



April 22, 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,

We write to respond to Defendant's request that Plaintiffs collect documents from their consulting experts that Plaintiffs are not in possession of, have no knowledge about, and therefore did not, and could not have, relied on to form the basis of their infringement contentions. As explained further below, Plaintiffs have gone above and beyond in providing substantial information to Defendants, and it is Defendants who have engaged in a pattern of delay, including refusing to disclose their technical information and theories to Plaintiffs.

1. Background

Plaintiffs served their initial infringement contentions in October 2019, which closely tracked the claim language of the asserted patents because—as Plaintiffs have long asserted—the claim language can and should easily be understood according to its plain and ordinary meaning. That interpretation was recently adopted by Judge Connolly during claim construction:

THE COURT: . . . [T]he method involve[s] the topically applying to the skin a composition that includes a concentration . . . and this is the key, the wherein clause, referring now to the adenosine concentration that is applied to the dermal cells, which is part of the skin, but what the wherein clause is defining is that the measurement is ten to the negative 4M to ten to the negative 7M when it comes to the '327 patent, claim 1 . . . all of that falls within the composition, which is topically applied to the skin, and obviously, that is occurring through the epidermis, which is the outer layer of the skin. So I actually found this to be one of the cases where I thought it was very, very clear from the claim language itself . . . And I think the written description makes it clear that there is a penetration of the concentration from the epidermal through the skin to the dermal cells . . . I think the claim language here as I've just articulated is quite clear

See Apr. 6, 2020 Hr. Tr. 56:19-58:25; *see also* D.I. 114 (ordering plain and ordinary meaning).

Nonetheless, when this Court ordered Plaintiffs to “provide supplemental infringement contentions that serve the purpose of providing notice to the Defendants of the infringement contentions beyond the mere language of the claims,” Dec. 9, 2019 Hr. Tr. 36:1-14, Plaintiffs did so, serving amended contentions which set forth (consistent with claim construction ruling) that “[a]pplying the [relevant accused product] topically causes adenosine to penetrate through the epidermal layer to apply to the dermal cell layer in a concentration of approximately [the claimed

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numerical ranges].” D.I. 124 Ex. B. Although the Court denied Defendant’s request for “production of the underlying test data,” Dec. 9, 2019 Hr. Tr. 36:15-17, in order to provide Defendant with as much notice as possible, Plaintiffs also produced the testing data they had received from their consulting experts, which is what Plaintiffs actually relied on for their infringement contentions. *See* D.I. 124 Ex. C.

Although Defendant protests it is prejudiced by these reports, its letter makes plain that the reports disclose substantial testing information, including the methodology used. Defendant acknowledges that the reports show that [REDACTED]

This is precisely the “underlying data,” “procedures,” and “protocols” that Defendant now demands, and the same information that Plaintiffs relied on for their infringement contentions. Plaintiffs did not receive or rely on “other results” for their contentions, nor does Defendant articulate how it is prejudiced by not knowing, for example, [REDACTED] used.

After Plaintiffs made this production in December 2019, Plaintiffs explained to Defendant they had produced the full testing data they had relied on for their infringement contentions, and had no other such testing materials, save communications with their experts, which Defendant has repeatedly confirmed it is not seeking. Plaintiffs did not hear back from Defendant for approximately three months, and assumed the issue had been put to bed. *See* D.I. 124 Ex. G. When Defendant reiterated the same question months later, Plaintiffs reconfirmed that they had produced all the testing data they had actually relied on, but “we have some new testing results that we will produce to you this week.” *Id.* Ex. J. Plaintiffs produced that new testing on April 10, 2020, as well as two other documents generated by their consulting experts, which are not infringement testing and which Plaintiffs did not rely on for contentions, which Plaintiffs provided in the interest of maximum disclosure. *See id.*

Defendant misleadingly characterizes these documents as “additional penetration testing of accused products . . . that appears to have been conducted nearly a year ago, in May 2019,” but does not attach the documents to its letter so the Court can see for itself. These documents are not May 2019 penetration testing of accused products. The produced “new testing results,” D.I. 124 Ex. J, are dated on their face March 30, 2020 (“Mar3020”). *See* Ex. 1. Plaintiffs had previously not been able to conduct testing of certain Accused Products because Defendant had discontinued them, but refused to provide samples of these products pursuant to Plaintiffs’ RFPs. *See* D.I. 123 Ex. 8. Plaintiffs accused these products on the basis of their apparent similarity to other tested products, *see* D.I. 124 Ex. B, and, once it was eventually able to find and test them, immediately produced the results to Defendant. The two other recently produced do not entail any testing whatsoever of the Accused Products, relating instead to some general background work conducted by Plaintiffs’ consulting experts in 2019 that Plaintiffs did not rely on for contentions. But mindful of the Court’s recent direction in the March teleconference, *see* Hr. Tr. 51:5-54:23, Plaintiff decided to produce them.

[REDACTED]

Defendant has the testing data that Plaintiffs actually relied on for their infringement contentions, as well as the other documents Plaintiffs received from their consultant lab, save privileged communications. Defendant now asks the Court to order Plaintiffs to collect additional, unknown documents from their consulting experts, that Plaintiffs did not rely on for their infringement contentions. For the reasons explained below, that request should be denied.

2. Rule 26(b)(4)(B) Protects Consulting Expert Materials

Contrary to Defendant's assertion, Plaintiffs have certainly not agreed to waive work-product or other privilege protection over its expert materials. Rule 26(b)(4)(B) provides that "a party may not, by interrogatories or deposition, discover facts known or opinions held by an expert who has been retained or specially employed by another party in anticipation of litigation or to prepare for trial and who is not expected to be called as a witness at trial." It "precludes discovery against an expert informally consulted in preparation for trial." *In re Cendant Corp. Sec. Litig.*, 343 F.3d 658, 665 n.7 (3d Cir. 2003). The rule applies where a party has "not yet decided" whether to designate a consulting expert as a testifying expert. *United States v. 215.7 Acres of Land, More or Less, Situate in Kent Cty., State of Del.*, 719 F. Supp. 273, 280 (D. Del. 1989) ("[W]hen and if the Government decides that these experts will be called at trial, the Bergolds will be entitled to certain information regarding their testimony."). The only exception to this rule is "upon a showing of exceptional circumstances under which it is impracticable for the party seeking discovery to obtain facts or opinions on the same subject by other means." *Cendant*, 343 F.3d at 665 n.7 (quoting Fed. R. Civ. Pro. 26(b)(4)(B)). "Once such a showing has been made, a court, before ordering discovery, must analyze the policy considerations underlying the rule to determine whether they outweigh the exceptional circumstances." *Id.*

The consulting expert rule is "designed to promote fairness by precluding unreasonable access to an opposing party's diligent trial preparation." *Bio-Tech. Gen. Corp. v. Novo Nordisk*, No. 02-235-SLR, 2003 WL 21057238, at *2 (D. Del. May 7, 2003) (citing Advisory Committee Notes, Fed. R. Civ. P. 26(b)(4)(B); *Ager v. Jane C. Stormont Hosp. & Training School for Nurses*, 622 F.2d 496, 502 (10th Cir.1980)). It is unsettled "whether Rule 26(b)(4)(D) is even subject to waiver," but the "general trend" is "to find that it is not." *Eidos Display, LLC v. Chunghwa Picture Tubes, Ltd.*, 296 F.R.D. 3, 7-8 (D.D.C. 2013) (citing cases from all over the country denying discovery from consulting experts). But even where some courts do find waiver, it is limited to the specific consultant documents put at issue. *See generally id.* at 8-9 ("[T]o the extent that Eidos has waived anything, it has only waived Dr. Rubloff's Declaration itself.") (discussing cases).

Gillette Co. v. Dollar Shave Club, Inc., No. CV 15-1158-LPS-CJB, 2018 WL 3528720 (D. Del. July 23, 2018), which Defendant relies on heavily, is entirely consistent with the rule as explained above, and supports Plaintiffs. In *Gillette*, the plaintiff incorporated "select images—from testing performed by non-testifying experts—into its infringement contentions," which "waived any protection that may have once applied to the disclosed images." *Id.* at *1. The parties in *Gillette* appear to have agreed that plaintiff actually relied on unproduced "documents regarding [its consultant's] tests, such as those regarding testing conditions and protocols, the underlying data, other images, or tests reports." *See* D.I. 548; D.I. 552. Accordingly, the *Gillette* plaintiff was ordered to produce the documents subject to their limited waiver, i.e., the "documents that form the bases of its infringement contentions," which in that case apparently included protocols, other images, and test reports in the plaintiff's possession that had not been produced. *Id.*

Here, Plaintiffs have already produced the "documents that form the bases of its infringement contentions": the very "test reports" Defendant attached to its letter, which reflect

“testing conditions and protocols” and the “underlying data” on which Plaintiffs relied. What Defendant is actually asking the Court to order is for Plaintiffs to collect new documents from its consulting experts, which Plaintiffs did not rely on for their infringement contentions, and produce those. Defendant cites no authority supporting such a request,² which contravenes the purpose of the rules to allow “counsel to obtain the expert advice they need to properly evaluate and present their clients’ positions without fear that every consultation with an expert may yield grist for the discovery mill.” *Cendant*, 343 F.3d at 665 n.7 (quoting *Moore’s Federal Practice* § 26.80[2] at 26–236.5). Defendant has not even tried to show “exceptional circumstances,” nor could it. *See Higher One, Inc. v. TouchNet Information Systems, Inc.*, 298 F.R.D. 82 (W.D. N.Y. 2014) (“Patentees failed to demonstrate exceptional circumstances that would justify discovery from adversary’s non-testifying consultant. The subpoena served on the expert would therefore be quashed.”); *Wright & Miller Federal Practice and Procedure* § 2032 (“[O]rdinarily each party has a full opportunity to retain its own experts; unlike fact witnesses they are not unique and, in an era when experts’ services are widely marketed, the supply of potential witnesses is often large.”).

3. Defendant’s Claims of Prejudice are Backwards

Defendant, without elaborating precisely what trial preparation it is unable to perform given the substantial information Plaintiffs have provided, claims prejudice purportedly justifying delaying the trial. In fact, it is Plaintiffs who are prejudiced by Defendant’s failure to provide discovery, including into its adenosine testing and technical theories of the case.

For example, Defendant complains about Plaintiffs’ response to Defendant’s overbroad Interrogatory No. 8, which asked Plaintiffs to catalog in extensive detail all facts regarding “any research, studies, evaluations, market research, analysis, development, manufacture, formulation, testing (including the methodologies used and the results thereof), and the like.” *See* D.I. 124 Ex. I. Defendant waited until late February to serve this Interrogatory, Plaintiffs timely responded by identifying responsive documents pursuant to Rule 33(d), and when Defendant demanded a supplement, Plaintiffs agreed. In contrast, in July 2019, Plaintiffs served an interrogatory asking Defendant to describe its “testing, including the methodology and results, regarding or relating to adenosine’s effect on human skin,” and to date, the only response Defendant has provided is to deny it has conducted any such testing, which is directly contradicted by its own public and produced documents. *See* Ex. 4 at Interrogatory No. 5; *see also* Ex. 3; D.I. 123 at 2. Similarly, where Plaintiffs have provided a response to Defendant’s invalidity interrogatory that is consistent with the Court’s claim construction order, *see* Ex. 7, and has agreed to supplement further, Defendant’s response to Plaintiffs’ corresponding infringement interrogatory (which Plaintiffs served months before Defendant’s invalidity interrogatory) is evasive and inconsistent with the claim construction order, but Defendant refuses to even discuss it with Plaintiffs. *See* Ex. 5 at Interrogatory No. 14; Ex. 6.

In short, the only prejudicial delay is Defendant’s, and its requests should be denied.

² Save *Gillette*, which supports Plaintiffs, Defendant cites only two cases, *Mercy Catholic Med. Ctr. v. Thompson*, 380 F.3d 142 (3d Cir. 2004) and *Duarte v. St. Paul Fire & Marine Ins. Co.*, No. EP-14-CV-305-KC, 2015 WL 7709433 (W.D. Tex. Sept. 25, 2015), neither of which order the collection of documents from a consulting expert. *Mercy* did not involve expert documents, and *Duarte* required the collection of documents from a testifying expert.

Respectfully submitted,

/s/ Brian E. Farnan

Brian E. Farnan

cc: Counsel of Record (Via E-Mail)