

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIOFRONTERA INCORPORATED, ET AL.,
Petitioners

v.

DUSA PHARMACEUTICALS, INC.,
Patent Owner

Case IPR2022-00056
Patent 10,357,567

PATENT OWNER'S MANDATORY NOTICES

**PATENT OWNER'S MANDATORY NOTICES
UNDER 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, the patent owner, DUSA Pharmaceuticals, Inc. (“Patent Owner”), hereby submits the following Mandatory Notices in response to the Petition for *Inter Partes* Review of U.S. Patent No. 10,357,567.

1. Real Party-In-Interest under 37 CFR § 42.8(b)(1)

DUSA Pharmaceuticals, Inc., Sun Pharmaceuticals Industries, Inc., Sun Pharmaceutical Holdings USA, Inc., and Sun Pharmaceutical Industries, Ltd. are the Real-Parties-in-Interest.

2. Related Matters under 37 CFR § 42.8(b)(2)

Patent Owner is not aware of other matters specifically involving the '567 patent, but the parties are presently involved in the following litigation: *DUSA Pharmaceuticals, Inc. v. Biofrontera Inc. et al.*, Civil Action No. 1:18-cv-10568 (D. Mass.).

3. Lead and Back-Up Counsel, under 37 CFR § 42.8(b)(3)

Patent Owner designates the following lead and back-up counsel:

LEAD COUNSEL	BACK-UP COUNSEL
W. Karl Renner, Reg. No. 41,265 Fish & Richardson P.C. 3200 RBC Plaza 60 South Sixth Street Minneapolis, MN 55402 Tel: 202-783-5070/Fax: 877-769-7945 Email: IPR46697-0005IP1@fr.com	Heather L. Flanagan, Reg. No. 54,101 Andrew B. Patrick, Reg. No. 63,471 Fish & Richardson P.C. 3200 RBC Plaza 60 South Sixth Street Minneapolis, MN 55402 Tel: 214-747-5070/Fax: 877-769-7945 PTABInbound@fr.com

4. Service Information under 37 CFR § 42.8(b)(4)(i) *et seq.*

Please address all correspondence and service to the address of counsel listed above. Patent Owner also consents to electronic service by email at IPR46697-0005IP1@fr.com (referencing No. 46697-0005IP1 and cc'ing PTABInbound@fr.com, axf-ptab@fr.com, patrick@fr.com, and flanagan@fr.com).

Respectfully submitted,

Dated: November 9, 2021

/Andrew B. Patrick/
W. Karl Renner, Reg. No. 41,265
Heather L. Flanagan, Reg. No. 54,101
Andrew B. Patrick, Reg. No. 63,471
Fish & Richardson P.C.

Attorneys for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on November 9, 2021, a complete and entire copy of this Patent Owners' Mandatory Notices and Power of Attorney were provided via electronic service, to the Petitioner by serving the correspondence address of record as follows:

Lauren L. Fornarotto
John F. Garvish
Geoffrey L. Smith
Matthew T. Cameron
MCKOOL SMITH, P.C.,
One Manhattan West
395 9th Avenue, 50th Floor
New York, New York 10001-8603

E-mail: BF-IPR@McKoolSmith.com

/Diana Bradley/
Diana Bradley
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(858) 678-5667