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10 UNITED STATES DISTRICT COURT
11 FOR THE NORTHERN DISTRICT OF CALIFORNIA
12 SAN FRANCISCO DIVISION

13 ROBERT JACOBSEN,)
14)
Plaintiff,)
15)
v.)
16)
MATTHEW KATZER, et al.,)
17)
Defendants.)

No. C-06-1905-JSW
**RESPONSES TO DEFENDANTS
MATTHEW KATZER AND KAMIND
ASSOCIATE'S INC.'S EVIDENTIARY
OBJECTIONS TO DECLARATIONS OF
ROBERT JACOBSEN, DICK BRONSON,
HANS TANNER, AND JOHN PLOCHER**

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

21) Filed concurrently:
1. Proposed Order
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1 Plaintiff Robert Jacobsen responds to the objections of Defendants Matthew Katzer and
2 KAMIND Associates, Inc. (“KAMIND”) to declarations offered in support of Mr. Jacobsen’s
3 opposition to the Katzer and KAMIND anti-SLAPP motion. Mr. Jacobsen first responds in general
4 to certain objections which Mr. Katzer and KAMIND make repeatedly, and then offers responses
5 to Mr. Katzer and KAMIND’s objections in the order they were given.

6 General responses

7 A. When offered in response to anti-SLAPP motions, evidence in the opposing
8 party’s declarations must be considered if they would likely be admissible at
9 trial. Fashion 21 v. Coalition for Humane Immigrant Rights of Los Angeles, 117
10 Cal. App. 4th 1138, 1147-48 (Cal. App. 2004) (“On a SLAPP motion ‘[a]n
11 assessment of the probability of prevailing on the claim looks to trial, and the
12 evidence that will be presented at that time.’”) (emphasis in original). Thus,
13 objections based on lack of authentication or foundation, and the like, are
14 overcome because they would be very likely be established at trial. Also, many
15 of the objections made by Mr. Katzer and KAMIND go to the form of and not
16 the substance of a declarant’s statement and could be easily resolved at trial.

17 B. Mr. Jacobsen is an expert witness. In the complaint, he is offered as an expert
18 in the field of model train control system software. Complaint ¶ 2. He has a
19 bachelor’s degree in computer science and electrical engineering from the
20 Massachusetts Institute of Technology. Jacobsen Decl. ¶ 2. He has extensive
21 work experience in related fields. Id. ¶¶ 2-3. He also has extensive experience
22 in the field of model train control system software. Id. ¶¶ 8-9. Thus, he is
23 qualified to give expert opinion testimony on model train control system
24 software. He may also rely on hearsay evidence to form an opinion. Fed. R.
25 Evid. 703. That he is an interested witness does not bar his testimony. See Fed.
26 R. Evid. 702. See also, People v. Johnson, 62 Cal. App. 4th 608, 615 (1998)
27 (“By the mid-19th century, parties and interested witnesses in civil cases were

1 allowed to give sworn testimony ... in most states in this country. . . . The
2 elimination of the disqualification was based primarily on an argument that ‘. . .
3 a witness's motive for lying should go to the weight, not the admissibility, of
4 testimony.’”) Thus, Mr. Jacobsen’s interest in the case affects the weight of the
5 testimony, but not the admissibility. Also, he does not have to testify to the facts
6 underlying his opinion, unless required to do so by the court. Fed. R. Evid. 705.
7 Should the Court require Mr. Jacobsen to discuss the bases for his opinion, Mr.
8 Jacobsen will file a supplemental declaration for consideration with the motion.

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

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Responses to Specific Objections

Jacobsen declaration, objections based on hearsay

1. Mr. Katzer offered in his declaration that there were more than 2300 emails from Mr. Jacobsen’s Lawrence Berkeley National Lab account, and these formed the basis for Mr. Katzer’s belief that the U.S. Department of Energy was affiliated with the JMRI Project. Because Mr. Katzer offers this collection of emails as evidence, and selects a few to include in his declaration, Mr. Jacobsen is entitled to offer another email from this collection into evidence. Fed. R. Evid. 106. In the alternative, Mr. Jacobsen offers the email as admissible under 803(3) or for impeachment purposes.
2. This evidence is offered for impeachment purposes.
3. This evidence is offered for impeachment purposes.
4. This evidence is admissible under 803(3) or offered for the purposes of notice.
5. This evidence is admissible under 803(3) or offered for the purposes of notice.
6. This evidence is foundational is nature. Mr. Jacobsen offers that he has been in contact with Mr. Burke, and expects that Mr. Burke will provide a declaration or appear in response to a subpoena, per 10 C.F.R. § 202.
7. This evidence is foundational is nature. Mr. Jacobsen offers that he has been in contact with Mr. Burke, and expects that Mr. Burke will provide a declaration or appear in response to a subpoena, per 10 C.F.R. § 202.
8. Mr. Katzer has stated in his declaration that he did not know that Mr. Jacobsen was an employee of the Lawrence Berkeley National Lab.

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However, as noted in the opposition, the FOIA request was directed to the Physics Division of the Lawrence Berkeley National Lab, which Mr. Katzer would not have known to direct the request to unless he had done research, such as finding the information in Exhibit I. Thus, this evidence is offered for impeachment purposes.

9. This evidence is foundational in nature. Mr. Jacobsen offers that he will subpoena the Director if necessary to bring this testimony in.

10. This evidence is offered for the purposes of notice and impeachment.

11. This evidence is admissible under 803(3) and offered for the purposes of notice.

12. This evidence is admissible under Fed. R. Evid. 803(6), 807, and 201. Per Fashion 21, foundation needed to admit the evidence under 803(6) is very likely to be made at trial, so the evidence is admissible. It is a regulation and admissible under 201(d). As it was obtained from the Lawrence Berkeley National Lab, it has the circumstantial guarantees of trustworthiness. It is also necessary to establish why Mr. Jacobsen was concerned for his reputation and thus is material and serves the interests of justice by its admission.

13. This evidence is admissible under Fed. R. Evid. 803(6), 807, and 201. Per Fashion 21, foundation needed to admit the evidence under 803(6) is very likely to be made at trial, so the evidence is admissible. It is a regulation and admissible under 201(d). As it was obtained from the Lawrence Berkeley National Lab, it has the circumstantial guarantees of trustworthiness. It is also necessary to establish why Mr. Jacobsen was concerned for his reputation and thus is material and serves the interests of justice by its admission.

14. This evidence is admissible under Fed. R. Evid. 803(6), 807, and 201. Per

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Fashion 21, foundation needed to admit the evidence under 803(6) is very likely to be made at trial, so the evidence is admissible. It is a regulation and admissible under 201(d). As it was obtained from the Lawrence Berkeley National Lab, it has the circumstantial guarantees of trustworthiness. It is also necessary to establish why Mr. Jacobsen was concerned for his reputation and thus is material and serves the interests of justice by its admission.

15. This evidence is admissible under Fed. R. Evid. 803(6), 807, and 201. Per Fashion 21, foundation needed to admit the evidence under 803(6) is very likely to be made at trial, so the evidence is admissible. It is a regulation and admissible under 201(d). As it was obtained from the UC Berkeley, it has the circumstantial guarantees of trustworthiness. It is also necessary to establish why Mr. Jacobsen was concerned for his reputation and thus is material and serves the interests of justice by its admission.

16. This evidence is admissible under Fed. R. Evid. 803(6), 807, and 201. Per Fashion 21, foundation needed to admit the evidence under 803(6) is very likely to be made at trial, so the evidence is admissible. It is a regulation and admissible under 201(d). As it was obtained from the UC Berkeley, it has the circumstantial guarantees of trustworthiness. It is also necessary to establish why Mr. Jacobsen was concerned for his reputation and thus is material and serves the interests of justice by its admission.

17. Mr. Jacobsen asks the court to take judicial notice of this fact, under Fed. R. Evid. 201.

18. This evidence is foundational.

19. Mr. Katzer offered in his declaration that there were more than 2300 emails from Mr. Jacobsen's Lawrence Berkeley National Lab account. This evidence is offered for the purposes of showing that Mr. Katzer had

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notice of JMRI activities.

20. Mr. Katzer offered in his declaration that there were more than 2300 emails from Mr. Jacobsen’s Lawrence Berkeley National Lab account. This evidence is offered for the purposes of showing that Mr. Katzer had notice of JMRI activities.

21. Mr. Katzer offered in his declaration that there were more than 2300 emails from Mr. Jacobsen’s Lawrence Berkeley National Lab account, and these formed the basis for Mr. Katzer’s belief that the U.S. Department of Energy was affiliated with the JMRI Project. Because Mr. Katzer offers this collection of emails as evidence, and selects a few to include in his declaration, Mr. Jacobsen is entitled to offer another email from this collection into evidence. Fed. R. Evid. 106. In the alternative, Mr. Jacobsen offers the email for impeachment purposes.

22. This evidence is foundational and offered for the purposes of showing that Mr. Katzer had notice of JMRI activities.

23. This evidence is foundational and offered for the purposes of showing that Mr. Katzer had notice of JMRI activities. Any statement inferred from Mr. Katzer’s participation on the list is a party opponent admission offered under Fed. R. Evid. 801(d)(2)(A), (C) and (D). The statement is offered under subsections (C) and (D) because Katzer is an employee and agent of KAMIND, and KAMIND authorized him to make the statement.

24. This evidence is foundational and offered for the purposes of showing that Mr. Katzer was offered his products for sale and public use. Any statement inferred from Mr. Katzer’s participation on the list is a party opponent admission offered under Fed. R. Evid. 801(d)(2)(A), (C) and (D). The statement is offered under subsections (C) and (D) because Katzer is an employee and agent of KAMIND, and KAMIND authorized

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him to make the statement. Per Fashion 21, an affidavit from a person from the Internet Archive would likely be obtained to admit the evidence. See e.g., Telewizja Polska USA, Inc., v. Echostar Satellite Corp., No. 02 C 3293, 2004 WL 2367740 (N.D. Ill. Oct. 15, 2004), at *6. A similar affidavit would likely be obtained from a representative of Digitrax. Thus, the evidence is admissible. Another basis for admitting the evidence is that Mr. Jacobsen is an expert witness and offers this testimony as an expert.

25. Mr. Jacobsen is an expert witness and offers this testimony as an expert, and for impeachment purposes.

26. Mr. Jacobsen is an expert witness and offers this testimony as an expert, and for impeachment purposes. This exhibit and evidence is also admitted under Dr. Tanner's declaration.

27. This evidence is a 801(d)(2)(C) admission, or in the alternative, offered for the purpose of impeachment.

Tanner declaration, objection based on hearsay

1. This evidence is offered for the purpose of notice and impeachment.
2. This evidence is offered for the purpose of notice and impeachment.
3. This evidence is offered for the purpose of showing that Defendants Katzer and KAMIND had notice and for impeachment. The letter is also admissible under 803(3).
4. This evidence is offered for the purpose of showing that Defendants Katzer and KAMIND had notice of a number of material references, via Katzer and KAMIND's attorney Kevin Russell. The evidence is also admissible under 803(3) and for impeachment.

Jacobsen declaration, objection based on lack of personal knowledge

- 1 1. “Evidence to prove personal knowledge may, but need not, consist of the witness’ own
2 testimony.” Fed. R. Evid. 602 (emphasis added). Exhibit D provides the evidence. Also,
3 because Mr. Jacobsen is an expert witness, he may gain personal knowledge about this
4 matter. Fed. R. Evid. 703
- 5 2. Mr. Jacobsen is an expert witness, and he offers this information as personal knowledge
6 that he gained as an expert. Fed. R. Evid. 703.
- 7 3. Mr. Jacobsen is testifying that he observed the change in the website, and thus it is in his
8 personal knowledge that this occurred.
- 9 4. Mr. Jacobsen is an expert witness, and he offers this information as personal knowledge
10 that he gained as an expert.
- 11 5. Mr. Jacobsen is testifying that he observed the change in the website, and thus it is in his
12 personal knowledge that this occurred.
- 13 6. As to the removal of the web page, Mr. Jacobsen is testifying that he observed the change
14 in the website, and thus it is in his personal knowledge that this occurred. As to ¶ 139, Mr.
15 Jacobsen is an expert witness, and he offers this information as personal knowledge that he
16 gained as an expert while researching information from Mr. Katzer and KAMIND’s own
17 web page.
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22 Bronson declaration, objection based on lack of personal knowledge

- 23 1. Mr. Bronson is testifying from his personal knowledge that Mr. Katzer knows about the
24 JMRI Project. Any missing foundation can be laid to make this admissible.
- 25 2. Mr. Bronson is testifying from his personal knowledge about what he knows.
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27 Plocher declaration, objection based on lack of personal knowledge

- 1 1. Mr. Plocher is testifying from his personal knowledge that Mr. Katzer knows about the
- 2 JMRI Project. Any missing foundation can be laid to make this admissible.
- 3 2. Mr. Plocher is testifying from his personal knowledge about what he knows.

4 Jacobsen declaration, objections based on inadmissible legal conclusions and opinion objections

- 5 1. This is neither an opinion nor a legal conclusion, but a fact.
- 6 2. As to the statement that “JMRI is itself prior art”, Mr. Jacobsen is an expert witness, has 2
- 7 patents of his own, and can offer an opinion about whether JMRI software is prior art to the
- 8 ‘329 patent. The remaining statements are neither opinion or legal conclusions, but facts.
- 9 3. This is neither an opinion nor a legal conclusion but a fact. The patent application was filed
- 10 on April 17, 2002, after that particular version of JMRI was posted to the web on April 14,
- 11 2002.
- 12 4. The statement is not an opinion nor a legal conclusion, but a fact about what Mr. Jacobsen
- 13 thought Defendants intentions and motivations were.
- 14 5. This is neither an opinion nor a legal conclusion, but a factual inference from the evidence
- 15 presented. Despite the protections of tenure, faculty at UC Berkeley can be fired for
- 16 dishonesty, such as claiming ideas as their own, which is what Defendants accused Mr.
- 17 Jacobsen of.
- 18 6. The statement is not an opinion nor a legal conclusion, but a fact about what Mr. Jacobsen
- 19 thought Defendants intentions and motivations were. As an expert witness, Mr. Jacobsen
- 20 can offer an opinion about who are players in the market for model train control system
- 21 software. That Mr. Katzer would be in a better position to control the market with Mr.
- 22 Jacobsen and JMRI out of business is a fact.
- 23 7. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
- 24 the technology of the JMRI project code, and offer them into evidence.
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- 1 8. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
2 LocoNet system technology of Digitrax, and offer them into evidence.
- 3 9. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
4 WinLok program offered by DigiToys, and offer them into evidence.
- 5 10. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
6 WinLok program offered by DigiToys, and offer them into evidence.
- 7 11. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
8 Railroad & Co. program offered by Freiwald Software, and offer them into evidence.
- 9 12. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
10 ROSA presentation program by Dr. Tanner, and offer them into evidence.
- 11 13. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
12 programs offered by Mr. Katzer and KAMIND, and offer them into evidence.
- 13 14. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
14 programs offered by Mr. Katzer and KAMIND, and offer them into evidence.
- 15 15. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
16 programs offered by Mr. Katzer and KAMIND, and offer them into evidence. Furthermore,
17 Mr. Katzer admitted that Train Server is an embodiment of the “invention” in the Katzer
18 patents.
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- 20 16. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
21 programs offered by Mr. Katzer and KAMIND, and Train Track Computer Systems, and
22 offer them into evidence.
- 23 17. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
24 programs offered by Mr. Katzer and KAMIND, and Train Track Computer Systems, and
25 offer them into evidence.
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1 18. As an expert witness, Mr. Jacobsen can make comparisons between the patent claims and
2 programs offered by Mr. Katzer and KAMIND, and offer them into evidence.
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4 Tanner declaration, objections based on inadmissible legal conclusions and opinion objections
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6 1. As an expert witness, Dr. Tanner can identify which parts of his program have the
7 functionality which Defendants alleged infringed the Katzer patents.
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9 Jacobsen declaration, objections based on relevance

10 Mr. Katzer and KAMIND identify all 18 items under “Inadmissible Legal Conclusions and
11 Opinion” as being irrelevant, and then identify an additional 5 items as irrelevant. First, Mr.
12 Jacobsen addresses the 18 items, numbered 1-18, and then the 5 additional items, numbered 2-6 to
13 match the Katzer/KAMIND objections.
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15 1. Mr. Katzer asserts in his declaration that he believed the U.S. Department of Energy was
16 sponsoring the project. The evidence offered tends to rebut the testimony that it was a
17 federal government project.

18 2. The evidence tends to show inequitable conduct, which shows bad faith and is relevant to
19 whether litigation privilege can be invoked.

20 3. Mr. Russell asserted that the ‘878 patent application was filed before the code was
21 published. This is not true. This tends to show that Mr. Russell was acting in bad faith.

22 4. The evidence shows the motive behind Defendants’ bad faith efforts and thus is relevant.

23 5. The evidence shows the plan Defendants used to attempt to coerce Mr. Jacobsen into
24 making a payment to them, and thus goes to bad faith.
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26 6. The evidence shows the plan Defendants used and the motive driving Defendants’ actions.
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- 1 7. The evidence shows copying which is relevant to show inequitable conduct, which tends to
- 2 show bad faith.
- 3 8. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section.
- 4 9. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section.
- 5 10. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section.
- 6 11. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section.
- 7 12. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section.
- 8 13. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section.
- 9 14. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section.
- 10 15. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section.
- 11 16. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section
- 12 17. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section.
- 13 18. Mr. Jacobsen incorporates by reference his answer in paragraph 2 of this section.
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17 The additional items, beginning with number 2.

- 18 2. Mr. Katzer asserts that his belief that the U.S. Department of Energy was sponsoring the
- 19 JMRI Project based on two sets of evidence: (1) 2300+ emails from Mr. Jacobsen's
- 20 Lawrence Berkeley National Lab email account, and (2) two ancient articles related to a
- 21 National Science Foundation education grant, which resulted in a paper presented at a
- 22 conference co-sponsored by the Department of Energy. Mr. Jacobsen offers his reaction as
- 23 that of a reasonable person, to rebut Mr. Katzer's ridiculous assertion re the emails.
- 24
- 25 3. Mr. Katzer also asserted that he did not know that Mr. Jacobsen was a researcher. However,
- 26 as noted in the opposition, Mr. Katzer could not have pinpointed where to send the FOIA
- 27 request – the Physics Division of the Lawrence Berkeley National Lab – until he had found
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where Mr. Jacobsen worked at the Lab. This would have told Mr. Katzer that Mr. Jacobsen was indeed a researcher, contrary to Mr. Katzer's fabrication in the declaration. For these reasons, it is relevant.

- 4. This objection is a repeat of paragraph 4 from the Inadmissible Legal Conclusions and Opinion Objections. Mr. Jacobsen incorporates by reference his answer in paragraph 4 in the earlier 1-18 set of this section.
- 5. This evidence offers proof of coercive tactics, and intent to threaten Mr. Jacobsen despite knowing that the patents are unenforceable. It is also evidence of a hollow threat, known as such to Mr. Katzer, but unknown to Mr. Jacobsen, who would have been concerned that he would be subject to a lawsuit. Thus, it is relevant.
- 6. This objection is a repeat of paragraph 6 from the Inadmissible Legal Conclusions and Opinion Objections. Mr. Jacobsen incorporates by reference his answer in paragraph 6 in the earlier 1-18 set of this section.

Tanner declaration, objections based on relevance

- 1. The evidence tends to show inequitable conduct, which shows bad faith and is relevant to whether litigation privilege can be invoked.

DATED: July 6, 2006

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