

EXHIBIT A

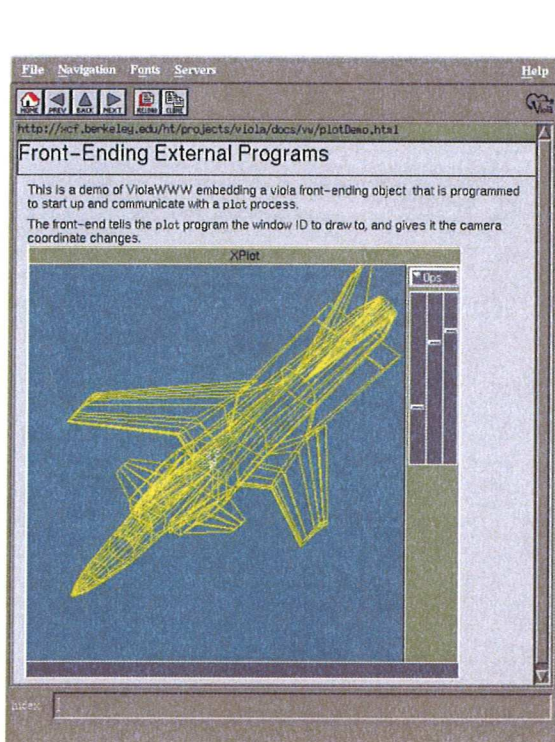
PART 4 OF 4

129. On information and belief, Krueger made the determination, prior to the issuance of the '906 patent, to not disclose to the PTO the information he received regarding the ViolaWWW browser.

D. The ViolaWWW browser was material to the patentability of the '906 patent

130. The ViolaWWW browser was material to the patentability of the claimed inventions in the '906 patent.

131. There is a remarkable similarity between the ViolaWWW browser and the preferred embodiment of the '906 patent:



ViolaWWW

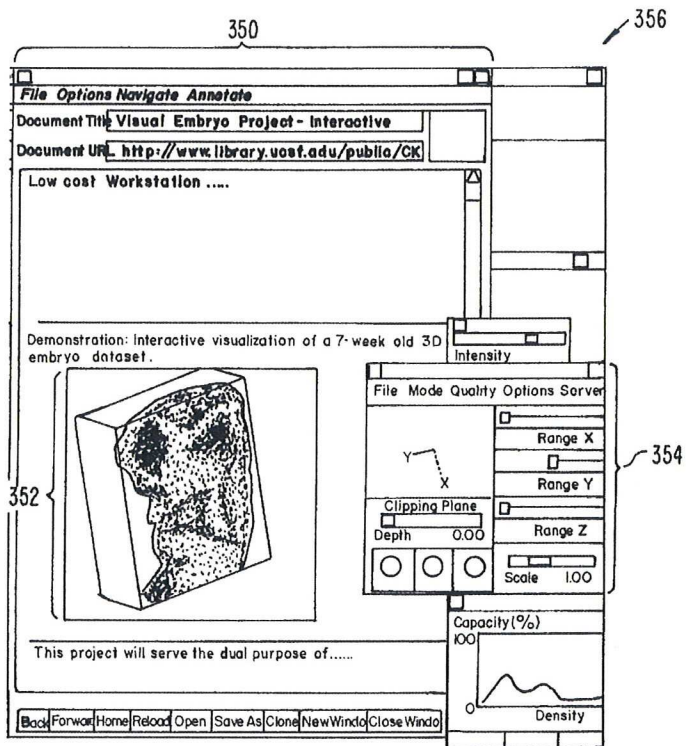


Fig. 9 of U.S. Patent No. 5,838,906

Both the ViolaWWW browser (on the left) and the preferred embodiment of the '906 patent (on the right) enabled a user to interact with a 3-dimensional image embedded in the middle of a webpage. In the ViolaWWW screenshot above, there are three slide controls to the right of the

embedded image that move up and down; these rotate the embedded image on the X, Y, and Z axes. Similarly, in the preferred embodiment of the '906 patent shown above, box 354 has three slide controls to the right of the embedded image that rotate the image on the X, Y, and Z axes. Thus, ViolaWWW, like the '906 patent, teaches a browser capable of displaying embedded interactive objects.

132. The Manual of Patent Examining Procedure in force at the time the application for the '906 patent was filed included the following statements:

Materiality is defined in 37 CFR 1.56(b) and discussed herein at MPEP § 2001.05. In addition to prior art such as patents and publications, 37 CFR 1.56 includes, for example, information on ***possible prior public uses***, sales, offers to sell, derived knowledge, ***prior invention by another***, inventorship conflicts, and the like, [emphasis in bold added]

133. The Manual of Patent Examining Procedure in force today contains similar language:

Materiality is defined in 37 CFR 1.56(b) and discussed herein at MPEP § 2001.05. In addition to prior art such as patents and publications, 37 CFR 1.56 includes, for example, information on >enablement,< ***possible prior public uses***, sales, offers to sell, derived knowledge, ***prior invention by another***, inventorship conflicts, and the like.

>“Materiality is not limited to prior art but embraces *any* information that a reasonable examiner would be substantially likely to consider important in deciding whether to allow an application to issue as a patent.” *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 326 F.3d 1226, 1234, 66 USPQ2d 1481, 1486 (Fed. Cir. 2003) (emphasis in original) (finding article which was not prior art to be material to enablement issue).< [emphasis in bold added]

134. The Federal Circuit has confirmed that the ViolaWWW browser was material to the patentability of the claimed inventions in the '906 patent.

135. The Federal Circuit held that a reasonable jury could find at least claims 1 and 6 of the '906 patent anticipated by the ViolaWWW browser under 35 U.S.C. § 102(a), (b), and/or (g). *See* 399 F.3d 1325, 1329, 1332–35 (Fed. Cir. 2005).

136. The Federal Circuit held that “Wei’s May 7, 1993 demonstration to two Sun Microsystems employees without confidentiality agreements was a public use under [35 U.S.C. § 102(b)].” 399 F.3d 1325, 1335 (Fed. Cir. 2005).

137. The Federal Circuit held that a reasonable jury could find at least claims 1 and 6 of the '906 patent obvious in light of the ViolaWWW browser. *See* 399 F.3d 1325, 1335 (Fed. Cir. 2005).

138. The Federal Circuit held that a district court could find that Doyle had committed inequitable conduct by failing to disclose the ViolaWWW browser to the Patent Office. *See* 399 F.3d 1325, 1336 (Fed. Cir. 2005).

139. On information and belief, Krueger was aware that the Federal Circuit confirmed that the ViolaWWW browser was material to the patentability of the claimed invention in the '906 patent, but he still did not discuss the ViolaWWW browser further with Doyle.

140. On information and belief, even after Krueger was aware that the Federal Circuit confirmed that the ViolaWWW browser was material to the patentability of the claimed invention in the '906 patent he did not disclose any additional information to help the Patent Office consider ViolaWWW browser.

141. The Patent Office has also confirmed that the ViolaWWW browser was material to the patentability of the claimed inventions in the '906 patent.

142. On or about July 30, 2007, during the 2005 reexamination of the '906 patent, the Patent Office rejected all claims of the '906 patent as being anticipated by DX95, which includes a copy of the text found in Pei Wei's August 1994 Viola paper, *see supra* ¶ 48.

143. Pei Wei had told Doyle on August 31, 1994, about the August 1994 Viola paper, *see supra* ¶¶ 44-48, and Doyle had downloaded and read that paper the same day, *see supra* ¶¶ 49, 55-57, yet Doyle never disclosed the Viola paper to the Patent Office during the original examination of the '906 patent.

144. The fact that Doyle may have conceived of the inventions claimed in the '906 patent before August 16, 1994, does not render the August 1994 Viola paper immaterial, because the Viola paper describes features of the ViolaWWW browser that existed before the invention date for the '906 patent and/or over one year before the application for the '906 patent was filed.

145. For example, the plotting demo described in the August 1994 Viola paper was part of the ViolaWWW browser software that was demonstrated to Sun Microsystems on May 7, 1993 — over one year before the application for the '906 patent was filed. *See supra* ¶¶ 51-54.

146. None of the claimed inventions in the '906 patent was conceived before August 1993.

147. Thus, the ViolaWWW browser software that was described in the August 1994 Viola paper and demonstrated to Sun Microsystems on May 7, 1993, also corroborates anticipation of the claimed inventions in the '906 patent under 35 U.S.C. § 102(g).

148. Neither reexamination of the '906 patent considered whether the claimed inventions were anticipated by "Wei's May 7, 1993 demonstration to two Sun Microsystems employees without confidentiality agreements" which the Federal Circuit has held was a "public use under [35 U.S.C. § 102(b)]." 399 F.3d 1325, 1335 (Fed. Cir. 2005).

149. In an *ex parte* reexamination, “[r]ejections will not be based on matters other than patents or printed publications, such as public use.” *See* Manual of Patent Examining Procedure (MPEP) § 2258(I).

150. On information and belief, Krueger knew that the Patent Office could not consider public use art during an *ex parte* reexamination.

151. The Patent Office had the authority during the original examination of the ‘906 patent to issue a rejection based on the “public use” provision of 35 U.S.C. § 102(b), but Doyle and Krueger never disclosed to the Patent Office during that examination the evidence they had in their possession that the ViolaWWW browser was in “public use” more than one year before the application for the ‘906 patent was filed.

152. On information and belief, the Patent Office would not have allowed the claims of the ‘906 patent if Doyle or Krueger had not engaged in inequitable conduct and instead had fulfilled their duty of candor and good faith in dealing with the Patent Office.

E. Doyle and Krueger intended to deceive the Patent Office during prosecution of the ‘906 patent

153. During prosecution of application number 08/324,443, which matured into the ‘906 patent, Doyle and Krueger withheld extensive evidence about the ViolaWWW browser.

154. For example, Doyle failed to disclose the following material information: the message from Raggett about the ViolaWWW browser and embedded objects, *see supra* ¶¶ 37-40; the communications with Pei Wei in 1994 about the ViolaWWW browser and the embedded interactive plotting demo that was in public use in May 1993, *see supra* ¶¶ 43-61; the August 1994 Viola paper describing the ViolaWWW browser and the embedded interactive plotting demo that was in public use in May 1993, *see supra* ¶¶ 44-48; the communications with Pei Wei in 1995 about the ViolaWWW browser and the embedded interactive plotting demo that was in

public use in May 1993 and again at the Wizards conference in July 1993, *see supra* ¶¶ 73-91; the contents of the “Viola stuff” folder that Doyle maintained, which included information about the Wizards conference in July 1993 and links to the ViolaWWW browser software, including source code for the embedded interactive plotting demo that was in public use in May 1993, *see supra* ¶¶ 95-116; and Pei Wei’s talk at Stanford in September 1994 about the embedded interactive plotting demo that was in public use in May 1993, *see supra* ¶¶ 117-123.

155. On information and belief, Krueger failed to disclose a number of material references regarding the ViolaWWW browser including at least the August 1994 Viola paper, Doyle’s communications with Pei Wei in 1994 about the ViolaWWW browser and the embedded interactive plotting demo that was in public use in May 1993; the Viola paper describing the ViolaWWW browser and the embedded interactive plotting demo that was in public use in May 1993; and the contents of the “Viola stuff” folder that Doyle maintained and was faxed to Krueger in August of 1998, which included information about the Wizards conference in July 1993 and links to the ViolaWWW browser software, including source code for the embedded interactive plotting demo that was in public use in May 1993.

156. Doyle and Krueger withheld information about the ViolaWWW browser with the specific intent to deceive the Patent Office.

157. Doyle had a financial interest in the patentability of the claimed inventions in the ‘906 patent. *See supra* ¶¶ 22-30.

158. The ViolaWWW browser threatened the patentability of the claimed inventions in the ‘906 patent, and thus threatened Doyle’s financial interests.

159. On information and belief, Doyle was personally involved in the prosecution of application number 08/324,443, which matured into the ‘906 patent.

160. For example, Doyle signed a declaration on or about November 22, 1994, stating that he was an inventor and acknowledging his duty of candor and good faith in dealing with the Patent Office. *See supra* ¶ 70.

161. On or about January 2, 1997, Doyle signed a declaration that was submitted to the Patent Office in an effort to establish an earlier date of invention for the claims of the '906 patent application.

162. On or about February 24, 1997, Doyle and Krueger participated in an examiner interview in an effort to secure allowance of the claims of the '906 patent application.

163. On or about May 27, 1997, Doyle signed a 28-page declaration (including an appendix) that was submitted to the Patent Office in an effort to establish himself as an "expert" in the subject matter of the claimed invention and to overcome various obviousness rejections to the claims of the '906 patent application.

164. On or about October 29, 1997, Doyle signed another declaration that was submitted to the Patent Office in an effort to establish an earlier date of invention for the claims of the '906 patent application.

165. On or about November 6, 1997, Doyle and Krueger participated in another examiner interview in an effort to secure allowance of the claims of the '906 patent application.

166. Krueger lacked a technical degree in computer science or electrical engineering, and thus he relied on Doyle to understand and describe the subject matter of the claimed invention and the prior art.

167. Doyle personally reviewed and approved papers submitted to the Patent Office during prosecution of the '906 patent.

168. Despite Doyle and Krueger's extensive personal involvement in the prosecution of application number 08/324,443, which matured into the '906 patent, Doyle and Krueger never disclosed the ViolaWWW browser to the Patent Office during that prosecution.

169. On information and belief, the circumstances of Doyle and Krueger's actions demonstrate an intent to deceive the Patent Office.

170. For example, during prosecution of the '906 patent, Doyle and Krueger made arguments for patentability that could not have been made if he had disclosed the ViolaWWW browser to the Patent Office.

171. On or about May 6, 1996, the Patent Office rejected several claims as being anticipated by the University of Southern California's "Mercury Project."

172. On or about August 6, 1996, a response to this rejection was submitted to the Patent Office.

173. Doyle personally reviewed and approved the response submitted to the Patent Office on or about August 6, 1996.

174. The response submitted on or about August 6, 1996, included the following statements:

The claimed combination is fundamentally different from the Mercury Project. In the claimed combination, the external object and executable object are embedded by reference in the HTML document and the object is displayed and processed within the same window where a portion of the original document is displayed. In the Mercury Project information is passed back to the server and a new document is generated and displayed. There is no display and processing the external object within the window in which a portion of the original document is displayed.

175. If Doyle or Krueger had disclosed the ViolaWWW prior art to the Patent Office, on information and belief, it would not have been possible to distinguish the claims of the '906 patent over the prior art on the basis that the prior art failed to disclose "display[ing] and

processing the external object within the window in which a portion of the original document is displayed.”

176. On or about March 26, 1997, the Patent Office rejected several claims as being obvious in light of “Khoyi et al. US Patent 5,206,951” in combination with other prior art.

177. On or about June 2, 1997, a response to this rejection was submitted to the Patent Office.

178. Doyle and Krueger personally reviewed and approved the response submitted to the Patent Office on or about June 2, 1997.

179. The response submitted on or about June 2, 1997, included the following statements:

[T]here is no suggestion in Khoyi of modifying Mosaic so that an external application . . . is invoked to display and interactively process the object within the document window while the document is displayed by Mosaic in the same window.

180. If Doyle or Krueger had disclosed the ViolaWWW prior art to the Patent Office, on information and belief, it would not have been possible to distinguish the claims of the ‘906 patent over the prior art on the basis that the prior art failed to disclose “an external application [that] is invoked to display and interactively process the object within the document window while the document is displayed by [the browser] in the same window.”

181. On or about August 25, 1997, the Patent Office rejected several claims as being obvious in light of “Koppolu et al. US Patent 5,581,686” in combination with other prior art.

182. On or about December 23, 1997, a response to this rejection was submitted to the Patent Office.

183. On information and belief, Doyle and Krueger personally reviewed and approved the response submitted to the Patent Office on or about December 23, 1997.

184. The response submitted on or about December 23, 1997, included the following statements:

[T]here is no disclosure or suggestion in Mosaic or Koppolu of automatically invoking an external application when an embed text format is parsed. Each of those references require user input, specifically clicking with a mouse pointer, to activate external applications to allow display and interaction with an external object.

185. If Doyle or Krueger had disclosed the ViolaWWW prior art to the Patent Office, on information and belief, it would not have been possible to distinguish the claims of the '906 patent on the basis that the prior art failed to disclose "automatically invoking an external application when an embed text format is parsed."

186. On information and belief, Doyle and Krueger's repeated use of arguments that could not have been made if Doyle or Krueger had disclosed the ViolaWWW prior art demonstrates an intent to deceive the Patent Office.

187. Doyle's intent to deceive the Patent Office is also demonstrated by comparing what he told an audience of web developers on or about March 27, 1995, to what he told the Patent Office on or about May 27, 1997.

188. On or about March 27, 1995, Doyle responded to a post on the publicly-accessible WWW-talk e-mail distribution list in which another author had written, under the heading "HotJava is here! And it *rocks*," "It's the most exciting thing to happen to the Web since viola." Doyle's response included the following statements:

If you take a close look at Java, you'll realize that it bears a close similarity to Viola, since the "applets" must be coded from a predefined language, downloaded and locally interpreted.

189. On or about May 27, 1997, Doyle signed a declaration that was submitted to the Patent Office. Doyle's declaration included the following statements:

The three exemplary products which incorporate the features of the claimed invention include Netscape Navigator 2.0 (or newer versions), Java, from Sun Microsystems, and ActiveX, from Microsoft. . . . [T]he success of these products is directly attributable to the claimed features of the invention.

....

A good indicator that Sun Microsystems felt that enabling interactivity in Web pages was the key feature of Java is given in the first chapter of "Hooked on Java," which was written by members of the original Java development team. They say, "With applets written in the Java programming language, Web users can design Web pages that include animation, graphics, games, and other special effects **Most important, Java applets can make Web pages highly interactive.**"

This statement shows that the developers of Java felt that the most important feature of the Java technology was the ability of Java to allow an embed text format (the applet tag) within a Web document to be parsed by a Web browser to automatically invoke an external executable application to execute on the client workstation in order to display an external object and enable interactive processing of that object within a display window created at the applet tag's location within the hypermedia document being displayed in the browser-controlled window. The book's authors further emphasize the novelty and nonobviousness of this technology when they say, "Quite simply, Java-powered pages are Web pages that have Java applets embedded in them. They are also the Web pages with the coolest special effects around Remember, **you need a Java-compatible Web browser such as HotJava to view and hear these pages and to interact with them; otherwise, all you'll access is static Web pages** minus the special effects."

....

The above citations, as well as the additional details given in Appendix A, provide ample evidence of the commercial success of products incorporating features of the claimed invention, as well as evidence of the widespread acclaim that these products have garnered for the technical innovations which the features of the claimed invention allowed them to provide. They further show that the successes of these products was a direct result of the features of the claimed invention, which they incorporated *through implementation of an embed text format that is parsed by a Web browser to automatically invoke an external executable*

application to execute on the client workstation in order to display an external object and enable interactive processing of that object within a display window created at the embed text format's location within the hypermedia document being displayed in the browser-controlled window.

190. The declaration Doyle signed on or about May 27, 1997, made no mention of Viola or the ViolaWWW browser.

191. Doyle and Krueger's disclosure of Java for purposes of commercial success, but not the ViolaWWW browser which Doyle knew was prior art that existed over one year before the application for the '906 patent was filed, demonstrates, on information and belief, an intent to deceive the Patent Office, especially given Doyle's belief that Viola was similar to Java and that Java embodied the claimed invention.

F. Between 1999 and 2003, Doyle learned about additional Viola prior art, and learned that an expert in the field believed that the plotting demo for the ViolaWWW browser anticipated the asserted claims of the '906 patent

192. Between 1999 and 2003, a third party disputed the validity of the '906 patent.

193. On information and belief, Doyle personally guided Eolas through the litigation concerning the validity of the '906 patent.

194. Throughout the litigation, the third party asserted that the plotting demo involving the ViolaWWW browser anticipated the asserted claims of the '906 patent.

195. The plotting demo relied on by the third party to prove anticipation of the asserted claims of the '906 patent was the same plotting demo that Pei Wei had repeatedly described to Doyle, *see supra* ¶¶ 44–54, 74–78, and which the Federal Circuit has held was a “public use” on May 7, 1993, 399 F.3d 1325, 1335 (Fed. Cir. 2005), and which Doyle himself came across from his own research into Viola, *see supra* ¶¶ 108–123.

196. In its contentions that the plotting demo involving the ViolaWWW browser anticipated the asserted claims of the '906 patent, the third party specifically identified the VOBJF tag, the plot.v file, and the vplot executable application.

197. For example, on or about December 14, 2001, the third party served an expert report by Dr. John P.J. Kelly, that included the following statements:

When ViolaWWW encountered the tag <VOBJF>/usr/work/viola/apps/plot.v</VOBJF>, an embed text format specifying the location of an object, it looked in the specified path for at least part of the object, parsed the path, and automatically loaded the object into the program. The file (plot.v) also contained type information associated with the object, such as the name and location of an external executable application, vplot, that also was automatically invoked to enable display of and user interaction with the object at a location within a display area within the document being displayed in the browser-controlled window corresponding to the location of the embed text format in the document. Subsequently, when the user interacted with the object, ViolaWWW sent messages to vplot based on the user input and received output from vplot, thus updating the display of the object.

198. Similarly, at a trial in 2003 concerning the validity of the '906 patent, Dr. Kelly testified that the plotting demo involving the ViolaWWW browser anticipated the asserted claims of the '906 patent, and he specifically identified the VOBJF tag, the plot.v file, and the vplot executable application for purposes of his anticipation analysis.

199. Pei Wei also testified at the trial in 2003 about the ViolaWWW browser and the plotting demo.

200. At the trial, exhibit DX34 included source code for the ViolaWWW browser dated May 12, 1993.

201. At the trial, exhibit DX37 included source code for the ViolaWWW browser dated May 27, 1993.

202. DX34 contains the code for the plotting demo that Pei Wei demonstrated to Sun Microsystems on May 7, 1993, in Northern California.

203. DX37 contains code for a plotting demo similar to the plotting demo in DX34.

204. On May 31, 1993, Pei Wei posted DX37 on a publicly-accessible Internet site and notified an engineer at Sun Microsystems that DX37 was available for downloading.

205. Under 35 U.S.C. § 102(b), DX37 was a “printed publication” over one year before the application for the ‘906 patent was filed.

206. Dr. Kelly testified that the plotting demo in DX34 and DX37 anticipates the asserted claims of the ‘906 patent. Dr. Kelly specifically identified the VOBJF tag, the plot.v file, and the vplot executable application for purposes of his anticipation analysis of DX37.

207. The Federal Circuit has held that Dr. Kelly’s testimony would allow a reasonable jury to conclude that DX37 anticipates at least claims 1 and 6 of the ‘906 patent. *See* 399 F.3d 1325, 1335 (Fed. Cir. 2005).

208. Neither Dr. Kelly nor the third party ever relied on anything other than the plotting demo involving plot.v and vplot to prove anticipation by the ViolaWWW browser.

209. For example, Dr. Kelly never discussed clock.v during the trial in July and August 2003.

210. On information and belief, Doyle attended the trial involving the third party held in July and August 2003.

211. On information and belief, by the end of the trial in August 2003, Doyle knew about and understood the third party’s contention that the plotting demo involving the ViolaWWW browser in DX37 anticipated the asserted claims of the ‘906 patent.

212. On information and belief, by the end of the trial in August 2003, Doyle knew about and understood Pei Wei's testimony that on May 31, 1993 — over one year before the application for the '906 patent was filed — he posted DX37 on a publicly-accessible Internet site and notified an engineer at Sun Microsystems that DX37 was available for downloading.

G. During the 2003 reexamination of the '906 patent, Doyle and Krueger concealed material information about the ViolaWWW plotting demo that Pei Wei and an expert had repeatedly contended anticipated the '906 patent

213. On or about October 30, 2003, the Director of the Patent Office initiated a reexamination of the '906 patent. The control number for this reexamination was 90/006,831.

214. During the 2003 reexamination, Doyle and Krueger withheld information about the ViolaWWW browser with, on information and belief, the specific intent to deceive the Patent Office.

215. Doyle had a financial interest in the patentability of the claimed inventions in the '906 patent. *See supra* ¶¶ 22–30.

216. The ViolaWWW browser threatened the patentability of the claimed inventions in the '906 patent, and thus threatened Doyle's financial interests.

217. On information and belief, Doyle and Krueger were personally involved in the 2003 reexamination of the '906 patent.

218. For example, on or about April 27, 2004, Doyle and Krueger participated in an examiner interview in an effort to confirm the patentability of the claims of the '906 patent application. Doyle gave the examiner a presentation supported by approximately 22 slides prepared by Doyle and Krueger, none of which discussed DX37 or the ViolaWWW browser. Neither Doyle nor Krueger mentioned the ViolaWWW browser during the interview.

219. On or about May 6, 2004, Doyle signed a declaration that was submitted to the Patent Office in an effort to confirm the patentability of the claims of the '906 patent application. This declaration made no mention of DX37 or the ViolaWWW browser.

220. On or about August 18, 2005, Doyle and Krueger participated in an examiner interview in an effort to confirm the patentability of the claims of the '906 patent application. Doyle gave the examiner a presentation supported by approximately 36 slides, none of which discussed DX37 or the ViolaWWW browser.

221. During the 2003 reexamination, Doyle and Krueger submitted selected information from the litigation with the third party concerning the validity of the '906 patent, but he withheld information that would have identified for the examiner the key features of the prior art ViolaWWW browser and how they matched up to the asserted claims of the '906 patent. This proved critical during the 2003 reexamination because when the examiner decided to look at the source code for the ViolaWWW browser, he missed the key points.

222. On or about December 30, 2003, Doyle and Krueger submitted to the Patent Office a CD containing two compressed zip files, one for the "DX34" version of the ViolaWWW source code dated May 12, 1993, and the other for the "DX37" version of the ViolaWWW source code dated May 27, 1993.

223. The compressed zip file for DX34 that Doyle and Krueger submitted to the Patent Office was named `viola930512.tar.gz.zip`. When unzipped, it contained 1,027 files in 35 folders consisting of 8 total megabytes in size.

224. The compressed zip file for DX37 that Doyle and Krueger submitted to the Patent Office was named `violaTOGO.tar.Z.zip`. When unzipped, it contained 1,030 files in 34 folders consisting of 7.7 total megabytes in size.

225. DX34 and DX37 contained source code for the ViolaWWW browser.

226. Source code cannot be executed by a computer. Source code must be compiled into binary code before it can be executed by a computer.

227. Without the compiled binary code, and without a suitable computer capable of executing that binary code (such as a Sun SPARCstation from the early 1990s), the Patent Office had no practical way to see the ViolaWWW browser in operation.

228. Given the voluminous nature of the contents of DX34 and DX37, and the practical inability of the Patent Office to run the ViolaWWW browser on a computer, it was especially important for Doyle and Krueger to be candid with the Patent Office about the contents of DX34 and DX37 so that the Patent Office could focus on the relevant files.

229. On information and belief, Doyle and Krueger were not candid and instead withheld material information that would have assisted the Patent Office in understanding the contents of DX34 and DX37.

230. On information and belief, Doyle and Krueger did not disclose the full contents of DX34 and DX37 in their entirety to the Patent Office during the first reexamination of the '906 patent.

231. On information and belief, the full contents of DX34 and DX37 were not submitted in their entirety until the Invention Disclosure Statement filed on November 1, 2006.

232. For example, during the 2003 reexamination, neither Doyle nor Krueger disclosed to the Patent Office the trial testimony of Pei Wei, who testified about the plotting demo in DX34 and DX37, *see supra* ¶¶ 199-205, nor did either Doyle or Kreuger disclose the trial testimony of Dr. Kelly, who testified that the plotting demo in DX34 and DX37 anticipated the asserted claims of the '906 patent, *see supra* ¶¶ 198, 206, nor did either disclose that Dr. Kelly

specifically identified the VOBJF tag, the plot.v file, and the vplot executable application for purposes of his anticipation analysis, *see supra* ¶ 197.

233. On March 2, 2005 — while the 2003 reexamination was still pending — the Federal Circuit held that Dr. Kelly’s testimony would allow a reasonable jury to conclude that DX37 anticipates at least claims 1 and 6 of the ‘906 patent. 399 F.3d 1325, 1335 (Fed. Cir. 2005).

234. Even after the Federal Circuit’s decision, however, Doyle and Krueger still did not disclose Dr. Kelly’s testimony to the Patent Office during the 2003 reexamination, nor did they disclose to the Patent Office that Dr. Kelly’s anticipation analysis relied upon the VOBJF tag, the plot.v file, and the vplot executable application.

235. On or about September 27, 2005, the examiner issued a statement for reasons of patentability in which the examiner confirmed the patentability of claims 1–10 of the ‘906 patent.

236. The examiner’s statement never discussed the plotting demo that Dr. Kelly had testified anticipated the asserted claims of the ‘906 patent.

237. When the examiner considered DX37, the examiner did not know where to look or what to look for. There were too many files in DX37 for the examiner to read himself. Thus the examiner was forced to resort to running text searches across all the files in DX37 in the hope of stumbling across relevant information.

238. The examiner used the “dtSearch” program to index and text search all DX37 files that contained textual content. *See* <http://www.dtsearch.com/>.

239. It is unclear what words the examiner searched for or how he came up with his search terms.

240. On information and belief, Doyle knew precisely what to look for, but he never told the examiner. For example, if Doyle or Krueger had told the examiner to look for plot.v, the examiner's text searches would have quickly found the plotting demo that Dr. Kelly had testified anticipated the asserted claims of the '906 patent.

241. The examiner's text searches did not lead him to the plotting demo, but instead led him to a clock application that used the file clock.v.

242. The file clock.v is a script file that displays the image of a clock. The clock application does not involve any separate executable application. It just involves a webpage and the clock.v script file.

243. The examiner reasoned that a script file like clock.v does not satisfy the "executable application" requirement of the claims of the '906 patent, and thus the examiner concluded that DX37 does not anticipate the asserted claims of the '906 patent.

244. The ViolaWWW source code teaches two ways of creating interactive webpages using embedded applications. One way is by using a simple script file, such as clock.v. All that is required is a webpage (such as violaApps.html) and the script file (such as clock.v). No binary executable application is involved. The other way taught by the ViolaWWW source code does use a binary executable application (such as vplot) in addition to a webpage and a file that contains the object (such as plot.v). The examiner did not consider this second way during the 2003 reexamination; he only considered the first way, and thus erroneously confirmed the patentability of the asserted claims of the '906 patent.

245. The examiner's reasons for patentability included the following statements:

The Viola system uses "C-like" Viola scripts that must be INTERPRETED by the browser and then TRANSLATED or CONVERTED into binary native executable machine code that can be understood by the CPU. Alternately, the Viola script is

precompiled into intermediate byte-code form and the byte-code is interpreted (i.e., translated) into binary native executable machine code at runtime. This extra step of translation results in an unavoidable performance penalty, as interpreted applications run much slower than compiled native binary executable applications.

Accordingly, the “C-like” Viola scripts (or corresponding byte-code representations) are not “executable applications”

246. The examiner’s reasoning overlooked the fact that the plotting demo in DX37 does use a separate executable application: vplot.

247. On information and belief, Doyle and Krueger knew that the plotting demo used a separate executable application, but Doyle and Krueger did not bring this fact to the examiner’s attention and instead allowed the examiner to confirm the patentability of the claims of the ‘906 patent on the basis of an incomplete understanding of DX37.

248. On information and belief, Doyle and Krueger knew that the plotting demo used a separate executable application for at least the following reasons:

- The August 1994 Viola paper, which states “This next mini application front-ends a graphing process (on the same machine as the viola process)” and which shows the plot of a fighter jet in a window titled “XPlot.” *See supra* ¶¶ 48-49.
- Pei Wei’s message to Doyle on September 1, 1994, which included the following statements: “[A]s for the plotting demo, it actually is really just a front-end that fires up a back-end plotting program (and the point is that that back-end could very well be running on a remote super computer instead of the localhost). For that demo, there is a simple protocol such that the front-end app could pass an X window ID to the back-end, and the back-end draws

the graphics directly onto the window *violaWWW* has opened for it.” *See supra* ¶ 61.

- The source code listed in the “Viola stuff” file included the file *plotDemo.html*, which states, “This is a demo of *ViolaWWW* embedding a *viola* front-ending object that is programmed to start up and communicate with a plot process. The front-end tells the plot program the window ID to draw to, and gives it the camera coordinate changes.” When the file *plotDemo.html* is parsed, it shows the plot of a fighter jet in a window titled “*XPlot*.” *See supra* ¶¶ 108-110.
- Pei Wei’s presentation at Stanford in September 1994, which included the following statements: “The next example is a front-end application to a backend. And the back-end is what actually does the computation and the drawing.” Included with the presentation was a screenshot of the *ViolaWWW* browser after parsing the file *plotDemo.html*. The screenshot shows the plot of a fighter jet in a window titled “*XPlot*.” The text in the webpage states, “This is a demo of *ViolaWWW* embedding a *viola* front-ending object that is programmed to start up and communicate with a plot process. The front-end tells the plot program the window ID to draw to, and gives it the camera coordinate changes.” *See supra* ¶ 118.
- The trial testimony of Pei Wei. *See supra* ¶ 199.
- The expert opinion of Dr. Kelly. *See supra* ¶¶ 197-198, 206.

249. Doyle and Krueger’s failure to tell the examiner about the *vplot* and *plot.v* files, and failure to disclose documents from the litigation that identified how Dr. Kelly matched up

the plotting demo in DX37 with the claims of the '906 patent, both alone and in combination with Doyle and Krueger's prior failure to disclose the ViolaWWW browser during the original prosecution of the '906 patent, constituted a knowing and intentional violation of their duty of candor and good faith in dealing with the Patent Office.

250. On information and belief, the Patent Office would not have confirmed the patentability of the claims of the '906 patent that were the subject of the 2003 reexamination if Doyle and Krueger had not engaged in inequitable conduct and instead had fulfilled their duty of candor and good faith in dealing with the Patent Office.

H. Doyle and Krueger's inequitable conduct during the 2003 reexamination infected the 2005 reexamination

251. On or about December 22, 2005, a third party filed a request to reexamine the '906 patent.

252. On or about February 9, 2006, the Patent Office granted the request to reexamine the '906 patent. The control number for this reexamination was 90/007,858.

253. Doyle had a financial interest in the patentability of the claimed inventions in the '906 patent. *See supra* ¶¶ 22–30.

254. The ViolaWWW browser threatened the patentability of the claimed inventions in the '906 patent, and thus threatened Doyle's financial interests.

255. On information and belief, Doyle and Krueger were personally involved in the 2005 reexamination of the '906 patent.

256. For example, on or about September 6, 2007, Doyle and Krueger participated in an examiner interview in an effort to confirm the patentability of the claims of the '906 patent application.

257. On or about October 1, 2007, Doyle submitted a declaration to the Patent Office in an effort to establish an earlier date of invention for the claims of the '906 patent application.

258. On or about May 9, 2008, Doyle and Krueger participated in another examiner interview in an effort to confirm the patentability of the claims of the '906 patent application.

259. On or about June 3, 2008, Doyle and Krueger participated in another examiner interview in an effort to confirm the patentability of the claims of the '906 patent application.

260. Doyle and Krueger's inequitable conduct during the 2003 reexamination infected the 2005 reexamination.

261. Although Doyle and Krueger disclosed material information about the ViolaWWW browser to the Patent Office during the 2005 reexamination, by that time it was too late.

262. For example, Doyle and Krueger disclosed the August 1994 Viola paper to the Patent Office on or about August 21, 2006.

263. This was the first time Doyle and Krueger had disclosed the August 1994 Viola paper to the Patent Office.

264. On information and belief, Doyle knew about the Viola paper no later than August 31, 1994, *see supra* ¶¶ 44–49, 56, but Doyle waited over 10 years — and two prosecutions of the '906 patent — to disclose that paper to the Patent Office.

265. On information and belief, Krueger knew about the August 1994 Viola paper no later than August of 1998, but waited 8 years — and two prosecutions of the '906 patent — to disclose that paper to the Patent Office

266. Shortly after Doyle and Krueger disclosed the August 1994 Viola Paper to the Patent Office during the 2005 reexamination, the Patent Office rejected all claims of the '906 patent.

267. In particular, on or about July 30, 2007, the Patent Office rejected all claims of the '906 patent as being anticipated by DX95, which includes a copy of the text found in Pei Wei's August 1994 Viola paper, *see supra* ¶ 48.

268. The rejection based on the August 1994 Viola paper confirms that the ViolaWWW browser was material prior art.

269. Doyle and Krueger did not respond to the merits of the rejection based on the August 1994 Viola paper. Instead Doyle filed a declaration asserting that his date of invention was before August 16, 1994.

270. In response to Doyle's declaration, the examiner withdrew the rejection based on the August 1994 Viola paper.

271. The 2005 examiner could have entered a new rejection based on DX37, which was a printed publication before the alleged conception of the inventions claimed in the '906 patent, but the 2005 examiner did not independently examine DX37 because the 2003 examiner had already concluded that DX37 did not invalidate the asserted claims of the '906 patent.

272. The conclusions about DX37 reached in the 2003 reexamination were erroneous due to Doyle and Krueger's inequitable conduct during that reexamination. *See supra* ¶¶ 229-250.

273. Thus, Doyle and Krueger's inequitable conduct during the 2003 reexamination infected the 2005 reexamination.

III. **Doyle submitted false statements about the secondary considerations of non-obviousness**

274. During the original prosecution of the '906 patent, Doyle submitted a declaration to the Patent Office containing false and misleading statements in an effort to obtain allowance of the claims.

275. Specifically, on or about June 2, 1997, Doyle submitted to the Patent Office a sworn declaration executed on or about May 27, 1997, for the purpose of overcoming the examiner's rejection on March 26, 1997.

276. On page 12 of the declaration, Doyle asserted that his claimed invention would not have been obvious over the cited prior art in view of "secondary considerations, including, in part, commercial success of products incorporating features of the claimed invention and industry recognition of the innovative nature of these products."

277. In support of his assertion, Doyle declared to the Patent Office that Sun Microsystems and Netscape had incorporated his invention into their Java software and Navigator Web browser, respectively. He stated: "Approximately 12 to 18 months after the applicants initially demonstrated the first Web plug-in and applet technology to the founders of Netscape and engineers employed by Sun Microsystems in November and December of 1993, as described in reference #4 from Appendix A (Dr. Dobb's Journal, 2/96), both Netscape and Sun released software products that incorporated features of the claimed invention"

278. On information and belief, this statement was false. Neither Doyle nor any of the other named inventors of the '906 patent demonstrated Web plug-in technology to any of the founders of Netscape in November or December of 1993.

279. On information and belief, when Doyle made these statements under oath, he also did not know whether any engineer employed by Sun Microsystems ever saw any of his demonstrations in November or December of 1993.

280. Doyle made these same false assertions in slides that he prepared and presented to the examiner in a personal interview on or about February 24, 1997. On a slide entitled “Relevant History of DHOE” (Doyle’s name for his invention), Doyle included as a bullet point: “1993 Demos to Sun & Netscape’s Founders.”

281. Doyle’s false statements in his declaration were material to the patentability of the pending claims. These statements purported to provide evidence of copying by others and thus objective evidence of nonobviousness, a factor to be considered in determining whether an alleged invention is patentable over the prior art. Without these false assertions, Doyle had no support for his argument that Netscape and Sun copied his alleged invention or that his technology was responsible for their commercial success.

282. By making these false statements under oath to the Patent Office, on information and belief, Doyle intended to mislead the Patent Office to believe that responsible persons at Netscape and Sun saw his alleged invention, appreciated its supposed merits, and therefore incorporated it into the Navigator browser and Java. Moreover, by making these false statements, Doyle, on information and belief, was trying to convince the Patent Office that the Netscape and Sun products succeeded because they incorporated his alleged invention.

283. Doyle’s submission of false statements under oath in his declaration to the Patent Office constituted a knowing and intentional violation of his duty of candor and good faith in dealing with the Patent Office.

IV. Conclusion

284. A judicial determination of the respective rights of the parties with respect to the unenforceability of the claims of the ‘906 Patent is now necessary and appropriate under 28 U.S.C. § 2201.

COUNT IV

285. Staples incorporates by reference the allegations contained in Paragraphs 1 to 5 of its Counterclaims.

286. An actual controversy exists between the parties with respect to the alleged infringement '985 Patent.

287. Although Eolas alleges in its Complaint that Staples has directly and/or indirectly infringed the claims of the '985 Patent, Staples has not directly and/or indirectly infringed, and does not directly and/or indirectly infringe, any claim of the '985 Patent.

288. A judicial determination of the respective rights of the parties with respect to the infringement of the claims of the '985 Patent is now necessary and appropriate under 28 U.S.C. § 2201.

COUNT V

289. Staples incorporates by reference the allegations contained in Paragraphs 1 to 5 of its Counterclaims.

290. An actual controversy exists between the parties with respect to the invalidity of the '985 Patent.

291. Although Eolas alleges in its Complaint that the '985 Patent was duly and legally issued by the United States Patent and Trademark Office after full and fair examination, each and every claim of the '985 Patent is invalid for failure to comply with the patent laws, including, but not limited to, 35 U.S.C. §§ 101, 102, 103, 112, and 113.

292. A judicial determination of the respective rights of the parties with respect to the infringement of the claims of the '985 Patent is now necessary and appropriate under 28 U.S.C. §2201.

COUNT VI

293. Staples incorporates by reference the allegations contained in Paragraphs 1 to 5 of its Counterclaims.

294. An actual controversy exists between the parties with respect to the unenforceability of the '985 Patent.

295. Although Eolas alleges in its Complaint that the '985 Patent was duly and legally issued by the United States Patent and Trademark Office after full and fair examination, each and every claim of the '985 Patent is unenforceable due to inequitable conduct before the United States Patent and Trademark Office.

296. Staples incorporates by reference the allegations contained in Paragraphs 17 to 268 of its Counterclaims.

297. The actions of Doyle and Krueger demonstrate a broad pattern of inequitable conduct that infected the prosecution of the '906 patent, the reexaminations of the '906 patent, and the prosecution of the '985 patent.

298. The application that matured into the '985 patent was filed on August 9, 2002.

299. The application number for the '985 patent was 10/217,955. This application was a continuation of a continuation of the application that had matured into the '906 patent.

300. Eolas had and still has rights to the patent application that matured into the '985 patent.

301. On information and belief, Doyle was personally involved in the prosecution of the '985 patent at the same time that he had a financial interest in Eolas.

302. On information and belief, Doyle knew that Eolas could assert the '985 patent in litigation to seek substantial settlements and/or damage awards, and thus the prosecution of the '985 patent was relevant to Doyle's financial interest in Eolas.

303. Doyle and his co-inventors are entitled to receive a portion of any royalties paid to The Regents of the University of California related to the '985 patent, and for this reason as well the prosecution of the '985 patent was relevant to Doyle's financial interests.

304. The claims at issue during prosecution of the '985 patent were similar to the claims at issue during the reexaminations of the '906 patent.

305. Accordingly, the information that Doyle and Krueger withheld during prosecution of the '906 patent was material to the patentability of the claims at issue during prosecution of the '985 patent for the same reasons previously stated.

306. As a result of the similarity between the claims at issue during prosecution of the '985 patent, and the claims of the '906 patent, the Patent Office issued a "double patenting" rejection during prosecution of the '985 patent. The rejection was issued on or about July 20, 2004.

307. To overcome the "double patenting" rejection during prosecution of the '985 patent, a terminal disclaimer was filed on or about March 7, 2005. As a result of the terminal disclaimer, the '985 patent may be in force up until November 17, 2015, the date on which the '906 patent will expire.

308. For at least this reason, Doyle and Krueger's inequitable conduct during the prosecution of the '906 patent infected the prosecution of the '985 patent.

309. On or about May 5, 2005, the Patent Office suspended prosecution of the '985 patent in light of the 2003 reexamination of the '906 patent. The Patent Office determined that the outcome of the 2003 reexamination had a material bearing on the patentability of the claims at issue during prosecution of the '985 patent.

310. For at least this reason, Doyle and Krueger's inequitable conduct during the 2003 reexamination of the '906 patent infected the prosecution of the '985 patent.

311. On or about January 18, 2006, the Patent Office suspended prosecution of the '985 patent in light of the 2005 reexamination of the '906 patent. The Patent Office determined that the outcome of the 2005 reexamination had a material bearing on the patentability of the claims at issue during prosecution of the '985 patent.

312. For at least this reason, Doyle and Krueger's inequitable conduct during the 2005 reexamination of the '906 patent infected the prosecution of the '985 patent.

313. On or about April 11, 2008, the claims at issue during prosecution of the '985 patent were amended to claim substantially the same subject matter claimed in the '906 patent.

314. Accordingly, the Patent Office did not undertake a separate substantive examination of the patentability of the claims in the '985 patent. Instead, the Patent Office simply applied the results of the prosecution of the '906 patent (including the results of the two reexaminations of the '906 patent) to the '985 patent.

315. For at least this reason, Doyle and Krueger's inequitable conduct during the prosecution and reexaminations of the '906 patent infected the prosecution of the '985 patent.

316. On or about November 13, 2008, a request was filed to lift the stay on the prosecution of the '985 patent in light of the completion of the 2005 reexamination of the '906 patent.

317. On or about March 20, 2009, the Patent Office allowed the claims in the '985 patent for the same reasons set forth by the Patent Office during the reexaminations of the '906 patent.

318. The examiner's reasons for allowance patent included the following statement: "[T]he claims [of the '985 patent] are allowable as the claims contain the subject matter deemed allowable in both Re exam 90/006,831 [the 2003 reexamination of the '906 patent] and Re exam 90/007,838 [the 2005 reexamination of the '906 patent] for the same reasons as set forth in the NIRC of the two Re exams."

319. The examiner's reasons for allowance of the '985 patent confirm that Doyle and Krueger's inequitable conduct during the prosecution and reexaminations of the '906 patent infected the prosecution of the '985 patent.

320. Eolas filed the complaint in this action on October 6, 2009, the same day that the '985 patent issued.

321. As a result of Doyle and Krueger's pattern of inequitable conduct, Eolas came to this Court with unclean hands.

322. As a result of Doyle and Krueger's inequitable conduct, and the unclean hands of Eolas, the '906 and '985 patents are unenforceable.

323. A judicial determination of the respective rights of the parties with respect to the unenforceability of the claims of the '985 Patent is now necessary and appropriate under 28 U.S.C. § 2201.

REQUESTS FOR RELIEF

Staples respectfully requests that this Court grant the following relief:

- A. Dismissal of the Second Amended Complaint for Patent Infringement against Staples with prejudice;
- B. A declaration that Plaintiff recovers nothing from Staples;
- C. An order enjoining Plaintiff, its owners, agents, employees, attorneys, and representatives, and any successors or assigns thereof, from charging or asserting infringement of any claim of the '906 Patent and the '985 Patent against Staples or anyone in privity with Staples;

- D. An award to Staples of its reasonable attorneys' fees and costs;
- E. A declaration that Staples has not infringed any claim of the '906 Patent, either directly or indirectly;
- F. A declaration that each and every claim of the '906 Patent is invalid;
- G. A declaration that each and every claim of the '906 Patent is unenforceable;
- H. A declaration that Staples has not infringed any claim of '985 Patent, either directly or indirectly;
- I. A declaration that each and every claim of the '985 Patent is invalid;
- J. A declaration that each and every claim of the '985 Patent is unenforceable; and
- K. Such other and further relief as the Court deems just and proper.

JURY DEMAND

Under Federal Rule of Civil Procedure 38(b), Staples respectfully requests a trial by jury on all matters raised in its Answer, and Defenses, or in the Amended Complaint for Patent Infringement.

Date: August 4, 2011

Respectfully submitted,

/s/ Michael E. Richardson

Michael E. Richardson, TX Bar No. 24002838
BECK REDDEN & SECREST
1221 McKinney, Suite 4500
Houston, TX 77010
Telephone: (713) 951-6284
Facsimile: (713) 951-3720
mrichardson@brsfirm.com

Mark G. Matuschak, admitted *pro hac vice*
Donald R. Steinberg, admitted *pro hac vice*
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, MA 02109
Telephone: (617) 526-6000

Facsimile: (617) 526-5000
mark.matuschak@wilmerhale.com
donald.steinberg@wilmerhale.com

Kate Hutchins, admitted *pro hac vice*
WILMER CUTLER PICKERING
HALE AND DORR LLP
399 Park Avenue
New York, NY 10011
Telephone: (212) 230-8800
Facsimile: (212) 230-8888
kate.hutchins@wilmerhale.com

Daniel V. Williams, admitted *pro hac vice*
WILMER CUTLER PICKERING
HALE AND DORR LLP
1875 Pennsylvania Avenue NW
Washington, DC 20006
Telephone: (202) 663-6000
Facsimile: (202) 663-6363
daniel.williams@wilmerhale.com

**ATTORNEYS FOR DEFENDANT
STAPLES, INC.**

CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3). Any other counsel of record will be served by facsimile transmission and/or first class mail this 4th day of August, 2011.

/s/ Michael E. Richardson

Michael E. Richardson