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17 UNITED STATES DISTRICT COURT
18 NORTHERN DISTRICT OF CALIFORNIA
19 SAN FRANCISCO DIVISION

20 ROBERT JACOBSEN, an individual,
21 Plaintiff,
22 vs.
23 MATTHEW KATZER, an individual, and
24 KAMIND ASSOCIATES, INC., an Oregon
25 corporation dba KAM Industries,
26 Defendants.

Case Number C06-1905-JSW

Hearing Date: December 15, 2006
Hearing Time: 9:00am
Place: Ct. 2, Floor 17

Hon. Jeffrey S. White

DEFENDANTS MATTHEW
KATZER AND KAMIND
ASSOCIATES, INC.'S MOTIONS TO
DISMISS FOR FAILURE TO STATE
A CLAIM ON WHICH RELIEF CAN
BE GRANTED [Fed. R. Civ. P.
12(b)(6)], AND MOTION TO
DISMISS FOR FAILURE TO JOIN A
PARTY UNDER RULE 19 [Fed. R.
Civ. P. 12(b)(7)] AND MOTION TO
STRIKE [Fed. R. Civ. P. 12(f)] AND
MOTION FOR MORE DEFINITE
STATEMENT [Fed. R. Civ. P. 12(e)];
MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT
THEREOF

1 **NOTICE**

2 To the court and all interested parties, please take notice that a hearing on Defendants
3 Matthew Katzer and Kamind Associates, Inc.'s Motions to Dismiss, Motion to Strike, and
4 Motion for a More Definite Statement will be held on December 15, 2006 at 9:00 a.m. in
5 Courtroom 2, Floor 17, of the above-entitled court located at 450 Golden Gate Avenue, San
6 Francisco, California.

7 **MOTION**

8 Defendants Matthew Katzer ("Katzer") and Kamind Associates, Inc. ("KAM") move the
9 court for an order dismissing Counts 5, 6, 8, 10 of plaintiff's amended complaint without leave to
10 amend; striking certain portions of the amended complaint, and requiring the plaintiff to clarify
11 Count 9. Additionally, defendants seek an order awarding the defendants their costs and
12 reasonable attorney fees against plaintiff Jacobsen for successfully dismissing plaintiff's
13 copyright infringement claim pursuant to 17 U.S.C. § 505.

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SUMMARY OF ARGUMENT

1
2 Plaintiff Robert Jacobsen's ("Jacobsen") first amended complaint resembles a public
3 relations document more than a pleading. Defendants are eager to frame the issues in this
4 dispute and answer Jacobsen's allegations regarding the enforceability of the patent at issue in
5 this lawsuit. However, in an attempt to grasp at any claim that might result in monetary damages
6 against defendants, Jacobsen has, again, clouded the patent enforceability issue by including
7 claims in the amended complaint that are not well-founded in law nor well-pleaded. The 31-
8 page amended complaint also includes pages upon pages of immaterial, impertinent and
9 scandalous information and allegations against defendants. Lastly, despite the length of the
10 amended complaint, it fails to include the most fundamental information required for defendants
11 to form a reasoned response to the pleading. For example, the complaint fails to identify the
12 trademark that is allegedly being infringed in Count 9. For these reasons, defendants are forced
13 to file these motions to dismiss, motion to strike and motion to make the pleading more definite
14 and certain.

15 Specifically, defendants seek to dismiss the state law claims (unfair competition and
16 unjust enrichment) as they are preempted by federal copyright law. 17 U.S.C. § 301.
17 Defendants seek to dismiss the Copyright Act claim on the basis that the right to bring a
18 copyright infringement claim has been waived since Jacobsen granted the general public a
19 nonexclusive license to reproduce, copy and distribute the open source software. *Sun*
20 *Microsystems, Inc. v. Microsoft Corp.*, 188 F.3d 1115, 1121 (9th Cir. 1999). Defendants seek to
21 dismiss the cybersquatting claim as Jacobsen has failed to join a necessary and indispensable
22 party, Mr. Jerry Britton. Fed. R. Civ. P. 19. Defendants seek to strike numerous portions of the
23 amended complaint that contain irrelevant and prejudicial material. Fed. R. Civ. P. 12(f).
24 Finally, defendants seek clarification on the trademark infringement claim, as the amended
25 complaint fails to identify the JMRI trademarks that are allegedly being infringed. Fed. R. Civ.
26 P. 12(e). Defendants request that Jacobsen not be granted leave to amend his complaint again.

1 **STATEMENT OF ISSUES TO BE DECIDED**

- 2 1. Whether Counts 5 and 10 of the amended complaint state a claim on which relief can be
3 granted? Fed. R. Civ. P. 12(b)(6).
- 4 2. Whether Count 8 of the amended complaint states a claim on which relief can be
5 granted? Fed. R. Civ. P. 12 (b)(6).
- 6 3. Whether Count 6 of the amended complaint should be dismissed for failure to join a party
7 under Fed. R. Civ. P. 19? Fed. R. Civ. P. 12(b)(7).
- 8 4. Whether certain paragraphs and footnotes in the amended complaint should be stricken?
9 Fed. R. Civ. P. 12(f).
- 10 5. Whether the plaintiff should make Count 9 more definite and certain by identifying the
11 trademarks that are allegedly being infringed? Fed. R. Civ. P. 12(e).

12 **STATEMENT OF RELEVANT FACTS**

13 The amended complaint contains 10 counts against KAM and/or Katzer. This motion
14 and memorandum addresses Count 4 (Sherman Act § 2 Antitrust claim), Count 5 (California
15 Unfair Competition Claim pursuant to California Business and Professions Code § 17200 *et*
16 *seq.*), Count 6 (cybersquatting), Count 7 (libel), Count 8 (copyright infringement), Count 9
17 (trademark infringement) and Count 10 (unjust enrichment).

18 Count 4 of the complaint was the Sherman Act claim that has already been dismissed
19 without leave to amend. Plaintiff's amended complaint inexplicably recites that he "reserves the
20 right to seek reinstatement of his antitrust claim upon review of the Court's pending written
21 ruling."

22 Count 5 of the complaint is for unfair competition. This claim alleges that Katzer "took
23 away" from plaintiff "a property right- the exclusive right to reproduce, distribute, and make
24 derivative copies" of the JMRI decoder definition files. Amended Complaint, ¶ 83. As is also
25 explained in the amended complaint, the general public is free to reproduce, distribute and make
26

1 derivative copies of the decoder definition files under the open source license. Amended
2 Complaint, ¶ 2, 41.

3 Count 6 of the complaint refers to Katzer’s alleged cybersquatting on the decoderpro.com
4 domain site. Plaintiff requests a transfer of the domain name to Jacobsen. Prayer at J. Plaintiff
5 states that Mr. Jerry Britton is the owner of the decoderpro.com domain name. Amended
6 Complaint, ¶ 90.

7 Count 7 of the amended complaint was the libel claim. Plaintiff has “reserve[d] the right
8 to seek reinstatement of his libel claim upon review of the Court’s pending written ruling.”

9 Count 8 of the amended complaint alleges that defendants “without permission or
10 consent, has [sic] made copies, distributed copies to the public or created derivative works in
11 violation of the exclusive rights” in violation of the Copyright Act. Amended Complaint, ¶ 100.

12 As also explained in the amended complaint, the general public is free to reproduce, distribute
13 and make derivative copies of the decoder definition files under the open source license.

14 Amended Complaint, ¶ 2, 41.

15 Count 9 of the amended complaint alleges that “various trademarks of the JMRI project”
16 have been infringed by defendants.

17 Count 10 of the amended complaint alleges that defendants have received an unjust
18 enrichment by allegedly recognizing “expenses and costs for his [misappropriation of the JMRI
19 decoder definition files] on his tax returns.” Amended Complaint, ¶ 120. Jacobsen and the
20 JMRI project “suffered a loss of credit for the hundreds of hours of work put into the copyrighted
21 work’s creation.” Amended Complaint, ¶ 123. Jacobsen made the decoder definition files free
22 to the public. Amended Complaint, § 118.

23 **ARGUMENT**

24 **A. Counts 5 and 10 of the Amended Complaint are preempted by the Copyright Act**

25 Counts 5 and 10 of the amended complaint are preempted by the Federal Copyright Act.
26 Section 301 of the Copyright Act preempts overlapping state law claims in language that is both

1 “explicit and broad.” *G.S. Rasmussen & Assoc. v. Kalitta Flying Serv.*, 958 F.2d 896, 904 (9th
2 1992). It provides as follows:

3 All legal or equitable rights that are equivalent to any of the exclusive rights within the
4 general scope of copyright as specified by section 106...are governed exclusively by
5 this title.... No person is entitled to any such right or equivalent right in any such work
under the common law or statutes of any State.

6 17 U.S.C. § 301.

7 Congress has explained that “[t]he intention of section 301 is to preempt and abolish any
8 rights under the common law or statutes of a State that are equivalent to copyright and that
9 extend to works, within the scope of the Federal copyright law.” H.R. Rep. No. 94-1476, at 130
10 (1976); *see also Maljack Prods. v. GoodTimes Home Video Corp.*, 81 F.3d 881, 888 (9th Cir.
11 1996).

12 The Ninth Circuit has adopted a two-part test to determine whether a state law claim is
13 preempted by the Act. Preemption occurs when: (1) the work at issue comes within the subject
14 matter of copyright, and (2) the rights granted under state law are “equivalent to any of the
15 exclusive rights within the general scope of copyright” set forth in the Act. *Del Madera Props.*
16 *v. Rhodes & Gardner, Inc.*, 820 F.2d 973, 976 (9th Cir. 1987) *overruled on other grounds by*
17 *Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994); *see also Selby v. New Line Cinema*, 96 F. Supp.
18 2d 1053, 1057 (C.D. CA 2000); *Laws v. Sony Music Entertainment, Inc.*, 448 F.3d 1134, 1137
19 (9th Cir. 2006).

20 1. Subject Matter of the Copyright

21 Both Count 5 (unfair competition) and Count 10 (unjust enrichment) address subject
22 matter that is clearly within the subject matter of the Copyright Act. Both claims concern *only*
23 the alleged misappropriation of the “decoder definition files” by defendants. Count 5 alleges that
24 “Katzner infringed copyrights on JMRI Project decoder definition files in violation of federal
25 copyright laws.” Amended Complaint, ¶ 83(a). Count 10 alleges that “Katzner took JMRI Project
26

1 decoder definition files subject to a copyright, took credit for the work and used it for his own
2 commercial gain.” Amended Complaint, ¶ 118.

3 The amended complaint unequivocally alleges that the decoder definition files are subject
4 to the Copyright Act, as evidenced by the above allegations, the copyright infringement claim
5 (Count 9), and Exhibit B which purports to be a copyright registration for the decoder definition
6 files. Additionally, the decoder definition files, as computer software, are copyrightable subject
7 matter under section 102 of the Copyright Act, which provides protection for “original works of
8 authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102; *see also ProCD v.*
9 *Zeidenberg* 86 F.3d 1447, 1453 (7th Cir. 1996). Therefore, the decoder definition files come
10 within the subject matter of copyright.

11 2. Equivalent Rights

12 Jacobsen’s unfair competition claim and unjust enrichment claims, both of which are
13 predicated upon the misappropriation of the decoder definition files, are equivalent to the rights
14 within the general scope of copyright as specified by section 106 of the Copyright Act. Section
15 106 provides a copyright owner with the exclusive rights of reproduction, preparation of
16 derivative works, distribution, performance, and display of the copyrighted work. 17 U.S.C. §
17 106. To survive preemption, a state cause of action must protect rights which are quantitatively
18 different from the copyright rights. *Del Madera* at 977 citing *Harper and Row Publishers, Inc.*
19 *v. Nation Enterprises*, 501 F. Supp. 848, 852 (S.D.N.Y. 1980), *aff’d*, 723 F.2d 195 (2d Cir.
20 1983), *rev’d on other grounds*, 471 U.S. 539, (1985). The state claim must have an “extra
21 element” which changes the nature of the action. *Id.* citing *Mayer v. Josiah Wedgwood & Sons,*
22 *Ltd.*, 601 F. Supp. 1523, 1535 (S.D.N.Y. 1985).

23 a. *Unfair Competition*

24 Jacobsen’s unfair competition does not add an “extra element” which changes the nature
25 of the action. In fact, the unfair competition claim alleges an “infringement of copyright” and
26 alleges that Jacobsen has lost *exactly* the exclusive rights protected by Section 106 of the

1 Copyright Act -- the exclusive right to reproduce, distribute and make derivative copies.
2 Amended Complaint, ¶ 83. In *Del Madera*, the Ninth Circuit held that the plaintiff's unfair
3 competition claim was preempted on almost exactly the same facts. The plaintiff in *Del Madera*
4 alleged that defendants had misappropriated a map and the time and effort plaintiff spent on
5 creating the map when defendants received this map from a third party. *Del Madera* at 977. The
6 Ninth Circuit held that this argument did not add an "extra element" that changed the nature of
7 the action and therefore the unfair competition claim was preempted. *Id.*

8 Similarly, Jacobsen's allegation that Katzer "took away" from Jacobsen the exclusive
9 right to reproduce, distribute and make derivative copies of the decoder definition files, and
10 "obtained a financial benefit" by using these files instead of his own (Amended Complaint, ¶
11 83), does not add an additional element to the nature of the action and is therefore preempted by
12 Copyright law.

13 b. *Unjust Enrichment*

14 It is even clearer that Jacobsen's unjust enrichment claim is preempted by the Copyright
15 law. The Ninth Circuit has held that unjust enrichment claims are equivalent to claims for
16 copyright infringement and thus preempted because such a claim lacks an extra element, namely
17 the bilateral expectation of compensation. *Grosso v. Miramax Film Corp.*, 383 F.3d 965, 968
18 (9th Cir. 2004) *reprinted as amended at* 2004 U.S. App. LEXIS 28043 at *5 (9th Cir. 2004); *Del*
19 *Madera* at 977. In this case, Jacobsen alleges that KAM and Katzer misappropriated decoder
20 definition files made available for free to the public. Amended Complaint, ¶ 118. There was
21 never any expectation of compensation to Jacobsen and any implied promise Katzer and KAM
22 would have made not to use or copy the materials is equivalent to the protection provided by
23 Section 106 of the Copyright Act. This claim is, therefore, preempted.

24 Based on the above, Counts 5 and 10 of the amended complaint should be dismissed
25 without leave to amend.

26 ///

1 **B. Alternatively, Counts 5 and 10 of the Complaint fail to state a claim under state law**

2 1. Unjust Enrichment

3 Count 10 of the complaint alleges that defendants have been “unjustly enriched” by
4 receiving the benefit of Jacobsen’s copyrighted decoder definition files. Amended Complaint, ¶
5 118-124.

6 Under California law, a plaintiff is only entitled to recover under an unjust enrichment
7 theory “if the circumstances must be such as to warrant the inference that it was the expectation
8 of *both parties* during the time the services were rendered that the compensation should be
9 made.” *Del Madera* at 978 citing *1 B. Witkin, Summary of California Law, Contracts* § 50, at
10 60-61 (8th ed. 1973 & Supp. 1984) (emphasis in original). Clearly, as a provider of free open
11 source software to the public (*see* Amended Complaint, ¶ 2, 41), Jacobsen never had an
12 expectation of compensation from anyone, including KAM and Katzer.

13 Additionally, the fact that Jacobsen has developed open source software that is available
14 to the public for reproduction, distribution and modification pursuant to an open source license
15 agreement (Amended Complaint, ¶ 2, 41) precludes an unjust enrichment claim against any of
16 the licensees for reproducing, distributing, or modifying the software. While all licensees of the
17 open source software certainly benefit from the software, this benefit is not *unjust* as a matter of
18 law since the software is freely distributed to anyone. See *First Nationwide Savings v. Perry*, 11
19 Cal. App. 4th 1657, 1662 (1992).

20 2. Unfair Competition

21 In order to bring an unfair competition claim under California law, Jacobsen must have
22 suffered an injury in fact and have lost money or property. Cal. Business and Professions Code §
23 17204. Jacobsen, as a matter of law, has suffered neither since the decoder definition files,
24 which are the subject of the unfair competition claim, were made available to the public for free
25 as open source software. Amended Complaint, ¶ 41. Defendants never “took away” Jacobsen’s
26 “exclusive right to reproduce, distribute and make derivative copies” of the decoder definition

1 files. Amended Complaint ¶ 83. Jacobsen admits that he gave away these rights as part of the
2 open source software license. Since Jacobsen has failed to state a claim for unfair competition,
3 this claim should be dismissed without leave to amend.

4 **C. Plaintiff has waived his ability to sue under the Copyright Act**

5 Count 8 of the amended complaint alleges that defendants, “without permission or
6 consent, has [sic] made copies, distributed copies to the public, or created derivative works in
7 violation of the exclusive rights.” Amended Complaint, ¶ 100. However, as explained in the
8 amended complaint, the copyrighted decoder definition files are subject to an open source
9 software license that allows licensees to make copies, distribute and create derivative works of
10 the software provided the licensees give the JMRI Project credit. Amended Complaint, ¶ 2, 41.

11 The Ninth Circuit has held that open source licensors such as Jacobsen waive their right
12 to sue for copyright infringement and can only sue for breach of contract. *Sun Microsystems,*
13 *Inc. v. Microsoft Corp.*, 188 F.3d 1115, 1121 (9th Cir. 1999). In *Sun Microsystems*, Sun and
14 Microsoft entered into a computer software licensing arrangement involving Java, a computer
15 programming language developed by Sun. *Id.* at 1117. Sun granted Microsoft broad rights to
16 use the language provided that Microsoft make available only products that are compatible with
17 Sun standards. *Id.* at 1118. Sun filed suit against Microsoft for copyright infringement alleging
18 that Microsoft had exceeded the scope of the license by creating enhanced versions of Java that
19 were fully operational only on Microsoft systems. *Id.* The Ninth Circuit held that, before Sun
20 could avail itself of the benefits of copyright law, it must “definitively establish that the rights it
21 claims were violated are copyright, not contractual rights.” *Id.* at 1122. This determination,
22 according to the Ninth Circuit, hinges on the scope of the license agreement. *Id.* at 1121.
23 “Generally, a copyright owner who grants a nonexclusive license to use his copyrighted material
24 waives his right to sue the licensee for copyright infringement and can only sue for breach of
25 contract.” *Id.* (citing *Graham v. James*, 144 F.3d 229, 236 (2nd Cir. 1998)). In other words, to
26 bring a copyright infringement claim, Jacobsen must establish that the defendants have violated

1 at least one of the exclusive rights granted to copyright holders under 17 U.S.C. § 106, and not a
2 right conferred by the license or contract. *Sun Microsystems* at 1122; *see also A&M Records,*
3 *Inc. v. Napster, Inc.*, 239 F.3d 1004, 1013 (9th Cir. 2001). Section 106 of the Copyright Act
4 grants a copyright holder the exclusive right to reproduce, prepare derivative works of, distribute,
5 display, and perform the copyrighted material. 17 U.S.C. § 106.

6 Jacobsen admits in the amended complaint that the open source software license that
7 governs the decoder definition files allows the general public to reproduce, prepare derivative
8 works of, and distribute the decoder definition files. Amended Complaint, ¶ 2, 41. The
9 restrictions placed on the distribution of the decoder definition files in the open source license
10 require the licensee to, *inter alia*, give “appropriate credit” to JMRI. *Id.* The amended complaint
11 alleges that the defendants “infringed the copyright” by failing to give credit to the JMRI Project
12 when they allegedly distributed the decoder definition files. Amended Complaint, ¶ 41.

13 However, “giving credit to the JMRI project” is not a right protected by section 106 of the
14 Copyright Act. Any such “right” is a right created by the open source license that governs the
15 JMRI decoder definition files. Assuming for the sake of argument that this right has been
16 violated, Jacobsen has, at best, a breach of license agreement claim against the licensee, not a
17 copyright infringement claim. By granting a nonexclusive open source license to the general
18 public to use, reproduce and distribute, Jacobsen has waived his right to sue anyone for copyright
19 infringement.

20 Should this Court grant defendants’ motion to dismiss the copyright infringement claim,
21 defendants hereby move this Court for an award of prevailing party costs and reasonable attorney
22 fees as allowed by 17 U.S.C. § 505. Defendants who successfully defend copyright infringement
23 claims are entitled to recover costs and attorney fees under the statute. *John C. Fogerty v.*
24 *Fantasy, Inc.*, 510 U.S. 517 (1994). Attorney fees may be awarded at this Court’s equitable
25 discretion and the Supreme Court has recognized a list of several nonexclusive factors that courts
26 should consider in making awards of attorney fees to prevailing parties. *Id.* at 535, n.19. These

1 factors include: frivolousness, motivation, objective unreasonableness (both in factual and in the
2 legal components of the case) and the need in particular circumstances to advance considerations
3 of compensation and deterrence. *Id.*

4 In this case, defendants believe that the factors weigh towards granting an award of
5 attorney fees to defendants. Jacobsen's copyright infringement claim is patently unreasonable
6 given the fact that Jacobsen retains no exclusive rights to the decoder definition files under the
7 broad open source license. A cursory review of case law from the Ninth Circuit would have led
8 Jacobsen's counsel to the conclusion that this type of claim is barred in the Ninth Circuit. The
9 copyright infringement claim is patently frivolous and has been brought in bad faith in an effort
10 to dream up a viable claim against defendants for monetary damages. This is evidenced by the
11 fact that the decoder definition files were not even registered with the Copyright Office until
12 months *after* this litigation had commenced. *See* Plaintiff's Exhibit B to Amended Complaint.

13 The copyright claim should be dismissed without leave to amend and defendants should
14 be awarded their reasonable costs and attorney fees in preparing this motion.

15 **D. Count 6 of the Amended Complaint should be dismissed for failure to join Jerry Britton**
16 **as an indispensable party**

17 Count 6 of the amended complaint (cybersquatting) alleges that Katzer transferred the
18 decoderpro.com domain name to Jerry Britton and "held on to rights in the domain name by
19 threatening to force Britton to pay \$20,000 if Britton transferred the domain name to any other
20 person...". Amended Complaint, ¶ 90. Jacobsen requests an order, pursuant to the
21 cybersquatting statute, "requiring Katzer to release any rights he has in said domain name and
22 *return said domain name to Jacobsen.*" Amended Complaint, Prayer at J (emphasis added). To
23 the extent that Count 6 requests declaratory relief requiring a transfer of a domain name that the
24 amended complaint itself avers is no longer owned or controlled by the defendants, Britton is a
25 necessary and indispensable party under Rule 19. It is submitted that because the Court lacks
26 personal jurisdiction over Britton and he cannot be joined, count 6 should be dismissed.

1 The Court must first determine if Jerry Britton is a “necessary party” as to Count 6. If so,
2 the Court must determine whether, if Britton cannot be joined, the claim should be dismissed
3 because Jerry Britton is “indispensable.” *Disabled Rights Action Committee v. Las Vegas*
4 *Events, Inc.*, 375 F.3d 861, 879 (9th Cir. 2004).

5 Britton is a necessary party and must be joined if: (1) in his absence complete relief
6 cannot be accorded among those already parties, or (2) Britton claims an interest relating to the
7 subject of the action and is so situated that the disposition of this action may as a practical matter
8 impair or impede Britton’s ability to protect that interest. Fed. R. Civ. P. 19(a). When a plaintiff
9 seeks to nullify a negotiated agreement between two parties, the plaintiff must join both parties.
10 *Clinton v. Babbitt*, 180 F.3d 1081, 1087 (9th Cir. 1999) (“[A] district court cannot adjudicate an
11 attack on the terms of a negotiated agreement without jurisdiction over the parties to that
12 agreement”), *citing Lomayaktwa v. Hathaway*, 520 F.2d 1324, 1326 (9th Cir. 1975). Here,
13 Jacobsen requests declaratory relief that is precisely an attack on the negotiated settlement
14 agreement between Britton and Katzer that transferred the rights in the domain name to Britton.
15 Clearly, complete relief of the type Jacobsen seeks cannot be afforded between Jacobsen and
16 Katzer unless Britton, the alleged current owner of the domain name, is joined.

17 Additionally, Britton has a legally protected interest in the domain name. Should this
18 court make an adjudication regarding that interest or its transfer, Britton will be exposed to
19 potential liability under the settlement agreement. Without Britton’s participation, he is unable
20 to protect and defend the validity of his interests. He is a “necessary” party under Rule 19(a).

21 Because Britton is a "necessary party" for the relief Jacobsen seeks, the Court should
22 determine whether Britton is an "indispensable party." If a court lacks personal jurisdiction over
23 an indispensable party, the court should dismiss that claim. *Hendricks v. Bank of Am., N.A.*, 408
24 F.3d 1127, 1135 (9th Cir. 2005). As a Pennsylvania resident with no apparent ties to California,
25 Britton is not subject to this court’s personal jurisdiction, so this Court should dismiss Count 6 if
26 Britton is indispensable to Count 6. Decl. of R. Scott Jerger, Exhibits A, page 2, Exhibit B.

1 An unjoined party's indispensability is an "equitable determination to be decided based
2 on a variety of factors." *Hendricks* at 1136. These factors include:

- 3 (1) to what extent a judgment rendered in Britton's absence might be prejudicial
4 to him or those already parties,
- 5 (2) the extent to which, by protective provisions in the judgment, by the shaping
6 of relief, or other measures, the prejudice can be lessened or avoided;
- 7 (3) whether a judgment rendered in the person's absence will be adequate; and
- 8 (4) whether the plaintiff will have an adequate remedy if the action is dismissed
9 for nonjoinder.

10 Here, the factors strongly weigh in favor of finding Britton to be indispensable. Granting
11 the declaratory relief that Jacobsen seeks would force Britton to breach his settlement agreement
12 with Katzer and transfer the domain name to Jacobsen. Likewise, a declaratory ruling in
13 Britton's absence regarding the rights in the domain name will not be adequate because of
14 Britton's current ownership of the domain name. Finally, Jacobsen retains an adequate remedy
15 because he can pursue Britton independently of this lawsuit for the rights in the domain name in
16 a court with personal jurisdiction over Britton.

17 Because Britton is a necessary and indispensable party to Jacobson's claim and the court
18 lacks personal jurisdiction over him, Count 6 of Jacobsen's amended complaint should be
19 dismissed without leave to amend.

18 **E. Motion to Strike**

19 Under Fed. R. Civ. P. 12(f), this Court "may order stricken from any pleading ... any
20 redundant, immaterial, impertinent, or scandalous matter." Jacobsen's amended complaint
21 resembles a public relations document for the open source software movement rather than a legal
22 pleading. The essential function of rule 12(f) is to "avoid the expenditure of time and money that
23 must arise from litigating spurious issues by dispensing with those issues prior to trial." *Fantasy,*
24 *Inc. v. Fogerty*, 984 F.2d 1524, 1527 (9th Cir. 1993). A rule 12(f) motion to strike may be used
25 to strike the prayer for relief where the damages sought are not recoverable as a matter of law.
26

1 *Tapley v. Lockwood Green Engineers, Inc.*, 502 F.2d 559 (8th Cir. 1974). Under rule 12(f),
2 defendants seek to strike the following items from the amended complaint:

3 (1) Paragraphs 1-6. These paragraphs contain immaterial, public relations matter on the
4 history of open source that has no possible bearing on the subject matter of the
5 litigation.

6 (2) Footnote 14; Paragraph 66; Count 4, footnote 19; Footnote 20; Count 7, footnote 21.
7 These citations to the amended complaint all contain instances where plaintiff
8 attempts to revisit his previous libel claim and Sherman Act claim against defendants.
9 The Sherman Act claim has been stricken without leave to amend. Plaintiff rather
10 bizarrely states that he is “reserving his rights to seek reinstatement [of these claims]
11 upon review of the Court’s written ruling.” Jacobsen has no rights to reserve. The
12 libel claim and the Sherman Act claim have been dismissed. Docket # 86. It would
13 severely prejudice defendants if defendants are forced to expend time and money to
14 dismiss these claims again should plaintiff attempt to “reinstate” them.

15 (3) Footnote 17. This footnote responds to an argument made in court papers filed by
16 Kevin Russell. Kevin Russell is no longer a party to this lawsuit and the motion to
17 dismiss underlying the argument that plaintiff is responding to has been granted by
18 this court. It is therefore irrelevant.

19 (4) Paragraph 105, the first clause of the sentence in paragraph 106 referencing 17
20 U.S.C. § 504 and Paragraph R of the Prayer, should plaintiff’s copyright claim
21 survive this motion. Plaintiff is not entitled to seek statutory damages under 17
22 U.S.C. § 504 since plaintiff admittedly registered the copyright after the alleged
23 infringement occurred. *Polar Bear Productions v. Timex Corp.*, 384 F.3d 700, 708,
24 n.5 (9th Cir. 2004).

25 (5) Paragraphs H and T in the Prayer. The relief sought in these requests is not
26 authorized by any of the statutes at issue in this case. Defendants would be

1 extremely prejudiced if required to comply with the requested relief in paragraphs H
2 and T of the prayer.

3 (6) All references in Paragraph 50 to Kevin Russell as a “defendant” in this lawsuit.

4 **F. Motion for More Definite Statement**

5 Despite the length of the amended complaint, Jacobsen has failed to identify the
6 trademarks that are allegedly being infringed in Count 9. Defendants seek a more definite
7 statement from Jacobsen pursuant to Fed. R. Civ. P. 12(e). Rule 12(e) states that “if a
8 pleading...is so vague and ambiguous that a party cannot reasonably be required to frame a
9 responsive pleading, the party may move for a more definite statement.”

10 Defendants cannot frame a responsive pleading until defendants understand which of the
11 “various JMRI trademarks” (Amended Complaint, ¶ 110) are allegedly being infringed. *Boxall*
12 *v. Sequoia Union High School District*, 464 F. Supp. 1104, 1114 (N.D. Cal. 1979). Therefore,
13 defendants request that this Court require Jacobsen to identify the JMRI trademarks.

14 **G. Jacobsen should not be granted leave to amend his complaint again**

15 Jacobsen should not be granted leave to amend his complaint as to Counts 5, 6, 8, and 10
16 because Jacobsen is precluded from bringing these claims against defendants as a matter of law.
17 *Albrecht v. Lund*, 845 F.2d 193 (9th Cir. 1988). Additionally, Jacobsen should not be afforded
18 leave to amend his complaint to add additional, new claims against defendants for a second time.
19 Leave to amend may be denied for reasons of undue delay, bad faith, repeated failure to cure
20 deficiencies by previous amendments allowed, futility of the amendment, and prejudice to the
21 opposing party. *Foman v. Davis*, 371 US 178, 182 (1962); *Allen v. Beverly Hills*, 911 F.2d 367,
22 373 (9th Cir. 1990).

23 Defendants are eager to answer and defend the patent enforceability allegations in this
24 lawsuit. Allowing Jacobsen to amend his complaint a second time will cause undue delay and
25 prejudice defendants. Jacobsen has alleged 10 claims (two of which have already been
26 dismissed) against defendants in a simple patent enforceability dispute. Conversely, not

1 allowing Jacobsen to amend his complaint again will not prejudice Jacobsen as he has pleaded
2 every remotely plausible claim against defendants available to him in the complaint and the
3 subsequent amended complaint.

4 **H. Conclusion**

5 Based on the above, this Court should grant KAM and Katzer’s motion to dismiss Counts
6 5, 6, 8, and 10 from the amended complaint, strike those certain portions of the amended
7 complaint referenced above that are immaterial to this lawsuit, require the plaintiff to clarify
8 Count 9, and award defendants their reasonable costs and attorney fees in an amount to be
9 determined for successfully dismissing Count 8. Additionally, this Court should not grant
10 Jacobsen leave to amend his complaint again.

11 Dated September 28, 2006.

Respectfully submitted,

12 _____
/s/

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20 **CERTIFICATE OF SERVICE**

21 I certify that on September 28, 2006, I served Matthew Katzer’s and KAM’s Motion to
22 Dismiss, etc., Supporting Memorandum, and Declaration of R. Scott Jerger in Support on the
23 following parties through their attorneys via the Court’s ECF filing system:

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25 Law Office of Victoria K. Hall
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/s/

R. Scott Jerger (*pro hac vice*)
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