

1 VICTORIA K. HALL (SBN 240702)
LAW OFFICE OF VICTORIA K. HALL
2 3 Bethesda Metro Suite 700
Bethesda MD 20814
3 Victoria@vkhall-law.com
Telephone: 301-28-5925
4 Facsimile: 240-536-9142

5 Attorney for Plaintiff
ROBERT JACOBSEN
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10 UNITED STATES DISTRICT COURT
11 FOR THE NORTHERN DISTRICT OF CALIFORNIA
12 SAN FRANCISCO DIVISION

13 ROBERT JACOBSEN,) No. C-06-1905-JSW
14)
Plaintiff,)
15) **PLAINTIFF ROBERT JACOBSEN'S**
v.) **MOTION TO STRIKE PORTIONS OF**
16) **DECLARATIONS OF MATTHEW**
MATTHEW KATZER, et al.,) **KATZER AND KEVIN RUSSELL**
17)
Defendants.) Courtroom: 2, 17th Floor
18) Judge: Hon. Jeffrey S. White
Date: Fri., December 19, 2008
19) Time: 9:00 a.m.
20)
21)
22)
23)
24)
25)
26)
27)
28)

I. INTRODUCTION

Defendant Matthew Katzer and his intellectual property counsel Kevin Russell filed several declarations in connection with their filings on Friday, November 7, 2008. Because portions of these declarations do not meet the requirements of Civil Local Rule 7-5(b), Plaintiff Robert Jacobsen moves to strike.

1 **II. FACTS**

2 **A. The Text to Be Stricken**

3 Under the Heading “KAM HAD AND CONTINUES TO HAVE A GOOD FAITH
4 BELIEF IN THE VALIDITY OF THE NOW-DISCLAIMED ‘329 PATENT”’, Katzer states:

5 43. At all times prior to the disclaimer of the ‘329 patent, I believed that KAM’s
6 patent was valid and that the JMRI software infringed that patent. To this date, I still
7 believe that the ‘329 patent was valid.

8 44. Nothing that Jacobsen or his attorney has filed in this lawsuit has shaken my
9 belief that KAM’s ‘329 patent was valid prior to the disclaimer. Nothing that
10 Jacobsen or his attorney has filed in this lawsuit has shaken this belief.

11 [...]

12 47. [...] This [FOIA] request was to gather information in support of a possible
13 lawsuit against JMRI for patent infringement. Since a Department of Energy email
14 account was being used by Jacobsen in his capacity as a developer of JMRI
15 software, I believed that a FOIA request to the Department of Energy would
16 produce relevant information relating to JMRI’s infringement of the ‘329 patent.

17 Declaration of Matthew Katzer in Opposition to Plaintiff’s Motion for a Preliminary Injunction
18 [Docket #261] at 9-10.

19 Katzer makes similar statements another declaration, filed the same day.

20 3. At all times prior to the disclaimer of the ‘329 patent, I believed that KAM’s
21 patent was valid and that the JMRI software infringed that patent. To this date, I still
22 believe that the ‘329 patent was valid.

23 4. I believe that KAM’s ‘329 patent was valid prior to the disclaimer and that
24 JMRI’s product infringed the ‘329 patent prior to the disclaimer. Nothing that
25 Jacobsen or his attorney has filed in this lawsuit has shaken this belief.

26 [...]

27 7. [...] This [FOIA] request was to gather information in support of a possible
28 lawsuit against JMRI for patent infringement. Since a Department of Energy email
account was being used by Jacobsen in his capacity as a developer of JMRI
software, I believed that a FOIA request to the Department of Energy would
produce relevant information relating to JMRI’s infringement of the ‘329 patent.

Declaration of Matthew Katzer Supporting the Reply of Defendant Kevin Russell to Plaintiff’s
Opposition Brief [Docket #256] at 1-2.

Kevin Russell also makes similar statements.

2. At all times previous to the filing of Jacobsen’s complaint in this matter, I
believed that KAMIND Associates, Inc.’s Patent No. 6,530,329 B2 was a valid
patent, and that software sponsored and made available by JMRI infringed that
patent. To this date, I still believe these things to be true.

1 3. [...] ... I told Jacobsen that in my opinion software sponsored and made available
2 in the market by JMRI infringed the '329 Patent, and that JMRI should either apply
for a license or cease distributing the infringing product. [...]

3 4. [...] A reason for the request was to gather information for a possible lawsuit
4 against JMRI for patent infringement.

5 5. Nothing Jacobsen said to me, and nothing his attorney has filed or otherwise
6 presented in this litigation has done anything to shake my belief that KAMIND
Associates, Inc.'s Patent No. 6,530, 329 is valid and the JMRI product directly
infringed it.

7 [...]

8 7. I have read the accompanying declaration of Matthew Katzer [...], and the
9 statements made in Paragraphs 5, 6, and 7 of that declaration are true to my personal
knowledge.

10 Declaration by Defendant Kevin Russell Supporting Reply to Plaintiff's Opposition Brief [Docket
11 #254] at 1-2.

12 **B. The Disclaimed '329 Patent and Accusations of Infringement**

13 Katzer and Russell's accusations arose from JMRI's client-server network code, which
14 permitted users to set up one or more client computers to send signals to a server computer, which
15 would send signals to a digital command station. They alleged Jacobsen infringed the following
16 claim:

17 1. A method of operating a digitally controlled model railroad comprising the steps
18 of: (a) transmitting a first command from a first program to an interface; (b)
19 transmitting a second command from a second program to said interface; and (c)
sending third and fourth commands from said interface representative of said first
and second commands, respectively, to a digital command station.

20 U.S. Patent No. No. 6,530,329 ('329 patent) col. 40: 21-29.

21 Russell prosecuted the application that led to this patent. In the Background of the
22 Invention section of the '329 patent's specification, Russell and Katzer wrote the following:

23 DigiToys Systems of Lawrenceville, Ga. has developed a software program for
24 controlling a model railroad set from a remote location. The software includes an
25 interface which allows the operator to select desired changes to devices of the
26 railroad set that include a digital decoder, such as increasing the speed of a train or
switching a switch. The software issues a command locally or through a network,
such as the internet, to a digital command station at the railroad set which executes
the command.

27 '329 patent, col. 1:46-54 (emphasis added).

28

1 **III. ARGUMENT**

2 An affidavit or declarations may contain only facts, must conform as much as
3 possible to the requirements of FRCivP 56(e), and must avoid conclusions and
4 argument. Any statement made upon information or belief must specify the basis
therefor. An affidavit or declaration not in compliance with this rule may be stricken
in whole or in part.

5 Civ. L.R. 7-5(b).

6 Katzer and Russell's statements relating to infringement and validity are legal conclusions.
7 Katzer is not qualified as an expert to give claim construction opinions, or determine infringement
8 or validity, and does not state any basis for his beliefs. Russell, a registered patent attorney, does
9 not specify the basis for his belief that Jacobsen's software infringed the '329 patent, nor has he
10 stated the basis for his belief that the '329 patent is valid. For these reasons, Jacobsen moves to
11 strike all paragraphs identified in Sec. II.A.

12 A. **Katzer is Not an Expert Qualified to Testify About the Validity or**
13 **Infringement of a Patent**

14 Katzer has offered legal conclusions in his declaration, but he is not an expert qualified to
15 give opinions on the validity or infringement of a patent. Claim construction, and opinions as to
16 validity or infringement, are technical skills for which a witness must be qualified as an expert in
17 order to testify. See Endress + Hauser, Inc. v. Hawk Measurement Sys. Pty. Ltd., 122 F.3d 1040,
18 1042 (Fed. Cir. 1997); Fed. R. Evid. 702. Katzer is a software developer. He opines that his '329
19 patent is valid and that JMRI infringed the patent, in particular claim 1. He is not a patent agent or
20 attorney, nor has he offered any foundation for the admissibility of his opinion as an expert who
21 can testify as to claim construction, validity or infringement. Because Katzer is not qualified to
22 offer a claim construction, or opinions about infringement or validity, he can offer no expert
opinions as to the '329 patent.

23 Even if Katzer could offer an expert opinion, Katzer's testimony should be stricken
24 because, like Russell as discussed next, Katzer has offered no basis for his opinion.

25 B. **Russell Does Not Offer a Basis for His Belief that the '329 Patent Is Valid**
26 **and Infringed.**

27 Unlike Katzer, Russell is a registered patent attorney and he could qualify as an expert
28 witness. See Reiffin v. Microsoft Corp., 270 F. Supp. 2d 1132, 1145 (N.D. Cal. 2003) (Walker, J.).

1 However the Court should strike Russell's testimony because Russell offers legal conclusions for
2 which he does not give a basis.

3 Russell offers no basis for his belief that Jacobsen infringed claim 1 of the '329 patent. To
4 determine patent infringement of method claims, one must construe the claims, then compare the
5 claims to the accused method. AquaTex Indus., Inc., v. Techniche Solutions, 419 F.3d 1374, 1380
6 (Fed. Cir. 2005). If the claims read on the accused method, then one must identify a person who is
7 practicing the accused method or show that the infringer's product necessarily practices the
8 accused method. ACCO Brands, Inc. v. ABA Locks. Mfrs. Co., 501 F.3d 1307, 1313 (Fed. Cir.
9 2007); Ormco Corp. v. Align Tech., Inc., 463 F.3d 1299, 1311 (Fed. Cir. 2006) ("Method claims
10 are only infringed when the claimed process is performed, not by the sale of an apparatus that is
11 capable of infringing use.") Russell has offered no claim construction, and has neither identified
12 any person who infringes nor shown that JMRI software necessarily infringes. Because he has not
13 offered a basis for his opinion, his testimony should be stricken.

14 Russell offers no basis for his belief that claim 1 of the '329 patent is valid. While an
15 issued patent is presumed valid, Russell described in the Background of the Invention a DigiToys
16 program, which sent signals through a network (an interface)¹ to a digital command station.

17 DigiToys Systems of Lawrenceville, Ga. has developed a software program for
18 controlling a model railroad set from a remote location. The software includes an
19 interface which allows the operator to select desired changes to devices of the
20 railroad set that include a digital decoder, such as increasing the speed of a train or
21 switching a switch. The software issues a command locally or through a network,
22 such as the internet, to a digital command station at the railroad set which executes
23 the command.

24 '329 patent, col. 1:46-54 (emphasis added)

25 Russell and Katzer therefore admitted that DigiToys was prior art. Then, they claimed it.

26 1. A method of operating a digitally controlled model railroad comprising the steps
27 of: (a) transmitting a first command from a first program to an interface; (b)
28 transmitting a second command from a second program to said interface; and (c)
sending third and fourth commands from said interface representative of said first
and second commands, respectively, to a digital command station.

'329 patent col. 40: 21-29.

¹ An interface is "[a] shared boundary across which information is passed." IEEE, The
Authoritative Dictionary of IEEE Standard Terms (7th ed. 2000).

1 Russell did not provide any DigiToys references to patent examiners until after Jacobsen
2 accused him and Katzer of inequitable conduct in the original complaint. Since Russell made the
3 disclosure, patent examiners have been rejecting claims over DigiToys. See, e.g., Request for
4 Judicial Notice [Docket # 246], Ex. G (Office Action dated Dec. 21, 2006) (rejecting ‘329 claim 2,
5 which was written in independent form and presented as a pending claim in U.S. Patent
6 Application No. 10/889,995). Russell has offered no claim construction or explanation as to why
7 claim 1 does not read on the DigiToys prior art when, on the face of it, it does. Given that he
8 withheld the DigiToys references from patent examiners, Russell must offer a basis for his belief
9 that the ‘329 patent is valid. For these reasons, the Court should strike Russell’s testimony relating
10 to the validity of the ‘329 patent.

11 **IV. CONCLUSION**

12 Because Katzer and Russell offer legal conclusions that have no claim construction or
13 factual basis, the Court should strike the portions of their declarations that are identified in Sec.
14 II.A.

15
16 Respectfully submitted,

17
18 DATED: November 21, 2008

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20 By _____/s/_____
Victoria K. Hall, Esq. (SBN 240702)
LAW OFFICE OF VICTORIA K. HALL
3 Bethesda Metro Suite 700
Bethesda MD 20814

21
22
23 Telephone: 301-280-5925
Facsimile: 240-536-9142

24 ATTORNEY FOR PLAINTIFF
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