

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.

IPR2022-00056
Patent 10,357,567

Before ERICA A. FRANKLIN, CHRISTOPHER G. PAULRAJ, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Renewed Unopposed Motion to Dismiss the Petition
and to Terminate the Proceeding; and Granting Joint Request that the
Settlement Agreement be Treated as Business Confidential and
Kept Separate

37 C.F.R. §§ 42.5(a), 42.71(a), 42.74

With authorization of the Board, Petitioner filed a renewed unopposed motion to dismiss the petition and to terminate this proceeding, Paper 8 (“Renewed Motion”), along with a copy of their written settlement agreement, Exhibit 1011 (“Settlement Agreement”). Additionally, pursuant to 35 U.S.C § 317(b) and 37 C.F.R. § 42.74(c), the parties filed a joint request that the settlement agreement be treated as business confidential information and be kept separate. Paper 9.

In the Renewed Motion, Petitioner asserts that good cause exists to dismiss the Petition and to terminate the proceeding because the proceeding is in its preliminary stage and Patent Owner has not yet filed a Preliminary Response. Paper 8, 3. Petitioner explains also that the parties have entered into a confidential settlement agreement, Ex. 1011, that resolves the parties’ dispute regarding U.S. Patent No. 10, 357, 567 B2 (Ex. 1001, “the ’567 patent”), along with other disputes in *Dusa Pharm., Inc. v. Biofrontera Inc. et al.* (Civil Action No. 1:18-cv-10568) involving two patents that are not in the same family as the ’567 patent. Paper 8, 2. Petitioner states that the Settlement Agreement “has been made in writing, and a true and correct copy shall be filed with this Office as business confidential pursuant to 35 U.S.C § 317(b) and 37 C.F.R. § 42.74(b) (Ex. 1101).” *Id.* at 3.

As Petitioner correctly asserts, this case is in the preliminary phase of the proceeding, as the Patent Owner has not yet filed a Preliminary Response, and the Board has not issued a decision whether to institute trial. Under the circumstances, we determine that it is appropriate to grant Petitioner’s Renewed Motion.

Additionally, the parties' joint request for the Settlement Agreement to be treated as business confidential information and kept separate from the file of the involved patents under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*.¹

ORDER

Accordingly, it is hereby:

ORDERED that Petitioner's Renewed Unopposed Motion to Dismiss the Petition is *granted* and the Petition is dismissed;

FURTHER ORDERED that the joint request for the settlement agreement to be treated as business confidential information and kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that the proceeding is terminated.

¹ In their joint request, the parties state, "Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Petitioner . . . and Patent Owner . . . jointly request to file the Settlement Agreement (Ex. 1101) . . . as business confidential information, which shall be kept separate from the file of the patent at issue, and only made available to Federal Government agencies upon written request..[sic]" Paper 9, 2. We note that 35 U.S.C. § 317(b) expressly provides that the agreement also "shall be made available . . . to any person on a showing of good cause." Similarly, 37 C.F.R. § 42.74(c) expressly provides that, in addition to a Government agency, the settlement "shall" be available "[t]o any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause." Thus, we treat the parties' omission of those provisions under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) as an inadvertent error and not as an argument or attempt to limit the provisions of that statute and rule. As set forth in this Order, the joint request is granted, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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