

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

Case IPR2018-01585

Patent 8,216,289

**JOINT MOTION & CERTIFICATION UNDER 37 C.F.R. § 42.100(b)
REQUESTING DISTRICT COURT-TYPE CLAIM CONSTRUCTION**

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. §§ 42.21(a) and 42.100(b), Patent Owner DUSA Pharmaceuticals, Inc. and Petitioner Biofrontera Incorporated, Biofrontera Bioscience GmbH, Biofrontera Pharma GmbH, and Biofrontera AG respectfully request that the Board apply a district court-type claim construction approach during this proceeding.

II. GOVERNING RULE

The broadest reasonable construction applies to the claims in an unexpired patent. *In re Cuozzo Speed Techs.*, 793 F.3d 1268, 1279 (Fed. Cir. 2015); *see also* 37 C.F.R. § 42.100(b) (“A claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears”). However, the *Phillips* claim construction rubric applies to the claims in an expired patent. *Black & Decker v. Positec USA, Inc.*, 646 Fed. App’x 1019, 1024 (Fed. Cir. 2016) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed.Cir.2005) (en banc)); *In re CSB–Sys. Int’l, Inc.*, 832 F.3d 1335, 1341–42 (Fed. Cir. 2016); *see also* *Emerson Electrical Co. v. IPCO, LLC*, IPR2017-00007, Paper 7, at 6 (PTAB April 5, 2017) (applying *Phillips* to claims of expired patent); *Intel Corp. v. FuzzySharp Tech., Inc.*, IPR2014-00001, Paper 7, at 9 (PTAB Jan. 29, 2014) (same).

III. STATEMENT OF FACTS

This motion is based on the following facts:

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1. The patent subject to this proceeding, U.S. Patent No. 8,216,289 (the “’289 Patent”), claims priority to Application No. 12/621,845, filed on November 19, 2009 (now U.S. Patent No. 8,030,836), which is a continuation of Application No. 11/716,014, filed on March 9, 2007 (now U.S. Patent No. 7,723,910), which is a continuation of Application No. 10/755,318, filed on January 13, 2004 (now Pat. No. 7,190,109), which is a divisional of Application No. 09/774,084, filed on January 31, 2001 (now Pat. No. 6,709,446), which is a divisional of Application No. 09/070,772, filed on May 1, 1998 (now Pat. No. 6,223,071). Thus, the earliest possible priority date is May 1, 1998. (Paper 1 at Ex. 1001 § (60).)

2. The ’289 Patent therefore expired on May 1, 2018 (i.e., 20 years from May 1, 1998).

3. Petitioner filed its Petition on August 22, 2018. On August 28, 2018, the Board issued its Notice Of Filing Date, according the Petition a filing date of August 22, 2018 and making Patent Owner’s preliminary response due November 28, 2018. (Paper 3 at 1–2.)

4. This motion is made within 30 days from the filing of the Petition.

5. On September 13, 2018, the Board authorized Petitioner to file this motion.

6. Petitioner has proposed several claim terms for construction under *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) in support of its Petition. (Paper 1 at 11–15.)

7. Patent Owner has not yet taken a position as to which, if any, claim terms it believes require construction.

8. Both Petitioner and Patent Owner agree, however, that to the extent the Board is to construe any claim term, it should employ a district court style claim construction.

IV. CERTIFICATION

Patent Owner and Petitioner certify, through the undersigned counsel, that the '289 Patent expired on May 1, 2018.

V. CONCLUSION

For the foregoing reasons, Patent Owner and Petitioner respectfully request that to the extent the Board determines claim construction is necessary during this proceeding, the Board apply a district court-type claim construction approach.

Dated: September 19, 2018

Respectfully submitted,

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