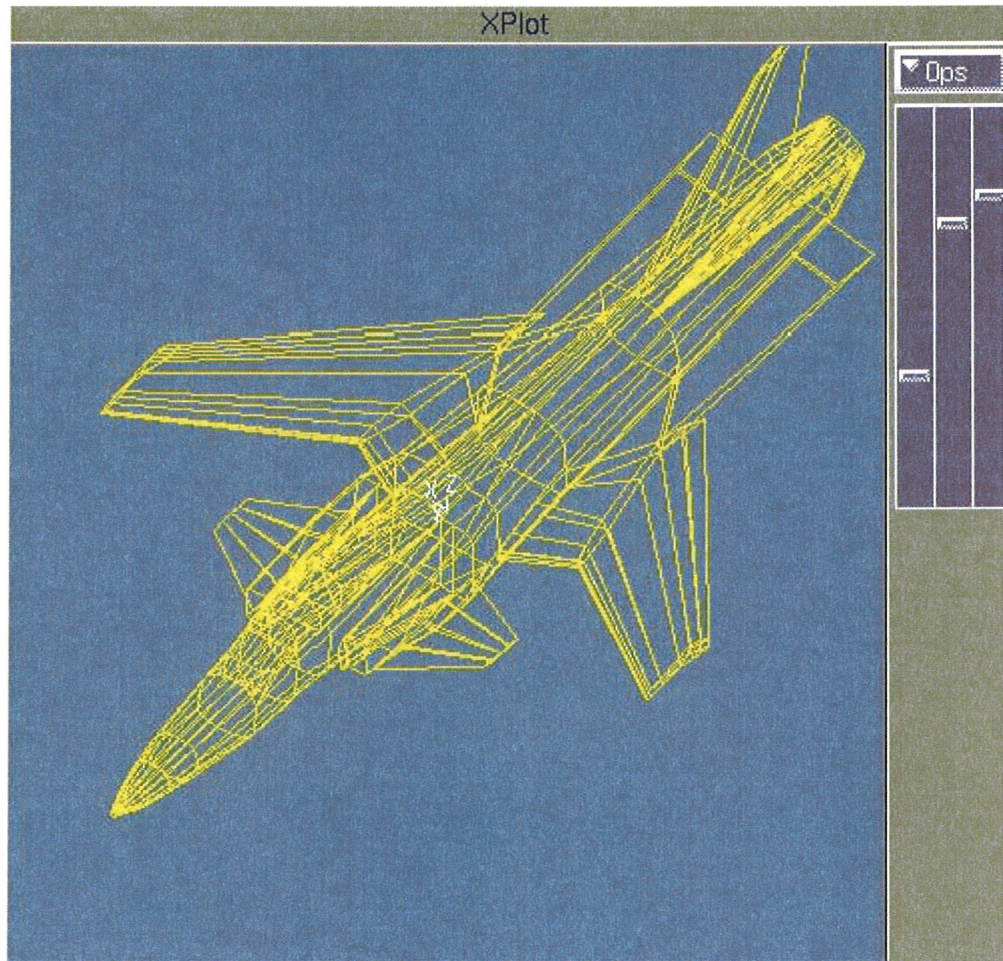


**STAPLES, INC.'S SECOND AMENDED ANSWER,
DEFENSES, AND COUNTERCLAIMS**

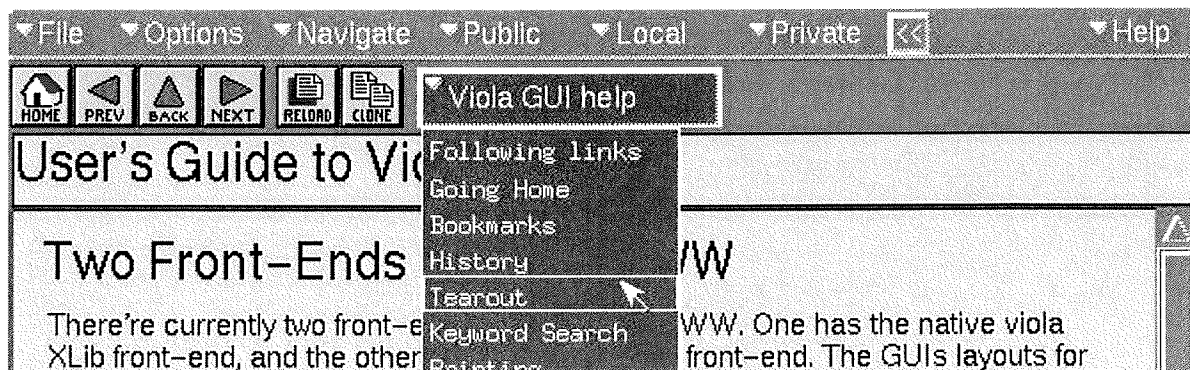
PART 2 OF 5

Such new accessories can be as simple as little applets that accompany documents, or conceivably as complicated as a news or mail reader. An analogy is how Emacs's programming environment allows that text editor to become much more than just a text editor.



Not only can mini applications be embedded inside of documents, they can even be plugged into the ViolaWWW's "toolbar".

The following picture shows a "bookmark tool" that acts as a mini table of contents for the page. In this case, the bookmark is linked to the document (by using the <LINK> tag of HTML 3.0), and the bookmark will appear and disappear with the document.



One can imagine many plug-in accessories/applets/tools possible with this facility. Like, a self guiding slideshow tool. Or, document set specific navigational tools/icons that are not pasted onto the page so that the navigational icons don't scroll away from view. Etc.

49. "Doyle downloaded and read the paper." 399 F.3d 1325, 1330 (Fed. Cir. 2005).

50. On August 31, 1994, at approximately 9:06 p.m. California time, Doyle responded to Pei Wei's statement at approximately 6:52 p.m. that "I don't think this is the first case of program objects embedded in docs and transported over the WWW. ViolaWWW has had this capabilities for months and months now." Doyle responded by asking Pei Wei, "How many months and months? We demonstrated our technology in 1993."

51. On August 31, 1994, at approximately 11:16 p.m. California time, Pei Wei responded to the message that Doyle had sent at approximately 9:06 p.m. Pei Wei's response included the following statements:

Definitely by May 8, 1993 we had demonstrated that plotting demo (the very one shown in the viola paper) to visitors from a certain computer manufacturer... This demo was memorable because someone and I at ORA had lost sleep the night before the meeting, in order to cook up that particular plotting demo :) We had to show something cool.

That demo wasn't very hard to do because by that time the basic capability was already in place for violaWWW to fetch viola

objects over HTTP (or whatever) and plug them into documents. Of course, our wire-frame plotting demo isn't anywhere as comprehensive as yours. But, the point was that there was a way to embed programmable & interactive objects into HTML documents.

52. When Pei Wei referred to the "plotting demo (the very one shown in the viola paper)," he was referring to the plot of the fighter jet shown above in the window titled "XPlot."
See supra ¶ 48.

53. When Pei Wei referred to a demonstration "by May 8, 1993" to "visitors from a certain computer manufacturer," he was referring to a demonstration of the plotting demo to Karl Jacob and James Kempf from Sun Microsystems on May 7, 1993. This demonstration took place in Northern California. There was no limitation, restriction or obligation of secrecy on Karl Jacob or James Kempf.

54. The Federal Circuit has 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).

55. On August 31, 1994, at approximately 11:13 p.m. California time, Doyle responded again to the message that Pei Wei had sent at approximately 6:52 p.m.

56. On information and belief, Doyle's response was sent after Doyle had read Pei Wei's August 1994 Viola paper.

57. Doyle's response included the following statements: "Pei is mistaken on two counts, as I describe below As Pei's paper on Viola states, that package did not support what it calls 'embeddable program objects' until 1994. . . . Furthermore, Viola merely implements an internal scripting language"

58. On August 31, 1994, at approximately 11:36 p.m. California time, Doyle responded to the message that Pei Wei had sent at approximately 11:16 p.m. Doyle's response

included the following statements: "Out of curiosity, did you publicly demonstrate this or publish any results before 1994?"

59. On September 1, 1994, at approximately 12:08 a.m. California time, Pei Wei responded to the message that Doyle had sent at approximately 11:13 p.m.

60. Pei Wei's message at approximately 12:08 a.m. was also responsive to the message that Doyle had sent at approximately 11:36 p.m.

61. Pei Wei's message to Doyle at 12:08 a.m. included the following statements:

Well. Viola's model was *demonstrated* in 1993, *released* freely in 1994. . . . And, as 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.

62. On information and belief, Doyle deleted from his computer his emails with Pei Wei on August 31 and September 1, 1994, and the copy of the August 1994 Viola paper that he had downloaded and read. Doyle kept on his computer other emails from that timeframe, however.

63. On information and belief, Doyle was living in Northern California on August 31, 1994, when he exchanged messages with Pei Wei about the ViolaWWW browser.

64. Pei Wei was living in Northern California on August 31, 1994, when he exchanged messages with Doyle about the ViolaWWW browser.

65. There was no limitation, restriction or obligation of secrecy on the recipients of Pei Wei's messages on August 31 and September 1, 1994, about the ViolaWWW browser.

66. There was no limitation, restriction or obligation of secrecy on the readers of Pei Wei's August 1994 Viola paper.

67. On October 17, 1994, the application for the '906 patent was filed. Doyle and Martin were among those named as inventors.

68. The application for the '906 patent discloses the Mosaic browser and the Cello browser, but not the ViolaWWW browser.

69. The application for the '906 patent included an information disclosure statement that identified several pieces of prior art, but not the ViolaWWW browser.

70. On November 22, 1994, Doyle signed a declaration under penalty of perjury that included the following statements: "I believe I am . . . an original, first and joint inventor . . . of the subject matter which is claimed and for which a patent is sought . . . the specification of which . . . was filed on October 17, 1994 as Application Serial No. 08/324,443. . . . I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56."

71. No disclosure about the ViolaWWW browser was ever provided to the Patent Office during prosecution of application number 08/324,443, which matured into the '906 patent.

B. Doyle was reminded about the ViolaWWW browser in 1995 during prosecution of the '906 patent

72. Doyle was reminded about Pei Wei and the ViolaWWW browser in 1995, during prosecution of the '906 patent, but still no disclosure about the ViolaWWW browser was provided to the Patent Office.

73. On August 21, 1995, at approximately 11:42 a.m. California time, Doyle posted a "Press Release" to the publicly-accessible WWW-talk e-mail distribution list. Doyle's post

included the following statements: "Eolas Technologies Inc. announced today that it has completed a licensing agreement with the University of California for the exclusive rights to a pending patent covering the use of embedded program objects, or 'applets,' within World Wide Web documents."

74. On August 21, 1995, at approximately 12:54 p.m. California time, Pei Wei responded on the publicly-accessible WWW-talk e-mail distribution list to Doyle's "Press Release." Pei Wei's response included the following statements: "[F]or the record, I just want to point out that the 'technology which enabled Web documents to contain fully-interactive "inline" program objects' was existing in ViolaWWW and was *released* to the public, and in full source code form, even back in 1993... Actual conceptualization and existence occurred before '93."

75. On August 21, 1995, at approximately 1:14 p.m. California time, Doyle responded to the message Pei Wei had sent at approximately 12:54 p.m. Doyle's response included the following statements: "We've had this discussion before (last September, remember?). You admitted then that you did NOT release or publish anything like this before the Eolas demonstrations."

76. On August 21, 1995, at approximately 4:09 p.m. California time, Pei Wei responded to the message that Doyle had sent at approximately 1:14 p.m. Pei Wei's response included the following statements:

Please carefully re-read my letter to you... I said Viola was demonstrated in smaller settings, but before your demo. The applets stuff was demo'ed to whomever wanted to see it and had visited our office at O'Reilly & Associates (where I worked at the time).

This is what I wrote on the VRML list:

....

- > Definitely by May 8, 1993 we had demonstrated that plotting demo
- > (the very one shown in the viola paper) to visitors from a certain
- > computer manufacturer... This demo was memorable because someone
- and I
- > at ORA had lost sleep the night before the meeting, in order to cook up
- > that particular plotting demo :) We had to show something cool.

That date (May 93), at least, predates your demo if I'm not mistaken. Then around August 93, it was shown to a bunch of attendees at the first Web Conference in Cambridge. . . .

....

If you're talking about interactive apps **specifically** on the web, ie applets in-lined into HTML documents etc., and with bi-directional communications, then look at ViolaWWW as it existed around late '92 early '93.

77. When Pei Wei referred to the “plotting demo (the very one shown in the viola paper),” he was referring to the plot of the fighter jet shown above in the window titled “XPlot.”
See supra ¶ 48.

78. When Pei Wei referred to a demonstration “by May 8, 1993,” he was referring to the demonstration of the plotting demo to two Sun Microsystems employees that the Federal Circuit has held “was a public use under [35 U.S.C. § 102(b)].” 399 F.3d 1325, 1335 (Fed. Cir. 2005).

79. When Pei Wei referred to the “first Web Conference in Cambridge” “around August 1993,” he was referring to the “World-Wide Web Wizards Workshop” held in Cambridge, Massachusetts on July 28–30, 1993.

80. On information and belief, people attending the Wizards workshop included Tim Berners-Lee, Marc Andreessen, Eric Bina, Dale Dougherty, Scott Silvey, and Pei Wei.

81. On information and belief, Tim Berners-Lee and Dale Dougherty were the organizers of the Wizards workshop.

82. On information and belief, Dale Dougherty worked at O'Reilly & Associates in Northern California.

83. On information and belief, in 1992, Dale Dougherty learned about Viola and recruited Pei Wei to join O'Reilly & Associates. Pei Wei's job at O'Reilly & Associates was to continue developing the ViolaWWW browser.

84. On information and belief, Scott Silvey worked with Pei Wei at O'Reilly & Associates in Northern California.

85. On information and belief, when Pei Wei wrote "This demo was memorable because someone and I at ORA had lost sleep the night before the meeting, in order to cook up that particular plotting demo," the other person he was referring to was Scott Silvey.

86. On information and belief, Tim Berners-Lee is the person generally attributed to be the inventor of the World Wide Web.

87. Marc Andreessen and Eric Bina were the authors of Mosaic, a popular browser for the World Wide Web created at the National Center for Supercomputing Applications (NCSA) at the University of Illinois at Urbana-Champaign.

88. Marc Andreessen and Eric Bina went on to found Netscape, the manufacturer of another popular browser for the World Wide Web.

89. On information and belief, Pei Wei and Scott Silvey demonstrated the ViolaWWW browser and its ability to automatically invoke interactive objects embedded within a webpage using the "VOBJF" tag to at least Marc Andreessen and Tim Berners-Lee at the Wizards workshop in Cambridge, Massachusetts in July 1993 — over one year before the application for the '906 patent was filed.

90. There was no limitation, restriction or obligation of secrecy on anyone at the Wizards workshop.

91. Pei Wei's demonstration at the Wizards workshop of the ViolaWWW browser and its ability to automatically invoke interactive objects embedded within a webpage using the "VOBJF" tag was a public use under 35 U.S.C. § 102(b).

92. Despite Pei Wei's communications to Doyle repeatedly providing evidence that the ViolaWWW browser was material prior art under 35 U.S.C. § 102(b), Doyle never disclosed the ViolaWWW browser to the Patent Office during prosecution of application number 08/324,443, which matured into the '906 patent.

93. Instead, on information and belief, Doyle deleted from his computer his emails with Pei Wei on August 21, 1995. Doyle kept on his computer other emails from that timeframe, however.

C. In 1998, during prosecution of the '906 patent, Doyle collected additional information about the ViolaWWW browser

94. In 1998, during prosecution of the '906 patent, Doyle obtained additional information about the ViolaWWW browser, but he still did not disclose any information about the ViolaWWW browser to the Patent Office, as explained in more detail below.

95. During prosecution of the '906 patent, Doyle maintained a folder called "Viola stuff."

96. The "Viola stuff" folder included a printout of Pei Wei's message to Doyle on August 31, 1994, at approximately 6:52 p.m. California time, in which Pei Wei told Doyle, "I don't think this is the first case of program objects embedded in docs and transported over the WWW. ViolaWWW has had this capabilities for months and months now." *See supra* ¶¶ 44–48.