

# Exhibit I



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January 23, 2009

**VIA EMAIL and U.S. MAIL**

Victoria F. Maroulis  
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555 Twin Dolphin Drive, Suite 560  
Redwood Shores CA 94065

**Re: ESN, LLC v. Cisco Systems, Inc. and Cisco-Linksys, LLC,  
Civil Action No. 5:08-cv-20 DF**

Dear Vicki:

I am writing in response to your letter of January 15, 2009, and as a follow up to our discussion in Dallas on January 13, 2009. First and foremost, we disagree with your narrow interpretation of *Technology Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316 (Fed. Cir. 2006). You claim that *Videotek* is limited to burdens of production and persuasion at trial. However, there is no such specific limitation stated therein.

*Videotek* clearly stands for the proposition that until the defendant has put forth relevant prior art that places the priority date at issue, there is no issue. *Id.* at 1328-29. Rule 26 states:

Parties may obtain discovery regarding any matter, not privileged, that is **relevant to the claim or defense of any party**, including the existence, description, nature, custody, condition, and location of any **books, documents, or other tangible things** and the **identity** and location of **persons** having knowledge of any discoverable matter. For good cause, the court may order discovery of any matter **relevant** to the subject matter involved in the action. Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence.

Fed. R. Civ. P. 26(b)(1). So the applicable question is whether the interrogatory seeks discovery of any matter that is "**relevant**" to the claim or defense of any party. Obviously Cisco's interrogatory number 7 is not seeking additional "books, documents



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or other tangible things” and is not seeking the “identity and location of any persons having knowledge of any discoverable matter.” All of that type of information has already been provided to Cisco in this case.

What Cisco is seeking is a “contention” from ESN that is not at issue in this case, not related to any claim or defense in this case and not likely to lead to the discovery of admissible evidence. You cite *Schovill Manufacturing Co. v. Sunbeam Corp.*, 61 F.R.D. 598 (D. Del. 1973) as “support” for your claim that ESN is obligated to respond to Cisco’s interrogatory number 7. In addition to having **no precedential effect** on the Court in our case, that 39-year-old district court case dealt with responding to claims of non-infringement of the asserted patent. Non-infringement, as you know, is always “**at issue**” in a patent infringement case, whether it be due to the alleged absence of certain claim limitations in the accused device or due to an allegation that you cannot infringe an invalid patent.

You also cite *Kraszewski v. State Farm General Insurance Co.*, 1983 WL 656 (N.D. Cal. June 9, 1983) as “support” for your claim that ESN is obligated to answer Cisco’s interrogatory number 7. Again, this case has **no precedential effect** on the Court in our case and had nothing to do with patent infringement. Additionally, the court specifically noted that the defendant’s objections were “frivolous and dilatory,” but does not state what those objections were – in fact, the interrogatories at issue in *Kraszewski* were related to the production of financial data prepared in the ordinary course of business, the same type of information that Cisco has yet to produce in this case.

Your claim that we have not cited any cases that contradict your “authorities” is completely irrelevant. In fact, the cases that you have cited are not “authority” to anything whatsoever in our case. What we have repeatedly cited in stating our position is Fed. R. Civ. P. 26. Despite our numerous conversations and letters, you made no attempt to state the relevance of interrogatory number 7 until your letter of January 15, 2009. Even that letter fails to adequately place “at issue” the information you seek.

Your letter of January 15, 2009 at least attempts to explain the relevance of Cisco’s interrogatory number 7, yet still falls short because of inaccurate and false claims of relevance. You claim that Cisco has identified three pieces of alleged prior art that put the priority date of the provisional application at issue, which are the Inbar patent, the alleged Sylanro Soft Switch product and the alleged Clarent NetPerformer product.

With respect to the Inbar patent, you have prepared a claim chart which allegedly supports Cisco’s invalidity position. However, none of the claims at issue are



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addressed in that claim chart. Therefore, for at least that reason, the Inbar patent is not relevant to any claim or defense in this case.

With respect to the Sylanro Softswitch, you claim a relevant date of August 20, 2001, citing CISCO 16325-26. Your P.R. 3-3 disclosure does not specify which section of 35 U.S.C. § 102 you are asserting, however, it references that the alleged product was offered for sale, sold or in public use as of that date. Based upon the language of your 3-3 disclosures, it appears you are asserting this alleged reference as a § 102(b) reference. As such, this alleged reference does not put the priority date of the '519 Patent at issue because the alleged "on sale date" falls less than one year before the non-provisional application. Thus, it would not qualify as 102(b) art even if ESN was not entitled to the priority date of the provisional application. Furthermore, we advised you long ago that your P.R. 3-3 disclosures were deficient because they failed to identify where each element could be found in the alleged prior art product. We advised you that you have not provided sufficient information in order to establish that these alleged products are prior art at all. You refused to supplement your 3-3 disclosures and we advised you that we would then hold you to your 3-3 disclosures as they existed. Your disclosures regarding the alleged Sylanro Softswitch consist of four pages from an alleged website that do not provide any specific details about the alleged product. All we have is an uncorroborated claim by you that the Sylanro Softswitch is prior art, which is insufficient.

With respect to the Clarent NetPerformer, the date listed on page six of your P.R. 3-3 disclosures indicates a date of August 21, 1999, not March 8, 2002. The March 8, 2002 date appears in brackets on CISCO 16509 and is in a different font than the rest of the document, which raises some question as to the accuracy and source of the alleged date of that document. In any event, you have provided no claim chart as to this alleged piece of prior art. Again, from the language of your 3-3 disclosure, it appears that you have asserted this as a § 102(b) reference. As such, this alleged reference does not put the priority date of the '519 Patent at issue because the alleged "on sale date" falls less than one year before the non-provisional application. Thus, it would not qualify as 102(b) art even if ESN was not entitled to the priority date of the provisional application. Again the deficiencies with Cisco's 3-3 disclosures with respect to this reference are the same as those described in the preceding paragraph.

With respect to the Osterhout, Wengrovitz, Janning, and Nodoushani patents, it appears that you are seeking a different response than the one called for in interrogatory number 7. You claim in your letter that those references may require ESN to swear behind those alleged references. However, this question is not presented by



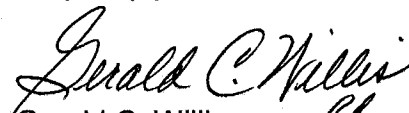
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Cisco's interrogatory. Additionally, you have not identified what provision of 35 U.S.C. § 102 you are claiming as a basis for your invalidity contentions with respect to these patents in your 3-3 disclosures, any correspondence or any meetings and phone calls.

As an additional matter, you continue to state verbally and in your correspondence that Cisco continues to work to identify additional prior art references. However, as I advised you at our meet and confer, that time has passed for Cisco. Your P.R. 3-3 disclosures were your opportunity to, and in fact your obligation to, identify **all** relevant prior art references. Any attempt to assert additional prior art will be met with objection and a motion to exclude from evidence. As we advised you many months ago when you refused to provide additional information about the alleged prior art products in your P.R. 3-3 disclosures, we will hold you to the disclosures you provided. If they are deficient and inadmissible under the local rules, as we believe they are, so be it.

Finally, we are still willing to consider answering Cisco's interrogatory number 7 if: (1) you can provide some reasonable explanation about the inconsistency of dates of the alleged prior art references; (2) explain why and how the Inbar patent, which you have not asserted against any of the claims at issue, is relevant to the question of priority; (3) explain how any alleged § 102(b) reference, with an alleged on sale date that falls less than one year before the filing date of the non-provisional application of the '519 Patent puts the priority date of the '519 patent at issue; and (4) how the Osterhout, Wengrovitz, Janning and Nodoushani patents put the priority date of the '519 Patent at issue.

Very truly yours,

  
Gerald C. Willis

c: Sayuri Sharper  
Kevin Smith  
John Ward  
Eric Albritton