

1 VICTORIA K. HALL (SBN 240702)
LAW OFFICE OF VICTORIA K. HALL
2 401 N. Washington St. Suite 550
Rockville MD 20850
3 Victoria@vkhall-law.com
Telephone: 301-738-7677
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, an individual,)
14)
Plaintiff,)
15 v.)
16)
MATTHEW KATZER, an individual, and)
17 KAMIND ASSOCIATES, INC., an Oregon)
corporation dba KAM Industries,)
18)
Defendants.)

No. C06-1905-JSW
**RESPONSE TO DEFENDANTS’
EVIDENTIARY OBJECTIONS TO THE
SUPPLEMENTAL DECLARATION OF
ROBERT JACOBSEN, THE
DECLARATION OF PAUL BENDER,
AND THE DECLARATION OF ALEX
SHEPHERD IN SUPPORT OF MOTION
FOR PRELIMINARY INJUNCTION**

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

21 Plaintiff Robert Jacobsen responds to Defendants’ Evidentiary Objections [Docket #135] to
22 the declarations [Docket #130, #131, #132] he filed with his Reply Memorandum [Docket #129].
23 He addresses them in the order which Defendants presents their objections.

24 As a preliminary matter, the Ninth Circuit has ruled that, when determining whether to
25 issue a preliminary injunction, district courts may consider evidence that would be inadmissible at
26 trial. Republic of the Philippines v. Marcos, 862 F.2d 1355, 1363 (9th Cir. 1988); United States
27 Cellular Investment Co. of Los Angeles, Inc. v. AirTouch Cellular, No. CV 99-12606 DT BQRX,
28

1 2000 WL 349002, at * 4 (C.D. Cal. Mar. 27, 2000). Aside from this, to the extent that foundation
2 for any of the objected-to evidence is missing to make it admissible under the Federal Rules of
3 Evidence, Plaintiff offers to provide that evidence at a later stage in this litigation.

4 **A. Declaration of Alex Shepherd**

5 Hearsay objections

6 1. Exhibit A: This exhibit is a statement describing an event made immediately after the declarant
7 (Mr. Shepherd) perceived the event. Thus, it is admissible under FRE 803(1). It is also a statement
8 related to a startling event made while Mr. Shepherd was under the excitement caused by the event.
9 It is admissible under FRE 803(2).

10 2. Exhibit B: This exhibit is a screenshot from Defendants' computer program, via a computer.
11 The hearsay rules apply only the statements made by a declarant, who is defined as "a person
12 makes a statement". FRE 801(b) and (c). It does not apply to non-humans. United States v.
13 Hamilton, 413 F.3d 1138 (10th Cir. 2005). To the extent that there are any statements from a
14 human, those statements are from Defendants or their employees or agents, and thus are admissible
15 under FRE 801(d)(2)(A) through (D).

16 3. Paragraph 5: This paragraph describes what Mr. Shepherd did, not what he said, thus there is no
17 statement that may constitute hearsay. Exhibit A, referred to in Paragraph 5, is discussed above.
18 The response to Defendants' objection to Exhibit A is incorporated by reference.

19 Foundation objections

20 Plaintiff believes that Mr. Shepherd's description of the steps he took do not constitute expert
21 opinion (FRE 702/703) or require authentication (FRE 901). In the alternative, Defendants have
22 implicitly made an admission that Mr. Shepherd is an expert witness. Mr. Shepherd is the
23 developer who created the accused feature in the JMRI software. Declaration of Robert Jacobsen
24 in Opposition to Motion to Strike Pursuant to CCP Sec. 425.16, at ¶¶ 62-63 [Docket #46]. If
25 Defendants accused this feature of infringing their patent, then they are logically admitted that the
26 person who created this feature has the technical skills to create software capable of infringing the
27 patent. Thus, to the extent that it is relevant to their objections, relevancy which as noted earlier

1 Plaintiff disputes, Defendants are admitting that Mr. Shepherd is an expert in software
2 development, and thus is qualified to do the basic tasks of downloading files, opening *.zip files,
3 running *.exe files, and opening readme.txt files.

4 1. Exhibit A: This is an email. The foundation for the email is described in paragraph 5 in the
5 section addressing Defendants' hearsay objections.

6 2. Exhibit B: The screenshot is the product of running the tool which Mr. Shepherd downloaded, as
7 described in his declaration. Mr. Shepherd is testifying to facts which are common knowledge –
8 downloading a file from the Internet, unzipping a file with a *.zip extension with the result that
9 files in the *.zip file are produced on the computer, running a file with a *.exe extension, and
10 opening and reading a file named readme.txt. Plaintiff asks the Court to take judicial notice per
11 FRE 201(b)(1) that performing these activities is common knowledge. Thus, they are facts, and
12 not opinion evidence under FRE 703, and furthermore, do not require detailed explanations about
13 the process or methods for foundation. In addition, these facts are not simulations of real events,
14 which would require validation per FRE 901 that the simulation replicated the real event, but the
15 real events themselves which Mr. Shepherd is testifying to. Thus, FRE 901 does not apply.

16 3. Paragraph 4: Mr. Shepherd describes what he did and result. Again, these are facts which
17 require no expert testimony. They describe the real event at issue, not simulations of real events
18 which would require validation per FRE 901 that the simulation replicated the real event, and thus
19 FRE 901 is not applicable.

20 **B. Declaration of Paul Bender**

21 Foundation objections

22 1. Paragraph 4: Mr. Bender is testifying as to facts, not opinion, thus FRE 703 and 901 do not
23 apply. Mr. Bender created some of the files, using the manufacturers' books. He testified that he
24 does not merely copy numbers or data when creating the files

25 2. Paragraph 5: Again, Mr. Bender is testifying as to facts, not opinion, thus FRE 703 and 901 do
26 not apply. To the extent he is supplying any views, it is not an expert opinion but is an explanation
27 of why he created the Decoder Definition Files the way he did.

1 **C. Supplemental Declaration of Robert Jacobsen**

2 Hearsay objections

3 1. Exhibit B: Defendants have not identified what in this exhibit they consider to be hearsay, so
4 Plaintiff addresses the word “Download” on the Download link on page 2 of this exhibit: These are
5 not statements offered for the truth of the matter asserted, but are operative facts. In the alternative,
6 Plaintiff asks the Court to take judicial notice under FRE 201(b)(1) that the word “Download” is
7 commonly used to direct the user to move his mouse pointer on the word “download” on a
8 computer screen and click the word so that a file may be transferred from another server via the
9 Internet to the user’s computer.

10 2. Exhibit C: Plaintiff incorporates by reference his response to Exhibit B of this section.

11 3. Exhibit D: This letter to Defendant Katzer records Plaintiff’s thoughts on the matter and thus is
12 admissible under FRE 803(3). To the extent that 803(3) is not applicable, this is not offered for the
13 truth of the matter asserted, but to show that Defendant had notice of Plaintiff’s claim to the
14 trademark DecoderPro®.

15 4. Exhibit E: This is admissible for the same reason as Exhibit A of Alex Shepherd’s Declaration is
16 admissible. See Response to Hearsay Objection to Exhibit A in the section on Declaration of Alex
17 Shepherd. As to the remaining statements (in the readme.txt file), they are admissible under FRE
18 801(d)(2)(A) through (D).

19 5. Exhibit F: A statement must be made by a human to constitute hearsay. FRE 801(b) and (c).
20 These statements are made by Defendants’ computer program. To the extent that any human is
21 responsible for these statements, it is Defendants and/or their employees and/or agents, and thus is
22 admissible under FRE 801(d)(2)(A) through (D).

23 6. Exhibit G: A statement must be made by a human to constitute hearsay. FRE 801(b) and (c).
24 These statements are made by, or as a result of, Defendants’ computer program. To the extent that
25 any human is responsible for these statements, it is Defendants and/or their employees and/or
26 agents, and thus is admissible under FRE 801(d)(2)(A) through (D).

27 7. Exhibit J: This website is operated by a vendor who contracts with Defendants to sell their
28

1 products. Any statements on this website is a statement made by Defendants and/or their
2 employees and/or their agents, and thus is admissible under FRE 801(d)(2)(A) through (D).

3 8. Exhibit K: Plaintiff incorporates by reference his response in this section to Defendants'
4 objection to Exhibit J.

5 9. Exhibit M: This document is admissible under FRE 803(6). Business records are admissible
6 under FRE 803(6) if "(1) the writing is made or transmitted by a person with knowledge at or near
7 the time of the incident recorded, and (2) the record is kept in the course of regularly conducted
8 business activity." United States v. Miller, 771 F.2d 1219, 1237 (9th Cir. 1985). As Defendant
9 Katzer is aware, given his familiarity with NMRA standards, this document is a standards
10 document made with knowledge at or near the time the document was created or changes were
11 made, and is kept in the course of regularly conducted business by an NMRA officer with the
12 responsibility to update the document. Plaintiff is seeking a stipulation from Defendants that this
13 document is admissible, or offers that he will obtain a declaration, or subpoena, an NMRA official
14 to lay the foundation for this exhibit. As noted earlier, even without this foundation, the district
15 court may accept this evidence for the purpose of deciding whether to issue a preliminary
16 injunction. Republic of the Philippines v. Marcos, 862 F.2d 1355, 1363 (9th Cir. 1988). Thus, this
17 objection should be overruled.

18 10: Exhibit N: This document is admissible under FRE 803(6). Business records are admissible
19 under FRE 803(6) if "(1) the writing is made or transmitted by a person with knowledge at or near
20 the time of the incident recorded, and (2) the record is kept in the course of regularly conducted
21 business activity." United States v. Miller, 771 F.2d 1219, 1237 (9th Cir. 1985). As Defendant
22 Katzer is aware, given his familiarity with the Lenz manufacturer, this document is a
23 manufacturer's product document made with knowledge at or near the time the document was
24 created or changes were made, and is kept in the course of regularly conducted business by Lenz
25 employee with the responsibility to update the document. Plaintiff is seeking a stipulation from
26 Defendants that this document is admissible, or offers that he will obtain a declaration, or
27 subpoena, an appropriate Lenz employee to lay the foundation for this exhibit. As noted earlier,

1 even without this foundation, the district court may accept this evidence for the purpose of deciding
2 whether to issue a preliminary injunction. Republic of the Philippines v. Marcos, 862 F.2d 1355,
3 1363 (9th Cir. 1988). Thus, this objection should be overruled.

4 11. Exhibit O: This document is admissible under FRE 803(6). Business records are admissible
5 under FRE 803(6) if “(1) the writing is made or transmitted by a person with knowledge at or near
6 the time of the incident recorded, and (2) the record is kept in the course of regularly conducted
7 business activity.” United States v. Miller, 771 F.2d 1219, 1237 (9th Cir. 1985). As Defendant
8 Katzer is aware, given his familiarity with Digitrax, this document is a manufacturer’s product
9 document made with knowledge at or near the time the document was created or changes were
10 made, and is kept in the course of regularly conducted business by a Digitrax employee with the
11 responsibility to update the document. Plaintiff is seeking a stipulation from Defendants that this
12 document is admissible, or offers that he will obtain a declaration, or subpoena, an appropriate
13 Digitrax employee to lay the foundation for this exhibit. As noted earlier, even without this
14 foundation, the district court may accept this evidence for the purpose of deciding whether to issue
15 a preliminary injunction. Republic of the Philippines v. Marcos, 862 F.2d 1355, 1363 (9th Cir.
16 1988). Thus, this objection should be overruled.

17 12. Paragraph 14: The statement which Alex Shepherd made to Mr. Jacobsen: See Response to
18 Hearsay Objection to Exhibit A in the section on Declaration of Alex Shepherd. As to the
19 remaining statements (in the readme.txt file), they are admissible under FRE 801(d)(2)(A) through
20 (D).

21 13: Paragraph 61: There are no statements in this paragraph that are made for the truth of the matter
22 asserted. To the extent that to “credit JMRI” may constitute a statement, it is an operative fact.

23 14. Paragraph 63: There are no statements in this paragraph that are made for the truth of the
24 matter asserted. To the extent that “He gives JMRI credit.” may constitute a statement, it is an
25 operative fact.

26 Foundation objections

27 Plaintiff has offered his expert qualifications on two occasions – the anti-SLAPP declaration and
28

1 his declaration accompanying his Motion for Preliminary Injunction. Plaintiff has a Bachelor's
2 degree in electrical engineering and computer science from MIT and doctorate in experimental
3 high energy physics from Stanford. Declaration of Robert Jacobsen in Opposition to Motion to
4 Strike Pursuant to CCP Sec. 425.16, at ¶¶ 2-3 [Docket #46]. He created computer controls in the
5 process control industry after graduation from MIT and has led groups of researchers to build
6 complex software systems. Id. He teaches physics at UC Berkeley with his Nobel Prize-winning
7 peers, and conducts advanced research in particle physics at the Lawrence Berkeley National
8 Laboratory. Id. at ¶¶ 4-5. He published a paper on using object-oriented software engineering in
9 connection with his work at the BaBar experiment, a major experimental high energy physics
10 collaboration at the Stanford Linear Accelerator Center. Id. at ¶¶ 3, 6. Plaintiff has been involved
11 in model railroading for the last 6 years, and played a major role in creating the JMRI software. Id.
12 at ¶¶ 7-9; Declaration of Robert Jacobsen in Support of Motion for Preliminary Injunction, at ¶¶ 1-
13 2 [Docket #115]. He has also tested other model railroad control systems manufacturer's products.
14 E.g., Declaration of Robert Jacobsen in Opposition to Motion to Strike Pursuant to CCP Sec.
15 425.16, at ¶ 86 [Docket #46]. As Defendant Katzer knows, Plaintiff was chair of the NMRA's
16 Digital Command Control Working Group, which works to create technical standards for model
17 railroad manufacturers. See Declaration of Robert Jacobsen in Support of Motion for Preliminary
18 Injunction, Ex. L (Defendant Katzer offering congratulations and advice to Plaintiff after Plaintiff's
19 announcement that he is head of the DCC Working Group) [Docket #115]. Plaintiff is qualified to
20 test Defendants' software.

21 As to the FRE 901 objection, Plaintiff is not offering testimony about a simulation of the
22 real event, which would require validation per FRE 901 that the simulation replicated the real
23 event, but testimony as to the real event itself – the installation and use of the software. Thus, FRE
24 901 is not applicable. To the extent that a description of the process or method used is required,
25 Plaintiff offers that the basic steps of installing the software (that is, inserting the Decoder
26 Commander CD in the computer's CD drive, clicking the install button that Decoder Commander
27 displays on the computer screen, hitting the "Enter" button several times, and clicking to accept the

1 license) are common knowledge and do not need to be detailed in his declaration. As for his
2 testimony that the infringing files were still present, Plaintiff offers that no highly technical process
3 or method is required – only locating the files in Defendants’ product’s file folders. See Bauman v.
4 DaimlerChrysler AG, No. C-04-00194 RMW, 2005 WL 3157472, at *5 (N.D. Cal. Nov. 22, 2005)
5 (discussing “elastic” standards of the rule – “sufficient to support a finding that the matter in
6 question is what proponent claims”). Thus, this objection should be overruled.

7 1. Paragraph 22: Plaintiff incorporates by reference the discussion above.

8 2. Paragraph 23: Plaintiff incorporates by reference the discussion at the beginning of this section.

9 3. Paragraph 24: Plaintiff incorporates by reference the discussion at the beginning of this section.

10 4. Exhibit F: Plaintiff incorporates by reference the discussion at the beginning of this section.

11 5. Exhibit G: Plaintiff incorporates by reference the discussion at the beginning of this section.

12 Commentary objection

13 1. Paragraph 25: This paragraph is relevant under FRE 402 because it explains one reason why
14 Plaintiff continues to press his Motion for Preliminary Injunction despite Defendants’ assertions
15 that their infringing conduct has come to a halt – Plaintiff tested Defendants’ software, searched
16 Defendants’ website, and looked to Defendants’ vendors’ websites, and found that Defendant
17 Katzer hadn’t done what he said he did in his declaration. Plaintiff discusses another reason which
18 is a significant omission in Katzer’s testimony – no statements regarding the effect of Katzer’s
19 changes on registered copies of Decoder Commander.

20 Respectfully submitted,

21 DATED: December 4, 2006

22 By _____ /s/
Victoria K. Hall, Esq. (SBN 240702)
LAW OFFICE OF VICTORIA K. HALL
23 401 N. Washington St. Suite 550
24 Rockville MD 20850

25 Telephone: 301-738-7677
Facsimile: 240-536-9142

26 ATTORNEY FOR PLAINTIFF