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February 12, 2020

**VIA CM/ECF & HAND DELIVERY**

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

**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") respectfully requests that this Court continue the document production deadline in this action from February 7, 2020 to March 6, 2020. As of today, L'Oréal USA has produced documentation for over 120 products of the 156 products the parties agree have been "accused" by Plaintiffs University of Massachusetts and Carmel Laboratories, LLC's (together, "Plaintiffs"). More specifically, L'Oréal USA has produced financial records for **all** accused products, as well as for products that were launched after the expiration date of the asserted patents. L'Oréal USA has also produced marketing materials for 131 products and technical documents for 126 products. Unfortunately, due to Plaintiffs' unwillingness to narrow its list of accused products, or to, at the very least, remove improperly accused products, L'Oréal USA requires more time to work through document production issues related to some of the requests for production. While, at this time, L'Oréal USA seeks only an extension of the document production deadline, the breadth of this case as described below may require L'Oréal USA to seek further relief from the Court as to additional deadlines in the coming months, perhaps even including the trial date, if Plaintiffs do not sufficiently narrow their list of accused products, as they previously promised to do.

Though Plaintiffs initiated this lawsuit over three years ago, they only recently identified the extremely large number of products they are accusing of infringement. Neither the original complaint, filed on June 30, 2017, nor the amended complaint, filed on August 18, 2017, identified any specific products that allegedly infringe the asserted claims of the asserted patents, save for one. (*See* D.I. 1, 13 ¶ 34 (identifying L'Oréal Paris RevitaLift Triple Power Deep-Acting Moisturizer).) Rather, the FAC vaguely defined the accused products as "a vast array of topical skincare products manufactured and sold by [L'Oréal USA] us[ing] the adenosine technology exclusively licensed to Carmel Labs." (*Id.* ¶ 31.) It was not until October 10, 2019, when Plaintiffs served their Infringement Contentions, that they accused specific products of infringement—181 products, to be exact.<sup>1</sup> (*See* Ex. B at Exhibit A thereto.)

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<sup>1</sup> Plaintiffs' discovery requests did not elucidate matters. Though Plaintiffs served two sets of interrogatories and two sets of requests for production prior to serving their Infringement Contentions, these discovery requests did not seek information as to any specific product sold by L'Oréal USA. Rather, they sought information as to any product that contains any level of



Importantly, L'Oréal USA could not have known which products Plaintiffs would accuse of infringement at the time the Scheduling Order issued, because that accusation is based on Plaintiffs' claim construction theory and Plaintiffs' purported confidential testing of the products. Even under Plaintiffs' fundamentally flawed theory, it has not accused every L'Oréal USA product containing adenosine of infringement, but rather only those products that Plaintiffs assert fit within their claim construction. Thus, it was not until October 2019, three months after the Scheduling Order was entered, that L'Oréal USA first became aware of the vast scope of this litigation.<sup>2</sup>

On October 14, 2019, within days of receiving Plaintiffs' Infringement Contentions, L'Oréal USA raised its concerns about the breadth of the accused products and the impending document production deadline during a call with Plaintiffs, but nevertheless sought to work cooperatively to find a feasible approach to discovery in this case, notwithstanding the scope of Plaintiffs' demands. On that call, L'Oréal USA proposed, and Plaintiffs agreed, to a phased production of marketing materials for the accused products, to begin in mid-November. Specifically, the parties agreed that "L'Oréal USA would provide targeted marketing materials for 30 products at a time, which would include product packaging and launch materials." (Ex. C at 1.) To accommodate Plaintiffs, L'Oréal USA asked Plaintiffs to provide it "with a list of any products Plaintiffs are particularly interested in so we can include those products in the first phase." (*Id.*) L'Oréal USA reiterated this request in a follow-up email. (*Id.*) Plaintiffs never provided L'Oréal USA with any such list.

During that same call, L'Oréal USA also offered to obtain documents from its French parent, L'Oréal S.A., noting that it was "not going to insist that Plaintiffs proceed through the Hague to obtain documents from L'Oréal S.A.," even though L'Oréal S.A. had been dismissed from the case. (*Id.*) Specifically, L'Oréal USA voluntarily agreed to "make all reasonable efforts to collect and produce any relevant documents maintained by L'Oréal S.A." (*Id.*) This undertaking, while still ongoing and time-consuming, has resulted in Plaintiffs obtaining responsive documents much sooner than if they had been forced to proceed through the Hague.

On October 29, 2019, Plaintiffs served L'Oréal USA with proposed Amended

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adenosine, regardless of the concentration. (*See, e.g.*, Ex. A at 7, Interrogatory No. 3 (seeking the identification of "every product [L'Oréal USA] has ever sold in the United States that contains adenosine as an ingredient").) Indeed, Plaintiffs did not serve discovery requests pertaining to any specific accused product until December 18, 2019, well after they served their Infringement Contentions.

<sup>2</sup> During meet and confer discussions, Plaintiffs have relied on the Court's Report and Recommendation denying L'Oréal USA's motion to dismiss to argue that L'Oréal USA was on notice that any product containing adenosine was accused of infringement. (*See* D.I. 31 at 9.) This argument fails. As Plaintiffs are well-aware, the claims in the asserted patents are limited to a particular concentration of adenosine, and there are a number of L'Oréal USA products containing adenosine Plaintiffs do not accuse of infringement. Thus, the fact that L'Oréal USA was aware that it sold products containing adenosine did not mean that L'Oréal USA was on notice as to the scope of the products that would be accused in this case. That notice was not provided until October 2019.

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Infringement Contentions, wherein they identified one additional accused product, bringing the total number of accused products to 182. Within days, L'Oréal USA expressed concern to Plaintiffs that, "[a]t this juncture, the unsupported nature of Plaintiffs' infringement contentions, as well as the large number of accused products, have rendered the current case schedule unworkable." (Ex. D at 1.) L'Oréal USA proposed "that Plaintiffs either agree to significantly reduce the number of accused products or that the parties discuss amending the current scheduling order." (*Id.*) Plaintiffs did not, and have refused to, significantly reduce the number of accused products in this case. On November 8, 2019, L'Oréal USA provided Plaintiffs with a proposed new case schedule for consideration. (Ex. E at 1; Ex. E-1 at 1.) Plaintiffs refused to consider moving any discovery dates, agreeing only to continue dates associated with claim construction briefing.<sup>3</sup> (Ex. F at 1-2.) At that time, L'Oréal USA informed Plaintiffs that it would make best efforts to comply with the discovery dates, but, given the number of accused products, that may not be possible.

On December 16, 2019, Plaintiffs served their Second Amended Infringement Contentions, which withdrew five accused products, leaving the count at 177. As L'Oréal USA continued its investigation and document production, it noted obvious deficiencies in the accused products list. For instance, several of the accused products simply did not exist, as the product names identified by Plaintiffs could not be located in any L'Oréal USA database. Several other products were not ever sold by L'Oréal USA. Others appeared on the list multiple times, under different names. Others still were not sold by L'Oréal USA until after 2019—*i.e.*, well after the expiration of the asserted patents. All of this took considerable time and effort to determine.<sup>4</sup> L'Oréal USA voiced these concerns to Plaintiffs, again noting that the sheer number of accused products rendered document collection and production a slow-moving and arduous task, albeit one L'Oréal USA was pursuing as quickly as possible. (Ex. G at 16.) As L'Oréal USA explained in follow-up correspondence, "[g]iven the errors in both the list of accused products . . . and Plaintiffs' unwillingness to narrow the case to a workable number of products, it is taking time to wade through all of the issues . . . ." (*Id.* at 13.) L'Oréal USA further explained:

[A]s we have previously discussed, we have been trying to work with you to move this case along as fast as possible, but in light of the 180+ accused products (some of which L'Oréal USA cannot identify in this system, because as you note, the names you provided differ from the names used by L'Oréal USA and because Plaintiffs have accused the same products two or three times), along with your unreasonable demands for discovery, we will need to request an extension of at least the February 7th document production deadline.

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<sup>3</sup> Plaintiffs initially conditioned continuing these dates on L'Oréal USA's acceptance of Plaintiffs' deficient infringement contentions. Plaintiffs withdrew this improper condition after L'Oréal USA objected to it. (Ex. F at 1-2.)

<sup>4</sup> Indeed, Plaintiffs initially accused products spanning 16 brands, including non-L'Oréal USA brands, all of which operate separately, requiring discussions with numerous different individuals on several different topics. These efforts are ongoing.

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(*Id.*) L'Oréal USA asked whether Plaintiffs would be agreeable to such an extension. Plaintiffs did not respond for a week, but agreed to discuss the matter during a meet and confer call on January 30, 2020. (*See id.* at 14.) L'Oréal USA circulated a proposed amended schedule in advance of that call—the same proposed schedule it circulated months earlier, in November 2019, which proposed a document production deadline of March 27, 2020. (*Id.* at 5.)

In follow-up email correspondence, counsel for Plaintiffs stated that they would agree to extend the document production deadline to February 28, 2020, “if and only if” L'Oréal USA would agree to “remedy the deficiencies in its production pursuant to Paragraph 6 of the Scheduling Order no later than . . . February 7, 2020.” (*Id.*) This was, of course, an empty gesture, as Plaintiffs knew that the parties had a disagreement regarding the scope of the document production called for by Paragraph 6 of the Scheduling Order. L'Oréal USA asked Plaintiffs to withdraw this improper condition, but Plaintiffs refused. (*Id.* at 2-3.)

L'Oréal USA has met the standard of good cause for an extension under Rule 16(b)(4). While L'Oréal USA has made significant strides in its document production and has produced documents for the vast majority of the accused products, it requires additional time to continue its investigation and complete its production, as it continues to find errors with Plaintiffs' list of accused products. As of January 31, 2020, L'Oréal USA had identified 21 improperly accused products (*i.e.*, products that were not sold by L'Oréal USA, are duplicate names of other products, or were launched after the expiration of the asserted patents).<sup>5</sup> L'Oréal USA provided this count to Plaintiffs and asked them to let L'Oréal USA know if their count differed. (Ex. G at 2.) L'Oréal USA also asked Plaintiffs to provide an updated accused products list so that everyone could be on the same page. (*Id.*) Plaintiffs refused to do either, thus forcing L'Oréal USA to continue its investigation into many products for which, at this time, it has been unable to locate records. As of today, L'Oréal USA has identified 32 products that are improperly listed as accused products. Plaintiffs' refusal to work with L'Oréal USA to arrive at the proper scope of accused products for this case necessitates this modest extension.

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>5</sup> L'Oréal USA disputes that any accused product infringes the asserted claims, but for purposes of this discovery dispute, L'Oréal USA refers to “improperly accused products” as those which objectively cannot be part of the case for the reasons noted above.