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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

REDACTED VERSION

**Re: *University of Massachusetts and Carmel Laboratories, LLC v. L'Oréal USA, Inc.*,
C.A. No. 17-868-CFC-SRF**

Dear Judge Fallon:

Defendant L'Oréal USA, Inc. ("L'Oréal USA") writes to respectfully request that the Court order Plaintiffs to provide three focused categories of relevant discovery: (1) interrogatory responses relating to Plaintiffs' testing conducted both before and during the course of this litigation; (2) documents relating to the Teresian Carmelites, which Plaintiffs recently confirmed they intend to discuss at trial; and (3) a supplementation of Plaintiffs' privilege log or production of any non-privileged documents.¹ A proposed Order is attached as Ex. A.

1. L'Oréal USA's Request That Plaintiffs Be Ordered to Supplement Their Responses to L'Oréal USA's Interrogatory Nos. 1, 8, 9, and 11

Interrogatory Nos. 1, 8, 9, and 11 seek, *inter alia*, information relating to any studies, evaluations, analysis, and testing of products that Plaintiffs contend are covered by the Patents-in-Suit. (*See* Ex. B at 4, N. Tymoczko April 8 Letter; *see also* Ex. C, Plaintiffs' Suppl. Responses to Interrogatory Nos. 1, 8, 9, and 11.) Discovery has revealed that Plaintiffs conducted testing (1) in 2019, which serves as the sole basis for its assertion of infringement and (2) in 2010, before this litigation was filed. Plaintiffs' interrogatory responses, however, do not address this testing. When informed of this deficiency, Plaintiffs agreed to supplement their responses to address "their testing of the Accused Products" (Ex. D at 2, B. Franklin April 13 Email), but then backtracked and failed to do so, forcing L'Oréal USA to seek the Court's assistance.

First, as the Court is aware, L'Oréal USA has been seeking discovery of basic facts concerning Plaintiffs' testing for the past seven months to prepare its claims and defenses. (*See* D.I. 121 at 1.) Plaintiffs have refused to provide any additional *documents* regarding their tests—even non-privileged documents containing the basic facts underlying these tests (*i.e.*, the conditions and protocols, laboratory notebooks, and underlying data)—but represented on April

¹ Plaintiffs sent an email to L'Oréal USA yesterday that showed a willingness to provide 30(b)(6) testimony on Topics 27-35 and 39, which were identified in the parties' Joint Motion (D.I. 153). In the interest of cooperation and to avoid burdening the Court, L'Oréal USA has agreed to withdraw those topics from consideration at this time without prejudice to its right to raise any 30(b)(6)-related disputes to the extent the parties reach an impasse.

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13 that they would “provide a supplementary *interrogatory response* regarding their testing of the Accused Products.” (See Ex. D at 2, B. Franklin April 13 Email (emphasis added).)

To that end, and following the Court’s directive during the April 24 conference,² L’Oréal USA asked Plaintiffs to confirm that this promised supplemental interrogatory response would address eight specific, factual topics relating to the design and execution of the tests relied upon by Plaintiffs. (Ex. F at 5-6, N. Tymoczko April 28 Email.) Plaintiffs acknowledged that they could provide the requested information, but agreed to do so only if L’Oréal USA would agree that (1) “providing this information would satisfy [L’Oréal USA’s] demands for testing information regarding the accused products during fact discovery,” (2) L’Oréal USA “will not argue some additional waiver exists on the basis of us giving you the information you’re now asking for,” and (3) “any further discovery about this testing will occur during expert discovery.” (Ex. F at 4-5, T. Lusztig April 29 Email.) To avoid burdening the Court and to lessen the continued prejudicial delay in receiving this basic factual information, L’Oréal USA agreed to not argue that providing such information would in and of itself result in any waiver and to not seek additional information about the testing during fact discovery. (Ex. F at 2, N. Tymoczko May 4 Email.)

Despite their previous commitment to supplement their interrogatory responses, including to answer basic factual questions regarding how the infringement contention tests were conducted, Plaintiffs suddenly reversed course and refused to provide any information whatsoever unless L’Oréal USA waived its right to seek appropriate relief (including potentially moving to preclude and/or strike portions of Plaintiffs’ forthcoming expert reports, if necessary) based on Plaintiffs’ failure to timely provide information regarding these tests.³ (See Ex. F at 1-2, T. Lusztig May 8 Email; N. Tymoczko May 10 Email.) Plaintiffs should not be permitted to renege on their commitment. Because the requested information is readily available to Plaintiffs, and given the concessions already agreed to by L’Oréal USA, Plaintiffs should be ordered to supplement their interrogatory responses with the requested information.

Nor can Plaintiffs justify backtracking on that pledge by now claiming this factual

² The Court denied without prejudice L’Oréal USA’s previous request for documents relating to these tests (D.I. 121), and encouraged the parties to work together with respect to discovery of the basic factual information sought by L’Oréal USA (Ex. E at 80:15-81:1 (“I don’t think I have a fulsome record right now to be able to decide that, so I err on the side of being conservative, denying it without prejudice and leaving it to the parties to continue to see if there is some informal agreement with respect to some type of underlying documents that aid in the interpretation of that chart or whether defendants are really seeking to engage in full-blown expert discovery early on without an expert report and nothing more than this chart.”)).

³ Given that L’Oréal USA does not have certain basic information regarding Plaintiffs’ testing, and does not know what information Plaintiffs’ experts will rely upon, the Court made clear that the denial of L’Oréal USA’s previous request for documents relating to these tests was without prejudice to raising this issue during expert discovery should it be determined that Plaintiffs withheld facts concerning these tests during fact discovery. (Ex. E at 85:4-16.) Plaintiffs’ request that L’Oréal USA waive these rights recognized by the Court as a condition for receiving basic factual information relating to Plaintiffs’ testing is therefore improper.

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information is privileged. Even putting aside that such a claim is belied by Plaintiffs' commitment to providing this information (notwithstanding their subsequent refusal),⁴ a patentee cannot disclose only testing results while concealing related facts. See *Koninklijke Philips Elec. N.V. et al. v. Zoll Medical Corp.*, 2013 WL 812484, at *2-3 (D. Mass. Mar. 4, 2013) (ordering that "technical information regarding the dates, parameters, and results of the tests referenced throughout ZOLL's preliminary infringement contentions" be provided and rejecting argument that such information was privileged because request did "not extend to communications from, or substantive discussion with, counsel"). This is consistent with the ruling in *Gillette*, where the defendants sought, and the Court ordered production of, information regarding "the testing conditions and protocols" underlying "results from tests of Defendants' products" incorporated into the plaintiffs' infringement contentions. See D.I. 68, Ex. 11, at 3 of 37; *Gillette Co. v. Dollar Shave Club, Inc.*, 2018 WL 3528720, at *1 (D. Del. July 23, 2018).

Second, Plaintiffs' responses to Interrogatory Nos. 1, 8, 9, and 11 are likewise deficient because they do not include any information concerning the 2010 testing of L'Oréal USA products that Plaintiffs conducted referenced in 2015 and 2016 correspondence between the parties leading up to this litigation. (See, e.g., Exs. G at 2-4, H at 14413-14.) L'Oréal USA is entitled to interrogatory responses that provide non-privileged, factual information regarding this testing, such as when it was conducted, by whom, and (if work-product protection is asserted) that it was conducted in anticipation of this litigation. Once again, after L'Oréal USA asked that Plaintiffs include information about "Carmel Laboratories' 2010 competitor testing" (Ex. B at 2, N. Tymoczko April 8 Letter), Plaintiffs agreed to supplement their responses to provide this type of basic factual information (Ex. I at 5, T. Lusztig April 14 Email), but then did not (see Ex. C).

2. L'Oréal USA's Request That Plaintiffs Supplement and Correct Their Privilege Log

Plaintiffs' privilege log identifies purportedly privileged documents with descriptions that are insufficient for L'Oréal USA to understand the basis for Plaintiffs' privilege assertions. (Ex. J at 1, K. Kasaraneni May 5 Email.) In particular, Plaintiffs assert work-product protection over documents dating as far back as 2008, but do not identify the specific litigation forming the basis of those claims. See *In re Oxbow Carbon LLC Unitholder Litig.*, 2017 WL 959396, at *5 (Del. Ch. Mar. 13, 2017) ("When a party seeks to invoke the work product doctrine, a party cannot merely recite 'in anticipation of litigation' as a formulaic set of magic words. A party must identify the specific litigation that forms the basis of the work product claim."). Without at least this information, L'Oréal USA cannot determine whether the assertion is appropriate, or whether the work involved non-privileged, routine investigations that would have been performed regardless of whether litigation ensued. See *Sandvik Intellectual Property AB v. Kennametal, Inc.*, 2011 WL 466696, at *3 (W.D. Pa. Feb. 4, 2011) (finding work product privilege did not apply to investigations before plaintiff's letter to defendant alleging infringement). This concern is particularly acute with respect to several entries addressing third-party communications between non-attorneys, where the third party is described merely as an "agent" or "accountant" performing generic "research" in anticipation of "potential" or "anticipated" litigation. (See, e.g., Ex. K at Entries No. 148, 149, 194, 220, 968, 969, 973.) It also extends to various internal

⁴ To be clear, L'Oréal USA does not seek Plaintiffs' experts' opinions or communications with counsel, nor does L'Oréal USA seek early expert discovery such as depositions of Plaintiffs' experts. Rather, L'Oréal USA seeks only factual information regarding the testing at issue.

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communications from the same time period. (*See, e.g., id.* at Entries No. 27, 132, 145, 151, 171, 208.) Plaintiffs should be ordered to either (1) supplement their privilege log descriptions to explain which litigation was at issue and provide factual information regarding the nature of the alleged work product or (2) produce any non-privileged documents.⁵

3. L'Oréal USA's Request for Documents Relating to the Teresian Carmelites

Plaintiffs should be ordered to produce documents pertaining to: (1) the financial condition and outlays of the Teresian Carmelites since 2008; and (2) former Teresian Carmelites (and Carmel Labs) President Dennis Wyrzykowski's decision to separate from the organization. (*See* Ex. M at RFP Nos. 138, 140.) Plaintiffs placed these matters at issue when they made several allegations concerning the Teresian Carmelites' finances and Mr. Wyrzykowski in their First Amended Complaint. (*See, e.g.,* D.I. 14 at ¶¶ 14, 15, 17, 28-30.) In September 2019, L'Oréal USA served document requests pertaining to these allegations. (*See* D.I. 104 at 1; *id.* at Ex. A.) Plaintiffs refused to produce responsive documents, contending that the production was unnecessary because, as L'Oréal USA understood it, Plaintiffs would not be introducing evidence or argument regarding the Teresian Carmelites during summary judgment or at trial. (D.I. 104 at 2; *id.* at Ex. A at Plaintiffs' Suppl. Responses to RFP Nos. 11, 30-33, 45, 84, 87, 92, and 95.) Yet, when L'Oréal USA sent Plaintiffs a draft stipulation reflecting Plaintiffs' position, Plaintiffs refused to sign it. Pursuant to this Court's Order, the parties further met and conferred in an attempt agree on "what information, if any, regarding the Teresian Carmelites is in or out." (Ex. N at 11:5-12.) The Court also instructed that, if the parties could not agree on a stipulation, L'Oréal USA could propound document requests covering the topics to which Plaintiffs refused to respond that are "narrowly tailored" and "relevant and proportional to the needs of the case." (*Id.* at 11:17-12:6.) During subsequent discussions, Plaintiffs disclosed that they did intend to introduce evidence at trial pertaining to the Teresian Carmelites' financial relationship with Carmel Labs and Mr. Wyrzykowski's affiliation with the monastery (even though that affiliation has ceased). (*See* Ex. O at 1-2, 7-8.) In light of this position, L'Oréal USA served specific discovery requests pertaining to these two categories. (*See* Ex. M.) Plaintiffs refused to produce responsive documents, and confirmed that they are withholding documents based on their belief that the requested information is not relevant. (*See id.* at Responses to RFP Nos. 138, 140; *see also* Ex. P at 1.) Simply put, Plaintiffs intend to introduce evidence about the Teresian Carmelites, and to describe Mr. Wyrzykowski as a member of that monastery, yet refuse to allow discovery into the Teresian Carmelites' financial outlays and Mr. Wyrzykowski's disassociation from that monastery. (*See* Ex. O at 1-2, 7-8.) Plaintiffs cannot have it both ways: If the Teresian Carmelites and Mr. Wyrzykowski's affiliation thereto are to be discussed at trial, then L'Oréal USA is entitled to discovery on these issues. *See Hubbard v. Bankatlantic Bancorp, Inc.*, 2009 WL 3856458, at *5 (S.D. Fla. Nov. 17, 2009) ("[T]he understandable desire for privacy must give way to Defendants' rights to discovery."); *see also Minerva Surgical, Inc. v. Hologic, Inc.*, 2019 WL 5092254 at *3 (D. Del. 2019) (allowing discovery where protective order was in place).

⁵ To the extent Plaintiffs assert L'Oréal USA's privilege log is deficient for failing to identify attorneys or provide sufficient privilege descriptions, the same deficiencies are present in Plaintiffs' May 11 Revised Privilege Log. Any order to supplement should therefore be reciprocal, as L'Oréal USA offered (Ex. L, May 12 K. Kasaraneni Email), but Plaintiffs rejected.

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Respectfully,

/s/ Frederick L. Cottrell, III

Frederick L. Cottrell, III (#2555)

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