

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 v.) **DECLARATION OF ROBERT**
16) **JACOBSEN IN SUPPORT OF**
MATTHEW KATZER, et al.,) **OPPOSITION TO DEFENDANTS'**
17) **MATTHEW KATZER AND KAMIND**
Defendants.) **ASSOCIATES, INC.'S MOTION TO**
18) **DISMISS FOR MOOTNESS**
19) Courtroom: 2, 17th Floor
Judge: Hon. Jeffrey S. White
20) Date: Fri., April 11, 2008
Time: 9:00 a.m.
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I, ROBERT JACOBSEN, have personal knowledge to the facts stated herein and hereby declare as follows:

I am a party to this action. I am submitting this Declaration in Support of the Opposition to Defendants' Matthew Katzer and KAMIND Associates, Inc.'s Motion to Dismiss for Lack of Subject Matter Jurisdiction.

- 1 1. I received a cease and desist letter from Kevin L. Russell, intellectual property counsel for
2 Defendants, in March 2005. A true and correct copy of that letter is attached as Exhibit A. He
3 stated that I may be infringing claim 1 of U.S. Patent No. 6,530,329, and offered me a license.
- 4 2. I responded to Mr. Russell's letter on March 29, 2005. A true and correct copy of that letter is
5 attached as Exhibit B. I told him I could find no evidence that JMRI infringed claim 1 of the
6 '329 patent, and asked him for proof.
- 7 3. Several months passed before I heard from Mr. Russell and Defendants again. In August 2005,
8 Mr. Russell sent me another cease and desist letter, this time enclosing an invoice for more than
9 \$200,000 that I supposedly owed for 7,000 licenses of KAMIND Associates, Inc. software. A
10 true and correct copy of this letter is attached as Exhibit C. I never ordered these licenses.
- 11 4. In October 2005, Mr. Russell sent me another cease and desist letter in the form of an updated
12 invoice for my "activities with respect to the JMRI software." A true and correct copy of this
13 letter is attached as Exhibit D.
- 14 5. On October 27, 2005, Mr. Russell sent a FOIA request to the U.S. Department of Energy for
15 information about me at Lawrence Berkeley National Laboratory, where I work as a high
16 energy research physicist. A true and correct copy of the FOIA request, as I received it, is
17 attached as Exhibit E. The FOIA request included an invoice for \$200,000. Ex. E at 18. It
18 also included allegations that I infringed multiple Katzer patents. Ex. E at 1. I can be fired
19 from the Laboratory for patent infringement. Ex. F at 6. These allegations were unnecessary to
20 obtain the information that Defendants sought. The FOIA request also referred to a "KAM
21 legal action in federal court", Ex. E at 3, which had never been filed, but which I and my
22 superiors at the Laboratory thought had been filed against me. When this FOIA arrived, I had
23 to explain the FOIA request and patent infringement allegations to my superiors, Dr. Jim
24 Siegrist and the head of the Laboratory, Nobel-prize winner Dr. Steve Chu. Each year since the
25 FOIA request, I have had to update Dr. Siegrist about the allegations of patent infringement.
26 Dr. Chu has expressed concern over these allegations on two occasions. I will have to continue
27 to answer questions about the patent infringement allegations until this matter is resolved.

- 1 6. In November 2005, Mr. Russell apparently sent another cease and desist letter with another
2 invoice, but he did not address it properly and the letter was returned to him. A true and correct
3 copy of the cease and desist letter is attached as Exhibit G.
- 4 7. In early January 2006, Mr. Russell sent another cease and desist letter and included a copy of
5 the November 2005 letter and its invoice. A true and correct copy of the cease and desist letter
6 is attached as Exhibit G.
- 7 8. In late January 2006, I wrote Mr. Russell back again. Attached as Exhibit H is a true and
8 correct copy of my letter. I stated that Katzer had claimed others' work in his patents, and that
9 both Katzer and Russell knew it. I told Russell that Katzer should dedicate his patents to the
10 public as it would be the best solution for all parties.
- 11 9. In early February 2006, Mr. Russell wrote me again. Attached as Exhibit I is a true and correct
12 copy of this letter. This was the last letter before I filed this lawsuit.
- 13 10. I have withheld several updates to JMRI software while waiting for this matter to be resolved.
14 In particular, I have written software code that would allow JMRI users to operate model trains
15 through the Internet, but I have not advertised it or released it due to the threat of patent
16 infringement charges. I expected this would be a popular feature, and users might use it and
17 practice claim 1 of the '329 patent or another claim of the multiple Katzer patents that
18 Defendants alleged I infringed. For these reasons, I withheld this particular update.
- 19 11. The main part of the lawsuit is seeking declarations from the Court that I did not infringe claim
20 1 of the '329 patent, and that claim 1 was invalid and unenforceable. I have been concerned
21 about the allegations that I infringed multiple Katzer patents, but if Defendants had disclaimed
22 claim 1 of the '329 patent, I might not have filed this lawsuit, or I may have dismissed it shortly
23 after filing. Instead, I have spent the last two years reviewing two and a half filing cabinets full
24 of prior art, and developing claim construction charts in preparation for this litigation. These
25 two years, and the costs in time and money, may have been avoided if Defendants disclaimed
26 the '329 patent at the start.

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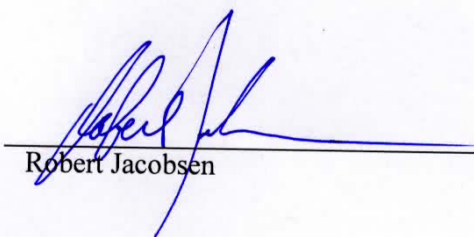
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1 - Respectfully submitted,

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3 DATED: February 29, 2008

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By 
Robert Jacobsen

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