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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

BRIGHTEX BIO-PHOTONICS, LLC,

Plaintiff,

v.

L'OREAL USA, INC.,

Defendant.

Case No. 3:24-cv-07919-JCS

L'OREAL USA, INC.'S PATENT L.R. 3-3
INVALIDITY CONTENTIONS

Pursuant to Patent Local Rule 3-3 and the schedule set by the Court in this case (Dkt. 34), Defendant L’Oreal USA, Inc. (“L’Oreal USA”) hereby provides its Invalidity Contentions for claims 5, 6, 9, 11 and 13 of U.S. Patent No. 9,542,595 (collectively, the “Asserted Claims” of “the ’595 Patent”).^{1, 2}

1. Introduction

These Invalidity Contentions are provided without prejudice to L’Oreal USA’s right to supplement or amend based on the discovery of new information, including, but not limited to: (1) amendments to Plaintiff’s Disclosure of Asserted Claims and Infringement Contentions; (2) admissions of Plaintiff regarding the prior art, the scope of the Asserted Claims, the meaning of claims terms, and the alleged priority, conception, and reduction to practice dates for any of the Asserted Claims, including statements by Plaintiff’s fact and expert witnesses, statements in documents produced by Plaintiff in this case, and statements in papers filed and evidence submitted by Plaintiff in this or any other case or proceeding involving the Asserted Patents; (3) additional prior art, including prior art obtained through discovery from Plaintiff or a third party, or through further investigation by L’Oreal USA; and (4) any order issued by the Court concerning the scope of Plaintiff’s infringement allegations or claim construction.

L’Oreal USA’s Invalidity Contentions are based on its current understanding of the Asserted Claims and of Plaintiff’s apparent interpretation of the Asserted Claims, as set forth in Plaintiff’s Infringement Contentions. Nothing in these Invalidity Contentions should be construed as an admission that any particular feature or aspect of any accused product practices any limitation of the Asserted Claims or that any of Plaintiff’s apparent claim constructions are reasonable, supportable, or proper. By providing these Invalidity Contentions, L’Oreal USA does not waive the right to contest claims constructions or take positions during claim construction proceedings

¹ As identified in Plaintiff’s Patent Local Rule 3-1 Disclosure of Asserted Claims and Infringement Contentions, served April 4, 2025.

² The Court has already found U.S. Patent No. 9,842,358 (“the ’358 Patent”) invalid as a matter of law and dismissed Plaintiff’s claim for infringement thereof. Dkt. 32. Accordingly, L’Oreal USA does not address the ’358 Patent in these Invalidity Contentions, but reserves the right to do so if the dismissal is reversed.

1 that may be inconsistent with positions expressed or implied herein. Nor does L'Oreal USA waive
2 any objections to Plaintiff's Infringement Contentions or challenges to Plaintiff's interpretation or
3 application of the Asserted Claims in those contentions. Indeed, Plaintiff's Infringement
4 Contentions are deficient in numerous respects and fail to describe the accused functionality and
5 Plaintiff's interpretation of claim language in a manner that would allow L'Oreal USA to fully
6 respond.

7 L'Oreal USA has submitted a petition for *inter partes* review of the '595 Patent (PTAB
8 Case No. IPR2025-00971), which it incorporates by reference in these Invalidity Contentions.

9 **2. Identification of Prior Art**

10 L'Oreal USA identifies the following prior art references that anticipate and/or render
11 obvious the Asserted Claims of the '595 Patent, or otherwise inform the relevant knowledge of a
12 person having ordinary skill in the relevant art at the time of the purported invention ("POSITA").
13 Whether a prior art reference anticipates or renders obvious a given claim may depend upon claim
14 construction.

15 In its Infringement Contentions, Plaintiff contends that each Asserted Claim is entitled to
16 a priority date of March 25, 2013, based on the disclosures of U.S. Provisional Application No.
17 61/805,126. Without conceding that priority date applies, each reference and system identified
18 below is prior art under 35 U.S.C. §§ 102(a)(1) and/or (2) based on the asserted March 25, 2013,
19 priority date. L'Oreal USA reserves the right to assert other prior art if a later priority date is
20 determined to apply.

21 Further, prior art patents and publications identified below may: (1) be related (such as a
22 divisional, continuation, continuation-in-part, parent, or child) to earlier- or later-filed patents or
23 publications, (2) have counterparts filed in other jurisdictions, and/or (3) incorporate (or be
24 incorporated by) other patents or publications by reference. The identified patents and publications
25 are intended to be representative of these other patents or publications to the extent they exist.
26 L'Oreal USA also incorporates by reference all prior art references cited on the face of the Asserted
27 Patents and in their prosecution histories.
28

2.1 Prior Art Patents and Published Patent Applications

PATENT / PUBLICATION NO.	FILING DATE	ISSUE / PUBLICATION DATE	INVENTOR(S)
US 2011/0301441A1 ("Bandic")	Feb. 28, 2011	Dec. 8, 2011	Jadran Bandic, Djuro Koruga, Sava Marinkovich, Rahul Mehendale
US 7,634,103 ("Rubinstenn '103")	Dec. 21, 2001	Dec. 15, 2009	Gilles Rubinstenn, Daniela Giacchetti, Francis Pruche
US 2003/0063300 ("Rubinstenn '300")	Dec. 21, 2001	Apr. 3, 2003	Gilles Rubinstenn
US 2005/0004475 ("Giron")	Jun. 14, 2004	Jan. 6, 2005	Franck Giron
US 8,910,082	Dec. 13, 2012	Dec. 9, 2014	Parham Aarabi
US 2003/0065526	Dec. 21, 2001	Apr. 3, 2003	Daniela Giacchetti, Francis Pruche, Gilles Rubinstenn
US 2003/0065255	Dec. 21, 2001	Apr. 3, 2003	Daniela Giacchetti, Gilles Rubinstenn, Francis Pruche
US 6,761,697	Dec. 21, 2001	Jul. 13, 2004	Gilles Rubinstenn, Francis Pruche
US 7,613,335	Feb. 12, 2004	Nov. 3, 2009	Geoffrey McLennan, Martin Donnelly, Deepa Gopalkrishnan, Eric Hoffman, Joseph Reinhardt, Melissa Suter
US 2003/0065578	Dec. 21, 2001	Apr. 3, 2003	Jerome Peyrelevade, Richard Naudin
US 8,009,884	Jun. 19, 2007	Aug. 30, 2011	Shiu-Shin Chio
US6654493	Nov. 12, 1999	Nov. 25, 2003	William J. Hilliard, Peter G. Engeldrum, Thomas L. Strother
US6985611/B2	Dec. 8, 2000	Jan. 10, 2006	Genevieve Loussouarn, Catherine Huber, Mahmoud Mourad
US7648364/B2	Jun. 26, 2001	Jan. 19, 2010	Christophe Dauga, Francis Xavier Quinn
US8360973/B2	Nov. 29, 2000	Jan. 29, 2013	Roland Bazin, Eric Doublet

PATENT / PUBLICATION NO.	FILING DATE	ISSUE / PUBLICATION DATE	INVENTOR(S)
US6937749/B2	Oct. 15, 2002	Aug. 30, 2005	Pierre Garnier
US7986987B2	Jun. 28, 2002	Jul. 26, 2011	Roland Bazin, Franck Giron
US20030050561/A1	Jun. 28, 2002	Mar. 13, 2003	Roland Bazin, Franck Giron
US20030065523/A1	Dec. 21, 2001	Apr. 3, 2003	Francis Pruche, Gilles Rubinstenn
US7437344/B2	Dec. 21, 2001	Oct. 14, 2008	Jerome Peyrelevade
US7324668B2	Dec. 21, 2001	Jan. 29, 2008	Gilles Rubinstenn
US20030065589A1	Dec. 21, 2001	Apr. 3, 2003	Daniella Giachetti
US20030063102A1	Dec. 21, 2001	Apr. 3, 2003	Gilles Rubinstenn, Frances Pruche
US20030065256A1	Dec. 21, 2001	Apr. 3, 2003	Gilles Rubinstenn
US7317818B2	Nov. 26, 2001	Jan. 8, 2008	Marc-Andre Lefebvre
WO2003054539A2	Dec. 18, 2002	Jul. 3, 2003	Francis Pruche and Gilles Rubinstenn
US6761697B2	Dec. 21, 2001	Jul. 13, 2004	Gilles Rubinstenn, Frances Pruche
US20060133997A1	Feb. 2, 2004	Jun. 22, 2006	Bernard Querleux, Roland Bazin
US20050111729A1	Oct. 13, 2004	May 26, 2005	Laurence Caisey
US7258023B2	Dec. 9, 2004	Aug. 21, 2007	Franck Giron
US7773091B2	Sep. 7, 2005	Aug. 10, 2010	Franck Giron, Eric Doublet
US20060274071A1	Sep. 29, 2005	Dec. 7, 2006	Roland Bazin
US20060210154A1	Mar. 15, 2006	Sep. 21, 2006	Jean-Luc Leveque, Roland Bazin

2.2 Prior Art Publications

TITLE	PUBLICATION DATE	AUTHOR(S) / PUBLISHER
Mobile Cosmetics Advisor: An Imaging Based Mobile Server ("Mobile Cosmetics Advisor")	January 2010	Nina Bhatti, Harlyn Baker, Hui Chao, Scott Clearwater, Mike Harville, Jhilmil Jain, Nic Lyons, Joanna Marguier, John Schettino, and Sabine Süssstrunk IS&T, The Society for Imaging Science and Technology, SPIE

2.3 Prior Art Systems

SYSTEM	RELEASE DATE
ModiFace Virtual Makeover Application <i>E.g.</i> , https://www.youtube.com/watch?v=zaKfRQl8tjU , https://www.amazon.com/ModiFace-Inc-Virtual-Makeover/dp/B009DJBPBW .	2010
Virtual Makeover by Daily Makeover <i>E.g.</i> , https://momintelligence.com/2011/11/daily-makeover/ .	2011
Makeover Studio by Daily Makeover <i>E.g.</i> , https://techcrunch.com/2009/08/23/daily-makeover-tries-to-re-create-the-beauty-counter-online/ .	2009
Virtual Makeover – Free Instant Makeover at Total Beauty <i>E.g.</i> , https://web.archive.org/web/20120314084556/http://www.totalbeauty.com/content/article/free-virtual-makeover-total-beauty , https://web.archive.org/web/20120224051014/http://www.beautyriot.com/free-virtual-makeover-intro .	2012

3. Invalidity Under 35 U.S.C. §§ 102 & 103

In the invalidity claim charts attached hereto as Appendices A–G (“Invalidity Claim Charts”), L’Oreal USA identifies the most relevant portions of the cited prior art references, illustrating that such references disclose, either expressly or inherently, or render obvious, either alone or in combination with other prior art references, each limitation of the Asserted Claims

1 identified therein. However, such references may contain additional support for certain claim
2 limitations and L'Oreal USA may rely on uncited portions of the references, other documents, and
3 expert testimony to provide context for or to aid in understanding the disclosures of the references.
4 Where L'Oreal USA cites to a particular figure in a reference, the citation should be understood to
5 encompass the caption and any corresponding description of the figure. Conversely, where L'Oreal
6 USA cites to particular text referring to a figure, the citation should be understood to include the
7 figure as well.

8 **3.1 Anticipation of the Asserted Claims**

9 L'Oreal USA contends that certain of the Asserted Claims are invalid under 35 U.S.C. §
10 102 as being anticipated by the following prior art patents and publications:

- 11 • U.S. Patent Pub. No. 2011/0301441A1 (“Bandic”)
- 12 • U.S. Patent No. 7,634,103 (“Rubinstenn ’103”)
- 13 • Mobile Cosmetics Advisor: An Imaging Based Mobile Server (“Mobile Cosmetics
14 Advisor”)

15 In the attached Invalidity Claim Charts, L'Oreal USA specifically identifies where each of
16 these references discloses every limitation of such claims.

17 L'Oreal USA further contends that certain of the Asserted Claims are invalid under 35
18 U.S.C. § 102 as being anticipated by the following prior art systems and technologies:

- 19 • ModiFace Virtual Makeover Application
- 20 • Virtual Makeover by Daily Makeover

21 In the attached Invalidity Claim Charts, L'Oreal USA identifies the basis for its contention
22 that each of these systems and technologies, as currently understood by L'Oreal USA, included
23 and/or discloses all features and functionality claimed in the Asserted Patents. Included in L'Oreal
24 USA's Patent L.R. 3-4 document production accompanying these Invalidity Contentions are
25 publicly accessible documents describing such systems and technologies, as they existed prior to
26 March 25, 2013. L'Oreal USA believes that additional documents describing each of these systems
27 and technologies are currently in the possession of non-parties. L'Oreal USA is continuing to
28

1 investigate and will produce additional documents describing these and/or related prior art systems
2 and technologies if, or when, such documentation is obtained.

3 **3.2 Obviousness of the Asserted Claims**

4 To the extent the prior art references and systems identified above do not anticipate an
5 Asserted Claim, each reference and system, either alone or in combination with the knowledge of
6 a POSITA and/or other prior art references disclosed herein, renders the claim obvious under 35
7 U.S.C. § 103. In the attached Invalidity Claim Charts, L'Oreal USA presents combinations of
8 certain prior art references and specifically identifies where each reference explicitly or inherently
9 discloses every limitation of the Asserted Claims. L'Oreal USA also provides reasons to combine
10 such references in Section 3.4, below.

11 These combinations are alternatives to L'Oreal USA's anticipation and single-reference
12 obviousness contentions and, therefore, should not be interpreted as indicating that any of the
13 individual prior art references included in the combinations are not alone invalidating prior art
14 under 35 U.S.C. §§ 102 and/or 103. Moreover, there are many possible combinations of the
15 disclosed references and the disclosure of certain combinations does not exclude other
16 combinations. L'Oreal USA's disclosure of such exemplary combinations is without prejudice to
17 its right to rely on additional or equivalent combinations, or to further explain any such
18 combinations.

19 Further, based on the information obtained to date, L'Oreal USA is unaware of any
20 secondary considerations that overcome the prima facie case of obviousness. To the extent Plaintiff
21 contends that any such secondary considerations exist, L'Oreal USA will respond in a manner
22 consistent with the Federal Rules of Civil Procedure, the Court's Local Rules, and this Court's
23 Orders.

24 **3.3 Invalidity Claim Charts**

25 Citations from the following prior art references, systems, and combinations are presented
26 in the attached Invalidity Claim Charts. Responsive to the discovery of additional information, as
27 described in Section 1 above, L'Oreal USA may further revise the Invalidity Claim Charts, or add
28 new invalidity claim charts, to assert that any such prior art, or other newly discovered prior art,

anticipates or renders obvious the claims of the Asserted Patents in a manner consistent with the Federal Rules of Civil Procedure, the Court’s Local Rules, and this Court’s Orders.

APPX.	PRIOR ART GROUND
A	Bandic , alone or in combination with the knowledge of a POSITA.
B	Rubinstenn ’103 , alone or in combination with the knowledge of a POSITA and/or Bandic.
C	Rubinstenn ’103 , alone or in combination with the knowledge of a POSITA and/or one or more of Bandic and Rubinstenn ’103.
D	Giron , alone or in combination with the knowledge of a POSITA.
E	ModiFace Virtual Makeover Application , alone or in combination with the knowledge of a POSITA.
F	Virtual Makeover by Daily Makeover , alone or in combination with the knowledge of a POSITA.
G	Mobile Cosmetics Advisor , alone or in combination with the knowledge of a POSITA.

3.4 Motivation to Combine

It would have been obvious to a POSITA to combine the identified prior art references. In *KSR Int’l Co. v. Teleflex Inc.*, the Supreme Court held that purported inventions arising from ordinary innovation, ordinary skill, or common sense are not patentable. 550 U.S. 398, 406, 420–22 (2007). In that regard, “[t]he combination of familiar elements according to known methods is likely to be obvious,” and thus not patentable, “when it does no more than yield predictable results.” *Id.* at 416. As the Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417; *see also id.* at 420 (“Common sense teaches ... that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”).

3.4.1 Motivation to Combine Rubinstenn '103 with Bandic

Rubinstenn '103 describes a calibration method (e.g., Figs. 6A and 6B) where a captured facial image may be displayed and then the user may “calibrate the color of the image when the subject perceives a difference between the displayed image and the actual color.” Rubinstenn '103 at 11:17-28, Figs. 6A & 6B. In Rubinstenn '103, however, the calibration may be incorrect due to a subject wrongly perceiving their skin color. Thus, a POSITA would have been motivated to combine Rubinstenn '103 with Bandic because Bandic discloses objective calibration principles. Bandic describes that its imaging device 108 can send the digital image to the host system 104, which can analyze 154 the image using algorithm 150. Bandic, ¶¶ 0312, 0392, 0427, 0429. The analysis may calibrate the acquired digital image via color offset correction. Algorithm 150 “may use RGB color analysis.” Bandic, ¶¶ 0427; *see also id.*, ¶¶ 0429, 0428, 0435, 0439. The color analysis includes “analyzing the color of skin images in a pixel by pixel manner.” Bandic, ¶ 0429. As part of this analysis, “colors obtained in a device dependent RGB color system are then converted into a device independent standard RGB color system (sRGB).” Bandic, ¶ 0429; Sonka, ¶ 101; *see also id.* ¶¶, 0430 (using a color standard space), 0435, 0439, at Fig. 58 (describing color offset) and Fig. 59 (depicting pixel view of image of subject’s face). Additionally, Rubinstenn '103’s user access device could perform the “image processing techniques” of Bandic, and thus, it could also perform Bandic’s calibration of converting device-dependent pixel color values to device independent “standard” values.

A POSITA also would have been motivated to combine Rubinstenn '103 with Bandic because both concern analyzing a subject’s skin and identifying a recommended cosmetic. They differ, however, in how they identify a cosmetic: Rubinstenn '103 generally determines a first cosmetic in response to a query answered by the subject. On the other hand, Bandic’s device analyzes the skin pixels according to color value.

Rubinstenn '103 describes that a query may indicate just a general category of cosmetics, and that “analytic techniques” may be used to analyze the subject’s image to identify a compatible cosmetic. If a subject responds to the query explaining that they would like a lipstick, Rubinstenn '103 explains that “analytic techniques may be used to identify lip stick likely to be compatible

1 with the subject.” Rubinstenn ’103 at 9:48-52. Rubinstenn ’103 later explains that captured images
2 (which can make up a 3D image), can show an external body condition and “the method may also
3 include proposing a beauty product to the subject . . . wherein the proposing may be based on least
4 partially on analyzing the external body condition.” Rubinstenn ’103 at 14:62-15:9. Analyzing this
5 external body condition can be based on “image processing techniques.” Rubinstenn103 at 15:13.

6 Rubinstenn ’103 does not describe the specifics of image processing techniques used to
7 determine a cosmetic, and thus, a POSITA would be motivated to turn to other references that
8 describe analyzing skin images to recommend a cosmetic. Bandic describes image processing
9 techniques of skin images for recommending a cosmetic, and thus, a POSITA would be motivated
10 to turn to Bandic for its image processing techniques.

11 Bandic teaches that the algorithm 150 (which is in the host system 104) conducts an RGB
12 color analysis. Bandic, ¶¶ 0427-0428. The color analysis includes analyzing each pixel’s color
13 after converting each pixel from a device dependent color to a device independent standard value:

14 In an exemplary embodiment of the present invention, a method for
15 determining skin characteristics and cosmetic features using **color analysis**
16 **includes a step of analyzing the color of skin images in a pixel by pixel**
17 **manner in a Red Green Blue (RGB) color system** for an acquired digital
18 image. . . . The step of analyzing the color of skin images in a pixel by pixel
manner in a sRGB color system for an acquired digital image comprises
analyzing a picture of a part of a person’s skin by generating a table of most
frequent colors appearing in the picture.

19 Bandic, ¶ 0429 (emphasis added). As part of the analysis, the pixels are converted into values
20 for a color space, such as into standard RGB color space values. Bandic, ¶¶ 0430, 0431 (“The
21 step of generating a sample of most frequent sRGB colors responsive to analyzing the color of
22 skin images in the sRGB color system for the acquired digital image comprises preserving a
23 plurality of sRGB color values.”).

24 Figure 58 (a process for determining a skin phototype), illustrates this, describing that an
25 image of a subject is analyzed in a pixel-by-pixel manner, the device dependent RGB colors are
26 calibrated (*e.g.*, converted into standard (device independent) “sRGB” color values), and those
27 values are generated in a range between 0 and 255. Bandic, ¶ 0436, Fig. 58 (annotated); *see also*
28 Bandic, ¶ 0505, Fig. 19; Sonka, ¶ 117.

1 Bandic's algorithm 150 can be used to determine skin phototype and skin state. For
2 example, algorithm 150's color analysis can determine skin phototype. Bandic, ¶ 0427. Algorithm
3 150 may be used to determine skin state 158, such as "mak[ing] a quantitative assessment of . . .
4 cosmetic indications, such as . . . skin color." Bandic, ¶ 0392. Bandic discloses that a skin state
5 provides a comprehensive description of the skin from the images, and skin phototype and skin
6 color are elements of skin state. Bandic, ¶ 0554.

7 The skin state 158 may be used to "recommend and design personalized products based on
8 skin health" Bandic, ¶ 0388; *see also* Bandic, ¶ 0498 ("Given the current skin state 158, a
9 new product or regimen 118 may be recommended."). Bandic also teaches that a POSITA would
10 appreciate that its RGB color analysis "may be useful in recommendation of a cosmetic product."
11 *See* Bandic, ¶ 0456

12 **3.4.2 Motivation to Combine Rubinstenn '103 with Rubinstenn '300**

13 Rubinstenn '103 describes a calibration method (e.g., FIG. 6A) in the context of a beauty
14 analysis which relies on the user to verify whether a color displayed on the screen is accurately
15 reflected (e.g., Rubinstenn103 at 11:17-12:34), but a POSITA would recognize that user error
16 could cause the calibration method to be wrong. Thus, a POSITA would turn to another method
17 where an electronic device calibrates the image without potential user error.

18 Rubinstenn '300 describes such calibration methods. Rubinstenn '300 describes several
19 methods of calibration where the device performs the calibration by matching the color of the
20 captured image with a "reference image" that comprises established color standards.
21 Rubinstenn300, ¶¶ 70; *see also id.*, ¶¶ 77-78. A reference image is an image of a color standard,
22 and using those known values, an image captured of the reference image can be corrected to
23 account for discrepancies.

24 Rubinstenn '300 generally describes a calibration method where the user takes an image
25 of their body part adjacent to a reference image to calibrate the image to conduct a beauty analysis.
26 Rubinstenn '300, ¶¶ 2, 64. Rubinstenn '300 teaches "displaying an image on a calibrated display
27 device" (302), "instructing a subject to place a body part adjacent the reference image" (304),
28 "capturing a calibrating image of the body part adjacent the reference image using an image

1 capture device” (36), and “calibrating information by processing the calibrating image and
2 information reflective of the reference image.” Rubinstenn ’300, ¶ 64, 72, 74, 76. The reference
3 image “may include a color bar of multiple colors and/or a swatch of multiple colors.” Rubinstenn
4 ’300, ¶ 70.

5 Rubinstenn ’300 describes a number of methods suited for specific image capturing
6 environments. For example, Rubinstenn ’300 discloses using a display to display a reference image
7 with the color standard, placing a body part next to the display, and then capturing them
8 simultaneously in an image to calibrate it (Rubinstenn ’300, ¶ 72) or capturing the body part in the
9 first image and the reference image in the second image under the same lighting conditions (*id.*,
10 ¶¶ 77-78). Because the device could perform this calibration, a user would not need to, and a
11 POSITA would be motivated to rely on Rubinstenn ’300 for calibration-specific techniques.

12 Rubinstenn ’103 also incorporates Rubinstenn ’300 by reference. Rubinstenn ’103 recites
13 that “[t]he following concurrently filed U.S. patent applications are also incorporated herein by
14 reference: . . . Calibrating Image Capturing, Ser. No. 10/024,334.” Rubinstenn ’103 at 20:36-37,
15 49-50. The Application No. of Rubinstenn ’300 (U.S. Pat. Pub. No. 2003/006300) is 10/024,334,
16 it shares the same inventor (Gilles Rubinstenn), was filed on the same date as Rubinstenn ’103,
17 and contains the same title as described in Rubinstenn ’103. A POSITA would view Rubinstenn
18 ’300 as part of Rubinstenn ’103’s disclosure and be more motivated to use ’300’s calibration
19 methods to overcome Rubinstenn ’103’s user-based calibration.

20 **3.4.3 Motivation to Combine Other Prior Art References and Systems**

21 Each of the other prior art references and systems identified in L’Oreal USA’s Invalidity
22 Claim Charts are directed to methods and systems that enable image analysis or simulation of a
23 cosmetic which support identifying a cosmetic product. For instance, Giron describes a system
24 that analyzes images of a subject’s face for determining whether a cosmetic product achieves a
25 desired result, such as fuller lips or hiding a skin defect. The system can prescribe a cosmetic
26 product to achieve the desired result. The ModiFace Virtual Makeover Application allowed a user
27 to upload an image of their face and to select a cosmetic product, and then simulated the application
28 of the product on the user’s face via the image. The Virtual Makeover by Daily Makeover

1 performed similar functions. Using the application, a user could upload an image of their face,
2 adjust the colors of the image, and simulate the application of various cosmetic products. The
3 system disclosed in Mobile Cosmetics Advisor system similarly calibrates and determines
4 cosmetic colors that match a user's skin color in an uploaded image of the user's face.

5 A POSITA would naturally look to related patents, patent applications, publications, and
6 commercial products to provide insight into how the inventors, authors, or companies framed and
7 applied the inventions, teachings, and commercial products. And a POSITA would have found it
8 obvious to combine and/or modify such prior art to utilize other known methods and principles to
9 conduct beauty analysis or cosmetic simulation of a subject's image supporting identification of a
10 cosmetic,, including but not limited to: (1) simulating a cosmetic on a subject's image, (2)
11 calibrating the image, (3) identifying color space values from pixels in the image, and (4)
12 transferring information of a cosmetic product. Indeed, doing so would have required nothing more
13 than combining known techniques and apparatuses according to their known and ordinary uses to
14 yield predictable results. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

15 Accordingly, a POSITA would have been motivated to combine and/or modify the prior art
16 references and systems identified in this and the preceding sections. *See supra* Sections 3.4.1–2;
17 *In re Inland Steel Co.*, 265 F.3d 1354, 1362 (Fed. Cir. 2001) (finding a motivation to combine
18 where the prior art references addressed the same problem, came from the same field of art, and
19 where the identified solutions corresponded well).

20 * * *

21 To the extent Plaintiff asserts that a POSITA would not have been motivated to combine
22 any of the prior art identified herein and/or challenges a POSITA's knowledge with respect to a
23 particular claim limitation, L'Oreal USA reserves the right to supplement these contentions and to
24 rely on uncited portions of the prior art, other documents, admissions by or on behalf of Plaintiff,
25 and expert testimony to establish that a POSITA would have been motivated to modify or combine
26 such prior art so as to render the claims invalid as obvious.

4. Invalidity Under 35 U.S.C. § 101

Pursuant to 35 U.S.C. § 101, patent protection is available for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” However, the Supreme Court has identified certain subject matter for which patent protection is not available, including abstract ideas. To determine whether a patent claims such ineligible subject matter, courts must follow a two-step framework. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). First, courts must “determine whether the claims at issue are directed to [a] patent-ineligible concept[],” e.g., an abstract idea. *Id.* If so, the next step is to look for an “‘inventive concept’—i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself.’” *Id.* at 217–18. The two steps are “plainly related” and “involve overlapping scrutiny of the content of the claims.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). In conducting this analysis, a representative claim may be used for claims that are “substantially similar and linked to the same abstract idea.” *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014); *Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1368 n.7 (Fed. Cir. 2017) (concluding that claims “should rise or fall together” when they “contain only minor differences in terminology but require performance of the same basic process”) (internal quotation marks omitted).

Relevant here, the Supreme Court has held, for example, that the “mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 573 U.S. at 223; *see also, e.g., id.* (“Thus, if a patent’s recitation of a computer amounts to a mere instruction to ‘implement’ an abstract idea ‘on ... a computer,’ [] that addition cannot impart patent eligibility.” (quoting *Mayo Collaborative Svcs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 84 (2012))); *Customedia Techs., LLC v. Dish Network Corp.*, 951 F.3d 1359, 1366 (Fed. Cir. 2020) (“Aside from the abstract idea of delivering targeted advertising, the claims recite only generic computer components, including a programmable receiver unit, a storage device, a remote server and a processor. ... Such generic and functional hardware is insufficient to render eligible claims directed to an abstract idea.”); *Bascom Global Internet Svcs., Inc. v. AT&T Mobility LLC*,

1 827 F.3d 1341, 1348 (Fed. Cir. 2016) (“An abstract idea on ‘an Internet computer network’ or on
2 a generic computer is still an abstract idea.” (citing *Intellectual Ventures I LLC v. Capital One Bank*
3 *(USA)*, 792 F.3d 1363, 1395, n.2 (Fed. Cir. 2015) (collecting cases))); *Elec. Power Grp.*, 830 F.3d
4 at 1355 (“But in this case the claims’ invocation of computers, networks, and displays does not
5 transform the claimed subject matter into patent-eligible applications. The claims at issue do not
6 require any nonconventional computer, network, or display components, or even a “non-
7 conventional and non-generic arrangement of known, conventional pieces,” but merely call for
8 performance of the claimed information collection, analysis, and display functions “on a set of
9 generic computer components” and display devices.” (quoting *Bascom*, 827 F.3d at 1349–52));
10 *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (“As the [Supreme] court later explained, *Flook*
11 stands for the proposition that the prohibition against patenting abstract ideas ‘cannot be
12 circumvented by attempting to limit the use of the [abstract idea] to a particular technological
13 environment’ or adding ‘insignificant postsolution activity.’” (quoting *Diamond v. Diehr*, 450 U.S.
14 175, 191–92 (1981))).

15 Moreover, although claims that “improve the functioning of the computer itself” may be
16 eligible for patent protection, it is “not enough [] to merely improve a fundamental practice or
17 abstract process by invoking a computer merely as a tool.” *Customedia*, 951 F.3d at 1362–64. For
18 example, “improving a user’s experience while using a computer application is not, without more,
19 sufficient to render the claims directed to an improvement in computer functionality.” *Id.* at 1365;
20 *see also, e.g., In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 612–13 (Fed. Cir. 2016) (“The
21 specification does not describe a new telephone, a new server, or a new physical combination of
22 the two. The specification fails to provide any technical details for the tangible components, but
23 instead predominately describes the system and methods in purely functional terms. ... In other
24 words, the focus of the patentee and of the claims was not on an improved telephone unit or an
25 improved server.”).

26 The Asserted Claims of the ’595 Patent recite nothing more than general image processing
27 steps to simulate the application of a cosmetic product on a user in an image. Specifically,
28 independent claim 5 of the ’595 Patent recites the following:

1 A method for analyzing a skin of a subject and identifying a cosmetic
2 product for the subject, comprising:

3 at an electronic device with one or more processors and memory storing
4 one or more programs for execution by the one or more processors:

5 calibrating colors of a first digital image, wherein the first digital
6 image depicts at least a portion of a face of the subject, and the first
7 digital image includes a plurality of pixels;

8 displaying the first digital image;

9 dividing the display of the first digital image into two sides, wherein
10 one side of the first digital image is displayed with no cosmetic
11 product applied, and one side of the first digital image is displayed
12 with a simulated application of a cosmetic product;

13 transferring the first digital image; and

14 transferring information of a cosmetic product, wherein skin pixels
15 in the plurality of pixels are identified, color space values are
16 identified from the skin pixels, and the cosmetic product is identified
17 at least based on the color space values.

18 The method of claim 5 involves four aspects: (1) calibrating colors of an image of a user's
19 face, (2) displaying the image, (3) simulating the application of a cosmetic product in a portion of
20 the image, and (4) transferring the image and information about the simulated cosmetic product
21 application. The method is performed by generic computer components, i.e., "an electronic device
22 with one or more processors and memory," and is not directed to an improvement of the
23 functioning of such device. Rather, the method is directed to improving the user's experience when
24 selecting a cosmetic product to purchase, which "typically involves many trials with different
25 products." '595 Patent at 1:38–41 ("It often takes time and efforts to find a cosmetic product that
26 works well for the user, which can be frustrating and cumbersome."). Claim 5 thus amounts to
27 nothing more than the abstract idea of simulating the application of a cosmetic product. Indeed,
28 calibrating colors of, displaying, and transferring information about an image are all generic and
conventional computing operations inherent to modifying an image so as to simulate the
application of a cosmetic product.

Independent claims 6 and 11 recite substantially identical limitations written as apparatus
claims. These claims, again, recite the use of generic computer components—e.g., an "electronic
device, comprising: one or more processors; and memory storing one or more programs for

1 execution by the one or more processors” (Claim 6) and a “non-transitory computer readable
2 storage medium storing one or more programs for execution by one or more processors of an
3 electronic device” (Claim 11)—which are insufficient to transform the abstract idea of simulating
4 the application of a cosmetic product into patent-eligible subject matter.

5 Dependent claims 9 and 13 merely recite the additional steps of “transferring a modified
6 image, wherein the modified image is prepared based on the first digital image, and at least a
7 portion of the modified image shows a simulated effect of application of the cosmetic product,”
8 which does not add any additional element or combination of elements that make these claims less
9 abstract than the ineligible concept of simulating the application of a cosmetic product.

10 **5. Invalidity Under 35 U.S.C. § 112**

11 As explained below, L’Oreal USA contends that certain limitations of the Asserted Claims
12 fail to satisfy the requirements of 35 U.S.C. § 112, but has nonetheless identified prior art
13 disclosures that anticipate and/or render obvious every limitation of the Asserted Claims in the
14 accompanying Invalidity Claim Charts based on an assumption that Plaintiff will contend that the
15 claims do satisfy such requirements. L’Oreal USA’s identification of prior art disclosures that
16 anticipate and/or render obvious a particular claim limitation in the accompanying Invalidity Claim
17 Charts is not an admission that the claim limitation satisfies the requirements of § 112, nor does it
18 represent any agreement or view as to the meaning of the limitation.

19 Where a claim term or limitation in one claim is identified as failing one or more
20 requirements under § 112, L’Oreal USA contends that the same claim term or limitation fails the
21 same requirement(s) in every instance the term or limitation is recited throughout the Asserted
22 Claims. Where a phrase is identified as failing one or more requirements under § 112, L’Oreal
23 USA contends that the subparts of the phrase also fail such requirement(s) within the context
24 recited in the claim.

25 **5.1 Lack of Written Description**

26 Pursuant to 35 U.S.C. § 112(a), a patent “specification shall contain a written description
27 of the invention, and of the manner and process of making and using it, in such full, clear, concise,
28 and exact terms as to enable any person skilled in the art to which it pertains, or with which it is

1 most nearly connected, to make and use the same.” Specifically, the specification must describe
2 the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that
3 the inventor had possession of the claimed invention (the “written description requirement”). *Ariad*
4 *Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

5 The limitations of “transferring the first digital image” and “transferring information of a
6 cosmetic product, wherein skin pixels in the plurality of pixels are identified, color space values
7 are identified from the skin pixels, and the cosmetic product is identified at least based on the color
8 space values,” as recited in claims 5, 6, and 11, lack written description support in the specification.
9 The specification only describes the transfer of such data in the context of embodiments where
10 certain operations are performed by a client device and others are performed by a server. *See* ’595
11 Patent at 8:17–11:21, Fig. 5. In those embodiments, “client 102 sends (502) a digital image of at
12 least a portion of a face of the subject (e.g., a user) to server 108,” which then “identifies (506)
13 skin pixels in the digital image,” “identifies (508) color space values from the skin pixels,”
14 “identifies (512) a cosmetic product at least based on the color space values,” and “sends (514)
15 information of the identified cosmetic product to client 102.” *Id.* at 8:20–10:23. However, the
16 claims require all such steps to be performed by a single “electronic device”—not distributed
17 across a client device and a server—and the specification provides no description of how to
18 perform the claimed “transferring” within a single device.

19 For at least the same reasons, the limitation of “transferring a modified image,” as recited
20 in claims 9 and 13, also lacks written description support in the specification. Again, the
21 specification only describes such transfer in connection with embodiments involving both a client
22 device and a server, *see* ’595 Patent at 10:19–11:9 (“server 108 prepares (520) a modified image
23 based on the digital image” and “sends (522) the modified image to client 102,” which then
24 “displays (526) the modified image”), which is distinct from the subject matter recited in the
25 claims.

26 **5.2 Indefiniteness**

27 Pursuant to 35 U.S.C. § 112(b), a patent “specification shall conclude with one or more
28 claims particularly pointing out and distinctly claiming the subject matter which the inventor or a

1 joint inventor regards as the invention.” According to the Supreme Court, this statutory
2 requirement “is met only when [the claims] clearly distinguish what is claimed from what went
3 before in the art and clearly circumscribe what is foreclosed from future enterprise.” *United*
4 *Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942). Thus, “a patent is invalid for
5 indefiniteness if its claims, read in light of the specification delineating the patent, and the
6 prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope
7 of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Claim terms
8 that are “insolubly ambiguous” also fail the definiteness requirement of § 112 because such terms
9 do not permit those skilled in the art to understand with precision what is inside and outside the
10 scope of the claim. *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir.
11 2005).

12 The term “transferring,” as recited in the Asserted Claims, renders those claims indefinite
13 because a POSITA cannot know with reasonable certainty what is required to perform this
14 operation. In particular, it is unclear where “the first digital image” and “information of a cosmetic
15 product” (claims 5, 6, and 11), or “a modified image” (claims 9 and 13), must be “transferr[ed]”
16 in accordance with the claims because the claims require all operations to be performed by the
17 same “electronic device.” There is no indication of where within that device any such data is
18 transferred or why. Indeed, the only reference to sending such data in the specification is in the
19 context of an embodiment where certain operations are performed by a client device while other
20 are performed by a server. *E.g.*, ’595 Patent at 8:17–11:21 (“FIG. 5 is a flowchart illustrating
21 operations performed by a client and a server in accordance with some embodiments. As shown in
22 FIG. 5, client 102 sends (502) a digital image of at least a portion of a face of the subject (e.g., a
23 user) to server 108. ... In some embodiments, server 108 prepares (520) a modified image based
24 on the digital image. At least a portion of the modified image shows a simulated effect of
25 application of the cosmetic product. ... In some embodiments, server 108 sends (522) the modified
26 image to client 102.”). Accordingly, because a POSITA cannot know with reasonable certainty the
27 scope of the claimed “transferring,” the Asserted Claims are indefinite.
28

1 **6. PLR 3-4 Document Production**

2 Pursuant to PLR 3-4(b), these Invalidity Contentions are accompanied by copies of each
3 prior art reference identified in Sections 2.1 and 2.2, above, as well as documents L'Oreal USA
4 has obtained to date describing each prior art system identified in Section 2.3, above (production
5 numbers LOREAL_0000150–74 and LOREAL_0000312–3173).

6 L'Oreal USA is also producing certain documents under PLR 3-4(a) (production numbers
7 LOREAL_0000175–311, LOREAL_0003184–85), and under PLR 3-4(c) and (e) (production
8 numbers LOREAL_0000001–39). However, the vast majority of documents L'Oreal USA has
9 identified to date under PLR 3-4(a), (c), and (e), as well as all documents it has identified under
10 PLR 4-3(d), are Highly Confidential and therefore require protections that are not provided under
11 the default protective order for the Northern District of California. Accordingly, L'Oreal USA will
12 not produce any such documents until an appropriate protective order has been entered by the
13 Court.

14
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16 Dated: May 19, 2025

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1 **CERTIFICATE OF SERVICE**

2 I hereby certify that on May 19, 2025, I caused the foregoing document to be served via
3 email upon counsel of record for Plaintiff:
4

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