

R. Scott Jerger (*pro hac vice*) (Oregon State Bar #02337)
Field Jerger LLP
610 SW Alder Street, Suite 910
Portland, OR 97205
Tel: (503) 228-9115
Fax: (503) 225-0276
Email: scott@fieldjerger.com

John C. Gorman (CA State Bar #91515)
Gorman & Miller, P.C.
210 N 4th Street, Suite 200
San Jose, CA 95112
Tel: (408) 297-2222
Fax: (408) 297-2224
Email: jgorman@gormanmiller.com

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

Hearing Date: December 19, 2008
Hearing Time: 9:00am
Place: Ct. 2, Floor 17

Hon. Jeffrey S. White

**DEFENDANTS MATTHEW
KATZER AND KAMIND
ASSOCIATES, INC.'S
OPPOSITION TO PLAINTIFF'S
MOTION FOR A PRELIMINARY
INJUNCTION**

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1 **STATEMENT OF ISSUED TO BE DECIDED**

- 2 1. Has Plaintiff demonstrated that he will likely suffer “irreparable” harm unless an
3 injunction issues?
4 2. Will Defendants suffer irreparable harm through entry of an injunction?
5 3. Does Defendants harm outweigh Plaintiff’s alleged harm?
6 4. Has Plaintiff demonstrated that he will prevail on the merits of his copyright claim?

7 **STATEMENT OF RELEVANT BACKGROUND FACTS**

8 Plaintiff is seeking a preliminary injunction to enjoin defendants from copying and
9 distributing Plaintiff’s copyrighted works entitled “JMRI Program and Decoder Definitions or
10 JMRI Decoder Definitions.” Proposed Order at 2 [Dkt.# 239]. Additionally, Plaintiff seeks to
11 enjoin Defendants from, *inter alia*, providing and distributing “copyright management
12 information that is false.” *Id.* Plaintiff states that he has copyrighted 195 Decoder Definition
13 Files. Declaration of Robert Jacobsen in Support of Motion for Preliminary Injunction [Dkt.#
14 237] (hereinafter “Jacobsen Decl.”) at ¶ 8. Plaintiff has only provided a complete copy of one of
15 those Decoder Definition files, the QSI Decoder Definition File, with his moving papers.
16 Jacobsen Decl., Ex. AD. Plaintiff then provides specific examples of textual information that
17 was allegedly authored by JMRI in this QSI Decoder Definition File, and then allegedly stolen
18 and copied by Defendants. Jacobsen Decl. at ¶¶ 71-73, 80, 109. Plaintiff, however, has no
19 copyright rights to this textual information contained in this particular QSI Decoder Definition
20 File which he accuses Defendants of infringing. Declaration of Matthew Katzer in Opposition to
21 Plaintiff’s Motion for a Preliminary Injunction (hereinafter “Katzer Decl.”) at ¶ 48-52. Rather,
22 this information was originally created by QSI Industries, Inc. and then published by QSI
23 Industries, Inc. in a work entitled “NMRA DCC Reference Manual for QSI Quantum HO
24 Equipped Locomotives – Version 3.0” (QSI Manual) before it was copied by the Plaintiff.
25 Katzer Decl. at ¶ 48, 51. Defendants own all the copyright rights to the QSI manual work and
26 therefore have every right to use this information in KAM software. Katzer Decl. at ¶ 48.

1 JMRI's Decoder Definition Files are data files that are part of JMRI's software product.
2 Decoder Pro. Katzer Decl. at ¶ 4. These files include manufacturer's specifications data relating
3 to the computer chips in model train engines (decoders) as well as program configuration
4 information. Katzer Decl. at ¶ 4. While not clear from Plaintiff's moving papers, Defendants
5 believe that Plaintiff is only alleging that Defendants' software product, Decoder Commander,
6 infringes on the manufacturer's specifications data contained in the Decoder Definition Files and
7 not on Plaintiff's executable code. This is because KAM's software code is and always has
8 been written in programming languages using Microsoft software tools which is different than
9 the Sun-based JAVA programming language used by the JMRI software. Katzer Decl. at ¶ 5.

10 In 2004, KAM began developing the software that would become Decoder Commander.
11 Katzer Decl. at ¶ 6. This software is similar in general functionality to JMRI's Decoder Pro in
12 that it also facilitates the programming of decoders by a user. Katzer Decl. at ¶ 6. KAM and
13 JMRI are the only two primary entities that provide such software in the U.S. market and they
14 are competitors with each other. Katzer Decl. at ¶ 6.

15 Originally Defendants' Decoder Commander did contain information copied and then
16 converted from JMRI's Decoder Definition Files. Katzer Decl. at ¶ 7. During the software
17 development phase of Decoder Commander, a KAM independent contractor downloaded the
18 JMRI open source decoder definition files in early 2005. Katzer Decl. ¶ 7. This independent
19 contractor, Robert Bouwens, then created a tool, called the template verifier, to extract the
20 manufacturer specifications data from the JMRI Decoder Definition Files. Katzer Decl. ¶ 8.

21 Defendants copied the JMRI Decoder Definition Files, at the time, in an effort promote
22 the idea of a national standard for manufacturer specifications data. Katzer Decl. ¶12; Jacobsen
23 Decl. at ¶ 50. Defendants, at the time, did not believe that Plaintiff would become upset by this
24 use. Katzer Decl. at 12. This is because the JMRI software was available for free to the public,
25 and because the JMRI Decoder Definition Files, themselves, are not foundational works, but
26 rather build on an effort by numerous manufacturers and users to create a master, uniform

1 template of manufacturer's specifications data. Katzer Decl. at ¶ 12 . For example, the JMRI
2 Decoder Definition Files contain manufacturer's specifications data initially created by multiple
3 different manufacturers, such as QSI Industries, Inc., as well as manufacturer's specifications
4 data originally created by the National Model Railroad Association. Katzer Decl. at ¶ 12.

5 The fact that JMRI was not "given credit" in the decoder template files results from the
6 fact that the JMRI credit information was contained in the comment fields of the decoder
7 definition file code. Katzer Decl. ¶ 13. The template verifier, which extracted the manufacturer
8 specifications data, was not designed to extract any information other than from data fields.
9 Katzer Decl. ¶ 13. This was not intentional. Katzer Decl. ¶ 13.

10 In early September 2006, Defendants first learned about Plaintiff's allegations that
11 Decoder Commander contained infringing works from the JMRI Decoder Definition Files.
12 Katzer Decl. at ¶ 14 In response, Defendants immediately recalled all allegedly infringing
13 product (at this time version 305 of Decoder Commander) from the market, removed version 305
14 from the KAM website, and sent KAM customers upgrades that did not contain any allegedly
15 infringing material. Katzer Decl. at ¶ 15. Defendants also made sure that the template verifier
16 tool was no longer available on the KAM website. Katzer Decl. at 15. All outstanding copies of
17 version 305 became non-functional on January 21, 2007 and accordingly any allegedly
18 infringing material is no longer functional. Katzer Decl. at ¶ 15.

19 To further address Plaintiff's concerns regarding the alleged infringement, KAM released
20 V306 of Decoder Commander on September 18, 2006. Katzer Decl. at ¶ 16. Plaintiff continued
21 his allegations of infringement and KAM therefore recalled V306 from the market and removed
22 V306 from the KAM website in late October 2006. Katzer Decl. at ¶ 16. All outstanding non-
23 registered copies of V306 became non-functional on March 21, 2007. Katzer Decl. at ¶ 16.
24 Version 304 (the version that Plaintiff uses as evidence of copyright infringement in his
25 declaration) became fully non-functional on October 10, 2006. Katzer Decl. at ¶ 17.

1 In November 2006, KAM released Decoder Commander, version 307. Decoder
2 Commander V307 contains only manufacturer's specifications data manually entered by KAM
3 and does not contain any manufacturer's specifications data copied from any JMRI Decoder
4 Definition Files. Katzer Decl. at ¶ 18 .KAM has ensured the inability to allegedly infringe JMRI
5 works because Decoder Commander V307 cannot read or write any decoder definition data files
6 from JMRI or anyone else. Katzer Decl. at ¶ 18. This is because Decoder Commander V307,
7 instead of using decoder definition data files, now uses a separate and new database containing
8 manufacturer's specifications data. Katzer Decl. at ¶ 18. This database is an SQL database
9 which means data is retrieved from and stored in the database using standard query language.
10 Katzer Decl. at ¶ 18. None of the JMRI Decoder Definition Files were used in any way to
11 construct this database. Katzer Decl. at ¶ 18. Using this type of Microsoft SQL database
12 technology was prohibitively expensive until 2006. Now, however, this type of SQL database is
13 cost effective and is a vastly superior technology when compared to the old versions of Decoder
14 Commander. Katzer Decl. at ¶ 18. Decoder Commander does not now include support for the
15 old decoder definition file based technology and will never revert to the old decoder definition
16 file based technology. Katzer Decl. at ¶ 20. This SQL database is not encrypted and is readily
17 viewable by anyone with appropriate software tools. Katzer Decl. at ¶ 20.

18 All software released prior to November 2006 (V306 and earlier) is incompatible with
19 any KAM software released after that date and all previous copies of Decoder Commander have
20 been recalled or destroyed. Katzer Decl. at ¶ 21. All registered customers and dealers have been
21 sent new updated replacement copies of Decoder Commander. Katzer Decl. at ¶ 21. Decoder
22 Commander is now a fully functional software program containing decoder definitions for those
23 decoders that it supports. Katzer Decl. at ¶ 22.

24 **SUMMARY OF THE ARGUMENT**

25 Plaintiff must demonstrate by a "clear showing" that he is entitled to a preliminary
26 injunction. *Mazurek v. Armstrong*, 520 U.S. 968, 972(1997). To prevail on his motion for a

1 preliminary injunction, Plaintiff must prove (1) irreparable harm, (2) a likelihood of success on
2 the merits, (3) that the balance of hardships tip in his favor, (4) that there is no adequate remedy
3 at law, and that (5) the public interest favors an injunction. *Amoco Production Co. v. Village of*
4 *Gambell, Alaska*, 480 U.S. 531, 542 (1987); *eBay, Inc. v. MercExchange, LLC.*, 547 U.S. 388,
5 391 (2006).

6 In this case, Plaintiff has failed to show (and cannot) show that he will suffer any harm at
7 all without a preliminary injunction. In contrast, Defendants will suffer substantial harm from
8 entry of an injunction. Additionally, Plaintiff can seek monetary damages for any alleged harm
9 and the public interest does not favor an injunction. Since all factors tip in Defendants favor,
10 Plaintiff's motion for a preliminary injunction should be denied.

11 ARGUMENT

12 I. Legal Standard

13 Defendants disagree with Plaintiff's characterization of the legal standard for granting a
14 preliminary injunction in this Circuit contained in Plaintiff's Motion for a Preliminary Injunction
15 (hereinafter "Motion") at 6, 12. Rather, a plaintiff seeking a preliminary injunction on a
16 copyright claim must establish (1) a likelihood of success on the merits; (2) a substantial threat
17 that plaintiff will suffer irreparable injury if the injunction is denied; (3) the balance of hardships
18 favors the plaintiff (i.e. that the threatened injury outweighs any damage the injunction might
19 cause the defendant); and (4) that the public interest favors an injunction. *eBay, Inc. v.*
20 *MercExchange, LLC*, 547 U.S. 388, 391 (2006) (test for permanent injunction); *Amoco*
21 *Production Co. v. Village of Gambell, Alaska*, 480 U.S. 531, 542 (1987) (test for preliminary
22 injunction); *Hologic, Inc. v. Cytoc Corp.*, 2008 U.S. Dist. LEXIS 36693, 2008 WL 1860035
23 (N.D. Cal. April 25, 2008). An injunction should only issue where the intervention of a court in
24 equity is essential in order effectually to protect property rights against injuries otherwise
25 irremediable. *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 311 (1982). A preliminary
26 injunction is a drastic and extraordinary remedy that is not to be routinely granted. *Intel Corp. v.*

1 *ULSI Systems Technology, Inc.*, 995 F.3d 1566, 1568 (Fed. Cir. 1993). A party seeking a
2 preliminary injunction must carry its burden of persuasion with a “clear showing.” *Mazurek v.*
3 *Armstrong*, 520 U.S. 968, 972 (1997). Lastly, a plaintiff must also satisfy the general equitable
4 requirements that legal remedies are inadequate to compensate for the injury. *eBay, Inc.*, 547
5 U.S. at 391; *Arcamuzi v. Continental Airlines, Inc.* 819 F.2d 935, 937 (9th Cir. 1987).

6 A preliminary injunction must be narrowly tailored to eliminate only the specific harm
7 alleged. It should be no more burdensome to a defendant than needed to promote relief.
8 *Meinhold v. United States*, 34 F.3d 1469 (9th Cir. 1994). A preliminary injunction cannot be
9 impermissibly vague and needs to give fair notice of what conduct will risk contempt, a
10 defendant cannot be left to guess. *Louis Epstein v. Kmart*, 13 F.3d 762 (3rd Cir. 1994).

11 Prior to *eBay*, a plaintiff seeking a preliminary injunction under federal copyright law
12 who demonstrated a likelihood of success on the merits of a copyright claim was entitled to a
13 presumption of irreparable harm. *Sun Microsystems, Inc. v. Microsoft Corp.*, 188 F.3d 1115,
14 1119 (9th Cir. 1999). In 2006, however, the Supreme Court eviscerated the presumption of
15 irreparable harm to motions for permanent injunctions in the patent infringement context,
16 holding that a Plaintiff seeking a permanent injunction must demonstrate that the traditional
17 equitable factors for granting an injunction have been met. *eBay Inc.*, 547 U.S. at 391. Since
18 that time, and subsequent to this Court’s August 17, 2007 Order denying Plaintiff’s original
19 motion for a preliminary injunction, numerous courts, including this Court, the Northern District
20 of California, have held that, as a result of *eBay*, the presumption of irreparable harm no longer
21 exists in the preliminary injunction context either. See e.g. *Hologic, Inc. v. Senorx, Inc.*, 2008
22 U.S. Dist LEXIS 36693 at *44-46 (N.D. Cal. April 25, 2008), *Tiber Labs, LLC v. Hawthorn*
23 *Pharms., Inc.*, 527 F. Supp.2d 1373, 1380 (N.D. Ga 2007); *Voile Mfg. Corp. v. Dandurand*, 551,
24 F.Supp.2d 1301, 1306 (D. Utah 2008); *Sun Optics, Inc. v. FGX Int’l, Inc.*, 2007 U.S. Dist.
25 LEXIS 56351; 2007 WL 2228569, at *1 (D. Del. August 2, 2007); *Torspo Hockey Int’l Inc. v.*
26 *Kor Hockey Ltd.*, 491 F. Supp. 2d 871, 881 (D. Minn. 2007); *Allora, LLC v. Brownstone, Inc.*,

1 2007 U.S. Dist. LEXIS 31343, 2007 WL 1246448 at *5 (W.D.N.C. April 27, 2007) (copyright
2 infringement). The Federal Circuit (citing its opinion in this case), after canvassing the Circuit
3 law, just days ago, affirmed that *eBay* applies to preliminary injunctions in both the patent and
4 copyright context. *Abbott Labs v. Sandoz*, --F.3d--, 2008 U.S. App. LEXIS 21880, *64-*87,
5 2008 WL 4636167 (Fed. Cir. October 21, 2008) (“as it stands, neither district courts, nor litigants
6 nor panels of this court, are provided with clear guidance, or any reason to reject the stricture of
7 *eBay*, 547 U.S. at 393, that “[n]othing in the patent Act indicates that Congress intended such a
8 departure from ‘the long tradition of equity practice.’” (at *86)).

9 Additionally, the Fourth Circuit Court of Appeals and two district courts in the Ninth
10 Circuit have recently held that no presumption of irreparable harm results from a finding of
11 liability in a copyright case following *eBay*. *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster*,
12 *Ltd.*, 518 F. Supp. 2d. 1197, 1210-1214. (C.D. Cal. 2007); *Designer Skin, LLC v. S&L Vitamins*,
13 *Inc.*, 2008 U.S. Dist. LEXIS 68467, 2008 WL 4174882 (D. Az. Sept. 5, 2008); *Chester Phelps*
14 *and Assoc., LLC v. Galloway*, 492 F.3d 532 (4th Cir. 2007). Indeed, in the *eBay* case itself, the
15 Supreme Court mentioned, in *dicta*, that principles of equity have always applied to the treatment
16 of injunctions under the Copyright Act. *eBay*, 547 U.S. at 392. Therefore, the presumption of
17 irreparable harm no longer applies to the preliminary injunction analysis for a copyright claim.

18 As a result, to prevail on his motion for a preliminary injunction based on alleged
19 copyright infringement, Plaintiff must now prove (1) irreparable harm, (2) a likelihood of
20 success on the merits, (3) that the balance of hardships tip in his favor, (4) that there is no
21 adequate remedy at law, and that (5) the public interest favors an injunction.

22 **II. Plaintiff will suffer no irreparable harm without injunctive relief**

23 Irreparable injury is the “single most important prerequisite for the issuance of a
24 preliminary injunction.” *Freedom Holdings, Inc. v. Spitzer*, 408 F.3d 112, 114 (2nd Cir. 2005).
25 Plaintiff must present evidence of actual injury to support claims of “irreparable injury,”
26 speculative losses are insufficient. *Goldie’s Bookstore, Inc. v. Sup. Ct.*, 739 F.2d 466, 472 (9th

1 Cir. 1984). Plaintiff has failed to allege any harm, much less irreparable harm, from Defendants'
2 alleged wrongdoing, and Plaintiff has failed to demonstrate that the threatened conduct continues
3 and that any future harm is “imminent.”

4 **A. Plaintiff has failed to allege any harm whatsoever**

5 Plaintiff has the burden of establish that he will be injured by the threatened conduct with
6 a “clear showing.” *Mazurek* 520 U.S. 968 at 972. However, Plaintiff’s 24-page declaration in
7 support of his motion for a preliminary injunction fails to allege *any* harm from the alleged
8 breach of Plaintiff’s copyright. There is not even merely one sentence addressing how Plaintiff
9 will be harmed in Plaintiff’s declaration. Plaintiff’s legal memorandum does contains a couple
10 oblique references to harm, *i.e.* that “delays result and inefficiency in development occurs” and
11 that “time lost in the open source development cycle due to license violations and Sec. 1202
12 violations cannot be regained...”. Plaintiff’s Motion at 13. While it is questionable whether
13 these oblique references amount to actual, imminent harm, and whether Plaintiff has standing to
14 sue for this harm of “delay” to the open source community when JMRI continues to release
15 product without delay (*See* Kazter Decl. at ¶ 42), this Court need not reach these questions. A
16 plaintiff must present evidence (*i.e.* a declaration or affidavit) demonstrating a likelihood that he
17 or she will be injured by the threatened conduct. *Doe v. National Board of Med. Examiners*, 199
18 F.3d 146, 152-153 (3rd Cir. 1999). An unsworn allegation in plaintiff’s legal memorandum is not
19 enough.

20 Since Plaintiff has failed to allege any harm, let alone irreparable harm, Plaintiff’s motion
21 for a preliminary injunction should be denied.

22 **B. Plaintiff has failed to demonstrate that a real and immediate threat still exists**

23 Plaintiff’s declaration uses version 304 of Decoder Commander as evidence of alleged
24 infringement. Jacobsen Decl. at ¶¶ 70-72. Version 304 became fully non-functional on October
25 10, 2006. Katzer Decl. at ¶ 17.

1 At this time, the most recent version of Defendants' Decoder Commander available (and
2 mailed as a replacement to all registered customers and dealers) does not contain any of the
3 decoder definition file data (*i.e.* manufacturer specification data) to which Plaintiff owns
4 copyright rights. Katzer Decl. ¶¶18-20. This version does not read, write or run previous
5 versions of Decoder Commander, including KAM's previous decoder template files containing
6 the manufacturer specifications data. Katzer Decl. ¶ 18. KAM's template verifier tool, the tool
7 that plaintiff alleges allows others to make unauthorized copies of plaintiff's copyrighted work
8 (Jacobsen Decl. at ¶ 74) is not contained in and does not function with the most recent versions
9 of Decoder Commander. Katzer Decl. ¶ 24. Additionally, this tool is not available on the KAM
10 website and has not been available since September 18, 2006. Katzer Decl. ¶ 16. Decoder
11 Commander now uses an entirely new database for its decoder template files. Katzer Decl. at ¶
12 18. There is absolutely no possibility that Defendants could or will use Plaintiff's alleged
13 copyrighted materials in the future, especially since such JMRI Decoder Definition Files, and all
14 other decoder definition files, are completely non-compatible with all versions of Decoder
15 Commander since November 2006. Katzer Decl. at ¶¶ 18-21.

16 Plaintiff has failed to allege that there is a real and immediate threat that the alleged
17 copyright infringement will continue. Past exposure to illegal conduct does not in itself show a
18 present case or controversy regarding injunctive relief. *City of Los Angeles v. Lyons*, 461 U.S.
19 95, 102 (1983). Here, Plaintiff's declaration fails to allege that Defendants are still infringing.
20 Plaintiff states that he is unsure whether Defendants' new database is infringing because he could
21 not get the latest version of Decoder Commander to work (through no fault of Defendants, see
22 Katzer Decl. at ¶ 25). Jacobsen Decl. at ¶ 97. Defendants have demonstrated that the new
23 database does not contain any of the allegedly infringing materials. Katzer Decl. at ¶¶ 18-21.
24 This database is not encrypted and includes textual information which is readily viewable by
25 anyone with appropriate software tools. Katzer Decl. at ¶ 20. Plaintiff then opines that KAM's
26 new Decoder Commander uses "infringing files" because it is "essentially unusable without

1 additional decoder definitions.” Jacobsen Decl. at ¶¶ 108, 110. As explained, KAM’s Decoder
2 Commander contains no allegedly infringing data files as the software now uses a new database
3 technology (based upon an SQL database) and does not use template files from JMRI or anyone
4 else. Katzer Decl. at ¶¶ 18-21. It is true that Decoder Commander Version 312 (and the present
5 version V400) include a limited number of decoder definitions. Katzer Decl. at ¶ 28. The
6 supported decoder definitions are only those for which KAM has permission to use the decoder
7 definitions from the copyright owner. Katzer Decl. at ¶ 28. KAM’s new Decoder Commander is
8 fully functional with the included decoder definitions for those decoders that it supports. Katzer
9 Decl. at ¶ 22.

10 Additionally, Plaintiff states that Defendants must be continuing to use “JMRI software
11 as a basis for their product” since they “have motive” to do so since Model Railroad News will
12 be reviewing both JMRI and KAM software in early 2009. Jacobsen Decl. at ¶ 110. Until
13 Katzer reviewed Jacobsen’s declaration, Katzer was unaware that Model Railroad News would
14 be reviewing JMRI and KAM software in 2009. Katzer Decl. at ¶ 27. Additionally, this
15 speculation about whether Defendants are using JMRI copyrighted material fails to meet
16 Plaintiff’s evidentiary burden of demonstrating that a real, imminent and significant harm exists
17 that could be remedied by injunctive relief. *Simula, Inc. v. Autoliv, Inc.* 175 F.3d 716, 725 (9th
18 Cir. 1999); *Midgett v. Tri-County Metro. Transp. Dist. of Oregon*, 254 F.3d 846, 850-851 (9th
19 Cir. 2001); *Goldie’s Bookstore, Inc.*, 739 F.2d at 472 (holding that speculative harm is
20 insufficient to establish irreparable harm).

21 Finally, Plaintiff alleges that KAM is distributing infringing software products via the
22 Link-Vet webpage. Jacobsen Decl. at ¶ 111. This is untrue, all CDs distributed through the
23 Link-Vet webpage contain only the newer (post-November 2006) versions of Decoder
24 Commander which do not contain, nor are compatible with, any of the allegedly infringing JMRI
25 decoder definition files. Katzer Decl. at ¶¶ 18-21.

1 Defendants have demonstrated, through the attached Declaration of Matthew Katzer, that
2 all versions of Decoder Commander subsequent to November 2006 do not contain any JMRI
3 Decoder Definition Files. Plaintiff has only provided mere speculation that Defendants are still
4 infringing. This does not satisfy Plaintiff's evidentiary burden. Since Plaintiff has failed to
5 demonstrate that a real, imminent and significant harm exists that could be remedied by
6 injunctive relief, Plaintiff's motion for a preliminary injunction should be denied.

7 8 **III. Defendants will suffer irreparable harm if an injunction enters**

9 This court must balance the competing claims of injury and consider the effect on each
10 party of the entry of a preliminary injunction. *Amoco Production Co. v. Village of Gambell,*
11 *Alaska*, 480 US at 542. Here, while Plaintiff has failed to allege any harm, Defendants will
12 suffer substantial harm from the entry of an injunction. The digitally controlled model train
13 software industry in the United States currently has two primary software suppliers. Katzer
14 Decl. at ¶ 31. KAM is one and the Plaintiff is the other. Katzer Decl. at ¶ 31. Subsequent to
15 November 2006, Defendants have not used any of the Plaintiff's allegedly copyrighted materials
16 and has no plans to do so in the future. Katzer Decl. at ¶¶ 18-21. Since KAM has not used
17 Plaintiff's allegedly copyrighted software since November 2006, and because KAM has no plans
18 to do so in the future, the Plaintiff's injunction request serves no purpose other than to adversely
19 affect KAM's business through this litigation. Katzer Decl. at ¶ 35.

20 Specifically, entry of an injunction would destroy Defendants most important business
21 relationship. Defendants' future is dependent on software it has been developing for a
22 distribution company ("Company") for the last twelve months. Katzer Decl. at ¶ 36. If the deal
23 between Defendants and the Company falls though, Defendants believe they will go out of
24 business. Katzer Decl. at ¶ 36. The Company and Defendants have studied the market and have
25 budgeted for sales of 45,000 units with revenue from the subscription agreements with customers
26 of \$290,000 annually by the end of the first year. Katzer Decl. at ¶ 37. The Company and

1 Defendants expect these revenues to grow by 30% annually thereafter and to be further
2 supplemented by the development of related products financed by these cash flows. Katzer Decl.
3 at ¶ 37. The Company is litigation adverse. Katzer Decl. at ¶ 38. The current litigation has not
4 yet destroyed Defendants' business relationship with the Company, though it has negatively
5 impacted the relationship. Katzer Decl. at ¶ 38. Defendants believe that the entry of the
6 injunction will probably destroy my business relationship with the company. Katzer Decl. at ¶
7 39. The Company has already indefinitely postponed all of our heretofore scheduled joint
8 meetings and planning sessions. Katzer Decl. at ¶ 39. Defendants believe that the Company did
9 this pending the resolution of the injunction motion. Katzer Decl. at ¶39. Defendants also
10 believe that Plaintiff's requested injunction is so broad that it would scare the Company or any
11 prospective business counterpart away from doing business with KAM, for fear of defending a
12 similar lawsuit from the Plaintiff and for fear of facing a similar barrage of negative publicity
13 from the Plaintiff, under the guise of litigation reporting. Katzer Decl. at ¶ 40.

14 Since Defendants' real harm clearly outweighs any harm (or lack thereof) to Plaintiff, an
15 injunction should not issue.

16 **IV. Plaintiff has not shown that he will succeed on the merits of his copyright**
17 **infringement claim**

18 **A. Plaintiff has failed to identify his copyrighted work**

19 Plaintiff has failed to identify the copyrighted work which he seeks to enjoin Defendants
20 from using. A *sin qua non* to a preliminary injunction is the identification of the work that is the
21 subject of the injunction. See *Louis Epstein*, 13 F.3d 762. Here, Plaintiff has submitted
22 numerous copyright registrations for "JMRI Program and Decoder Definitions" and "JMRI
23 Decoder Definitions." See Ex. C-I of Plaintiff's Second Amended Complaint. According to
24 Plaintiff there are 195 files subject to his copyright registration. Jacobsen Decl. at ¶ 8.
25 Plaintiff's proposed injunction seeks to enjoin Defendants from using "Plaintiff Robert
26 Jacobsen's copyrighted works entitled JMRI Program and Decoder Definitions." Proposed

1 Order at 2 [Dkt.# 239]. Plaintiff has failed to submit the actual works described by the phrase
2 “JMRI Program and Decoder Definitions.” Plaintiff has only submitted one decoder definition
3 file with his declaration-the QSI file. Jacobsen Decl., Exhibit AD. This is akin to Plaintiff
4 registering a copyright for a series of different books, then seeking to enjoin others from copying
5 any of the books, but without telling anyone which books are being allegedly infringed, or the
6 contents of the allegedly infringed books.

7 The proposed injunction also seeks to enjoin Defendants from, among other things,
8 “providing copyright management information that is false.” Proposed Order at 2 [Dkt.# 239].
9 This phrase is so hopelessly broad and vague that it would be impossible for Defendants or KAM
10 customers to be on notice of the enjoined conduct or for this Court to enforce the injunction. A
11 preliminary injunction must be narrowly tailored to eliminate only the specific harm alleged. It
12 should be no more burdensome to a defendant than needed to promote relief. *Meinhold*, 34 F.3d
13 1469. A preliminary injunction cannot be impermissibly vague and needs to give fair notice of
14 what conduct will risk contempt, a defendant cannot be left to guess. *Louis Epstein*, 13 F.3d 762.
15 Since Plaintiff has failed to identify his copyrighted work, and since Plaintiff’s requested
16 injunction is impermissibly vague, the motion for a preliminary injunction should be denied.

17 **B. Plaintiff is not the copyright holder of some of the underlying material**

18 This problem of narrowly tailoring an injunction is further highlighted by the fact that
19 Plaintiff is not the copyright owner of some of the works to which he is claiming copyright
20 ownership. The JMRI Decoder Definition Files are not foundational works and they incorporate
21 many manufacturer’s specifications data initially created by multiple manufacturers as well as
22 specifications data created by the National Model Railroad Association. Katzer Decl. at ¶ 12.
23 For example, Plaintiff uses the “JMRI Decoder Definition File, QSI_Electric.tpl.xml” to
24 highlight instances of Defendants alleged copyright infringement of “variable structure,
25 selection, naming and default variable values.” Jacobsen Decl. ¶ 72. Exhibit AD contains the
26 Decoder Definition File and Exhibit AE contains KAM’s comparable work from the Version 304

1 of Decoder Commander (which became non-functional on October 10, 2006, Katzer Decl. at ¶
2 17). Paragraphs 71-73, 80, 109 of Jacobsen's Declaration discuss various instances of
3 Defendants' alleged infringement of this JMRI Decoder Definition File by comparing similar
4 lines of text in Exhibits AD and AE and conclude that KAM had copied numerous fields of text
5 from the "author of the JMRI file."

6 However, Plaintiff does not have any rights to the QSI terms and associated values
7 described in his declaration. The variable structures, selection, naming and default variable
8 values contained in the JMRI Decoder Definition File are copied directly from the NMRA DCC
9 Reference Manual for QSI Quantum HO Equipped Locomotives-Version 3.0 (QSI Manual).
10 Katzer Decl. at ¶ 51, Exhibit E. This QSI Manual was originally created by QSI Industries, Inc.
11 and then published in February 2005 by QSI Industries, Inc. Katzer Decl. at ¶ 51. The JMRI
12 Decoder Definition File containing this information was subsequently published in June 2005.
13 Katzer Decl. at ¶ 51. Exhibits F through AO to the Katzer Declaration demonstrate that the
14 textual information used by Plaintiff as examples of alleged infringement of JMRI intellectual
15 property was copied by JMRI directly from the QSI Manual into the JMRI Decoder Definition
16 File.

17 KAM is the owner, via assignment, of all copyright rights in the QSI Manual. Katzer
18 Decl. at ¶ 48, Exhibit C. KAM registered its copyright rights with the United States Copyright
19 Office and obtained Copyright Registration Number TX 6-445-094, effective November 13,
20 2006. Katzer Decl. at 48. A copy of this registration is attached as Exhibit D to the Declaration
21 of Katzer. This QSI Manual copyright protects expressions of code, structure, sequence, and
22 organization for programming QSI decoders. Katzer Decl. at ¶ 49. Based on this copyright,
23 KAM has the right to use all of the QSI material in its Decoder Commander software. Katzer
24 Decl. at ¶ 52.

25 Plaintiff by failing to identify with any specificity the copyrighted work, and has not
26 demonstrated that he will succeed on the merits of his copyright infringement claim. Defendants

1 have demonstrated that Plaintiff is not the copyright owner of the QSI works, and the works that
2 Plaintiff chose as his best example of Defendants alleged misconduct. Defendants have
3 demonstrated that they have the right to use the works contained in the QSI Manual and Plaintiff
4 has no copyright rights in this material. Since Plaintiff has failed to prove that he is the
5 copyright owner of the allegedly infringing works, Plaintiff's motion for a preliminary injunction
6 should be denied.

7 **V. Adequate monetary damages are available to Plaintiff should he prevail**

8 The availability of a legal remedy indicates that a party's injury is not irreparable. *FDIC*
9 *v. Faulkner*, 991 F.2d 262, 265 (5th Cir. 1993). The fact that plaintiff can seek adequate
10 compensatory damages through the Copyright Act in the ordinary course of this litigation weighs
11 heavily against entry of a preliminary injunction. *Sampson v. Murray*, 415 U.S. 61, 90 (1974)
12 ("the possibility that adequate compensatory or other corrective relief will be available at a later
13 date, in the ordinary course of litigation, weighs heavily against a claim of irreparable harm.")

14 Plaintiff's alleged harm in his legal memorandum is "time lost in the open source
15 development cycle due to license violations and Sec. 1202 violated." Plaintiff's Motion for
16 Preliminary Injunction at 13. Plaintiff asserts that this time cannot be regained through a
17 monetary award. *Id.* Plaintiff does not explain, at all, how Defendants alleged infringement
18 allegedly slowed down the open source development cycle. The Supreme Court has discussed
19 whether "lost time" can be sufficient to support a finding of irreparable harm, stating "[the
20 temporary loss of income, ultimately to be recovered, does not usually constitute irreparable
21 injury. * * * "The key word in this consideration is irreparable. Mere injuries, however
22 substantial, in terms of money, *time* and energy necessarily expended * * * are not enough. The
23 possibility that adequate compensatory or other corrective relief will be available at a later date,
24 in the ordinary course of litigation, weighs heavily against a claim of irreparable harm."
25 (emphasis added) *Sampson*, 415 U.S. at 90 (1974) (*quoting Virginia Petroleum Jobbers*
26 *Association v. Federal Power Commission*, 259 F.2d 921, 925 (D.C. Cir. 1958).

1 Here, Plaintiff has the possibility of recovering adequate compensatory damages and has
2 pled actual and statutory damages under the Copyright Act in his Second Amended Complaint.
3 As Nimmer explains, the Plaintiff will be entitled to recover the actual damage that the plaintiff
4 incurred and defendants' alleged profits "to the extent that such profits have not already been
5 taken into account in computing the [plaintiff's] actual damages." 4-14 Nimmer on Copyright §
6 14.01.

7 To date, KAM has sold approximately 65 copies of the allegedly infringing Decoder
8 Commander amounting to total gross sales of approximately \$1,200.00. Katzer Decl. at ¶ 23.
9 Based on this, and discovery conducted in this case, Plaintiff will be entitled to present evidence
10 at the trial on the merits of his actual damages and of the Defendant's profits from the alleged
11 infringing activity. The availability of a damage award is an adequate remedy. Accordingly,
12 the Court should deny Plaintiff's request for a preliminary injunction.

13 **VI. The public interest does not support entry of an injunction**

14 Since Defendants removed all allegedly infringing material from their products in
15 November 2006, the public interest does not support entry of a preliminary injunction. Rather,
16 entry of the proposed preliminary injunction is not in the public interest. The proposed
17 injunction is so vague and broad it is impossible for KAM customers to know what conduct will
18 risk contempt. A preliminary injunction must be narrowly tailored to eliminate only the specific
19 harm alleged. It should be no more burdensome to a defendant than needed to promote relief.
20 *Meinhold*, 34 F.3d 1469. A preliminary injunction cannot be impermissibly vague and needs to
21 give fair notice of what conduct will risk contempt, a defendant cannot be left to guess. *Louis*
22 *Epstein*, 13 F.3d 762.

23 For example, the proposed injunction seeks to enjoin KAM customers from "providing
24 copyright information that is false" without identifying to what the term "copyright information"
25 refers. Proposed Order at 2. Additionally, as discussed above, the proposed injunction seeks to
26 enjoin customers from "reproducing Plaintiff Robert Jacobsen's copyrighted works entitled JMRI

1 Program and Decoder Definitions, or JMRI Decoder Definitions” without identifying the content
2 of this work. Since the proposed injunction is hopelessly vague and overbroad, Defendants
3 respectfully request that the motion for a preliminary injunction be denied.
4

5 **VII. Plaintiff’s claim is moot**

6 Additionally and separate and apart from the preliminary injunction factor test discussed
7 above, KAM has clearly shown that the allegedly wrongful behavior cannot reasonably be
8 expected to recur. As discussed in detail above, KAM has not distributed any allegedly
9 infringing product since November 2006. KAM’s products now look to a new database using a
10 new technology and there is no reason that KAM would ever revert to the old technology.
11 Katzer Decl. at ¶¶18-21. If a defendant shows that subsequent events have made it absolutely
12 clear that the allegedly wrongful behavior cannot reasonably be expected to recur, then this
13 showing renders moot a motion for injunctive relief. *Federal Trade Commission v. Affordable*
14 *Media, LLC*, 179 F.3d 1228, 1238 (9th Cir. 1999); *see also Barnes v. Healy*, 980 F.2d 572, 580
15 (9th Cir. 1992) (holding that voluntary cessation of allegedly illegal conduct renders moot a
16 challenge to such conduct when (1) there is no reasonable expectation that the wrong will be
17 repeated and (2) interim relief or events have completely and irrevocably eradicated the effects
18 of the alleged violation). Therefore, since the issue is moot, an injunction should not enter.

19 **VIII. Conclusion**

20 Since Plaintiff has failed to show that he will be harmed (irreparably or otherwise) by the
21 allegedly infringing conduct, since Defendants will be substantially harmed by entry of an
22 injunction, since Plaintiff has failed to demonstrate that he will succeed on the merits of his
23 copyright infringement claim, since Plaintiff has an adequate remedy at law, and since
24 Defendants have long ago made it absolutely clear that the allegedly infringing activity will not
25 reoccur, Defendants respectfully request that Plaintiff’s motion for a preliminary injunction be
26 denied.

1 Dated November 7, 2008.

2 Respectfully submitted,

3 /s/ Scott Jerger

4 R. Scott Jerger (*pro hac vice*)
5 Field Jerger LLP
6 610 SW Alder Street, Suite 910
7 Portland, OR 97205
8 Tel: (503) 228-9115
9 Fax: (503) 225-0276
10 Email: scott@fieldjerger.com

11 **CERTIFICATE OF SERVICE**

12 I certify that on November 7, 2008, I served Matthew Katzer's and KAM's Memorandum
13 in Opposition to Plaintiff's Motion for a Preliminary Injunction on the following parties through
14 their attorneys via the Court's ECF filing system:

15 Victoria K. Hall
16 Attorney for Robert Jacobsen
17 Law Office of Victoria K. Hall
18 3 Bethesda Metro Suite 700
19 Bethesda, MD 20814

20 /s Scott Jerger

21 R. Scott Jerger (*pro hac vice*)
22 Field Jerger LLP
23
24
25
26