

Exhibit D

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August 14, 2008

VIA ELECTRONIC MAIL

Gerald C. Willis
McAndrews Held & Malloy LTD
500 West Madison Street
34th Floor
Chicago, Illinois 60661

Re: ESN LLC v. Cisco Systems, Inc.

Dear Gerald:

I write to address deficiencies in ESN's "Answers to Defendants' Second Set of Interrogatories," served on July 14, 2008. In its response to Interrogatory No. 7, ESN made numerous improper objections and failed to provide a substantive response in compliance with the Federal and Local Rules.

Cisco's Interrogatory No. 7 requests:

State and describe in detail how the written description and any drawing(s) of ESN's Provisional Application No. 60/283,888 support the subject matter claimed in the '519 Patent, including: (i) the specific identification of any and all disclosures(s) in the provisional application for each element of each claim in the '519 Patent; and (ii) the specific identification of any and all disclosures(s) in the provisional application that enable a person skilled in the art to which the invention pertains to make and use the invention.

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ESN objects to this Interrogatory because: (1) it seeks information that is not relevant to any claim or defense presented in this action; and (2) it is a premature contention interrogatory seeking evidence related to claim construction and calls for expert analysis.

First, ESN is disingenuous in asserting that Interrogatory No. 7 is not relevant to any claim or defense in this suit. On the contrary, information sought by Interrogatory No. 7, whether the patent-in-suit is entitled to the priority date of the provisional application, can be determinative of the outcome of a patent infringement suit. *See, e.g. New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1297 (Fed. Cir. 2002) (The Federal Circuit affirmed the district court's grant of summary judgment to invalidate the patent-in-suit based on on-sale bar, holding that the patent was not entitled to an earlier priority date because the disclosure in the provisional application failed to adequately describe the claims.)

To be entitled to the filing date of a provisional application, the specification of the provisional application must meet the written description and enablement requirements as set forth in 35 U.S.C. § 112 ¶ 1. *See id.* at 1294. Since ESN contends that the priority date of the patent-in-suit is the provisional application filing date, it must provide Cisco with the basis that the provisional application meets 35 U.S.C. § 112 ¶ 1.

Second, Interrogatory No. 7 is not premature. Interrogatory No. 7 seeks identification of disclosures in the provisional application that meet the written description and enablement requirement — it does not seek ESN's claim construction position. Therefore, this interrogatory does not fall within the scope of exception to Local Patent Rule 2-5¹ and is not premature. Relevant case law in the Eastern District of Texas does not excuse a party from answering a contention interrogatory even if the answer depends on how claims are construed or are subject of expert opinion. *See Caritas Technologies, Inc. v. Comcast Corp.*, No. 2:05CV339, U.S. Dist. LEXIS 94879 at *18-21 (E.D. Tex. Feb. 10, 2006) (the court granting the plaintiff's motion to compel answers to an interrogatory, rejecting the defendant's argument that the plaintiff's interrogatory is premature because a response to the interrogatory depends on its construction of the asserted claims).

¹ Local Patent Rule 2-5 provides that "it shall not be a legitimate ground for objecting to an opposing party's discovery request ... that the discovery request or disclosure requirement is premature" except:

- (a) Request seeking to elicit a party's claim construction position;
- (b) Requests seeking to elicit from the patent claimant a comparison of the asserted claims and the accused apparatus, product device, process, method, act or other instrumentality;
- (c) Requests seeking to elicit an accused infringer a comparison of the asserted claims and the prior art; and
- (d) Requests seeking to elicit from an accused infringer the identification of any opinions of counsel, and related documents, that it intends to rely upon as a defense to an allegation of willful infringement.

In order to comply with Fed. R. Civ. P 26(b)(1), Fed. R. Civ. 33(b) and P.R. 2-5, ESN must provide Cisco with a proper and complete answer to Interrogatory No. 7. Please let me know by August 18, 2008 if ESN will supplement its answer by August 25, 2008. Please do not hesitate to contact me if you have any questions.

Very truly yours,

A handwritten signature in black ink, appearing to read 'Sayuri Sharper', with a stylized flourish at the end.

Sayuri Sharper

cc: All Counsel of Record