

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
6
7
8
9

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.)
16)
MATTHEW KATZER, et al.,)
17)
Defendants.)
18)
19)
20)
21)
22)
23)
24)
25)
26)
27)
28)

Courtroom: 2, 17th Floor
Judge: Hon. Jeffrey S. White
Date: Fri., December 19, 2008
Time: 9:00 a.m.

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. Because of the
19 way Katzer and Russell worded the FOIA request, they made it appear as though I had gotten
20 the Laboratory involved in JMRI and the Lab was therefore a party to patent infringement. I
21 can be fired from the Laboratory for patent infringement. Ex. F at 6. These allegations were
22 unnecessary to obtain the information that Defendants sought. The FOIA request also referred
23 to a "KAM legal action in federal court", Ex. E at 3, which had never been filed, but which I
24 and my superiors at the Laboratory thought had been filed against me. When this FOIA
25 arrived, I had to explain the FOIA request and patent infringement allegations to my superiors,
26 Dr. Jim Siegrist and the head of the Laboratory, Nobel-prize winner Dr. Steve Chu, who have
27 both expressed concern. Each year since the FOIA request, I have had to update Dr. Siegrist
28

1 about the allegations of patent infringement. I will have to continue to answer questions about
2 the patent infringement allegations until this matter is resolved.

3 6. In November 2005, Mr. Russell apparently sent another cease and desist letter with another
4 invoice, but he did not address it properly and the letter was returned to him. A true and correct
5 copy of the cease and desist letter is attached as Exhibit G.

6 7. In early January 2006, Mr. Russell sent another cease and desist letter and included a copy of
7 the November 2005 letter and its invoice. A true and correct copy of the cease and desist letter
8 is attached as Exhibit G.

9 8. In late January 2006, I wrote Mr. Russell back again. Attached as Exhibit H is a true and
10 correct copy of my letter. I stated that Katzer had claimed others' work in his patents, and that
11 both Katzer and Russell knew it. I told Russell that Katzer should dedicate his patents to the
12 public as it would be the best solution for all parties.

13 9. In early February 2006, Mr. Russell wrote me again. Attached as Exhibit I is a true and correct
14 copy of this letter. This was the last letter before I filed this lawsuit.

15 10. After I received the FOIA request, I learned about PACER and used it to search for the lawsuit
16 that had supposedly been filed against me. I found none. I knew about threats against Glen
17 Butcher that caused him to withdraw his software from distribution. Attached as Exhibit J is a
18 true and correct copy of an email from Glen Butcher regarding Katzer's threat to sue him. I
19 found Katzer's web pages, which boasted of suits against other model railroaders. Attached as
20 Exhibit K and L are true and correct copies of the relevant Katzer web pages. Using PACER, I
21 found the lawsuits against DigiToys, Freiwald Software, and Jerry Britton. I knew about the
22 threats against DigiToys and Freiwald, and considered the lawsuits, as well as other activities
23 described in the Opposition. I became increasingly concerned that Defendants would file suit
24 against me next. JMRI is Defendants' largest competitor in the United States, and the last
25 major software competitor that Defendants had not filed suit against, and I was a leader of
26 JMRI. These facts and Defendants' and Mr. Russell's aggressive enforcement tactics prompted
27 me to file suit.

1 11. I have withheld several updates to JMRI software while waiting for this matter to be resolved.

2 12. The main part of the lawsuit is seeking declarations from the Court that I did not infringe claim
3 1 of the '329 patent, and that claim 1 was invalid and unenforceable. I have been concerned
4 about the allegations that I infringed multiple Katzer patents, but if Defendants had disclaimed
5 claim 1 of the '329 patent, I might not have filed this lawsuit, or I may have dismissed it shortly
6 after filing. Instead, I have spent the last three years reviewing two and a half filing cabinets
7 full of prior art, and developing claim construction charts in preparation for this litigation.
8 These three years, and the costs in time and money, may have been avoided if Defendants
9 disclaimed the '329 patent at the start.

10 Respectfully submitted,

11 DATED: October 10, 2008

12
13 By  _____
14 Robert Jacobsen