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

PART __3__ OF __5__

97. The "Viola stuff" folder included a printout of Doyle's message to Pei Wei on August 31, 1994, at approximately 11:36 p.m. California time, in which Doyle asked Pei Wei, "Out of curiosity, did you publicly demonstrate this or publish any results before 1994?" *See supra* ¶ 58.

98. The "Viola stuff" folder included a printout from the URL <http://www.w3.org/History/1994/WWW/WorkingNotes/>. This webpage has a heading for the "WWWWizardsWorkshop" "Cambridge, Mass, July 1993" and includes links to "Announcement," "Agenda," and "Photos of attendees."

99. "WWWWizardsWorkshop" refers to the World-Wide Web Wizards Workshop held in Cambridge, Massachusetts on July 28-30, 1993, that Pei Wei attended. *See supra* ¶¶ 79-91.

100. The "Announcement" link links to a webpage at <http://www.w3.org/History/1994/WWW/WorkingNotes/1993_Workshop/Announcement.html> that states that "Interactive objects" would be discussed at the Wizards workshop.

101. The "Agenda" link links to a webpage at <http://www.w3.org/History/1994/WWW/WorkingNotes/1993_Workshop/Agenda.html> that states that "Interactive objects" was on the agenda for discussion at the Wizards workshop.

102. The webpages for the Wizards workshop corroborate Pei Wei's statement to Doyle on August 21, 1995, that the plotting demo described in the August 1994 Viola paper was "shown to a bunch of attendees at the first Web Conference in Cambridge" "around August 93" — over one year before the application for the '906 patent was filed. *See supra* ¶ 76.

103.   The "Viola stuff" folder included a printout of a webpage with a link to the source

code for viola-2.1.2, archived on September 2, 1993 — over one year before the application for

the '906 patent was filed.

104.   The "Viola stuff" folder included a printout of a webpage with the "README"

file for viola-2.1.2. The date at the top of the "README" file is July 27, 1992. The

"README" file includes instructions for building the binary code for the "viola" program, and

instructions for running the ViolaWWW browser. The "README" file states at the bottom:

> Comments and questions:
>
> Please send WWW specific bugs to www-bugs@info.cern.ch,
> general comments to www-talk@info.cern.ch, and anything to
> wei@xcf.Berkeley.EDU.
>
> Pei Y. Wei
> wei@xcf.Berkeley.edu

105.   The "Viola stuff" folder included a printout of a message that Pei Wei had sent to

the publicly-accessible WWW-talk e-mail distribution list on January 28, 1994, that included the

following statements: "Right now, the ViolaWWW that is under development can embed viola

objects/applications inside of HTML documents."

106.   The "Viola stuff" folder included a printout of a message that Pei Wei had sent to

the publicly-accessible WWW-talk e-mail distribution list on February 25, 1994, that included

the following statements:

> The new ViolaWWW is now available for ftp'ing. It's beta and
> feedback is very welcomed. The README file follows...
>
> --
> --
> ViolaWWW, Version 3.0 Beta   Feb 23 1994
> ---------------------------
> ---------------------------
>
> ViolaWWW is an extensible World Wide Web hypermedia
> browser for XWindows.

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. . . .

Notable features in the new ViolaWWW

. . . .

* Embeddable in-document and in-toolbar programmable viola
objects. A document can embed mini viola applications (ie: a
chess board), or can cause mini apps to be placed in the toolbar.

. . . .

Availability

Source and binary can be found in ftp://ora.com/pub/www/viola.
Sparc binary is supplied.

. . . .

Pei Y. Wei (wei@ora.com)
O'Reilly & Associates, Inc.

107. The "Viola stuff" folder included a printout from the URL

<http://xcf.berkeley.edu/ht/projects/viola/>. The printout included the following statements:

ViolaWWW, Version 3.1 Beta   Mar 23 1994
_____

ViolaWWW is an extensible World Wide Web hypermedia
browser for XWindows.

. . . .

Notable features in the new ViolaWWW

. . . .

* Embeddable in-document and in-toolbar programmable viola
objects. A document can embed mini viola applications (ie: a
chess board), or can cause mini apps to be placed in the toolbar.

. . . .

Availability

Source and binary can be found in ftp://ora.com/pub/www/viola.
Sparc binary is supplied.

. . . .

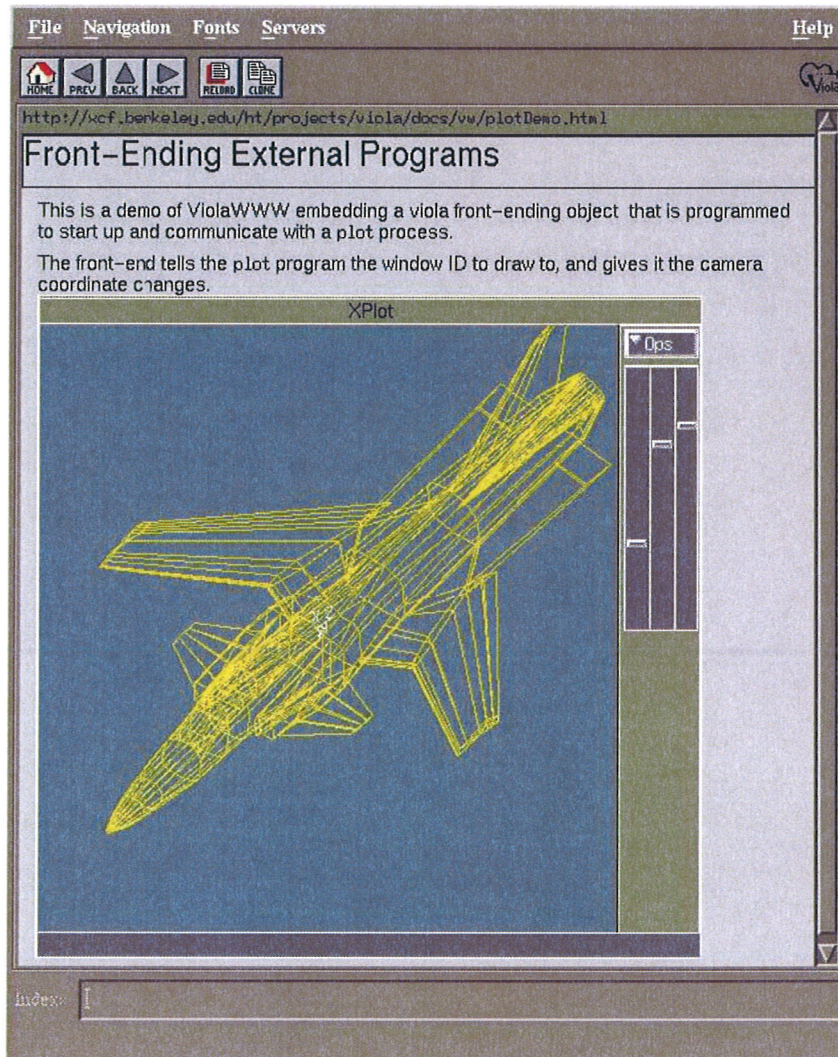Pei Y. Wei (wei@ora.com)
O'Reilly & Associates, Inc.

108.   The "Viola stuff" folder included a printout from the URL

<http://xcf.berkeley.edu/ht/projects/viola/docs/viola/>. One of the files listed in the printout is

named "plotDemo.html".

109.   The "Viola stuff" folder included a printout from the URL

<http://xcf.berkeley.edu/ht/projects/viola/docs/objs/>. One of the files listed in the printout is

named "plot.v".

110.   The following is a screenshot of the ViolaWWW browser after parsing the file

plotDemo.html:

File   Navigation   Fonts   Servers   Help

HOME PREV BACK NEXT RELOAD CLONE

http://xcf.berkeley.edu/ht/projects/viola/docs/vw/plotDemo.html

Front-Ending External Programs

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.

XPlot

111.   The files plotDemo.html and plot.v include code for the plotting demo described in the August 1994 Viola paper.

112.   The file plotDemo.html specifies the location of the file plot.v, which in turn specifies the location of a separate executable application named vplot.

113.   Pei Wei had told Doyle on August 31, 1994 how the plotting demo worked: "[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-

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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.

114.   Pei Wei had told Doyle on August 31, 1994, *see supra* ¶ 51, and again on August 21, 1995, *see supra* ¶ 76, that the plotting demo described in the August 1994 Viola paper was the "very one" demonstrated "to visitors from a certain computer manufacturer" by May 8, 1993.

115.   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).

116.   Thus, during prosecution of the '906 patent, Doyle knew about Pei Wei's demonstration of the plotting demo that the Federal Circuit has held was a "public use" under 35 U.S.C. § 102(b); Doyle knew how the plotting demo worked; and Doyle had access to the code for that plotting demo.

117.   During prosecution of the '906 patent, Doyle printed webpages containing information about a talk that Pei Wei gave at Stanford University in Northern California in September 1994.

118.   The webpages that Doyle printed included the following statements and graphic:

WWW Browsers: Extensibility Issues

Pei Wei, <u>O'Reilly & Associates</u>

Stanford Computer Forum WWW Workshop - September 20-21, 1994

. . . .

Extensibility in WWW Browsers

The WorldWideWeb is a powerful medium which has many applications beyond just publishing static documents. It is

certainly an interface to the space of "documents." But already, with established features such as input-forms and server-side scripting, we see that the web is also increasingly becoming an interface to the space of what is traditionally called "applications."

. . . .

In this talk I'll describe a few possible approaches for a browser to gain more flexibility, and to briefly describe one particular approach as implemented by a system known as ViolaWWW.

. . . .

Possible Ways to Extend Browsers

We already do "extend" browsers with things like "external viewers." But there's not a very good integration with the browser. Ideally those external viewers should be rendering in-place inside the document, and be working together with the browser, be tightly integrated with the browser and other parts...

. . . .

Work at O'Reilly & Associates: VIOLA-WWW

. . . .

This is the Viola system that is being developed at O'Reilly and Associates. This system has the following interesting characteristics:
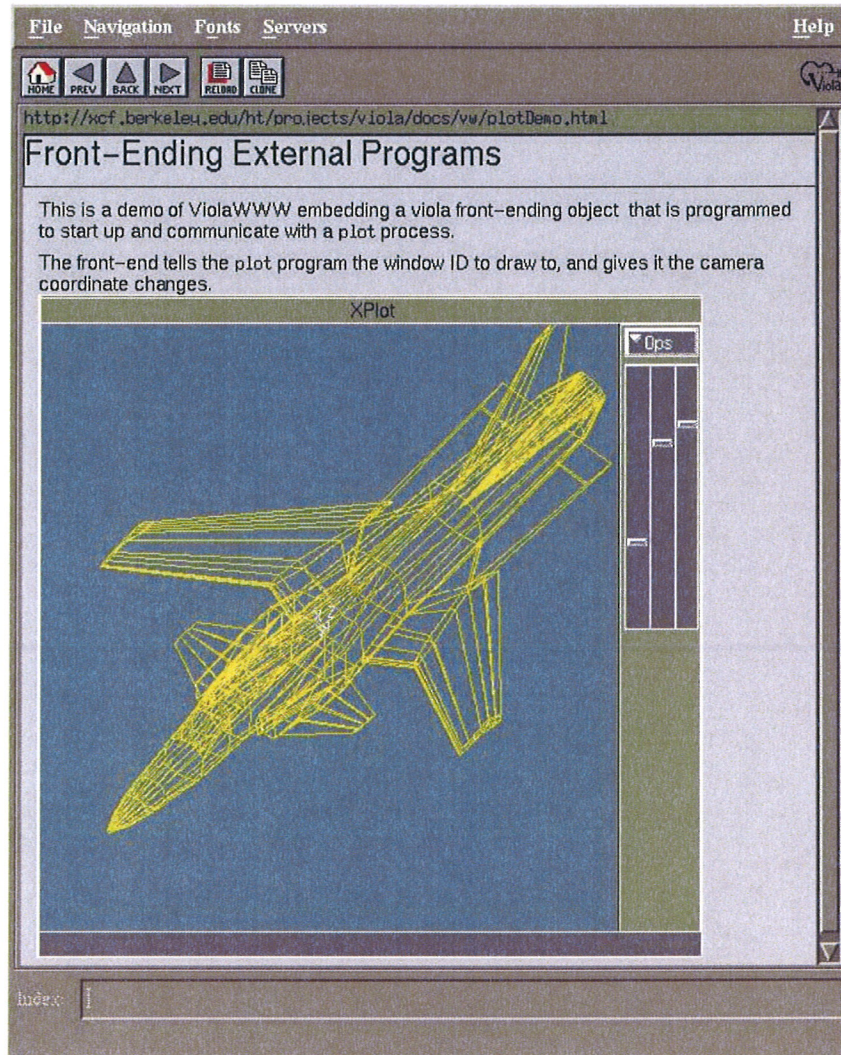
. . . .

Three, program objects can be embedded into documents and the toolbar. . . .

. . . .

The next example is a front-end application to a backend. And the back-end is what actually does the computation and the drawing.

. . . .

119. There was no limitation, restriction or obligation of secrecy on anyone attending the talk that Pei Wei gave at Stanford University in September 1994.

120. The plotting demo described in the talk at Stanford University in September 1994 is the same plotting demo described in the August 1994 Viola paper. *See supra* ¶ 48.

121. Pei Wei had told Doyle on August 31, 1994, *see supra* ¶ 51, and again on August 21, 1995, *see supra* ¶ 76, that the plotting demo described in August 1994 Viola paper was the "very one" demonstrated "to visitors from a certain computer manufacturer" by May 8, 1993.

122. On information and belief, 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).

123.   Thus, during prosecution of the '906 patent, Doyle was repeatedly confronted with evidence that the ViolaWWW browser was material prior art under 35 U.S.C. § 102(b), yet Doyle never disclosed the ViolaWWW browser to the Patent Office during prosecution of application number 08/324,443, which matured into the '906 patent.

124.   On information and belief, the ViolaWWW browser, including the August 1994 Viola paper, was disclosed to Krueger in August of 1998, after the Notice of Allowance for the '906 patent issued but before the '906 patent issued, when he received a fax containing a number of references regarding the ViolaWWW browser.

125.   On information and belief, the fax sent to Krueger in August of 1998 was to allow him to analyze whether the ViolaWWW browser, including the August 1994 Viola paper, should be submitted to the Patent Office.

126.   On information and belief, Kruger was aware of Pei Wei's May 1993 demonstration of the ViolaWWW browser to Sun Microsystems employees without a confidentiality agreements.

127.   On information and belief, Krueger considered Pei Wei's statements regarding the May 1993 demonstration of the ViolaWWW browser to Sun Microsystems employees when he analyzed whether to disclose the ViolaWWW browser to the Patent Office.

128.   On information and belief, Krueger had no reason to disbelieve Pei Wei's statements regarding the May 1993 demonstration of the ViolaWWW browser to Sun Microsystems employees.