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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

**JOINT CASE MANAGEMENT
STATEMENT AND [PROPOSED]
ORDER**

Location: 17th Floor, Courtroom 2

Judge: Honorable Jeffrey S. White

Per the Court's order, the parties met and conferred in person on the afternoon of August 11, 2006 regarding this joint case management statement. The parties submit this Joint Case Management Statement.

1. A brief description of jurisdictional issues

Plaintiff Jacobsen filed his Complaint on March 13, 2006. The complaint alleges that defendants fraudulently procured nearly a dozen patents and sought to enforce them through various unlawful, unfair and fraudulent means. The complaint also contains claims alleging unfair competition and cyber-squatting.

1 The declaratory judgment regarding one Katzer patent, and the Lanham Act (cyber-
2 squatting) claims involve federal questions. 28 U.S.C. § 1331. The plaintiff has also brought a
3 California Unfair Competition Act claim (California Business & Professions Code § 17200 *et*
4 *seq.*).¹ Jurisdiction is proper in this Court for this state law claim based on the supplemental
5 jurisdiction of this Court. 28 U.S.C. § 1367.

6 No parties remain to be served in this lawsuit.

7 **2. A brief description of the case and defenses**

8 Plaintiff Jacobsen is a high energy physicist who does research at the Lawrence Berkeley
9 National Laboratory of the University of California, and Stanford University and at CERN in
10 Switzerland, and teaches physics at the University. As a hobby, Jacobsen develops, with others,
11 open source software code called JMRI (Java Model Railroad Interface) that Jacobsen alleges is
12 distributed free of charge. KAM is an Oregon corporation and Katzer is its principal. Defendants
13 state that KAM has patents for software products, at least one of which is similar to and is
14 infringed by the JMRI project software. Defendants assert that KAM's software products' function
15 is similar to the software products provided for free by JMRI. Jacobsen alleges that Katzer and his
16 attorney, Kevin Russell, intentionally withheld prior art that they knew was material to
17 patentability from the Patent Office in obtaining the patents and for these reasons, as well as others,
18 Jacobsen alleges that said patents are thereby invalid and/or unenforceable.

19 Jacobsen's complaint seeks declaratory relief regarding noninfringement, invalidity, and
20 unenforceability of the patent-in-suit, U.S. Pat. No. 6,520,329, which per the U.S. Patent and
21 Trademark Office website is assigned to Katzer, but which Defendant Katzer and KAM state is
22 held by KAM. The complaint alleges that the patent-in-suit is invalid because prior art anticipates
23 or makes it obvious, and/or that it failed to meet the requirements of 35 U.S.C. Sec. 112. The
24 complaint also alleges the patent-in-suit, and related patents, were obtained through fraud on the
25 patent office or inequitable conduct. The complaint also contains claims alleging unfair
26 competition and cyber-squatting. Defendants believe that KAM's patents are valid.

27 _____
28 ¹ The parties have removed the antitrust claim (Count IV) and libel (Count VII), and discussion of Defendant Kevin
Russell, from this Joint Case Management Statement.

1
2 **3. Brief Description of the legal issues genuinely in dispute**

3 Plaintiff believes that defendants KAM and Katzer have invalid and/or unenforceable
4 patents, and have violated the California Unfair Competition Act. Plaintiff also believes that
5 defendants KAM and Katzer have violated the Lanham Act by cybersquatting. Defendants dispute
6 all of these claims.

7 **4. Procedural History**

8 Plaintiff's complaint was filed on March 13, 2006. The following motions were heard on
9 August 11, 2006. The initial case management conference was also held on August 11, 2006.

10 (1) Anti-SLAPP motions to strike by Defendants KAM, Katzer and Russell.

11 (2) Defendant Russell's motion to dismiss counts 5 and 7.

12 (3) Defendants KAM and Katzer's motion to dismiss counts 4 and 7. KAM and Katzer have an
13 outstanding motion to bifurcate and stay Count 5, the § 17200 claim.

14 The Court has granted all motions except the motion to bifurcate. A written ruling is pending.

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

16 No initial disclosures have been made. Per order of this Court, the date for initial Fed. R.
17 Civ. P. 26 disclosures will be Sept. 5, 2006.

18 **6. Discovery Plan**

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

20 A. List of Potentially Key Witnesses

- 21 1. Matthew Katzer
22 2. Robert Jacobsen
23 3. Hans Tanner
24 4. John Plocher
25 5. A.J. Ireland
26 6. Strad Bushby
27 7. John E. Kabat
28 8. Juergen Freiwald

- 1 9. Dick Bronson
 - 2 10. Jerry Britton
 - 3 11. Developers of the JMRI software.
 - 4 12. Developers and manufacturers of third party model train software
 - 5 13. Contributors and users of the JMRI software
 - 6 14. Unknown employees and supervisors at the Lawrence Berkeley National Laboratory
 - 7 15. Dean of the UC Berkeley Physics Department
 - 8 16. Unknown employees and supervisors at the US Department of Energy
 - 9 17. Kevin Russell
 - 10 18. Glenn Butcher
 - 11 19. Unknown employees of KAMIND Associates, Inc.
 - 12 20. Unknown employees of Chernoff, Vilhauer, McClung and Stenzel.
 - 13 21. Examiners at the U.S. Patent & Trademark Office.
 - 14 22. Unknown members of the NMRA.
 - 15 23. Unknown employees of Marklin.
 - 16 24. Stan Ames.
 - 17 25. Rutger Friburg.
 - 18 26. Ed Loizeaux.
 - 19 27. Unknown employees of Train Track Computer Systems, Inc.
 - 20 28. Roger Webster
 - 21 29. John McCormick
 - 22 30. John Littman
 - 23 31. Dr. Bruce Chubb
 - 24 32. Unknown members of the Tech Model Railroad Club of MIT
- 25 Plaintiff has yet to receive an Answer from defendants, and cannot determine what additional
26 witnesses may be necessary to call in response to that Answer. Plaintiff also believes it is
27 premature to engage in developing a detailed discovery plan given the posture of the case, that an
28 amended complaint will be filed by Sept. 11, 2006 with more claims, and that early summary

1 judgment motions will be filed. Thus, Plaintiff reserves the right to name other key witnesses.

2 B. List of Key Information

- 3 1. All versions of the JMRI software.
- 4 2. All software development information for the JMRI software project.
- 5 3. All information relating to JMRI's market share.
- 6 4. All information relating to the "lost income" referenced in ¶ 7 of the complaint.
- 7 5. All versions of any relevant KAM software, including but not limited to alpha, beta and released
- 8 versions.
- 9 6. All references in Katzer and KAM's, and their attorney Kevin Russell's, possession that relate to
- 10 patentability.
- 11 7. All plans relating to enforcing the Katzer patents.
- 12 8. All plans relating cybersquatting on others' trademarks.
- 13 9. All plans for filing intellectual property rights on behalf of Katzer, and KAM and its related
- 14 entities.
- 15 10. All evidence that the patent(s)-in-suit meet, or do not meet, requirements of 35 U.S.C. § 112.
- 16 11. All financial information relating to KAM and its related entities.
- 17 12. File wrappers for the patent application, and related patent applications, that issued as the
- 18 patent-in-suit.
- 19 13. Trademark applications for all KAM products.
- 20 14. All emails from Jacobsen to any JMRI user, NMRA member, or other hobbyist related to
- 21 JMRI or model train software.

22 Plaintiff believes that significant evidence is in the Record that will permit Plaintiff to seek early
23 summary judgment on several claims. Plaintiff also will add claims by Sept. 11, 2006 in an
24 amended complaint. Thus, Plaintiff believes that it is premature to offer a detailed discovery plan
25 until the amended complaint is filed, early summary judgment motions have been heard, and the
26 parties have gone through the ADR process. Furthermore, Plaintiff has yet to receive an Answer
27 from defendants, and cannot determine what additional information he will seek in response to that
28 Answer. Plaintiff thus reserves the right to seek further key information.

7. Motions before trial

Jacobsen, KAM and Katzer anticipate motions for summary judgment prior to trial on virtually all of plaintiff’s claims. KAM and Katzer anticipate that new parties will be added and further anticipate evidentiary and claim-construction hearings. Jacobsen may also add parties.

8. Description of Relief Sought

Plaintiff seeks declaratory and injunctive relief, and costs and attorney’s fees. Defendants believe Plaintiff has not described the calculation of damages in the complaint. KAM’s counterclaims will include claims for monetary damages, including reasonable royalty, and/or lost profits, and/or enhanced damages, and/or attorney fees.

9. ADR Efforts to Date

There have been no ADR efforts to date. Per this Court’s order given at the initial CMC, the parties will participate in ENE to be completed by Dec. 11, 2006.

10. Consent to a magistrate judge

The defendants do not consent to a magistrate judge.

11. Proposed Litigation and Discovery Schedule

The parties jointly submit the following dates: Should Plaintiff be required to seek leave to amend the Complaint, Plaintiff’s counsel will submit the amended Complaint to Defendants’ counsel by Aug. 31, 2006, per the Court’s order. Defendants’ counsel will have until Sept. 11, 2006 to object to the amended Complaint, per the Court’s order. If Plaintiff is not required to seek leave to amend the Complaint, then the amended Complaint will be filed by Sept. 11, 2006, per the Court’s order. The parties propose another case management conference for December 15, 2006, and ENE to be completed by Dec. 11, 2006.

Defendants’ proposal:

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

Date	Counting	Rule	Event
12/11/06			ENE to be completed
12/15/06			Case Management Conference
	20 days after filing of Amended Complaint, unless defendants file another responsive pleading or motion to dismiss		Answer, Counterclaims, Cross Claims and additional parties
	20 days after filing of defendant's Answer		Reply to counterclaims, cross claims and answer of additional parties
	10 days after answer is served		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 ALLEGED, 50 days after preliminary invalidity contentions are served	Pat L.R. 3-5	File final invalidity 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
	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

Date	Counting	Rule	Event
	14 days after service of opening Markman	Pat L.R. 4-5	Response Markman brief
	7 days after service of responsive Markman	Pat L.R. 4-5	Reply Markman brief
	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
	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

1 schedule if the circumstances so warrant.

2 Should the case not be resolved on dispositive motions, defendants believe that the trial will
 3 last approximately 10 days. Plaintiff has requested a jury trial in his complaint. Defendants
 4 believe that California Unfair Competition Act claim (Count V) can and should be bifurcated and
 5 stayed pending resolution of the patent enforceability claims and have filed a motion to this effect.

6 Plaintiff's proposal:

7 Plaintiff believes that a number of claims may be resolved in his favor on early summary judgment
 8 motions, and that the ADR process may result in settling the case. Furthermore, without an
 9 Answer from defendants, and information regarding additional third party defendants, Plaintiff can
 10 make no estimate on the time needed in the schedule above, and thus declines to do so. Since
 11 Plaintiff believes bifurcation would delay the resolution of the case at additional expense to
 12 Plaintiff, with no benefit in efficiency to the judicial system, Plaintiff opposes bifurcation. Plaintiff
 13 will file an amended Complaint by Sept. 11, 2006, with added claims, which should be considered
 14 prior to granting a motion for bifurcation. The amended Complaint may result in another series of
 15 motions to dismiss. Thus, Plaintiff believes it would be most economical to limit setting dates to
 16 those set by the court at the initial CMC on Aug. 11, 2006, and for new motions to dismiss and any
 17 early summary judgment and other motions, and the next case management conference.

18 **12. Current Service List**

Plaintiff Jacobsen	Defendants KAM and Katzer
Victoria K. Hall Law Office of Victoria K. Hall 401 N. Washington Street, Suite 550 Rockville, MD 20850 Tel: (301) 738-7677 Fax: (240) 536-9142 Email: Victoria@vkhall-law.com	R. Scott Jerger Field & Jerger, LLP 610 SW Alder Street, Suite 910 Portland, OR 97205 Tel: (503) 228-9115 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

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

Not applicable

14. Disclosures

Defendants KAM and Katzer

As discussed in defendants Matthew Katzer and KAM's certificate of interested entities, Barbara Dawson has an interest that could be substantially affected by the outcome of this proceeding.

Respectfully submitted,

Attorney for Plaintiff Robert Jacobsen

VICTORIA K. HALL
Law Office of Victoria K. Hall

Dated: Aug. 17, 2006

_____/s/
VICTORIA K. HALL (SBN 240602)
Attorney
Law Office of Victoria K. Hall

Attorney for Defendants Katzer
and KAMIND Associates, Inc.

R. SCOTT JERGER
Field and Jerger

JOHN C. GORMAN
Gorman & Miller

Dated: August 17, 2006

_____/s/
R. SCOTT JERGER (*pro hac vice*)
Attorney
Field Jerger LLP

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[PROPOSED] JOINT CASE MANAGEMENT ORDER

Having received the Joint Case Management Statement, the Court orders the parties to complete initial Rule 26 disclosures by Sept. 5, 2006. If required to seek leave to amend the Complaint from the Court, Plaintiff will send a courtesy copy of the Amended Complaint to opposing counsel by Aug. 31, 2006, who will file any objections to the Amended Complaint by Sept. 11, 2006.

The parties will participate in Early Neutral Evaluation, to be completed by Dec. 11, 2006. The next Case Management Conference will set for Friday, December 15, 2006 at 1:30 pm following any motions that the parties file.

DATED: _____

By _____
JEFFREY S. WHITE
UNITED STATES DISTRICT JUDGE

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CERTIFICATE OF SERVICE

I hereby certify that on Aug. 17, 2006, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the e-mail addresses denoted on the Electronic Mail Notice List

By _____/s/_____
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