

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

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

ROBERT JACOBSEN,	)	No. C-06-1905-JSW
	)	
Plaintiff,	)	<b>CASE MANAGEMENT STATEMENT</b>
	)	<b>AND [PROPOSED] ORDER</b>
v.	)	
	)	Date: Aug. 11, 2006
MATTHEW KATZER, et al.,	)	Time: 9:00 a.m.
	)	Location: 17th Floor, Courtroom 2
Defendants.	)	Judge: Honorable Jeffrey S. White
	)	
	)	
	)	
	)	

Plaintiff Robert Jacobsen submits this case management statement and requests that the Court adopt this case management statement in its Case Management Order. Plaintiff worked with all Defendants in developing this Case Management Statement, but at the last minute, Defendant Russell, through his counsel David M. Zeff, objected to the statement without identifying the cause for concern and without recommending changes. He refused to cooperate with Plaintiff's counsel further. Counsel for Defendants Katzer and KAMIND Associates, Inc., Mr. Scott Jerger, said he left town the afternoon of Friday, August 4, 2006. His paralegal, Mr. Jonathan Smale, sent a newer version that Mr. Zeff consented to, but Mr. Smale sent it to an email address that Plaintiff's counsel does not check regularly, and she has told defense counsel she does not check this email address

1 regularly. Plaintiff's counsel found it around 9 p.m. Pacific time on Aug. 4, 2006. Plaintiff's  
2 counsel has to make a small, but necessary change re the signatures, plus add a proposed order, on  
3 Defendants' proposed version, and she does not have their authority to make any changes. She and  
4 Mr. Jerger did speak around 11 p.m., and he authorized her to make the changes to their version,  
5 but Mr. Zeff was unavailable. Thus, Mr. Jacobsen submits this case management statement on his  
6 own, and has included a signature block for defense counsel to sign and efile should they chose to  
7 agree to this version. The versions are nearly the same.

8 **1. A brief description of jurisdictional issues**

9 Plaintiff Jacobsen filed his Complaint on March 13, 2006. The complaint alleges that  
10 defendants fraudulently procured nearly a dozen patents and sought to enforce them through  
11 various unlawful, unfair and fraudulent means. The complaint also contains claims alleging  
12 antitrust violations, unfair competition, cyber-squatting, and libel.

13 The declaratory judgment re one Katzer patent, and the Sherman Act and the Lanham Act  
14 (cyber-squatting) claims involve federal questions. 28 U.S.C. § 1331. The plaintiff has also  
15 brought a libel claim under California law and a California Unfair Competition Act claim  
16 (California Business & Professions Code § 17200 *et seq.*). Jurisdiction is proper in this Court for  
17 these state law claims based on the supplemental jurisdiction of this Court. 28 U.S.C. § 1367.  
18 Subject matter jurisdiction in the case against Mr. Russell is proper despite the claim for less than  
19 the jurisdictional amount because Plaintiff seeks punitive damages.

20 Re the Sherman Act claim, defendants KAM and Katzer have filed a motion to dismiss the  
21 Sherman Act claim, *inter alia*, asserting that the plaintiff does not have standing to bring such a  
22 claim and therefore this Court does not have subject matter jurisdiction. Fed. R. Civ. P. 12(b)(1).  
23 Plaintiff believes subject matter jurisdiction exists because there is no argument re constitutional  
24 standing.

25 Defendant Kevin Russell has filed a motion to dismiss for lack of personal jurisdiction  
26 (12(b)(2)). Plaintiff believes that Mr. Russell is subject to specific personal jurisdiction.

27 No parties remain to be served in this lawsuit.

28 //

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

2           Plaintiff Jacobsen is a high energy physicist who does research at the Lawrence Berkeley  
3 National Laboratory of the University of California, and Stanford University and at CERN in  
4 Switzerland, and teaches physics at the University. As a hobby, Jacobsen develops, with others,  
5 open source software code called JMRI (Java Model Railroad Interface) that Jacobsen alleges is  
6 distributed free of charge, or at cost. KAM is an Oregon corporation and Katzer is its principal.  
7 Russell is the attorney for Katzer and KAM. Defendants state that KAM has patents for software  
8 products, at least one of which is similar to and is infringed by the JMRI project software.  
9 Defendants assert that KAM's software products' function is similar to the software products  
10 provided for free by JMRI. Jacobsen alleges that Katzer and Russell intentionally withheld prior  
11 art that they knew was material to patentability from the Patent Office in obtaining the patents and  
12 for these reasons, as well as others, Jacobsen alleges that said patents are thereby invalid and/or  
13 unenforceable.

14           Jacobsen's complaint seeks declaratory relief regarding noninfringement, invalidity, and  
15 unenforceability of the patent-in-suit, U.S. Pat. No. 6,520,329, which per the U.S. Patent and  
16 Trademark Office website is assigned to Katzer, but which Defendant Katzer and KAM state is  
17 held by KAM. The complaint alleges that the patent-in-suit is invalid because prior art anticipates  
18 or makes it obvious, that it failed to meet the requirements of 35 U.S.C. Sec. 112. The complaint  
19 also alleges the patent-in-suit, and related patents, were obtained through fraud on the patent office  
20 or inequitable conduct. The complaint also contains claims alleging antitrust violations, unfair  
21 competition, cyber-squatting, and libel.

22           Defendants believe that KAM's patents are valid. Defendants have filed motions to dismiss  
23 the libel claim based on California's anti-SLAPP law, Cal. Code Civ. Pro § 425.16(b)(1).  
24 Defendant Kevin Russell has filed a motion to dismiss Counts 5 and 7 of the complaint for failure  
25 to state a claim and lack of personal jurisdiction. Defendants Matthew Katzer and KAM have filed  
26 a motion to dismiss Counts 4 and 7 of the complaint and a motion to bifurcate and stay discovery  
27 on Count 5.

28           //

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

2           Plaintiff believes that defendants KAM and Katzer have invalid and/or unenforceable  
3 patents, have violated the Sherman Act, California Unfair Competition Act, and the Lanham Act  
4 by cybersquatting, and have libeled plaintiff in a FOIA request submitted to the U.S. Department of  
5 Energy. Plaintiff asserts that Russell has libeled him and violated California Bus. & Prof. Code  
6 17200 *et seq.* Defendants dispute all of these claims and have filed several dispositive motions at  
7 this time.

8           **4. Procedural History**

9           Plaintiff's complaint was filed on March 13, 2006. The following motions will be heard on  
10 August 11, 2006. The initial case management conference will also be held on August 11, 2006.

11           (1) Anti-SLAPP motions to strike by Defendants KAM, Katzer and Russell.

12           (2) Defendant Russell's motion to dismiss counts 5 and 7.

13           (3) Defendants KAM and Katzer's motion to dismiss counts 4 and 7 and motion to bifurcate  
14 and stay count 5.

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

16           No initial disclosures have been made. Per order of this Court, the date for initial Fed. R.  
17 Civ. P. 26 disclosures will be set by the Court at the initial case management conference on August  
18 11, 2006 (Docket #41). The parties have conferred and suggest a date of Sept. 5, 2006.

19           **6. Discovery Plan**

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

21           A. List of Potentially Key Witnesses

- 22           1. Matthew Katzer  
23           2. Robert Jacobsen  
24           3. Hans Tanner  
25           4. John Plocher  
26           5. A.J. Ireland  
27           6. Strad Bushby  
28           7. John E. Kabat

- 1 8. Juergen Freiwald
  - 2 9. Dick Bronson
  - 3 10. Jerry Britton
  - 4 11. Developers of the JMRI software.
  - 5 12. Developers and manufacturers of third party model train software
  - 6 13. Contributors and users of the JMRI software
  - 7 14. Unknown employees and supervisors at the Lawrence Berkeley National Laboratory
  - 8 15. Dean of the UC Berkeley Physics Department
  - 9 16. Unknown employees and supervisors at the US Department of Energy
  - 10 17. Kevin Russell
  - 11 18. Glenn Butcher
  - 12 19. Unknown employees of KAMIND Associates, Inc.
  - 13 20. Unknown employees of Chernoff, Vilhauer, McClung and Stenzel.
  - 14 21. Examiners at the U.S. Patent & Trademark Office.
  - 15 22. Unknown members of the NMRA.
  - 16 23. Unknown employees of Marklin.
  - 17 24. Stan Ames.
  - 18 25. Rutger Friburg.
  - 19 26. Ed Loizeaux.
  - 20 27. Unknown employees of Train Track Computer Systems, Inc.
  - 21 28. Roger Webster
  - 22 29. John McCormick
  - 23 30. John Littman
  - 24 31. Dr. Bruce Chubb
  - 25 32. Unknown members of the Tech Model Railroad Club of MIT
- 26 Plaintiff has yet to receive Answers from defendants, and cannot determine what additional  
27 witnesses may be necessary to call in response to those Answers. Plaintiff also believes it is  
28 premature to engage in developing a detailed discovery plan given the posture of the case, that an

1 amended complaint will be filed shortly with more claims, and that early summary judgment  
2 motions will be filed. Thus, Plaintiff reserves the right to name others who will be key witnesses in  
3 the case.

4 B. List of Key Information

- 5 1. All versions of the JMRI software.
- 6 2. All software development information for the JMRI software project.
- 7 3. All information relating to JMRI's market share.
- 8 4. All information relating to the "lost income" referenced in ¶ 7 of the complaint.
- 9 5. All versions of any relevant KAM software, including but not limited to alpha, beta and released  
10 versions.
- 11 6. All references in Katzer, KAM and Russell's possession that relate to patentability.
- 12 7. All plans relating to enforcing the Katzer patents.
- 13 8. All plans relating cybersquatting on others' trademarks.
- 14 9. All plans for filing intellectual property rights on behalf of Katzer, and KAM and its related  
15 entities.
- 16 10. All evidence that the patent(s)-in-suit meet, or do not meet, the requirements of 35 U.S.C. Sec.  
17 112.
- 18 11. All financial information relating to KAM and its related entities.
- 19 12. File wrappers for the patent application, and related patent applications, that issued as the  
20 patent-in-suit.
- 21 13. Trademark applications for all KAM products.
- 22 14. All emails from Jacobsen to any JMRI user, NMRA member, or other hobbyist related to  
23 JMRI or model train software.

24 Plaintiff believes that significant evidence is in the Record that will permit Plaintiff to seek early  
25 summary judgment on several claims. Plaintiff also will add claims shortly in an amended  
26 complaint. Thus, Plaintiff believes that it is premature to offer a detailed discovery plan until the  
27 amended complaint is filed, early summary judgment motions have been heard, and the parties  
28 have gone through the ADR process. Furthermore, Plaintiff has yet to receive Answers from

1 defendants, and cannot determine what additional information he will seek in response to those  
 2 Answers. Plaintiff thus reserves the right to seek further key information.

3 **7. Motions before trial**

4 Jacobsen, KAM and Katzer anticipate motions for summary judgment prior to trial on  
 5 virtually all of plaintiff's claims. If Russell remains in the case, he too will move for summary  
 6 judgment before trial as to all claims against him. KAM and Katzer anticipate that new parties will  
 7 be added and further anticipate evidentiary and claim-construction hearings. Jacobsen may also add  
 8 parties to the amended Complaint.

9 **8. Description of Relief Sought**

10 Plaintiff seeks declaratory and injunctive relief, as well as loss of income among other  
 11 damages. Defendants believe Plaintiff has not described the calculation of damages in the  
 12 complaint. Plaintiff seeks lost income, presumed damages, punitive damages, and injunctive relief,  
 13 and will seek costs and attorney's fees. KAM's counterclaims will include claims for monetary  
 14 damages, including reasonable royalty, and/or lost profits, and/or enhanced damages, and/or  
 15 attorney fees.

16 **9. ADR Efforts to Date**

17 There have been no ADR efforts to date. The parties will meet and confer on August 22,  
 18 2006 and file the ADR certification. Plaintiff will select a Settlement Conference as his first  
 19 choice, with Early Neutral Evaluation as a second choice. No settlement conference has been  
 20 scheduled at this time. Defendant Russell, if he remains in the case, will opt for ENE.

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

22 The defendants do not consent to a magistrate judge.

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

24 Defendants' proposal:

Date	Counting	Rule	Event
3/13/06			Complaint
			Answer, counterclaims, cross claims, and additional parties

Date	Counting	Rule	Event
			Answers to counterclaims, cross claims, and by additional parties
8/11/06		FRCP 26 f	Initial case mgmt conference
8/21/06	10 days after initial case mgmt conf	Pat. L.R. 3-1, FRCP 26a, L.R. 16.8	Preliminary infringement contentions; Meet and Confer re initial disclosures and file joint ADR certification
8/25/06	14 days after initial case mgmt conf unless waived	FRCP 26 a	Initial disclosures
10/1/06	45 days after preliminary infringement contentions	Pat L.R. 3-3	Preliminary 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
10/10/06	10 days after preliminary invalidity contentions	Pat L.R. 4-1	Simultaneous exchange of terms to be construed
10/30/06	20 days after exchange of terms to be construed	Pat L.R. 4-1	Simultaneous exchange of preliminary claim constructions
1/2/07	60 days after exchange of preliminary claim constructions	Pat L.R. 4-1	Joint claim construction and Prehearing statement
2/1/07	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
2/16/07	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
3/2/07	14 days after service of opening	Pat L.R. 4-5	Response Markman brief



<b>Date</b>	<b>Counting</b>	<b>Rule</b>	<b>Event</b>
	Markman		
3/9/07	7 days after service of responsive Markman	Pat L.R. 4-5	Reply Markman brief
3/23/07	7-14 days prior to claim construction hearing	Standing Order ¶ 7	Tutorial
3/30/07	14 days after service of reply Markman and at court's convenience	Pat L.R. 4-6	Claim construction hearing
4/30/07	Court's convenience		Claim construction ruling
5/30/07	30 days after claim construction ruling	Pat L.R. 3-6	File final infringement contentions
6/19/07	50 days after claim construction ruling	Pat L.R. 3-6	File final invalidity contentions
6/19/07	50 days after claim construction ruling	Pat L.R. 3-8	Service of opinion of counsel for willfulness defense
7/19/07			Close of discovery for infringement for all fact and expert witnesses
8/24/07			Dispositive motion and opening brief filing deadline
9/7/07			Response briefs
9/21/07			Reply briefs
10/5/07			Summary judgment hearing
11/2/07			Summary judgment ruling
11/16/07			Pretrial order
12/14/07			Pretrial conference
1/ -- /08	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.

1           Should the case not be resolved on dispositive motions, defendants believe that the trial will  
2 last approximately 10 days. Plaintiff has requested a jury trial in his complaint. Defendants  
3 believe that all of the non-patent issues can and should be bifurcated and stayed pending resolution  
4 of the patent enforceability claims and have filed a motion to this effect.

5 Plaintiff's proposal:

6           Plaintiff believes that a number of claims may be resolved in his favor on early summary  
7 judgment motions, and that the ADR process may result in settling the case. Furthermore, without  
8 Answers from defendants, Plaintiff can make no estimate on the time needed in the schedule  
9 above, and thus declines to do so. Since bifurcation would delay the resolution of the case at  
10 additional expense to Plaintiff, with no benefit in efficiency to the judicial system, Plaintiff opposes  
11 bifurcation. Plaintiff also expects to file an amended Complaint shortly, with added claims, which  
12 should be considered prior to granting a motion for bifurcation. The amended Complaint may  
13 result in another series of motions to dismiss. Plaintiff believes it would be most economical to the  
14 Court to set only those dates noted in Docket 41, a deadline for an amended Complaint, a deadline  
15 for new motions to dismiss and any early summary judgment and other motions, and the next case  
16 management conference. He suggests the next case management conference be held in late  
17 October, or mid-December.

18  
19           **12. Current Service List**

20 R. Scott Jerger  
21 Field & Jerger, LLP  
22 610 SW Alder Street, Suite 910  
23 Portland, OR 97205  
Tel: (503) 228-9115  
Fax: (503) 225-0276  
Email: [scott@fieldjerger.com](mailto:scott@fieldjerger.com)

24 John C. Gorman  
25 Gorman & Miller, P.C.  
26 210 N 4th Street, Suite 200  
27 San Jose, CA 95112  
Tel: (408) 297-2222  
Fax: (408) 297-2224  
Email: [jgorman@gormanmiller.com](mailto:jgorman@gormanmiller.com)

1 Victoria K. Hall  
2 Law Office of Victoria K. Hall  
3 401 N. Washington Street, Suite 550  
4 Rockville, MD 20850  
5 Tel: (301) 738-7677  
6 Fax: (240) 536-9142  
7 Email: Victoria@vkhall-law.com

8 David M. Zeff  
9 Law Office of David M. Zeff  
10 1388 Sutter Street, Suite 820  
11 San Francisco, CA 94109  
12 Tel: (415) 923-1380  
13 Fax: (415) 923-1382  
14 Email: ZeffLaw1@aol.com

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

16 Not applicable

17 **14. Disclosures**

18 Defendants KAM and Katzer

19 As discussed in defendants Matthew Katzer and KAM's certificate of interested entities,  
20 Barbara Dawson has an interest that could be substantially affected by the outcome of this  
21 proceeding.

22 Plaintiff

23 This information is provided per the Recusal Order. Except for Mr. Jacobsen, none of the  
24 parties listed below has any interest in this case. Mr. Jacobsen does not seek recusal.

25 Mr. Jacobsen is a physics professor at UC Berkeley, associate dean for undergraduate  
26 advising, and has an appointment at the Lawrence Berkeley National Laboratory. He is chair of the  
27 UC Berkeley Academic Senate faculty committee on undergraduate admissions, and as such, is  
28 acquainted with Dean Edley at Boalt Hall, and serves on two committees with Prof. Jesse Choper.

//

//

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Respectfully submitted,

Attorney for Plaintiff Robert Jacobsen

VICTORIA K. HALL  
Law Office of Victoria K. Hall

Dated: Aug. 4, 2006

\_\_\_\_\_/s/\_\_\_\_\_  
VICTORIA K. HALL (SBN 240602)  
Attorney  
Law Office of Victoria K. Hall

The signature blocks below are provided for e-filing should the defendants choose to agree to this Case Management Statement.

Attorney for Defendants Katzer  
and KAMIND Associates, Inc.

R. SCOTT JERGER  
Field and Jerger

JOHN C. GORMAN  
Gorman & Miller

Dated: \_\_\_\_\_

\_\_\_\_\_  
R. SCOTT JERGER (*pro hac vice*)  
Attorney  
Field and Jerger

Attorney for Defendant Kevin Russell

DAVID M. ZEFF  
Law Offices of David M. Zeff

Dated: \_\_\_\_\_

\_\_\_\_\_  
DAVID M. ZEFF (SBN 63289)  
Attorney  
Law Offices of David M. Zeff

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

[PROPOSED] CASE MANAGEMENT ORDER

Having received the Case Management Statement, the Court orders the parties to meet and confer re ADR and initial disclosures by August 22, 2006, and to complete initial Rule 26(f) disclosures by Sept. 5, 2006.

The party whose discovery and litigation schedule is adopted by the Court at the initial case management conference shall prepare a proposed order reflecting the Court's decision, and submit it to this Court to adopt.

DATED: \_\_\_\_\_

By \_\_\_\_\_  
JEFFREY S. WHITE  
UNITED STATES DISTRICT JUDGE