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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, ) **PLAINTIFF MOTION FOR LIMITED**  
15 ) **EARLY DISCOVERY**  
v. )  
16 ) Courtroom: 2, 17th Floor  
MATTHEW KATZER, et al., ) Judge: Hon. Jeffrey S. White  
17 )  
Defendants. )  
18 )  
19 )  
20 )  
21 )

22 Plaintiff respectfully asks for limited early discovery related to Defendants' Motion to  
23 Dismiss for Lack of Subject Matter Jurisdiction.

24 **I. Introduction and Relevant Facts**

25 Defendants Matthew Katzer and KAMIND Associates, Inc. say they filed a patent  
26 disclaimer which they attached to Defendant Katzer's declaration. [Docket # 203]. This  
27 disclaimer disclaims all claims of the '329 patent, but no other Katzer patent. Id.

28 In a FOIA request directed at Plaintiff's employer, the U.S. Department of Energy and

1 Lawrence Berkeley National Laboratory, Defendants alleged that Plaintiff infringed multiple  
2 Katzer patents. Ex. A at 1 (“KAMIND Associates, Inc. is a small software vendor that has patents  
3 being infringed by the JMRI project sponsored by the Lab.”) (emphasis added). Defendants have  
4 repeatedly represented to this Court that they had a good faith belief when they filed the FOIA  
5 request that Plaintiff was infringing multiple patents. Declaration of Matthew Katzer in Support of  
6 Special Motion to Strike [Docket #13] ¶ 5 (“...infringing KAM’s patents.”), ¶ 7 (“...infringement  
7 of KAM’s patents.”); Defendants’ Matthew Katzer and KAMIND Associates, Inc. Special Motion  
8 to Strike Plaintiff’s Libel Claim under Cal. Civ. Pro. Code § 425.16 [Docket #29] at 5, l. 7 (“KAM  
9 believes that certain JMRI software infringes on KAM patents.”), at 8, ll. 21-22 (“...to alert the  
10 DOE that the JMRI project was infringing on KAM patents.”).

11 After Defendants filed their motion to dismiss for lack of subject matter jurisdiction,  
12 Plaintiff, through his counsel, sought the identity of the Katzer patents that Plaintiff is alleged to  
13 have infringed. Defense counsel denied that Defendants had alleged infringement of multiple  
14 patents, and stated the FOIA request only alleged infringement of the ‘329 patent. Cf. Ex. A at 1.  
15 Plaintiff files this motion to seek from Defendants and/or their intellectual property counsel, Kevin  
16 Russell, the identity of the Katzer patents which Defendants alleged in their FOIA request to the  
17 U.S. Department of Energy that Plaintiff infringed.<sup>1</sup>

## 18 **II. Argument**

19 Because Plaintiff bears the burden of demonstrating a case or controversy exists, he needs  
20 to take limited early discovery. Plaintiff initially pled declaratory judgment of non-infringement,  
21 invalidity, and unenforceability of claim 1 of the ‘329 patent because Defendants had specified that  
22 patent only and made general allegations of patent infringement as to other Katzer patents. In the  
23 normal course of discovery, Plaintiff would have sought information about the other Katzer patents  
24 and then could seek leave to amend the complaint, if necessary. Because Defendants seek to  
25 dismiss the declaratory judgment causes of action for lack of subject matter jurisdiction, Plaintiff  
26 needs this information before discovery opens. A party may seek early discovery by court order.

27 <sup>1</sup> Plaintiff deferred filing this motion while the parties were in a cooling off period after the Feb.  
28 13, 2008 settlement conference, in the hope that the parties might come to terms and settle the case.  
Settlement talks ended last Friday.

1 See Fed. R. Civ. P. Rule 26(d). Parties have used early discovery when seeking information to  
2 oppose a motion to dismiss for lack of personal jurisdiction. E.g., Invitrogen Corp. v. Pres. &  
3 Fellows of Harvard College, No. 07-cv-0878-JLS (S.D. Cal. Oct. 4, 2007) at \*3. Defendants here  
4 challenge jurisdiction, in particular subject matter jurisdiction, which Plaintiff must establish.  
5 Thus, early discovery is appropriate.

6 A party seeking early discovery must show good cause. “Good cause may be found where  
7 the need for expedited discovery, in consideration of the administration of justice, outweighs the  
8 prejudice to the responding party.” Semitool, Inc. v. Tokyo Electron Am., 208 F.R.D. 273, 276  
9 (N.D. Cal. 2003). Good cause exists here, because Plaintiff needs the information to oppose  
10 Defendants’ motion, and because the limited request should pose no burden on Defendants, as  
11 explained below. Furthermore, if Defendants, after years of alleging patent infringement against  
12 Plaintiff, identify no other patent that Plaintiff purportedly infringes, this admission will put a  
13 significant part of the case to rest, facilitate case management, and may result in an earlier  
14 settlement of the case.

15 Plaintiff needs expedited discovery. In charging Plaintiff with infringement of multiple  
16 Katzer patents in their FOIA request and representing to this Court that Plaintiff has infringed  
17 multiple patents, Defendants imply they will bring multiple claims against Plaintiff. The identity  
18 of the Katzer patents is relevant to the Plaintiff’s opposition to Defendants’ motion to dismiss. If  
19 Defendants assert multiple patents, the declaratory judgment cause of action of inequitable conduct  
20 during the prosecution of the ‘329 patent will not be moot because inequitable conduct during the  
21 prosecution of the ‘329 patent may infect the other patents. Nilssen v. Osram Sylvania, Inc., 504  
22 F.3d 1223, 1230 (Fed. Cir. 2007). Also, the declaratory judgment causes of action for non-  
23 infringement and invalidity can be amended to include these other Katzer patents. Thus, Plaintiff  
24 is entitled to find out what Katzer patents he allegedly infringes so he can use that information in  
25 his opposition to Defendants’ motion to dismiss.

26 The discovery does not prejudice Defendants. The limited nature of this discovery should  
27 pose no burden. As noted earlier, they have repeatedly represented that they had a good faith belief  
28 that Plaintiff infringed multiple Katzer patents. In order to have that good faith belief, they must

1 have conducted an infringement analysis. See View Eng'g, Inc. v. Robotic Vision Sys., Inc., 208  
2 F.3d 981, 986-87 (Fed. Cir. 2000); Judin v. United States, 110 F.3d 780, 784 (Fed. Cir. 1997).  
3 Thus, they should know which Katzer patents they believe Plaintiff infringed.

4 Thus, Plaintiff has shown good cause exists for early discovery. He needs it to oppose  
5 Defendants' Motion to Dismiss for Lack of Subject Matter Jurisdiction. The discovery should pose  
6 no burden on Defendants. Plaintiff asks the Court to grant his motion for limited early discovery,  
7 and to stay briefing on Defendants' Motion in the interim as requested in a separate administrative  
8 motion, filed concurrently.

9 **III. Conclusion**

10 Plaintiff respectfully asks the Court to grant his motion for early limited discovery.

11 Respectfully submitted,

12 DATED: February 25, 2008

13 By \_\_\_\_\_ /s/  
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