VICTORIA K. HALL (SBN 240702)
LAW OFFICE OF VICTORIA K. HALL
3 Bethesda Metro Suite 700
Bethesda MD 20814
Victoria@vkhall-law.com
Telephone: 301-28-5925
Facsimile: 240-536-9142

Attorney for Plaintiff
ROBERT JACOBSEN

UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

ROBERT JACOBSEN, Plaintiff, v. MATTHEW KATZER, et al., Defendants.	No. C-06-1905-JSW **PLAINTIFF ROBERT JACOBSEN'S REPLY MEMORANDUM TO DEFENDANTS' AND RUSSELL'S OPPOSITIONS TO MOTION TO STRIKE PORTIONS OF DECLARATIONS OF MATTHEW KATZER AND KEVIN RUSSELL** Courtroom: 2, 17th Floor Judge: Hon. Jeffrey S. White Date: Fri., December 19, 2008 Time: 9:00 a.m.

I. INTRODUCTION

Because Defendants and Kevin Russell have not shown that their declarations meet the requirements of Civil L.R. 7-5, the unsupported sections of their declarations should be stricken.

II. BACKGROUND

In February 2008, Defendants filed a motion to dismiss the declaratory judgment causes of action relating to U.S. Patent No. 6,530,329. Defendants later re-filed the motion in September

2008.

Jacobsen opposed, arguing that the Court nonetheless retained jurisdiction. Defendants, and Kevin Russell, replied to Jacobsen's Opposition. They provided declarations in which they stated they had various beliefs about Jacobsen's alleged infringement of claim 1, a method claim, of the patent-in-suit, U.S. Patent No. 6,530,329, and the validity of that claim and patent. They did not provide either a legal analysis or factual support for their beliefs.

Jacobsen filed a motion to strike portions of their declarations, under Civil L. R. 7-5(b). Defendants and Russell filed oppositions but did not explain how their declarations meet the requirements of Civil L.R. 7-5(b). They did not amend their declarations to include the basis for their beliefs.

III. ARGUMENT

Civil L. R. 7-5 states: "Any statement made upon information or belief must specify the basis therefor. An affidavit or declaration not in compliance with this rule may be stricken in whole or in part." Because Defendants and Russell have not specified the basis for their beliefs, the portions of their declarations should be stricken. An analysis of infringement requires a claim construction, and a comparison of the claims, as construed, to the accused product or method. AquaTex Indus., Inc., v. Techniche Solutions, 419 F.3d 1374, 1380 (Fed. Cir. 2005). For method claims, a patent holder must further identify an infringer who is practicing the method, or must show that the product necessarily practices the method. ACCO Brands, Inc. v. ABA Locks. Mfrs. Co., 501 F.3d 1307, 1313 (Fed. Cir. 2007). Likewise, an analysis relating to validity requires the same claim construction as the one used for the infringement analysis, and a comparison with the prior art reference or references. Amazon.com, Inc. v. Barnesandnoble.com, Inc., 239 F.3d 1343, 1351 (Fed. Cir. 2001) ("A patent may not, like a 'nose of wax', be twisted one way to avoid anticipation and another to find infringement.") (citation omitted).

The deficiencies in Katzer and Russell's declarations exist and have not been cured. Neither Defendants nor Russell offer any claim construction and a comparison of the claims to the accused product to show the basis for their belief that Jacobsen infringed. They also do not

identify any infringer nor identify how JMRI software necessarily infringed claim 1 of the '329 patent. They also do not provide an analysis relating to validity to support their belief that, using same claim construction they used for infringement, the patent is valid. Therefore, the portions of their declarations should be stricken. E.g., Hologic, Inc. v. Senorx, Inc., No. C 08-00133 RMW, 2008 WL 1860035 (N.D. Cal. Apr. 25, 2008) at *16; ABM Indus., Inc. v. Zurich Am. Insur. Co., No. C 05-3480 SBA, 2006 WL 2595944 (N.D. Cal. Sept. 11, 2006) at *9; Page v. Children's Council, No. C 06-3268 SBA, 2006 WL 2595946 (N.D. Cal. Sept. 11, 2006) at *5; Reiffin v. Microsoft Corp., 270 F. Supp. 2d 1132, 1145 (N.D. Cal. 2003).

Defendants and Russell make a range of arguments in opposition to the motion to strike, but their arguments do not cure the deficiencies. Their arguments do not relate to Civil L. R. 7-5(b), but to their Reply memoranda. To the extent that these arguments add new material to their Reply, Jacobsen will address them in a separate Surreply that he is drafting.

The technology is simple. These claim terms are not difficult to construe. The relevant terms are found in any standard technical dictionary. There is no reason for Defendants and Russell not to, at least, attempt a claim construction—or better yet, provide the claim construction that they did prior to making their accusations against Jacobsen in March 2005.

But, on a separate note, perhaps a reason does exist to avoid claim construction and analysis. Russell's declaration provides a hint of a reason that Russell would not want to revisit his past infringement and validity analyses. Russell accuses Jacobsen of "attempt[ing] ... to litigate the issues in the patent office...." Declaration by Defendant Kevin Russell Supporting Reply to Plaintiff's Opposition Brief [Docket #254] at ¶ 6. Russell did not explain what the "attempt" was. Jacobsen has not made any filings with patent examiners, but the undersigned sent a letter, dated Aug. 20, 2007, to another department in the Patent Office, as required by PTO regulations. The substance of this letter, and facts in the public record, strongly suggest that Defendants and Russell have been less than candid with the Court on an important issue. Jacobsen is drafting a Surreply to address this and other issues raised in Defendants' and Russell's Reply memoranda.

IV. CONCLUSION

The motion to strike should be granted.

Respectfully submitted,

DATED: December 3, 2008

By /s/

Victoria K. Hall, Esq. (SBN 240702)
LAW OFFICE OF VICTORIA K. HALL
3 Bethesda Metro Suite 700
Bethesda MD 20814

Telephone: 301-280-5925
Facsimile: 240-536-9142

ATTORNEY FOR PLAINTIFF