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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-JL **PLAINTIFF ROBERT JACOBSEN'S REPLY MEMORANDUM TO DEFENDANTS MATTHEW KATZER AND KAMIND ASSOCIATES, INC.'S OPPOSITION TO JACOBSEN'S MOTION FOR DISCOVERY PLAN** Courtroom: F, 15th Floor Judge: Hon. James Larson Date: Weds., June 17, 2009 Time: 9:30 a.m.

Plaintiff Robert Jacobsen respectfully submits this Reply to Defendants Matthew Katzer and KAMIND Associates, Inc.'s Opposition to Jacobsen's Motion for Discovery Plan. Jacobsen requests a hearing in person, and that the matter not be decided on the papers.

I. Statement of Relevant Facts

Jacobsen adds the following to put the facts in the proper context.

Facts Relating to the Cause of Action

Jacobsen is a leader of an open source group called the Java Model Railroad Interface project, or JMRI. Several dozen developers, located in United States and 13 other countries, have contributed code to JMRI.[1] The developers produce software which permits a model railroader to easily program a model train decoder chip. Many chips exist. For each chip, developers create a file called a Decoder Definition File, which incorporates and arranges an individual manufacturers' data relating to its model train decoder chips. Defendants Katzer and KAMIND Associates, Inc. downloaded the Decoder Definition Files and converted them to a format to use with their product. Defendants did not follow the terms of the license. Because these terms were conditions, Defendants committed copyright infringement when they violated the license terms. See Jacobsen v. Katzer, 535 F.3d 1373, 1382 (Fed. Cir. 2008).

Procedure

On May 18, 2006, Defendants sought permission to continue the deadline for the Rule 26(f) conference, then set for July 11, 2006. [Docket # 34] The Court granted Defendants' request. [Docket # 41] Although the parties had put forward several case management statements, none of these statements included any detailed information related to discovery. [Dockets # 80, 82, 87, 146, 160, 216] They have never met and conferred as required by Rule 26(f). Prior to the May 1, 2009 status conference, Jacobsen's counsel attempted to meet and confer for discovery planning, but Katzer's counsel refused. He stated that there was no need for any changes to the discovery limits and said that the parties would work out whatever differences there were so that Jacobsen could get his evidence.

At the May 1, 2009 status conference, the district court entered a discovery order, [Docket # 302], but not, as Defendants stated, a discovery plan. The district court directed the parties to file motions to make changes in the limits to discovery granted by the rules. On May 15, 2009, the undersigned attempted to make changes to the limits in the discovery rules, including suggestions intended to narrow the scope of discovery. Katzer refused. In his opposition, Katzer now casts

[1] The open source development model, which JMRI relies upon, is based on input and software code contributions from developers around the world.

Jacobsen's proposal not as narrowing the scope, but as broadening the scope of discovery. That is the opposite of Jacobsen's intention.

II. Argument

Jacobsen sought modifications on discovery limits, in particular, depositions, interrogatories, and scope of discovery. Jacobsen addresses Defendants' opposition to each.

A. Depositions

Jacobsen's proposed modifications should be granted. In most litigation, there are a few witnesses who know most of the relevant facts. In those instances, 10 depositions are enough. Here, there are two witnesses who know most of the relevant facts—Robert Jacobsen and Matthew Katzer. There are many other witnesses—such as, the developers who created the code—who know specific facts about their work that Jacobsen needs to introduce, in particular about damages. These facts probably could be adduced in about one hour of deposition time with the relevant developer. Jacobsen may also need similar short depositions to seek evidence relating to permission to use data from manufacturers. Jacobsen asks only that such depositions not be treated as equivalent to the deposition of the parties, as the 10-deposition rule does.[2]

Where a number of witnesses' testimony is required to establish a party's right, a Court should grant the request for additional depositions in advance to avoid prejudice to the party caused from multiple requests for additional depositions. See Del Campo v. Am. Corrective Counseling Srvs., Inc., No. 01-21151-JW, 2007 WL 3306496, at *6 (N.D. Cal. Nov. 6, 2007) (in class action, granting additional 13 depositions in advance because of party's need to establish commonality and typicality, and to avoid prejudice to party that would be caused if forced to file a motion for each deposition).

Katzer argues that these depositions will be unduly burdensome and that only $1200 in sales[3] is at issue. That is incorrect. If statutory damages are not available to Jacobsen, the amount

[2] Some of this evidence can be obtained through written depositions, but it would benefit the jury to hear on videotape from the developers themselves, many of whom are located outside the San Francisco area.

[3] Katzer has counterclaimed for infringement of an instruction manual, for which he bought an assignment after being charged with copyright infringement. Jacobsen has not sold any of these manuals, thus his sales are $0. Katzer is seeking $6 million in damages.

of actual damages may be calculated through a value of use theory. See Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1174, (9th Cir. 1977), superseded on other grounds by 17 U.S.C. Sec. 504(b), as recognized in Dream Games of Ariz. v. PC Onsite, 561 F.3d 983, 988 (9th Cir. 2009). See also Polar Bear Prods., Inc. v. Timex Corp., 384 F.3d 700, 708-09 (9th Cir. 2004); Deltak, Inc. v. Advanced Systems, Inc., 767 F.2d 357, 361-62 (7th Cir. 1985). For example, if the average amount of time to develop a file is 15 hours, there are 100 files, and the hourly rate for a developer is $100/hr, then the evidence would support an award of $150,000. To establish this amount, Jacobsen needs to introduce evidence relating to the time JMRI developers took to create the files. Indeed, with a number of manufacturers, JMRI users, and developers in attendance at the National Model Railroad Association annual convention July 5-11, the parties may be able to conduct a number of these depositions in one week in one location. Jacobsen's request should be granted.[4]

B. Interrogatories

Jacobsen sought the additional interrogatories at the same time he sought changes to the deposition limits to save this Court's time by avoiding multiple motions and to avoid having to seek modifications late in discovery, when the deadline to complete discovery nears. Both his counsel regret the inadvertent error relating to the local rule, and withdraw the request.[5]

C. Scope of Discovery

Jacobsen seeks to limit discovery to the party's claims and defenses, issues relating to credibility, and any other issues that the parties may inquire into. Because the parties appear to agree that scope should be narrowed, the Court should grant the limits that Jacobsen requested.

Katzer argues that Jacobsen's proposal would broaden discovery. Cf. Declaration of Victoria K. Hall, Ex. A (email in which Katzer's counsel disagreed with proposal). The parties agree that Katzer has put in issue his intent to infringe Jacobsen's copyright, his intent to remove

[4] In the alternative, Jacobsen asks the Court to order the parties to meet and confer, as required by Rule 26(f), and put forward a proposal for a discovery plan by Friday, June 19, 2009, with a hearing set for Wednesday, July 1, 2009 at 9:30 a.m.

[5] Both counsel also regret the error relating to the motion to shorten time, and thank the Court's clerk for bringing it to their attention. Both counsel have re-read the local rules to refresh their memories.

copyright management information from Jacobsen's files, and his intent to profit from Jacobsen's domain name. Katzer has also put in issue whether he poses a future threat of infringement for purposes of injunctive relief. The jury will need to assess Katzer's credibility regarding these issues. Thus, discovery relating to credibility should be permitted. The additional language of "any other issues that the parties may inquire into" is standard boilerplate language, and should cause no problems.

III. Conclusion

To avoid problems later in discovery, and to provide the jury with the evidence it needs, Jacobsen asks the Court to modify the discovery, as stated above.

Respectfully submitted,

DATED: June 8, 2009

By /s/

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