



December 5, 2019

VIA E-FILING

The Honorable Sherry R. Fallon
J. Caleb Boggs Federal Building
844 N. King Street
Room 3124, Unit 14
Wilmington, DE 19801-3555

Re: University of Massachusetts, et al. v. L'Oréal USA, Inc. (17-868-CFC-SRF)

Dear Judge Fallon:

We write on behalf of Plaintiffs to respond to Defendant's December 4, 2019 letter. That letter, which seeks an order compelling Plaintiffs to supplement their infringement contentions, as well as the production of expert "testing information," mischaracterizes the parties' discussions about these issues in addition to being contrary to well-established law.

A. The infringement contentions adequately disclose Plaintiffs' infringement theories.

The Court's order required a chart "identifying specifically where and how each limitation of each asserted claim is found within each" Accused Product, including the "identity of the structure[s], act[s], or material[s]" that "perform the claimed function." D.I. 46 ¶ 3(a).¹ This rule distinguishes "between the required identification of the precise element of any accused product alleged to practice a particular claim limitation, and every evidentiary *item of proof* showing that the accused element did in fact practice the limitation." *AntiCancer, Inc. v. Pfizer, Inc.*, 769 F.3d 1323, 1330–31 (Fed. Cir. 2014); *see also Creagri, Inc. v. Pinnaclife Inc., LLC*, No. 11-CV-06635-LHK-PSG, 2012 WL 5389775, at *4 (N.D. Cal. Nov. 2, 2012) ("Creagri does not at this time have to prove through evidence that the recommended dosage in fact does infringe its patent. It only has to provide enough information for Pinnaclife to understand its theory of infringement."); Ex. A at 51:11-52:10 (Connolly, J: "[M]y understanding of infringement contentions are they're contentions that articulate the theory of infringement . . . I do not understand the contention with infringement or of infringement to have to set forth each and every piece of evidence that a plaintiff of expects will support an infringement theory . . . [an] infringement theory would say, well, your product works in the following manner, which is why it infringes.").

Defendant complains that Plaintiffs' infringement contentions "parrot" claim language, but there is no rule that contentions cannot resemble claim language, as long as they put an infringer on notice of the theory of infringement. *See Solannex, Inc. v. MiaSole, Inc.*, No. 11-CV-00171-PSG, 2013 WL 1701062, at *4 (N.D. Cal. Apr. 18, 2013) (finding contentions sufficient to "meet the L.R. 3-1 standard in putting MiaSolé on notice of Solannex's infringement theory" although

¹ The Court's disclosure rule mirrors the Northern District of California Local Patent Rule 3-1, available at <https://www.cand.uscourts.gov/rules/patent-local-rules/>. Accordingly, Plaintiffs cite cases from the Northern District of California interpreting that rule.

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certain “infringement explanations do closely mirror the claim language”). The patents disclose methods for the topical application of a composition containing adenosine, wherein the adenosine that is “applied to the dermal cells” is within certain numerical ranges. Plaintiffs’ contentions disclose that “using,” (i.e., “topically applying”) each Accused Product applies “a concentration of adenosine of approximately” the claimed ranges to the dermal cells. *See, e.g.*, Def.’s Ex. 4, 5 (two representative claim charts²). This puts Defendant on notice of Plaintiffs’ infringement theory that the “structure[s], act[s], or material[s]” of its products that meet this claim limitation is their topical use, which causes the claimed concentration of adenosine to reach the dermal cells.³

Save its protest about the similarity between the language in the claim charts and in the patents, Defendant’s letter does not identify what it is unable to understand about Plaintiffs’ straightforward theory of infringement, nor was Defendant able to explain its position on any of the parties’ meet and confers. Defendant suggests that Plaintiffs’ theory of infringement cannot hold water because compositions that “contain 0.1% adenosine” do not infringe the patent, but that claim construction argument was rejected by the PTO multiple times during Defendant’s failed IPR attempt. *See* Ex. B at 8-15 (denying *inter partes* review for the ’327 patent, finding that “wherein the adenosine concentration applied to the dermal cells is 10-4 M to 10-7 M” discloses a concentration that is “applied to the dermal cells,” not “in the composition”); Ex. C at 7-14 (same for the ’513 patent); *see also Renesas Tech. Corp. v. Nanya Tech. Corp.*, No. C03-05709JF(HRL), 2005 WL 2000926, at *5 (N.D. Cal. Aug. 18, 2005) (“[Rule 3-1] does not require plaintiff to produce evidence of infringement or to set forth ironclad and irrefutable claim constructions, nor does it require a plaintiff to provide support for its contentions.”) (quotation omitted).

Nonetheless, in an attempt to avoid this needless dispute, and although infringement contentions “require *specific allegations*” rather than “*evidence of infringement*,” Plaintiffs offered to provide Defendants with the data that Plaintiffs relied on to support their belief that the accused products meet this limitation. *Comcast Cable Commc’ns, LLC v. OpenTV, Inc.*, No. C 16-06180 WHA, 2017 WL 2630088, at *2 (N.D. Cal. June 19, 2017). On November 13, 2019, Plaintiffs did provide that data in the form of a document showing, among other things, infringing ranges for 120 tested Accused Products. *See* Def.’s Ex. 8 at 5, Ex. 9. In response, Defendant now manufactures a new complaint that it needs unidentified expert discovery from Plaintiffs to understand the operation of its own products, and that the ordinary timing of expert discovery, agreed on by the parties months ago, is “sandbagging.”

Plaintiffs’ contentions as served put Defendant on notice of their theory of infringement by plainly disclosing that applying the Accused Products topically causes adenosine in the claimed ranges to reach to the dermal cell layer. Although nothing more is required at this stage, Plaintiffs

² Defendant omits the other 274 claim charts Plaintiffs served, covering all accused products. In the interest of saving space, Plaintiffs have not attached those charts to their letter but will immediately provide them to the Court upon request.

³ Defendant previously complained Plaintiffs’ theory that another claim limitation regarding dermal cell proliferation was not sufficiently disclosed, but Defendant now appears to concede that the information received from Plaintiffs on this limitation is sufficient. *See* Def.’s Letter at 4.

went above and beyond in trying to resolve this dispute. Defendant's demands are a moving target, and not grounded in any reasonable understanding of what the rules require. Defendant's motion should be denied outright. If the Court orders Plaintiffs to supplement their infringement contentions in any way, it should order Plaintiffs to supplement with the data they have already provided Defendants, which goes well beyond what is required to demonstrate Plaintiffs' "theory of infringement." Ex. A at 51:12-13.

B. Defendant's argument that Plaintiffs waived privilege over "testing information," raised for first time in its December 4, 2019 letter, should be rejected.

Because contentions serve to disclose theories of infringement rather than evidentiary proof, testing data is not required. *See Creagri*, 2012 WL 5389775 at *3 ("Pinnaclife suggests that Creagri must provide testing data or other facts beyond what it has so far indicated to support its contentions. Pinnaclife's argument overstates the requirements of Patent L.R. 3-1."). On the parties' call in which Plaintiffs offered to provide Defendant with certain data, the parties agreed that disclosure of a "theory of infringement is not expert discovery." Def.'s Ex. 8 at 2. Despite that agreement, Defendant now seeks to turn its unfounded request for supplementation of Plaintiffs' infringement contentions into an astonishing request for expert work product.

As a threshold matter, Defendant never raised its new waiver argument with Plaintiffs during any of their previous meet and confers. On those calls, Defendant requested supporting data, which Plaintiffs provided in order to avoid motion practice, premised on an agreement that Plaintiffs would not be providing "expert discovery." After Plaintiffs provided the data, Defendants invented a new request for "laboratory notebooks and experimental protocols," which it contended "must be provided" as a routine part of infringement contentions. *Id.* at 4. Defendant did not raise a waiver argument, or its RFPs, with Plaintiffs before submitting yesterday's letter. *But see* Def.'s Letter at 3 n.6 and Ex. 1, 12 (seeking an order compelling Plaintiffs to produce privileged documents in response to Defendant's RFP No. 33). Because Defendant did not even attempt to meet and confer with Plaintiffs about this waiver issue—nor did Defendant tee this issue up in the parties' joint motion for a telephonic hearing—this aspect of Defendant's motion should be denied. *See, e.g.* Ex. D at 9:22-25 (Stark, J: "I'm denying IV's request, and I'm doing so for failure to adequately meet and confer in compliance at least with the spirit of the discovery procedures I have, if not the letter of them as well."); D.I. 62 (requesting a teleconference to address "Defendant's request that Plaintiffs supplement their infringement contentions").

Defendant's position is also meritless, and unsupported by the cases it cites. *Tessengerlo Kerley, Inc. v. OR-Cal, Inc.* held that "[t]o fulfill its Rule 3-1 obligation, plaintiff need not provide evidentiary support, *i.e.*, append a report of its allegedly privileged testing results. The *accuracy* of plaintiff's tests are not at issue at the initial disclosure stage." No. C 11-04100 WHA, 2012 WL 1253178, at *4 (N.D. Cal. Apr. 13, 2012). To the extent *Tessengerlo* required the production of any data, Plaintiffs already provided that to Defendant. *See* Def.'s Ex. 9. If, like Plaintiffs, a patent-holder relies on expert testing to form the basis of its belief that there is infringement, "reliance on that data" for contentions does not waive privilege because "infringement contentions provide

notice of the accusing party's specific infringement theories, and are not considered evidence. . . . [Thus,] privilege may remain intact." *Id.*; see also *Lambeth Magnetic 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.);"); *Kimberly-Clark Worldwide, Inc. v. First Quality Baby Prod., LLC*, No. 1:CV-09-1685, 2010 WL 4537002, at *2 (M.D. Pa. Nov. 3, 2010) ("KC using testing data to put First Quality on notice is not relying on the materials as evidence in support of its infringement theories."); *Gillette Co. v. Dollar Shave Club, Inc.*, which Defendant relies on, is likewise inapposite because Plaintiffs did not disclose expert-created materials as "evidence on which [they] would be relying in future stages of this case." No. CV 15-1158-LPS-CJB, 2018 WL 3528720, at *1 (D. Del. July 23, 2018). If Plaintiffs later decide to use this data as evidence in the case for the purposes of expert reports, they will provide to Defendant all the materials required pursuant to Rule 26(a)(2)(B).

C. Representative testing is sufficient to support preliminary infringement contentions.

Defendant suggests it is improper that Plaintiffs tested a selection of 120 accused products, but "[a] par[t]y claiming infringement does not have to reverse engineer every one of a defendant's products. Instead, a plaintiff must only demonstrate why it believed before filing the claim that it had a reasonable chance of proving infringement." *Infinion Techs. AG v. Volterra Semiconductor*, No. C-11-06239 MMC (DMR), 2013 WL 5366131, at *4 (N.D. Cal. July 31, 2013).

This Court has already explained that Defendant has been "on notice that products containing adenosine made by the eighteen brands specified in the FAC are accused of infringement." D.I. 31 at 9. That is what Plaintiffs accused, supported by testing results for 120 products that Plaintiffs' claim charts show are substantially similar—described by Defendant in public materials as providing the same results to consumers, and comprised of the same common ingredients—to all approximately 180 accused products. See *ParkerVision, Inc. v. Qualcomm Inc.*, No. 6:14-CV-687-ORL, 2015 WL 4751354, at *3 (M.D. Fla. Aug. 11, 2015) ("[W]here a plaintiff accuses a large number of products and asserts that each accused product infringes the asserted technology in the same way, a representative accused product can be used to outline the plaintiff's infringement contentions against other accused products."). Defendant's complaint that Plaintiffs had not tested every product before serving contentions is particularly galling where the majority of the untested products were discontinued by Defendant, but Defendant has thus far refused to provide them to Plaintiffs. See, e.g., Ex. E, F; see also *SAGE Electrochromics Inc. v. View Inc.*, No. C-12-06441 JST (DMR), 2013 WL 4777164, at *2 (N.D. Cal. Sept. 6, 2013) ("[I]n arguing that Patent Local Rule 3-1 requires reverse engineering, View overstates Rule 3-1's specificity requirement. . . . It does not require Plaintiff to reverse engineer every product it has accused, especially where the products are not reasonably available to the public.").

Plaintiffs respectfully request the Court deny Defendant's motion.

Respectfully submitted,

/s/ Brian E. Farnan

Brian E. Farnan

cc: Counsel of Record (Via E-Mail)