

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

L'ORÉAL S.A. and L'ORÉAL USA, INC.,)

Plaintiffs,)

v.)

Civil Action No. 12-98-GMS

JOHNSON & JOHNSON CONSUMER)
COMPANIES, INC. and NEUTROGENA)
CORPORATION,)

Defendants.)

L'ORÉAL S.A. and L'ORÉAL USA, INC.,)

Plaintiffs,)

v.)

Civil Action No. 12-99-GMS

MSD CONSUMER CARE, INC.,)

Defendant.)

ORDER CONSTRUING THE TERMS OF U.S. PATENT NOS. 5,587,150 & 5,576,354

After having considered the submissions of the parties¹ and hearing oral argument on the matter, IT IS HEREBY ORDERED, ADJUDGED, and DECREED that, as used in the asserted claims of U.S. Patent Nos. 5,587,150 (the "'150 Patent"), and 5,576,354 (the "'354 Patent"):

A. The '150 Patent

¹ The plaintiffs, L'Oreal S.A. and L'Oreal USA, Inc. (together, "L'Oréal"), have combined their claim construction briefing for the two actions. Unless otherwise noted, references in this order to docket items use the docket numbers from the 12-98-GMS action.

1. The preamble term “photostable cosmetic screening composition for protection of the human epidermis against ultraviolet rays of wavelengths between 280 and 380 nm” is not a claim limitation and does not require construction.²

² L’Oréal argues that this term, which represents the preamble of Claims 21 and 32 and a portion of the preamble of Claim 33, has a limiting effect on those claims and should be construed in accordance with L’Oréal’s proposed definitions of the component terms “photostable” and “cosmetic screening composition.” (D.I. 49 at 2; D.I. 58 at 6–8.) The defendants contend that this term is not a claim limitation and need not be construed. (D.I. 53 at 3 n.4; No. 12-99, D.I. 49 at 6–8.) For the reasons that follow, the court agrees with the defendants.

The court first addresses this term as it appears in Claims 21 and 32 of the ’150 Patent. By way of example, Claim 21 provides:

A photostable cosmetic screening composition for protection of the human epidermis against ultraviolet rays of wavelengths between 280 and 380 nm, which comprises, in a cosmetically acceptable vehicle containing at least one fatty phase, 1 to 5% by weight of a dibenzoylmethane derivative, said dibenzoylmethane derivative being 4-tert-butyl-4'-methoxydibenzoylmethane, and at least 1% by weight of a α -cyano- β,β -diphenyl-acrylate of formula: [graphic skeletal formula representation of formula (I)] in which R₁ and R'₁ represent a hydrogen atom; R₂ represents a 2-ethylhexyl radical; and R₃ represents a —CN radical, the mole ratio of the compound of formula (I) to the dibenzoylmethane derivative being not less than 0.8.

’150 Patent at 10:4–26. The disputed phrase clearly represents the preamble of these claims, and, as a general rule, a preamble has no limiting effect. *See Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358 (Fed. Cir. 2010). The court, however, will treat a preamble as a claim limitation if it “recites essential structure or steps,” or if it is “necessary to give life, meaning, and vitality” to the claim. *See Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002). Though the Federal Circuit has not established any litmus test to define when a preamble limits claim scope, *id.* at 808; *see also Am. Med. Sys.*, 618 F.3d at 1363 (Dyk, J., dissenting) (“[W]e have not succeeded in articulating a clear and simple rule. As a result of the lack of clarity as to whether a preamble should be construed as limiting, our case law has become rife with inconsistency”); 3 Donald S. Chisum, *Chisum on Patents* § 8.06[1][d] (2013), it has noted several “guideposts” that have emerged from the caselaw, *see Catalina Mktg. Int’l*, 289 F.3d at 808.

In considering whether the “photostable cosmetic screening composition” phrase is “necessary to give life, meaning, and vitality” to the claim, the court looks to each of these “guideposts.” First, nothing in the disputed phrase serves as an antecedent basis for later terms nor is the phrase otherwise “essential to understand limitations or terms in the claim body.” *See id.* at 808. L’Oréal argues, without further explanation, that “adding octocrylene to avobenzone in a specific mole ratio is merely an ‘academic exercise’ without the underlying purpose or essence of the invention recited in the preamble.” (D.I. 51 at 12.) It fails, however, to identify any elements within the body of the claim that cannot be understood absent the context provided in the preamble.

This is also not a situation in which the preamble recites “additional structure or steps underscored as important by the specification.” *Catalina Mktg. Int’l*, 289 F.3d at 808. In fact, the disputed phrase does not provide any additional structural information. Rather, the “for protection of the human epidermis” language signals the intended use of the composition, and the “photostable cosmetic screening composition” language merely describes the properties or features inherent in a composition having the subsequently recited components. *See, e.g.*, ’150 Patent at 10:4–7. Even if one were to accept L’Oréal’s proposed construction of “photostable,” as the “photochemical stability of avobenzone corresponding to the photochemical stability of avobenzone provided by 0.8 molar ratio of octocrylene to avobenzone in a neutral environment,” it would not constitute additional structure, since it only repeats information conveyed in the body of the claim. *See id.* at 10:24–26.

Additionally, there was no “clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art.” *Catalina Mktg. Int’l*, 289 F.3d at 808 (noting that such reliance “indicates use of the preamble to define, in part, the claimed invention” and “transforms the preamble into a claim limitation”). L’Oréal

notes that “in the last Office Action before the patents-in-suit received a Notice of Allowance, the Examiner rejected the claims over GB 2198944, asserting that ‘[i]t would have been obvious . . . in view of the teaching [of the asserted art] that a combination of UV-A and UV-B absorbers results in a composition which provides enhanced photochemical stability’” (D.I. 58 at 8 (quoting D.I. 57, Ex. D at APX0396).) The applicants, however, did not rely on the term “photostable”—or any other portion of the preamble—to overcome this rejection. Instead, they noted that (1) it was unlikely that a person of skill in the art would select their preferred diphenylacrylate in light of its relatively low absorptive capacity; (2) one of the prior art references itself could have disclosed the invention if it were obvious; (3) the prior art did not provide sufficient motivation to combine diphenylacrylate derivatives with dibenzoylmethane derivatives; and (4) even if there were sufficient motivation, a person of skill would have looked for stabilizing agents among compounds of any type and not just UV-B screening agents. (D.I. 57, Ex. D at APX0399–401.)

On the other hand, the Federal Circuit has noted that preamble language merely “describing the use of an invention” or “extolling benefits or features of the claimed invention” does not function as a claim limitation. *Catalina Mktg. Int’l*, 289 F.3d at 809. These are precisely the roles played by the preamble phrase at issue here, as it serves only “to give context for what is being described in the body of the claim.” *Symantec Corp. v. Computer Assocs. Int’l, Inc.*, 522 F.3d 1279, 1288 (Fed. Cir. 2008). When preamble language is used in such a “duplicative” fashion, it does not present separate limitations. *See id.* at 1288–89.

L’Oréal’s principal argument is that the preamble “recite[s] the ‘essence or fundamental characteristic of the claimed invention.’” (D.I. 58 at 6 (quoting *Vizio, Inc. v. ITC*, 605 F.3d 1330, 1340 (Fed. Cir. 2010).) Indeed, in several decisions, the Federal Circuit has indicated that a preamble term reflecting the essence of the claimed invention might be limiting where it gives “life and meaning” to the remainder of the claim. *See, e.g., Vizio, Inc.*, 605 F.3d at 1340–41; *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333 (Fed. Cir. 2003); *Griffin v. Bertina*, 285 F.3d 1029, 1033 (Fed. Cir. 2002). L’Oréal, however, misunderstands the logic of these cases and suggests that a preamble term is limiting whenever the preamble relates to the “essence” of an invention. (D.I. 58 at 6–7.) A closer examination of these decisions reveals a far narrower scope. In *Griffin*, for example, the court found the preamble of a method claim reciting a “method for diagnosing an increased risk for thrombosis” to be limiting. 285 F.3d at 1031. The court concluded that “[d]iagnosis is . . . the essence of this invention,” and that its presence gave “‘life and meaning’ to the manipulative steps.” *Id.* at 1033. Central to this determination, however, was the court’s finding that the manipulative steps in the claim would be rendered “empty language” and mere “academic exercises” absent the purpose recited in the preamble. *See id.* (“In the absence of the preamble’s stated objective to diagnose thrombosis, the term ‘test subject’ is empty language. What is one testing for, and who is a suitable subject?”). Viewed properly, these decisions merely reflect the well-settled rule that “when the preamble is essential to understand limitations or terms in the claim body, the preamble limits claims scope,”—a rule that, as discussed above, is inapplicable here. *Catalina Mktg. Int’l*, 289 F.3d at 808. As such, the only “guideposts” relevant to the present dispute suggest that the preamble term is non-limiting in Claims 21 and 32.

The question of whether this term has a limiting effect within the context of Claim 33 requires some further analysis. Though neither L’Oréal nor the defendants acknowledge it in their discussion of the preamble issue, Claim 33 employs the so-called “*Jepson* form,” and “*Jepson* claiming generally indicates intent to use the preamble to define the claimed invention, thereby limiting claim scope.” *Catalina Mktg.*, 289 F.3d at 808. The Federal Circuit has explained the rationale for this presumption as follows:

The *Jepson* form allows a patentee to use the preamble to recite “elements or steps of the claimed invention which are conventional or known.” When this form is employed, the claim preamble defines not only the context of the claimed invention, but also its scope. Thus, the form of the claim itself indicates [the applicant’s] intention to use the preamble to define, in part, the structural elements of his claimed invention.

Rowe v. Dror, 112 F.3d 473, 479 (Fed. Cir. 1997) (internal citations omitted).

While the *Jepson* structure of Claim 33 certainly suggests that its preamble has some limiting effect, the format alone does not resolve the court’s inquiry. The Federal Circuit has made clear that “the mere fact that a structural term in the preamble is part of the claim does not mean that the preamble’s statement of purpose or other description is also part of the claim.” *Marrin v. Griffin*, 599 F.3d 1290, 1295 (Fed. Cir. 2010). The court

2. The preamble term “photostable” is not a claim limitation and does not require construction.³
3. The preamble term “cosmetic” is not a claim limitation and does not require construction.⁴
4. The preamble term “cosmetic screening composition” is not a claim limitation and does not require construction.⁵
5. The term “cosmetically acceptable vehicle” is construed to mean “base composition for the screening agents which is suitable for topical application.”⁶

understands this principle to apply with equal force in the *Jepson* context and believes that the preamble of Claim 33 can be separated into structural and merely descriptive portions. Claim 33 reads:

In a photostable cosmetic screening composition for protection of the human epidermis against ultraviolet rays of wavelengths between 280 and 380 nm which consists essentially of a dibenzoylmethane derivative as a UV-A screen in combination with a UV-B screen in a cosmetically acceptable vehicle containing at least one fatty phase, wherein the improvement comprises increasing the protection of the skin against UV rays of wavelengths between 280 and 380 nm by using 1 to 5% by weight of a dibenzoylmethane derivative, said dibenzoylmethane derivative being 4-tert-butyl-4'-methoxydibenzoylmethane, and an effective amount of at least 1% by weight of a α -cyano- β , β -diphenyl-acrylate of formula: [graphic skeletal formula representation of formula (I)] in which R₁ and R'₁ represent a hydrogen atom; R₂ represents a 2-ethylhexyl radical; and R₃ represents a —CN radical, the mole ratio of the compound of formula (I) to the dibenzoylmethane derivative being not less than 0.8.

'150 Patent at 11:26–12:26. A portion of Claim 33's preamble—the segment reading, “which consists essentially of a dibenzoylmethane derivative as a UV-A screen in combination with a UV-B screen in a cosmetically acceptable vehicle containing at least one fatty phase”—certainly “define[s] . . . the structural elements of [the] claimed invention.” This is expected in a *Jepson* claim, and the court understands this phrase to have a limiting effect. However, as in Claims 21 and 32, the disputed phrase—“photostable cosmetic screening composition for protection of the human epidermis against ultraviolet rays of wavelengths between 280 and 380 nm”—addresses only the intended use of the claimed composition and extols certain features thereof. The failure of this phrase to recite “elements . . . of the claimed invention which are conventional or known,” extinguishes the rationale for the *Jepson* presumption of limiting effect. As such, the court offers no construction for this particular preamble term.

³ See *supra* note 2.

⁴ See *supra* note 2.

⁵ See *supra* note 2.

⁶ L'Oréal argues that “cosmetically acceptable vehicle” need not be construed but that its plain and ordinary meaning is “base composition for avobenzone and octocrylene which is suitable for topical application.” (D.I. 49 at

6. The term “effective amount” is construed to mean “amount which increases the skin protecting abilities of the composition against UV rays between 280 and 380 nm.”⁷

3.) The defendants propose that it be construed as “[t]he base composition for the active ingredients which is suitable for topical application in a cosmetic screening composition.” (*Id.*)

While the parties agree that the vehicle is a “base composition,” there is some dispute as to what is included in that composition. In their opening brief, Johnson & Johnson Consumer Companies, Inc. and Neutrogena Corporation (together, “Neutrogena”) frame the question as whether the vehicle is a base composition for only octocrylene and avobenzene or whether it is a base composition for the “active ingredients selected from defined chemical classes of which avobenzene and octocrylene are only one out of many possible pairs of active ingredients.” (D.I. 53 at 18.) The defendants argue for the latter view, (*id.*; No. 12-99, D.I. 49 at 18–19), while L’Oréal appears to suggest that the “cosmetically acceptable vehicle” can be a base composition for only avobenzene and octocrylene, (D.I. 51 at 16).

The court largely agrees with the defendants on this issue. It is presumed that claim terms are used consistently throughout a patent, *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005), and importing L’Oréal’s “vehicle” definition into, for example, Claim 1 would yield nonsensical results, as Claim 1 does not call for the use of avobenzone and octocrylene (D.I. 58 at 28; No. 12-99, D.I. 49 at 18–19). L’Oréal defends its proposed construction by noting that the *asserted* claims of the ’150 Patent identify these two specific screening agents as the relevant members of the broader chemical classes. (D.I. 58 at 28.) This argument, however, is unavailing. Regardless of which claims are being asserted, the court’s claim construction occurs in the context of the entire ’150 Patent. While L’Oréal’s approach may not pose practical problems in a subsequent infringement analysis limited to those claims involving only avobenzene and octocrylene, its narrow construction simply does not reflect the meaning of the term “vehicle” as it appears in the ’150 Patent.

The court, however, declines to adopt the defendants’ proposed alternative. As L’Oréal correctly observes, the term “active ingredients” is undefined and creates unnecessary ambiguity. (D.I. 58 at 29.) The court’s construction instead employs the “screening agents” language actually found in the specification. *See* ’150 Patent at 2:64–66 (“By virtue of their lipophilic character, the screening agents used distribute uniformly in conventional cosmetic vehicles containing at least one fatty phase . . .”). The term “screening agents” is well-defined in the ’150 Patent, *see id.* at 1:10–2:50, and prosecution history, (D.I. 57, Ex. D at APX0399), and requires no further construction.

Finally, the court rejects the defendants’ attempt to include a requirement that the “cosmetically acceptable vehicle” be “in a cosmetic screening composition.” While Neutrogena is correct in noting that the asserted claims each recite the “vehicle” as a component of the “cosmetic screening composition,” (D.I. 53 at 10:4–7), that context is already provided in the claim language and need not be incorporated in the court’s construction of the present term, *see, e.g.*, ’150 Patent at 10:4–7.

⁷ L’Oréal contends that, while this term requires no construction, its plain and ordinary meaning is “amount which increases UV protection provided by photostabilized avobenzene.” (D.I. 49 at 3.) MSD Consumer Care, Inc. (“MSD”) suggests that the term is indefinite but that, for construction purposes, it should be defined as “enough to increase the skin protecting abilities of the composition against UV rays between 280 and 380 nm.” (*Id.*) Neutrogena declines to offer a proposed construction for this term and instead references its construction of “effective amount of at least 1%,” which it simply argues is indefinite. (*Id.*)

This term appears in Claim 33, which uses the *Jepson* form. As noted above, Claim 33 first discloses a screening composition “consist[ing] essentially of a dibenzoylmethane derivative as a UV-A screen in combination with a UV-B screen in a cosmetically acceptable vehicle containing at least one fatty phase,” and then describes its claimed improvement as follows:

7. The term “effective amount of at least 1% by weight” is construed to mean “amount of at least 1% by weight which increases the skin protecting abilities of the composition against UV rays between 280 and 380 nm.”⁸

B. The '354 Patent

1. The term “cosmetic screening composition” is construed to mean “composition containing sunscreen active agents that affects appearance.”⁹

wherein the improvement comprises increasing the protection of the skin against UV rays of wavelengths between 280 and 380 nm by using 1 to 5% by weight of a dibenzoylmethane derivative, said dibenzoylmethane derivative being 4-tert-butyl-4'-methoxydibenzoylmethane, and an effective amount of at least 1% by weight of a α -cyano- β,β -diphenyl-acrylate of formula: [graphic skeletal formula representation of formula (I)] in which R₁ and R'₁ represent a hydrogen atom; R₂ represents a 2-ethylhexyl radical; and R₃ represents a —CN radical, the mole ratio of the compound of formula (I) to the dibenzoylmethane derivative being not less than 0.8.

'150 Patent at 11:26–12:26. The plain language of this claim makes clear that the “effective amount” is an amount sufficient to “increas[e] the protection of the skin against UV rays of wavelengths between 280 and 380 nm.” The court therefore substantially adopts MSD’s proposed construction, as it is consistent with this understanding.

⁸ The parties combine their briefing of this term and “effective amount.” For the reasons discussed above, the court substantially adopts MSD’s proposed construction. *See supra* note 7.

⁹ The parties combine their discussion of “cosmetic screening composition,” as it appears in both the '150 and '354 Patents. As discussed above, the court finds that this term, as it appears in the '150 Patent, is not a claim limitation and requires no construction. *See supra* note 5. In the '354 Patent, however, this term occurs outside the formal preamble. For example, Claim 16 provides:

Process for stabilizing dibenzoylmethane derivatives with respect to UV radiation of wavelengths between 280 and 380 nm, comprising adding at least 1% by weight of a of a α -cyano- β,β -diphenyl-acrylate of formula: [graphic skeletal formula representation of formula (I)] in which R₁ and R'₁ represent a hydrogen atom; R₂ represents a 2-ethylhexyl radical; and R₃ represents a —CN radical; to a cosmetic screening composition comprising a cosmetically acceptable vehicle containing at least one fatty phase and 1 to 5% by weight of a dibenzoylmethane derivative, said dibenzoylmethane derivative being 4-tert-butyl-4'-methoxydibenzoylmethane, the mole ratio of the compound of formula (I) to the dibenzoylmethane derivative being not less than 0.8.

'354 Patent at 9:1–24. This claim recites a process in which a diphenylacrylate is added to a “cosmetic screening composition.” It then goes on to disclose that the composition “comprises” certain elements, effectively embedding a composition claim within the broader process claim. While the term “cosmetic screening composition” appears in what would be the preamble to the embedded composition claim if it were taken separately, it does not appear in the formal preamble to the process claim, which recites only a “[p]rocess for stabilizing dibenzoylmethane derivatives with respect to UV radiation of wavelengths between 280 and 380 nm.” Absent appearance in the actual preamble, there is no presumption that the term is non-limiting, and the court therefore provides a construction of this term as it appears in the '354 Patent.

L'Oréal argues that, while no construction is necessary, the plain and ordinary meaning of “cosmetic screening composition” is “composition containing sunscreen active agents which is suitable for topical application.” (D.I. 49 at 4.) The defendants, on the other hand, offer variations of a construction that would require

2. The term “cosmetic” is construed to mean “affecting appearance.”¹⁰
3. The term “cosmetically acceptable vehicle” is construed to mean “base composition for the screening agents which is suitable for topical application.”¹¹
4. The preamble term “stabilizing [avobenzone] with respect to UV radiation of wavelengths between 280 and 380 nm” is not a claim limitation and does not require construction.¹²

the composition to have a beautification or defect masking effect. Specifically, Neutrogena suggests that the term be construed as a “cosmetic . . . composition containing sunscreen active agents” where “cosmetic” is defined as “serving to beautify the body or hide defects.” (*Id.*) MSD also proposes a “cosmetic . . . composition containing sunscreen active agents” but would define cosmetic as “[m]aterial intended to be applied to the body for beautifying or defect masking purposes.” (*Id.*)

The court agrees with the defendants that the word “cosmetic” requires the claimed composition to have some effect on appearance. This is the ordinary meaning of the term, and the court rejects L’Oréal’s attempt to link cosmetic instead with the concept of “topical application.” The specification statement relied upon by L’Oréal demonstrates only that the applicants intended the composition to be used for skin protection—it says nothing about its means of administration nor does it link such means to the word “cosmetic.” *See* ’354 Patent at 3:39–41. Likewise, L’Oréal’s citation to the background of U.S. Patent No. 4,894,222 (the “’222 Patent) shows only that “cosmetically acceptable” compositions can also be “topically applied.” (D.I. 58 at 26.) Finally, L’Oréal’s claim differentiation argument is unavailing, as it rests on the flawed premise that “cosmetics” must contain “pigments” or “colorants.” (D.I. 51 at 14–15.)

The court believes “cosmetic” should be given its ordinary meaning: affecting appearance. While the court is generally in agreement with the defendants, it notes that their “beautification” constructions are somewhat narrower than even the definitions found in their own cited extrinsic evidence. *See* 21 U.S.C. § 321(i)(1) (cited by MSD and defining “cosmetic” as “articles . . . “for cleansing, beautifying, promoting attractiveness, or altering the appearance.”) The plain meaning of “cosmetic” relates to appearance alteration, not necessarily improvement or beautification.

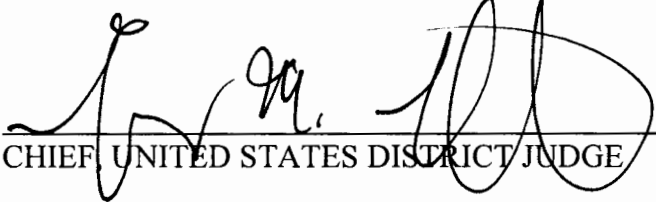
Additionally, the court rejects any suggestion by the defendants that the “cosmetic” feature of the composition must exist independently of its “screening” function. (No. 12-99, D.I. 57 at 18.) As the specification makes clear, exposure to ultraviolet rays can cause various skin issues having an aesthetic dimension, including erythema, burning, wrinkles, loss of elasticity, and premature aging. *See* ’354 Patent at 1:23–32. Thus, the very act of screening against such rays can have a “cosmetic” effect. This understanding comports with the specification of the ’354 Patent and resolves both the defendants’ concerns about rendering the word “cosmetic” meaningless, (D.I. 62 at 12; No. 12-99, D.I. 51 at 18), and L’Oréal’s worries about excluding a preferred embodiment, (D.I. 58 at 25).

¹⁰ *See supra* note 9.

¹¹ The parties combine their discussion of this term as it appears in both the ’150 and ’354 Patents. Since the patents-in-suit share a “substantively identical” specification and the same parent application, the construction of this term in the two patents effectively turns on the same intrinsic evidence. (D.I. 51 at 18.) The court therefore agrees with the parties and assigns this term the same construction as in the ’150 Patent. *See supra* note 6.

5. The preamble term “stabilizing” is not a claim limitation and does not require construction.¹³

Dated: July 19, 2013


CHIEF UNITED STATES DISTRICT JUDGE

¹² The parties combine their discussion of this term with their discussion of the “photostable” terms in the ’150 Patent. For the reasons provided above, the court finds that this term is not a claim limitation and requires no construction. *See supra* note 2.

¹³ *See supra* note 12.