

1 BRUCE LOCKE, Bar #177807
MOSS & LOCKE
2 555 University Avenue #170
Sacramento, CA 95825
3 Telephone: (916) 569-0663
blocke@mosslocke.com

4 JOHN BALAZS, Bar #157287
5 Attorney At Law
916 2nd Street, 2nd Floor
6 Sacramento, California 95814
Telephone: (916) 447-9299
7 john@balazslaw.com

8 Attorneys for Defendant
AMR MOHSEN
9

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11 IN THE UNITED STATES DISTRICT COURT
12 FOR THE NORTHERN DISTRICT OF CALIFORNIA
13 SAN FRANCISCO DIVISION

14 UNITED STATES OF AMERICA,) No. CR 03-95-WBS
15)
16 Plaintiff,) DEFENDANT AMR MOHSEN'S PRO SE
17 v.) AMENDMENT TO MOTION FOR NEW TRIAL
18) ON GROUND OF INEFFECTIVE
19 AMR MOHSEN and ALY MOHSEN,) ASSISTANCE OF COUNSEL
20)
21 Defendants.) Hon. William B. Shubb
22)
23 _____)

24 For the record, attached is defendant Amr Mohsen's pro se
25 Amendment to his motion for new trial on ground of ineffective
26 assistance of counsel, which was presented to the Court and opposing
27 counsel during today's hearing.

28 DATED: September 15, 2006

Respectfully submitted,

/s/ JOHN BALAZS

JOHN BALAZS
Attorney for Defendant
AMR MOHSEN

AMR MOHSEN
Defendant
UKU 326
North County Jail
550 6th Street
Oakland, CA 94607

PRO SE

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

UNITED STATES OF AMERICA,

Plaintiff,

v.

AMRMOHSEN AND ALY MOHSEN,

Defendants,

No. CR 03-95-WBS

DEFENDANT AMR MOHSEN'S PRO SE
AMENDMENT TO MOTION FOR NEW
TRIAL ON GROUND OF INEFFECTIVE
ASSISTANCE OF COUNSEL

Date: September 15, 2006

Time: 10:30 am

Hon. William B. Shubb

INTRODUCTION

This is an addendum to the prior motion-brief and reply-brief for new trial dated 4/14/06 and 6/7/06 respectively to add the relevant points of law for ineffective assistance of counsel.

A. THE LAW

Ineffective assistance of counsel claims one analyzed under Strickland test (Strickland v. Washington 466 US 668, 1984) which has two components: “First, the defendant must show that counsel’s performance was deficient. Second, the defendant must show that the deficient performance prejudiced the defense” (Id, 678).

The sixth Amendment right to the effective assistance of counsel applies equally to retained and appointed counsel (Cuyler v. Sullivan 446 US 335, 1980).

In Strickland, the court grounded the competency determination on “counsel’s duty to bring to bear such skill and knowledge as will render the trial a reliable adversarial testing process” (466 US at 2065). Counsel’s competence is presumed, however, and the defendant must rebut the presumption by proving that his attorney’s representation was unreasonable under prevailing professional norms and that the challenged action was not sound strategy (Id at 688-689). In making the competence determination, the court “should keep in mind that counsel’s function, as elaborated in the prevailing professional norms, is to make the adversarial testing process work in the particular case” (Id at 690). Because that testing process will not function properly unless defense counsel has done some investigation into the prosecution’s case and into various defense strategies, “counsel has a duty to make reasonable investigations or to make a reasonable decision that makes particular investigation unnecessary” (Id at 691).

Although it is generally advisable for a reviewing court to assess counsel’s overall performance to determine whether the defendant has overcome the presumption of reasonable representation, even a generally creditable performance will not overcome an apparent or pervasive failure to “make reasonable investigation or to make a reasonable decision that makes particular investigation unnecessary” (Kinnmelman v. Morrison, 477 US365, 384, 386, 1986).

Failing to introduce evidence because of a misapprehension of the law is a classic example of deficiency of counsel. (Smith v. Dretke, 417 F3d 438, 442, 5th Circuit 2005) citing (Williams v. Taylor 529 US 362, 395, 2000, "finding deficiency of counsel where the petitioner's lawyers failed to conduct an investigation, "not because of any strategic calculation, but because they incorrectly thought state law barred access to those records"). (See also Blackburn v. Foltz 828 F 2d 1177, 1182, 6th Circuit 1987, counsel's performance was deficient and "outside the wide range of professionally competent assistance," where counsel's failure to move for suppression and his legal advice to the petitioner was based not "on strategy, but on mistaken beliefs and" a startling ignorance of the law [citation omitted]).

Under the prejudice component of the Strickland test "the defendant must show that there is a reasonable probability that, but for counsel's unprofessional errors, the result of the proceeding would have been different. A reasonable probability is a probability sufficient to undermine confidence in the outcome" 466 at 694.

B. ANALYSIS

In this case, defense counsel misapprehended the law of materiality of mail fraud in the 5th Circuit (and inexcusably neglected to review the model jury instruction) and the relevant patent law. Therefore, they failed to conduct adequate investigations and introduce important impeachment and exculpatory evidence and legal arguments.

(1) Counsel misapprehended the law of materiality of mail fraud in two respects.

They assumed it was the same as perjury materiality and litigation expenses were not included in the "parting with money." In all the motion-briefs of 16/5/05, 11/16/05, 1/17/06 and proposed jury instruction of 2/11/06, only one materiality test was argued for the perjury and mail fraud charges. The criterion of mail fraud materiality is different than the criteria of perjury materiality.

Therefore additional evidence and legal arguments were needed to provide reasonable defense (see footnote 4 in the brief of 6/7/06). If counsel had not misapprehended the law, they would have conducted investigations of the events in the patent case as Quickturn conducts as requested by prior retained counsel on the strong recommendation of the lead patent attorney of Aptix (see footnote 5 in

the brief of 6/7/06). Prior retained counsel had initiated subpoena of Quickturn documents related to the patent case as Aptix lead patent attorney indicated that such investigation would provide relevant impeachment evidence to Quickturn allegations (see footnote 7 in the brief of 6/7/06). "Failing to introduce evidence because of a misapprehension of the law is a classic example of deficiency of counsel," *Smith v. Dretke* 417 F3d 438, 442, 5th Circuit 2005. Also, the Supreme Court found deficiency of counsel where the petitioner's lawyer failed to conduct an investigation because they incorrectly thought state law barred access to those records" *Williams v. Taylor* 529 US 362, 395, (2000). Also, the 6th Circuit Appeal Court stated "counsel's performance was deficient and outside the wide range of professionally competent assistance," where counsel's failure to move for suppression and his legal advice to the petitioner was based "not on strategy but on mistaken beliefs and a startling ignorance of the law." *Blackburn v. Foltz* 828 F2d 1177, 1182, (6th Circuit 1987).

Defense counsels were seasoned and skilled litigators. It is therefore all the more inexplicable and shocking that they failed to fulfill the most basic obligation of defense counsel, to investigate the law of the jurisdictions as it applies to their client's case. Defense counsel's trial strategy, accordingly was the product not of reasoned decision, but of inexcusable ignorance of the law. The performance in this regard was most deficient and thus "outside the wide range of professionally competent assistance." *Blackburn v. Foltz* 828F2d at 1182 citing *Strickland* 466US at 600.

The prejudice component of the *Strickland* test is also easily met here. Counsel's failure to realize the differences of the mail fraud materiality test from the perjury materiality during the pretrial motions and the trial preparation, and to grasp the necessity of conducting the investigations of the events and Quickturn conduct in the patent case were therefore manifestly prejudicial. It is highly probable that, had counsel researched the Ninth Circuit law and utilized the information provided by these investigations, Defendant would have acquitted of most or all the charges in courts 1-4 and 10-19 in the indictment. Examples of such information are: evidence to impeach the witnesses of the prosecution (see

footnote 1, 3, 10, and 11 in the brief of 6/7/06), to demonstrate and argue to the jury that Quickturn's actions related to the notebook were unreasonable, to expose the inaccuracies and falsities related the Lebo note (see footnote 1 in the brief of 6/7/06), to raise reasonable doubt on the elements of the charges (see footnote 2, 10, and 11 in the brief of 6/7/06), to make timely objections on the uncharged theory of materiality and fraud scheme based on the notice of infringement allegations (see footnote 1 in the brief of 6/7/06), to request timely unanimity instruction.

Under these circumstances, it is clear that there is a reasonable probability that, but for counsel's error and ineffective assistance, the result of the trial would have been different.

- (2) Counsel misapprehended the applicable patent law and its relevance to the criminal trial. A summary of relevant patent law is provided in Exhibit 1. Counsel argued in the trial the first two items. However he failed to investigate the relevance and applicability of the last three items. Potential legal arguments that could be developed with relevant patent law are summarized in the example of Exhibit 2. The patent validity presumption statute 35 USC282 with the circumstances and evidence of record in the case and the guidelines of the advisory committee adopted by the Senate for the Amendment of 1973 Enactment of Rule 301 of the Federal Rules of Evidence could lead to the argument that the notebook was not material as a matter of law (see footnote 2, 6, 8, and 9 in the brief of 6/7/06) and to additional jury instructions. Similar result can also be reached by applying the but-for materiality test in the fifth item.

Defense counsel failure to investigate the law as it applies to their client case and the trial strategy accordingly were the product not of reasoned decision, but of inexcusable ignorance of the law. The performance in this regard was most deficient and "thus outside the wide range of professionally competent assistance" *Blackburn v. Foltz* 828 F2d at 1182, citing *Strickland* 446 US at 600.

The prejudice component of the *Strickland* test is also evidently met here. It is highly probable that had counsel researched the applicable patent law and utilized

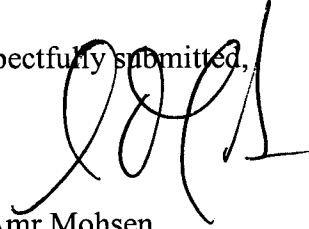
that information for legal arguments and additional jury instructions (such as for validity presumption), the results of the trial would have been different.

C. CONCLUSION

For all the reasons, the Court should grand Dr. Mohsen a new trial on all counts.

DATED: September 14, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Amr Mohsen', written over the text 'Respectfully submitted,'.

/s/ Amr Mohsen

AMR MOHSEN

DEFENDANT, PRO SE

EXHIBIT 1RELEVANT PATENT LAW
IN
PATENT INFRINGEMENT LITIGATION

- 1) In patent infringement litigation, the issues to be decided by the trier of fact (jury or judge) are the patent validity and product infringement.
- 2) Presumed date of Invention of Patent
 - a. According to patent statute 35 US 102(g), the general rule is that the first to invent has priority in obtaining a patent. Thus the second person to conceive of the invention is not entitled to a patent and a patent granted to that second person is subject to being declared invalid. The initial filing of a patent application is treated as the presumed date of invention. The filing date of Aptix patent 5, 544, 069 was September 20, 1989. Therefore, 10/20/89 is the presumed date of the invention that is defined in the patent
- 3) Validity Presumption of Patent and Invalidation Burden of Proof
 - a. According to patent statute 35 US 282, a patent issued by the Patent and Trademark Office (PTO) is presumed valid. Nevertheless, an opposing party can challenge the patent validity if it can prove by clear and convincing evidence to the court that someone else conceived of the invention before the holder of the patent conceived of his invention (35 US 102). The issued patent can become invalid if it can be proven that all the elements of the subject invention were described, anticipated, or made obvious by another patent application or publication prior to the date of the patent invention (prior art). According to well established patent case law, the burden of establishing invalidity shall rest with the attacking party by clear and convincing evidence and the burden never shifts (*Innovative Scuba v. Fed. Ind.* 26F sd, 1112, 1115 Fed Cir1994, *American Hoist v. Sowa* 725 F2d 1350, 1360, Fed Cir. 1986). The patentee is not required to rebut any allegations of invalidity until the attacking party can meet its burden of proof to the court. Then, the patentee has the option, in the case the invalidity is proven by prior art to introduce into evidence any

documentation or extrinsic evidence that can prove an earlier date of invention before the presumed date of the patent application filing.

4) Intrinsic (admissible) and Extrinsic (inadmissible) Evidence in Patent Litigation

Since patents are like statutes, enforceable against the public, the intrinsic admissible evidence in patent litigations are only the public records: patent claims, specifications, prior art, and prosecutions file history at the PTO.

Everything else is extrinsic and inadmissible including: inventor's testimonies, records, and notebooks; expert testimonies and reports; dictionaries and opinions of attorneys. (*Markman v. Westview* 52F3d 967, 979-983, Federal Circuit 1996). However, the district court has the discretion to consider the admissibility of extrinsic evidence, such as an inventor's notebook, only if the patentee relies on it explicitly in a rebuttal to an invalidation challenge after meeting the necessary burden of proof.

5) Materiality Test in Patent Litigation

- a. It is important to understand the unique context of patent litigation for the materiality test. Patent claims impose liabilities on the public, similar to statutes. All the evidence for the patent validity and claims interpretation have to rely on public record, ie the intrinsic evidence: the patent claims, specifications prior art and prosecution file history at the Patent and Trademark Office (PTO). The PTO is the government agency responsible for issuing valid patents complying with 35 USC 112 for full disclosure of written description of the invention to enable any person skilled in the art to practice.
- b. The materiality of any misconduct, which could affect the validity of the patent (such as nondisclosure of prior use or prior art, fraudulent document, misrepresentations and concealment of facts), at the PTO or the court is a necessary element to justify sanctions (such as unenforceability, dismissal, default, anti-trust damages, attorney-fees, or criminal punishment).

- c. The materiality test for criminal statutes and common law fraud in courts of law is the predictable capacity to influence or the predictable natural tendency to influence the decision of the decision making body at the time the misconduct was made (*Kungys v. US* 485 US 759, 1988; *US v. Neder* 527 US 1, 1999). The materiality test for unclean hands doctrine in courts of equity is some unconscionable act of one coming for relief immediate and necessary relation to the equity that he seeks in respect to the matter in litigation (*Keystone v. Gen Excavator* 290 US 240, 1933).
- d. In applying these materiality tests, the following considerations should be taken into account for misconducts which could affect the patent validity in court patent litigations:
 - i. The decision of patent validity is an objective decision relying on the case specific actual facts which are well defined since the patent was issued and do not change with time: the interpretation of the claims (as issued by the PTO and revisited by the court's claim construction rulings according to the words of the claims, specification and prosecution file history), the prior art and compliance with patent statutes;
 - ii. Such misconducts do not trigger a potential investigation in contrast to other contexts such as Grand Jury hearings, denaturalization, anti-trust. All the relevant facts of claim interpretation and prior art are well defined;
 - iii. Such misconducts have the predictable capacity by themselves sufficient to either make the patent valid or to have no effect on its validity;
 - iv. Such misconducts do not have partial influence or natural tendency to influence by proving or disproving a fact in a chain of evidence, in contrast to other contexts where there could be infinite variety of factual patterns that may emerge.

These considerations have led to the causality test for materiality in patent litigations: the misconduct is material if the patent would have been invalid but for that

misconduct, if the patent would have been invalid without that misconduct. The Supreme Court, the Federal Circuit Court and other courts have consistently used the but-for test in patent litigation

- (i) Nobel Pharma v. Implant innovation 141F3d1059, 1070, Federal Circuit 1998
- (ii) HP v. Bausch & Lomb 882 F2d 1556, 1562, Fed Circuit 1989
- (iii) Norton v. Curtiss 433F2d779, 793, 799, CCPA 1971
- (iv) Corning Glass v. Anchor Hocking Glass Co. 253 Suppl 461, 470 D. Delaware 1966
- (v) Baldwin-Lima v. Tatnall Measuring Systems 169 F. Suppl. 1, 25, E D Penn 195
- (vi) Corona Cord Tire Co. v. Dovan Chemical 276US 358, 373-74, 1928

EXHIBIT 2

PATENT VALIDITY PRESUMPTION AND NOTEBOOK IMMATERIALITY

- 1) According to patent statute 35USC288 “a patent shall be presumed valid based on its filing date. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.” Federal Circuit patent case law also stated the invalidity burden of proof should be by clear and convincing evidence, and “the role of the trial court is to determine whether the challenger has carried its burden.” (Innovative Scuba v. Federal Ind. 26F3d1112, 1116, Federal Circuit 1994)
- 2) The advisory committee adopted the Senate Amendment for the 1974 Enactment of Rule 301 of the Federal Rules of Evidence (House Conference Report No. 93_1597): “a presumption is sufficient to get a party past an adverse party’s motion to dismiss at the end of his case-in-chief. If the adverse party offers no evidence contradicting the presumed fact, the court will instruct the Jury that if it finds the basic facts, it may presume the existence of the presumed fact. If the adverse party does offer evidence contradicting the presumed fact, the court cannot instruct the Jury that it may presume the existence of the presumed fact from proof of the basic facts. The court may, however, instruct the jury that it may infer the existence of the presumed fact from proof of the basic facts.”
- 3) The following facts were undisputed in the criminal trial.
 - i. In the patent case, Quickturn asserted prior art defenses by serving pleadings pursuant to Local Rules 16.9(b) (RT168.5-25, 173:21-23, 181.16, 189.6; trial exhibits F and P);
 - ii. No admissible evidence was presented to prove that Quickturn’s prior art invalidated the 069 patent claims to meet the burden of proof by clear and convincing evidence.
 - iii. Expert testimony of Dr. Tredennick, that none of Quickturn’s prior art could invalidate the 069 patent claims, was uncontroverted (RT1020);

- iv. The reference of Dr. Tredennick that “Quickturn had an expert who came to just the opposite conclusion” (RT1029:4-7) was inadmissible hearsay, as this expert of Quickturn did not testify and was not cross-examined for the Jury to assess his credibility especially that Dr. Tredennick also testified that “I don’t agree with the other expert. IN fact, I don’t believe that the other expert actually wrote the reports that he signed.” (RT1031: 6-11);
 - v. According to the materiality Jury instruction #15, what Aptix and Quickturn expert opinions, what lawyers said or what Dr. Mohsen thought was not objective evidence to satisfy the objective test requirement.
- 4) According to Rule 301 of the Federal Rules of Evidence, the court should have instructed the Jury:
- i. Since it is undisputed that the 069 patent was issued and presumed valid based on its filing date September 20, 1989,
 - ii. the prosecutors offered no admissible evidence to contradict it.
 - iii. then the Jury should presume that the 069 patent was valid based on its filing date at the time of the alleged misrepresentations.
 - iv. And the 1988 engineering notebook would not have been introduced to the fact-finder and was not material as a matter of law.

This should justify acquittal on the basis of insufficiency of the evidence.

- 5) The error of not giving the Jury such instruction violated due process, was not harmless and resulted in “actual prejudice” (US v. Lane 474US438, 449, 1986) and had “a substantial and injurious effect or influence in determining the jury’s verdict” (Brecht v. Asrahawson 507US619, 637, 1993). This should justify a new trial.