



April 20, 2020

VIA E-FILING

The Honorable Sherry R. Fallon
J. Caleb Boggs Federal Building
844 N. King Street
Wilmington, DE 19801-3568

FILED UNDER SEAL

RE: *University of Massachusetts Medical School, et al. v. L'Oréal S.A., et al.*
(C.A. No. 17-cv-868-CFC-SRF)

Dear Magistrate Judge Fallon,

Plaintiffs write to respectfully move the Court to order Defendant to produce three narrow categories of outstanding documents: (1) certain development records for the Accused Products; (2) certain documents related to Defendant's patent applications that cite the asserted patents; and (3) organizational charts reflecting the structure of Defendant's business and personnel.

1. Defendant's Product Development Records

The two asserted patents claim methods for using adenosine to enhance skin by applying adenosine to the dermal cells, which increases the size and function of dermal fibroblast cells and consequently improves wrinkling and skin smoothness.¹ On Defendant's websites, it claims to include adenosine in its products for "providing anti-aging benefits," including "significant improvements in the visible signs of aging as well as improving skin smoothness." Ex. 1 (print-out from the L'Oréal Paris U.S.A. website).²

[REDACTED]

But, although Defendant includes adenosine that operates at the dermal cell level in the manner claimed in the asserted patents in at least approximately 150 Accused Products, [REDACTED]


Plaintiffs served an interrogatory seeking precisely this information in July 2019, asking Defendant to "describe in detail when and the reason(s) why You determined to use adenosine as an ingredient in any product You have sold in the United States, including but not limited to any

¹ Plaintiffs recently won their motion for claim construction adopting this interpretation, over Defendant's interpretation that the patents do not operate at the dermal cell level. *See* D.I. 114.

² Also attached as Exhibit 6 to Plaintiffs' June 30, 2017 Complaint, D.I. 1.

³ While Defendant produced product testing for some Accused Products, as previously ordered by the Court, Defendant has produced documents reflecting the inclusion of adenosine in its formulations for only the following products: [REDACTED]

testing and/or research that was relevant to Your decision to include adenosine in Your products.”
See Ex. 3 at 7 (Interrogatory No. 6).



Plaintiffs emailed and met and conferred telephonically with Defendants about this issue, and clarified they are only looking for product development records related to the claimed technology—i.e., documents related to Defendant’s decision to include adenosine in the Accused Products, and/or documents related to the Accused Products’ ability to enhance skin, with or without the inclusion of adenosine. Defendant argued that these documents are “irrelevant” and it would be burdensome for unspecified reasons for Defendant to collect and produce any further documents whatsoever. Plaintiff said that the missing product development information is compounded by Defendant’s incomplete and apparently inaccurate response to Plaintiffs’ Interrogatory No. 6; Defendant purported it would supplement that response on the parties’ call, but later withdrew that offer. *See* Ex. 9.

In short, Plaintiffs request the Court order Defendant to produce product development records related to Defendant’s decision to include adenosine in the Accused Products, instead of or in addition to any other ingredient that may reduce wrinkling, roughness, dryness, or laxity of the skin, along with a complete response to Plaintiffs’ Interrogatory No. 6. These are narrow requests critical to damages, among other issues.

2. Defendant’s Patent Records and Inventor Files

Plaintiffs have contended since filing of the original Complaint that Defendant has known about the asserted patents since as early as 2002, including because Defendant’s patents and applications cite and describe the asserted patents as important inventions related to using adenosine for skincare. *See, e.g.*, Ex. 10 at [0018] (explaining Plaintiffs’ asserted patents teach “that adenosine or an analog of adenosine be used in a composition that is topically applied to the

skin to improve skin condition and in particular to combat lines, skin laxity, skin dryness and pigmentary blemishes” and “that adenosine increases the size of fibroblasts and increases the synthesis of proteins by fibroblasts.”); *see also* D.I. 1 ¶¶ 19-22 and Ex. 4. Indeed, two of Defendant’s patent applications (the “Galey” and “Cornell” applications), both of which relate to using adenosine to enhance skin, were rejected by the Patent Office over Plaintiffs’ asserted patents. *See* Ex. 11 (Galey) at 4-16; Ex. 12 (Cornell) at 3-5.

Where Plaintiffs contend that Defendant was aware of the asserted patents, had its own related applications rejected over the asserted patents, failed to obtain a license from Plaintiffs, and then went ahead with its plans to make the Accused Products regardless, these rejected patent applications are critical to indirect infringement and willfulness. *See, e.g.*, D.I. 31 at 12-17 (this Court’s Report and Recommendation referencing the same facts as critical to the same issues). Accordingly, Plaintiffs served several related document requests, as early as July 2019. *See, e.g.* Ex. 6 at RFP No. 43; Ex. 8 at RFP No. 1, 2, 13, 22, 23, and 32. To date, Defendant has not even produced the full file histories of these patents and patent applications.

The parties met and conferred about this issue, and Defendant represented that it would supplement its production of file histories. Plaintiffs requested that Defendant also search the inventor files for at least the Galey and Cornell applications—both of which claim using adenosine to enhance skin, and both of which were rejected over the asserted patents—for responsive documents that are not in the public file histories and which relate to the benefits of adenosine, and Defendant’s knowledge of the asserted patents. Defendant refused, objecting that these inventor files are in the possession of a third party, its parent company L’Oréal S.A.

That argument does not hold water for at least two reasons. First, the invention claimed in the Cornell patent application was invented by employees of Defendant L’Oreal U.S.A., not its parent company. *Compare* Ex. 13 with Ex. 14-16 [REDACTED], and it should finally search for relevant and responsive documents in the files of these inventors, whom Plaintiffs disclosed in their August 2019 initial disclosures, *see* Ex. 17.

Second, with respect to the Galey application, this request is limited to the files of a single inventor (Mr. Galey), *see* Ex. 10, and these files are particularly important both because the Galey application is the first L’Oréal patent or application to cite to or reference the asserted patents, and because Mr. Galey made extensive representations about the asserted patents in his efforts to obtain patent protection for his own, ultimately rejected invention. *See* Ex. 18. It is critical for Plaintiffs to know what responsive and relevant documents are in Mr. Galey’s files that are not part of the public file history. Defendant has represented and demonstrated it is readily able to obtain documents from L’Oréal S.A. *See, e.g.* Feb. 18, 2020 Hr. Tr. at 6:17-23 (“The one thing I would add, Your Honor, is as we noted in the papers, a part of what we have agreed to do is to produce documents without requiring plaintiffs to go through the Hague Commission to get documents from the parent company, L’Oreal S.A., and we have been doing that.”); *see also* [REDACTED]

Defendant should not be permitted to pick and choose which documents it wants to produce, providing Plaintiffs with documents that may help its defense while refusing to search for and produce documents that tend to show its infringement has been willful.

3. Organizational Charts

Plaintiffs served a request for Defendant's organizational charts in July, and never received them. *See* Ex. 20 at RFP No. 35. Organizational charts are critical to prosecuting Plaintiffs' case, because [REDACTED]

[REDACTED] In March 2020, and only after Plaintiffs filed a letter requesting a teleconference with the Court to address this issue, *see* D.I. 100, Defendant identified certain witnesses whose files it had searched for responsive documents. To date, Defendant has never supplemented its initial disclosures identifying which, if any witnesses, it may bring to trial, and which, if any witnesses may have discoverable information. Plaintiffs need this information to move forward with individual depositions.

Indeed, the same information is critical to move forward Plaintiffs' 30(b)(6) depositions of Defendant. Thus far, on the parties' meet and confers about Plaintiffs' deposition notice, Defendant has objected that Plaintiffs' topics are unreasonably burdensome and will each require dozens of witnesses to testify from each individual brand owned by Defendant, because there is no overlap whatsoever between the personnel from these different brands. Defendant has used this claim to justify its delays in providing witnesses for deposition, although Defendant's website suggests that there are individuals who oversee for, for example, marketing, finances, and research & innovation not at the individual brand level. *See* Ex. 22.⁴

For the reasons described above, Plaintiffs respectfully request the Court grant their motion.

Respectfully submitted,

/s/ Brian E. Farnan

Brian E. Farnan

cc: Counsel of Record (Via E-Mail)

⁴ Although Plaintiffs raised this issue on telephonic meet and confers, including on the April 14, 2020 call, after Plaintiffs added this issue to the parties' joint motion, Defendants claimed the parties had never discussed it. That is incorrect, *see* Ex. 23, and in any event is irrelevant, given that Plaintiffs immediately offered to meet and confer again about this narrow issue, which Defendant did not agree to do before the deadline for this letter. *See* Ex. 24.