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

13 ROBERT JACOBSEN, an individual,) No. C06-1905-JSW
14)
Plaintiff,)
15 v.) **MOTION FOR LEAVE TO FILE**
16) **SECOND AMENDED COMPLAINT, AND**
MATTHEW KATZER, an individual, and) **IN THE ALTERNATIVE, MOTION FOR**
17 KAMIND ASSOCIATES, INC., an Oregon) **FINAL JUDGMENT UNDER RULE 54(B)**
corporation dba KAM Industries,) **AS TO CYBERSQUATTING CAUSE OF**
18) **ACTION**
Defendants.) Courtroom: 2, 17th Floor
19) Judge: Hon. Jeffrey S. White
Date: Friday, Jan. 4, 2008
20) Time: 9:00 a.m.

21 NOTICE OF MOTION

22 TO THE PARTIES AND THEIR ATTORNEYS OF RECORD

23 PLEASE TAKE NOTICE that, on Friday, January 4, 2008, at 9:00 a.m. in Courtroom 2,
24 17th floor of the San Francisco Division of the United States District Court for the Northern
25 District of California, located at 450 Golden Gate Avenue, San Francisco, California, Plaintiff
26 Robert Jacobsen will seek leave for file a Second Amended Complaint. This motion is based on
27

1 the following.

2 INTRODUCTION

3 Although he has consent from Defendants to file a Second Amended Complaint, Plaintiff
4 files this motion for leave to file his Second Amended Complaint to address another matter that has
5 arisen since the last hearing on Sept. 14, 2007.

6 After careful consideration, Plaintiff has decided to provide two versions of the proposed
7 Second Amended Complaint, one with cybersquatting and one without cybersquatting. This is
8 why: Plaintiff believes he needs to make the record for appeal on cybersquatting, and that it must
9 be done through a motion for leave to file an amended complaint. However, Plaintiff is mindful of
10 this Court's past orders regarding previously dismissed causes of action. So that there will be no
11 further delays in this litigation, Plaintiff provides an alternate version for the Court to accept should
12 the Court choose not to restore the previously dismissed cybersquatting cause of action. Defendants
13 do not object to filing a Second Amended Complaint, but state they object to Plaintiff filing two
14 Second Amended Complaints. Defendants appear to believe that Plaintiff is filing two Second
15 Amended Complaints instead of a motion for leave to file a Second Amended Complaint.

16 ISSUES TO BE DECIDED

- 17 • Should the cybersquatting cause of action be restored and Version A of the proposed Second
18 Amended Complaint be filed?
- 19 • Should Version B of the proposed Second Amended Complaint be filed, and final judgment
20 under Rule 54(b) be entered as to the cybersquatting cause of action?

21 ARGUMENT

22 Plaintiff seeks leave to file a Second Amended Complaint. If a party has amended his
23 pleading once, "a party may amend the party's pleading only by leave of court or by written
24 consent of the adverse party; and leave shall be freely given when justice so requires." Fed. R. Civ.
25 P. Rule 15(a). Plaintiff provides two versions of the proposed Second Amended Complaint.
26 Defendants, as noted earlier, consent to the filing of either version of proposed Second Amended
27 Complaint. Version A (Exhibit A) contains the cybersquatting claim. Version B (Exhibit B) does

1 not. One can discern the difference between the complaints by looking at the lower right hand
2 corner of the proposed complaints, which have either an “A” for Version A, or “B” for Version B.
3 The reason Plaintiff files this motion is to address the previously dismissed cybersquatting cause of
4 action. Plaintiff and his counsel are aware of the Court’s views on including references to
5 previously dismissed causes of action in later complaints, and thank the Court in advance for its
6 patience while Plaintiff makes the record for appeal. To the extent necessary, Plaintiff moves for
7 leave to file this as a motion for reconsideration, on the following basis:

8 Plaintiff did not know that this Court thought counsel for Plaintiff said the cybersquatting
9 cause of action was in rem. Plaintiff could not have known, through his own diligence, that the
10 Court held this belief. Plaintiff only became aware of this belief when the Court issued its order on
11 Aug. 17, 2007, and only last week obtained the transcript from the court reporter, which confirmed
12 that counsel for Plaintiff did not say the cybersquatting cause of action was in rem. See Transcript
13 of Proceedings, Jan 19, 2007, at 18, l. 22 – 20, l. 16. (Exhibit C). There, counsel for Plaintiff
14 stated, “How about if I just say, let’s not go for decoderpro.com [sic] back in this litigation.” Id. at
15 18, ll. 22-23. Counsel for Plaintiff then said that Plaintiff would seek an award for attorney’s fees
16 to bring an in rem action in the Eastern District of Virginia. Id. at 19, ll. 4-7. There is no mention
17 of bringing an in rem action in the Northern District of California, nor would it make sense to
18 because the registrar, Network Solutions, is located in the Eastern District of Virginia. An in rem
19 action must be brought in the district in which the domain name registrar is located. See 15 U.S.C.
20 Sec. 1125(d)(2) (“The owner of a mark may file an in rem civil action against a domain name in
21 the judicial district in which the domain name registrar, domain name registry, or other domain
22 name authority that registered or assigned the domain name is located....”). Further in the
23 transcript, counsel for Plaintiff said that if Plaintiff dropped his claim for the transfer of
24 decoderpro.com, then this change would moot Defendants’ motion to dismiss for failure to join a
25 party under Rule 19. Id. at 19, ll. 17-19; at 20, at ll. 8-12. Thus, the Jan. 19, 2007 transcript, just
26 recently available, constitutes a material difference in facts as compared with what the Aug. 17,
27 2007 order said, so that leave to file this motion for reconsideration should be granted under Civil

1 L.R. 7-9(b)(1).

2 Likewise, under Civil L.R., 7-9(b)(2), there was an emergence of new facts – that this Court
3 believed that counsel for Plaintiff had stated cybersquatting was in rem, which as noted above
4 counsel for Plaintiff (1) did not say and (2) did not know the Court thought this is what she said.
5 Facts are newly available to the Court – they are in the transcript. On this basis, leave to file this
6 motion for reconsideration should be granted.

7 Finally, and with all due respect, under Civil L.R. 7-9(b)(3), there was a manifest failure by
8 the Court to consider material facts that were presented to the Court at the Jan. 19, 2007 hearing –
9 that counsel for Plaintiff described the cause of action, pending in this lawsuit, in a manner that
10 made it clear it was not cybersquatting in rem.

11 Plaintiff believes that the cybersquatting claim is a viable claim, as shown by the UDRP
12 panel’s decision in Jacobsen v. Britton, WIPO Case No. D2007-0763. He also believes that the
13 cybersquatting claim is not moot because Plaintiff also sought injunctive relief, which has not been
14 granted or addressed.

15 To prevail on a cybersquatting claim, a trademark holder must show he is the owner of a
16 distinctive or famous mark, and “without regard to the goods or services of the parties, that
17 [Defendants] (i) ha[d] a bad faith intent to profit from that mark ...; and (ii) register[ed],
18 traffic[ked] in, or use[d] a domain name” that is identical or confusingly similar to the mark.
19 Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672, 680 (9th Cir. 2005); 15 U.S.C. § 1125(d)(1)(A).

20 Plaintiff has shown that he is the trademark holder. The DecoderPro trademark is distinctive
21 because of its widespread use and recognition among model railroaders who use computer control
22 in their layouts, and also because Plaintiff registered the mark, and the U.S. Trademark Office
23 placed the mark on its Principal Register. Defendants had no legitimate rights in the mark.

24 Defendants registered the domain name. When Plaintiff learned about this, he demanded
25 the domain name be transferred to him. Defendant Katzer refused to transfer the domain name to
26 Plaintiff. Instead, he transferred it to Jerry Britton for a monetary interest of \$20,000 plus
27 attorneys’ fees, payable if Mr. Britton broke the settlement agreement. Britton was barred from

1 transferring the domain name to anyone else, including Plaintiff, the rightful owner. These facts
2 support that Defendants registered and trafficked in the domain name, and Defendants had bad
3 faith intent to profit from the mark.

4 Thus, the cybersquatting claim is a viable claim, and should be permitted in the Second
5 Amended Complaint. This Court has ordered the parties to attend a settlement conference on or
6 before Dec. 14, 2007. Plaintiff will put his best efforts into the settlement conference, but he
7 cannot in good conscience settle the case if cybersquatting is not part of the settlement. Plaintiff
8 believes it would be better if cybersquatting were part of the settlement conference that this Court
9 ordered, but if the Court does not permit Version A to be filed, then Plaintiff moves for final
10 judgment of the cybersquatting claim under Federal Rules of Civil Procedure Rule 54(b) so that he
11 may consolidate the matter with his other appeal pending before the Federal Circuit, and so that he
12 may engage in settlement talks through the Federal Circuit mediation program.

13 Having made the record for appeal as to cybersquatting, Plaintiff moves to Version B.

14 Version B is the same complaint without the cybersquatting claim. Facts relevant to
15 cybersquatting are also relevant to showing that Defendants engaged in a pattern of infringing
16 JMRI and others' intellectual property, and claiming JMRI and other's IP as their own, and so the
17 facts remain.

18 The exhibits remain the same for both versions of the proposed Second Amended
19 Complaint. Counsel for Plaintiff sent defense counsel both versions of the proposed Second
20 Amended Complaint. Defendants consented to filing either version of the Second Amended
21 Complaint under Rule 15. Defendants did state that they objected to filing both versions of the
22 Second Amended Complaint. However, Plaintiff is filing a motion for leave to file a Second
23 Amended Complaint, and is not filing two Second Amended Complaints. Defendants have not
24 stated a position on the motion for final judgment under Rule 54(b) as to the cybersquatting cause
25 of action, nor on the motion for leave to file motion for reconsideration.

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