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December 4, 2019

**VIA CM/ECF & HAND DELIVERY**

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



**Re: Univ. of Massachusetts et al., v. L'Oréal USA, Inc., C.A. No. 17-868-CFC-SRF**

Dear Judge Fallon:

I write on behalf of Defendant L'Oréal USA, Inc. to respectfully request that Plaintiffs be ordered to (1) supplement their infringement contentions to provide notice of how the accused products allegedly satisfy certain claim language in the patents-in-suit and (2) provide related testing information on which Plaintiffs rely to support such assertions, which they previously agreed to provide. (*See* Ex. 1 (Proposed Order).)

**1. The Patents-in-Suit and Plaintiffs' Deficient Infringement Contentions**

This is a patent infringement case in which Plaintiffs have accused more than 180 L'Oréal USA products of infringing two patents. Those patents are directed to topically applying compositions containing adenosine for "enhancing the condition" of skin. Pertinent to this motion, Plaintiffs have provided claim charts in connection with their infringement contentions that separately address the claim language "wherein the adenosine concentration applied to the dermal cells is  $10^{-4}$  M to  $10^{-7}$  M"<sup>1</sup> (the "concentration claim language") and "without increasing dermal cell proliferation" (the "dermal cell claim language"). (*See* Ex. 2 at claim 1; Ex. 3, at claim 1.)

Under the Scheduling Order, Plaintiffs were required to serve infringement contentions on October 10 setting forth "specifically where and *how* each limitation of each asserted claim is found within each Accused Instrumentality." (D.I. 46 at ¶ 3(c) (emphasis added).) For the claim language at issue, however, Plaintiffs simply parroted back that language and cited "forthcoming expert disclosures" and/or "defendants' internal, to-be-produced documents" in each of the 268 infringement claim charts they served. (*See, e.g.*, Ex. 4 at 1[c], 1[f], 3.)<sup>2</sup> L'Oréal USA promptly

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<sup>1</sup> The concentration range " $10^{-4}$  M to  $10^{-7}$  M" appears in claim 1 of the asserted '327 patent. Claim 1 of the '513 patent has the same language, but specifies a concentration range of " $10^{-3}$  M to  $10^{-7}$  M." Dependent claims 3 in both patents further narrow the concentration ranges. In this letter, the concentration amounts from the patents-in-suit are collectively referred to as the "concentration claim language."

<sup>2</sup> Plaintiffs' ¶ 3(g) charts regarding their own products took the same approach, including the alleged reliance on *L'Oréal USA's* documents. (*See, e.g.*, Ex. 5 at 1[c], 1[f], 3.)



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notified Plaintiffs that their barebones contentions and paragraph 3(g) charts were insufficient. (Ex. 6 (Oct. 28 Email).) Following a meet and confer, Plaintiffs agreed to produce “the data that [they] relied on to form the basis of [their] belief that these limitations are met.” (See Ex. 7 at 1-2 (Nov. 8 Email).)

Rather than provide the agreed-upon information, however, on November 13, Plaintiffs emailed L’Oréal USA a chart and cited two documents (one of which had not been previously produced). (Ex. 8 at 5 (Nov. 13 Email); Ex. 9 (“[REDACTED]” document).) This chart simply lists product names and a series of numbers with no indication of what they mean or how they were obtained, and no other information related to this testing was provided.<sup>3</sup> Moreover, the document does not contain information for more than 60 accused products, and Plaintiffs have not linked the testing of one product to any other. Plaintiffs have also refused to amend their contentions in any way unless L’Oréal USA agreed that it would not seek further information. (E.g., Ex. 8 at 5 (Nov. 13 Email).) Following another meet and confer, Plaintiffs continued to refuse to supplement their contentions or to provide the requested information, thus forcing L’Oréal USA to seek relief from the Court. (Ex. 8 at 1, 4 (Nov. 14 & Nov. 19 Emails).)

## **2. Plaintiffs’ Contentions Are Deficient and Must Be Supplemented Consistent with Their Prior Commitment**

“Infringement contentions . . . serve the purpose of providing notice to the Defendants of infringement theories beyond the mere language of the patent claim” and are “intended to require the party claiming infringement to crystallize its theories of the case early in the litigation and to adhere to those theories once disclosed.” E.g., *Intellectual Ventures I LLC v. AT&T Mobility LLC*, No. 13-1668-LPS, 2017 WL 658469, at \*2 (D. Del. Feb. 14, 2017); *Theranos, Inc. v. Fuisz Pharma LLC*, No. 11-cv-05236-YGR, 2012 WL 6000798, at \*2-4 (N.D. Cal. Nov. 30, 2012) (“In patent litigation, vague and conclusory contentions are inadequate.”). As explained below, Plaintiffs contentions fail to meet these standards.

Plaintiffs’ current infringement contentions are deficient because they do not contain *any* explanation of how the concentration or dermal cell limitations are allegedly met (and even the information from Plaintiffs’ November 13 email has not been incorporated). Instead, the contentions simply repeat the language of the claim and refer to “forthcoming” expert discovery. Such contentions fail to provide the requisite notice contemplated by the Scheduling Order, and defeat the very purpose of contentions by leaving L’Oréal USA guessing at Plaintiffs’ infringement theories. See, e.g., *Intellectual Ventures*, 2017 WL 658469 at \*2; *HSM Portfolio LLC v. Fujitsu Ltd.*, No. 11-770-RGA (D. Del. May 7, 2014) (Ex. 10 at 1-3) (ordering supplementation of infringement contentions that said “nothing about . . . why [the claim limitation at issue] is present in the [accused] product”).

Moreover, the simple production of a summary chart with numbers does not cure Plaintiffs’ deficient contentions with respect to the concentration claim language because it does

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<sup>3</sup> The document file name is “[REDACTED],” one column bears the heading “[REDACTED],” and another set of columns bears the heading “[REDACTED],” but what this text represents has not been explained.

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not contain any information about how those numbers were obtained or how the testing was performed, which, as with any scientific experiment, is essential to understanding the numerical information summarized therein. Where, as here, testing forms the basis for a plaintiff's allegations, the testing information must be disclosed with the contentions. *See, e.g., Tessenderlo Kerley, Inc. v. Or-Cal, Inc.*, No. C 11-04100 WHA, 2012 WL 1253178, at \*3-4 (N.D. Cal. Apr. 13, 2012) (requiring supplementation and explaining that the patentee must "articulate the precise way in which it believes the products to be infringing" and, "to the extent testing data are the basis for this belief, this order finds its disclosure is required under Rule 3-1").<sup>4</sup>

In *Gillette Co. v. Dollar Shave Club, Inc.*, Chief Judge Stark addressed this very issue, and ordered the production of "documents that form[ed] the bases of [Plaintiff's] infringement contentions" where Plaintiff "incorporated" select materials "from testing performed by non-testifying experts . . . into its infringement contentions." No. 15-1158-LPS, 2018 WL 3528720, at \*1 (D. Del. July 23, 2018).<sup>5</sup> In so doing, the Court concluded that any alleged privilege or protection was "waived" by the voluntary disclosure, and that "it would not further the interests of fairness or efficiency to make Defendants wait for expert discovery to . . . be in a position to analyze and potentially take discovery on" the testing. *Id.* Consistent with the ruling in *Gillette*, Plaintiffs should be required, at a minimum, to provide documents regarding the "██████████ ██████████," including, for example, any testing conditions and protocols, underlying data, other results, and laboratory notebooks. This basic, non-privileged, factual information is distinct from expert opinion analyzing or interpreting the testing and should be provided without further delay.<sup>6</sup>

In addition, the chart is also insufficient because it does not contain entries for more than 60 accused products or connect the tested products with any untested products. It is thus unclear how this testing relates to Plaintiffs' infringement allegations for approximately one third of the accused products. To provide adequate notice of Plaintiffs' infringement theories, their contentions must, at a minimum, specify which tested product provides the basis of their infringement claim for each untested product, as opposed to generically citing a chart concerning more than 100 different products.

Allowing Plaintiffs to withhold this information and hide their infringement positions until expert discovery severely prejudices L'Oréal USA by hindering its ability to prepare its noninfringement and invalidity defenses (including its invalidity contentions, which are due on

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<sup>4</sup> Similar to the Scheduling Order here, the local patent rules applicable to the *Tessenderlo* case required "[a] chart identifying specifically where each limitation of each asserted claim is found within each Accused Instrumentality." *Id.* at \*1.

<sup>5</sup> The briefing in that case makes clear that the defendants were seeking "documents regarding [plaintiff's] tests, such as those regarding the testing conditions and protocols, the underlying data, other images, or test reports." (Ex. 11 at Brief Page 1.)

<sup>6</sup> Indeed, in response to L'Oréal USA's requests for production, Plaintiffs have agreed to produce "documents Concerning any testing or analysis of any Accused Product," and should not be able to shield these materials from disclosure now with claims of privilege, work-product, or "forthcoming expert disclosures." (See Ex. 12 at 33.)

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December 13) and develop related evidence during fact discovery. The prejudice is especially acute here because the accused products contain adenosine in concentrations that Plaintiffs expressly distinguished during patent prosecution. For example, many of the accused products [REDACTED] adenosine, which Plaintiffs explained during prosecution was higher than the concentrations covered by the asserted claims. (*See, e.g.*, Ex. 13 at 4-5 (distinguishing prior art compositions with “0.1%” adenosine, which equates to “ $3.8 \times 10^{-3}$  M” in the terminology of the asserted claims, as “relatively high” and stating that the “proposed amended claims would recite a maximum concentration of adenosine of  $10^{-4}$  M.”).)<sup>7</sup> Given Plaintiffs’ prior representations, L’Oréal USA is entitled to meaningful infringement contentions identifying how Plaintiffs can now claim that these same concentrations somehow infringe their patents. Indeed, in opposing L’Oréal USA’s motion to dismiss, Plaintiffs expressly acknowledged that contentions (as opposed to pleadings) must provide notice “beyond the mere language of the patent claim” and “set forth how the accused products meet the claim limitations,” yet now seek to avoid those very requirements until expert discovery. (D.I. 19 at 2-3.) This only compounds the prejudice, as the Scheduling Order currently provides only three weeks between the service of Plaintiffs’ opening infringement report and L’Oréal USA’s response. Without notice of their infringement contentions, Plaintiffs will be permitted to use expert discovery to sandbag L’Oréal USA, forcing L’Oréal USA to respond to information on which Plaintiffs have already stated they will rely and that Plaintiffs are sitting on right now.

### 3. Plaintiffs’ Infringement Contentions for the Dermal Cell Language

In their November 13 email, Plaintiffs suggested that they could agree to supplement their contentions with respect to the dermal cell claim language to cite the “[REDACTED]” chart, ETHIER\_00000041, and CARMEL LABS\_00000710, but sought to impermissibly condition that supplementation on L’Oréal USA otherwise accepting the sufficiency of their contentions. (*See* Ex. 8 at 5.) If Plaintiffs were to serve amended contentions citing these three documents from their email to confirm that this is the basis for their infringement allegations, it would resolve this aspect of the parties’ dispute.

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Accordingly, Plaintiffs should be required to provide supplemental contentions and documents regarding the underlying testing consistent with the attached proposed order.

Respectfully,

/s/ Frederick L. Cottrell, III

Frederick L. Cottrell, III (#2555)

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

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<sup>7</sup> While these arguments may implicate claim construction and other merits-related issues, as the Court recognized in the motion to dismiss proceedings (D.I. 31 at 11-12), that does not excuse Plaintiffs from providing meaningful factual disclosures in their contentions.