IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

UNIVERSITY OF MASSACHUSETTS and CARMEL LABORATORIES, LLC Plaintiffs, v. L'ORÉAL USA, INC. Defendant.	Civil Action No.17-0868-CFC-SRF

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MEMORANDUM OPINION

April 20, 2021
Wilmington, Delaware

COLM F. CONNOLLY
UNITED STATES DISTRICT JUDGE

Plaintiffs University of Massachusetts and Carmel Laboratories, LLC (collectively, UMass) have sued Defendant L'Oréal USA, Inc. for infringement of U.S. Patent Numbers 6,423,327 (the #327 patent) and 6,645,513 (the #513 patent). Pending before me is L'Oréal's Motion for Summary Judgment of Indefiniteness of the Skin Enhancement Claim Limitation (D.I. 278). L'Oréal argues that claims 1, 3, 5, 6, 7, and 9 of the asserted patents are invalid for indefiniteness. D.I. 278 at 1.

I. BACKGROUND

The asserted patents teach methods to treat skin using the organic compound adenosine. Each patent has a single independent claim—claim 1 in each patent. For purposes of the pending motion, the patents' independent claims and written descriptions are identical. In each patent, claim 1 recites:

> [a] method for enhancing the condition of unbroken skin of a mammal by reducing one or more of wrinkling, roughness, dryness, or laxity of the skin, without increasing dermal cell proliferation, the method comprising topically applying to the skin a composition comprising a concentration of adenosine in an amount effective to enhance the condition of the skin without increasing dermal cell proliferation, wherein the adenosine concentration applied to the dermal cells is [a recited concentration range].

The two claim 1s differ only with respect to the recited concentration range. In claim 1 of the #327 patent, the recited range of adenosine "applied to the dermal cells" is "10^{-4} M to 10^{-7} M." In claim 1 of the #513 patent, the recited range is "10^{-3} M to 10^{-7} M."

In their jointly filed claim construction chart, the parties identified the recited concentration range limitation (that is, "wherein the adenosine concentration applied to the dermal cells is [within the recited ranges]") as the only claim term that required construction. D.I. 77 at 2. The parties outlined their respective positions with respect to the recited concentration range limitation in an 82-page joint brief. UMass argued that the limitation should be given its plain and ordinary meaning. L'Oréal argued that the limitation should be construed to mean "wherein the adenosine concentration applied to the skin containing the dermal cells is [within the recited ranges]." D.I. 77 at 2.

The parties' claim construction dispute turned on the meaning of "applied to the dermal cells." L'Oréal argued that those words require the concentration of adenosine to be measured when the adenosine is topically applied to the surface (i.e., epidermal layer) of the skin. UMass argued that the concentration of adenosine is measured at the dermal cells underneath the surface of the skin when the adenosine is absorbed and reaches the dermal cells. I agreed with UMass and concluded that, based on the claim language and intrinsic evidence, the plain and

ordinary meaning of the limitation required the concentration to be measured when the adenosine reached the dermal cells under the surface of the skin.

II. LEGAL STANDARDS

A. Indefiniteness

Section 112(b) of the Patent Act requires that the claims of a patent "particularly point[ ] out and distinctly claim[ ] the subject matter which the inventor . . . regards as the invention." 35 U.S.C. § 112(b) (previously § 112 ¶ 2). To satisfy this requirement, a claim must be "sufficiently 'definite.'" *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1348 (Fed. Cir. 2002). "The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, *e.g.*, competitors of the patent owner, can determine whether or not they infringe." *Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1340 (Fed. Cir. 2003). "[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). "[A] patent does not satisfy the definiteness requirement of § 112 merely because 'a court can ascribe some meaning to a patent's claims.'" *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed.

Cir. 2014) (quoting *Nautilus*, 572 U.S. at 911). To comply with § 112, a patent "must provide objective boundaries for those of skill in the art." *Id.* Thus, "[t]he scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual." *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005), *abrogated on other grounds by Nautilus*, 572 U.S. at 901.

"Indefiniteness is a matter of claim construction, and the same principles that generally govern claim construction are applicable to determining whether allegedly indefinite claim language is subject to construction." *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008), *abrogated on other grounds by Nautilus*, 572 U.S. at 901. Courts construe claims "as written, not as the patentees wish they had written [them]." *Chef Am. Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004).

B. Summary Judgment

A court must grant summary judgment "if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). Federal Circuit decisions, however, appear to confirm that I may grant summary judgment based on indefiniteness even when the parties present conflicting expert testimony about whether an artisan of ordinary skill would be able to understand disputed claim terms. *See, e.g.*,

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