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VIA CM/ECF

The Honorable Sherry R. Fallon
District Court of Delaware
J. Caleb Boggs Federal Building
Wilmington, DE 19801-3567

PUBLIC REDACTED VERSION

Re: Univ. of Massachusetts et al. v. L'Oréal USA, Inc., C.A. No. 17-868-CFC-SRF

Dear Judge Fallon:

I write on behalf of Defendant L'Oréal USA, Inc. ("L'Oréal USA") to respectfully request that the Court order Plaintiffs to (1) produce the non-privileged, basic factual information underlying the testing affirmatively disclosed and relied on as their sole basis for asserting infringement and (2) meet and confer with L'Oréal USA regarding an appropriate extension of the case schedule to propose to Judge Connolly to ameliorate the prejudice already suffered as a result of Plaintiffs' failure to timely produce such information.¹ (*See* Ex. 1 (Proposed Order).)

The patents-in-suit are directed to topically applying compositions containing adenosine for "enhancing the condition" of skin "wherein the adenosine concentration applied to the dermal cells is," *e.g.*, 10^{-4} M to 10^{-7} M (the "concentration claim language"). Plaintiffs' sole basis for asserting more than 150 L'Oréal USA products infringe the concentration claim language (*i.e.*, the sole basis for bringing this lawsuit) is testing conducted by one or more of Plaintiffs' experts. (*See, e.g.*, Ex. A at 1[f], 3; Ex. B at 1-2, 5; Ex. C, ADENOSINE_00003794.) Because Plaintiffs' testing formed the sole basis for their infringement allegations, and they affirmatively relied on and disclosed such testing in their infringement contentions, Plaintiffs have (and appear not to contest that they have) waived any work-product protection for the information underlying the testing. *See, e.g., Gillette Co. v. Dollar Shave Club, Inc.*, No. 15-1158-LPS, 2018 WL 3528720, at *1 (D. Del. July 23, 2018) (ordering the production of "documents that form[ed] the bases of [Plaintiff's] infringement contentions" where Plaintiff "incorporated" select materials "from testing performed by non-testifying experts . . . into its infringement contentions").² Despite not contesting that the factual information underlying their testing is within their control and not protected, Plaintiffs have continually resisted producing this basic information for the past six months, thereby prejudicing L'Oréal USA's ability to prepare its defenses.

¹ To the extent an appropriate extension cannot be granted, given Plaintiffs' evasive conduct and failure to timely produce that information to L'Oréal USA's significant prejudice, L'Oréal USA requests in the alternative that Plaintiffs be precluded from relying on their infringement testing in this action.

² The briefing in *Gillette* makes clear that the defendants were seeking "documents regarding [Plaintiff's] tests, such as those regarding the testing conditions and protocols, the underlying data, other images, or test reports." (D.I. 68, Ex. 11 at Brief Page 1.)



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1. **Plaintiffs Have Consistently Attempted to Hide Their Infringement Theories and Related Factual Information**

For the concentration claim language, Plaintiffs' initial infringement contentions (served on October 10, 2019) simply parroted back that language and cited "forthcoming expert disclosures" in each of the 268 infringement claim charts they served. (*See, e.g.*, Ex. A at 1[f], 3; D.I. 68 at 1.) When notified of their deficient contentions, and following a meet and confer, Plaintiffs provided L'Oréal USA only a chart containing numbers that purport to reflect the final results of analytical testing. (*See* Ex. D at 1-2 (Nov. 13 T. Lusztig Email to S. Polatoglu); Ex. E, Plaintiffs' number chart.) This belated disclosure, made on November 13, 2019, established that expert testing was in fact the sole basis for Plaintiffs' infringement contentions. Nevertheless, Plaintiffs refused to supplement their contentions or provide certain basic information concerning this testing, even though they had agreed to produce "the data that [they] relied on to form the basis of [their] belief that these limitations are met." (*See* Ex. F at 1 (Nov. 8 T. Lusztig Email to S. Polatoglu).) As a result, L'Oréal USA was forced to seek relief from the Court, which in turn ordered Plaintiffs to supplement their infringement contentions. (Dec. 9 Hearing Tr. 36:5-14.)

Following the Court's Order, Plaintiffs supplemented their infringement contentions and expressly relied on the results of their expert testing, citing both the previously disclosed chart and documents reflecting only the high-level results of the testing relied on and disclosed by Plaintiffs. (*See, e.g.*, Ex. A at 1[f], 3; Ex. B at 1-2, 5, Ex. C, ADENOSINE_00003794.) Importantly, though, the cited documents did not include documents concerning basic facts about the testing relied on by Plaintiffs, including the testing conditions and protocols, underlying data, other results, and laboratory notebooks that L'Oréal USA had been explicitly requesting since November, and such information is indisputably not provided in, or apparent from, the produced documents.³ (*See, e.g.*, Ex. D at 1, Nov. 14 Email from S. Polatoglu to Counsel; D.I. 68 at 3; Ex. C, ADENOSINE_00003794.) Accordingly, L'Oréal USA reiterated its request that Plaintiffs produce such information without further delay. (Ex. G at 1-2, Dec. 31 Email from N. Tymoczko to Counsel ("Please confirm that Plaintiffs will promptly produce the documents and information created in the connection with that testing, including, for example, testing conditions and protocols, underlying data, other results, and laboratory notebooks.")) In response, Plaintiffs represented that they "produced all of the testing data that Plaintiffs received and relied on for infringement contentions. Save communications with its consulting experts, which L'Oréal represented to the Court it is not seeking production of, ***Plaintiffs have no other materials related to this testing.***" (*Id.* at 1, Jan. 7 Email from T. Lusztig to N. Tymoczko (emphasis added).)

³ This information includes, for example, (1) the experimental protocols to understand how the tests were conducted, (2) details regarding the type and source of [REDACTED] skin referenced in the summary charts Plaintiffs produced, (3) information regarding how Plaintiffs' expert(s) prepared the products they tested, including how they added what they refer to as [REDACTED] to the accused products, and (4) the specific analytical techniques and procedures used in the experiments.

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Based on Plaintiffs' representation, L'Oréal USA diligently attempted to surmise the missing information. For example, because Plaintiffs previously agreed to produce documents "within Plaintiffs' possession, custody, or control" "[c]oncerning any testing or analysis of any Accused Product" (Ex. H, Supplemental Response to RFP No. 121), L'Oréal USA reviewed the documents produced by the document production deadline in February to identify informative documents with respect to the testing. Plaintiffs produced no such documents.⁴ As a result, L'Oréal USA was forced once again to raise with Plaintiffs their failure to produce documents concerning the facts and circumstances of its infringement contention testing.⁵ (Ex. J, Mar. 27 to Apr. 13 Email Correspondence between the parties.) Although Plaintiffs continued their attempts to evade this issue, it eventually became clear that Plaintiffs were simply refusing to produce documents that necessarily exist under the guise that those documents are in their experts'—and not Plaintiffs'—possession.

2. Plaintiffs Should Be Required to Produce Their Infringement Contention Testing Documents

Having put their own testing at issue to justify bringing this lawsuit, Plaintiffs cannot now contend that *underlying factual information*, including basic facts about the conditions and conduct of the disclosed-and-relied-upon testing, is protected from disclosure.⁶

Having abandoned their initial argument to avoid disclosure (*i.e.*, work-product protection), Plaintiffs now appear to be taking the remarkable position that they need not provide the requested information because it is in their experts' hands, and Plaintiffs are somehow not obliged to ask for it. This argument defies logic. It is undisputed that Plaintiffs have engaged one or more experts to conduct testing on their behalf, received documents from their experts regarding that testing, and affirmatively relied on it in their infringement contentions. It is likewise undisputed that Plaintiffs could in fact simply also ask their experts for these additional

⁴ Confronted with Plaintiffs' consistent and ongoing refusal to provide information necessary to understand their infringement contentions, L'Oréal USA also served an interrogatory seeking information regarding Plaintiffs' infringement tests. (Ex. I, Interrogatory No. 8.) Plaintiffs' interrogatory response did not, however, provide the requested information or even address their infringement contention testing concerning the concentration claim language, nor did it identify any documents related to this testing, notwithstanding Plaintiffs' reliance on Rule 33(d). (*Id.*) Although Plaintiffs provided no excuse for their failure to properly respond to this interrogatory, on April 13, Plaintiffs agreed to supplement their interrogatory response. L'Oréal USA has yet to receive that supplementation, and such supplementation would in any event be inadequate because, without a Court order, L'Oréal USA will very likely continue to receive incomplete information.

⁵ To make matters worse, on April 10, Plaintiffs produced documents concerning *additional* penetration testing of accused products—*which Plaintiffs represented on January 7 did not exist*—that appears to have been conducted *nearly a year ago*, in May 2019.

⁶ To be clear, L'Oréal USA is not seeking communications with Plaintiffs' experts or draft reports, but rather factual information underlying the testing Plaintiffs have put at issue.

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materials, and that their experts would in turn provide them, but that Plaintiffs are unwilling to do so until expert discovery.

Plaintiffs should not be able to use the fiction that these documents are not in their “possession, custody, or control” to avoid disclosure, as the required materials are in Plaintiffs’ control and have already been at issue in this case for more than six months. *See, e.g., Mercy Catholic Med. Ctr. v. Thompson*, 380 F.3d 142, 160 (3d Cir. 2004) (“In the context of Fed.R.Civ.P. 34(a), so long as the party has the legal right or ability to obtain the documents from another source upon demand, that party is deemed to have control.”); *Duarte v. St. Paul Fire & Marine Ins. Co.*, No. EP-14-CV-305-KC, 2015 WL 7709433, at *5 (W.D. Tex. Sept. 25, 2015) (holding that a party’s expert’s documents are within the “control” of that party under Rule 34, and rejecting the argument that the party did “not have the legal right to demand production of the [documents] from [their expert] solely because he is [the party’s] expert”).

Plaintiffs’ continual refusal to produce this basic information—months after they were required to do so under the Scheduling Order (D.I. 46)—has severely prejudiced L’Oréal USA by limiting its ability to prepare its defenses. The prejudice is especially acute here given the short time between the close of fact discovery and expert reports, and in view of Plaintiffs’ ongoing refusal to provide any modifications to the case schedule.⁷

Given Plaintiffs’ “evasive or incomplete disclosure, answer, or response” under Fed. R. Civ. P. 37(c)(1)(C), L’Oréal USA respectfully requests that Plaintiffs be required to (1) produce the requested documents immediately and (2) meet and confer regarding an appropriate extension of one to two months to the case schedule to be proposed to Judge Connolly or, alternatively, that Plaintiffs be precluded from relying on their infringement testing in this case.

Respectfully,

/s/ Frederick L. Cottrell, III

Frederick L. Cottrell, III (#2555)

cc: Counsel of Record (via CM/ECF and E-Mail)

⁷ Given the significant complications from the current health crisis, including the need to take and defend potentially more than 30 depositions over the next 30 days, an extension of the case schedule is necessary. Notwithstanding their representation to the Court that they “are going to be more than reasonable to accommodate any type of discovery extension or other manner to accommodate the challenges that [the health crisis] is going to impose on all of us” (Mar. 26 Hearing Tr. at 82:17-20), Plaintiffs have refused to work with L’Oréal USA on such extensions. Moreover, Plaintiffs’ refusal to provide the requested testing information has only exacerbated the difficulties facing L’Oréal USA during this time period.