

EXHIBIT B

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

ESN, LLC,

Plaintiff,

v.

CISCO SYSTEMS, INC. and
CISCO-LINKSYS, LLC,

Defendants.

CIVIL ACTION NO. 5:08-CV-20-DF

JURY TRIAL DEMANDED

**CISCO SYSTEMS, INC.'S AND CISCO-LINKSYS, LLC'S INVALIDITY
CONTENTIONS**

I. INTRODUCTION

Pursuant to Local Rule 3-3 of the Local Patent Rules of the Eastern District of Texas and the Court's Docket Control Order, defendants Cisco Systems, Inc. and Cisco-Linksys, LLC (collectively "Cisco") hereby provide their Invalidity Contentions with respect to the claims identified by plaintiff ESN, LLC ("ESN") in its April 13, 2008 Disclosure of Asserted Claims and Infringement Contentions (collectively "asserted claims"). The asserted claims are Claims 1, 3-10, and 12-18 of U.S. Patent Number 7,283,519 ("the '519 Patent"). With respect to each asserted claim, Cisco hereby: (a) identifies each item of prior art that either anticipates the claim or renders it obvious; (b) identifies whether these prior art references anticipate the claim or render the claim obvious and identify combinations of prior art that render the claim obvious; (c) identifies where within each item of prior art each element of the claim is found; and (d) identifies the grounds of invalidity based on indefiniteness under 35 U.S.C. § 112(2) or enablement or written description under 35 U.S.C. § 112(1) of any of the asserted claims. In

addition, Cisco hereby produces documents currently in its possession, custody or control required to accompany these Preliminary Invalidation Contentions pursuant to Patent Local Rule 3-4.

II. OBJECTIONS AND RESERVATIONS

The information and documents hereby produced are provisional and subject to revision as follows: Cisco expressly reserves the right to amend the disclosures and document production herein should ESN be allowed to provide any information that it failed to provide in its Rule 3-1 and 3-2 disclosures and that may require Cisco to revise, amend, and/or supplement its disclosures and document production. Furthermore, because discovery has only recently begun and because Cisco has not yet completed its search for and analysis of the prior art, Cisco reserves the right to revise, amend, and/or supplement the information provided herein should further analysis and discovery lead to additional information, consistent with the Patent Local Rules and the Federal Rules of Civil Procedure. In addition, Cisco's ultimate contentions concerning the invalidity of the claims of the '519 Patent may change depending upon the Court's construction of the claims, and/or positions that ESN or its expert witness(es) may take concerning claim interpretation, infringement, and/or invalidity issues.

Prior art not included in this disclosure, whether known or not known to Cisco, may become relevant. In addition, the obviousness combinations of references provided below under 35 U.S.C. § 103 are merely exemplary and are not intended to be exhaustive. In particular, Cisco is currently unaware of the extent, if any, to which ESN will contend that limitations of the asserted claims are not disclosed in the prior art identified by Cisco. To the extent such an issue arises, Cisco reserves the right to identify other references that would have made the addition of the allegedly missing limitation to the disclosed device obvious.

Furthermore, Cisco's claim charts cite particular teachings and/or disclosures of the prior art as applied to features of the asserted claims. However, persons of ordinary skill in the art generally may view an item of prior art in the context of other publications, literature, products, and understanding. As such, Cisco reserves the right to rely on uncited portions of the prior art references and on other publications and expert testimony as aids in understanding and interpreting the cited portions, as providing context to them, and as additional evidence that the prior art discloses a claim limitation. Cisco further reserve the right to rely on uncited portions of the prior art references, other publications, and testimony to establish that a person of skill in the art would have been motivated to combine certain of the cited references so as to render the claims obvious.

For the purposes of these Invalidity Contentions, Cisco identifies prior art references and provides element by element claim charts based in part on the apparent constructions of the asserted claims advanced by ESN in its Infringement Contentions. Nothing stated herein shall be treated as an admission that Cisco agrees with ESN regarding the scope of any of the asserted claims or claim constructions advanced by ESN in its Infringement Contentions. Cisco's claim constructions will be disclosed during the *Markman* process set forth in the Court's Docket Control Order.

Pursuant to P.R. 3-3 and 3-4, Cisco provides disclosures and related documents pertaining only to the asserted claims as identified by ESN in its Preliminary Infringement Contentions. Cisco reserves the right to supplement these contentions to show the invalidity of any additional claims that the Court may allow ESN to later assert. Further, on May 8, 2008, Cisco wrote to ESN regarding the deficiencies in its P.R. 3-1 Disclosure of Asserted Claims and

Infringement Contentions. Cisco reserves the right to supplement these contentions if ESN is permitted to amend its infringement contentions to address these deficiencies.

III. INVALIDITY CONTENTIONS

A. Identification of Prior Art Pursuant to P.R. 3-3(a)

At this time, Cisco contends that at least the following prior art references anticipate or renders obvious, either alone or in combination, the asserted claims of the '519 Patent:

United States Patents/Patent Applications

- Osterhout, et al., United States Patent No. 7,197,029 (issued Mar. 27, 2007) ("Osterhout")
- Wengrovitz, United States Patent No. 7,035,248 (issued Apr. 25, 2006) ("Wengrovitz")
- Baratz, et al., United States Patent No. 5,742,596 (issued Apr. 21, 1998) ("Baratz")
- Czajkowski, et al., United States Patent No. 6,526,058 (issued Feb. 25, 2003) ("Czajkowski")
- Janning, et al., United States Patent No. 7,024,461 (issued Apr. 4, 2006) ("Janning")
- Nodoushani, et al., United States Patent No. 6,563,816 (issued May 13, 2003) ("Nodoushani")
- Chung, et al., United States Patent No. 6,584,108 (issued June 24, 2003) ("Chung")
- Oran, United States Patent No. 6,275,574 (issued Aug. 14, 2001) ("Oran")
- Inbar, et al., United States Patent No. 6,885,660 (issued on Apr. 26, 2005) ("Inbar")
- Kung, et al., United States Patent No. 6,917,610 (issued on July 12, 2005) ("Kung")
- Gerszberg, et al., United States Publication No. 2002/0033416 (published Mar. 21, 2002) ("Gerszberg")
- Chow, et al., United States Publication No. 2003/0185203 (published Oct. 2, 2003) ("Chow")

Other Publications

- Girard, G. and Hoffpauir, S., SIP-Telephony Service Interface Overview (published Mar. 20, 2000) ("Girard")
- "IP Communications Services Trial," by T. Hastings, MCI/Worldcom presentation given at Fall '99 Voice On the Net, September 29, 1999
- IETF RFC 2543, "SIP: Session Initiation Protocol," March 1999
- "Computer Telephony Encyclopedia," R. Grigonis, published by CMP Books
- "Practical VoIP Using VOCAL," L. Dang et. al., published by O'Reilly
- "Softswitching Seeks IP, PSTN Fusion," article by Joshua Piven, Computer Technology Review, Jan. 1, 2000
- "Ecstasy at VoDSL vendors as customers sign up and deliveries begin," Voice over DSL Reporting, September 13, 1999

Commercial Products

- Cisco MC3810 Multiservice Access Concentrator, offered for sale, sold and in public use no later than Jan. 27, 1998
- Cisco 3600 series router, offered for sale, sold and in public use no later than October 21, 1997
- Cisco Voice Manger, offered for sale, sold and in public use no later than March 23, 1998,
- Cisco 2600 series router, offered for sale, sold and in public use no later than March 23, 1998
- Lucent PathStar BSX, offered for sale, sold and in public use no later than April 28, 1999
- Komodo Fone 300, offered for sale, sold and in public use no later than September, 2000
- Ascend MAX 6000, offered for sale, sold and in public use no later than November 16, 1998
- Ascend MultiVoice Access Manager, offered for sale, sold and in public use no later than July 2000
- Motorola Vanguard 6560 router, offered for sale, sold and in public use no later than September 17, 1999

- Cabletron Spectrum Enterprise Manager, offered for sale, sold and in public use no later than May, 1999
- Mediatrix APA III-1, offered for sale, sold and in public use no later than September, 2000
- CommWorks Total Control 1000 Media Gateway, offered for sale, sold and in public use no later than September 12, 2000
- CommWorks 4220 SIP Proxy Server, offered for sale, sold and in public use no later than September 12, 2000
- Clarent NetPerformer Enterprise Gateway, offered for sale, sold and in public use no later than August 31, 1999
- Sylanro Softswitch, offered for sale, sold and in public use no later than August 20, 2001
- 8x8 IntraSwitch iPBX, offered for sale, sold and in public use no later than December 23, 1999
- ProtoQuick SIP Stack from Hughes Software Systems, offered for sale, sold and in public use no later than September 11, 2000
- Open source SIP, Vovida Open Communication Application Library (VOCAL) from Vovida Networks, offered for free download and in public use no later than September 1999
- SIP enhanced services creation software suite from Broadsoft, offered for sale, sold and in public use no later than September 1999
- All the softswitches mentioned in the article, "Soft-Switching and Public Network Integration," by Bill Michael, January 1, 2000, including: Integrated Convergent Switch, Convergent; EXS Media Gateway, Excel Switching; USX1000, Lara Technology; ETX5000, Salix Technologies; PSX6000, Sonus Networks; Fusion 5000, Tachion Networks; Open Compact Exchange, Taqua Systems; and SMX-2100, Unisphere. These products were offered for sale, sold and in public use no later than January 1, 2000.
- All the carrier class gateways mentioned in the article, "Internet Telephony Round Up: Carrier Class Gateways," published in January, 2000, including: CPX 1200 Series, Motorola Computer Group; Terabit Switch Router, Avici Systems, Inc.; MMS-1600, TransMedia Communications, Inc.; GSX9000, Sonus Networks, Inc.; SMX-2100, Unisphere Solutions, Inc.; Integrated Convergence Switch, Convergent Networks; PathStar Access Server, Lucent Technologies; Clarent Gateway 400, Clarent Corp.; IP.tel 6000, Cirilium Corp.; CVX 1800 Access Switch, Nortel Networks; Nuvo 500, Mockingbird Networks; ETX5000, Salix Technologies; SURPASS, Siemens Information and Communication Networks;

Nokia IP Telephony Gateway, Nokia; VocalTec Telephony Gateway Series 2000, VocalTec Communications, Ltd.; Tempest Data Voice Gateway, Franklin Telecom; Unified Services Exchange 1000, Lara Technology, Inc.; ORCA, Nuera Communications, Inc.; CommWorks, 3COM Corp.; Netspeak Gateway Exchange, Netspeak Corp.; Intelligent Network eXchange Switch (INX), World Telecom Labs; MainStreetXpress 36100 Access Concentrator, Newbridge Networks Corp.; CallLogiX Voice/Fax Gateway, Infosoft Technologies; Alcatel 1000 Call Server, Alcatel; Array Series 3000, Array Telecom Corp.; IP Telephony Solution, Ericsson, Inc.; and iServer 6d, Industrial CPU Systems. These products were offered for sale, sold and in public use no later than January 2000.

- All the VoIP gateways and gatekeepers mentioned in the article, "Voice over IP: Products, Services and Issues," by V. Kulathumani, November 23, 1999, including: IPT from Ericsson; ITX 120 from ECI Telecom; Portal CPCI Gateway from GlobalTel; Typhoon from Franklin Telecom; IP.tel 6000 from Hypercom; Telecommunication Pro from Internet Telecom; MasterVox from MasterMind Technologies; Edge Commander from Media Gate; Local Exchange Server from Global Gateway Group; InfoGate from Innomedia; Network Exchange 2410 from Netrix; InterPrise Series from Inter Tel; Digital Gateway from Interline; NeTrueCom from NeTrue; IPBX and Connect from NetPhone; IP Telephony Gateway from Nokia; CVX 1800 Gateway from Nortel; StarGate Server from StarVox; Latnet Gateway Server from Latic; Golden Gateway from Telogy; Vega 100, Vega 200 from VegaStream; Telco-In-a-Box from VipNet; INX from World Telecom Labs; Total Control Gateway from 3COM; Multivoice for the MAX from Ascend; Cheap all from Cheap Call; Carrier IP Gateway from Coyote Technologies; CpIP Gateway from Computer Protocol; Clarent Gateway from Clarent; Series 3000 from Array Telecom; Estream from EFusion; NetBlazer 8500 from DigiEurope; iSwitch Gateway from Intelliswitch; Packetstar from Lucent; Nuvo 500 from Mockingbird; F200ip from Nuera; Qbox V series from Quescom; VocalTec Gateway from VocalTec; Vswitch from Vsys; MultiVoIP from ViveSynergies; i-Tone from ArelNet; Micom V/IP Gateway from Micom; IP*Star from VocalData. These products were offered for sale, sold and in public use no later than November 23, 1999.

Cisco contends that, at a minimum, if the asserted claims are found not to be anticipated by the identified prior art, the asserted claims would have been obvious in view of those references either alone or in combination with one or more of the references disclosed above.

Suggestions and/or motivations to modify a prior art reference or to combine prior art teachings are found in the identified prior art references themselves, the technical problem itself, and the knowledge of or generally available to persons of ordinary skill and creativity in the art to which the '519 patent pertains prior to the time of the alleged invention of the '519 Patent.

One of skill in the art would reasonably expect success in such modifications and/or combinations. Such modifications and/or combinations were within the skill and knowledge of those of ordinary skill and creativity in the art at the time of the alleged invention of the '519 Patent.

Cisco also contends that all the commercial products identified above are prior art under 35 U.S.C. § 102(b) and § 102(g). The following entities were involved in the development, including conception and reduction to practice, of the identified commercial products: Cisco Systems; Lucent; Komodo; Ascend Communications; Motorola; Cabletron; Mediatix; 3Com; Clarent; 8x8; Hughes Software Systems; Vovida Networks; Broadsoft; Convergent Networks; Excel Switching; Lara Technology; Salix Technologies; Sonus Networks; Tachion Networks; Taqua Systems; Unisphere Solutions; Avici Systems; TransMedia Communications; Cirilium Corp.; Nortel Networks; Mockingbird Networks; Siemens Information and Communication Networks; Nokia; VocalTec Communications; Nespeak Corp.; World Telecom Labs; Newbridge Networks Corp.; Infosoft Technologies; Alcatel; Array Telecom Corp.; Ericsson; Industrial CPU Systems; ECI Telecom; GlobalTel; Franklin Telecom; Ericsson; Hypercom; Internet Telecom; MasterMind Technologies; Media Gate; Global Gateway Group; Innomedia; Netrix; Inter Tel; Interline; NetTrue; Connectfrom NetPhone; StarVox; Latic; Telogy; VegaStream; VipNet; World Telecom Labs; Cheap Call; Coyote Technologies; Computer Protocol; Array Telecom; EFusion; DigiEurope; Intelliswitch; Nuera; Quescom; Vsys; ViveSynergies; ArelNet; Micom; and VocalData.

Cisco has not had the opportunity to investigate through discovery whether any basis exists for invalidity of the '519 Patent under 35 U.S.C. § 102(f). Cisco reserves the right, after further discovery and investigation is conducted, to amend this list as needed.

B. Identification of Asserted Claim Elements for Each Prior Art Pursuant to P.R. 3-3(b) & (c)

Cisco attaches as Exhibit A charts identifying where within each item of prior art each element of each asserted claim is found at least in part according to ESN's apparent construction of the claims. If a combination of prior art references makes a claim obvious, each such combination as well as motivations to combine such items is identified.

The disclosures provided in Exhibit A are exemplary only. Cisco reserves the right to rely on the identified citations as well as other aspects of the prior art to demonstrate such invalidity. Cisco may rely on the United States Patent and Trademark Office's characterization(s) of the teaching effect(s) of prior art. Cisco may also rely on the admissions, statements, representations, and characterizations made by ESN concerning the prior art during the prosecution of the applications that led to the '519 Patent, the reexamination of the '519 Patent, or any related U.S. or foreign patent applications.

The contention that a prior art reference includes a specific claim element is not an admission as to the construction of that claim element. These preliminary invalidity contentions are made prior to the Court's construction of the claim terms and at least in part according to ESN's apparent construction of the claims. Pursuant to P.R. 3-6(b), Cisco will amend its contentions, as appropriate, once the Court has provided the parties with its construction of the claims.

C. Grounds of Invalidity Based on Indefiniteness, Enablement or Written Description Pursuant to P.R. 3-3(d)

Claims 1, 3-10, and 12-18 of the '519 Patent are invalid under 35 U.S.C. § 112(2) for failure to particularly point out and distinctly claim the subject matter the inventor regards as the inventions. Further Claims 1, 3-10, and 12-18 of the '519 Patent are invalid under 35 U.S.C. § 112(1) in that the specification does not set forth the alleged inventions so as to enable person

skilled in the art to make and use it without undue experimentation. These claims are also invalid under this section because the written description does not reflect that the inventors were in possession of the claimed inventions.

DATED: June 2, 2008

Respectfully submitted,

By 
Victoria Maroulis

MCKOOL SMITH P.C.

SAM BAXTER
Texas Bar No. 01938000
sbaxter@mckoolsmith.com
104 E. Houston St., Suite 300
P.O. Box 0
Marshall, Texas 75670
Telephone : (903) 923-9000
Facsimile : (903) 923-9099

GARRET W. CHAMBERS
Texas State Bar No. 00792160
gchambers@mckoolsmith.com
300 Crescent Court, Suite 1500
Dallas, Texas 75201
Telephone : (214) 978-4000
Facsimile : (214) 978-4044