by the Board based upon a petition”). And as noted in section C, *infra*, no rule or statute authorizes the Board

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