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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

ROBERT JACOBSEN,

Plaintiff,

v.

MATTHEW KATZER, et al.,

Defendants.

No. C-06-1905-JSW

RESPONSES TO OBJECTIONS TO PLAINTIFF'S EVIDENCE SUBMITTED IN OPPOSITION TO RUSSELL'S MOTIONS TO DISMISS

Date: August 11, 2006
Time: 9:00 a.m.
Courtroom: 2, 17th Floor
Judge: Hon. Jeffrey S. White

Filed concurrently:
1. Proposed Order

Plaintiff Robert Jacobsen responds to the objections of Defendant Kevin Russell to declarations offered in support of Mr. Jacobsen's opposition to Mr. Russell's Motions to Dismiss. Mr. Jacobsen recognizes that this is a 12(b)(2) motion, and that the evidence offered in his declaration was more than was necessary to demonstrate that Mr. Russell had directed tortious activity toward California, thus subjecting Mr. Russell to personal jurisdiction in California. Mr. Jacobsen apologizes to the Court, and offers the following: While Mr. Jacobsen could meet most if not all objections now or by the time of the August 11, 2006 hearing, he is only going to meet those objections which attack facts that would support personal jurisdiction. In some instances in the responses to a specific objection, Mr. Jacobsen incorporates by reference a general response.

General responses

A. Many of the objections made by Mr. Russell go to the form of and not the substance of a declarant's statement and could be easily resolved at trial. See, e.g., ¶ 1, 4, 5, 12, 13 ("conclusory" objections). Mr. Russell relies on Orr v. Bank of America, NT & SA, 285 F.3d 764 (9th Cir. 2002) for support of his objections. But subsequent 9th Circuit authority interpreting Orr has concluded that even in the summary judgment context evidence in an improper form may be admitted, where its contents could be admitted at trial. Fraser v. Goodale, 342 F.3d 1032, 1036-37 (9th Cir. 2003).

B. Mr. Jacobsen is an expert witness. In the complaint, he is offered as an expert in the field of model train control system software. Complaint ¶ 2. He has a bachelor's degree in computer science and electrical engineering from the Massachusetts Institute of Technology. Jacobsen Decl. ¶ 2. He has extensive work experience in related fields. Id. ¶¶ 2-3. He also has extensive experience in the field of model train control system software. Id. ¶¶ 8-9. Thus, he is qualified to give expert opinion testimony on model train control system software. He may also rely on hearsay evidence to form an opinion. Fed. R. Evid. 703. That he is an interested witness does not bar his testimony. See Fed. R. Evid. 702. See also, People v. Johnson, 62 Cal. App. 4th 608, 615 (1998)

("By the mid-19th century, parties and interested witnesses in civil cases were allowed to give sworn testimony … in most states in this country. . . . The elimination of the disqualification was based primarily on an argument that '. . . a witness's motive for lying should go to the weight, not the admissibility, of testimony.'") Thus, Mr. Jacobsen's interest in the case affects the weight of the testimony, but not the admissibility. Also, he does not have to testify to the facts underlying his opinion, unless required to do so by the court. Fed. R. Evid. 705. Should the Court require Mr. Jacobsen to discuss the bases for his opinion, Mr. Jacobsen will file a supplemental declaration for consideration with the motion.

C. Dr. Tanner is an expert witness. In the complaint, he named as a manufacturer of model train control system software. Complaint ¶ 16. He is familiar with others' software. Tanner Decl. ¶¶ 2, 29-30, 37. He has interpreted the capabilities of his own and others' software in the past, and compared them with the Katzer patent claims. Tanner Decl. Ex. F. Thus, he is qualified to give expert opinion testimony on model train control system software. He may also rely on hearsay evidence to form an opinion. Fed. R. Evid. 703. He is not a party to the litigation. To the extent that he is a competitor of Mr. Katzer and KAMIND does not bar his testimony. See Fed. R. Evid. 702. See also, People v. Johnson, 62 Cal. App. 4th 608, 615 (1998) ("By the mid-19th century, parties and interested witnesses in civil cases were allowed to give sworn testimony … in most states in this country. . . . The elimination of the disqualification was based primarily on an argument that '. . . a witness's motive for lying should go to the weight, not the admissibility, of testimony.'") Thus, Dr. Tanner's interest – if any – in the case affects the weight of the testimony, but not the admissibility. Also, he does not have to testify to the facts underlying his opinion, unless required to do so by the court. Fed. R. Evid. 705. Should the Court require Dr. Tanner to discuss the bases for his opinion, Dr. Tanner will file a supplemental declaration for consideration with the motion.

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

Responses to Specific Objections

1. (Jacobsen Decl. ¶ 46) 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.

19. (Jacobsen Decl. ¶ 123) Mr. Jacobsen incorporates by reference his General Response ¶ B. Mr. Jacobsen is an expert witness and offers this testimony as an expert. The trademark information is relevant because it tends to show that Mr. Russell committed inequitable conduct, which tends to negate serious and good faith contemplation of litigation necessary to invoke litigation privilege. Mr. Russell offers no citation for the basis of his objection.

24. (Tanner Decl. ¶ 20) Mr. Jacobsen incorporates by reference his General Response ¶¶ A, C and D. 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. 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.

25. (Tanner Decl. ¶¶ 24-26) 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. 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.

DATED: July 6, 2006

By /s/

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