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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.  
18  
19  
20

No. C-06-1905-JSW

**PLAINTIFF’S MOTION FOR LEAVE TO  
FILE MOTION FOR  
RECONSIDERATION, MOTION FOR  
STAY, AND REQUEST FOR  
CLARIFICATION**

Courtroom: 2, 17th Floor  
Judge: Hon. Jeffrey S. White

21 Plaintiff Robert Jacobsen files this motion for leave to file a motion for reconsideration  
22 under L.R. 7-9. Jacobsen files also this motion for stay. The Court correctly notes the  
23 requirements for it to have subject matter jurisdiction over a declaratory judgment action, but  
24 nowhere is there a requirement that the imminent lawsuit be brought in good faith. It merely needs  
25 to be imminent. For pre-litigation activities to be protected under anti-SLAPP laws, they must –  
26 among other things – be done in serious and good faith contemplation of a lawsuit. Cf. Flatley v.  
27 Mauro, 39 Cal. 4th 299, 320-24 (Cal. 2006) (demand letters were not protected activities under  
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1 anti-SLAPP laws; anti-SLAPP not co-extensive with litigation privilege). Plaintiff produced  
2 significant evidence that he believes will show that Katzer and Russell filed their anti-SLAPP  
3 declarations in bad faith – knowing that the information in them (specifically, their beliefs that the  
4 DOE was involved and that Jacobsen was infringing a valid and enforceable patent) was false.  
5 Thus, Jacobsen should be entitled to relief from this judgment under Rule 56(g) and/or 60(b). He  
6 asks the Court to stay the deadline to pay until the end of discovery and/or claim construction, so  
7 the he may be able to demonstrate that the declarations were made in bad faith. Jacobsen also  
8 includes in this motion a request for a clarification regarding the Ruling.

9 **I. Motion for Reconsideration**

10 Plaintiff respectfully asks the Court to reconsider its Oct. 20, 2006 ruling [Docket #111] for  
11 the following reasons:

12 **A. Anti-SLAPP**

13 In order for the movant to prevail, he needs to make a prima facie showing that he was  
14 engaging in an activity protected by Cal. Civ. P. § 425.16. For pre-litigation activities, he must  
15 show, among other things, that he was acting in serious and good faith contemplation of litigation.  
16 Mezetti v. State Farm Mutual Auto. Ins. Co., 346 F. Supp. 2d 1058, 1065 (N.D. Cal. 2004). In this  
17 case, this requires that Katzer and Russell had a serious and good faith belief that (1) Jacobsen  
18 and/or the JMRI Project were infringing a Katzer patent, and (2) the Department of  
19 Energy/Lawrence Berkeley Lab (DOE/LBL) was connected to Jacobsen and the JMRI Project  
20 when the FOIA (App. A.) was sent. The Ruling discusses the connection between DOE/LBL and  
21 Jacobsen, but there is no discussion about Defendants' having a good faith belief that Jacobsen  
22 and/or the JMRI Project were infringing – either directly or indirectly – a Katzer patent. Due  
23 process requires that the Court make such a finding before entering an anti-SLAPP judgment  
24 against Jacobsen. See TeleVideo Systems, Inc. v. Heidenthal, 826 F.2d 915, 917 (9th Cir. 1987).

25 To succeed on direct infringement of a method patent, such as Katzer's patents, Katzer  
26 must show that Jacobsen himself practiced the methods of the patent. RF Delaware, Inc. v. Pac.  
27 Keystone Techs., Inc., 326 F.3d 1255, 1267 (Fed. Cir. 2003). There is no such evidence in  
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1 Defendants' filings. To find indirect infringement of a method patent, Katzer must show (1)  
2 inducement to infringe, such as providing instructions and (2) direct infringement. Warner-  
3 Lambert Co. v. Apotex Corp., 316 F.3d 1348, 1363 (Fed. Cir. 2003). Despite 14 months of charges  
4 of infringement against Jacobsen, Defendants produced no evidence that JMRI or Jacobsen  
5 provided instructions to practice the steps in the '329 patent, nor any evidence of direct  
6 infringement by anyone. The only evidence – aside from conclusory statements by Katzer and  
7 Russell – is an isolated paragraph in Russell's August 2005 letter to Jacobsen. Russell Declaration,  
8 Ex. 3, at 1 [Docket #25]. There, Russell uses "program" and "interface" interchangeably, in  
9 violation of the canons of claim construction. Cf. U.S. Pat. No. 6,520,329 cl. 1 ("A method of  
10 operating a digitally controlled model railroad comprising the steps of: (a) transmitting a first  
11 command from a first program to an interface; (b) transmitting a second command from a second  
12 program to said interface; and (c) sending third and fourth commands from said interface  
13 representative of said first and second commands, respectively, to a digital command station.")  
14 (emphasis added). If a patentee uses different words within the same claim, it is presumed that the  
15 patentee meant different things. Even if the Court accepts this as a claim construction, the Court  
16 still would need to conduct its own claim construction to evaluate whether this definition can  
17 support a good faith belief of patent infringement.

18 Thus, we ask the Court vacate its Order, or in the alternative, vacate and defer until after  
19 claim construction when the Court may assess whether the description which Russell provided in  
20 his August 2005 letter can support a good faith belief of patent infringement.

21 **B. Antitrust**

22 Plaintiff respectfully submits that the threatened injury, which would support standing  
23 under Clayton Act § 16 (injunctive relief), is the \$203,000 in licensing fees which Katzer claims  
24 are due to him. These fees are in the relevant market – model train control system software.

25 **C. Libel**

26 At the August 11, 2006 hearing, Plaintiff also suggested he could succeed on a libel per  
27 quod theory, which has not been discussed in the Court's Ruling. The cases cited by Defendants  
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1 and the Court relate to a libel per se theory.<sup>1</sup> Libel per quod requires that the injurious character or  
 2 effect of the statement be established by the allegation and proof. Slaughter v. Friedman, 32 Cal.3d  
 3 149, 153-54 (Cal. 1982). Although the statement appears non-defamatory, extrinsic circumstances  
 4 impart the defamatory meaning to the statement. Gifford v. Nat'l Enquirer, Inc., (No. CV 93-3655  
 5 LGB, Dec. 7, 1993), 1993 WL 767192, at \*6; Palm Springs Tennis Club v. Rangel, 73 Cal. App.  
 6 4th 1, 5 (App. Ct. 1999) (“If ... the defamatory meaning would appear only to readers who might  
 7 be able to recognize it through some knowledge of specific facts and/or circumstances, not  
 8 discernible from the face of the publication, and which are not matters of common knowledge  
 9 rationally attributable to all reasonable persons, then the libel ... will be libel per quod.”). Special  
 10 damages must be pled and proved. Cal. Civ. § 45a. As he noted in his arguments, Jacobsen is  
 11 subject to the rules and regulations of the Lawrence Berkeley Lab and UC Berkeley. Jacobsen  
 12 Decl. ¶¶ 47-53, Ex. M, N [Docket #56]. Despite his tenured status, he could be dismissed from his  
 13 job for patent infringement. Id. Further, because of the sensitive nature of his field of work –  
 14 scientific research, an allegation of taking another’s work without giving due credit is defamatory.  
 15 Id. Thus these allegations of patent infringement have a tendency to injury one in his employment,  
 16 and meet the requirements of the libel statute. Cal. Civ. § 45. If not understood as such by the  
 17 public in general, this allegation of patent infringement would be understood as defamatory within  
 18 Jacobsen’s professional circle, which is libel per quod. Jacobsen stated that he lost wages as a  
 19 result, specifically identifying the source – a contract worth \$3,000 – plus at the hearing, his  
 20 counsel also stated that Jacobsen had to spend money to get patent file wrappers (\$800) to help him  
 21 defend himself against these charges. These constitute special damages. Gomes v. Fried, 136 Cal.

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 23 <sup>1</sup> Plaintiff also respectfully asks the Court to reconsider its finding re libel per se. Defendants had stated in their papers  
 24 that they had searched in vain for any case that might support a libel per se theory for a false allegation of patent  
 25 infringement, but did not find any. They did not search very hard. The following cases have permitted libel per se  
 26 theory for a false allegation of patent infringement: Republic Tobacco Co. v. N. Atlantic Trading Co., 381 F.3d 717,  
 27 728-29 (7th Cir. 2004); Del Monte Fresh Produce N.A., Inc. v. Transportation Ins. Co., 2006 WL 2331144 (Civ.A. 06  
 28 C 1658 N.D. Ill. Aug. 8, 2006), at \*5; Ideal Instruments, Inc. v. Rivard Instruments, Inc., 434 F. Supp. 2d 598, 622-23  
 (D. Iowa 2006); Amerisure Ins. Co. v. Laserage Tech. Corp., 2 F. Supp. 2d 296, 304 (W.D.N.Y. 1998); Accent  
 Designs, Inc. v. Jan Jewelry Designs, Inc., 827 F. Supp. 957, 967 (S.D.N.Y. 1993). Also, Defendants did not produce  
 the entire FOIA request in their papers. The FOIA request in its entirety is attached as Appendix A to this motion, and  
 does show that the FOIA was indeed about Jacobsen. He is mentioned numerous times, and the October 2005 bill from  
 KAMIND Associates, Inc. to “Bob Jacobson” for \$206,047.96 was included in the FOIA request. This bill is  
 addressed to Mr. Jacobsen’s home on Marin Avenue in Berkeley, California.

1 App. 3d 924, 939-40 (App. Ct. 1982) (special damages encompass pecuniary loss resulting from  
2 the defamatory statement). As a result, the libel claim should be permitted to stand as libel per  
3 quod.

## 4 **II. Stay**

5 Plaintiff requests a stay of execution until this Court conducts claim construction for the  
6 reasons stated herein. Plaintiff also requests the stay until the end of litigation for the reason noted  
7 in the introductory paragraph. In the course of filing his opposition to the anti-SLAPP motions,  
8 Plaintiff produced significant evidence of bad faith, and believes he can show that Katzer and  
9 Russell filed bad faith declarations in connection with their anti-SLAPP motions. Thus, Plaintiff  
10 believes he will be able to re-open the judgment under Rule 56(g) and/or 60(b) and vacate the anti-  
11 SLAPP attorney fee awards granted in the Court's Ruling. As noted earlier, maintaining a  
12 declaratory judgment action is not inconsistent with arguing that Katzer and Russell were not  
13 acting in good faith pre-litigation activities. Anti-SLAPP laws require Defendants (and then-  
14 Defendant Russell) to make a prima facie case of their activities in serious and good faith  
15 contemplation of litigation. Mezetti v. State Farm Mutual Auto. Ins. Co., 346 F. Supp. 2d 1058,  
16 1065 (N.D. Cal. 2004); cf. Flatley v. Mauro, 39 Cal. 4th 299, 320-24 (Cal. 2006). A declaratory  
17 judgment requires imminent apprehension of a lawsuit, Super Sack Mfg. Corp. v. Chase Packaging  
18 Corp., 57 F.3d 1054, 1058 (Fed. Cir. 1995), but not that the lawsuit be brought in good faith.

19 For these reasons, Jacobsen asks the Court to stay the requirement to pay until the close of  
20 discovery and/or claim construction.

## 21 **III. Request for Clarification**

22 Plaintiff requests a clarification regarding the Ruling. He seeks the Court's views on  
23 whether the anti-SLAPP ruling constitutes a finding of fact or conclusion of law that affects the  
24 inequitable conduct claim. Plaintiff believes that it does not, since the Ruling did not evaluate the  
25 inequitable conduct claim, but looked only at Katzer and Russell's evidence in evaluating whether  
26 they had made a prima facie case of engaging in a protected activity. Furthermore, Plaintiff  
27 believes that the Ruling could not, since to foreclose this avenue would be to permit anti-SLAPP  
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1 laws to usurp the federal law for reviewing patent claims, and would also violate the federal  
2 preemption doctrine, since California anti-SLAPP laws would preempt federal patent laws and  
3 Markman. However, Plaintiff makes this request to seek a clarification on this matter.

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5 Respectfully submitted,

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7 DATED: October 30, 2006

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