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

13 ROBERT JACOBSEN, )  
14 )  
Plaintiff, )  
15 v. )  
16 MATTHEW KATZER, et al., )  
17 )  
Defendants. )  
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\_\_\_\_\_ )

No. C-06-1905-JSW  
**RESPONSES TO OBJECTIONS TO  
PLAINTIFF'S EVIDENCE SUBMITTED  
IN OPPOSITION TO RUSSELL'S  
SPECIAL MOTION TO STRIKE**  
Date: August 11, 2006  
Time: 9:00 a.m.  
Courtroom: 2, 17th Floor  
Judge: Hon. Jeffrey S. White  
Filed concurrently:  
1. Proposed Order

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1 Plaintiff Robert Jacobsen responds to the objections of Defendant Kevin Russell to the  
2 declarations offered in support of the opposition to Mr. Russell's anti-SLAPP motion. Mr.  
3 Jacobsen first responds in general to certain objections which Mr. Russell makes repeatedly, and  
4 then offers responses to Mr. Russell's objections in the order they were given. In some instances in  
5 the responses to the specific objection, Mr. Jacobsen incorporates by reference a general response.

6 General responses

7 A. When offered in response to anti-SLAPP motions, evidence in the opposing  
8 party's declarations must be considered if they would likely be admissible at  
9 trial. Fashion 21 v. Coalition for Humane Immigrant Rights of Los Angeles, 117  
10 Cal. App. 4th 1138, 1147-48 (Cal. App. 2004) ("On a SLAPP motion '[a]n  
11 assessment of the probability of prevailing on the claim looks to *trial*, and the  
12 evidence that will be presented at that time.") (emphasis in original). Thus,  
13 objections based on lack of authentication or foundation, and the like, are  
14 overcome because they would be very likely be established at trial. Also, many  
15 of the objections made by Mr. Russell go to the form of and not the substance of  
16 a declarant's statement and could be easily resolved at trial. See, e.g., ¶ 1, 4, 5,  
17 12, 13 ("conclusory" objections). For this reason, Defendant's reliance on the  
18 local rule 7-5 and 56(e) is misplaced. Mr. Russell also relies on Orr v. Bank of  
19 America, NT & SA, 285 F.3d 764 (9th Cir. 2002). The Orr case cited by Mr.  
20 Russell relates to a summary judgment motion, not an anti-SLAPP motion.  
21 Moreover, subsequent 9th Circuit authority interpreting Orr has concluded that  
22 even in the summary judgment context evidence in an improper form may be  
23 admitted, where its contents could be admitted at trial. Fraser v. Goodale, 342  
24 F.3d 1032, 1036-37 (9th Cir. 2003).

25 B. Mr. Jacobsen is an expert witness. In the complaint, he is offered as an expert in  
26 the field of model train control system software. Complaint ¶ 2. He has a  
27 bachelor's degree in computer science and electrical engineering from the  
28 Massachusetts Institute of Technology. Jacobsen Decl. ¶ 2. He has extensive

1 work experience in related fields. Id. ¶¶ 2-3. He also has extensive experience  
2 in the field of model train control system software. Id. ¶¶ 8-9. Thus, he is  
3 qualified to give expert opinion testimony on model train control system  
4 software. He may also rely on hearsay evidence to form an opinion. Fed. R.  
5 Evid. 703. That he is an interested witness does not bar his testimony. See Fed.  
6 R. Evid. 702. See also, People v. Johnson, 62 Cal. App. 4th 608, 615 (1998)  
7 (“By the mid-19th century, parties and interested witnesses in civil cases were  
8 allowed to give sworn testimony ... in most states in this country. . . . The  
9 elimination of the disqualification was based primarily on an argument that ‘. . .  
10 a witness's motive for lying should go to the weight, not the admissibility, of  
11 testimony.’”) Thus, Mr. Jacobsen’s interest in the case affects the weight of the  
12 testimony, but not the admissibility. Also, he does not have to testify to the facts  
13 underlying his opinion, unless required to do so by the court. Fed. R. Evid. 705.  
14 Should the Court require Mr. Jacobsen to discuss the bases for his opinion, Mr.  
15 Jacobsen will file a supplemental declaration for consideration with the motion.

16 C. Dr. Tanner is an expert witness. In the complaint, he named as a manufacturer  
17 of model train control system software. Complaint ¶ 16. He is familiar with  
18 others’ software. Tanner Decl. ¶¶ 2, 29-30, 37. He has interpreted the  
19 capabilities of his own and others’ software in the past, and compared them with  
20 the Katzer patent claims. Tanner Decl. Ex. F. Thus, he is qualified to give  
21 expert opinion testimony on model train control system software. He may also  
22 rely on hearsay evidence to form an opinion. Fed. R. Evid. 703. He is not a  
23 party to the litigation. To the extent that he is a competitor of Mr. Katzer and  
24 KAMIND does not bar his testimony. See Fed. R. Evid. 702. See also, People  
25 v. Johnson, 62 Cal. App. 4th 608, 615 (1998) (“By the mid-19th century, parties  
26 and interested witnesses in civil cases were allowed to give sworn testimony ...  
27 in most states in this country. . . . The elimination of the disqualification was  
28 based primarily on an argument that ‘. . . a witness's motive for lying should go

1 to the weight, not the admissibility, of testimony.”) Thus, Dr. Tanner’s interest  
2 – if any – in the case affects the weight of the testimony, but not the  
3 admissibility. Also, he does not have to testify to the facts underlying his  
4 opinion, unless required to do so by the court. Fed. R. Evid. 705. Should the  
5 Court require Dr. Tanner to discuss the bases for his opinion, Dr. Tanner will file  
6 a supplemental declaration for consideration with the motion.

7 D. Mr. Russell repeatedly cites to Schumer v. Laboratory Computer Systems, 308  
8 F.3d 1304 (Fed. Cir. 2002). The cases which Schumer relies upon involve a  
9 party in the litigation stating that he or she invented what was claimed in the  
10 patent-in-suit, Sandt Tech., Ltd. v. Resco Metal & Plastics Corp., 264 F.3d 1344  
11 (Fed. Cir. 2001), or parties in an interference proceeding, Singh v. Brake, 222  
12 F.3d 1362 (Fed. Cir. 2000). Singh in particular requires only oral testimony of  
13 prior inventorship to be corroborated. 222 F.3d at 1367. But a number of  
14 instances in which Schumer is offered for support involve prior art that was  
15 neither created by Mr. Jacobsen nor is oral testimony, but created by parties who  
16 have no connection to the litigation or is written evidence created at or near the  
17 time the prior art was created. Thus, Mr. Russell’s reliance on Schumer is  
18 misplaced. Next, for those few items involving oral testimony of prior  
19 inventorship by Mr. Jacobsen and the JMRI Project team, it is not a proper  
20 consideration of the evidence for Mr. Russell to isolate one piece of evidence,  
21 state that it is not corroborated, and then argue that it should not be considered.  
22 When taken with other evidence offered in the Jacobsen and Tanner  
23 declarations, the any claim of prior inventorship is in fact corroborated. For  
24 instances, Jacobsen Decl. ¶¶ 64, 65, 67, and 68, include a statement of that the  
25 0.9.2 release existed prior to the ‘878 patent application’s filing date, and a  
26 posting which was made at or near the date of the 0.9.2 release.

27 Responses to Specific Objections

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1. The theory behind the libel claim is libel per se. Libel per se does not require damages to be proved. Cal. Civ. § 45a. Slaughter v. Friedman, 32 Cal. 3d 149, 153 (1982). Damages are presumed. Id. Even if the libel claim were not libel per se, the value of the lost contract work can be admitted. Mr. Jacobsen incorporates by reference his General Response ¶ A.
2. The theory behind the libel claim is libel per se. Libel per se does not require damages to be proved. Cal. Civ. § 45a. Slaughter v. Friedman, 32 Cal. 3d 149, 153 (1982). Damages are presumed. Id. Even if the libel claim were not libel per se, the value of the lost contract work can be admitted. Mr. Jacobsen incorporates by reference his General Response ¶ A.
3. Mr. Jacobsen’s belief is a fact – what he thought at the time. Mr. Jacobsen also offers the evidence in this paragraph in his role as an expert witness. Mr. Jacobsen incorporates by reference his General Response ¶ B.
4. Mr. Jacobsen incorporates by reference his General Response ¶¶ A, B and D. That Mr. Jacobsen is an interested party is not a proper basis for an objection. Mr. Jacobsen is an expert witness and offers this testimony as an expert. Also, the technology is disclosed in one of the more than 2300 emails that Mr. Russell relies upon in his anti-SLAPP motion as a basis for having a reasonable belief that Mr. Jacobsen’s activities at the U.S. Department of Energy were infringing. Thus, this evidence is properly admitted under Fed. R. Evid. 106. Mr. Russell states that an “additional ground for this objection is that the statement is hearsay, as the ‘technology’ disclosed in version 0.9.0 is not before the Court.” First, the version discussed is 0.9.2, not 0.9.0. Second, that the technology is not before the court is not a basis for a hearsay objection. Finally, there is no

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out-of-court statement in the technology which constitutes hearsay.

5. Mr. Jacobsen incorporates by reference his General Response ¶¶ A, B and D. That Mr. Jacobsen is an interested party is not a proper basis for an objection. Mr. Jacobsen is an expert witness and offers this testimony as an expert. The best evidence rule objection has a high probability of being overcome at trial, and thus is properly disregarded.

6. Mr. Jacobsen incorporates by reference his General Response ¶ B. Mr. Jacobsen is an expert witness and offers this testimony as an expert.

7. Mr. Jacobsen incorporates by reference his General Response ¶ B. Mr. Jacobsen is an expert witness and offers this testimony as an expert.

8. Mr. Jacobsen incorporates by reference his General Response ¶ B. Mr. Jacobsen is an expert witness and offers this testimony as an expert.

9. Mr. Jacobsen incorporates by reference his General Response ¶ B. Mr. Jacobsen is an expert witness and offers this testimony as an expert. Furthermore, this objection is waived by not objecting to the same information in Jacobsen Decl. ¶ 99.

10. Mr. Jacobsen incorporates by reference his General Response ¶ B. Mr. Jacobsen is an expert witness and offers this testimony as an expert. Furthermore, this objection is waived by not objecting to the same information in Jacobsen Decl. ¶ 101.

11. Mr. Jacobsen incorporates by reference his General Response ¶ A. Mr. Russell did not object to this same information when it appeared in Jacobsen Decl. ¶¶ 95 and 101, and thus the objection is waived. The lack of authentication is the type of objection that has a high probability of being overcome at trial, and thus is properly disregarded.

12. Mr. Jacobsen incorporates by reference his General Response ¶¶ A and B. That Mr. Jacobsen is an interested party is not a proper basis for an objection. Mr. Jacobsen is an expert witness and offers this testimony as

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an expert. Mr. Russell misstates Mr. Jacobsen’s declaration by characterizing Mr. Jacobsen’s testimony as stating that WinLok has “similar ‘features’”. Mr. Jacobsen states that it has the same features as the Katzer patent. Jacobsen Decl. ¶ 105. Mr. Russell further argues that this evidence is irrelevant. It is relevant because, combined with other information, it tends to show that Mr. Russell committed inequitable conduct, and tends to negate any claim of serious and good faith contemplation of litigation, which is necessary to invoke litigation privilege.

- 13. Mr. Jacobsen incorporates by reference his General Response ¶¶ A, B and D. That Mr. Jacobsen is an interested party is not a proper basis for an objection. Mr. Jacobsen is an expert witness and offers this testimony as an expert. Mr. Russell’s objection that the testimony is “confusing and generalized” is not specific enough to permit Mr. Jacobsen to form a response to the objection.
- 14. Mr. Jacobsen incorporates by reference his General Response ¶¶ A, B and D. That Mr. Jacobsen is an interested party is not a proper basis for an objection. Mr. Jacobsen is an expert witness and offers this testimony as an expert. Mr. Russell’s objection that the testimony is “confusing and generalized” is not specific enough to permit Mr. Jacobsen to form a response to the objection.
- 15. Mr. Jacobsen incorporates by reference his General Response ¶¶ A, B and D. That Mr. Jacobsen is an interested party is not a proper basis for an objection. Mr. Jacobsen is an expert witness and offers this testimony as an expert. The best evidence rule objection has a high probability of being overcome at trial, and thus is properly disregarded. Mr. Russell’s objection that the testimony is “confusing and generalized” is not specific enough to permit Mr. Jacobsen to form a response to the objection.

- 1                   16.       Mr. Jacobsen incorporates by reference his General Response ¶¶ A and B.  
2                   Contrary to Mr. Russell’s assertions, personal knowledge is not the only  
3                   way to authenticate a document. Fed. R. Evid. 901, 902. The lack of  
4                   authentication is the type of objection that has a high probability of being  
5                   overcome at trial, and thus is properly disregarded.
- 6                   17.       Mr. Jacobsen incorporates by reference his General Response ¶¶ A and B.  
7                   Contrary to Mr. Russell’s assertions, personal knowledge is not the only  
8                   way to authenticate a document. Fed. R. Evid. 901, 902. The lack of  
9                   authentication is the type of objection that has a high probability of being  
10                  overcome at trial, and thus is properly disregarded.
- 11                  18.       Mr. Jacobsen incorporates by reference his General Response ¶ B. Mr.  
12                  Jacobsen is an expert witness and offers this testimony as an expert. The  
13                  trademark information is relevant because it tends to show that Mr.  
14                  Russell committed inequitable conduct, which tends to negate serious and  
15                  good faith contemplation of litigation necessary to invoke litigation  
16                  privilege. Mr. Russell offers no citation for the basis of his objection.
- 17                  19.       Mr. Jacobsen incorporates by reference his General Response ¶ B. Mr.  
18                  Jacobsen is an expert witness and offers this testimony as an expert. The  
19                  trademark information is relevant because it tends to show that Mr.  
20                  Russell committed inequitable conduct, which tends to negate serious and  
21                  good faith contemplation of litigation necessary to invoke litigation  
22                  privilege. Mr. Russell offers no citation for the basis of his objection.
- 23                  20.       Mr. Jacobsen incorporates by reference his General Response ¶ B. Mr.  
24                  Jacobsen is an expert witness and offers this testimony as an expert. The  
25                  trademark information is relevant because it tends to show that Mr.  
26                  Russell committed inequitable conduct, which tends to negate serious and  
27                  good faith contemplation of litigation necessary to invoke litigation  
28                  privilege. Mr. Russell offers no citation for the basis of his objection.



1                   21.       Mr. Jacobsen incorporates by reference his General Response ¶¶ A, B and  
2                   D. That Mr. Jacobsen is an interested party is not a proper basis for an  
3                   objection. Mr. Jacobsen is an expert witness and offers this testimony as  
4                   an expert. The best evidence rule objection has a high probability of  
5                   being overcome at trial, and thus is properly disregarded. Mr. Russell’s  
6                   objection that the testimony is “confusing and generalized” is not specific  
7                   enough to permit Mr. Jacobsen to form a response to the objection.

8                   22.       Mr. Jacobsen incorporates by reference his General Response ¶¶ A, B and  
9                   D. That Mr. Jacobsen is an interested party is not a proper basis for an  
10                  objection. Mr. Jacobsen is an expert witness and offers this testimony as  
11                  an expert. The best evidence rule objection has a high probability of  
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13                  objection that the testimony is “confusing and generalized” is not specific  
14                  enough to permit Mr. Jacobsen to form a response to the objection.

15               23.       Mr. Jacobsen incorporates by reference his General Response ¶¶ A, B and  
16                  D. That Mr. Jacobsen is an interested party is not a proper basis for an  
17                  objection. Mr. Jacobsen is an expert witness and offers this testimony as  
18                  an expert. Mr. Russell’s objection that the testimony is “confusing and  
19                  generalized” is not specific enough to permit Mr. Jacobsen to form a  
20                  response to the objection.

21               24.       Mr. Jacobsen incorporates by reference his General Response ¶¶ A, C and  
22                  D. Dr. Tanner is not a party to the litigation. Furthermore, even if Dr.  
23                  Tanner were an interested party, that he was an interested party is not a  
24                  proper basis for an objection. Like Mr. Jacobsen, Dr. Tanner is an expert  
25                  witness and offers this testimony as an expert. Mr. Russell’s objection that  
26                  the testimony is “confusing and generalized” is not specific enough to  
27                  permit Mr. Jacobsen to form a response to the objection.

28               25.       Mr. Jacobsen incorporates by reference his General Response ¶¶ A, C and

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D. This evidence is offered for the purpose of impeachment. It is also offered for the purpose of showing that Mr. Russell received notice. Dr. Tanner is not a party to the litigation. Furthermore, even if Dr. Tanner were an interested party, that he was an interested party is not a proper basis for an objection. Like Mr. Jacobsen, Dr. Tanner is an expert witness and offers this testimony as an expert. As for hearsay, the statements are admissible under Fed. R. Evid. 803(3). Mr. Jacobsen cannot discern the double hearsay without further information, and thus cannot address it.

26. Mr. Jacobsen incorporates by reference his General Response ¶¶ A, C and D. Evidence which is not admissible under Fed. R. Evid 803(3) is offered for the purpose of impeachment. It is also offered for the purpose of showing that Mr. Russell received notice. Dr. Tanner is not a party to the litigation. Furthermore, even if Dr. Tanner were an interested party, that he was an interested party is not a proper basis for an objection. Like Mr. Jacobsen, Dr. Tanner is an expert witness and offers this testimony as an expert. Mr. Jacobsen cannot discern the double hearsay without further information, and thus cannot address it.

27. Mr. Jacobsen incorporates by reference his General Response ¶¶ A, C and D. This evidence is offered for the purpose of impeachment. It is also offered for the purpose of showing that Mr. Russell received notice. Dr. Tanner is not a party to the litigation. Furthermore, even if Dr. Tanner were an interested party, that he was an interested party is not a proper basis for an objection. Like Mr. Jacobsen, Dr. Tanner is an expert witness and offers this testimony as an expert. Mr. Jacobsen cannot discern the double hearsay without further information, and thus cannot address it.

