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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

ROBERT JACOBSEN, an individual, Plaintiff, v. MATTHEW KATZER, an individual, and KAMIND ASSOCIATES, INC., an Oregon corporation dba KAM Industries, Defendants.	No. C06-1905-JSW **MOTION FOR LEAVE TO FILE SURREPLY TO DEFENDANTS REPLY MEMORANDUM** Courtroom: 2, 17th Floor Judge: Hon. Jeffrey S. White

Plaintiff Robert Jacobsen seeks leave to file a Surreply to Defendants' Reply Memorandum [Docket #127]. A Surreply may be filed if the opposing party introduces new material is its reply. E.g. Clark v. Mason, No. C04-1647C, 2005 WL 1189577, at * 3 (W.D. Wash. May 19, 2005). Defendants introduced new arguments in their Reply: (1) Federal Rules of Civil Procedure 12(g) does not apply, (2) JMRI owns the trademark, not Mr. Jacobsen, and (3) this Court has ruled the Tapley decision holds that portions of the prayer for relief may be stricken. Plaintiff files this motion for leave to file a Surreply to respond to these arguments. The short proposed Surreply is

included in Appendix A.

DATED: December 4, 2006

By /s/

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Appendix A

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I. Introduction

Plaintiff Robert Jacobsen responds to Defendants' Reply Memorandum [Docket #127] to address three arguments which Defendants raised for the first time in their Reply.

II. Argument

First, contrary to Defendants' assertions, Federal Rules of Civil Procedure Rule 12(g) does bar certain of their pre-answer Motions: their Motion to Dismiss for Failure to Join a Party under Rule 19, their Motion to Dismiss Count V and their Motion to Strike. The case law Defendants

cite is inapplicable.

Rule 12(g) is clear: If a party files a Rule 12 motion, he must include all other Rule 12 motions then available to him or else he waives the defense or objection – unless he may make the motion again per Rule 12(h). Charles Wright & Alan Miller, 5B Federal Practice and Procedure § 1388 ("The filing of an amended complaint will not revive the right to present by motion defense that were available but were not asserted in a timely fashion prior to the amendment of the pleadings….") In this case, Rule 12(h)(2) applies, and thus, Defendants may only make the 12(b)(6) and 12(b)(7) motion in a responsive pleading under Rule 7(a), a motion for judgment on the pleadings, or at trial on the merits. Count 6 was in the original Complaint, and thus the 12(b)(7) motion was available to Defendants when they filed their first motion to dismiss [Docket #42]. Also, Count 5 was in the original Complaint, so the 12(b)(6) motion was also available to Defendants. According to the Rule 12(h)(2), the next opportunity for Defendants to file these Motions is when they file their Answer. Because the portions of the Motion to Strike which were in the Original Complaint but not objected to, do not pertain to an insufficient defense, Defendants are permanently barred by Rule 12(g) from making a motion to strike relating to them. Thus, these motions should be dismissed.

Defendants misstate three cases in support of their assertions that they may raise these defenses now. Schabel v. Lui does not hold that nonwaivable defenses can be raised at any time. It permits a defendant who has not been served with process and who does not join a Rule 12 motion with defendants who have been served with process to raise Rule 12 defenses and objections in a later motion. In Schabel, two defendants (Froyer USA and FSN Top Secret) had not been served with summons. 302 F.3d 1023, 1033 (9th Cir. 2002). At appeal, both argued that the district court lacked personal jurisdiction. Id. However, despite not having been served with summons, one of the two defendants (Froyer USA) had explicitly joined other defendants (who had been served with summons) in an earlier Rule 12(b) motion. Id. That defendant was not permitted to raise the Rule 12(b)(2) defense of lack of personal jurisdiction later on. Id. at 1034. The Ninth Circuit considered the lack of personal jurisdiction arguments of the other defendant (FSN Top Secret) because, the Court held, that defendant was not required to join in other defendants' Rule

12 motion. "[N]othing in [Rule 12] requires codefendants represented by the same counsel to raise or waive all their defenses together." Id. Here, both defendants have filed a Rule 12 motion earlier in this litigation. Thus, they both should have raised all defenses and objections then available to them in that earlier Rule 12 motion. Because they have not, they may not file another Rule 12 motion based on those earlier defenses and objections until they make filings per Rule 12(h)(2). Likewise, Freeman v. Northwest Acceptance Corporation does not state that nonwaivable defenses may be raised at any time. In Freeman, the Fifth Circuit addressed whether plaintiffs had circumvented subject matter jurisdiction rules. 754 F.2d 553, 555 (5th Cir. 1985). Only after concluding that plaintiffs had, and that diversity jurisdiction had been destroyed, did the Fifth Circuit address another basis for its ruling: failure to join an indispensable party which would have also destroyed diversity. Id. at 559. Defendants did not raise the defense at trial. Id. The Fifth Circuit held that this did not result in waiver on appeal. See id. Contrary to Katzer and KAMIND Associates, Inc.'s interpretation of this case law, the Fifth Circuit did not rule that defendants who had not included a Rule 12 defense or objection, then available to them, with a Rule 12 motion, could later file another Rule 12 motion at any time, without regard for Rule 12(g) and Rule 12(h). Finally, Rosenblatt v. United Air Lines also does not hold that Defendants may raise, specifically, a Rule 12(f) objection any time they choose. Instead, it holds that, per Rule 12(f), the Court may sua sponte strike a portion of the pleading under the provisions of the rule. 21 F.R.D. 110, 111 (S.D.N.Y. 1957).

Plaintiff believes that Rule 12(g) should govern and bar those Motions which Plaintiff has identified. He relies on Wright and Miller, the civil procedure treatise. Other courts also follow the rule outlined in Rule 12(g). E.g., English v. Dyke, 23 F.3d 1086, 1090 (6th Cir. 1994) ("Any defense that is available at the time of the original motion but is not included, may not be the basis for a second pre-answer motion."). Thus, this Court should bar these Motions.

Plaintiff addresses briefly two other points which Defendants raised: the owner of DecoderPro® and the Court which issued the Wells decision which Defendants cited in their Tapley arguments.

Defendants state that Plaintiff does not own DecoderPro®. He does. See Amended

Complaint, at ¶ 45.

Defendants identify this Court as having issued a decision which states that Tapley v. Lockwood Green Engineers Inc. holds that a portion of a Prayer for Relief may be stricken under Rule 12(f). This is incorrect. The Wells v. Board of Trustees of the California State University decision was issued by another Court in the Northern District of California. See 393 F. Supp. 2d 990, 990 (N.D. Cal. 2005).

III. Conclusion

Plaintiff respectfully asks the Court to deny those Motions to Dismiss and Strike which are barred by Rule 12(g), and to find that he is the owner of the DecoderPro® trademark.

Respectfully submitted,

DATED: December 4, 2006

By /s/

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