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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)**

1 **FIRST SUPPLEMENTAL COUNTERCLAIM**  
2 **(Copyright Infringement under the Copyright Act § 501(a))**

3 **BACKGROUND FACTS**

- 4 1. Kamind Associates, Inc. (KAM) is an Oregon corporation with a principal place of  
5 business in Portland, Oregon.
- 6 2. Upon information and belief, plaintiff/counterdefendant Robert Jacobsen is an  
7 individual resident of Berkeley, California.
- 8 3. The following counterclaim arises under the copyright laws of the United States, and  
9 under the common law. This Court has original jurisdiction of the subject matter of the  
10 statutory counterclaim pursuant to 28 U.S.C. §§ 1331 and 1338.
- 11 4. Venue for defendants' counterclaims is proper in this District pursuant to 28 U.S.C.  
12 § 1391(b) because plaintiff-counterdefendant resides in this District.
- 13 5. KAM is a small startup company that has invested years of development, substantial  
14 financial resources in order to provide digitally controlled model train software at a  
15 reasonable price to the model train community.
- 16 6. KAM sold the world's first client server software product for digitally command  
17 controlled model trains in July 1997.
- 18 7. Plaintiff's JMRI software was first developed in 2001.
- 19 8. The National Model Railroad Association (NMRA) Digital Command Control (DCC)  
20 Reference Manual for QSI Quantum HO Equipped Locomotives-Versions 3.0, 4.02,  
21 4.1, 4.3 and 4.4 (QSI Manual) includes a set of commands used to program QSI digital  
22 command control hardware. The QSI Manual contains unique expressions and  
23 descriptions of decoder variables and features used to configure locomotive functions  
24 as well as expressions of code, structure, sequence and/or organization. For example,  
25 the QSI Manual contains commands that control the headlight functions on model train  
26 locomotives.

- 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:  
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  - 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.

7  
8 Dated September 9, 2009.

9 Respectfully submitted,

10 /s/ R. Scott Jerger

11 R. Scott Jerger (*pro hac vice*)

12 Field Jerger LLP

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**CERTIFICATE OF SERVICE**

I certify that on September 9, 2009, I served Matthew Katzer's and KAM's First Supplemental Counterclaim on the Plaintiff through his attorney via the Court's ECF filing system:

Victoria K. Hall  
Attorney for Robert Jacobsen  
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: September 9, 2009

/s/ R. Scott Jerger

R. Scott Jerger (*pro hac vice*)

Field Jerger LLP

Case Number C 06 1905 JSW  
Defendants' First Supplemental Counterclaim.