



1 Courtroom 2, Floor 17, of the above-entitled court located at 450 Golden Gate Avenue, San  
2 Francisco, California.

3 **MOTION**

4 Defendants Matthew Katzer (“Katzer”) and Kamind Associates, Inc. (“KAM”) move the  
5 court for an order dismissing Counts 1, 2 and 3 of Plaintiff’s second amended complaint, and the  
6 associated relief requested in Plaintiff’s Prayer for Relief A, B, C, D, E, F, G and T (requesting  
7 costs and attorney fees pursuant to 35 U.S.C. § 285), as moot under Fed. R. Civ. P. 12(b)(1).

8 **STATEMENT OF ISSUES TO BE DECIDED**

- 9 1. Whether Counts 1, 2 and 3 and the associated relief requested in Plaintiff’s Second  
10 Amended Complaint should be dismissed as moot.

11 **STATEMENT OF RELEVANT FACTS**

12 The second amended complaint contains 7 counts against KAM and/or Katzer. Three of  
13 the claims request declaratory relief relating to the patent-in-suit, the ‘329 patent. Currently  
14 pending before this Court is Defendants’ 12(b)(6) motion to dismiss Plaintiff’s Digital  
15 Millelleum Copyright Act (DMCA) claim and Plaintiff’s breach of contract claim (counts 5 and  
16 6 respectively). This pending motion also requests that this Court strike all portions of the  
17 amended complaint seeking attorney fees and statutory damages pursuant to 17 U.S.C. §§ 504,  
18 505. The present motion seeks to dismiss Count 1 (Declaratory Judgment of Unenforceability of  
19 the ‘329 patent, Count 2 (Declaratory Judgment of Invalidity of the ‘329 Patent), and Count 3  
20 (Declaratory Judgment of Non-Infringement of the ‘329 Patent) of the Second Amended  
21 Complaint. Additionally, this motion seeks to dismiss Plaintiff’s associated relief requested in  
22 Plaintiff’s Prayer for Relief A, B, C, D, E, F and G relating to requests for declarations and an  
23 injunction relating to the ‘329 patent as well as Prayer for Relief T requesting a determination by  
24 this Court that this is an “exceptional case” and that Plaintiff is entitled to an award of costs and  
25 attorney fees pursuant to 35 U.S.C. § 285.

1 This motion is based on the Defendants' February 1, 2008 Disclaimer in Patent under 37  
2 C.F.R. 1.321(a) filed with the United States' Patent and Trademark Office, disclaiming all claims  
3 in the '329 patent. *See* Exhibit A to Decl. of Matthew Katzer. This divests the Court of subject  
4 matter jurisdiction.

## 5 ARGUMENT

### 6 1. Standard of Review

7 A motion to dismiss is proper under Fed. R. Civ. P. 12(b)(1) for lack of subject matter  
8 jurisdiction. In this case, Defendants recent action of filing a Disclaimer of the '329 patent  
9 removes this Court of subject matter jurisdiction under both the (1) case or controversy  
10 requirement for federal court jurisdiction in the U.S. Constitution, and (2) the doctrine of  
11 mootness.

12 Lack of subject matter jurisdiction may be raised at any stage of the litigation. *Morongo*  
13 *Band of Mission Indians v. Cal. State Board of Equalization*, 858 F.2d 1376, 1380 (9<sup>th</sup> Cir.  
14 1988). Because this Court's power to hear the case is at stake, this Court is not limited to  
15 considering only the allegations in the complaint and this court may consider extrinsic evidence.  
16 *Augustine v. United States*, 704 F.2d 1074, 1077 (9<sup>th</sup> Cir. 1983).

### 17 2. Discussion

18 The United States Constitution limits federal judicial power to designated "cases" or  
19 "controversies." U.S. Constit., Art. III, § 2. Thus, federal courts may only determine such  
20 matters that arise in the context of an actual "case" or "controversy." *SEC v. Medical Comm'n*  
21 *for Human Rights*, 404 U.S. 403, 407, 92 S. Ct. 577, 30 L. Ed.2d 560 (1972). Consistent with  
22 this Constitutional requirement, the Declaratory Judgment Act, 28 U.S.C. § 2201(a) (2007)  
23 provides that a district court has jurisdiction over a declaratory judgment action only when there  
24 exists an "actual controversy." An actual controversy must exist at all stages of review, not  
25 merely at the time the complaint is filed. *Preiser v. Newkirk*, 422 U.S. 395, 401, 95 S.Ct. 2330,  
26 45 L. Ed.2d 272 (1975). It is the burden of the party claiming declaratory judgment jurisdiction

1 to establish that such jurisdiction existed at the time the claim was filed and that it has continued  
2 since. *Steffel v. Thompson*, 415 U.S. 452, 459 n.10, 94 S.Ct. 1209, 39 L.Ed.2d 505 (1974). For  
3 an actual controversy to exist in the declaratory actions that Plaintiff asserts, Plaintiff bears the  
4 burden of proving that the facts alleged “under all circumstances, show that there is a substantial  
5 controversy, between the parties having adverse legal interests, of sufficient immediacy and  
6 reality to warrant the issuance of a declaratory judgment.” *MedImmune, Inc., v. Genentech, Inc.*,  
7 127 S.Ct. 764, 771, 166 L. Ed. 2d 604 (2007).

8 Here, although an substantial controversy of sufficient immediacy and reality may have  
9 existed prior to Defendants filing their Disclaimer of Patent, the filing of the Disclaimer removes  
10 any controversy (at all, immediate or otherwise) between the parties that Jacobsen (or anyone  
11 else for that matter) will face an infringement suit based on an assertion of the ‘329 patent. The  
12 Federal Circuit, prior to the recent *MedImmune* case discussed *supra*, has held that a covenant  
13 not to sue contained in a declaration filed in Court by the patentee, in an action seeking  
14 declaratory judgments of patent invalidity and noninfringement, covenanting not to “assert any  
15 claim of patent infringement against [plaintiff]” was sufficient to “divest a trial court of  
16 jurisdiction over a declaratory action.” *Amana Refrigeration, Inc. v. Quadlux, Inc.*, 172 F.3d  
17 852, 855, 50 U.S.P.Q.2D (BNA) 1304 (Fed. Cir. 1999) (citing *Super Sack Mfg. Corp. v. Chase*  
18 *Packaging Corp.*, 57 F.3d 1054, 1060, 35 U.S.P.Q.2D (BNA) 1139, 1144 (Fed. Cir. 1995)).

19 Recently, in *MedImmune*, the Supreme Court re-examined the test for determining  
20 declaratory judgment jurisdiction. Although neither *Super Sack* nor *Amana* has been expressly  
21 overruled, both applied the “reasonable apprehension of imminent suit” test, which was  
22 expressly disavowed in *MedImmune*. *MedImmune*, 127 S. Ct. at 774, n.11. The Federal Circuit,  
23 however, has recently analyzed the jurisdictional issue, in a patent case with similar facts to the  
24 case at bar, in the declaratory judgment context under the new framework of *MedImmune*.  
25 Looking to *Super Sack* and *Amana* for guidance and noting that the holdings in both cases are  
26 not necessarily dependant on the “reasonable apprehension of imminent harm” requirements, the

1 Federal Circuit held that the defendant, Nucleonics, had not made a showing of “sufficient  
2 immediacy and reality” to support declaratory judgment jurisdiction for its counterclaims.  
3 *Benitec Austl., Ltd. v. Nucleonics, Inc.*, 495 F.3d 1340 (Fed. Cir. 2007). In *Benitec*, the plaintiff  
4 Benitec acknowledged lack of infringement and moved to dismiss its infringement claims, noting  
5 that Nucleonics activities are not infringing and could not become infringing until “at least 2010-  
6 2012 if ever” (when Nucleonics planned on filing a new drug application.) *Id.* at 1346. Stating  
7 that federal courts are not to give opinions on moot questions or abstract propositions, the  
8 Federal Circuit held that there was no “substantial controversy between [Benitec and  
9 Nucleonics], of sufficient immediacy and reality to warrant the issuance of a declaratory  
10 judgment.” *Id.* at 1349.

11 In this case, Defendants have gone farther than merely covenanting not to assert a claim  
12 against Jacobsen under the ‘329 patent. Defendants have filed a Disclaimer of all claims of the  
13 ‘329 patent. Exhibit A to Decl. of Matthew Katzer. 35 U.S.C. § 253 allows a patentee to  
14 “disclaim” some or all claims in a patent and this disclaimer “shall thereafter be considered as  
15 part of the original patent to the extent of the interest possessed by the disclaimant and by those  
16 claiming under him.” This Disclaimer removes any controversy at all between the parties  
17 regarding the ‘329 patent (immediate or otherwise).

18 Additionally, this Disclaimer renders moot Plaintiff’s patent suit and deprives the Court  
19 of subject matter jurisdiction to pass on the validity of the ‘329 patent. *See Alta. Telecomms.*  
20 *Research Ctr. v. Rambus, Inc.*, 2006 U.S. Dist. LEXIS 81093 at \*6 (N.D. Cal 2006) (holding that  
21 a Disclaimer filed under 35 U.S.C. § 253 and 37 C.F.R. 1.321 “rendered moot the interfering  
22 patent suit and deprived the court of subject-matter jurisdiction”) (citing *Albert v. Kevex Corp.*,  
23 729 F.2d 757, 760-761 (Fed. Cir. 1984)). A federal court has no authority to give opinions upon  
24 moot questions. *County of Los Angeles v. Davis*, 440 U.S. 625, 627-630 (1979).

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1 **3. Conclusion**

2 Based on the above and since no actual or justiciable controversy exists with respect to  
3 the '329 patent, Defendants respectfully request that Claims 1, 2 and 3 of the Second Amended  
4 Complaint and the associated relief requested in Plaintiff's Prayer for Relief A, B, C, D, E, F, G  
5 and T (requesting costs and attorney fees pursuant to 35 U.S.C. § 285) be dismissed with  
6 prejudice.

7 Dated February 12, 2008.

8 Respectfully submitted,

9 /s/Scott Jerger

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17 **CERTIFICATE OF SERVICE**

18 I certify that on February 12, 2008, I served Matthew Katzer's and KAM's MOTION TO  
19 DISMISS COUNTS 1, 2, AND 3 OF PLAINTIFF'S SECOND AMENDED COMPLAINT AS  
20 MOOT on the following parties through their attorneys via the Court's ECF filing system:

21 Victoria K. Hall  
22 Attorney for Robert Jacobsen  
23 Law Office of Victoria K. Hall  
24 3 Bethesda Metro Suite 700  
25 Bethesda, MD 20814

26 /s/ Scott Jerger

R. Scott Jerger (*pro hac vice*)  
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