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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

ROBERT JACOBSEN, Plaintiff, v. MATTHEW KATZER, et al., Defendants.	No. C-06-1905-JSW **DECLARATION OF ROBERT JACOBSEN IN SUPPORT OF MOTION FOR PRELIMINARY INJUNCTION** Courtroom: 2, 17th Floor Judge: Hon. Jeffrey S. White

I, ROBERT JACOBSEN, have personal knowledge to the facts stated herein and hereby declare as follows:

I am a party to this action. I am submitting this Declaration in Support of the Motion for Preliminary Injunction.

JMRI CREATES DECODER DEFINITION FILES

1. I am model railroader. As part of my model-railroading hobby, I have contributed to the development of the underlying National Model Railroad Association (NMRA) Digital

Command Control (DCC) standards used by many model railroaders and present in many types of model railroad equipment. I have served as the Chair of the DCC Working Group within the NMRA. I worked directly with many types of digital model railroad equipment, including all common types of DCC systems. I have used and observed many types of model railroad software. In several cases, I have helped people debug other types of model railroad software.

2. I am involved in the Java Model Railroad Interface (JMRI) open-source software project. I have been involved since approximately the beginning of the effort in 2001, and am currently one of the leaders of it. I have written parts of the code and documentation. I have helped others write parts. I have given public talks about the use and structure of the software. I have periodically built versions of the JMRI software for general use, and posted them to the SourceForge web site for downloading by the public. The JMRI software is popular among its users.

3. To allow more realistic operation, certain model railroads use decoders (computer chips) in locomotives and other equipment to control their operation. These decoders need to be properly configured to get the most possible use from them. The process of configuring a decoder is referred to as "programming" it.

4. There are many different types of decoders, and they vary greatly in complexity. The configuration information for them also varies greatly.

5. One of the first parts of the JMRI Project was DecoderPro, a tool that makes it to easier to program decoders. It does this by allowing the person using it to select options and settings with language naturally understood by model railroaders, rather than having to specify numeric values to be stored in computer locations. DecoderPro uses Decoder Definition Files to help with the programming.

6. Model railroaders write Decoder Definition Files that describe their understanding of how to program each type of decoder. DecoderPro and other programs can then use this information when assisting a user who is programming a decoder.

7. I first wrote some of these files in the summer of 2001.

8. A large number of other model railroaders have also written JMRI Decoder Definition files.

9. Neither Defendant Katzer nor any agent or employee from Defendant KAMIND Associates, Inc. ever contacted me for authorization to use the JMRI Decoder Definition Files.

10. Neither Defendant Katzer nor any agent or employee from Defendant KAMIND Associates, Inc. ever contacted me to negotiate a contract to use the JMRI Decoder Definition Files.

DEFENDANTS ANNOUNCE PLANS FOR THEIR DECODER TEMPLATES

11. On April 24, 2005, Defendant Katzer published an announcement of KAM's "Train Server 3.0" product. Exhibit A is a copy of that announcement. It says in part:

> Our latest product release is "Decoder Commander®". This software is design [sic] to provide the most intuitive programmer on the market. Our users tell us that Decoder Commander far surpasses any other solution available in the market (free or commercial). We are very pleased with the command station integration and ease of use that this software provides. Decoder Commander will set the new programmer standard.

and

> Build 30 has the following features: Decoder Commander® – a distributed GUI programmer for loco programming allowing importing of ours or other third party decoder templates

and

> Decoder Commander will be available to all KAM subscription customers at a reduce [sic] price prior to June 30, 2005. This offer will only be available to subscription customers, for orders on the web, electronic download only. The special introduction price will be 40% below the retail price of the software. You may order Decoder Commander on June 1, 2005 from <http://www.kamind.com/>www.kamind.com web site. Decoder Commander® suite will also be available from our dealers after June 30, 2005. Decoder

> Commander® Suite will retail for $59.

Ex. A (emphasis added).

12. At the National Model Railroad Association convention in Cincinnati during July 2005, Defendants presented their "Decoder Commander" product.

13. Defendant Katzer was scheduled to give a talk entitled "Decoder Commander – Easy Tool for Programming Decoders" at the convention. Ex. B, at 7.

14. Exhibit C is a copy of a KAM sales brochure. It carries a copyright date of 2005. It says in part:

> Decoder Commander uses a set of configurable templates that you can customize for your own use. KAM ships all of the popular templates with the software, and provides additional templates on www.kamind.com. Decoder commander also supports a full set of programming tools that allows you to import a template from different decoder programming software packages.

Ex. C (emphasis added).

15. Exhibit D is a copy of the KAM manual for their Decoder Commander product. They claim that they created the template files. It says in part:

> All decoders have unique characteristics. KAM has created a set of Decoder Templates that has these characteristics in a XML configuration file.

Ex. D, at 11 (emphasis added).

16. No credit or acknowledgement was given to the JMRI Project.

DEFENDANTS' COPYRIGHT INFRINGEMENT DISCOVERED

17. Aware of Defendant Katzer's past theft of JMRI intellectual property, I began to investigate in late spring 2006 whether KAMIND Associates, Inc.'s products were using JMRI intellectual property. I bought a copy of Decoder Commander in June 2006.

18. I received a package containing a CD ROM labeled TS3.30.304, the "304 CD"

19. I reviewed the contents of the KAM 304 CD. As one of the leaders of the JMRI Project, I am familiar with the file names of the project's software. When I reviewed the names of the decoder template files on the KAM 304 CD, I immediately recognized the names of the

JMRI Decoder Definition Files.

20. I compared the JMRI Decoder Definition Files with the decoder template files on the KAM 304 CD. Attached as Exhibit E is a true and accurate copy of the JMRI Decoder Definition File, QSI_Electric.xml. Attached as Exhibit F is a true and accurate copy of Defendants' decoder template, QSI_Electric.tpl.xml, from the KAM 304 CD.

21. Aside from technical format differences, I found numerous instances of copying. I made the following discoveries:

- Each template file on the KAM 304 CD and each JMRI Decoder Definition file contains a version number and modification date. These vary from Decoder Definition File to Decoder Definition File. The version number in each file on the KAM 304 CD was identical to the version number in the corresponding JMRI Decoder Definition File. The modification date in each file on the KAM 304 CD was identical to the modification date in the corresponding JMRI Decoder Definition file. Compare Ex. E at 1 with Ex. F at 1.
- Within individual files, there are numerous examples of information directly copied. As one example of many, I compare here the JMRI "QSI_Electric.xml" file and the corresponding "QSI_Electric.tpl.xml" file on the KAM 304 CD. In one section, these files describe the 7th output of the decoder and what it can do. The evidence of copying in just this small area of the files includes:
  - A typographical error appears exactly the same in the two files – instead of using "output" (for the output of the decoder), the name is given as "outout". Compare Ex. E at 8 (bottom) with Ex. F at 29 (quarter page from top).
  - One choice for this element is "Stobe Ditch Lights" – another misspelling, since it should be "Strobe Ditch Lights". This misspelling is also present in the file on the KAM 304 CD. Compare Ex. E at 9 (near top) with Ex. F at 29 (near bottom).
- The author of the JMRI file used "and" and "+" to represent the word "and".

This appears in the following choices:

- "Directional Headlight + Directional Mars Light"
- "Directional Headlight + Directional Ditch Lights"
- "Scale mph Report and Status Report"
- "Squealing Brakes + Air Brakes".

These variations are also present in the file on the KAM 304 CD. Compare Ex. E at 9 (near top) with Ex. F at 29 (bottom).

- The author of the JMRI file used lower case in "Scale mph Report and Status Report" although one might expect the "MPH" to be capitalized. It is also present in lower case in the file on the KAM 304 CD. Compare Ex. E at 9 (near top) with Ex. F at 29 (bottom).

A large number of additional similarities of this type are present in this specific pair of files.

- Each JMRI Decoder Definition File contains a copyright notice and an author name. These are missing from the KAM template files. Compare Ex. E at 1 (top – near date) with Ex. F at 1 (top – should have been near date).

22. Similar evidence of copying exists in all approximately 100 files.

23. The KAM 304 CD contains an installer which unpacks and installs Decoder Commander on a Windows PC. I ran that installer and found that it had installed a software tool called "Template_verifyer.exe".

24. The instructions for the use of this tool describe its use as:

> The Template Verification Tools is a tool that KAM has released to allow you to create your own template file, and use third party templates, and convert them into a format that is usable by Decoder Commander.

Ex. D, at 30 (emphasis added).

25. I ran the tool. It presented a tab labeled "JMRI", and the option to "Convert JMRI template into a KAM template". A true and accurate copy of this screen is attached as Exhibit G.

26. After running the tool, I determined the tool's purpose is to convert JMRI Decoder

Definition Files to Defendants' decoder templates.

27. I compared the JMRI Decoder Definition Files and the files produced by the software tool. Attached as Exhibit H is a true and accurate copy of the decoder template output from Defendants' software tool when processing the QSI_Electric.xml JMRI file. The output files are in a different technical format than the template files on the KAM 304 CD, but contain the same information expressed in the same way. I again found numerous instances of copying:

- The version number and modification date were preserved intact from the input JMRI Decoder Definition File to the output decoder template. However, the version author – present in the same element as the version number and modification date within the input JMRI Decoder Definition File – was stripped out by the software tool and not present in the output decoder template. Compare Ex. E at 1 (top, near date) with Ex. H at 1 (missing, should be near date).
- The copyright notice from the input JMRI Decoder Definition File was not copied to the output decoder template created by the software tool. Compare Ex. E at 1 (top) with Ex. H at 1 (missing, should be at top).
- Within individual files, there are numerous examples of information directly copied. As one example of many, I compared the JMRI "QSI_Electric.xml" file and the corresponding template output file. In one section, these files describe the 7th output of the decoder and what it can do. The evidence of copying in just this small area of the files includes:
  - A typographical error appears exactly the same in the two files – instead of using "output" (for the output of the decoder), the name is given as "outout". Compare Ex. E at 8 (bottom) with Ex. H at 24 (top).
  - One choice for this element is "Stobe Ditch Lights" – another misspelling, since it should be "Strobe Ditch Lights". This misspelling is present in both the JMRI file and the template output file. Compare

Ex. E at 9 (near top) with Ex. H at 24 (lower mid-page).

- The author of the JMRI file used "and" and "+" to represent the word "and". This appears in the following choices:
  - "Directional Headlight + Directional Mars Light"
  - "Directional Headlight + Directional Ditch Lights"
  - "Scale mph Report and Status Report"
  - "Squealing Brakes + Air Brakes".

  These variations are present in both the JMRI file and the template output file. Compare Ex. E at 9 (near top) with Ex. H at 24 (lower mid-page).
- The author of the JMRI file used lower case in "Scale mph Report and Status Report" although one might expect the "MPH" to be capitalized. It is present in lower case in both the JMRI file and the template output file. Compare Ex. E at 9 (near top) with Ex. H at 24 (lower page).

A large number of additional similarities of this type are present in this specific pair of files.

28. Again, similar evidence of copying exists in all approximately 100 files.

29. I obtained other copies of KAMIND Associates, Inc.'s products and found the same files and software tool.

DEFENDENTS OBTAINED THE JMRI DECODER DEFINITION FILES

30. After learning of the copying, I searched for evidence that Defendant was aware of the JMRI Decoder Definition Files and the license governing permission for their use.

31. In an internet discussion on May 2, 2003, I replied to Defendant Katzer that "JMRI uses XML files to store state information (decoder definitions, layout configuration, etc), …". Attached as Exhibit I is a true and accurate copy of this posting.

32. On May 10, 2003, Defendant Katzer replied to another post in that same discussion. In part, that reply said "Like wise, the xml definitions you use in jmri for the data files I suspect that you would like to see them submitted." Attached as Exhibit J is a true and accurate copy of this posting.

33. On August 8, 2003, I replied to a question in an email post by Defendant Katzer with information about the JMRI Decoder Definition Files and where to obtain additional information, including the files. Attached as Exhibit K is a true and accurate copy of this posting.

34. Defendant Katzer is a member of the JMRI users electronic discussion group on which the JMRI Decoder Definition Files are discussed. He has posted to it numerous times in 2004 and 2005, indicating that he read the group during that period.

35. On March 30, 2004, Defendant Katzer wrote to me via direct email. Attached as Exhibit L is a true and accurate copy of this email. In it, he made the statement that "Currently you are supply [sic] software under the GNU license". His statement was incorrect, as JMRI uses a different license. I brought this to his attention explicitly, including both pointers to the full license and discussion of its terms, in an email dated March 30, 2004. Attached as Exhibit M is a true and accurate copy of this email.

36. On September 7, 2004 in another internet discussion, Defendant Katzer indicated his familiarity with the terms of the JMRI license by saying "JMRI license agreement requires them to ship source, and dictates what can be charge [sic]." Attached as Exhibit N is a true and accurate copy of this posting.

37. On July 25, 2005, Defendant Katzer posted to a NMRA Working Group mailing list to start a discussion about creating a common format for decoder information. It included the statement:

> "I had an old action item from 2004, to develop an XML cv format that the NMRA, mfg and software developers cuydl use as a standard.
>
> ...
>
> - KAM has a format that we use for our Decoder Commander.
>
> - JMRI folks have a format that they use for decoder pro.
>
> Does this make sense to merge the two together to create a NMRA document that defines what the format should be, that way we can all use the same data format?"

Attached as Exhibit O is a true and accurate copy of this posting.

38. The JMRI software, including Decoder Definition Files, is freely available for download via the internet. For privacy reasons we keep no records of who has downloaded the software. Each downloaded copy of the software includes the entire collection of current JMRI Decoder Definition Files as plain text. The files are also individually available for download.

39. Defendants' lawyer wrote to me on August 24, 2005 to describe their "analysis of (my) existing implementation of the JMRI software". Attached as Exhibit P is a true and accurate copy of this letter. To make their analysis, they must have downloaded the JMRI software, in which case they would have received copies of the entire collection of current JMRI Decoder Definition Files.

40. I attended the NMRA DCC Working Group meeting in Austria during September of 2004. At that meeting, I met Robert Bouwens of Switzerland. We had previously corresponded over email. He gave me a business card which identified him as working for KAM.

41. On December 31, 2001 Robert Bouwens had posted a note about looking at specific JMRI Decoder Definition Files on the web. Attached as Exhibit Q is a true and accurate copy of this posting.

42. On August 15, 2005, Robert Bouwens posted a note about the Decoder Definition Files and templates. Attached as Exhibit R is a true and accurate copy of this posting. It contains the following statement: "When you look at the jmri defs for the gold decoder then you see my personal view of open source ;-)", followed by lines quoted from the JMRI Decoder Definition File for the Lenz Gold decoder. Ex. R, at 1.

43. That August 15, 2005 posting then shows a template in the KAM format that contains information copied from the JMRI "Umelec_ATL2064.xml" Decoder Definition File. Ex. R, at 3-4.

44. The August 15, 2005 posting also contains the statement:

> "I've written a converter to make jmri templates a bit more strict.
>
> The panel info will also be stripped.
>
> But it need additional work to complete the resulting template..."

Ex. R, at 4.

45. Defendant Katzer and Defendant KAM's employee both knew about the JMRI Decoder Definition Files, the license governing their use, had obtained copies of them, and had intentionally created a tool to convert them.

DEFENDANTS CONTINUE THEIR INFRINGING ACTIVITY

46. In late August 2006, I obtained a copy of an updated version of Defendants' products. This contained a CD labeled TS4.30.305, the 305 CD.

47. Many of the decoder template files from the KAM 304 CD were gone, but some were still present.

48. I reviewed those that were present and found the same evidence of copying as I had on the KAM 304 CD.

49. The software tool was not present on the KAM 305 CD. Instead, there was a note that said (emphasis added): "Smart decoder Editor (.net 2.0) v1.0 is released. Editor can read 3rd party decoder templates. The editor is available as a seperate [sic] download from our website."

50. In late September 2006, after I charged Defendants with copyright infringement, Defendants sent me another CD labeled TS4.30.306, the KAM 306 CD.

51. I reviewed the KAM 306 CD. I found that one file which had been named in the Amended Complaint had been removed. There was a note explaining this as "Incorrect decoder template shipped with software." However, other files which I and others originally authored were present. Evidence of copy is still present in those files, and the authors' names and copyright information has been stripped. The tool remains available on the web.

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I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed this 24th day of October, 2006, in Berkeley, California.

By _____
Robert Jacobsen