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May 14, 2020

**VIA CM/ECF**

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

**PUBLIC 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 respond to the issues Plaintiffs raised in their May 13, 2019 letter brief (D.I. 159).

**Plaintiffs' Interrogatory No. 3:** As an initial matter, contrary to Plaintiffs' assertion, this case is not about adenosine. Adenosine is a naturally occurring molecule that is present in every human cell. And the prior art is replete with references to adenosine's use in cosmetic compositions, including at concentrations present in the accused products for years before Plaintiffs' patents were even filed. The patents-in-suit relate to a very narrow method of using adenosine, which includes applying an adenosine composition such that, according to Plaintiffs, a particular adenosine concentration "reaches the dermal cell layer" (*i.e.*, below the outer "epidermal" layer) of the user's skin. To that end, Plaintiffs have not asserted that every adenosine-containing product that L'Oréal USA has sold infringes the patents-in-suit, nor can they.<sup>1</sup> (*See, e.g.*, Ex. A at 1 ("[T]he Accused Products are the *subset* of [adenosine-containing] products . . ."); D.I. 93 at 2 ("[T]he Accused Products consist of the *subset* of those adenosine-containing products that meet the claim limitations of the asserted patents.") (emphasis added).)

L'Oréal USA has fully complied with its obligations at each stage of the discovery process with respect to Interrogatory No. 3. The Interrogatory, which was served in July 2019, asked L'Oréal USA to identify every product L'Oréal USA has ever sold containing adenosine (D.I. 159, Ex. A at 7). As the law requires Plaintiffs, not L'Oréal USA, to identify the products that underlie Plaintiffs' infringement theories, L'Oréal USA did not interpret this Interrogatory (served in advance of Plaintiffs' infringement contentions) as a request to locate possibly accused products. *See, e.g., Magnadyne Corp. v. Best Buy Co.*, 2010 WL 11520525, at \*2 (C.D. Cal. Feb. 22, 2010) (it is plaintiff's responsibility to identify the accused products); *Ethicon LLC v. Intuitive Surgical, Inc.*, 2018 WL 1392341, at \*3 (D. Del. Feb. 12, 2018) ("'[M]ere suspicion or speculation' that [defendant]'s unaccused [product] will infringe the asserted patents . . . is not enough to render the requested discovery relevant to [plaintiff]'s infringement claims.").

Thus, L'Oréal USA objected to the Interrogatory as overbroad, unduly burdensome, and not proportionate to the needs of this case, but provided a substantive response to the Interrogatory, answering as much as it could, by identifying 126 products. (*See* D.I. 159, Ex. B

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<sup>1</sup> Plaintiffs have thus necessarily had to assert infringement against the accused products in this case based on testing the concentration of adenosine at a particular skin location after application of those products. (*See, e.g.*, Ex. D.I. 121 at Ex. A-C.)

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at Response to Interrogatory No. 3.) *See* Fed. R. Civ. P. 33(b)(3) (requiring parties to respond to interrogatories to the extent not objectionable); *Ahdom v. Lopez*, 2017 WL 3537083, at \*2 (E.D. Cal. Aug. 17, 2017) (“A responding party is not generally required to conduct extensive research in order to answer an interrogatory, but a reasonable effort to respond must be made.”). This was not an easy task, as L’Oréal USA had to manually review carton artwork for skincare products to confirm they contain adenosine. On October 10, 2019, Plaintiffs served their infringement contentions, which accused 181 products, but which excluded many of the products identified by L’Oréal USA.<sup>2</sup> Thereafter, the parties discussed a workable approach to discovery in light of the vast number of accused products, and the appropriate bounds of the case and Interrogatory No. 3. Plaintiffs confirmed during the parties’ discussions that they were accusing only a “subset” of products containing adenosine, and it was these products to which the case related. (*See, e.g.*, Ex. A at 1; *see also* D.I. 93 at 2.). As part of those discussions, L’Oréal USA asked Plaintiffs to provide any information they had on products they believed were missing from L’Oréal USA’s response to Interrogatory No. 3. (*See, e.g.*, D.I. 159, Ex. C at 6.) Plaintiffs never responded. On November 27, 2019, L’Oréal USA served a supplemental response to Interrogatory No. 3 after confirming that the new products identified in Plaintiffs’ infringement contentions contained adenosine and were sold in the U.S. (D.I. 159, Ex. D at 64-66 (corrected version served on December 3).) For 111 days, Plaintiffs never raised any issues with this response.

Plaintiffs may claim that Interrogatory No. 3 requires L’Oréal USA to now identify products beyond the accused products notwithstanding the objections served and maintained by L’Oréal USA since September. The law does not place such a burden on L’Oréal USA, *see, e.g.*, *Micro Motion, Inc. v. Kane Steel Co., Inc.*, 894 F.2d 1318, 1326-27 (Fed. Cir. 1990), much less at this late stage of the proceedings. Indeed, the *Micro Motion* court stated: “The discovery rules are designed to assist a party to prove a claim it reasonably believes to be viable *without discovery*, not to find out if it has any basis for a claim.” *Id.* Plaintiffs’ expectations aside, consistent with this authority, L’Oréal USA amended its Interrogatory No. 3 response *in November* to identify the specific documents under FRCP 33(d) that relate to the accused products. If Plaintiffs truly had an issue with L’Oréal USA’s objections or responses to Interrogatory No. 3, they should have raised it then—particularly given the numerous categories of documents Plaintiffs have requested for each and every accused product—rather than seek to reset the litigation at this stage. Moreover, Plaintiffs’ request that L’Oréal USA conduct searches using the word “adenosine” to identify new products is not even workable, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] This is why L’Oréal USA had to manually review carton artwork, which provides the product name and ingredient list, to identify products containing adenosine. (*See* D.I. 159, Ex. G at 11-13.) This process was extensive.<sup>3</sup>

Plaintiffs’ apparent quest to now expand the case beyond the more than 150 products already accused of infringement is improper, and would prejudice L’Oréal USA’s ability to prepare for depositions during this last month of discovery.

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<sup>2</sup> Plaintiffs did not explain their decision not to accuse these additional identified products.

<sup>3</sup> Plaintiffs cite a document produced in the FTC Investigation to suggest that L’Oréal USA can easily identify additional products containing adenosine. (D.I. 159, Ex. T.) Not so. From the outset, the FTC investigation involved a defined set of products, by name. Unlike here, L’Oréal USA was not asked to link an ingredient to a formula number to a product name to sales data.

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**Documents Regarding L'Oréal USA's Knowledge of the Patents-in-Suit:** As discussed above, this case is not about adenosine itself, or even the mere use of adenosine in cosmetic compositions by L'Oréal USA and many other companies for decades. Plaintiffs' letter, however, seeks to significantly broaden discovery at this late stage to burden L'Oréal USA when the parties should be focused on completing fact discovery and preparing expert reports due on June 19. L'Oréal USA has made tremendous efforts to produce relevant documents in this case, including in response to Plaintiffs' ever-expanding, belated requests. (*See, e.g.*, D.I. 155, Ex. A (L'Oréal USA's Supp. Responses to RFP Nos. 27, 32, 40-42, 53, 59).)

Plaintiffs, however, are not entitled to every single document L'Oréal USA has regarding adenosine, much less under the guise of "knowledge of the patents-in-suit." Thus, unlimited searches for "adenosine" or "75156"—which are anything but "tailored" terms—in central databases containing product testing and development documents would be overbroad, unduly burdensome, and certainly far exceed the scope required to assess whether L'Oréal USA had knowledge of the patents-in-suit.<sup>4</sup> For the reasons discussed above, the search terms already run through MILOR (including, but not limited, "adenosine AND skin" and "adenosine AND (dermal OR dermis)") are sufficient to capture documents relating to the use of adenosine as relevant to the patents-in-suit. (*See, e.g., id.* (Supp. Response to RFP No. 27).) Any other use of adenosine is irrelevant. Plaintiffs also complain that L'Oréal USA has searched only two custodians for "Dobson" and "Ethier." That is not true: L'Oréal USA has used such terms in conjunction with "adenosine" to search the MILOR database and emails from R&I custodians. (*See* Ex. C at 3-4, 12.) Moreover, a search through MILOR for "Dobson" or "Ethier" by themselves did not return any additional responsive documents.

Plaintiffs also request that L'Oréal USA search the files of *non-party* L'Oréal S.A. employees, including, for the first time, an indeterminate set of "custodians Defendant's investigation has revealed." (*See* Ex. D.I. 159, Proposed Order.) That request is overbroad and unrelated to whether *L'Oréal USA* had knowledge of the patents-in-suit, or whether *L'Oréal USA* infringes the patents-in-suit. Moreover, Plaintiffs have been aware of L'Oréal USA's 26 document custodians since March 18, when L'Oréal USA disclosed them in its supplemental response to Interrogatory No. 11.<sup>5</sup> (Ex. D.) Plaintiffs' request is also untimely: Plaintiffs did not raise this new, expanded request for more than a month, despite having ample opportunity (including an intervening Court conference) to do so. Finally, even the identification of high-level L'Oréal S.A. executives in Plaintiffs' initial disclosures (*e.g.*, CEO; Director of Corporate Acquisitions, Licensing, and External Business Development; Global Head of Patents) is an apparent attempt to harass L'Oréal USA and in no way proportional to the needs of the case.<sup>6</sup> Although L'Oréal USA has already exceeded its discovery obligations by producing documents from the central repositories of non-party L'Oréal S.A. and searching for files of L'Oréal S.A. employees Jean-Baptiste Galley and Marie-Laurence Abella, this new, belated, and untargeted

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<sup>4</sup> For example, such terms would return entirely irrelevant documents, such as certificates of analysis from adenosine suppliers or those relating to research regarding the use of adenosine in products other than cosmetics.

<sup>5</sup> This search went above and beyond the 10 custodians required by the Court's Default Standard for Discovery.

<sup>6</sup> As has become commonplace, Plaintiffs' proposed order is so broad as to include unspecific custodians, including "any L'Oréal S.A. custodians Defendant's investigation has revealed may have knowledge of the Patents-in-Suit or the inventors." (D.I. 159, Proposed Order.)

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request for documents from employee files of non-party L'Oréal S.A. custodians is a bridge too far, and is entirely irrelevant to determining L'Oréal USA's knowledge of the patents-in-suit.

With respect to "right to market" documents, L'Oréal USA offered to collect and log<sup>7</sup> such documents for the accused products. Plaintiffs refused that offer, and instead insisted on L'Oréal USA collecting such documents for any and all products containing adenosine, even if those products are not accused of infringement in this case. Given the multi-step, manual search necessary for identifying and collecting such "right to market" documents for each accused product individually (let alone for any and all products containing adenosine), and the fact that they will merely be logged given their privileged nature, this request is overly broad, unduly burdensome, and not proportional to the needs of the case.

**License Agreements and Litigation Hold:** As L'Oréal USA explained during the March 26 conference, it has not located relevant license agreements. (Ex. E at 69:11-21.) Nonetheless, L'Oréal USA produced its license agreements with L'Oréal S.A., which cover the brands implicated in this case.<sup>8</sup> In addition, yesterday, as agreed, L'Oréal USA provided Plaintiffs with the dates it issued litigation holds and the names of the recipients of those holds.

**L'Oréal USA's Privilege Log:** L'Oréal USA has invested considerable time and effort in ensuring its privilege log includes enough factual detail for Plaintiffs to assess L'Oréal USA's privilege claims, even with respect to entries of questionable relevance to this case. Plaintiffs have not explained how any of the alleged deficiencies actually impact their privilege analysis, nor have they addressed L'Oréal USA's repeatedly stated concern that Plaintiffs' positions are at odds with their own privilege log. (Ex. F at 1; Ex. G at 1, 12.) For example, "many of the entries [in Plaintiffs' log] do not include any attorney, either in the to/from/cc fields, nor in the entry's description." (D.I. 159 at 4; D.I. 160, Ex. K at Entry Nos. 1-12, 176.)<sup>9</sup> Likewise, Plaintiffs' supplemental log contains entries that are substantively indistinguishable from those they complain about in L'Oréal USA's log. (See, e.g., D.I. 160, Ex. K at Entry Nos. 133, 136-37 ("re. patent prosecution") and 4-12, 152-65 ("reflecting legal advice").) Finally, L'Oréal USA has already indicated that it will provide a redaction log, and is diligently working to do so, even as it continues to produce more documents. Regardless, in an attempt to avoid burdening the Court with this peripheral issue, L'Oréal USA offered to agree to a mutual exchange of supplemental privilege logs to address Plaintiffs' concerns to the extent possible, which Plaintiffs refused. (See also D.I. 160 at 4 n.5.) Plaintiffs' request should be denied or, in the alternative, the Court should order a mutual supplementation.

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<sup>7</sup> Because they involve a determination that there is no legal obstacle to bringing the product at issue to market, these right to market documents are by their very nature privileged.

<sup>8</sup> Plaintiffs' reliance on deposition testimony to argue that L'Oréal USA did not search for license agreements is misplaced. This testimony related to an R&I retention policy, and Ms. Al-Ebbinni was discussing documents maintained by third parties, not L'Oréal USA. As Ms. Al-Ebbinni later testified, L'Oréal USA searched for license agreements relating to this case, [REDACTED]

<sup>9</sup> Plaintiffs' May 11 supplement did not correct this incongruity. (D.I. 160, Ex. L at 1.) Nor have Plaintiffs indicated the names associated with many email addresses appearing on their privilege log, let alone explained which names or email addresses correspond to attorneys.

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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)

Attachments