EXHIBIT F

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION

EOLAS TECHNOLOGIES, INC. Plaintiff, v. ADOBE SYSTEMS, INC. ET AL., Defendants.	)	CIVIL ACTION NO. 6:09-C-446 (LED)

SUPPLEMENTAL EXPERT REPORT OF NICHOLAS P. GODICI

I. INTRODUCTION

1. I am the same Nicholas P. Godici who provided the Expert Report of Nicholas P. Godici, dated July 20, 2011 in the above referenced matter.

2. This Supplemental Expert Report incorporates the opinions set forth in my initial Expert Report of July 20, 2011 and addresses issues raised in this matter subsequent to my initial report.

3. In my initial Expert Report, I specifically contemplated that a supplemental report may be necessary if other matters including information and/or expert reports arose subsequent to my initial report. See ¶¶ 2 and 12 of my initial report.

> 2. I reserve the right to give opinions on facts and other matters arising subsequent to this report, including rebuttal to any matter raised by the parties or their experts, either prior to or during any hearing or trial in this action.
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> * * *
>
> 12. The opinions stated in this report are based on information currently available to me. I reserve the right to continue my investigation and study, which may include a review of documents, expert reports, or other information that may yet be produced, as well as any testimony from depositions for which transcripts are not yet available and that may yet be taken in this case. Therefore, I reserve the right to expand or modify this report as my investigation and study continues, and to supplement my opinions in response to any additional information that becomes available to me, to any matters raised by the parties, and/or other opinions provided by the parties' expert(s). In my testimony I may use exhibits and demonstratives.

4. My curriculum vita attached as **Exhibit A** to my initial report remains unchanged.

A. Prior Testimony

5. An updated list of cases in which I have testified as an expert at trial or by deposition in the last four years is attached as **Exhibit B**.

B. Materials Considered

6. **Exhibit C** to this report lists materials that I have considered in addition to the materials that were listed in **Exhibit C** to my initial report.

II. MY SUPPLEMENTAL ANALYSIS AND OPINIONS

7. I have been asked to address the following issues in this supplemental report.

A. The Addition of the University of California as a Co-Plaintiff

8. I am informed that the University of California has been added as a co-plaintiff in this action. I have been asked to evaluate the impact of this change with respect to the opinions expressed in my initial report.

9. As stated in my initial report, in 37 CFR § 1.56(c) the PTO sets forth who owes a duty of disclosure during the prosecution of a patent application as follows:

> (c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
>
> (1) Each inventor named in the application;
>
> (2) Each attorney or agent who prepares or prosecutes the application; and
>
> (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

10. Additionally, section 2001.01 of the MPEP gives the following guidance regarding who has the duty to disclose:

> Individuals having a duty of disclosure are limited to those who are "substantively involved in the preparation or prosecution of the application." This is intended to make clear that the duty does not extend to typists, clerks, and similar personnel who assist with an application.
>
> The word "with" appears before "the assignee" and "anyone to whom there is an obligation to assign" to make clear that the duty applies only to individuals, not to organizations. For instance, the duty of disclosure would not apply to a corporation or institution as such. However, it would apply to individuals within the corporation or institution who were substantively involved in the preparation or prosecution of the application, and actions by such individuals may affect the rights of the corporation or institution.

11. Further, MPEP section 2280 provides the following guidance regarding who has a duty of disclosure during reexamination proceedings as follows:

> The duty of disclosure in reexamination proceedings applies to the patent owner; to each attorney or agent who represents the patent owner, and to every other individual who is substantively involved on behalf of the patent owner. That duty is a continuing obligation on all such individuals throughout the proceeding. The continuing obligation during the reexamination proceeding is that any such individual to whom the duty applies who is aware of, or becomes aware of, patents or printed publications which (A) are material to patentability in a reexamination proceeding, and (B) which have not previously been made of record in the patent file, must bring such patents or printed publications to the attention of the Office.

12. Based on the above PTO guidance *individuals* have the duty to disclose information during both initial examination and reexamination. The duty also applies to individuals within corporations and institutions who are inventors or were substantively involved in the preparation and prosecution of an application and *the actions by such individuals may affect the rights of the corporation or institution*.

13. My opinions set forth in my initial report regarding the violations of the duty of disclosure by Mr. Doyle and Mr. Krueger during the prosecution of the '906 patent are unchanged by the addition of the University of California as a co-plaintiff.

14. Additionally, I note that at the time that the subject matter of the '906 patent was allegedly conceived, September 7 1993,[1] all three inventors listed on the '906 patent application were employed by the University of California. Mr. Doyle was the Director of the Center for Knowledge and Technology at the University of California's San Francisco campus[2] and Mr. Martin was the Assistant Director of the same facility.[3] Mr. Ang was also employed by the University in the same Center for Knowledge and Technology.[4]

15. Furthermore, the evidence of Mr. Doyle's extensive knowledge of the ViolaWWW browser and the warnings he received from others before the filing of the '906 patent application (on October 17, 1994) (see ¶ 175 of my initial report) occurred while Mr. Doyle was the Director of the Center for Knowledge and Technology at the University of California's San Francisco campus. This included his discussions with O'Reilly & Associates "people" regarding Viola, the email Dr. Doyle received from Mr. Raggett advising him to look into Viola, the multiple emails Dr. Doyle received from Pei Wei, the inventor and developer of Viola, in 1994 and 1995 stating that ViolaWWW had the capabilities of the alleged '906 invention and that Viola had been publicly released well prior to the conception of the '906 invention, and Mr. Doyle's reading of the Viola

[1] See Exhibit 13 of the Martin deposition of 8/19/11.
[2] See the Doyle Dep. Tr. of 2/29/2000 at 237:19-238:8 and the Doyle Dep. Tr. of 1/25/2000 at 183:24-185:7.
[3] See the Martin Dep. Tr. of 8/18/11 at 36:6-38:3.
[4] See the Ang Dep. Tr. of 7/22/11 at 492:10-15.

Article. As explained in my initial report, despite being warned that the ViolaWWW browser preceded the '906 invention and being informed of the capabilities of the ViolaWWW browser, Mr. Doyle failed to disclose any information about the ViolaWWW browser to the PTO during the prosecution of the '906 patent application.

16. Co-inventor David Martin was the Assistant Director of the Center for Knowledge and Technology at the University of California's San Francisco campus during the same time period described in the preceding paragraph. Mr. Martin hired and supervised an individual named Chris McRae who was also employed at the Center for Knowledge and Technology at the University of California's San Francisco campus during 1993 and 1994.[5] I have reviewed testimony from Mr. Chris McRae.[6] Mr. McRae was aware of the ViolaWWW browser at least as early as July of 1993.[7] He discussed the ViolaWWW browser with Mr. Martin and Cheong Ang (both co-inventors of the '906 patent) before he left the University of California San Francisco in December 1993.[8] More specifically, he testified that he told Mr. Martin that he had seen the Viola WWW browser,[9] including the drawing area widget in Viola, and that the idea that Mr. Martin and Dr. Doyle had was not patentable because Viola already had this technology.[10]

17. Mr. Martin also became aware of the ViolaWWW browser through his discussions with Mr. Doyle before they applied for the '906 patent. On May 19, 1994, he received an email inquiry from ViolaWWW developer Pei Wei wherein Pei Wei asked for donations of guest accounts to test Viola in exchange for an updated ViolaWWW

[5] See the McRae Dep. Tr. of 9/19/11 at 120:8-9, 161:15-22.
[6] See the McRae Dep. Tr. of 9/19/11 at 36:25-37:10.
[7] See the McRae Dep. Tr. of 9/19/11 at 87:15-88:23.
[8] See the McRae Dep. Tr. of 9/19/11 at 190:1-11; 199:6-10.
[9] See the McRae Dep. Tr. of 9/19/11 at 193:22-194:15.
[10] See the McRae Dep. Tr. of 9/19/11 at 93:1-22; 148:4-149:3.

executable. Mr. Martin replied to Pei Wei's inquiry stating that he would be willing to discuss providing a guest account on the University of California computer system.[11] That same day, Dr. Doyle forwarded an email from Dave Raggett to Mr. Martin. The email from Mr. Raggett informed Mr. Martin about the ViolaWWW browser, disclosed Viola's ability to display interactive objects embedded within webpages, and provided a location where Mr. Martin could download the Viola browser.[12]

18. As explained in my initial report, information about the ViolaWWW browser is "but-for" material to the examination of the '906 patent application.[13] As an inventor, Mr. Martin had a duty to disclose material information to the PTO under his duty of disclosure. He did not disclose information about the ViolaWWW to the PTO during the prosecution of the '906 patent applications. In fact he testified that he did not disclose the information about the ViolaWWW to the PTO because he relied on Mr. Doyle to determine that it was not relevant.[14] In my opinion Mr. Martin's failure to disclose the ViolaWWW browser information was a violation of his duty of disclosure.

19. Further, the ViolaWWW browser was developed by Mr. Pei Wei who was a former student at the University of California. When Pei Wei learned via a University of California press release dated August 30, 1994 that managers at the University of California claimed to have invented the subject matter of the '906 patent application he immediately informed Mr. Doyle that in fact the ViolaWWW browser he had earlier developed and publicly disclosed included the subject matter allegedly invented by Dr.

[11] See Exhibit 35 of the Martin deposition on 9/19/11.
[12] EOLASTX-0000025961.
[13] See section IV. D. of my initial report.
[14] See the Martin Dep. Tr. of 8/91/11 at 427:23-428:14.

Doyle and Mr. Martin.[15] As fully explained in my initial report Mr. Doyle failed to disclose the information he was aware of and received regarding the Pei Wei's prior development of the ViolaWWW browser and its capabilities to the PTO during the examination of the '906 patent application.[16]

20. As inventors, both Mr. Doyle and Mr. Martin signed an inventor's declaration as required by PTO regulations. [17] The declaration states that the inventors believed they were the original and first inventors of the claimed subject matter of the '906 application.[18] The declaration was made to complete the filing requirements of the application on behalf of the assignee, the University of California. Based on Mr. Doyle's communications with former University student, Pei Wei, and Dave Raggett and Mr. Martin's communications with Mr. McRae both Dr. Doyle and Mr. Martin had information regarding the earlier invented ViolaWWW browser prior to signing the declaration in the '906 application on November 22, 2005. Based on Dr. Phillips' analysis the ViolaWWW browser includes the subject matter of the claimed invention of the '906 patent and therefore Dr. Doyle and Mr. Martin were *not* the first to invent that subject matter. As such, the declaration signed by Doyle and Martin was false.

21. As named inventors Dr. Doyle and Mr. Martin were under a duty to disclose material information to the PTO during the examination of the '906 patent. As managers at the University of California at the time they allegedly conceived of the invention of the '906 patent, their actions, or in this case inactions (failure to disclose the ViolaWWW browser information), would affect the right of the patent owner or assignee,

[15] EOLASTX-0000061841.
[16] Sections II C & D.
[17] See 37 CFR 1.63.
[18] EOLASTX-0000007737.

the University of California, to enforce the '906 patent. Stated another way, if the Court finds that inventors Doyle, Martin, or anyone else substantively involved in the prosecution of the '906 patent withheld the ViolaWWW browser information with intent to deceive the PTO and that the ViolaWWW browser information was material, the '906 patent in not enforceable by either Eolas or the University of California.

22. It is my understanding that the University of California has not completed and is still producing documents in this matter. Also, I understand that to date the University of California has not produced certain pieces of prior art located in its libraries that Dr. Phillip's cites in his Supplemental Expert Report On Invalidity and which were never submitted to the USPTO during the prosecution and re-examinations of the '906 and '985 patents.[19] Therefore, I reserve the right to further supplement my opinions based upon the University of California's continued production.

B. The Court's Recent Construction of the Claim Term *Executable Application*

23. Additionally, I have been asked to review the term "executable application" as defined by the PTO and this Court. Specifically, I note that the Court has now construed the claim term "executable application" to mean, "any computer program code that is not the operating system or a utility that is launched to enable an end user to directly interact with data".[20]

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[19] *See* October 27, 2011 Supplemental Expert Report on Invalidity by R. Phillips at p. 25 (Ohtsu93 and Rowe92).

[20] Dkt. No. 914 at p. 11. I understand that the Court adopted this construction of the term "executable application" in view of the fact that the Illinois District Court and Federal Circuit construed this term of the '906 patent in this manner in the previous *Microsoft* litigation. *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1336-38 (Fed. Cir. 2005).

24. In the Office Action of September 27, 2005 in the first reexamination proceeding, the PTO examiner explained his construction of the term "executable application" in the context of interactive processing.[21] The examiner stated that executable application must be a separate application from the browser application.[22] Specifically, when examining the relationship between the interactive processing element and the executable application the examiner stated:

> Instant '906 independent claims 1 and 6 therefore require an operative coupling between the claimed "executable application" and the claimed "interactive processing" such that the claimed "interactive processing" must be enabled by an "executable application" that meets five explicitly claimed requirements:
>
> 1. The *executable application must be external to the first distributed multimedia document*.
>
> 2. The executable application must be automatically invoked by the browser application when the "embed text format" is parsed by the browser application.
>
> 3. The executable application must *execute on the client workstation*.
>
> 4. The executable application must display the object within the display area created at the first location within the portion of the first distributed hypermedia document being displayed in the first browser controlled window.
>
> 5. The executable application must enable interactive processing of the object within the display area created at the first location within the portion of the first distributed hypermedia document being displayed in the first browser-controlled window.[23]

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[21] EOLASTX-0000006893-6973 and January 20, 2006 Office Action EOLASTX-0000006974-7048.
[22] EOLASTX-0000006904 ("In contrast, the instant '906 claims explicitly require the 'interactive processing' to be enabled by an 'executable application' that is a separate application from the browser application.").
[23] EOLASTX-0000006905-06 (emphasis added).

The examiner used this understanding of the term "executable application" to distinguish the Berners-Lee, Raggett I, and Raggett II prior art from the claimed invention during the first reexamination.[24]

25. In the same action, the examiner eliminated ViolaWWW as a rejecting reference because he concluded that Viola scripts were not an "executable application". In his explanation, the examiner first reiterated his understanding of "executable application" as a separate binary code automatically invoked by the browser.[25] The examiner then differentiated Viola's computer code from executable applications because Viola uses a scripting language that is not written in binary code. [26]

26. After the completion of the re-examination proceeding which included the examiner's elimination of the Viola prior art, this Court construed the term "executable application," which is currently defined as described in Paragraph 23. I understand from Dr. Phillips that in Plaintiffs' application of this construction as part of its infringement case, Plaintiffs have not limited the "executable application" to just that, but rather includes scripts that are interpreted by the browser. This definition is significantly broader that the definition used by the examiner.

27. It is my opinion that the PTO construed the term "executable application" in a more narrow way than the Court has in this matter construed the term. By doing so the PTO eliminated prior art, including the ViolaWWW browser, that under this Court's

[24] EOLASTX-0000006906. Notably, during re-examination this art was distinguished based upon the PTO's interpretation that excluded scripts. EOLASTX-0000005839-41.
[25] EOLASTX-0000006951 ("To be "executable" the contents of the memory location pointed to by the program counter must contain an instruction in binary form.")
[26] EOLASTX-0000006951. The examiner concluded that Viola's scripting language was not an executable application because a script was not written in binary code.

interpretation would not be eliminated but would be material to the more broadly construed claims in this action.

C. Use of the Internet at the PTO

28. At the time the '906 patent application was under examination at the PTO, that is between October 1994 and November 1998, the PTO was in the initial stages of deploying Internet capability to patent examiners.[27] In July 1996 the PTO distributed a document entitled "Rules of the Road" setting forth policies and rules for employees when using PTO systems.[28] In early 1997, the PTO began the process of providing Internet access to PTO employees. Prior to that time PTO examiners did not have the capability to use the Internet to conduct prior art searches. Further, at that time by law, 35 U.S.C. §122, patent applications were considered confidential until such time as a patent may have issued from the application. Since communications and data transmitted on the Internet at that time were not encrypted or secure, examiners were instructed to restrict Internet search queries to general state of the art so as not to disclose confidential information in Internet search queries.[29] In June 1999, the PTO issued an Internet Usage Policy to PTO employees again reiterating that search queries must be limited to general state of the art and that all Internet prior art searches must be documented in accordance with procedures set forth in MPEP 719.05.[30]

29. Based on my experience at the PTO, during the time the '906 patent application was pending, the Internet was *not* widely used to do prior art searching and

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[27] Interim Internet Usage Policy, 1195 OG 89 (February 10, 1997) ("The Patent and Trademark Office (PTO) is in the process of providing Internet access to PTO employees.").
[28] *Id.*
[29] *Id.*
[30] Internet Usage Policy, 64 F.R. 33056 (June 21, 1999).

instead examiners used internal patent databases and commercial databases to search for prior art. Additionally, if the Internet was used to conduct a prior art search, examiners were required to document the search in the file history of the application. I note there is no evidence or documentation in the file history that an Internet search was conducted by the examiner during the original prosecution of the '906 patent application.

D. Lack of Testing Facilities at the PTO

30. The PTO does not have laboratories or testing facilities or equipment to independently verify or test products embodying inventions submitted in patent applications or other information submitted during the prosecution of a patent application. Therefore, based on my experience, the PTO would have had no specialty equipment to review and compile the source code submitted to the PTO on the CDs containing DX34 and DX37 during the reexamination proceedings of the '906 patent. There is no indication in the patent history that the examiner ever used a SunSparc Station or any special equipment to examine DX34 or DX37. The PTO would only have had a common PC, and therefore would only have had the ability to review the information via a common PC as described by Examiner Courtenay in the NIRC mailed on September 27, 2005 in the first reexamination of the '906 patent. As explained by Examiner Courtenay, the PTO determined that the code found on the CD that included DX34 and DX37 was to be considered a printed publication. Therefore the Examiner took the steps described in the NIRC to determine to what extent the information on the CD was relevant to the claims of the '906 patent. There is no evidence in the record that the Examiner ever attempted to compile the code on the CD. Nor does the examiner state

that he viewed or considered any demonstrations using the information contained on the CDs submitted during reexamination.

E. Incomplete Submission of Viola to the PTO

31. In my previous report, I explained that when Viola was submitted in the first instance to the USPTO as DX34 and DX37, it was not submitted in its entirety. Attorney Krueger submitted the corrected DX34 and DX37 without identifying the differences between the two submissions. Since that time, I have been provided a copy of the discs submitted to the PTO. The differences between the discs are critical from the examiner's standpoint for the following reasons.

32. I understand that Dr. Phillips has reviewed copies of the discs purported to be DX34 and DX37 that were submitted to the PTO during the first and second reexamination proceedings. I am informed by Dr. Phillips that the functionalities disclosed in the second submission of DX34 and DX37 would anticipate the claims of the '906 patent.

33. I understand from Dr. Phillips that the disc provided to the PTO in the first reexamination contained only Viola source code. The examiner noted that DX34 and DX37 were contained in a CD disc stored as an artifact associated with the Image File Wrapper for the reexamination.[31] The examiner noted the following traits of the two files contained in the originally submitted "Viola Code" disc:

> 1) viola930512.tar.gz.zip - this compressed file represents the earlier Viola source code, also referred to as "DX34" in the CAFC opinion (Docket no. 04-1234, March 2, 2005, see also IFW "Reexam .Notice of Court Action" dated April 11, 2005; see especially page 11 as numbered in the printout (corresponding to IFW page 16 of 32). The

[31] EOLASTX-0000006941.

> viola930512.tar.gz.zip (i.e., "DX34") file, when unzipped, contains 1,027 files in 35 folders consisting of 8 total megabytes in size.
>
> 2) violaTOGO.tar.Z.zip - this compressed file represents the later Viola source code, also referred to as "DX37" in the CAFC opinion. The violaTOGO.tar.Z.zip (i.e., "DX37"") file, when unzipped, contains 1,030 files in 34 folders consisting of 7.7 total megabytes in size.[32]

Dr. Phillips informs me that this information corresponds to the first disc that was submitted to the USPTO. In order to view any of the files in a human readable text format on his common PC the examiner would need to extract both of the .tar files creating a series of folders and files which could be examined in text format. My understanding from discussions with Dr. Phillips is that the examiner only used dtsearch to review DX37, and the examiner failed to disclose the terms used in the search.

34. Also, I understand from Dr. Phillips that the second disc contained different versions of DX37 and DX34. Dr. Phillips informed me that the second submission of DX34 included more than just the "viola930512.tar.gz.zip" file referred to by the examiner as "DX34." Likewise, Dr. Phillips informed me that the primary differences between the first and second submission of DX34 include:

- an SGML file for Viola's browser named "sgmls-1_1_91_tar";
- a hypermedia document explaining many of the missing files from the original submission named "Note";
- various documents and pictures explaining the Viola browser and showing the browser in action contained within the "docs" folder; and
- the vplot executable application

35. Similarly, I understand from Dr. Phillips that the second submission of DX37 contained more than just the "violaTOGO.tar.Z.zip" file. The second submission

[32] EOLASTX-0000006942.

of DX37 included over 150 pages of emails related to the Viola browser in a file named "viola-email" and a timeline which shows the early development of key Viola features in a file named "Viola timeline."

36. After the above described versions of DX34 and DX37 were submitted to the USPTO during the second reexamination proceeding a subsequent Office Action was issued. However, the patent examiner never considered the re-submitted versions of Viola when issuing this Action.[33] Instead the examiner quoted and relied on the review of DX34 and DX37 by the examiner in the first-reexamination where the first examiner considered only the incomplete versions of DX34 and DX37.[34] There is no evidence in the record that indicates that any PTO examiner considered the information contained on the second set of discs containing different versions of DX34 and DX37, which includes the information that Dr. Phillips states anticipates the claims of the '906 patent. As stated above the only evidence in the PTO record indicating that DX34 or DX37 were considered was contained in the record of the first reexamination in which examiner Courtenay considered the incomplete versions of DX34 and DX37.

37. As mentioned in my initial report (¶ 169), I am informed by Dr. Phillips that in addition to reviewing an incomplete version of DX37, Examiner Courtenay's search and review of the DX37 CD failed to uncover material portions of the code, including plotting portions and plot.v. Therefore, there is no indication that Examiner Courtenay considered the *material* portion of the DX37 source code. I am further informed by Dr. Phillips that DX34 and DX37 considered by Examiner Courtenay contained the following applications: Clock, Vicon, Query, Wave fun, and Noodle

[33] EOLASTX-0000003316.
[34] EOLASTX-0000003316.

Doodles. The analysis by Examiner Courtenay in the first re-examination only specified that the examiner considered the Clock application, which was the first application on the list. Examiner Courtenay did not mention in his Action any of the other applications or their attributes.[35] Of particular note, the Noodle Doodles application is not discussed in examiner Courtenay's analysis, and I am informed by Dr. Phillips that the Noodle Doodles application is material to patentability.

Respectfully submitted,

Date: November 14, 2011

Nicholas P. Godici

Nicholas P. Godici

[35] EOLASTX-0000006943-EOLASTX-0000006952

Exhibit A

Nicholas P. Godici
Executive Advisor
Birch, Stewart, Kolasch, & Birch, LLP

Professional Experience

Birch, Stewart, Kolasch & Birch, LLP, Falls Church, VA.

Executive Advisor (April 2005-present)
Responsibilities include business development, public relations, expert witness, and IP consulting.

United States Patent and Trademark Office, Department of Commerce, Washington D.C.

Commissioner for Patents (March 2000-March 2005)
Appointed by the Secretary of Commerce to a five-year term as Commissioner for Patents in 2000. Direct report to the Under Secretary Of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. Served as the Chief Operating Officer for all aspects of patent related operations with the mission to properly implement the patent laws and regulations of the United States. Oversaw a budget of over $750 million dollars and a staff of over 5000 employees. Areas of responsibility included strategic planning, budget formulation and execution, information technology systems, staffing, employee development, labor management relations, customer outreach, congressional relations, public advisory committee relations, and patent policy formulation. Testified before the United States House and Senate on various intellectual property matters.

Acting Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (January 2001-December 2001)
Served as Acting Under Secretary during the change in Administration in 2001. As the head of the Agency, chief executive officer and a direct report to the Secretary of Commerce, was responsible for all aspects of intellectual property policy and operations for the Administration. Represented the United States in international meetings at the World Intellectual Property Organization (WIPO) and with other national IP offices. Lead the "heads of office" meeting with the President of the European Patent Organization (EPO) and the Commissioner of the Japan Patent Office (JPO). Interacted with Congress, other agencies within the Administration, and major IP bar and trade associations on legal issues, operations of the USPTO, and national security.

Expert Advisor at the USPTO (July-September 2009)
At the request of the Secretary of Commerce I accepted a temporary assignment as an expert advisor to the Secretary and the Under Secretary of Commerce to strengthen the management structure of the USPTO and provide an up-to-date assessment of the challenges facing the agency.

Various Positions Within the USPTO (June 1972-March 2000)
Held various positions with the USPTO starting with patent examiner in the mechanical arts, Supervisory Patent Examiner, Group Director, Deputy Assistant Commissioner for Patents, and Acting Assistant Commissioner for Patents. Lectured in the Patent Academy for many years. Responsibilities included oversight for Patent Cooperation Treaty (PCT) operations which included the processing of all international applications. Assumed responsibility for the entire patent examining corps as Deputy Assistant Commissioner for Patents in 1997.

Education

B.S., Pennsylvania State University, Engineering Mechanics, 1972

Certificate of Advanced Public Management, The Maxwell School of Citizenship and Public Affairs, Syracuse University, 1999.

Professional Affiliations and Awards

Elected fellow of the National Academy of Public Administration (NAPA) 2001.

Outstanding Engineering Alumni, Pennsylvania State University, 2002

Member of the Industrial and Professional Advisory Committee for the College of Engineering at Pennsylvania State University.2001-2003.

Named “One of the most important people in intellectual property today” by Legal Times Magazine in 2001.

Registered to Practice before the United States Patent and Trademark Office

Publications

“Supporting a Knowledge Based Economy, Software Patents”, Managing Intellectual Property Magazine, Innovation and Invention Focus 2004.

“Adequately Funding the USPTO: A Critical Problem that Must be Solved”, Medical Innovation & Business, Summer 2010-Volume 2- Issue 2

Exhibit B

List of Cases in Which Nicholas P. Godici Has Served as an Expert Witness and Given Testimony (either at deposition or trial) Within the Last Four Years

ConnecTel LLC v Cisco Systems, Inc., United States District Court for the Eastern District of Texas, Civil Action 2:24-cv-00396-LED

Certain Flash Memory Devices and Components Thereof, and Products Containing Such Devices and Components, United States International Trade Commission, Investigation No. 337-TA-552 (Hynix v Toshiba)

Forgent Networks, Inc. v EchoStar Technologies, Inc., Scientific-Atlanta, Inc, Motorola, Inc., and Digeo, Inc., United States District Court For The Eastern District Of Texas, Consolidated Civil Action No. 6:06-cv-208

New York University v AutoDesk, Inc., United States District Court For The Southern District Of New York, Civil Action No. 06-cv-5274 (JSR) (MHD)

Trading Technologies Int'l, Inc. v eSpeed, Inc., eSpeed International, Ltd., Ecco LLC, and EccoWare, Ltd, United States District Court For The Northern District of Illinois, Civil Action 2:06-CV-156

American Calcar, Inc. v American Honda Motor Co., Inc. and Honda Of America Mfg., Inc., United States District Court for the Southern District of California, Civil No. 06-2433-DMS (CAB)

Lazare Kaplan International Inc. v Photoscribe Technologies, Inc. et al., United States District Court for the Southern District of New York, Civil Action No. 06-4005 (TPG) (GWG)

Repligen Corporation and the Regents of the University of Michigan, v Bristol-Myers Squibb Company, United States District Court for the Eastern District of Texas, Case No. 2:06-CV-004-TJW

Net2Phone, Inc., v eBay, Inc., Skype Technologies SA, Skype Inc., and John Does 1-10, United States District Court District of New Jersey, Civil Action No. 06-2469 (KSH)

In re K-Dur Antitrust Litigation, United States District Court District of New Jersey, Civil Action No. 01-1652 (JAG)

Bally Gaming, Inc. v IGT and Sierra Design Group, United States District Court for the District of Nevada, Case No. 3:06-CV-00483-Erc-(RAM)

Cross Atlantic Capital Partners Inc. v Facebook, Inc., United States District Court for the Eastern District of Pennsylvania, CA No. 07-CV-02768-JP

PDL Biopharma Inc. v SUN Pharmaceuticals Industries, United States District Court District of New Jersey, CA No. 07-1788 (KSH)(PS)

Medtronic Sofamor Danek v Globus Medical Inc., United States District Court for the Eastern District of Pennsylvania, CA No. 06-CV-4248-JG

Atlantic Research Marketing Systems, Inc. v Troy Industries, Inc., United States District Court for the District of Massachusetts, C.A. No. 07-cv-11576

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Certain Vein Harvesting Surgical Systems and Components Thereof, United States International Trade Commission, Investigation No. 337-TA-645, (Marquet v Terumo)

Degelman Industries LTD., v Pro-Tech Welding and Fabricating, Inc. and Michael P. Weagley, United States District Court Western District of New York, Civ. Action No.: 06-CV-6346

Conrad O. Gardner v. Toyota Motor Corp. et al., United States District Court Western District of Washington at Seattle, No. C 08-0632 RAJ

DataTreasury Corp. v. Wells Fargo & Co. et al, United States District Court for the Eastern District of Texas Marshall Division, case 2:06-cv-72DF

Semiconductor Energy Laboratory Co. v. Samsung Electronics Co. et al., United States District Court Western District of Wisconsin, civil action no. 3:09-cv-00001-BBC

Phillip M. Adams & Associates v. Fujitsu Limited et al., United States District Court for the Northern District of Utah, Civil No. 1:05-CV-64 TS

Software Tree LLC, v. Red Hat et al., United States District Court for the Eastern District of Texas, civil action no. 6:09-cv-00097

B.Braun Melsungen AG et al. v. Terumo Medical Corp. et al.,United States District Court for the District of Delaware, civil action no. 1:09-cv-00347

Ebay Inc. v. IDT Corp, IDT Telecom, Inc., Union Telecard Alliance LLC, and Net2phone, Inc., United States District Court Western District of Arkansas, civil action 4:08-cv-04015

The Chamberlain Group, Inc. and Johnson Controls Interiors LLC v. Lear Corporation, United States District Court for the Northern District of Illinois, civil action no. 05-C-3449

Kathrein-Werke KG, v. RYMSA, United States District Court Northern District of Illinois, 07 C 2921

SYNQOR Inc., v. Artesyn Technologies, Inc., United States District Court Eastern District of Texas, civil action no. 2:07-CV-497-TJW-CE

Joy MM Delaware Inc., v. Cincinnati Mine Machinery Co., United States District Court Western District of Pennsylvania, civil action no. 2:09-cv-01415- GLL

Halo Electronics, Inc., v. Pulse Engineering Inc., United States District Court District of Nevada, case no. 2:07-cv-00331-PMP-PAL

Wi-Lan, Inc. v. Acer et al, and Westell Technologies Inc .et al, United States District Court Eastern District of Texas, case no 2:07-cv-473-TJW and 2:07-cv-474-TJW

Mformation Technologies, Inc. v. Research In Motion Limited et al, United States District Court Northern District of California , case no. 08-cv-4990

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US Rubber Recycling, Inc., v. ECORE International Inc., United States District Court Central District of California, Case No. CV 09-9516 SJO

Bedrock Computer Technologies LLC v. Google et al, United States District Court Eastern District of Texas Tyler Division, Civil Action No. 6:09-cv-269-LED

Halliburton Energy Services, Inc. v. Weatherford International, Inc., United States District Court Northern District of Texas Dallas Division, civil action no. 3:10-cv-02595-N

Sever Technology Inc. v. American Power Conversion Corp., United States District Court District of Nevada, case no. 3:06-CV-698-LRH-VPC

Apple Inc. v. Samsung Electronics Co., United States District Court, Northern District of California, San Jose Division, case no. 11-cv-01846-LHK

* I served as an expert witness for the underlined party

Exhibit C
Materials Considered

PATENT INFORMATION:

5,838,906 Patent

7,599,985 Patent

5,838,906 Patent File Wrapper

'831 Patent File Re-Exam

'858 Patent File Re-Exam

7,599,985 Patent File Wrapper

Documents submitted to USPTO during 1st & 2nd Patent Re-examinations

PLEADINGS:

Plaintiff's Second Amended Complaint for Patent Infringement [Docket 517]

Defendant Yahoo! Inc.'s Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 561]

Defendant eBay Incorporated's Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 562]

Defendant Amazon.com, Inc.'s Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 563]

Eolas' Reply to Defendant Yahoo! Inc.'s Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 578]

Eolas' Reply to Defendant eBay Incorporated's Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 579]

Eolas' Reply to Defendant Amazon.com, Inc.'s Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 580]

Defendant Microsoft's Local Rule 56.1(b)(3) Response to Plaintiffs' Statement of Undisputed Facts, and Microsoft's Statement of Additional Material Facts, in Opposition to Plaintiffs' Motion for Summary Judgment on Inequitable Conduct (with Exhibits) [EOLASTX-0000044448, EOLASTX-E-00000226121_HC-AEO]

Plaintiffs' Memorandum of Law in Support of Their Motion for Summary Judgment of Inequitable Conduct and Plaintiffs' Opposition to Defendant's Motion for Leave to Amend Its Answer and Counterclaim [Eolas v. Microsoft, Docket No. 686]

Plaintiffs' Reply Brief in Support of Their Motion for Summary Judgment on Inequitable Conduct [Eolas v. Microsoft, Docket No. 813]

Plaintiffs' Local Rule 56.1(a) Response to Defendant's Statement of Facts Regarding Plaintiffs' Motion for Summary Judgment on Inequitable Conduct [Eolas v. Microsoft, Docket No. 822]

Plaintiffs' Statement of Undisputed Facts in Support of Their Motion for Summary Judgment on Inequitable Conduct [Eolas v. Microsoft, Docket No. 685]

Plaintiffs' Motion for Summary Judgment [Eolas v. Microsoft, Docket No. 679]

Defendant Microsoft's Opposition to Plaintiffs' Motion for Summary Judgment on Inequitable Conduct [Eolas v. Microsoft, Docket No. 801]

Declaration of Richard A. Cederoth [Eolas v. Microsoft, Docket No. 800]

Defendant Microsoft's Motion for Leave to Amend Its Answer and Counterclaim [Eolas v. Microsoft, Docket No. 670]

Plaintiffs' Memorandum of Law in Support of Their Motion for Summary Judgment on Inequitable Conduct and Plaintiffs' Opposition to Defendant's Motion for Leave to Amend Its Answer and Counterclaim [Eolas v. Microsoft, Docket No. 686]

Defendant Microsoft's Reply Memorandum In Support of Its Motion for Leave to Amend Its Answer and Counterclaim [Eolas v. Microsoft, Docket No. 691]

Plaintiffs' Sur-Reply Memorandum of Law in Opposition to Defendants' Motion for Leave to Amend Its Answer and Counterclaim [Eolas v. Microsoft, Docket No. 699]

Ruling on the Defense of Inequitable Conduct [Eolas v. Microsoft, Docket No. 491]

Defendant Yahoo! Inc.s Answer, Affirmative Defenses, and Counterclaims to Plaintiffs' Third Amended Patent Infringement Complaint [Docket No. 1025]

Plaintiffs' Third Amended Complaint for Patent Infringement [Docket No. 891]

Memorandum Opinion and Order [Docket No. 914]

Order [Docket No. 989]

DEPOSITION TRANSCRIPTS:

Eolas v. Microsoft – Depositions of Michael Doyle [EOLASTX-E-0000000178, 180, 181, 182, 185, 186]

Eolas v. Microsoft – Depositions of Pei Wei

Eolas v. Microsoft – Deposition of Charles Krueger [EOLASTX-0000318685]

Deposition of Charles Kulas [6/15/2011]

Deposition of Dr. Michael Doyle [6/24/2011]

Deposition of Dr. Michael Doyle [6/30/2011]

Deposition of Charles Krueger [6/14/2011]

Revised Deposition of Dr. Michael Doyle [8/10/2011]

Revised Deposition of Dr. Michael Doyle [8/11/2011]

Deposition of David Martin [8/18/2011]

Deposition of David Martin [8/19/2011]

Deposition of Christopher McRae [9/19/2011]

Revised Deposition of Pei Wei [10/5/2011]

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858 Re-exam [EOLASTX-0000003004-3806]

831 Re-exam [EOLASTX-0000004542-7068]

906 Patent Prosecution [EOLASTX-0000007069-8338]

985 Patent Prosecution [EOLASTX-0000008339-9072]

Subject: How to Reach Cheong Ang - Martha Leuhrmann email to Michael Doyle, 8/29/94 [Defendant's Trial Exhibit 825, EOLASTX-0000026094]

RE: Testing accounts for ViolaWWW – David Martin email to Pei Wei 5/20/94 [Defendant's Trial Exhibit 89, EOLASTX-0000025958-25959]

Index of Michael D. Doyle E-Mails [Defendant's Trial Exhibit 703B, EOLASTX-0000026059-26092]

Re: the <EMBED> tag in HTML+ - Michael Doyle message to David Martin 5/20/94 [Defendant's Trial Exhibit 90, EOLASTX-0000025961-25962]

7,599,985 Patent [EOLASTX-E-0002374729_HC-AEO]

Re: Eolas Acquires Milestone Internet Software Patent – Pei Wei 8/21/95 [Defendant's Trial Exhibit 135, EOLASTX-0000022474-22475]

Re: Viola.tar.z for ftping – Pei Wei email to James Kempf 5/31/1993 [Defendant's Trial Exhibit 41, EOLASTX-0000065008]

Re: ViolaWWW – Pei Wei message to weber@eit.com, wei@ora.com 10/17/93 [Defendant's Trial Exhibit 62, EOLASTX-0000022428]

Re: ViolaWWW alpha – John Cahill message to wei@xcf.berkeley.edu 10/21/93 [Defendant's Trial Exhibit 63, EOLASTX-0000022429]

Re: ViolaWWW beta release is available – Pei Wei posting 2/25/1994 [Defendant's Trial Exhibit 73, EOLASTX-0000022436-22437]

Viola Stuff [Defendant's Trial Exhibit 147, EOLASTX-00000168065-168090]

"A Brief Overview of the VIOLA Engine, and its Applications" [Defendant's Trial Exhibit 93A, EOLASTX-0000025964-25974]

Re: FYI…press release – Michael Doyle posting 8/31/94 [Defendant's Trial Exhibit 100, EOLASTX-0000168171]

FYI…press release – Michael Doyle posting 8/30/94 [Defendant's Trial Exhibit 826, EOLASTX-0000022772-22773]

Re: FYI…press release – Pei Wei message to www-vrml@wired.com 8/31/94 [Defendant's Trial Exhibit 98, EOLASTX-0000061841]

Re: FYI…press release – Michael Doyle message to Pei Wei 8/31/94 [Defendant's Trial Exhibit 99, EOLASTX-0000035966]

Re: FYI…press release – Michael Doyle posting 8/31/94 [Defendant's Trial Exhibit 101, EOLASTX-0000025980-25981]

Re: FYI…press release – Michael Doyle posting 8/31/94 [Defendant's Trial Exhibit 102, EOLASTX-0000043735-43736]

Re: FYI…press release – Pei Wei message to Michael Doyle 8/31/94 [Defendant's Trial Exhibit 107, EOLASTX-0000042939-42940]

Re: FYI…press release – Pei Wei posting 9/1/94 [Defendant's Trial Exhibit 111, EOLASTX-0000025989-25990]

Viola Information from Stanford Computer Forum WWW Workshop – September 20-21, 1994 [Defendant's Trial Exhibit 121, EOLASTX-0000168057-168063]

Viola Information from Stanford Computer Forum WWW Workshop – September 20-21, 1994 [Defendant's Trial Exhibit 122, EOLASTX-0000168154-168165]

Eolas Acquires Milestone Internet Software Patent – Info@eolas.com to www-talk@w3.org 8/21/95 [Defendant's Trial Exhibit 196, EOLASTX-0000026057]

Eolas Acquires Milestone Internet Software Patent – Pei Wei to www-talk@w3.org 8/21/95 [Defendant's Trial Exhibit 136, EOLASTX-0000026004]

Eolas Acquires Milestone Internet Software Patent – Pei Wei to Michael Doyle 8/21/95 [Defendant's Trial Exhibit 138, EOLASTX-0000026006]

Eolas v. Microsoft - Supplemental Expert Invalidity Report of John Kelly [EOLASTX-0000098503-98637]

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9/27/2005 Notice of Intent to Issue Ex Parte Reexammination Certificate [EOLASTX-0000006893-6969]

OTHER PRODUCTION:

RE: Hot Java is here! And it *rocks* - Michael Doyle message to ses@tipper.oit.unc.edu 3/27/95 [Defendant's Trial Exhibit 127, PH_001_0000597952]

Eolas v. Microsoft - Expert Invalidity Report of John Kelly [PH_001_0000035135-35184]

Portable Document Format Reference Manual [ADBE0195521]

TRIAL TRANSCRIPTS:

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Eolas v. Microsoft Trial Transcript

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Claim Chart for Adobe Showing Indirect Infringement of the 906 Patent Through PDF Authoring Tools and Direct and/or Indirect Infringement Via Its PDF Viewers

Claim Chart for Adobe Showing Indirect Infringement of the 906 Patent Through Flash Authoring Tools and Direct and Indirect Infringement Via Players

Claim Chart for Adobe Showing Indirect Infringement of the 985 Patent Through PDF Authoring Tools and Direct and/or Indirect Infringement Via Its PDF Viewers

Claim Chart for Adobe Showing Indirect Infringement of the 985 Patent Through Flash Authoring Tools and Direct and Indirect Infringement Via Players

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Email from John Dawes re: Acrobat and UCSF [5/17/93]

Email from Christopher McRae to www-talk re: HTML spec [6/21/93]

Email from Christopher McRae to David Martin re: Adobe Acrobat beta agreement? [6/2/93]

Email from Christopher McRae to John Dawes re: Acrobat and UCSF [5/14/93]

Email from David Martin to Christopher McRae re: Adobe Acrobat Beta Agreement? [6/21/93]

Email from David Martin to Daniel Miles Kehoe re: Adobe's PDF [7/20/93]

Email from David Martin to Marc Solomon re: [kehoe@fortuity.sf.ca.us (Daniel Miles Kehoe): Adobe's PDF] [7/19/93]

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[http://www.w3.org/History/19921103-hypertext/hypertext/Products/MediaView/Mail.html]

Email from Callilliau@cernnext.cern.ch to tim@cernnext.cern.ch, www-talk@nxoc01.cern.ch, luotonen@ re: WWWWorkshop [7/16/93]

Email from Daniel Miles Kehoe to cailliau@cernnext.cern.ch re: Adobe's PDF [7/16/93]

Email from Christopher McRae to David Martin re: Adobe Acrobat Beta Agreement? [6/18/93]

A Brief History of Adobe Acrobat [ADBE0196062-0196071]

Eolas v. The Regents of the University of California 399 F.3d 1325

REPORTS:

Richard Phillips Report - Appendix C – video demonstrations

Richard Phillips Supplemental Invalidity Report dated 10/27/2011