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**United States District Court**  
For the Northern District of California

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

ROBERT JACOBSEN,

No. C 06-1905 JSW (JL)

Plaintiff,

v.

ORDER DENYING WITHOUT  
PREJUDICE MOTION FOR ISSUANCE  
OF LETTER OF REQUEST (Docket #  
315)

MATTHEW KATZER, et al.,

Defendants.

**I. Introduction**

Plaintiff's Motion for Issuance of Letters Rogatory (Letter of Request) (Docket # 315) was referred by the district court (Hon. Jeffrey S. White), pursuant to 28 U.S.C. §636(b). Jacobsen seeks the cooperation of the courts of Switzerland in obtaining the deposition of Robert Bouwens, a Swiss national. Plaintiff Robert Jacobsen has accused Defendants Matthew Katzer and KAMIND Associates, Inc. of infringing his copyrights in Java Model Railroad Interface (JMRI) software. Katzer and KAMIND acknowledge that they copied, modified, and distributed portions of JMRI software, but say that Robert Bouwens, a Swiss national living in the Aargau canton in Switzerland, committed the acts. Bouwens' testimony directly relates to willfulness elements of the copyright infringement and DMCA violation claims. As far as Jacobsen is aware, the last time that Bouwens was in the United States was July 2008. The parties have contacted Bouwens. Bouwens did not respond to

1 Jacobsen's email. Defendant Katzer and Defendants' counsel, Scott Jerger, has also  
2 contacted Bouwens to see if Bouwens would be willing to make himself available for  
3 deposition. Despite repeated attempts to obtain Bouwens' cooperation, Bouwens finally  
4 responded, and refused to cooperate.

5 Defendants filed a qualified non-opposition to the motion for issuance, objecting to  
6 some of the specifications in the Letter of Request. This Court found the matter suitable for  
7 submission without a hearing or appearance before the Court pursuant to Civil Local Rule  
8 7-1(b), vacated the hearing and the matter was submitted. The pretrial schedule for this  
9 case is that a Motion Hearing is set for December 4, 2009; Pretrial Conference is set for  
10 March 1, 2010; and Jury Trial is set for March 22.

## 11 II. Parties' Argument

12 Katzer does not object to this Court sending a Letter of Request for the testimony of  
13 Robert Bouwens. However, Katzer filed a response to address and object to specific factual  
14 mis-characterizations and argument contained in Plaintiff's Letter of Request. Specifically,  
15 Katzer responds to the following sections:

16 7.b.: Summary of Complaint: This case does not involve any patent issues. All  
17 patent claims were dismissed with prejudice in this Court's Order dated January 9,  
18 2009. [Dkt.# 284]. Therefore, Katzer objects to the characterization of the complaint  
19 as involving patent declaratory actions.

20 7.c.: Summary of Defence and Counterclaim: Again, Katzer objects to the discussion  
21 of patent issues, which are not relevant to this case. Additionally, Katzer objects to  
22 factual mis-characterizations of the record in this case. Katzer has never admitted  
23 (and does not admit to) "copying, modifying and distributing Jacobsen's copyrighted  
24 works...". In his answer, Katzer specifically denies that Jacobsen is the owner of any  
25 copyrighted works (which to date, Jacobsen has yet to identify, with the exception of  
26 the QSI decoder definition file). See [Dkt.#290] at ¶¶ 80, 88.

27 Katzer also objects to the unfounded assertion that Katzer "blames" Bouwens for  
28 anything and also to the characterization of Katzer's copyrighted works as an "instruction  
29 manual."

30 Jacobsen responds by arguing that, since Katzer does not object to issuing the  
31 Letter of Request, the Court should issue it and disregard Katzer's "quibbles" with the  
32 substance: As Jacobsen argues -

1 Defendants quibble about certain phrasing in the letter of request, but these do not  
2 provide a reason to bar the issuance of the letter of request. The Second Amended  
3 Complaint does indeed state claims for declaratory judgment of non-infringement,  
4 invalidity, and unenforceability— causes of action that were also in the two earlier  
5 complaints. This district court dismissed these causes of action several months after  
6 Defendants filed a disclaimer, one day after missing Judge Laporte's court-ordered  
7 deadline to produce their claim construction, infringement, validity, and enforceability  
8 positions. Order [Docket # 199]; Declaration of Matthew Katzer, Ex. A [Docket #203].  
9 Defendants argue that because the district court dismissed these causes of action,  
10 the district court's order treats the causes of action as if they never existed.  
11 Defendants tried that argument with the Federal Circuit when they sought to transfer  
12 the pending appeal to the Ninth Circuit. It didn't work. See Exhibit 1 (Federal Circuit  
13 order denying motion to transfer).

14 As for the statements that Katzer admitted to copying, modifying, and distributing  
15 Jacobsen's code, and admitted ownership, this Court need look no further than the  
16 admissions Katzer made to the Federal Circuit in the previous appeal. *Jacobsen v.*  
17 *Katzer*, 535 F.3d 1373, 1379 (Fed. Cir. 2008) ("The parties do not dispute that  
18 Jacobsen is the holder of a copyright in certain materials distributed through his  
19 website. Katzer/Kamind also admits that portions of the DecoderPro software were  
20 copied, modified, and distributed as a part of the Decoder Commander software.")  
21 (footnote omitted).

22 In addition, Katzer takes issue with Jacobsen's description that the QSI manual is an  
23 instruction manual, and that Jacobsen hasn't adequately identified his work. Katzer  
24 also objects to Jacobsen's description that Katzer is blaming Bouwens for  
25 infringement. Jacobsen invites the Court to review the QSI manual, which was filed  
26 as Exhibit E with Mr. Katzer's declaration. [Docket #261]. Jacobsen believes his  
27 description of the QSI manual is accurate. As for identifying his work, Jacobsen has  
28 made the appropriate copyright claim in his registrations. In the previous appeal, the  
Federal Circuit did not find the registration to be problematic, and neither should this  
Court. Finally, as for blaming Bouwens, Katzer is quick to point the finger at  
Bouwens for his work in copying and modifying Jacobsen's Decoder Definition files.  
Declaration of Matthew Katzer [Docket #261] at 1-2. It's fair to state that Katzer is  
attempting to blame Bouwens.

### 21 **Analysis and Conclusion**

22 In January 2009, the district court issued an order denying Jacobsen's motion for  
23 preliminary injunction, granting Defendants' motion to dismiss for mootness; denying  
24 Defendant's motion to strike Plaintiff's motion for attorney fees; and granting in part and  
25 denying in part Defendants' motion to dismiss for failure to state a claim. The court granted  
26 leave for Jacobsen to file an amended complaint within twenty days of the date of the  
27 Order. Plaintiff filed an appeal to the Federal Circuit in February 2009 (Federal Circuit Case  
28 No. 2009-1221).

1 The district court found, among other things, that there are no longer any patent  
2 issues in this case, because Katzer disclaimed the patent at issue, that Jacobsen's  
3 copyright claims were problematic at best, that Katzer owned the copyright to some of the  
4 software at issue and that Jacobsen could not prove the likelihood of harm:

5 Counts one, two and three of the second amended complaint must be dismissed as  
6 moot because of Defendants' disclaimer of the patent sued upon. The Defendants  
7 filed a Disclaimer in Patent under 37 C.F.R. § 1.321(a) with the Patent and  
8 Trademark Office on February 1, 2008, disclaiming all claims in the '329 patent.  
9 (See Declaration of Matthew Katzer, ¶ 3, Ex. A.) There is no dispute that the patent  
10 at issue in this case has been disclaimed and there is therefore no further  
11 substantial controversy between the parties of "sufficient immediacy and reality to  
12 warrant the issuance of a declaratory judgment." (Order e-filed January 5, 2009 at  
13 Docket # 284, ("Order") at 3:21-27).

14 The court also held that Jacobsen failed to show harm from Katzer's alleged use of  
15 his open source software, or even the extent of his alleged ownership:

16 Although Jacobsen makes legal arguments regarding the alleged harm he may  
17 suffer, for instance delays and inefficiency in development and time lost in the open  
18 source development cycle, he has failed to put forward any evidence of such harms.  
19 Jacobsen has failed to proffer evidence of harm suffered or any evidence of a real or  
20 immediate threat of imminent harm in the future. The Court also finds that Jacobsen  
21 has failed to identify with the requisite particularity the extent of his copyright  
22 ownership over the disputed underlying material. The JMRI Project Decoder  
23 Definition Files incorporate many manufacturers' specifications data as well as rights  
24 to specific terms whose copyright is owned by Defendants. Even if Jacobsen's  
25 heavy burden to warrant injunctive relief had been met, it is unclear how the Court  
26 would fashion an injunction which would be narrowly tailored to enjoin only those  
27 allegedly infringing uses of Jacobsen's copyrighted content. (Order e-filed January 5,  
28 2009 at Docket # 284, p. 14, n.3)

29 This reflects the finding by the Federal Circuit, which Jacobsen neglects to include in  
30 his citation, that Katzer disputed that he violated Jacobsen's copyright because Katzer has  
31 a license to use the material: "Katzer/Kamind argues that they cannot be liable for copyright  
32 infringement because they had a license to use the material." *Jacobsen v. Katzer* 535 F.3d  
33 1373, 1379 (Fed. Cir. 2008). At most, the Federal Circuit had held, prior to the district  
34 court's ruling on remand, that Katzer had violated certain terms of the Artistic License to  
35 use Jacobsen's copyrighted materials, and it remanded the case to the district court to  
36 determine whether Jacobsen had demonstrated (1) a likelihood of success on the merits

1 and either a presumption of irreparable harm or a demonstration of irreparable harm; or (2)  
 2 a fair chance of success on the merits and a clear disparity in the relative hardships and  
 3 tipping in his favor. *Id.* at 1382 -1383.


4 The district court then issued its order finding *inter alia* that Jacobsen did not have a  
 5 likelihood of prevailing on the merits of this claim, which ruling is currently on appeal, again  
 6 to the Federal Circuit.

7 Keeping in mind the prior rulings by the district court and the Federal Circuit in this  
 8 case, this Court finds that Jacobsen's response to Katzer's objections to the Letter of  
 9 Request as drafted are well-taken and that Jacobsen's response does not adequately  
 10 address the objections. The fact remains that Jacobsen's patent claims were dismissed by  
 11 the trial court and this ruling has not been reversed; that Katzer does not admit to "copying,  
 12 modifying and distributing Jacobsen's copyrighted works . . ." because he argues that he  
 13 has a license to them and has not violated the license. Similarly, Jacobsen does not refute  
 14 that he is not the owner of any copyrighted works, the Federal Circuit merely affirmed that  
 15 he has a cause of action for trademark infringement (district court Order at 24:24-25).  
 16 Finally Katzer denies that it "blames" Bouwens for anything and objects rightfully to the  
 17 characterization of its copyrighted works as an "instruction manual."

18 The function of a Letter of Request is to obtain the cooperation of a foreign court in  
 19 conducting discovery. This Court finds that Jacobsen may obtain relevant evidence without  
 20 incorporating the materials to which Katzer objects. Accordingly, the motion for issuance of  
 21 Letter of Request is denied, without prejudice to Jacobsen's re-drafting the Letter of  
 22 request without the objectionable content.

23 IT IS SO ORDERED.

24 DATED: October 6, 2009

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 28 JAMES LARSON  
 U.S. Magistrate Judge

28 G:\JLALL\CHAMBERS\CASES\CIV-REF\06-1905\Order deny 315.wpd