



May 14, 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, et al. v. L'Oréal USA, Inc.***  
**(C.A. No. 17-cv-868-CFC-SRF)**

Dear Magistrate Judge Fallon,

L'Oréal seeks relief on three “new” issues. But the Court already heard two of these issues. L'Oréal presents no new facts or law warranting revisiting the Court's decision denying discovery into Plaintiffs' privileged testing, and demands the same Teresian Carmelites documents the Court previously said were overbroad. The third issue is a meritless attack on Plaintiffs' privilege log. The Court should deny the requested relief.

**L'Oréal's Renewed Request for Discovery into Plaintiffs' Privileged Testing.** Plaintiffs' position on fact discovery into their infringement testing has been consistent throughout this case: they are willing to provide (and have already provided, *see, e.g.*, D.I. 127 Ex. 1) the information relied on for infringement contentions— but further information is privileged consulting expert work product and premature during fact discovery. At the April 24 hearing, the Court rejected L'Oréal's request for further fact discovery into Plaintiffs' privileged testing, finding that “Plaintiff has disclosed the summary sheet they've relied on in amending their infringement contentions and *that's pretty much the extent, as I read Gillette, as to what Judge Stark permitted in Gillette.*” Ex. 1 at 79:1-10 (emphasis added). In so ruling, the Court expressed concern about the possibility of “a snowball” of further expert discovery that would be “inappropriate at this stage of a litigation.” *Id.* at 83:16-22.<sup>1</sup>

The Court's denial was without prejudice to the parties “briefing this issue” with further authority. *Id.* at 82:21-84:11. Since then, Plaintiffs conferred with L'Oréal, and requested any further authority for its position. As of this filing, L'Oréal has not responded to Plaintiffs' request, and instead raises the same question as a “new” issue here. *See* Ex. 3 at 1. The only additional case cited in its letter supports Plaintiffs. *See Koninklijke Philips Elecs. N.V. v. ZOLL Med. Corp.*, No. CIV. 10-11041-NMG, 2013 WL 812484, at \*2 (D. Mass. Mar. 4, 2013) (explaining that ZOLL “has not otherwise characterized the information as having been generated by ‘experts’” and it is therefore distinguishable from “a request for materials prepared by a non-testifying expert and, thus, was analyzed using the standards set forth in Rule 26(b) (4)(D), a provision which ZOLL has not sought to invoke”). The Third Circuit has explained that Rule 26(b)(4)(B) “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); *see also 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.”); *Lambeth Magnetic*

<sup>1</sup> L'Oreal now demands precisely that “inappropriate” “expert discovery,” threatening to compel Rule 30(b)(6) testimony about Plaintiffs' privileged consulting expert testing. *See* Ex. 2 at 2.

*Structures, LLC v. Seagate Tech. (US) Holdings, Inc.*, No. CV 16-538, 2018 WL 466045, at \*5 (W.D. Pa. Jan. 18, 2018) (“Finding a waiver of privilege as to any testing cited at this early stage of litigation would cut against both the purpose of the privilege (protecting clients’ ability to seek preparatory advice without fear) and the purpose of the local rule (providing defendants with early notice of specific claims).”). The Court should deny a request for the same information at issue at the April 24 hearing, but in the form of an interrogatory instead of documents.

Indeed the only “new” thing about L’Oréal’s motion is its argument that Plaintiffs purportedly agreed to give it privileged information. This argument fails for at least two reasons. *First*, this “new” information comes from an email dated April 13, 2020—i.e., well before the April 24 hearing, and before the parties submitted their letter briefs for the April 24 hearing. *See* D.I. 121. There is nothing “new” about this. *Second*, nowhere in the email do Plaintiffs agree to provide the information L’Oréal seeks. Some history is helpful here: On April 8, L’Oréal requested Plaintiffs supplement interrogatory responses, including interrogatories covering a broad range of testing issues, such as analysis conducted by the inventors of the asserted patents. *See* Ex. 5 at 1-2. Plaintiffs agreed to supplement, but noted they would not provide privileged information. *See* Ex. 4 at 2 (explaining that Plaintiffs “will not be producing any privileged work product”). Plaintiffs began working on gathering information, including by interviewing the inventors, and had planned to include in those supplements the *non-privileged* information regarding their infringement testing—i.e., by citing, by bates number, the testing reports Plaintiffs have produced. After the April 24 hearing, while Plaintiffs were working on these supplements, L’Oréal made clear that it wanted a lengthy narrative supplement providing the privileged information the Court had just held it was not entitled to, including information Plaintiffs could not have relied on for their infringement contentions. *See* Ex. 3 at 4 (“We are working on the interrogatory supplement we said we would serve, but had not planned to address the many detailed questions you posed only yesterday.”).

Despite the Court’s recent order saying they were not required to provide this information, Plaintiffs offered to try to obtain the narrative requested by L’Oréal—in exchange for some reasonable assurances that providing further information would not kick off “a snowball course” into premature expert discovery. *See id.* (“To be clear, we do not believe that we need to provide any more information during fact discovery regarding the testing of the accused products, but are willing to provide the information you requested in your email and hope that we can reach a compromise that satisfies both of our concerns.”). L’Oréal rejected that compromise by reserving the right to argue preclusion, despite Plaintiffs’ voluntary disclosure, and to undo the deal if L’Oréal unilaterally determines that the voluntarily-provided information is not “full and complete.” *See id.* at 2. Put differently, L’Oréal wanted Plaintiffs to provide the very information the Court had just ruled Plaintiffs were not required to produce, in exchange for nothing. Since that was “not a fair compromise,” *id.* at 2, Plaintiffs served the promised supplement describing inventor research, but without citing the bates numbers of the testing reports. *See* D.I. 160 Ex. C.

To the extent that what L’Oréal wants is what Plaintiffs had offered—an interrogatory supplement identifying by bates number the non-privileged testing reports Plaintiffs have produced—Plaintiffs will serve such a supplement this week. But L’Oréal’s correspondence makes clear what it wants is for Plaintiffs to provide privileged information, for which it has no authority supporting its entitlement, while reserving all rights to argue that Plaintiffs still have not provided enough.

The same is true for information about Plaintiffs’ pre-suit testing that L’Oréal demands. Plaintiffs have never agreed to provide this plainly privileged information. *See, e.g., Cendant*, 343

F.3d at 665 n.7. The email L'Oréal relies on merely agrees to supplement interrogatory responses; it does not agree to provide privileged information, or even mention pre-suit testing. *See* D.I. 160 Ex. I at 2 (“We confirmed we will prepare supplementary responses to your interrogatories No. 1, 4, 5, 6, 8, 9, 10, 11, 12, 13, 14, and 15.”). L'Oréal argues it needs an interrogatory response in order to evaluate Plaintiffs' privilege claim, but cites no authority for testing privilege in that way. That is what privilege logs are for. Documents related to Plaintiffs' pre-suit testing are logged on their privilege log. L'Oréal's motion should be denied.

**L'Oréal's Renewed Request for Discovery into Non-Party Teresian Carmelites.** At the March 26 hearing, the Court ordered the parties to try to resolve this issue, and if they could not, that L'Oréal may “serve a narrowly tailored request for production . . . [that is] relevant and proportional to the needs of the case.” Ex. 7 at 11:19-25. After, Plaintiffs explained to L'Oréal that they plan to introduce limited evidence about the Teresian Carmelites, and Dennis Wyrzkowski's affiliation. Specifically, they just need to be able to put facts in context, like who witnesses are, and how and why Carmel Labs came to license the asserted patents—via Mr. Wyrzkowski's introduction, through the Teresian Carmelites, to Dr. Dobson. Somewhat shockingly, L'Oréal's position was that Plaintiffs must agree to omit these basic narrative facts altogether. *See* Ex. 9 at ¶ 2. Because Plaintiffs cannot agree to such an overbroad and unworkable *limine*, L'Oréal now seeks “All Documents and Things Concerning the financial condition and outlays of the Teresian Carmelites,” and “All Documents and Things Concerning Dennis Wyrzkowski's affiliation with the Teresian Carmelites, including All Documents and Things Concerning his separation from the Teresian Carmelites and/or his decision to cease monastic life.” *See* Ex. 6 at RFP No. 138, 140.

To be clear, Plaintiffs have already produced all documents relating to (i) “the founding of Plaintiff Carmel Labs, including why it was founded and that it is a subsidiary of the Teresian Carmelites,” (ii) “communications between the Teresian Carmelites and L'Oréal USA and/or L'Oréal S.A.,”<sup>2</sup> and (iii) “documents and/or evidence that mentions the Teresian Carmelites that is also related to or which regards otherwise relevant issues, such as adenosine, this lawsuit, the Asserted Patents, the inventors of the Asserted Patents, Plaintiffs, the Easeamine Products, and/or the Accused Products.” *See* Ex. 9 at ¶¶ 1, 3. However, documents going to this non-party's financial condition, or why Mr. Wyrzkowski left monastic life, have zero relevance to this case.

With respect to documents concerning the Teresian Carmelites' “financial condition and outlays,” L'Oréal claims it needs these documents because the FAC put “the Teresian Carmelites' financial relationship with Carmel Labs” at issue. D.I. 160 at 4. But the Court directed L'Oréal to serve “narrowly tailored request[s]” that take into account that Plaintiffs “*do not intend to pursue claims in the first amended complaint relating to the Teresian Carmelites financial condition.*” Ex. 7 at 11:5-12 (emphasis added). The only facts at issue are that Carmel Labs is a subsidiary of the Teresian Carmelites and provided it with funds; Plaintiffs have already produced the relevant and responsive documents about that narrow issue. *See* Ex. 6 at RFP No. 137. With respect to Mr. Wyrzkowski's personal decision to leave monastic life, L'Oréal has never articulated what relevance these details of his personal life have to any claim or defense in this case. L'Oréal's request that Plaintiffs produce documents about Mr. Wyrzkowski's personal life is irrelevant and burdensome. Its motion should be denied.

---

<sup>2</sup> Plaintiffs clarified they meant “communications between Carmel Labs and L'Oreal, which reference the Teresian Carmelites, and which both sides have produced in this case.” *See* Ex. 8.

**L’Oréal’s Request for a Further Revised Privilege Log.**<sup>3</sup> L’Oréal asks the Court to order additional information for certain entries in Plaintiffs’ privilege log, suggesting that that “the same deficiencies” Plaintiffs identified in L’Oréal’s log, *see* D.I. 159, are in Plaintiffs’. D.I. 160, at 4, n. 5. A simple comparison refutes this. **Plaintiffs’ typical description:** “Confidential communication among Carmel Labs employees, board members, and retained consulting expert re. potential infringement reflecting work product created at the direction of counsel in anticipation of litigation.” D.I. 160, Ex. K, at Entry No. 968. **L’Oréal’s typical description:** “Document providing legal advice regarding intellectual property.” D.I. 159, Ex. N, at Entry No. 557.

The entries L’Oréal identifies as deficient claim work-product protection for materials generated in anticipation of “potential infringement” litigation. Contrary to L’Oréal’s log, Plaintiffs’ entries including third parties identify the parties and describe their relationship to Plaintiffs and the privileged work product—marketing agent, accountant, testing agent, consulting expert. *See* Entries No. 148, 149, 194, 220, 968, 969, 973. Other entries in the log show that Plaintiffs were communicating with counsel at the same time. *See, e.g.*, Entry No. 967 (confidential communication including expert, Plaintiffs, and outside counsel). This is more than enough to show that the documents were prepared in connection with possible litigation. *See, e.g., Phillips Electronic N. Am. Corp. v. Universal Electronics Inc.*, 892 F. Supp. 108, 110 (D. Del. 1995) (distinguishing between testing performed in the normal course of business, and privileged testing performed as part of patent infringement investigation); *United States v. Veolia Env’t N. Am. Operations, Inc.*, 2013 WL 5779653, at \*5 (D. Del. 2013) (observing that retention of outside counsel showed litigation was reasonably anticipated). It is unclear what more information Plaintiffs could provide that would not be privileged. *See* Fed. R. Civ. P. 26(b)(5)(A)(ii) (privilege log should describe documents “without revealing information itself privileged or protected”). L’Oréal’s request for further information regarding Plaintiffs’ infringement analyses is improper.

In arguing otherwise, L’Oréal relies on two easily distinguishable cases. The Court in *Sandvik* found that testing the defendant performed as part of its routine patent-clearing investigations without anticipating specific litigation was not privileged—but that later testing conducted when the plaintiff had notified the defendant of potential infringement *was* privileged. *Sandvik Intellectual Property AB v. Kennametal, Inc.*, 2011 WL 466696, at \*4 (W.D. Pa. 2011). Plaintiffs’ log already shows that the privileged documents were generated in anticipation of potential infringement litigation. *In re Oxbow Carbon LLC Unitholder Litigation*, 2017 WL 959396 (Del. Ch. 2017), is even further afield. The challenged log entries there consisted only of a “generic description,” the substance of which showed the documents related to “a business matter, not a litigation matter” (such as employee practices or travel policies), and the only recipient of *any* of the communications was an HR employee. *Id.*, at \*6. This is nothing like the entries in Plaintiffs’ log, which explain that the privileged documents were created in connection with potential infringement litigation and show the involvement of counsel.

As for the “various internal communications,” its May 13 letter is the first time L’Oréal has raised any issue with these entries. *See* Ex. 10. Again, Plaintiffs are at a loss for what more non-privileged information they can provide to show that materials created in connection with “potential infringement” are entitled to work-product protection.

<sup>3</sup> After L’Oréal questioned the presence of third parties in certain entries in Plaintiffs’ log, Plaintiffs reviewed their log and provided a revised log within six days. *See* Ex. 10. L’Oréal never raised the issues addressed in its letter.

Respectfully submitted,

/s/ Brian E. Farnan

Brian E. Farnan

cc: Counsel of Record (via E-Mail)