

Exhibit F

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August 29, 2008

VIA ELECTRONIC MAIL

Gerald C. Willis
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500 W. Madison St., 34th Floor
Chicago, IL 60661

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

Dear Jerry:

Cisco writes in response to your August 20, 2008 letter regarding ESN's refusal to answer Cisco's Interrogatory No. 7, which seeks ESN's position as to how the written description in ESN's Provisional Application supports the subject matter of the claims of the patent in suit. ESN acknowledges on page three of your letter that this information is relevant to whether ESN can claim the priority date of the provisional application. Instead of answering, however, ESN has argued: 1) that because Cisco bears the burden of proof on the issue of invalidity at trial, ESN need not respond to discovery on the subject until after Cisco establishes a *prima facie* case of invalidity; and 2) that Cisco's interrogatory improperly seeks to elicit ESN's claim construction position as prohibited by Patent Local Rule 2-5(a). Neither argument has merit.

The Burden of Proof Argument

Your letter clarifies that the basis for ESN's objection to Cisco's interrogatory is that ESN contends it "is not relevant to any claim or defense in this case." You also write: "ESN is not obligated to provide Cisco with ESN's basis for claiming the priority date of the provisional application unless and until Cisco presents facts that establish a *prima facie* case that ESN is not entitled to the priority date." The apparent basis for ESN's position is that it is Cisco's burden at trial to prove the invalidity of the patent claims and that the issue of the appropriate priority date

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for the patent in suit pertains to the issue of invalidity. This argument, however, improperly conflates which party bears the burden of proof at trial with what evidence is discoverable. These two issues are distinct, as is well established and beyond dispute.

As an initial matter, Federal Rule of Civil Procedure 26(b)(1) states: "Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense . . ." Rule 33 permits Cisco to serve interrogatories that "relate to any matter that may be inquired into under Rule 26(b)." Neither rule creates an exception based on which party has the burden of proof at trial. Therefore, if the issue of the priority date is relevant to the defense of invalidity, then Cisco is entitled to take discovery from ESN related to it. Here, the issue of the appropriate priority date is relevant to what is and is not prior art to the patent in suit and therefore the defense of invalidity.

ESN does not dispute that Cisco contends that the patent in suit is invalid. ESN merely contends that it need not respond to discovery requests on issues upon which it does not bear the burden of proof at trial. It is, however, black letter law that "[t]he 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). For example, 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.

None of the authority you cite is to the contrary. The authorities you cite merely establish that Cisco bears the burden of proving invalidity by clear and convincing evidence at trial. But none of these cases hold that the burden of proof at trial has any bearing on discovery. For example, *Innovative Scuba Concepts, Inc. v. Feder Industries, Inc.*, 26 F.3d 1112, 1115 (Fed. Cir. 1994), upon which ESN relies, held that it was improper for the district court to shift the burden of persuasion at trial to the plaintiff to rebut evidence supporting an inference of invalidity. Nothing in that opinion purports to condition discovery on which party bears the ultimate burden of proof. The *Kraszewski* decision deems ESN's position an "absurdity", "frivolous," "wholly lacking in substantial justification," and sanctionable.

The Patent Local Rule 2-5(a) Argument

ESN also contends at the conclusion of your letter that Cisco's interrogatory is impermissible under Local Patent Rule 2-5(a), which allows for objections to interrogatories that seek a party's claim construction position. Local Patent Rule 2-5 states in relevant part:

Except as provided in this paragraph or as otherwise ordered, it shall not be a legitimate ground for objecting to an opposing party's discovery request . . . that the discovery request is premature in light of, or otherwise conflicts with, these Patent Rules. A party may object, however, to responding to the following categories of discovery requests . . . on the ground that they are premature in light of the timetable provided in the Patent Rules:

- (a) Requests 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 from an accused infringer a comparison of the asserted claims and the prior art.

Rule 2-5 therefore announces a general rule that a party may not refuse to respond to interrogatories on the grounds that they are premature. It then lists several specific exceptions. In your letter, ESN contends that responding to Cisco's interrogatory would require it to disclose where in the Provisional Application's specification each element of each claim is disclosed. ESN contends that this process would require ESN to disclose its claim construction position under Patent Local Rule 2-5(a) because implicitly ESN would be comparing the specification in the provisional application to the asserted claims, thereby conceding that certain descriptions contained in the Provisional Application fell within the scope of certain claim elements. ESN's interpretation is, however, unsupported by any case law cited or available.

ESN's reading of Patent Local Rule 2-5(a) is erroneous because it would unreasonably render subsections 2-5(b) and 2-5(c) superfluous. An interrogatory that sought a comparison of the asserted claims to either the prior art or an accused product would—under ESN's reading—also require disclosure of the responding party's claim construction position. Yet the drafters of Patent Local Rule 2-5 found it necessary to list subsections (b) and (c) in addition to the prohibition announced in subsection (a). ESN's broad interpretation of Patent Local Rule 2-5(a) would therefore cover all of the same cases that subsections (b) and (c) do, thereby rendering those subsections unnecessary. This position runs contrary to the canon of construction that the words of a statute or rule are not to be rendered superfluous if such an interpretation is avoidable. *See Huntleigh USA Corp. v. United States*, 525 F.3d 1370, 1382 (Fed. Cir. 2008); *see also Hicks v. Charles Pfizer & Co., Inc.*, 466 F. Supp. 2d 799, 807 (E.D. Tex. 2005) (applying the canon in interpreting the Federal Rules of Evidence). To give independent meaning to both subsections (b) and (c), subsection (a) must be given a more narrow reading than ESN's position allows.

Because neither of ESN's arguments are supported—and indeed have in some instances been declared frivolous in prior cases—Cisco requests a prompt and complete response to Cisco's Interrogatory No. 7.

Very truly yours,

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

Sayuri Sharper

SS:KAS