Exhibit H

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January 15, 2009

VIA ELECTRONIC MAIL

Gerald Willis
McAndrews Held & Malloy
500 West Madison Street, 34th Floor
Chicago, IL 60661

Re: ESN, LLC v. Cisco Systems, Inc.

Dear Jerry:

I write in regard to Cisco's Interrogatory Number 7 and the parties' related meet and confer meeting in Dallas. As you know, Interrogatory Number 7 calls for ESN's position as to how the claims of the asserted patent are supported by the provisional application to which it claims priority. The parties are in agreement that the answer to this interrogatory is relevant to whether or not ESN may claim priority to that provisional application, and therefore which references are prior art. Nevertheless, ESN has refused to provide a substantive response to this interrogatory for a variety of reasons.

At our recent meet and confer meeting in Dallas, ESN argued that it was not obligated under the Rules of Civil Procedure to respond to this interrogatory. According to ESN, it need not provide its contention regarding its entitlement to the filing date of the provisional application until Cisco has identified prior art that falls between the filing dates of the provisional application and the application from which the patent issued. In support of that proposition, ESN relied on the case *Technology Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316 (Fed. Cir. 2008). That case is not, however, applicable.

Technology Licensing Corp. describes the burdens of production and persuasion at trial. *Id.* at 1327. That case explains:

> [The defendant], having the ultimate burden of proving its defense of invalidity based on anticipating prior art, then has the burden of going forward with evidence that there is such anticipating prior art . . . .
>
> At that point [the patentee] has the burden of going forward with evidence either that the prior art does not actually anticipate, or, as was attempted in this case, that it is not prior art because the asserted claim is entitled to the benefit of a filing date prior to the alleged prior art. This requires [the patentee] to show not only the existence of the earlier application, but why the written description in the earlier application supports the claim.

Id. Technology Licensing Corp. therefore stands for the proposition that ESN need not present evidence ***at trial*** of its entitlement to the priority date of the provisional application until Cisco presents evidence ***at trial*** that prior art invalidates the asserted claims. That proposition is inapplicable to this dispute for two reasons.

First, Cisco has already met the burden that ESN contends applies. In its invalidity contentions, Cisco identified dozens of prior art references that it contends invalidate the claims of ESN's patent. Even assuming that *Technology Licensing Corp.* is applicable, the burden ESN incorrectly claims it imposes on Cisco has been met.

Second, burdens of production and burdens of persuasion are techniques for structuring the presentation of evidence at a trial. Nothing in *Technology Licensing Corp.* purports to create a limitation on what information must be produced in response to a discovery request. It never mentions or discusses discovery obligations.

To the contrary, it is black letter law that trial burdens are not limits on discovery. American Jurisprudence, for example, states: "The ultimate burden of proof is not a limitation upon the boundaries of discoverable material, and a party may be entitled to discovery, regardless of whether that party has or does not have the burden of proof on the particular issue." 23 Am. Jur. 2d Depositions and Discovery § 24 (footnotes omitted). That proposition is supported by multiple cases.

In *Scovill Manufacturing Co. v. Sunbeam Corp.*, 61 F.R.D. 598 (D. Del. 1973), a manufacturer refused to respond to an interrogatory that sought the basis for its position that its product did not infringe. The manufacturer refused to answer on the ground that it was the patentee's burden of proving infringement at trial. *Id.* at 601. The parties cross-moved to compel and for a protective order. The court granted the motion to compel, stating: "The Court holds that the ultimate burden of proof at trial is not a limitation upon the boundaries of discoverable material." *Id.*

Similarly, in *Kraszewski v. State Farm General Insurance Co.*, No. C 79 1261, 1983 WL 656 (N.D. Cal. June 9, 1983), the court characterized as "dilatory, frivolous and wholly lacking in substantial justification" the argument that a party could refuse to respond to an interrogatory until the propounding party "produced 'credible evidence' to support the allegations underlying

the questions." *Id.* at *7. The position, the court wrote, "was recognizable as an absurdity to anyone even passingly familiar with the American discovery process." *Id.* As a result, the court sanctioned the offending party. You have cited no cases that contradict any of these authorities.

Despite having previously provided this authority to ESN, you have persisted in refusing to respond to Cisco's interrogatory until Cisco specifically identifies prior art that falls between the filing dates of the two patent applications. Yet this authority makes clear that Cisco's ultimate burden of production and persuasion at trial are not adequate grounds for such a refusal. Nevertheless, to avoid burdening the Court with a Motion to Compel the information that Cisco is undeniably entitled to, the following representative prior art references put at issue ESN's purported ability to rely on the provisional application:

Inbar, U.S. Patent No. 6,885,660 filing date 2/14/2002

Sylantro Softswitch: "Sylantro Announces Sophisticated Routing and Network Configuration Capabilities for Service Providers," press release dated 8/20/2001

Clarent NetPerformer: "Clarent Announces SIP-Based Integration Of NetPerformer Product Line With Its Softswitch," press release dated 3/8/2002.

In addition, whether ESN can claim priority to the provisional application is relevant to whether or not ESN can attempt to swear behind references that predate the provisional application. ESN's ability to swear behind at least the following references may be affected by whether ESN can claim priority to the provisional application:

Osterhout, U.S. Patent No. 7,197,029 filing date 9/29/2000

Wengrovitz, U.S. Patent No 7,035,248 filing date 2/12/2001

Janning, U.S. Patent No 7,024,461 filing date 4/28/2000

Nodoushani, U.S. Patent No 6,563,816 filing date 11/28/2000

Finally, Cisco continues to work to identify additional prior art references, some of which may fall between the filing dates of ESN's two patent applications.

Cisco is identifying the above references in reliance on the statements you made during our in-person meet and confer that ESN will, subject to and without waiving its objection, respond to Interrogatory 7. Please indicate by Tuesday, January 20, 2009, whether ESN intends to provide a supplemental response as agreed at the meet and confer.

Very truly yours,

Victoria Maroulis/KAS

Victoria F. Maroulis

VFM:KAS