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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 August 17, 2007 order [Docket #158], the parties submit this Joint Case Management Statement.

1. A brief description of jurisdictional issues

Plaintiff Jacobsen filed an Amended Complaint Sept. 11, 2006. After the court’s August 17, 2007 ruling, the remaining claims are three declaratory judgment causes of action relating to patent issues, a copyright infringement cause of action, and a federal trademark dilution cause of action. These claims involve federal questions. The court has subject matter jurisdiction under 28 U.S.C. § 1331. No defendants remain to be served.

2. A brief description of the case and defenses

Plaintiff Jacobsen is a high energy physicist who does research at the Lawrence Berkeley National Laboratory of the University of California, and Stanford University and at CERN in

1 Switzerland, and teaches physics at the University. As a hobby, Jacobsen develops, with others,
2 open source software code called JMRI (Java Model Railroad Interface) that Jacobsen alleges is
3 distributed free of charge. KAM is an Oregon corporation and Katzer is its principal. Defendants
4 allege that KAM has patents for software products, at least one of which is similar to and is
5 infringed by the JMRI project software. Defendants assert that KAM's software products are
6 infringed by software products provided for free by JMRI. Jacobsen alleges that Katzer and his
7 attorney, Kevin Russell, intentionally withheld prior art that they knew was material to
8 patentability from the Patent Office in obtaining the patents and for these reasons, as well as others,
9 Jacobsen alleges that said patents are thereby invalid and/or unenforceable. Jacobsen alleges that
10 he does not infringe the claim Defendants accused him of infringing.

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

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

21 All legal issues are in dispute.

22 **4. Procedural History**

23 Plaintiff filed his complaint Mar. 13, 2006. Defendants and then-defendant Kevin Russell filed
24 motions to dismiss and anti-SLAPP motions in May 2006. The Court granted Defendants' and Mr.
25 Russell's motions, which dismissed antitrust and libel claims against Defendants, and dismissed
26 Mr. Russell from the action. Plaintiff filed an amended complaint Sept. 11, 2006. On Sept. 28,
27 2006, Defendants filed motions to dismiss copyright, § 17200, cybersquatting, and unjust
28 enrichment claims, and a motion to strike portions of the amended complaint and a motion for

1 more definite statement for the dilution claim. Plaintiff filed a motion for preliminary injunction to
2 enjoin Defendants' alleged copyright infringement on Oct. 24, 2006. Defendants withdrew their
3 motion to dismiss the copyright infringement claim, and motion for more definite statement,
4 without prejudice, on Nov. 17, 2006. The Court granted all of the motions Defendants sought, and
5 denied Plaintiff's motion for preliminary injunction to enjoin Defendants' copyright infringement.
6 Plaintiff will appeal the denial of his motion for preliminary injunction. On Sept. 4, 2007, Plaintiff
7 filed a motion for leave to file motion for reconsideration of the Court's August 17, 2007 ruling.

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

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

10 **6. Discovery Plan**

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

12 A. List of Potentially Key Witnesses

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

- 15 1. Matthew Katzer,
- 16 2. Robert Jacobsen,
- 17 3. Hans Tanner,
- 18 4. John Plocher,
- 19 5. A.J. Ireland,
- 20 6. Strad Bushby,
- 21 7. John E. Kabat,
- 22 8. Juergen Freiwald,
- 23 9. Dick Bronson,
- 24 10. Jerry Britton,
- 25 11. Contributors, resellers, distributors and developers of the JMRI software, Developers and
26 manufacturers of third party model train software,
- 27 13. Contributors and users of the JMRI software (U.S. and foreign),
- 28 14. Unknown employees and supervisors at the Lawrence Berkeley National Laboratory,

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

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

28 B. List of Key Information

- 1 1. All versions of the JMRI software, and any KAM software development.
- 2 2. All software development information for the JMRI software project.
- 3 3. All information relating to JMRI's market share.
- 4 4. All information in Katzer and KAM's, and their attorney Kevin Russell's, possession that are
- 5 relevant to patentability of patents and applications in Katzer portfolio.
- 6 5. All information relating to enforcing the Katzer patents.
- 7 6. All information relating Defendants' cybersquatting on, use of , or registering the domain names
- 8 of, others' trademarks, trade names, and the like.
- 9 7. All plans for filing intellectual property rights on behalf of Katzer, and KAM and its related
- 10 entities.
- 11 8. All evidence that the patent(s)-in-suit meet, or do not meet, requirements of 35 U.S.C. § 112.
- 12 9. All financial information relating to KAM and its related entities.
- 13 10. File wrappers for the patent application, and related patent applications, that issued as the
- 14 patent-in-suit.
- 15 11. Trademark applications for all KAM products.
- 16 12. All emails from Jacobsen to any JMRI user, NMRA member, or other hobbyist related to
- 17 JMRI or model train software.
- 18 13. All correspondence to and from Defendants and their agents and employees, to any person at
- 19 Lawrence Berkeley Laboratory (LBL), University of California, Lawrence Livermore National
- 20 Laboratory (LLNL), or Los Alamos National Laboratory (LANL), relating to model trains.
- 21 14. Identification of all email addresses used by Mr. Katzer since January 1, 1987.
- 22 15. Identification of all agents or others who sell Defendants' products.
- 23 16. All documents relating to plans for the use of the JMRI code in Defendants' products.
- 24 17. The number of Defendants' products that have been shipped, and the number of downloads of
- 25 Defendants' products from their or their agents' websites.
- 26 18. All emails from JMRI users to Jacobsen related to JMRI or model train software.
- 27 19. Identification of all email addresses used by Jacobsen since 1987.
- 28

1 20. All business and financial records of the JMRI group and all business and financial records of
2 Jacobsen relating to the JMRI group.

3 21. All communications between Jacobsen and/or JMRI with any person relating to this lawsuit.

4 22. Identification of all distributors of JMRI software.

5 23. Identification of all members or contributors to the JMRI project.

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

11 **7. Motions before trial**

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

15 **8. Description of Relief Sought**

16 Generally, Plaintiff seeks declaratory and injunctive relief, damages for copyright
17 infringement, and costs and attorney's fees. Defendants believe Plaintiff has not described the
18 calculation of damages in the complaint. KAM's counterclaims will include claims for permanent
19 injunctive relief and for monetary damages, including reasonable royalty, and/or lost profits, and/or
20 enhanced damages, and/or attorney fees.

21 **9. ADR Efforts to Date**

22 The parties completed ADR on Dec. 5, 2006. The parties and the ADR mediator exchange
23 emails with the mediator on a quarterly basis to give the mediator a status update. Plaintiff and
24 Defendants believe that further ADR will not be productive until, at least, summary judgment
25 motions are heard, or after claim construction.

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

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

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

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

3 **Defendants' proposal:**

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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
9/14/07			Case Management Conference
TBD			Answer, Counterclaims, Cross Claims and additional parties
TBD	20 days after filing of defendant's Answer		Reply to counterclaims, cross claims and answer of additional parties
			Optional Additional Case Management Conference
	20 days after Reply is filed		Preliminary infringement contentions
	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	Pat L.R. 3-5	File final invalidity

Date	Counting	Rule	Event
	ALLEGED, 50 days after preliminary invalidity contentions are served		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
4/17/08			Close of fact discovery for all non-patent claims
	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
5/15/08			Plaintiff's expert disclosures for non-patent claims
	7 days after service of responsive Markman	Pat L.R. 4-5	Reply Markman brief
6/15/08			Defendant's expert disclosures for non-patent claims
8/15/08			Expert discovery for non-patent claims closes
	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
	Court's convenience		Claim construction ruling

Date	Counting	Rule	Event
	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 do not agree with Plaintiff's proposal outlined below.**

Plaintiff's proposal:

In the absence of an Answer and a 26(f) conference, and with no information about counterclaims and third-party defendants, Plaintiff cannot propose a detailed discovery schedule –

1 it's like putting the cart before the horse. Plaintiff prefers the following proposal to reduce the
 2 likelihood that the parties will need to file motions to adjust the schedule and cause further delay.

3 Plaintiff proposes that he be allowed to amend his complaint to restructure the pleadings in
 4 light of the court's August 17, 2007 ruling, and other developments. He also would like to amend
 5 the complaint to include contract-related claims and at least one additional federal claim. As this
 6 court has recognized in its Jarritos ruling, the standard for trademark dilution changed with recent
 7 amendments to the federal statute. These amendments were signed into law after Plaintiff filed his
 8 amended complaint. Plaintiff will remove this cause of action.

9 Plaintiff proposes that he be given 30 days to file the Second Amended Complaint, and
 10 Defendants be given 30 days to Answer this complaint. Plaintiff asks the Court to order
 11 Defendants to answer this complaint so that litigation may proceed.

12 Once Defendants file an Answer, Plaintiff proposes that the Court hold another CMC for a
 13 status update, and scheduling deadlines for the 26(f) conference.

14 As Defendants stated they intend to bring multiple counterclaims against multiple parties,
 15 twenty days proposed by Defendants is too short, and not nearly the amount of time – now 15
 16 months – that Defendants have had to file an Answer.

17 Plaintiff believes his proposal is the best course to prevent delay, given that no Answer has
 18 been filed and that, without an Answer and without information about additional parties or
 19 counterclaims, he cannot reasonably offer a detailed discovery plan. He also recommends against
 20 using Defendants' time table for these reasons, and because it does not account for foreign
 21 discovery or electronic discovery, nor has the parties met and conferred as required by Rule 26(f).
 22 Thus, Plaintiff believes it would be most economical to limit setting dates to those discussed above,
 23 instead of having to return to the Court to re-schedule deadlines once Defendants have filed an
 24 Answer.

12. Current Service List

Plaintiff Jacobsen	Defendants KAM and Katzer
Victoria K. Hall Law Office of Victoria K. Hall 3 Bethesda Metro Suite 700 Bethesda, MD 20814 Tel: (301) 280-5925	R. Scott Jerger Field Jerger, LLP 610 SW Alder Street, Suite 910 Portland, OR 97205 Tel: (503) 228-9115

Fax: (240) 536-9142 Email: Victoria@vkhall-law.com	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

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

Not applicable

14. Disclosures

Plaintiff:

(a) Plaintiff is a professor and Associate Dean at UC Berkeley. Because of his administrative roles, he is in regular contact with some faculty professors at UC Berkeley’s law school, Boalt Hall. He serves on a committee with former Dean Jesse Choper.

(b) UC Berkeley, Lawrence Berkeley National Laboratory, and the U.S. Department of Energy are potential third party defendants, per Defendants.

(c) The judge, Jeffrey S. White, has taught regularly for more than 20 years at Boalt Hall. Last semester, he taught Civil Trial Practice.

(d) Counsel for Plaintiff, Victoria K. Hall, was a student in the judge’s Civil Trial Practice class in Spring 2004. In the latter half of the class, she assisted the judge, and was in regular contact with him outside class, in locating students to serve on juries for mock trials held in his courtroom.

(e) Plaintiff and the judge do not know each other personally.

Under 28 U.S.C. § 455(a), “[a] ... judge ... shall disqualify himself in any proceedings in which his impartiality might reasonably be questioned.” Plaintiff respectfully asks the court to

