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UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ROBERT JACOBSEN, an individual,)	No. C-06-1905-JSW
)	
Plaintiff,)	JOINT CASE MANAGEMENT
)	STATEMENT AND [PROPOSED]
v.)	ORDER
)	
MATTHEW KATZER, an individual, and)	Location: 17th Floor, Courtroom 2
KAMIND ASSOCIATES, INC., dba KAM)	Judge: Honorable Jeffrey S. White
Industries, an Oregon corporation,)	
)	
Defendants.)	
)	
)	
)	

Per the Court’s order of December 20, 2006 [Docket #145], the parties submit this Joint Case Management Statement.

1. A brief description of jurisdictional issues

Plaintiff Jacobsen filed his Complaint March 13, 2006. The complaint alleges defendants fraudulently procured nearly a dozen patents and sought to enforce them through various unlawful, unfair and fraudulent means. The complaint also contains claims alleging unfair competition and cyber-squatting. Jacobsen filed an amended Complaint on Sept. 11, 2006, adding claims alleging copyright infringement, federal trademark dilution and state law unjust enrichment. Plaintiff’s declaratory judgment regarding U.S. Pat. No. 6,530,329 , the Copyright Act, and the Lanham Act (cyber-squatting and dilution) claims involve federal questions. 28 U.S.C. § 1331. Plaintiff has

1 also brought a California Unfair Competition Act claim (Cal. Bus. & Prof. Code § 17200 *et seq.*)
2 and unjust enrichment claim. Jurisdiction is proper for these claims based on the Court's
3 supplemental jurisdiction. 28 U.S.C. § 1367. No defendants remain to be served.

4 **2. A brief description of the case and defenses**

5 Plaintiff Jacobsen is a high energy physicist who does research at the Lawrence Berkeley
6 National Laboratory of the University of California, and Stanford University and at CERN in
7 Switzerland, and teaches physics at the University. As a hobby, Jacobsen develops, with others,
8 open source software code called JMRI (Java Model Railroad Interface) that Jacobsen alleges is
9 distributed free of charge. KAM is an Oregon corporation and Katzer is its principal. Defendants
10 allege that KAM has patents for software products, at least one of which is similar to and is
11 infringed by the JMRI project software. Defendants assert that KAM's software products' function
12 is similar to the software products provided for free by JMRI. Jacobsen alleges that Katzer and his
13 attorney, Kevin Russell, intentionally withheld prior art that they knew was material to
14 patentability from the Patent Office in obtaining the patents and for these reasons, as well as others,
15 Jacobsen alleges that said patents are thereby invalid and/or unenforceable. Jacobsen alleges that
16 he does not infringe the patent claims.

17 Jacobsen's complaint seeks declaratory relief regarding noninfringement, invalidity, and
18 unenforceability of the patent-in-suit, U.S. Pat. No. 6,530,329. The complaint alleges the patent-
19 in-suit is invalid because prior art anticipates or makes it obvious, and/or it failed to meet the
20 requirements of 35 U.S.C. § 112. The complaint also alleges the patent-in-suit, and related patents,
21 were obtained through fraud on the patent office or inequitable conduct. The complaint also
22 contains claims alleging unfair competition, and cyber-squatting. An amended complaint added
23 trademark dilution, copyright infringement and unjust enrichment claims after Plaintiff allegedly
24 learned of Defendants' alleged activities during the anti-SLAPP proceedings. Defendants allege
25 KAM's patents are valid. No related proceedings are pending.

26 **3. Brief Description of the legal issues genuinely in dispute**

27 All legal issues are in dispute.

28 **4. Procedural History**

1 Plaintiff filed his complaint Mar. 13, 2006. Defendants and then-defendant Kevin Russell filed
2 motions to dismiss and anti-SLAPP motions in May 2006. The Court granted Defendants' and Mr.
3 Russell's motions, which dismissed antitrust and libel claims against Defendants, and dismissed
4 Mr. Russell from the action. Plaintiff filed an amended complaint Sept. 11, 2006. On Sept. 28,
5 2006, Defendants filed motions to dismiss copyright, § 17200, cybersquatting, and unjust
6 enrichment claims, and a motion to strike portions of the amended complaint and a motion for
7 more definite statement for the dilution claim. Plaintiff filed a motion for preliminary injunction to
8 enjoin Defendants' copyright infringement Oct. 24, 2006. Defendants withdrew their motion to
9 dismiss the copyright infringement claim, and motion for more definite statement, without
10 prejudice, on Nov. 17, 2006. The Court will consider the remaining motions Jan. 19, 2007.

11 **5. Brief Description of Discovery to date**

12 Plaintiff and Defendants made initial disclosures per this Court's order on Sept. 5, 2006.

13 **6. Discovery Plan**

14 The Proposed Litigation and Discovery Schedule is discussed in Section 11 below.

15 A. List of Potentially Key Witnesses

16 The list of potentially key witnesses are as follows. Foreign or difficult to serve witnesses are
17 identified by Plaintiff.

- 18 1. Matthew Katzer,
- 19 2. Robert Jacobsen,
- 20 3. Hans Tanner,
- 21 4. John Plocher,
- 22 5. A.J. Ireland,
- 23 6. Strad Bushby,
- 24 7. John E. Kabat,
- 25 8. Juergen Freiwald,
- 26 9. Dick Bronson,
- 27 10. Jerry Britton,
- 28 11. Contributors, resellers, distributors and developers of the JMRI software, Developers and

- 1 manufacturers of third party model train software,
- 2 13. Contributors and users of the JMRI software (U.S. and foreign),
- 3 14. Unknown employees and supervisors at the Lawrence Berkeley National Laboratory,
- 4 15. Dean of the UC Berkeley Physics Department,
- 5 16. Unknown employees and supervisors at the US Department of Energy,
- 6 17. Kevin Russell,
- 7 18. Glenn Butcher (South Pacific atoll potentially accessible by military only),
- 8 19. Unknown employees of KAMIND Associates, Inc. (U.S. and foreign),
- 9 20. Unknown employees of Chernoff, Vilhauer, McClung and Stenzel, .
- 10 21. Examiners at the U.S. Patent & Trademark Office,
- 11 22. Unknown members of the NMRA (U.S. and foreign), , .
- 12 23. Unknown employees of Marklin (U.S. and foreign),
- 13 24. Stan Ames,
- 14 25. Rutger Friburg (Sweden),
- 15 26. Ed Loizeaux,
- 16 27. Unknown employees of Train Track Computer Systems, Inc.,
- 17 28. Roger Webster,
- 18 29. John McCormick,
- 19 30. John Littman,
- 20 31. Dr. Bruce Chubb,
- 21 32. Unknown members of the Tech Model Railroad Club of MIT,
- 22 33. Robert Bouwens (Switzerland),
- 23 34. Unknown employees and/or agents of Bouwens Engineering (Switzerland),
- 24 35. Members of the NMRA DCC Working Group (U.S. and foreign),
- 25 36. Roland Dehmet (Germany or Switzerland),
- 26 37. Konrad Froitzheim (same),
- 27 38. Zana Ireland,
- 28 39. Unknown employees of Digitrax corporation,

1 40. Unknown employees of Intel Corp.

2 Plaintiff and Defendants reserve the right to name other key witnesses.

3 B. List of Key Information

4 1. All versions of the JMRI software, and any KAM software development.

5 2. All software development information for the JMRI software project.

6 3. All information relating to JMRI's market share.

7 4. All information in Katzer and KAM's, and their attorney Kevin Russell's, possession that are
8 relevant to patentability of patents and applications in Katzer portfolio.

9 5. All information relating to enforcing the Katzer patents.

10 6. All information relating Defendants' cybersquatting on, use of , or registering the domain names
11 of, others' trademarks, trade names, and the like.

12 7. All plans for filing intellectual property rights on behalf of Katzer, and KAM and its related
13 entities.

14 8. All evidence that the patent(s)-in-suit meet, or do not meet, requirements of 35 U.S.C. § 112.

15 9. All financial information relating to KAM and its related entities.

16 10. File wrappers for the patent application, and related patent applications, that issued as the
17 patent-in-suit.

18 11. Trademark applications for all KAM products.

19 12. All emails from Jacobsen to any JMRI user, NMRA member, or other hobbyist related to
20 JMRI or model train software.

21 13. All correspondence to and from Defendants and their agents and employees, to any person at
22 Lawrence Berkeley Laboratory (LBL), University of California, Lawrence Livermore National
23 Laboratory (LLNL), or Los Alamos National Laboratory (LANL), relating to model trains.

24 14. Identification of all email addresses used by Mr. Katzer since January 1, 1987.

25 15. Identification of all agents or others who sell Defendants' products.

26 16. All documents relating to plans for the use of the JMRI code in Defendants' products.

27 17. The number of Defendants' products that have been shipped, and the number of downloads of
28 Defendants' products from their or their agents' websites.

- 1 18. All emails from JMRI users to Jacobsen related to JMRI or model train software.
- 2 19. Identification of all email addresses used by Jacobsen since 1987.
- 3 20. All business and financial records of the JMRI group and all business and financial records of
- 4 Jacobsen relating to the JMRI group.
- 5 21. All communications between Jacobsen and/or JMRI with any person relating to this lawsuit.
- 6 22. Identification of all distributors of JMRI software.
- 7 23. Identification of all members or contributors to the JMRI project.

8 Defendants reserve the right to seek further key information. Plaintiff believes that it is
9 premature to offer a detailed discovery plan because the parties have not had their 26(f) conference
10 due to the deferral of this conference [Docket #34]. Furthermore, Plaintiff has yet to receive an
11 Answer from defendants, and cannot determine what additional information he will seek in
12 response to that Answer. Plaintiff thus also reserves the right to seek further key information.

13 **7. Motions before trial**

14 Jacobsen, KAM and Katzer expect to file motions for summary judgment prior to trial on
15 virtually all claims. KAM and Katzer anticipate that new parties will be added. Jacobsen may also
16 add parties and claims. The parties expect there will be evidentiary and claim-construction
17 hearings.

18 **8. Description of Relief Sought**

19 Generally, Plaintiff seeks declaratory and injunctive relief, statutory or actual damages for
20 copyright infringement, statutory damages for trademark law violations, disgorgement for unjust
21 enrichment, and costs and attorney's fees. Defendants believe Plaintiff has not described the
22 calculation of damages in the complaint. KAM's counterclaims will include claims for monetary
23 damages, including reasonable royalty, and/or lost profits, and/or enhanced damages, and/or
24 attorney fees.

25 **9. ADR Efforts to Date**

26 The parties completed ADR on Dec. 5, 2006. The parties and the ADR mediator have
27 scheduled a phone call for Mar. 5, 2007 to give the mediator a status update. Plaintiff and
28

1 Defendants believe that further ADR will not be productive until, at least, summary judgment
 2 motions are heard, or after claim construction.

3 **10. Consent to a magistrate judge**

4 The defendants do not consent to a magistrate judge. Plaintiff is familiar with the
 5 magistrates in this district and is comfortable proceeding before them or a district court judge.

6 **11. Proposed Litigation and Discovery Schedule**

7 The parties respectfully disagree over schedules, and thus submit their own proposals.

8 **Defendants' proposal:**

Date	Counting	Rule	Event
3/13/06			Complaint
8/11/06		FRCP 26 f	Initial case mgmt conference
9/5/06		FRCP 26 a	Initial Disclosures
9/11/06			Amended Complaint
12/5/06			ENE/ADR completed
1/19/07			Case Management Conference
	20 days after the Court issues its written ruling on the pending motions that will be heard on January 19, 2007, assuming that Plaintiff will not file an Amended Complaint. If Plaintiff is allowed to file an Amended Complaint, 20 days after filing of Amended Complaint, unless defendants file another responsive pleading or motion to dismiss		Answer, Counterclaims, Cross Claims and additional parties
	20 days after filing of defendant's Answer		Reply to counterclaims, cross claims and answer of additional parties
	10 days after answer is served		Preliminary infringement contentions
	45 days after preliminary infringement	Pat L.R. 3-	Preliminary

Date	Counting	Rule	Event
	contentions	3	invalidity contentions
	IF NO INFRINGEMENT ALLEGED, 10 days after answer is served	Pat L.R. 3-5	Preliminary invalidity contentions
	IF NO INFRINGEMENT ALLEGED, 10 days after preliminary invalidity contentions are served	Pat L.R. 3-5	Meet & confer re preliminary invalidity contentions
	IF NO INFRINGEMENT ALLEGED, 50 days after preliminary invalidity contentions are served	Pat L.R. 3-5	File final invalidity contentions
	10 days after preliminary invalidity contentions	Pat L.R. 4-1	Simultaneous exchange of terms to be construed
	20 days after exchange of terms to be construed	Pat L.R. 4-1	Simultaneous exchange of preliminary claim constructions
	60 days after exchange of preliminary claim constructions	Pat L.R. 4-1	Joint claim construction and Prehearing statement
	30 days after service of joint claim construction	Pat L.R. 4-4	Close of all discovery relating to claim construction including fact and experts
	45 days after service of joint claim construction AND 6 weeks prior to claim construction hearing	Pat L.R. 4-5 AND standing order ¶ 9	Opening Markman brief by party claiming infringement
	14 days after service of opening Markman	Pat L.R. 4-5	Response Markman brief
	7 days after service of responsive Markman	Pat L.R. 4-5	Reply Markman brief
	7-14 days prior to claim construction hearing	Standing Order ¶ 7	Tutorial
	14 days after service of reply Markman and at court's convenience	Pat L.R. 4-6	Claim construction hearing

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Date	Counting	Rule	Event
	Court's convenience		Claim construction ruling
	30 days after claim construction ruling	Pat L.R. 3-6	File final infringement contentions
	50 days after claim construction ruling	Pat L.R. 3-6	File final invalidity contentions
	50 days after claim construction ruling	Pat L.R. 3-8	Service of opinion of counsel for willfulness defense
			Close of discovery for infringement for all fact and expert witnesses
			Dispositive motion and opening brief filing deadline
			Response briefs
			Reply briefs
			Summary judgment hearing
			Summary judgment ruling
			Pretrial order
			Pretrial conference
	At court's convenience		Trial

The above schedule presupposes that all parties will proceed with discovery cooperatively and as provided by the Federal Rules of Civil Procedure, the orders of this Court, and applicable law. Defendants specifically reserve their right to petition the Court to modify and/or amend this schedule if the circumstances so warrant.

Should the case not be resolved on dispositive motions, defendants believe that the trial will last approximately 10 days. Plaintiff has requested a jury trial in his complaint. Defendants

1 believe that California Unfair Competition Act claim (if not dismissed) can and should be
2 bifurcated and stayed pending resolution of the patent enforceability claims and have filed a motion
3 to this effect. **Defendants do not agree with Plaintiff's proposal outlined below.**

4 **Plaintiff's proposal:**

5 In the absence of a 26(f) conference, the Plaintiff proposes the following: Given the state of the
6 litigation, Plaintiff believes that several factors could cause discovery to last longer than it would
7 otherwise, and would thereby delay trial. These factors are foreign discovery, procedures relating
8 to the patent causes of action, and electronic discovery issues. Plaintiff therefore proposes the
9 following to make it less likely that these factors will cause delay.

10 Foreign discovery: The parties will identify foreign witnesses they may seek discovery from, and
11 contact these witnesses to determine arrangements to be made (court orders etc.) to obtain
12 discovery and take depositions abroad. The parties will file any motions for court orders relating to
13 obtaining foreign discovery and taking foreign depositions by Feb. 16, 2007. The parties will be
14 permitted to seek court orders for witnesses they later learn about, or for other good cause.

15 Patent causes of action: Plaintiff proposes that, by Feb. 8, 2007, Defendants identify any parties
16 they intend to sue for infringement, and identify the claims they will assert against these parties.
17 The Patent Local Rules timeline will begin unless added parties seek relief from the schedule.

18 Electronic discovery: With the Dec. 1, 2006 changes in the Federal Rules of Civil Procedure
19 relating to electronic discovery, Plaintiff proposes the parties meet and confer to address issues
20 relating to electronic discovery and report to the Court by Mar. 20, 2007 to resolve any issues.

21 Other dates: If the Court does not dismiss any claims in the Amended Complaint, Defendants will
22 file an Answer with any counterclaims by Feb. 8, 2007. Should the Court dismiss any claims
23 without prejudice, Plaintiff will file a Second Amended Complaint within 20 days of this Court's
24 Written Ruling dismissing the claim(s). Plaintiff believes that he should defer filing a Second
25 Amended Complaint until after reviewing this Court's ruling so that he may draft the Second
26 Amended Complaint with the basis for the ruling in mind. Defendants will file an Answer with
27 any counterclaims, along with any motions to dismiss, within 20 days of Plaintiff's filing, or notice
28 that no Second Amended Complaint will be filed. If no additional parties are added, Plaintiff will

1 file an Answer to Defendants’ counterclaims, and any motions related to Defendants’ filings,
 2 within 45 days of Defendants’ filings. (As Defendants stated they intend to bring multiple
 3 counterclaims against multiple parties, twenty days proposed by Defendants is too short, and not
 4 nearly the amount of time – 10 months – that Defendants have had to file an Answer.) If additional
 5 parties are added, Plaintiff will file an Answer to Defendants’ counterclaims, and any motions
 6 related to Defendants’ filings, within 90 days of Defendants’ filings due to the need to consult with
 7 the additional parties on joint defense issues. Twenty days after Defendants’ Answer is filed, or
 8 any Answer Plaintiff files in response to Defendants’ counterclaims, whichever is later, the parties
 9 will meet and confer for their Rule 26(f) conference. The parties will draft a discovery plan at that
 10 time, file it within 14 days of the Rule 26(f) conference, and file a motion for further CMC.

11 Plaintiff believes this is the best course to prevent delay, given that no Answer has been
 12 filed and that, without an Answer and without information about additional parties or
 13 counterclaims, he cannot reasonably estimate the time needed for discovery. He also recommends
 14 against using Defendants’ time table for these reasons, and because it does not account for foreign
 15 discovery, electronic discovery, or discovery on non-patent causes of action. Thus, Plaintiff
 16 believes it would be most economical to limit setting dates to those discussed above.

17 **12. Current Service List**

Plaintiff Jacobsen	Defendants KAM and Katzer
Victoria K. Hall Law Office of Victoria K. Hall 401 N. Washington Street, Suite 550 Rockville, MD 20850 Tel: (301) 738-7677 Fax: (240) 536-9142 Email: Victoria@vkhall-law.com	R. Scott Jerger Field Jerger, LLP 610 SW Alder Street, Suite 910 Portland, OR 97205 Tel: (503) 228-9115 Fax: (503) 225-0276 Email: scott@fieldjerger.com
	John C. Gorman Gorman & Miller, P.C. 210 N 4th Street, Suite 200 San Jose, CA 95112 Tel: (408) 297-2222 Fax: (408) 297-2224 Email: jgorman@gormanmiller.com

26 **13. Other items not addressed by Civil L.R. 16-10**

27 Not applicable

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14. Disclosures

As discussed in defendants Matthew Katzer and KAM's certificate of interested entities, Barbara Dawson has an interest that could be substantially affected by the outcome of this proceeding. As noted in Plaintiff's updated certificate of interested entities [Docket # 109], Plaintiff believes parties affected by an adverse, general ruling relating to open source licenses include any open source group that relies on these licenses to protect their intellectual property rights. Plaintiff believes the Artistic License, which JMRI uses, is relied upon by multiple open source projects. Plaintiff believes the largest is Perl, which is used for a very large number of websites and applications, including the PACER document system. Plaintiff also respectfully suggests that the Court order Defendants to identify parties they intend to name in the litigation so that any recusal or disqualification issues may be addressed early on.

Respectfully submitted,

Dated: Jan. 16, 2007

/s/
VICTORIA K. HALL (SBN 240702)
Attorney
Law Office of Victoria K. Hall
Attorney for Plaintiff Robert Jacobsen

~~/s/
R. SCOTT JERGER (pro hac vice)
Attorney
Field Jerger LLP
Attorney for Defendants Katzer and KAMIND
Associates, Inc.~~

[PROPOSED] JOINT CASE MANAGEMENT ORDER

Having received the Joint Case Management Statement, the Court orders the parties to proceed with:

- () Plaintiff's proposed discovery and litigation schedule
- () Defendants' proposed discovery and litigation schedule.

DATED: _____

By _____
JEFFREY S. WHITE
UNITED STATES DISTRICT JUDGE