

1 R. Scott Jerger (*pro hac vice*) (Oregon State Bar #02337)
2 Field Jerger LLP
3 610 SW Alder Street, Suite 910
4 Portland, OR 97205
5 Tel: (503) 228-9115
6 Fax: (503) 225-0276
7 Email: scott@fieldjerger.com

8 John C. Gorman (CA State Bar #91515)
9 Gorman & Miller, P.C.
10 210 N 4th Street, Suite 200
11 San Jose, CA 95112
12 Tel: (408) 297-2222
13 Fax: (408) 297-2224
14 Email: jgorman@gormanmiller.com

15 Attorneys for Defendants
16 Matthew Katzer and Kamind Associates, Inc.

17 UNITED STATES DISTRICT COURT
18 NORTHERN DISTRICT OF CALIFORNIA
19 SAN FRANCISCO DIVISION

20 ROBERT JACOBSEN, an individual,
21
22 Plaintiff,
23
24 vs.
25
26 MATTHEW KATZER, an individual, and
KAMIND ASSOCIATES, INC., an Oregon
corporation dba KAM Industries,
Defendants.

Case Number C06-1905-JSW

Hearing Date: None
Hearing Time: None
Place: Ct. 2, Floor 17

Hon. Jeffrey S. White

**DEFENDANTS MATTHEW
KATZER AND KAMIND
ASSOCIATES, INC.'S
MEMORANDUM IN OPPOSITION
TO PLAINTIFF'S MOTION FOR
EARLY DISCOVERY**

Defendants Matthew Katzer and Kamind Associates, Inc. (Katzer) hereby respond to
Plaintiff's Motion for early discovery.

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Case Number C 06 1905 JSW
Defendants' Memorandum in Opposition to Plaintiff's Motion for Early Discovery

1 **INTRODUCTION**

2 As an initial matter, Plaintiff has, yet again, refused to comply with this Court’s rules and
3 orders. Plaintiff’s Motion for Early Discovery violates this Court’s standing order on discovery
4 and discovery motions as well as this Court’s Order referring all discovery matters to a
5 magistrate judge [Dkt. # 151]. Plaintiff’s Motion for Early Discovery is also not a motion for
6 administrative relief pursuant to Civil L.R. 7-11. Therefore, the Motion for Early Discovery is
7 not properly noticed or formatted pursuant to Civil L.R. 7-2 and not properly before this Court.
8 Plaintiff’s failure to follow the rules and orders of this Court works prejudice on Defendants as
9 Defendants must now either respond to this substantive motion within three (3) days pursuant to
10 Civil L.R. 7-11 or file the appropriate papers to require Plaintiff to comply with this Court’s local
11 rules and orders. Defendants have chosen the former by filing this Memorandum in Opposition.

12 Plaintiff’s motion for early discovery seeks information to oppose Defendants’ pending
13 Motion to Dismiss Counts 1, 2, and 3 of Plaintiff’s Second Amended Complaint as Moot [Dkt.
14 #203] (hereinafter “Defendants’ Motion to Dismiss”). The information Plaintiff seeks is “the
15 identity of patents that Plaintiff is alleged to infringe.” Plaintiff’s Motion for Early Discovery at
16 2. As conceded by Plaintiff in his Motion for Early Discovery and in response to Plaintiff’s
17 demand, Defendants have explained to Plaintiff that the word “patents” in the FOIA request
18 refers only to the ‘329 patent. Motion for Early Discovery at 2, Exhibit A to Decl. of R. Scott
19 Jerger.

20 Plaintiff’s Motion for Early Discovery belies Plaintiff’s true motives in this litigation.
21 Information relating to other patents is clearly unrelated and irrelevant to Plaintiff’s declaratory
22 actions on the ‘329 patent. To Plaintiff however, this case is not about the ‘329 patent, it is about
23 Defendants’ entire patent portfolio. *See* Second Amended Complaint at pages 15-34, Exhibit A
24 to Plaintiff’s Second Amended Complaint. Plaintiff’s problem, however, is that only the ‘329
25 patent had been asserted against Plaintiff in the form of demand letters and therefore, prior to the
26 filing of the Disclaimer, declaratory judgment jurisdiction and an actual controversy only existed

1 based on Defendants' assertion of the '329 patent. Plaintiff now desperately seeks
2 documentation that Defendants are asserting any of Defendants additional patents against
3 Plaintiff so that Plaintiff can foment additional litigation, bring additional declaratory actions in
4 this existing case and keep the patent aspects of this lawsuit alive.

5 Plaintiff's Motion for Early Discovery is a thinly veiled and not-so-artful attempt to
6 generate some sort of evidence that Plaintiff can point to so that he can allege that he is in
7 reasonable apprehension of imminent suit and that an actual controversy of sufficient immediacy
8 and reality exists among the parties in regard to Katzer's additional patents. However, as
9 Defendants have explained to Plaintiff, the FOIA request relates to the '329 patent. Exhibit A to
10 Decl. of R. Scott Jerger. Defendants are not presently asserting any other patent against Plaintiff
11 and there is no discoverable information to suggest otherwise.

12 Lastly, and most importantly, the issue of whether Plaintiff is being accused of infringing
13 any of Defendants patents, other than the '329 patent, is completely irrelevant to resolution of
14 Defendants' pending motion to dismiss Plaintiff's declaratory claims regarding the '329 patent.

15 ARGUMENT

16 1. Standard of Review

17 Plaintiff's motion to open formal discovery in this case falls under the Court's general
18 discretion to engage in case management. A party seeking expedited discovery must
19 demonstrate "good cause" for the early discovery. *Semitool, Inc. v. Tokyo Electron America*,
20 208 F.R.D. 273, 276 (N.D. Cal. 2003). Good cause requires the requested discovery to be
21 relevant to Plaintiff's opposition to Defendant's motion to dismiss the '329 declaratory actions
22 and "reasonably calculated to lead to the discovery of admissible evidence." *Id.* at 276, Fed. R.
23 Civ. P. 26(b)(1).

24 2. Discussion

25 Plaintiff can point to no conceivable factual situation or authority which would make
26 discovery of "the identity of the Katzer patents which Defendants alleged [Plaintiff] infringed"

1 relevant to the pending motion to dismiss the '329 claim. The only issue before this Court is
2 whether an actual and substantial controversy of sufficient immediacy and reality exists between
3 Plaintiff and Defendants regarding the '329 patent. *See* Defendants' Motion to Dismiss at 4-5.
4 No such controversy exists. Defendants have filed a Disclaimer of the '329 patent with the
5 USPTO and have additionally covenanted not to sue Plaintiff for past, present or future
6 violations of the '329 patent, to the extent this is necessary. *See* Exhibit A to Defendants'
7 Motion to Dismiss, Exhibit A to Decl. of R. Scott Jerger. Defendants can do nothing further and
8 Plaintiff has achieved the relief sought in his request for declaratory judgments of
9 unenforceability, invalidity and non-infringement regarding the '329 patent.

10 Plaintiff fuzzily asserts that information surrounding Defendants other patents not-in-suit
11 is relevant because "[i]f Defendants assert multiple patents, the declaratory judgment cause of
12 action of inequitable conduct during the prosecution of the '329 patent will not be moot because
13 inequitable conduct during the prosecution of the '329 patent may infect the other patents."
14 Motion for Early Discovery at 3 citing *Nilssen v. Osram Sylvania, Inc.*, 504 F.3d 1223, 1230
15 (Fed. Cir. 2007).

16 First, there is no "declaratory judgment cause of action of inequitable conduct" in the
17 complaint. The declaratory actions in the complaint address unenforceability, invalidity and non-
18 infringement of the '329 patent. All three of these issues are resolved with the Disclaimer.

19 Second, discovery on "the identity of the Katzer patents that Defendants allege in their
20 FOIA request [...] that Plaintiff infringed" is completely irrelevant to the issue of whether
21 Plaintiff's declaratory actions against the '329 patent are moot and is not reasonably calculated to
22 lead to the discovery of admissible evidence. Fed. R. Civ. P. 26(b)(1). There is no conceivable
23 piece of evidence that would alter the fact that Defendants have Disclaimed the '329 patent and
24 will not ever assert this patent against Plaintiff. *Nilssen* does not help Plaintiff in this matter, but
25 rather is inapposite to the issue at hand. Defendants agree with Plaintiffs that, in theory, alleged
26 inequitable conduct in the '329 patent can be used as the basis to invalidate another patent

1 asserted against Plaintiff. This was the issue in *Nilssen*. If, for example, Defendants were to
2 bring counterclaims against Plaintiff alleging infringement of another patent, then Plaintiff could
3 seek discovery on inequitable conduct relating to the prosecution of the '329 patent and a
4 holding from this Court that Defendants engaged in inequitable conduct relating to the
5 prosecution of the '329 patent, even though the '329 patent is no longer in suit. *Nilssen*, 504
6 F.3d at 1230. This issue is not presently before the Court, however. Similarly, as Plaintiff
7 acknowledges, if Defendants did assert any patent infringement counterclaims against Plaintiff in
8 this lawsuit, then Plaintiff can amend his complaint to include declaratory judgment actions for
9 non-infringement and invalidity of those recently-asserted patents at that time. Plaintiff's
10 Motion for Early Discovery at 3. This issue is also not presently before this Court. What is
11 before this Court is Defendants' pending motion to dismiss the declaratory actions against the
12 '329 patent. Information relating to the "identity of Katzer patents which Defendants alleged in
13 their FOIA request [...] that Plaintiff infringed" is completely irrelevant to the issue of whether
14 an actual and substantial controversy of sufficient immediacy and reality exists between Plaintiff
15 and Defendants regarding the '329 patent. As discussed in Defendants' Motion to Dismiss,
16 filing the Disclaimer removed any actual or substantial controversy regarding the '329 patent.

17 **3. Conclusion**

18 Based on the above, Defendants respectfully request that this Court deny Plaintiff's
19 motion for early discovery.

20 Dated February 27, 2008.

21 Respectfully submitted,

22 /s/ Scott Jerger

23 R. Scott Jerger (*pro hac vice*)
24 Field Jerger LLP
25 610 SW Alder Street, Suite 910
26 Portland, OR 97205
Tel: (503) 228-9115
Fax: (503) 225-0276
Email: scott@fieldjerger.com

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CERTIFICATE OF SERVICE

I certify that on February 27, 2008, I served Matthew Katzer's and KAM's MEMORANDUM IN OPPOSITION TO PLAINTIFF'S MOTION FOR EARLY DISCOVERY on the following parties through their attorneys via the Court's ECF filing system:

Victoria K. Hall
Attorney for Robert Jacobsen
Law Office of Victoria K. Hall
3 Bethesda Metro Suite 700
Bethesda, MD 20814

/s/ Scott Jerger
R. Scott Jerger (*pro hac vice*)
Field Jerger LLP