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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)	
14)	OPPOSITION TO DEFENDANTS
15)	MATTHEW KATZER AND KAMIND
15	v.)	ASSOCIATES, INC.'S MOTION TO
16)	DISMISS FOR MOOTNESS
16	MATTHEW KATZER, et al.,)	
17)	Courtroom: 2, 17th Floor
17)	Judge: Hon. Jeffrey S. White
18)	Date: Fri., April 11, 2008
18)	Time: 9:00 a.m.
19)	
20)	
21)	

22 Plaintiff respectfully submits this Opposition to Defendants' Motion to Dismiss for Mootness.

23 **I. RELEVANT FACTS**

24 Three years ago, Defendants sent the first of multiple cease and desist letters to Plaintiff's
25 home address, alleging infringement of U.S. Patent No. 6,530,329. Declaration of Robert Jacobsen
26 [hereinafter Jacobsen Decl.] ¶ 1, Ex. A. Later, they included invoices in excess of \$200,000 to
27 Plaintiff's home address, and charged him with 7,000 infringements. Id. ¶ 3, 4, 6, 7, Ex. C, D, G.
28 In October 2005, they also sent a FOIA request, which included unnecessary allegations of patent

1 infringement, an invoice for more than \$200,000, and a false claim that a federal lawsuit had been
 2 filed against Plaintiff, to Plaintiff's employer, the U.S. Department of Energy and Lawrence
 3 Berkeley National Laboratory. *Id.* ¶ 5, Ex. E at 1, 3, 18. Plaintiff challenged Defendants to
 4 provide proof that Plaintiff infringed the '329 patent. *Id.* ¶ 2. Defendants did not even produce a
 5 claim construction position. *See id.* ¶¶ 1, 3, 4, 6, 7, 9, Ex. A, C, D, G, I. In March 2006, Plaintiff
 6 filed this lawsuit—the core of which was the declaratory judgment causes of action of non-
 7 infringement, invalidity, and unenforceability. Since the FOIA request, Defendants have
 8 repeatedly charged Plaintiff with infringement of not only the '329 patent, but of multiple
 9 unspecified patents. Jacobsen Decl. Ex. E at 1 (FOIA request: "KAMIND Associates, Inc. is a
 10 small software vendor that has patents being infringed by the JMRI project sponsored by the
 11 Lab."), Declaration of Matthew Katzer in Support of Special Motion to Strike [Docket #13] ¶ 5
 12 ("...infringing KAM's patents."), ¶ 7 ("...infringement of KAM's patents."); Defendants' Matthew
 13 Katzer and KAMIND Associates, Inc. Special Motion to Strike Plaintiff's Libel Claim under Cal.
 14 Civ. Pro. Code § 425.16 [Docket #29] at 5, l. 7 ("KAM believes that certain JMRI software
 15 infringes on KAM patents."), at 8, ll. 21-22 ("...to alert the DOE that the JMRI project was
 16 infringing on KAM patents.") (emphasis added in all).

17 Two years later, Defendants were subject to an order from Judge Laporte to produce
 18 disclosures relating to infringement, validity, and enforceability by January 31, 2008. [Docket
 19 #199]. Three months earlier, Defendants had promised Plaintiff and Judge Laporte they would
 20 make these disclosures, but had failed to do so. *See id.* Defendants again failed to produce the
 21 disclosures. Suddenly and without explanation, Defendants filed a disclaimer the next day,
 22 February 1, 2008, rather than produce the disclosures. *See* Declaration of Matthew Katzer [Docket
 23 #203], Ex. A. Defendants still have not produced the disclosures to Plaintiff. Now Defendants
 24 seek to dismiss the three declaratory judgment causes of action for mootness.

25 II. ARGUMENT

26 A. Case or Controversy Exists Because Defendants Have Not Provided Proof They 27 Filed Disclaimer

28 As a preliminary matter, a case or controversy still exists in this lawsuit until Defendants

1 prove they filed the disclaimer they included with their motion. A disclaimer which disclaims
2 patent claims has an effect similar to a certificate of correction—it eliminates the claims from the
3 patent, treating the patent as if it issued without them. Vectra Fitness, Inc. v. TNWK Corp., 162
4 F.3d 1379, 1384 (Fed. Cir. 1998). If Defendants indeed filed the disclaimer they attached to
5 Defendant Katzer’s declaration, Plaintiff agrees that the declaratory judgment actions relating to
6 non-infringement and invalidity of the ‘329 patent are moot because the disclaimer treats the ‘329
7 patent as if it never issued. Plaintiff is willing to stipulate, as Defendants stated in their Opposition
8 to Plaintiff’s Motion for Limited Early Discovery at 4, that “Plaintiff has achieved the relief sought
9 for declaratory judgments” relating to non-infringement and invalidity of the ‘329 patent, and asks
10 the Court to include this finding in its order. But here, the disclaimer which Defendants included
11 with their motion has no endorsement from the U.S. Patent & Trademark Office. Until they
12 provide the proof the PTO received the specific disclaimer Defendants filed here with the Court, or
13 the disclaimer appears in the U.S. Patent & Trademark Office’s Official Gazette, available at
14 <http://www.uspto.gov/web/patents/patog> (last visited Feb. 29, 2008), a case or controversy still
15 exists.¹ Thus, this court still has jurisdiction over the three declaratory judgment causes of action,
16 and should not strike any relief.

17 **B. Defendants Charged Plaintiff With Infringing Multiple Patents, Thus Case or**
18 **Controversy Exists as to Other Patents**

19 The declaratory judgment actions are not moot as they relate to the multiple patents that
20 Defendants alleged Plaintiff infringed. Defendants charged Plaintiff with infringement of multiple

21 ¹ Two disclaimers appear on the docket of the ‘329 patent in Public PAIR. However, these
22 disclaimers cannot be downloaded from the website. Defendants inexplicably did not send a copy
23 of the disclaimer to the PTO to endorse and return to Defendants for their files. See Ex. A,
24 Declaration of Scott Jerger, Opposition to Motion for Limited Early Discovery [Docket #209].
25 Furthermore, as suggested in Vectra Fitness, the PTO does not accept disclaimers that disclaim the
26 same subject matter. Vectra Fitness, 162 F.3d at 1384. Thus, in light of Vectra Fitness, the two
27 disclaimers raise questions as to what exactly Defendants filed with the PTO. Also, because
28 Defendants failed to provide the disclosure relating to infringement, validity, and enforceability as
promised to Plaintiff and Judge Laporte, Plaintiff believes it is necessary for Defendants to prove
they filed that specific disclaimer with the PTO, either with an endorsement from the PTO on the
disclaimer showing it was received, or by having it appear in the Official Gazette. In the
meantime, Plaintiff objects to the disclaimer because there is no proof that specific disclaimer was
filed with the PTO.

1 patents in their FOIA request to the U.S. Department of Energy, and represented to this Court in
2 earlier filings that Plaintiff infringed multiple patents. These threats can form the basis of a
3 declaratory judgment action, MedImmune, Inc. v. Genentech, Inc., 127 S.Ct. 764, 772-73 (2007),
4 and thus are not dependent solely on whether Defendants assert other Katzer patents, as Defendants
5 claimed in the Opposition to Plaintiff’s Motion for Limited Early Discovery. The declaratory
6 actions depend on whether there is a dispute between the parties. Defendants made the accusation,
7 which caused problems for Plaintiff at work and coerced him to withhold updates to JMRI software
8 that he believes he is entitled to add. Jacobsen Decl. ¶¶ 5, 10. Plaintiff seeks to have a declaration
9 as to his rights without having to “bet the farm”, MedImmune, 127 S.Ct. at 772 (2007), SanDisk
10 Corp. v. STMicroelectronics, Inc., 480 F.3d 1372, 1378 (Fed. Cir. 2007), by risking treble damages
11 and attorneys fees. When determining subject matter jurisdiction in declaratory judgment actions,
12 the court constructs a hypothetical complaint that the declaratory judgment defendant would have
13 filed. Fina Oil & Chem. Co. v. Ewen, 123 F.3d 1466, 1470 (Fed. Cir. 1997). The hypothetical
14 complaint here would read that Plaintiff infringed multiple patents. Due to the general nature of
15 the allegation in the hypothetical complaint, Plaintiff would have been entitled to file a motion for
16 more definite statement. The court would have still had jurisdiction over the case—and it still does
17 over the three declaratory judgment causes of action as they relate to the other patents.²

18 Also, due to the allegation that Plaintiff infringed multiple patents, the declaratory judgment
19 action relating to unenforceability of the ‘329 patent is not moot. Inequitable conduct as to one
20 patent may infect other related patents, making them unenforceable. Nilssen v. Osram Sylvania,
21 Inc., 504 F.3d 1223, 1230 (Fed. Cir. 2007). Because inequitable conduct as to the ‘329 patent may
22 render unenforceable other patents Katzer has asserted, the declaratory judgment action relating to
23 unenforceability of the ‘329 patent is not moot. Also, the Court retains jurisdiction over the
24 declaratory judgment cause of action relating to unenforceability so that it may determine an
25 attorney fee award. Monsanto Co. v. Bayer Bioscience, N.V., ___ F.3d ___, slip op. at 22-24 (Fed.
26 Cir. Jan. 25, 2008); see Brooks Furniture Mfg., Inc. v. Dutailier Int’l, Inc., 393 F.3d 1378, 1381

27 _____
28 ² Plaintiff filed a motion for limited, early discovery to obtain the identity of the other Katzer
patents. [Docket #207]. This Court denied the motion earlier today. [Docket #212].

1 (Fed. Cir. 2005). Thus, the Court should deny Defendants' motion to dismiss for mootness the
 2 declaratory judgment cause of action for unenforceability, and deny to motion to strike parts C, D,
 3 E, F, and T (relating to Sec. 285) of the relief.

4 **C. Court Retains Jurisdiction to Rule on Award of Costs and Attorney Fees**

5 Even if the Court loses jurisdiction over the declaratory judgment causes of action, the
 6 Court retains jurisdiction to determine an attorney fee award.³ Monsanto Co. v. Bayer Bioscience,
 7 N.V., ___ F.3d ___, slip op. at 22-24 (Fed. Cir. Jan. 25, 2008). Defendants seek to strike the
 8 attorney fee award, but offer no argument for doing so and fail to cite mandatory authority such as
 9 Monsanto.⁴ The Court should retain jurisdiction. Defendants have repeatedly represented to this
 10 Court that they had a good faith belief that Plaintiff was infringing multiple Katzer patents. In
 11 order to have that good faith belief, they must have conducted an infringement analysis. See View
 12 Eng'g, Inc. v. Robotic Vision Sys., Inc., 208 F.3d 981, 986-87 (Fed. Cir. 2000); Judin v. United
 13 States, 110 F.3d 780, 784 (Fed. Cir. 1997). But Defendants failed to produce disclosures on
 14 infringement, validity, and enforceability, and disclaimed the '329 patent to evade making the
 15 disclosure. Defendants could not identify even one instance of patent infringement, let alone the
 16 7,000 infringements that they charged Plaintiff with. In disclaiming the '329 patent instead of
 17 providing the disclosures, Defendants have in effect admitted they had no basis for their charges.
 18 If they had disclaimed the '329 patent at the start, they would not have wasted two years of this
 19 Court's limited time and resources on the '329 patent.⁵ Because they did not disclaim this patent at
 20 the beginning, Defendants have prejudiced Plaintiff, forcing both Plaintiff and his counsel to
 21 devote two years' of time and expense to review and prepare claim construction positions, and
 22

23 ³ Much like the Court retained jurisdiction to determine the anti-SLAPP attorney fee award to
 Kevin Russell although the Court found it did not have jurisdiction. [Docket #111] at 7-14.

24 ⁴ If Defendants offer argument in their Reply, Plaintiff will seek leave to file a Surreply.

25 ⁵ Indeed, if Defendants had disclaimed the '329 patent in early 2006, this lawsuit might never have
 26 been brought. Jacobsen Decl. ¶ 11. Pre-MedImmune law might have required a more specific
 27 threat relating to the other Katzer patents. Plaintiff did not know that Defendants had modified
 JMRI software and were including it with their products, see Supplemental Declaration of Robert
 28 Jacobsen in Support of Motion for Preliminary Injunction [Docket #131] at 3-5, so the copyright,
 DMCA, and contract claims would never had existed, and the Federal Circuit appeal would not be
 pending. The cybersquatting could have been resolved through a UDRP proceeding.

