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Attorneys for Defendants
Matthew Katzer and Kamind Associates, Inc.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ROBERT JACOBSEN, an individual,

Plaintiff,

vs.

MATTHEW KATZER, an individual, and
KAMIND ASSOCIATES, INC., an Oregon
corporation dba KAM Industries,

Defendants.

Case Number C06-1905-JSW

Hon. Jeffrey S. White

**DEFENDANTS' MATTHEW
KATZER AND KAMIND
ASSOCIATES, INC.'S FIRST
SUPPLEMENTAL
COUNTERCLAIM FOR
COPYRIGHT INFRINGEMENT
(damages in excess of \$6,000,000)**

[PROPOSED]

- 1 9. In the model train world, QSI hardware, such as the QSI Quantum Equipped
2 Locomotive, is widely used.
- 3 10. The QSI Manual was developed by QS Industries, Inc.
- 4 11. KAM's software products incorporated portions of the QSI Manual in 2003 to facilitate
5 the ability of users to control and program model trains containing QSI decoders.
- 6 12. Version 3.0 of the QSI Manual was released on February 16, 2005. Version 4.02 of the
7 QSI Manual was released on August 16, 2006. Version 4.1 of the QSI Manual was
8 released on October 9, 2007. Version 4.3 of the QSI Manual was released on June 17,
9 2008. Version 4.4 of the QSI Manual was released on September 23, 2008.
- 10 13. In June 2005, Plaintiff's JMRI software package known as Decoder Pro included
11 verbatim, portions of version 3.0 of the QSI Manual. In October 2006, Plaintiff's JMRI
12 software package known as Decoder Pro included verbatim, portions of version 4.02 of
13 the QSI Manual. After October 26, 2007, Plaintiff's JMRI software package known as
14 Decoder Pro included verbatim, portions of version 4.1 of the QSI Manual. In August
15 2008, Plaintiff's JMRI software package known as Decoder Pro included verbatim,
16 portions of version 4.3 of the QSI Manual. In March 2009, Plaintiff's JMRI software
17 package known as Decoder Pro included verbatim, portions of version 4.4 of the QSI
18 Manual.
- 19 14. In 2006, KAM purchased from QS Industries, Inc. all right, title and interest in and to
20 Version 3.0 of the QSI Manual. In 2008, KAM purchased from QS Industries, Inc. all
21 right, title and interest to all versions of the QSI Manual.
- 22 15. Plaintiff's use of portions of the QSI Manual was without the permission of QS
23 Industries, Inc or KAM.

24 CAUSE OF ACTION

- 25 16. This claim arises under 17 U.S.C. § 501(a). Defendant KAM realleges all allegations
26 in paragraphs 1 through 15 above as though fully set forth herein.

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17. KAM is the owner by signed written assignment of all copyright rights in and to the NMRA DCC Reference Manual for QSI Quantum HO Equipped Locomotives- Versions 3.0, 4.02, 4.1, and 4.3. KAM registered its copyright rights with the United States Copyright Office for Version 3.0 and obtained Copyright Registration Number TX 6-445-094, effective November 13, 2006. KAM registered its copyright rights with the United States Copyright Office for Version 4.02 and obtained Copyright Registration Number TX 6-888-840 on November 7, 2008. KAM registered its copyright rights with the United States Copyright Office for Version 4.1 on August 5, 2009 and this registration is still pending. KAM registered its copyright rights with the United States Copyright Office for Version 4.3 on April 28, 2009 and this registration is still pending. KAM registered its copyright rights with the United States Copyright Office for Version 4.4 on August 4, 2009. These versions of the QSI Manual are hereinafter referred to as the “Copyrighted Materials.”
 18. Pursuant to 17 U.S.C. § 410(c) these certificates of copyright registration identified above constitutes *prima facie* evidence of the validity of the copyrights and of the facts stated in the certificate. KAM’s registered copyright in the Copyrighted Materials as embodied in the Copyright Registrations is entitled to this statutory presumption.
 19. KAM and its predecessors in interest created the Copyright Materials as original works of authorship, and, as such, the Copyrighted Materials constitute copyrightable subject matter under the copyright laws of the United States. The Copyrighted Materials were automatically subject to copyright protection under 17 U.S.C. § 102(a) when such materials were fixed in a tangible medium of expression. Copyright protection under 17 U.S.C. §§ 102 and 103 extends to derivative works. Derivative works are defined in 17 U.S.C. § 101 to included works based on the original work or any other form in which the original work may be recast, transformed modified, or adapted.
 20. The Copyrighted Materials include protected expressions of code, structure, sequence and/or organization.

- 1 21. On information and belief, parts or all of the Copyrighted Material have been, and are
2 continuing to be, copied or otherwise improperly used by Plaintiff as the basis for the
3 JMRI software without the permission of KAM.
- 4 22. Plaintiff has infringed and will continue to infringe KAM's copyright in and relating to
5 the Copyrighted Materials by using, copying, modifying, and/or distributing parts of the
6 Copyrighted Materials, or derivative works based on the Copyrighted Materials in
7 connection with its distribution of the JMRI software, inconsistent with KAM's
8 exclusive rights under the Copyright Act.
- 9 23. Plaintiff does not own the copyright to the Copyrighted Materials nor does it have
10 permission or proper license from KAM to use any part of the Copyrighted Materials.
- 11 24. Upon information and belief, Plaintiff's conduct was and is willfully done with
12 knowledge of KAM's, and its predecessor in interests, copyrights.
- 13 25. Defendant KAM has no adequate remedy at law. Plaintiff's conduct has caused, and if
14 not enjoined, will continue to cause, irreparable harm to KAM.
- 15 26. As a result of Plaintiff's wrongful conduct, KAM is entitled to the following relief:
16
 - 17 1. Injunctive relief pursuant to 17 U.S.C. § 502 against Plaintiff's further use or
18 copying of any part of the Copyrighted Materials; and
 - 19 2. KAM's actual damages in an amount to be proven at trial and in excess of
20 \$6,000,000 and any additional profits of the infringer as a result of Plaintiff's
21 infringement; and
 - 22 3. KAM's costs pursuant to 17 U.S.C. § 505.

23 **PRAYER**

24 **On Defendant KAM's Counterclaim:**

- 25 1. Injunctive relief pursuant to 17 U.S.C. § 502 against Plaintiff's further use or
26 copying of any part of the Copyrighted Materials;

- 1 2. KAM's actual damages in an amount to be proven at trial and in excess of
- 2 \$6,000,000 and any additional profits of the infringer as a result of Plaintiff's
- 3 infringement and;
- 4 3. KAM's costs pursuant to 17 U.S.C. § 505;
- 5 4. Pre and Post-judgment interest; and
- 6 5. Any other legal and equitable relief deemed just and proper by this Court.

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8 Dated August ____, 2009.

9 Respectfully submitted,

10 PROPOSED

11 R. Scott Jerger (*pro hac vice*)
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20 **CERTIFICATE OF SERVICE**

21 I certify that on August ____, 2009, I served Matthew Katzer's and KAM's First
22 Supplemental Counterclaim on the Plaintiff through his attorney via the Court's ECF filing
23 system:

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

David McGowan
Warren Hall
5998 Alcala Park
San Diego, CA 92110

Dated: August ____, 2009.

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