

Exhibit A

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

13 ROBERT JACOBSEN,) No. C06-1905-JSW
14)
Plaintiff,)
15 v.) **[PROPOSED] SECOND AMENDED**
16) **COMPLAINT FOR DECLARATORY**
MATTHEW KATZER, et al.,) **JUDGMENT, VIOLATIONS OF**
17) **COPYRIGHT AND FEDERAL**
Defendants.) **TRADEMARK LAWS, AND STATE LAW**
18) **BREACH OF CONTRACT**
19)
20)
Courtroom: 2, 17th Floor
Judge: Hon. Jeffrey S. White

21 Plaintiff, Robert Jacobsen, alleges as follows:

22 I. NATURE OF ACTION

- 23 1. Defendant Matthew Katzer has stolen a fledgling open source software group's intellectual
24 property for his own and his company, Defendant KAMIND Associates, Inc.'s, economic
25 gain. This lawsuit seeks to stop him.
26 2. In 2000, Robert Jacobsen and other software developers founded the Java Model Railroad
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1 Interface (JMRI) Project¹. The JMRI Project relies on the voluntary contributions of its
2 members to produce software used by model train hobbyists. In return for the efforts of its
3 members, the JMRI Project licenses its software to the general public under an open source
4 license. Common to open source licenses are conditions requiring free
5 distribution/redistribution of the software, that the source code be provided along with the
6 actual object code or executable file, and that any derivative work also be licensed as an
7 open source licensed product.²

8 3. Open source software is relatively new but of increasing importance to the public, business
9 community and the government. Some better known open source licensed software include
10 Apache Web Server³, Mozilla⁴ and Linux.⁵ Some lesser known, but equally important,
11 open source projects include Samba⁶ and MySQL.⁷ The impact that these various open
12 source projects have had on the software industry as a whole cannot be overstated. The
13 Apache Web Server application runs approximately 60 percent of the web servers on the
14 Internet⁸ and Linux is projected to have a market value of \$35 billion by 2008.⁹

15 4. Common to all these various open projects, is that each started out small, and grew through
16 the contributed time, effort, and labor of various software developers. As an example, the
17 Linux operating system began as a hobby project undertaken by Linus Torvolds.¹⁰
18 Torvolds wrote the first version of the Linux operating system and posted it to an online
19 news group for comment and review. Software developers reviewed his code and critiqued
20 it. Through this review, the Linux operating system grew more sophisticated, and robust to
21 the point where now today Linux is an enterprise-grade operating system running
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23 ¹ JMRI Project, [at](http://jmri.sourceforge.net/apps) <http://jmri.sourceforge.net/apps> (last visted Sept. 10, 2006)

24 ² Open Source Initiative definition, [at](http://www.opensource.org/docs/definition.php) <http://www.opensource.org/docs/definition.php> (last visited Sept. 10, 2006).

25 ³ Apache project, [at](http://www.apache.org) <http://www.apache.org> (last visited Sept. 10, 2006)

26 ⁴ Mozilla project, [at](http://www.mozilla.org) <http://www.mozilla.org> (last visted Sept. 10, 2006)

27 ⁵ Linux project, [at](http://linux.org) <http://linux.org> (last visited Sept. 10, 2006)

28 ⁶ Samba project, [at](http://us3.samba.org/samba) <http://us3.samba.org/samba> (last visited Sept. 10, 2006)

⁷ MySQL project, [at](http://www.mysql.com) <http://www.mysql.com> (last visited Sept. 10, 2006)

⁸ Apache project a success [at](http://news.netcraft.com/archives/web_server_survey.html) http://news.netcraft.com/archives/web_server_survey.html (last visited Sept. 10, 2006)

⁹ Corporate Overview March 2005, [at](http://www.osdl.org/docs/corporate_overview_march_2005.ppt#31) http://www.osdl.org/docs/corporate_overview_march_2005.ppt#31 (last visited September 10, 2006)

¹⁰ Linux kernel description, [at](http://en.wikipedia/wiki/Linux_kernel) http://en.wikipedia/wiki/Linux_kernel (last visited Sept. 10, 2006)

1 everything from cell phones to super computers.

2 5. Currently, various Internet websites such as SourceForge¹¹ and Freshmeat¹² host open
3 source projects. Thousands of open source software projects exist. SourceForge, for
4 example, hosts more than 100,000 projects. Projects often start as informal groups of
5 software developers who create code to meet a specific need. Developers work on the
6 project because they enjoy it. These Internet websites not only host these various open
7 source projects, but in effect serve as incubators for various open source technology and the
8 intellectual property associated with these projects. The projects on these websites generate
9 large amounts of copyrighted materials in the form of source code, numerous trademarks
10 used to designate a project and its products, and other types of intellectual property.
11 Copyrighted source code is typically licensed under an Open Source license such as the
12 Artistic License or GPLv2.

13 6. Open source software exists side by side with proprietary software, whose code is kept
14 secret from the public. An important aspect of open source software, and its associated
15 licensing scheme, that separates it from other software and their associated licensing
16 schemes, is reciprocity, where developers share their updates and new code with each other
17 to increase the rate of technical advance.¹³ Here, Defendant Mathew Katzer (“Katzer”) has
18 taken valuable intellectual property from the JMRI project for his own and his company’s
19 economic gain, and has not only contributed nothing in return, but sought to attack
20 members of the JMRI project. As with many informal groups, JMRI Project developers
21 neither initially registered copyrights nor trademarked their projects or product names, nor
22 filed patent applications for inventions they created. Nor did they incorporate as
23 businesses. Some projects do later become corporations and run businesses, and thus have
24 typical legal protections available to them. But what of the fledgling open source projects,
25 like the JMRI Project, and their individual software developers, that create valuable

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27 ¹¹ SourceForge.net, at <http://sourceforge.net> (last visited Sept. 10, 2006)

¹² Freshmeat, at <http://freshmeat.net> (last visited Sept. 10, 2006)

¹³ Martin Frink, *The Business and Economics of Linux and Open Source* 39 (2003).

1 intellectual property which is later stolen and used by others for their own profit? Or
2 worse, patented and used against the very members of the open source project who created
3 it? This case is about the legal protections – intellectual property, in particular – that are
4 available to open source software projects in their infancy, and the individual developers
5 who comprise these projects.

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7 **II. THE PARTIES**

8 7. Robert Jacobsen (“Jacobsen”) is an individual living in Berkeley, California. He works for
9 the University of California, Berkeley and the Lawrence Berkeley National Laboratory
10 (“Lab”) of the University of California. He teaches physics at the university. He is a model
11 train hobbyist who has written, with others, open source software code called JMRI (Java
12 Model Railroad Interface) which allows him and other model train hobbyists to control
13 hardware on model train layouts. Jacobsen, a primary developer and distributor of the
14 software through the JMRI Project, makes this software available on the Internet, free of
15 charge, but allows hobbyists to donate to support the project. His experience with model
16 train control systems is such that he is an expert in the field. He is a member of the
17 National Model Railroad Association, and its Digital Command Control (DCC) Working
18 Group, a select group of manufacturers and expert model train hobbyists, who work
19 together to develop written guidelines for the industry. Manufacturers and other producers
20 of hardware and software use these standards so that their products will interface
21 seamlessly with other products. Model train hobbyists use these software and hardware
22 products to simulate – with great detail – the operation of life-size trains from a given time
23 frame and location, such as Northern California rail lines along the Pacific Coast during the
24 1950s.
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- 1 8. Matthew Katzer (“Katzer”) is an individual living in Oregon. He is also a model train
2 hobbyist who has written software code for controlling model train hardware on a layout.
3 He has obtained several utility patents, including one or more in which he captured JMRI
4 intellectual property, and has several patent applications pending at the time this second
5 amended complaint is filed. His experience with model train control systems is such that he
6 is also an expert in the field. On information and belief, Defendant Matthew Katzer
7 became involved in the National Model Railroad Association in the late 1980s or early
8 1990s. Like Plaintiff, Katzer is also a member of the DCC Working Group.
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- 10 9. KAMIND Associates, Inc. (“KAM”) is an Oregon corporation with its principal place of
11 business at Hillsboro, Oregon. It does business as KAM Industries. On information and
12 belief, KAM is owned by Katzer and another person, Barbara Dawson. On information and
13 belief, KAM is in the business of selling products embodying methods which Katzer said
14 were his inventions, and which Katzer claimed in the patents issued to him. KAM’s
15 products range in list price from \$49 to \$249.
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17 III. JURISDICTION AND VENUE

- 18 10. This action arises under patent laws of the United States (35 U.S.C. §§ 1 *et seq.*), the
19 Lanham Act (15 U.S.C. §§ 1051 *et seq.*), copyright laws of the United States (17 U.S.C. §§
20 1 *et seq.*) and laws authorizing declaratory judgment actions (28 U.S.C. §§ 2201-2202).
21 Because of a series of demand letters, bills and a FOIA request directed at Jacobsen’s
22 employer, Defendants’ conduct has put Jacobsen in reasonable and serious apprehension of
23 imminent suit for infringement of U.S. Patent No. 6,530,329. Based on the allegations in
24 Paragraphs 15 through 449, there is a conflict of asserted rights between Jacobsen and
25 Defendants Katzer and KAM, and thus an actual controversy exists between Jacobsen and
26 Defendants Katzer and KAM as to the validity, scope, enforceability and infringement of
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1 the '329 patent. Defendants' conduct has violated federal copyright laws, or in the
2 alternative, breached contracts in violation of California state law.

3 11. This Court has personal jurisdiction over the defendants. Jacobsen is the main contact for
4 the JMRI Project. Katzer has repeatedly directed charges of infringement against Jacobsen,
5 and interfered with his employment. He converted copyrighted JMRI Project files to his
6 own files, actions which are outside the scope of the software license. Defendants
7 committed various acts in an attempt to force Jacobsen to shutdown his software or force
8 him to pay Katzer and KAM royalties on Katzer's fraudulently obtained and invalid
9 patents. Thus, Defendants' conduct resulted in apprehension of suit and injury in this
10 jurisdiction.
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12 12. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331, 1338, 2201, and
13 2202, and supplemental jurisdiction, 28 U.S.C. § 1367.
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15 13. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b) and (c).

16 IV. INTRADISTRICT ASSIGNMENT

17 14. This case is exempt from Local Rule 3-2 because it is an intellectual property matter. The
18 clerk assigned it to the San Francisco division.

19 V. FACTS

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21 15. Plaintiff begins with the state of the prior art. Long before this dispute arose, and well
22 before Katzer filed his first patent applications, others practiced the method Katzer charged
23 Jacobsen with infringing. Thus, the "invention" in claim 1 of the '329 patent was common
24 knowledge in the model railroading community. All documents referred to in this Second
25 Amended Complaint are incorporated by reference.

26 16. Claim 1 of the '329 patent states:

27 A method of operating a digitally controlled model railroad comprising the steps of:
28 (a) transmitting a first command from a first program to an interface; (b)

1 transmitting a second command from a second program to said interface; and (c)
2 sending third and fourth commands from said interface representative of said first
3 and second commands, respectively, to a digital command station.

4 17. A command is a pulse, signal, or set of signals initiating one step in the performance of a
5 controlled operation.

6 18. A program is a set of instructions for carrying out a task on a computer – these may be in
7 machine code or in the program language. A program is the whole set of instructions – not
8 a subroutine or a portion of the program. However, claim 1 requires that the program send
9 signals to an interface. A static set of written instructions does not send commands by
10 itself. It only does so when invoked. Hence, a program here is a self-contained set of
11 instructions and its internal data and state, and typically takes the form of a process or task
12 that holds this state and data and runs the program.

13 19. An interface is a shared boundary across which information is passed.

14 20. A digital command station is hardware and/or software that receives commands, converts
15 them into digital signals, and uses the digital signals to control the model train layout.

16 21. Several types of prior art are relevant to claim 1 of the '329 patent. Among them are
17 client-server networking, digital command control, and real – often called “prototype” –
18 railroads.
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21 Client-server networking

22 22. One of the first computer networks was ARPANET, the precursor to today's Internet.
23 ARPANET consisted of a number of computers, connected to each other, in many
24 locations. Created in the late 1960s, ARPANET permitted one computer to send a
25 command to another computer, and the other computer to send the command to a computer
26 or device on its local network. Thus, using ARPANET, someone could perform all steps of
27 claim 1 of the '329 patent, except sending a signal to a digital command station. Digital
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- 1 command stations were not created until the late 1980s. ARPANET is one type of network.
2 Another is a client-server network.
- 3 23. After first appearing in the late 1970s, client-server networking architectures became
4 popular in the late 1980s and early 1990s as many applications were migrated from
5 centralized minicomputers and mainframes to networks of personal computers.
- 6 24. The design of applications for a distributed computing environment required that they
7 effectively be divided into two parts: client (front end) and server (back end). The network
8 architecture on which they were implemented mirrored this client-server model, with a
9 user's personal computer (the client) typically acting as the requesting machine and a more
10 powerful server machine - to which the client was connected via a communications network
11 - acting as the supplying machine.
- 12 25. Because of their scalability, client-server networks are suitable for mid-sized and large
13 businesses, having servers ranging in capacity from high-end personal computers to
14 mainframes.
- 15 26. A predecessor to client-server networking for model railroads appeared in a 1977 article in
16 Byte magazine. There, two model railroaders, John Hart and Ed Badger, used two
17 terminals to direct commands to an interface, which sent commands to a model train layout.
18 As noted, digital command stations did not exist at the time, and personal computers were
19 not in widespread use.
- 20 27. Client-server networking itself appeared in model train layouts in 1985, when Dr. Bruce
21 Chubb began publishing a series of articles in Model Railroading magazine. In his first
22 article, he showed two model railroaders each using radio controlled handheld devices,
23 which sent commands to an interface connected to a computer. Dr. Chubb's article
24 described building and programming the computer so that it could issue the commands to
25 the model train layout. Dr. Chubb, in 1989, published a book on creating interfaces that
26 could, among other things, control model train layouts. Dr. Chubb's book suggested that a
27 model railroader would want to update a computer screen prior to sending a command to a
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layout.

28. In 1993, Dr. Roger Webster of Millersville University, Pa., conceived an idea to teach his computer science students about client-server networking through using client programs and a server to run a model train layout using Marklin digital control. Like Plaintiff, Dr. Webster used Java to write programs to control the trains. Dr. Webster filed a National Science Foundation education grant application on or about May 11, 1993 for computers and other hardware to use in his classes. The abstract of the grant stated: “This project improves the quality of instruction in computer science by providing students with a powerful computer workstation and a laboratory of three real-time platforms from which to study and experiment with the techniques of real-time systems: (1) a real-time model railroad switching yard system,....” The work was to be completed by November 1995. Dr. Webster sought another grant on or about June 7, 1996. This grant was to be completed by June 30, 1998. On information and belief, he and his students in 1994 began publicly using client-server networking to send commands to a Marklin digital command station to control the model train layout.

29. Dr. Webster was not the only professor to use model train control to teach his students. By 1991 at the latest, Dr. John McCormick of the State University of New York at Plattsburgh had given assignments to his students to run model trains on a model train layout using multiple computers and digital command stations. Dr. McCormick published several papers describing his students’ work. A newspaper reported on Dr. McCormick’s classes.

30. Roland Rehmet, a researcher at TU Munich, a university in Germany, created a program for running a model train layout, using a network system and a Marklin digital command station. In March 1996, Rehmet made his software available on the web.

31. While teaching at University of Michigan in 1994, Dick Volz, a past president of the IEEE Robotics and Automation Society, gave assignments to his students to create client-server software to run model trains on a layout. In the mid-1990s, Volz also had made client-server model train control software available on the web.

1 32. Others used client-server networking to run model train layouts, in connection with
2 research in other fields. In 1995, Dr. Konrad Froitzheim of Germany, as a part of a
3 research project for displaying digital video, set up a model train layout to have something
4 interactive to video and transmit. He wrote software that could be downloaded from the
5 Internet to run the trains. The software operated on a user's computer, and sent commands
6 through the Internet to Dr. Froitzheim's web server, which acted as an interface. The web
7 server sent the commands to a digital command station which executed the commands on
8 the model train layout. This website and layout remained in operation until 2005. Dr.
9 Froitzheim presented this work at IEEE conferences, and published the work in journals.
10 Katzer knew about Dr. Froitzheim because Marklin newsletters, which Katzer subscribed
11 to, covered Dr. Froitzheim's work.

12 Model railroads, digital command control, and networking

13 33. In the late 1980s and early 1990s, manufacturers began to use digital communications
14 packets to control model trains layouts. This is called digital command control. The
15 advantages of digital control were that a specific decoder in a model train could receive
16 digital signals and adjust the train's actions accordingly. Prior to digital control, electric
17 signals sent to the railway track caused all trains on a track to speed up or slow down at the
18 same rate. Individual control was possible only if the track were segmented and a train
19 operated on one segment of the track. Pre-digital control required additional wiring, and
20 controlling software and hardware to model action of real railroads. With the rise of digital
21 control, this complexity was no longer needed.

22 34. In the early 1990s, the National Model Railroad Association started a Digital Command
23 Control Working Group, consisting of various manufacturers and expert model railroaders.
24 The group considered various digital command control (DCC) standards. It adopted a
25 standard in 1993.

26 35. A. J. Ireland, of Digitrax, developed various DCC systems and began selling them by 1993.
27 A year later, Ireland developed a simple computer network, called LocoNet, to interconnect
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1 parts of the model railroad system – one or more throttles (hand-held computer devices)
2 used to control individual trains, personal computers to control individual trains, and a
3 command station to route control signals to one or more trains. About the same time,
4 Defendant Katzer signed Digitrax’s nondisclosure agreement and received detailed
5 proprietary information about LocoNet, so Katzer could make his software work with
6 LocoNet. In October 1997, Ireland filed U.S. Provisional Application No. 60/062,100 on
7 advances over LocoNet. In Figure 2, Ireland showed personal computers, handheld
8 devices, radio devices, and other devices which controlled model trains on layouts through
9 a digital command station, called primary control unit 22. The application described
10 hardware or software called Attached Logic Modules, or ALMs, which acted as interfaces
11 between programs and digital command stations. As noted in the application, ALMs, such
12 as Locomotive Control ALM 23 and Turnout Control ALM 24 in Figure 2, receive signals
13 from programs on personal computers 2, and send signals to the primary control unit 22.
14 “An ALM may be implemented as a sub-element of the logic or software of a system
15 hardware implementation ... or may be a physically separate piece of hardware and
16 software connected to the network to specifically implement the desired type of ALM
17 feature.” Primary control unit 22 then sends the commands to the model train layout.

18 36. In 1994, Strad Bushby developed a way for model railroaders to control which commands
19 would be executed in a digital command control system. It was activated by setting what
20 came to be known among model railroaders as the “Bushby bit”. When the Bushby bit was
21 set, commands to the layout from computer programs would be directed to a specific
22 program, which would reformat them and forward them to the layout. Thus, this program
23 received commands from other programs, acted as an interface, and sent commands to the
24 model train layout.

25 37. In 1995, Bushby set up in his basement a network of multiple interconnected computers to
26 run a model train layout. He used digital control. His activities were advertised in
27 programs at area model railroad conventions beginning in 1996, and tour buses of model
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1 railroaders came to his home to see his control systems set-up. Bushby discussed his model
2 train control systems with Katzer before Katzer filed his patent applications. Aware of
3 Bushby's invention, Defendant Katzer nevertheless claimed programs sending commands
4 to an interface, which sent the commands to a digital command station.

5 38. Mr. Juergen Freiwald of Egmatung, Germany wrote and sold software under the names
6 "Railroad and Co." and "TrainController". This software competes with KAM's products,
7 and Katzer included information about it in his presentations at NMRA conventions in 1997
8 and 1998. In 1996, Railroad & Co. offered its version 2.1a from various webpages at
9 www.he.net/~freiwald/pages/library.htm, www.he.net/~freiwald/pages/tech.htm,
10 www.he.net/~freiwald/pages/railco.htm, and www.he.net/~freiwald/pages/goody.htm.
11 These pages were captured by Internet Archive in late December 1996. This version
12 provided a Railroad & Co. Library. The Library acted as an interface between programs
13 and a digital command station. Model railroaders could write a program, such as a program
14 written in C++, to send commands to the Library. They could also send commands to the
15 Library via their Railroad & Co. software. The Library manages the commands and sends
16 them to the digital command station. Thus, the C++ program could send a first command to
17 the Library. Railroad & Co. software could send a second command to the Library. The
18 Library could send third and fourth command representative of the first and second
19 commands, to the digital command station for execution on the model railroad layout.

20 39. In 1993, Dr. Hans Tanner of DigiToys released WinLok 1.5, a software program which
21 allowed model train control. In 1995, Dr. Tanner released WinLok 2.0 which incorporated
22 other advances in train control. The WinLok programs are known to model train
23 enthusiasts, and were reviewed in Model Railroading magazine in March 1995 (WinLok
24 1.5) and December 1995 (WinLok 2.0). The programs compete with KAM's products.
25 Through the DCC Working Group, Katzer knew Dr. Tanner, his company and his products.
26 Katzer also discussed WinLok in his 1997 and 1998 NMRA presentations. Katzer is
27 familiar with Model Railroading magazine, because he advertised in it, and provided free
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1 CDs of his product with the magazine, and because his product was discussed in the same
2 article that WinLok 1.5 was reviewed. In his patent applications, Katzer referred to
3 software published by DigiToys, but he intentionally did not identify it on the Information
4 Disclosure Sheet nor did he provide a copy of it or its manual to the patent examiner. The
5 only DigiToys software programs that Katzer could have been referring to is the WinLok
6 series.

7 40. In late 1997, Dr. Tanner posted WinLok 2.1, including its manual showing model
8 railroaders how to use the software, for download from the DigiToys website. This manual
9 is available on Internet Archive, from www.digitoys-systems.com/winlok21e.html. This
10 version showed how model railroaders could create “Timetable” programs, which
11 controlled the speed of model trains. The manual discussed “Timetable” programs on page
12 45. “Timetable” programs look similar to train schedules that real railroads and their
13 customers use. “Timetable” programs are sets of instructions, which send commands to
14 WinLok layout drivers. The WinLok layout drivers then send the commands to the layout.
15 The manual discussed layout drivers on page 153. Multiple “Timetable” programs could be
16 used simultaneously, or a “Timetable” program could run a model train simultaneously
17 with a throttle program running another model train. Thus, the WinLok 2.1 manual
18 discloses (1) a “Timetable” program sending a first command to a layout driver interface,
19 (2) a second “Timetable” program, or a throttle program sending a second command to the
20 same layout driver interface, and (3) the layout driver interface sending third and fourth
21 commands representative of the first and second commands to a digital command station
22 for execution on a model train layout.

23 41. On information and belief, in early 1997, Tanner created a model train networking system
24 called Railroad Open System Architecture, or ROSA. Incompatibility between model train
25 manufacturers had long been a problem. ROSA was Tanner’s solution, and it used a
26 specific protocol, CORBA, to communicate between incompatible hardware. Tanner gave
27 a presentation on ROSA at the July 1997 NMRA convention. Katzer was in the audience.
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1 ROSA featured client-server networking, and using databases to store information about the
2 state of devices – trains, railyard switches, lights, bridges, etc. – on the model train layout.
3 In his patent application, Katzer acknowledged the existence of ROSA when he referred to
4 a software program from DigiToys and that it could be used in networks, and that it used
5 CORBA (although Katzer misspelled it as COBRA). This is ROSA. Then Katzer claimed
6 the methods that WinLok and ROSA could practice, as his own invention.

7 42. During 1997, Stanley Ames, Rutger Friberg and Edward Loizeaux wrote a book called
8 “Digital Command Control - the comprehensive guide to DCC” which described various
9 aspects of model train control systems. Among others, the book described methods for
10 queuing commands to the railroad and sending them in a different order so that high
11 priority commands were handled first. Katzer received a manuscript of this book in
12 February 1998 to review, and signed its Foreward, which stated, “The manufacturers and
13 DCC Working Group volunteers listed below and on the next page have reviewed the
14 contents of this book, and affix their signatures as indication of their support for the
15 information provided.” Katzer received a copy of the first edition, autographed “To my
16 friend Matt, with regards, Rutger”, by co-author Rutger Friberg. KAM has offered the
17 book for sale. However, as will be shown, Katzer did not produce this book to the Patent
18 Office until a patent examiner independently located it and used it as a basis for rejecting
19 claims in one of Katzer’s patent applications. Only then did Katzer produce the reference
20 to other examiners reviewing his patent applications.

21 Real railways and trains

22 43. Because model trains and their layouts are models of real railways and trains, model
23 railroaders look to real railways and trains to replicate the real world on a model scale.
24 Defendants themselves advertise that model railroaders who buy their software can control
25 their trains like real trains. So, like many model railroaders, Defendant Katzer looks to real
26 trains to create his models.

27 44. On information and belief, real – or as they are called by model railroaders, prototype –
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1 railroads began using computers and networking to control trains in the early 1980s.
2 45. Numerous vendors created software for running real trains on real world tracks. The one
3 most relevant to this lawsuit is Train Track, of Newport Beach, California.
4 46. By 1993, Train Track was offering for sale TDDPro32, software for use with Windows NT in
5 controlling real trains. The software came with a help manual. Train Track had a slide
6 show presentation that showed its software in use in New York City, Kansas City and other
7 cities. One slide showed that TDDPro's client-server networking was in public use by, at the
8 latest, 1995. Thus, two programs sent commands to an interface which itself sent
9 commands to be executed on the railway. In 1998, Defendant Katzer signed a contract with
10 Train Track to incorporate TDDPro in his software products. Thus, Katzer knew that Train
11 Track had used client-server networking with real trains years before his first patent
12 application. He also knew that model railroaders, like himself, look to real trains systems to
13 create models. But until he filed his anti-SLAPP declarations and needed to show good
14 faith, Katzer never provided any information about Train Track to the Patent Office. Only
15 then did he bury information about Train Track with about 5,000 to 6,000 pages of
16 references. He never specifically told the examiners about the Train Track deal and how he
17 incorporated TDDPro – the basis for his “invention” – in his software.

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19 Defendants, and their prosecuting attorney Russell, commit inequitable conduct and fraud on the
20 Patent Office

21 47. Throughout nearly 10 years of examination of Katzer patent applications, Defendant Katzer
22 and his prosecuting attorney, Kevin L. Russell, committed inequitable conduct and fraud on
23 the Patent Office.

24 48. Katzer filed numerous applications for patents on model train control systems, beginning
25 with U.S. Application No. 09/104,461 (“the ‘461 application”), filed on June 24, 1998,
26 which matured into U.S. Patent No. 6,065,406 (“the ‘406 patent”).

27 49. From the ‘461 application stemmed several continuation applications, from which issued a
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1 number of other patents, including the '329 patent, the patent-in-suit. The '329 patent
2 issued from U.S. Application No. 10/124,878 ("the '878 application"), which was filed
3 April 17, 2002 and claimed benefit of U.S. Application No. 09/858,222 only. The '329
4 patent stated '222's filing date was April 17, 2002. The '222 application, in turn, claimed
5 benefit of the filing date of U.S. Application No. 09/550,904, which claimed benefit of the
6 filing date of the '461 application. A chart of Katzer's U.S. patent applications and their
7 corresponding patents is attached as Appendix A. The '329 patent is Appendix B.

8 50. While the '878 application was pending, Russell, acting on behalf of Defendants, filed a
9 lawsuit against DigiToys in September 2002. In doing so, Defendants and Mr. Russell took
10 positions in court that were inconsistent with those that they were then advocating before
11 the Patent Office, but they never told the Patent Office.

12 51. Katzer and Russell filed patent applications, including the '878 application, which they
13 knew claimed prior art, but Katzer and Russell did not tell the examiners that they had
14 proposed claims they knew were invalid under Sections 102 and 103, and were not
15 described, enabled, or otherwise supported by the specification.

16 52. These actions were no accident, but a pattern of intentional deception practiced on the
17 examiners throughout the prosecution of Katzer's patent applications.

18 53. Mr. Russell, again on Defendants' behalf, submitted 5,000 to 6,000 pages of references to
19 examiner to consider in pending applications. Some of these were in Defendants or Mr.
20 Russell's possession for several years. They submitted these references only after they
21 were accused of inequitable conduct.

22 54. Neither Russell or Katzer ever told examiners about other examiners' rejection, or a
23 reference used to reject claims even though related patents were still open for prosecution
24 on the merits.

25 55. In multiple applications, Mr. Russell, on Defendants' behalf, submitted claims that were
26 invalid for double patenting under Sec. 101, but never told the examiners. As a result, one
27 patent, U.S. Patent No. 7,177,733, invalid for Sec. 101 double patenting over U.S. Patent
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No. 6,909,945, issued.

Russell and Katzer withhold material information regarding DigiToys from PTO examiners

56. While the '878 application was pending, Russell and Katzer took positions inconsistent with those they advocated before the Patent Office, and failed to tell the Patent Office about them.

57. By mid-2002, Mr. Russell obtained three patents on Mr. Katzer's behalf, and filed several continuations, one of which later issued as the patent-in-suit in Jacobsen v. Katzer.

58. In the first application, U.S. Application No. 09/104,461 filed on June 24, 1998, Mr. Russell described a DigiToys reference in state of the prior art section of the Background of the Invention.

59. Thus, this reference is applicant-admitted prior art.

60. The DigiToys reference is a software program called WinLok.

61. Mr. Russell never produced to the examiner any DigiToys/WinLok reference manuals nor the software program itself – until he was accused of inequitable conduct in 2006 when he included it with the 5,000 to 6,000 pages of references.

62. In the '461 application, Mr. Russell described advantages relating to a resident external controlling interface, and asynchronous communication, as advances over the prior art.

63. This application later issued as the U.S. Patent No. 6,065,406.

64. In U.S. Application No. 10/124,878, one of '461's great-grandchild continuation applications, Mr. Russell removed references in the claims to interfaces that were resident, external and controlling, and communication that was asynchronous. The '878 application later issued as the '329 patent.

65. A comparison between two claims from the '406 patent and the '329 patent shows the differences. Claim 27 of the '406 patent was one of the claims that were asserted in Katzer v. Tanner. Claim 10 is its corresponding claim in the patent-in-suit.

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'406	Comparison – strikethrough is text deleted from '406, added text is in brackets.	'878 application, which issued as patent-in-suit, '329
27. A method of operating a digitally controlled model railroad comprising the steps of:	27: [10.] A method of operating a digitally controlled model railroad comprising the steps of:	10. A method of operating a digitally controlled model railroad comprising the steps of:
(a) transmitting a first command from a first client program to a resident external controlling interface through a first communications transport;	(a) transmitting a first command from a first client program to a[n] resident external controlling interface through a first communications transport ; [and]	(a) transmitting a first command from a first program to an interface; and
(b) receiving said first command at said resident external controlling interface; and	(b) receiving said first command at said resident external controlling interface; and	N/A
(c) said resident external controlling interface selectively sending a second command representative of said first command to one of a plurality of digital command stations for execution on said digitally controlled model railroad based upon information contained within at least one of said first and second commands.	(c) [(b)] said resident external controlling interface selectively sending a second command representative of said first command to one of a plurality of digital command stations for execution on said digitally controlled model railroad based upon information contained within at least one of said first and second commands.	(b) said interface selectively sending a second command representative of said first command to one of a plurality of digital command stations based upon information contained within at least one of said first and second commands.

66. Thus, the '406 claim 27 is within the scope of claim 10 of the '878 application.

67. In September 2002, while he was prosecuting the '878 application, Mr. Russell, on Defendants' behalf, filed suit against DigiToys, Inc., which produced and sold the DigiToys program, WinLok, described in the state of the prior art. The case was Katzer and KAMIND Associates, Inc. v. Tanner, Case No. CV02-1293 (D. Or.).

68. Mr. Russell accused DigiToys of infringing the '406 patent, as well as U.S. Patent Nos. 6,270,040 and 6,267,061, through DigiToys' sale and distribution of WinLok 2.1.

69. Russell also sent a cease and desist letter dated Sept. 18, 2002 to DigiToys, in which Russell accused DigiToys of infringing claim 27 of the '406 patent, among other claims and

- 1 patents. Plaintiff focuses on claim 27.
- 2 70. Key to this claim is sending commands to a “plurality of digital command stations”.
- 3 71. WinLok has a feature, called MultiDrive, which allows the program to send commands to
- 4 more than one digital command station.
- 5 72. The MultiDrive feature acts as an interface between the WinLok program and a digitally
- 6 controlled model railroad, and uses configurable rules to determine which of two or more
- 7 command stations should be sent any given command.
- 8 73. On information and belief, WinLok 1.5 was first offered for sale in 1993.
- 9 74. WinLok 1.5 was reviewed in Model Railroading magazine in March 1995, which states that
- 10 WinLok was available for \$139.95.
- 11 75. MultiDrive is discussed in the second column of the first page of the review. Engine
- 12 Commander, the other software that the first paragraph of the article mentions, belongs to
- 13 Defendants.
- 14 76. On information and belief, MultiDrive is the feature that performed the accused function.
- 15 77. Russell has neither accused another WinLok feature of infringing this claim nor denied that
- 16 MultiDrive wasn’t the accused feature.
- 17 78. Dr. Hans Tanner, the owner of DigiToys, wrote Mr. Russell back in early October 2002.
- 18 79. He stated that the accused features in WinLok 2.1 were present in WinLok 1.5 and WinLok
- 19 2.0, which has first been offered for sale and sold, with their help manuals, in 1993 and
- 20 1995, respectively.
- 21 80. Dr. Tanner produced the magazine article referred to above, and sales receipts.
- 22 81. He also described other software programs, including those from Railroad & Co., that he
- 23 said were § 102(b) art.
- 24 82. He also accused Katzer of not meeting Katzer’s duty under 37 CFR Sec. 1.56 – the rule
- 25 central to inequitable conduct.
- 26 83. Tanner said that the DigiToys program referred to in the Katzer specifications could only be
- 27 WinLok.
- 28

- 1 84. The letters and appendices were also sent to the file wrappers of the ‘406, ‘040, and ‘061
2 patents as citations to art.
- 3 85. Neither these nor any WinLok reference manual were given to the examiners until
4 Defendant Katzer and Mr. Russell produced the 5,000 to 6,000 pages of references in May
5 and June 2006.
- 6 86. The significance of these WinLok references was never explained – they were merely
7 produced and listed on two IDSs the Office received May 25, 2006 and June 26, 2006.
- 8 87. A basic principle of patent law is, that which infringes if later, anticipates if earlier.
- 9 88. In filing the lawsuit against Tanner, Russell and Defendant Katzer admitted they believed
10 that WinLok infringed.
- 11 89. Katzer and Russell learned – if they didn’t know earlier since WinLok is applicant-admitted
12 prior art – that WinLok predated the ‘406 patent by more than 1 year. Thus, Russell and
13 Katzer must have known that, under their own reasoning, WinLok 1.5 and 2.0 would have
14 been Sec. 102(b) art.
- 15 90. Although not mentioned in Tanner’s letter, WinLok 2.1 itself was first offered for
16 download in December 1997 from the Internet, and thus was, at a minimum, Sec. 102(a)
17 art, which Katzer and Russell should have disclosed to the examiners.
- 18 91. At this same time, Mr. Russell, acting on Defendants’ behalf, was prosecuting the ‘878
19 application, in which claim 10, shown above, was pending.
- 20 92. As shown, claim 27 asserted against Tanner is within the scope of claim 10.
- 21 93. Mr. Russell responded to Dr. Tanner’s letter, but he never did produce to the examiner any
22 of the references that Dr. Tanner identified, nor did he ever file a Request for Continued
23 Examination (RCE) to continue prosecution of the ‘878 application.
- 24 94. Instead, faced with evidence that he had taken positions in court inconsistent with those he
25 argued before the Patent Office – that is, that the claim 10 in the ‘878 application was an
26 advance over WinLok – Mr. Russell never brought the information to the attention of the
27 examiner.
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1 95. Instead, he did nothing – except drop the lawsuit against DigiToys.

2 96. On Mar. 11, 2003, the ‘878 application with its Claim 10 issued as the ‘329 patent, now the
3 patent-in-suit in Jacobsen v. Katzer.

4 97. On information and belief, Defendant Katzer and Mr. Russell intended to deceive the
5 examiner, as bringing this to the examiner’s attention might put a halt to keeping alive a
6 chain of continuation applications.

7 98. Because inequitable conduct as to one claim in a patent makes all claims in that patent
8 unenforceable, and Defendant Katzer and Mr. Russell committed inequitable conduct
9 during the prosecution of claim 10 of the ‘878 application, claim 1 of the ‘329 patent is
10 unenforceable.

11 99. Withholding the details surrounding the Katzer v. Tanner lawsuit from the Patent Office
12 was no isolated sleight of hand, but a part of a continuous pattern by Defendants and their
13 prosecution counsel, Kevin L. Russell.

14 Katzer and Russell withhold material references from examiners

15 100. As shown earlier, from the time he filed his first patent application, Katzer knew
16 about a number of references – Railroad & Co., ROSA, the Bushby bit, LocoNet, Webster’s
17 public use of client-server networking to run model trains, WinLok 2.1, and Train Track –
18 that were material to the patentability of claim 1 of the ‘329 patent. Not only that, but both
19 Defendant Katzer and Mr. Russell knew about the WinLok series and ROSA – Katzer,
20 because he discussed them at his NMRA presentations, and Russell, because he described
21 them in the State of the Prior Art section of the Background of the Invention, and because
22 of the Tanner lawsuit.

23 101. Instead of telling the examiners about these references, Defendant Katzer and Mr.
24 Russell concealed the references – until forced to reveal them after Plaintiff accused both
25 Katzer and Russell of inequitable conduct.

26 102. When Katzer and Russell finally revealed these references, the result was fatal to
27 one important patent application. Claims in U.S. Application No. 10/889,995 were identical
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1 to those in the '329 patent, and they were rejected twice as obvious (1) over the newly
2 submitted prior art, and (2) WinLok and ROSA, applicant-admitted prior art. Despite
3 several attempts, Defendants and Mr. Russell never got the pending claims allowed, and
4 acquiesced in the rejections by failing to respond to them. On July 6, 2007, the patent
5 examiner noted the application as abandoned.

6 103. When he filed his first patent application, Katzer knew about Railroad & Co.'s
7 software. He discussed it in his 1997 and 1998 NMRA presentations. Katzer never
8 disclosed this Sec. 102(b) bar to the examiner.

9 104. Katzer knew about ROSA. He was present when Dr. Tanner gave his presentation
10 on ROSA to the NMRA DCC Working Group in July 1997. He referred to ROSA in his
11 1998 NMRA presentation. The description in the state of the prior art section of the Katzer
12 specification refers to DigiToys' networking capabilities. This is ROSA. Under June 2006,
13 neither Defendant Katzer nor Mr. Russell gave this presentation to the examiner.

14 105. Katzer signed a nondisclosure agreement with Digitrax, and received detailed
15 specifications about LocoNet, including the ALMs. Katzer needed this information so that
16 he could make his software work with LocoNet. Katzer never disclosed this Sec. 102(b)
17 bar to the examiner.

18 106. Katzer asked Bushby about his model train computer network and the Bushby bit.
19 Katzer never disclosed this Sec. 102(b) public use bar to the examiner.

20 107. As shown in his anti-SLAPP declaration, Katzer received information from Dr.
21 Webster that Dr. Webster had, beginning in 1993 or 1994, given class assignments for
22 client-server networking in model train layouts. Katzer never disclosed this Sec. 102(b)
23 public use bar to the examiner.

24 108. Defendant Katzer and Mr. Russell discussed WinLok in the state of the prior art,
25 and then turned around and sued DigiToys for the very features that Defendant Katzer and
26 Mr. Russell had previously admitted had been created by others before Defendant Katzer's
27 "invention". In the case of WinLok 2.1, Defendant Katzer never filed a Rule 131
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1 declaration to swear behind the reference.

2 109. Defendant Katzer, and on information and belief, Mr. Russell, never told the
3 examiner about Defendants' deal with Train Track, and that Train Track practiced client-
4 server networking with real railroads more than 1 year before Katzer's first patent
5 application.

6 110. Thus, both Defendant Katzer and Mr. Russell knew that Katzer was not the sole
7 inventor of the "inventions" filed in the Katzer patent applications.

8 111. The pattern of inequitable conduct and fraud on the Patent Office extends to the
9 prosecution of other patent applications.

10 Contrary to MPEP, Russell never informed examiners about other examiners' rejections

11 112. Examiners never learned about each other's rejections in co-pending related
12 applications because Defendant Katzer and Mr. Russell, although required by MPEP §
13 2001.06(b), never told them about the rejections.

14 113. In examining the '995 application, Examiner Nguyen rejected in the Aug. 7, 2006
15 Office Action all claims as unpatentable over the recently submitted 5,000 to 6,000 pages of
16 references.

17 114. In the Dec. 21, 2006 Office Action, Examiner Nguyen rejected all claims as obvious
18 in light of applicant-admitted prior art, including the DigiToys reference.

19 115. Other related patent applications were pending. Some had specifications that were
20 identical to the specification in the '995 application, or included large portions of the
21 specification that was in the '995 application. Some patents in the chain of continuations
22 had terminal disclaimers to the same patent, '406, that issued from the first Katzer patent
23 application, '461.

24 116. Examiner Beaulieu was examining the '815 and '794 applications, which are
25 continuations of the '461 application that the '995 application was also a continuation of.
26 See Appendix A.

27 117. Examiner Le was examining the '227 application, whose ancestral application has a
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- 1 terminal disclaimer to the patent, '406, that issued from the '461 application.
- 2 118. A large portion of the '227 application has language that is identical to the '461
3 application.
- 4 119. The '329 patent, whose claims were copied into the '995 application, has a terminal
5 disclaimer to the '406 patent. Claim 1 of the '406 patent is within the scope of claim 1 of
6 the '329 patent, and claim 27 of the '406 patent is within the scope of claim 10 of the '329
7 patent.
- 8 120. Neither Defendant Katzer nor Mr. Russell ever told Examiner Beaulieu or Examiner
9 Le of Nguyen's rejections, nor did they file RCEs to continue prosecution of applications
10 pending before these other examiners, in light of these rejections.
- 11 121. These actions evidence an intent to deceive.
- 12 122. Separately, in examining the '227 application, Examiner Le also made rejections
13 based on an Ames reference (the Digital Command Control book which Katzer signed, as
14 described earlier) and the DigiToys reference (WinLok) in a July 28, 2005 Office Action.
- 15 123. Examiners Hernandez and Nguyen were examining the '995 application. Examiner
16 Beaulieu was examining the '815 and '794 applications.
- 17 124. As noted earlier, Katzer, the applicant, signed the Foreward, which states: "The
18 manufacturers and DCC Working Group volunteers listed below and on the next page have
19 reviewed the contents of this book, and affix their signatures as indication of their support
20 for the information provided."
- 21 125. On information and belief, Katzer signed the Foreward on or about February 1998.
- 22 126. As noted earlier, Katzer received a first edition copy, autographed by a co-author,
23 Rutger Friberg.
- 24 127. Only after claims were rejected on the basis of Ames and DigiToys (WinLok) – and
25 after being accused of inequitable conduct – did Defendant Katzer and Mr. Russell finally
26 submit Katzer's first edition copy of Ames, among the 5,000-6,000 pages of submissions.
- 27 128. To overcome Examiner Le's rejection, Mr. Russell argued on Sept. 27, 2006, that
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1 Ames did not suggest the claimed subject matter, specifically commands that are received
2 in a sequence, but are transmitted in a different sequence. Mr. Russell described this
3 claimed subject matter as “not first-in first-out prioritization.”

4 129. In his Sept. 27, 2006 response, Russell never addressed the part of the rejection
5 based on WinLok.

6 130. However, he should have. When Mr. Russell brought suit against DigiToys in
7 September 2002 for infringing of the ‘040 patent, Mr. Russell had charged DigiToys with
8 infringing that very subject matter. But because WinLok 2.1 was § 102(a) or § 102(b) art,
9 WinLok anticipated the ‘040 patent. Thus, Mr. Russell had to realize that, in prosecuting
10 the application which issued as the ‘040 patent, he had taken a position inconsistent with
11 the one he was advocating in Oregon federal court against DigiToys. Yet, here Mr. Russell
12 had again made that argument – that Katzer’s “invention” was an advance over WinLok.
13 Russell had received a rejection, based in part on WinLok. And yet Russell did not bring to
14 Examiner Le’s attention the arguments Russell had previously made in Katzer v. Tanner.

15 131. Buried in the 5,000 to 6,000 pages of references is the Katzer v. Tanner lawsuit
16 which showed that Mr. Russell had previously taken a position in direct contradiction of the
17 position he was now advocating to Examiner Le. But Mr. Russell never told Examiner Le.

18 132. Other than listing it with dozens of other references on IDSs, Mr. Russell also never
19 brought the Ames reference to the attention of Examiners Beaulieu and Nguyen.

20 133. He also never brought Examiner Le’s rejection to their attention. And he never told
21 any examiner that he had in court taken a position inconsistent with what he was arguing
22 before the Patent Office.

23 134. These actions evidence an intent to deceive.

24 Inequitable conduct during the examination of other patent applications infects the chain of Katzer
25 patents

26 135. Defendant Katzer and Mr. Russell regularly engaged in a practice of submitting
27 proposed claims that were exactly, word-for-word, the same as claims in previously issued
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1 patents, and which thus would be subject to double-patenting rejections under § 101.
2 Although required by MPEP § 2001.06(d), neither Defendant Katzer nor Mr. Russell ever
3 told the examiners that the proposed claims were copies of claims in patents that had issued.

4 136. In many instances, the examiners who have worked on Katzer applications rejected
5 the proposed claims for double-patenting under § 101.

6 137. However, Defendant Katzer and Mr. Russell continued his practice of submitting
7 these claims – and not telling examiners, despite the requirements in MPEP § 2001.06(d)
8 and MPEP § 2001.06(b).

9 138. On information and belief, Defendant Katzer and Mr. Russell continued to submit
10 these claims in order to have these claims examined in light of a massive quantity – 5,000
11 to 6,000 pages – of prior art that they suddenly produced after being accused of inequitable
12 conduct. This would act as a sort of reexamination without an admission that a substantial
13 new question of patentability existed as to those claims.

14 139. In one instance, a patent – discussed next – issued that is invalid for Sec. 101 double
15 patenting.

16 140. Thus, a pattern of inequitable conduct infects both chains of Katzer patents, making
17 the ‘329 patent unenforceable.

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19 The ‘733 patent is invalid for Sec. 101 double patenting, and unenforceable for inequitable conduct
20 and fraud on the PTO

21 141. Defendant Katzer and Mr. Russell, on Defendants’ behalf, filed U.S. Application
22 10/989,815 on Nov. 16, 2004. This application issued as U.S Patent No. 7,177,733 on Feb.
23 13, 2007.

24 142. Although they had received 3 rejections for Sec. 101 double patenting, Defendant
25 Katzer and Mr. Russell initially submitted the exact same claims as claims 1-47 of U.S.
26 Patent No. 6,676,089.

27 143. Apparently the same day, Mr. Russell, on Defendants’ behalf, filed a preliminary
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1 amendment, canceling those claims “without prejudice” and submitting the same claims as
2 those in the co-pending 10/713,476 application, ‘815’s parent application. The ‘815
3 application was a continuation of the ‘476 application.

4 144. Russell re-numbered the newly proposed claims as claims 48-94.

5 145. He had the ‘476 application’s claims re-typed. There was a typo in the first new
6 claim, Claim 48, listing two steps “(e)”.

7 146. MPEP § 2001.06(b) states:

8 The individuals covered by 37 CFR 1.56 have a duty to bring to the attention of the
9 examiner, or other Office official involved with the examination of a particular
10 application, information within their knowledge as to other copending United States
11 applications which are "material to patentability" of the application in question.

12 147. Defendant Katzer and Mr. Russell did not tell Examiner Beaulieu, who was also
13 examining the co-pending ‘476 application, that the claims in the ‘815 application were the
14 same as those in the ‘476 application and thus would be subject to a provisional §101
15 double patenting rejection.

16 148. Examiner Beaulieu allowed claims in the ‘476 application.

17 149. The ‘476 application issued as U.S. Patent No. 6,909,945 on June 21, 2005.

18 150. MPEP 2001.06(d) states:

19 Where claims are copied or substantially copied from a patent, 37 CFR 1.607(c)
20 requires applicant shall, at the time he or she presents the claim(s), identify the
21 patent and the numbers of the patent claims. **Clearly, the information required by
22 37 CFR 1.607(c) as to the source of copied claims is material information under 37
23 CFR 1.56 and failure to inform the USPTO of such information may violate the
24 duty of disclosure.

25 151. When the ‘476 application issued as the ‘945 patent on June 21, 2005, Mr. Russell
26 did not inform Examiner Beaulieu that the proposed claims in the ‘815 were the exact same
27 as those in an issued patent.

28 152. In response to charges of inequitable conduct in the original complaint, and prior art
submitted with oppositions to their anti-SLAPP motions, Russell and Defendant Katzer in
May and June 2006 submitted 5,000-6,000 pages of new references for Examiner Beaulieu
to consider while examining the ‘815 application.

1 153. Still, neither Russell nor Defendant Katzer told Examiner Beaulieu that the pending
2 claims in the '815 were the exact same as those in the '945 patent.

3 154. Examiner Beaulieu did not recognize the Sec. 101 double patenting rejection, and
4 allowed the claims, which issued as the '733 patent on Feb. 13, 2007.

5 155. By the time that the '815 application issued as the '733 patent, Mr. Russell had
6 received no less than 5 rejections for § 101 double patenting.

7 156. These actions of re-typing the claims that he had submitted, and later got issued, in
8 the prior application, coupled with withholding information that the claims were invalid
9 under § 101 and his awareness of § 101 rejections, shows that Mr. Russell knew he was
10 submitting the invalid claims – that it was no mistake.

11 157. By canceling the initial claims “without prejudice”, Mr. Russell demonstrated an
12 intent to continue submitting claims that were invalid for Sec. 101 double patenting.

13 158. Thus, these actions are show intent to deceive.

14 159. Prior to obtaining the '733 patent, Defendant Katzer and Mr. Russell engaged in a
15 pattern of submitting proposed claims that were exactly the same as those in another issued
16 Katzer patent or in a co-pending Katzer patent application.

17 Both '329 and '023 patents are unenforceable for inequitable conduct

18 160. Russell, on Defendants' behalf, filed U.S. Application 10/340,522 on Jan. 10, 2003.

19 161. Instead of submitting new claims, Russell submitted the same claims as claims 1-20
20 of U.S. Application 10/124,878, which would soon issue as the patent-in-suit, '329.

21 162. MPEP § 2001.06(b) states:

22 The individuals covered by 37 CFR 1.56 have a duty to bring to the attention of the
23 examiner, or other Office official involved with the examination of a particular
24 application, information within their knowledge as to other copending United States
25 applications which are 'material to patentability' of the application in question.

26 163. By using the exact same claims in both the '522 application and the '878
27 application, both sets of claims would be subject to provisional Sec. 101 double patenting
28 rejections.

164. Defendant Katzer and Mr. Russell did not identify that the claims in the '522

1 application were copied from the '878 application.

2 165. Russell did not file an RCE to withdraw the '878 application from issue.

3 166. The '878 application issued as the '329 patent on March 11, 2003.

4 167. MPEP 2001.06(d) states:

5 Where claims are copied or substantially copied from a patent, 37 CFR 1.607(c)
6 requires applicant shall, at the time he or she presents the claim(s), identify the
7 patent and the numbers of the patent claims. **Clearly, the information required by
8 37 CFR 1.607(c) as to the source of copied claims is material information under 37
9 CFR 1.56 and failure to inform the USPTO of such information may violate the
10 duty of disclosure.

11 168. Defendant Katzer and Mr. Russell did not tell the examiner that the claims pending
12 in the '522 application were the exact same as in the '329 patent.

13 169. Examiner Hernandez of the Computerized Vehicle Controls and Navigation art
14 group 3661 rejected the claims in the '522 application for Sec. 101 double patenting in the
15 Apr. 2, 2003 Office Action.

16 The '699 patent, which issued from the '416 application, is unenforceable for inequitable conduct

17 170. Russell, on Defendants' behalf, filed U.S. Application 10/705,416 on Nov. 10,
18 2003.

19 171. Having received a Sec. 101 double patenting rejection a few months earlier, Russell
20 nevertheless submitted the same claims as claims 1-11 of U.S. Patent No. 6,494,408.

21 172. MPEP 2001.06(d) states:

22 Where claims are copied or substantially copied from a patent, 37 CFR 1.607(c)
23 requires applicant shall, at the time he or she presents the claim(s), identify the
24 patent and the numbers of the patent claims. **Clearly, the information required by
25 37 CFR 1.607(c) as to the source of copied claims is material information under 37
26 CFR 1.56 and failure to inform the USPTO of such information may violate the
27 duty of disclosure.

28 173. Defendant Katzer and Mr. Russell did not tell the examiner that the claims pending
in the '416 application were the exact same as those in the '408 patent.

174. Examiner Le of Railways, Boats and Wheels art group 3617 rejected the claims in
the '416 application for Sec. 101 double patenting in the Apr. 21, 2004 Office Action.

1 Russell and Katzer engage in inequitable conduct and fraud on the PTO during examination of the
2 '995 application

3 175. Russell, on Defendants' behalf, filed U.S. Application 10/889,995 on Jul. 13, 2004.

4 176. Having already received two Sec. 101 double patenting rejections, Russell
5 submitted the same claims as claims 1-20 of the '329 patent, the patent-in-suit.

6 177. MPEP 2001.06(d) states:

7 Where claims are copied or substantially copied from a patent, 37 CFR 1.607(c)
8 requires applicant shall, at the time he or she presents the claim(s), identify the
9 patent and the numbers of the patent claims. **Clearly, the information required by
10 37 CFR 1.607(c) as to the source of copied claims is material information under 37
11 CFR 1.56 and failure to inform the USPTO of such information may violate the
12 duty of disclosure.

13 178. Defendant Katzer and Mr. Russell did not tell the examiner that the claims pending
14 in the '995 application were the exact same as those in the '329 patent.

15 179. Examiner Hernandez began the examination of this application, and in the Dec. 15,
16 2004 Office Action, rejected the claims for § 103 obviousness-type double patenting, but
17 not § 101 double patenting.

18 180. Mr. Russell submitted a terminal disclaimer, but still did not tell Examiner
19 Hernandez that the claims were the same as claims 1-20 of the '329 patent.

20 181. In the Sept. 22, 2005 Office Action, Examiner Hernandez rejected certain claims
21 over a reference called Lainema.

22 182. Examiner Hernandez then left the PTO.

23 183. A new examiner, Nguyen, continued the examination.

24 184. In response to charges of inequitable conduct in the original complaint, and prior art
25 submitted with oppositions to their anti-SLAPP motions, Russell and Defendant Katzer in
26 May and June 2006 submitted 5,000-6,000 pages of new references for Examiner Nguyen
27 to consider while examining the '995 application.

28 185. In the Aug. 7, 2006 Office Action, Examiner Nguyen rejected all claims as obvious
over prior art in the 5,000 to 6,000 pages of references that Russell and Defendant Katzer
had recently submitted.

1 186. To overcome the Lainema rejection, Mr. Russell had re-written and submitted
2 claims 2 and 17 in independent form as claims 1 and 16, although they were the same as
3 claims 2 and 17 in the '329 patent, if those claims had been written in independent form.

4 187. Although he cancelled some claims that were duplicates of claims in the '329
5 patent, other copies of '329 claims still remained.

6 188. Again, Mr. Russell never indicated to Examiner Nguyen that he was submitting
7 '329 claims 2 and 17 as the new claims 1 and 16 of the '995 application, nor did he indicate
8 that he was keeping some claims that were duplicates issued in the '329 patent.

9 189. By the time they had submitted their last set of claims on Oct. 5, 2006, Defendant
10 Katzer and Mr. Russell had received 5 rejections for § 101 double patenting, including one
11 Sec. 101 double patenting rejection on Aug. 4, 2006 in U.S. Application 11/375,794.

12 190. Defendant Katzer and Mr. Russell's actions of (1) intentionally changing the claim
13 language to previously issued claims to obtain claims which would be invalid under Sec.
14 101 and (2) keeping in other claims that were invalid for Sec. 101 double patenting, and (3)
15 not informing the examiner about this, cannot be explained by anything other than an intent
16 to deceive the examiner.

17 The '836 patent, which issued from the '227 application, is unenforceable for inequitable conduct

18 191. Russell, on Defendants' behalf, filed U.S. Application 10/976,227 on Oct. 26, 2004.

19 192. Having already received two Sec. 101 double patenting rejections, Russell again
20 submitted the same claims as claims 1-11 of the '408 patent.

21 193. MPEP 2001.06(d) states:

22 Where claims are copied or substantially copied from a patent, 37 CFR 1.607(c)
23 requires applicant shall, at the time he or she presents the claim(s), identify the
24 patent and the numbers of the patent claims. **Clearly, the information required by
25 37 CFR 1.607(c) as to the source of copied claims is material information under 37
26 CFR 1.56 and failure to inform the USPTO of such information may violate the
27 duty of disclosure.

28 194. Mr. Russell did not tell the examiner that the claims pending in the '227 application
were the exact same as those in the '408 patent.

195. Examiner Le rejected the claims in the '227 application for Sec. 101 double

1 patenting in the Mar. 11, 2005 Office Action.

2 The '812 patent, which issued from the '794 application, is unenforceable for inequitable conduct

3 196. Russell, on Defendants' behalf, filed U.S. Application 11/375,794 on Mar. 14, 2006,
4 the day after this lawsuit was filed.

5 197. Having already received three Sec. 101 double patenting rejections, Russell
6 submitted the same claims as claims 1-47 of the '089 patent.

7 198. MPEP 2001.06(d) states:

8 Where claims are copied or substantially copied from a patent, 37 CFR 1.607(c)
9 requires applicant shall, at the time he or she presents the claim(s), identify the
10 patent and the numbers of the patent claims. **Clearly, the information required by
11 37 CFR 1.607(c) as to the source of copied claims is material information under 37
12 CFR 1.56 and failure to inform the USPTO of such information may violate the
13 duty of disclosure.

14 199. Defendant Katzer and Mr. Russell did not tell the examiner that the claims pending
15 in the '794 application were the exact same as those in the '089 patent.

16 200. Examiner Beaulieu of art group 3661 rejected the claims in the '794 application for
17 Sec. 101 double patenting in the Aug. 4, 2006 Office Action.

18 Russell and Katzer engage in inequitable conduct during the examination of the '784 application

19 201. Russell, on Defendants' behalf, filed U.S. Application 11/592,784 on Nov. 3, 2006.

20 202. Having already received four Sec. 101 double patenting rejections, Russell again
21 submitted the same claims as claims 1-11 of the '408 patent.

22 203. MPEP 2001.06(d) states:

23 Where claims are copied or substantially copied from a patent, 37 CFR 1.607(c)
24 requires applicant shall, at the time he or she presents the claim(s), identify the
25 patent and the numbers of the patent claims. **Clearly, the information required by
26 37 CFR 1.607(c) as to the source of copied claims is material information under 37
27 CFR 1.56 and failure to inform the USPTO of such information may violate the
28 duty of disclosure.

204. Defendant Katzer and Mr. Russell did not tell the examiner that the claims pending
in the '784 application were the exact same as those in the '408 patent.

205. Examiner Le rejected the claims in the '784 application for Sec. 101 double
patenting in the Mar. 26, 2007 Office Action.

Russell and Katzer engage in inequitable conduct during the examination of the '770 application

206. Russell, on Defendants' behalf, filed U.S. Application 11/593,770 on Nov. 11, 2006.

207. Having already received four Sec. 101 double patenting rejections, Defendant Katzer and Mr. Russell again submitted the same claims as claims 1-47 of the '089 patent.

208. MPEP 2001.06(d) states:

Where claims are copied or substantially copied from a patent, 37 CFR 1.607(c) requires applicant shall, at the time he or she presents the claim(s), identify the patent and the numbers of the patent claims. **Clearly, the information required by 37 CFR 1.607(c) as to the source of copied claims is material information under 37 CFR 1.56 and failure to inform the USPTO of such information may violate the duty of disclosure.

209. Defendant Katzer and Mr. Russell did not tell the examiner that the claims pending in the '770 application were the exact same as those in the '089 patent.

210. Examiner Beaulieu of art group 3661 rejected the claims in the '770 application for Sec. 101 double patenting in the Sep. 18, 2007 Office Action.

Russell and Katzer engage in inequitable conduct during the examination of the '233 application

211. Russell, on Defendants' behalf, filed U.S. Application 11/607,233 on Dec. 1, 2006.

212. Having already received four Sec. 101 double patenting rejections, Defendant Katzer and Mr. Russell again submitted the same claims as claims 1-47 of the '089 patent.

213. MPEP 2001.06(d) states:

Where claims are copied or substantially copied from a patent, 37 CFR 1.607(c) requires applicant shall, at the time he or she presents the claim(s), identify the patent and the numbers of the patent claims. **Clearly, the information required by 37 CFR 1.607(c) as to the source of copied claims is material information under 37 CFR 1.56 and failure to inform the USPTO of such information may violate the duty of disclosure.

214. Defendant Katzer and Mr. Russell did not tell the examiner that the claims pending in the '233 application were the exact same as those in the '089 patent.

215. Examiner Beaulieu of art group 3661 rejected the claims in the '233 application for Sec. 101 double patenting in the Apr. 30, 2007 Office Action.

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1 216. On information and belief, Defendant Katzer and Mr. Russell submitted other
2 claims invalid for § 101 double patenting during the prosecution of other patent
3 applications.

4 217. Repeatedly filing previously issued claims, in the face of § 101 rejections, combined
5 with the failure to inform the examiners that the proposed claims had previously issued,
6 demonstrates intent to deceive the Office.

7 218. Defendant Katzer and Mr. Russell’s actions during the prosecution of the ‘995
8 application and the ‘815 application confirm they intended to deceive the Office.

9 219. Thus, the pattern of withholding rejections, and submitting claims invalid for Sec.
10 101 double patenting, shows a pattern of intent to deceive.

11 220. This pattern demonstrates that inequitable conduct and fraud on the Patent Office
12 infects the chains of Katzer patents.

13 221. Thus, no Katzer patent, including ‘329, is enforceable.

14

15 Meanwhile, the JMRI Project starts up

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17 222. As Katzer and Russell began prosecuting patent applications, Plaintiff Robert
18 Jacobsen returned to an old hobby from his teen years – model trains. Shortly afterward,
19 Jacobsen teamed with model train hobbyists to create the JMRI (Java Model Railroad
20 Interface) Project on SourceForge.net, an incubator site which hosts more than 100,000
21 open source software projects. As the group’s membership changed, Jacobsen found
22 himself taking on more responsibilities, until he became one of the leaders of the group. He
23 currently serves as the main contact for the JMRI Project. The JMRI Project produces
24 software to run trains, switches and other items on a layout. The software installs on one
25 computer, and runs model train hardware from that computer.

26 223. Hobbyists have several ways to control trains and other equipment on a layout. One
27 is Digital Command Control (DCC), a standard developed by the DCC Working Group of
28 the National Model Railroad Association (NMRA). DCC and similar systems control

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1 trains, rail switches and other items on a layout, via computer chips (called decoders)
2 embedded in the hardware. Numerous model train equipment manufacturers offer products
3 for use in train control systems, including hardware and software. Because of the
4 differences between products, software used to control the trains must be tailored to permit
5 hobbyists to change settings for these items. JMRI Project software meets this need,
6 including what are called “decoder definition files” which allow the software to be used
7 with a wide range of model train hardware. These definitions are stored for computational
8 purposes in computer files. The JMRI developers as a group have produced definitions for
9 more than 350 models of decoders. These definitions are stored in more than 100 files.
10 Furthermore, because of the flexibility of the Java programming language, hobbyists may
11 use JMRI Project software on various computer platforms, including Mac, Windows and
12 Linux operating systems. The JMRI Project recently won a prestigious award from Sun
13 Microsystems for its innovative use of the Java programming language.¹⁴

14 224. Jacobsen is popular among hobbyists, and most manufacturers. As he became more
15 deeply involved in model trains, he joined the National Model Railroad Association,
16 became a member of the Digital Command Control (DCC) Working Group, and then Chair
17 of that standards-setting group. As the main contact for the JMRI Project, he has helped
18 numerous model train hobbyists with setting up their software and layouts. Within a mere 5
19 years, as more hobbyists and manufacturers sought Jacobsen for help, Jacobsen became a
20 leader in the model train community

21 Katzer and Jacobsen’s first contact

22 225. A software developer by training, Jacobsen had been interested in writing his own
23 code to control trains. He had heard about Katzer through others, and contacted him to talk
24 about model trains. Katzer tried to sell Jacobsen his software, but Jacobsen declined to buy
25 it and said he planned on writing his own. Katzer reacted negatively, and Jacobsen ended
26 the email exchange. They emailed again in 2001, with the same result. Jacobsen instead

27 ¹⁴ Sun Microsystems, 2006 JavaOne Conference, Duke’s Choice Awards, at
28 http://java.sun.com/javaone/sf/dukes_choice_awards.jsp (last visited Sept. 11, 2006).

1 joined the JMRI Project.

2 226. Jacobsen then joined the NMRA DCC Working Group, and became acquainted with
3 manufacturers such as A.J. Ireland, Hans Tanner and Juergen Freiwald, and expert
4 hobbyists such as Strad Bushby and others. He also got to know Katzer. They exchanged
5 emails repeatedly through Jacobsen's email address, Bob_Jacobsen@lbl.gov, which
6 Jacobsen used due to the long hours he puts in at the university. As Jacobsen rose to the top
7 of the working group leadership, Jacobsen quickly received the recognition that Katzer had
8 sought for years.

9 The JMRI Project thrives, and Katzer steals its Intellectual Property

10 227. JMRI software is created by about several dozen programmers. Work first began in
11 2000.

12 228. JMRI has never been sponsored by any federal or state entity.

13 229. DecoderPro is the most popular JMRI application.

14 230. DecoderPro is used to configure decoder chips in trains. These chips control the
15 trains' operation, such as speed of the train, its lights and its sound. DecoderPro supports
16 more than 100 groups of decoder chip models, or 350 specific decoder models.

17 231. Chips range from simple to complex to program.

18 232. Documentation on how to program the chips is sometimes scant or nonexistent.

19 233. DecoderPro lets model railroaders easily program the decoder chips.

20 234. To function properly, DecoderPro needs Decoder Definition files.

21 235. Each Decoder Definition file defines, organizes, and provides default values for
22 only one group of decoder chip models.

23 236. Decoder Definition files also control the display of the variables on the DecoderPro
24 screen.

25 237. JMRI programmers put more than 5 years worth of work into JMRI 1.7.1, which
26 included DecoderPro and its Decoder Definition files.

27 238. JMRI programmers include their names, version numbers and modification dates on
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1 the Decoder Definition files they create or change.

2 239. DecoderPro has received favorable reviews in model railroad magazines, and is well
3 known among model railroaders who use decoder chips.

4 240. JMRI holds user group meetings on DecoderPro and workshops on using
5 DecoderPro. These meetings and workshops have been held in the United States and
6 Europe.

7 241. Participants on model railroad listservs – including listservs that Defendant Katzer
8 belongs to – are aware of and discuss DecoderPro.

9 242. The Decoder Definitions are important to model railroad software manufacturers.
10 Railroad & Co., DigiToys, Litchfield Station, MTS Associates, and GPP Software have
11 made arrangements with Plaintiff to use the Decoder Definitions.

12 243. Defendants never contacted Plaintiff, nor made arrangements with Plaintiff, to use
13 the JMRI Decoder Definition files.

14 244. Instead, beginning in 2004, Defendants downloaded Plaintiff’s Decoder Definition
15 files, stripped out all copyright notices and attribution to JMRI and the authors, and
16 converted the code to a format to use with their products, including Decoder Commander.

17 245. Then Defendants advertised, sold, and distributed their Decoder Commander
18 product as the best available software for model railroaders to use to program decoders.

19 246. Decoder Commander could never work nearly as well without the modified versions
20 of Plaintiff’s Decoder Definition files. The Decoder Definition files included with Decoder
21 Commander were a significant part of Decoder Commander’s value to users.

22 247. Defendants focused JMRI and Plaintiff when Plaintiff and JMRI began producing
23 software in 2002.

24 248. On or about March 12, 2002, Plaintiff announced the JMRI 0.9 release via email
25 and on the JMRI SourceForge website. This was JMRI’s first version. Plaintiff is the
26 owner and assignee of the copyright in this version. The copyright registration is in
27 Appendix C.

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1 249. The release is subject to the original Artistic License.

2 250. The Artistic License states, in its Preamble:

3 The intent of this document is to state the conditions under which a Package may be
4 copied, such that the Copyright Holder maintains some semblance of artistic control
5 over the development of the package, while giving the users of the package the right
6 to use and distribute the Package in a more-or-less customary fashion, plus the right
7 to make reasonable modifications.

8 251. The Artistic License also states:

9 3. You may otherwise modify your copy of this Package in any way, provided that
10 you insert a prominent notice in each changed file stating how and when you
11 changed that file, and provided that you do at least ONE of the following:

12 a) place your modifications in the Public Domain or otherwise make them Freely
13 Available, such as by posting said modifications to Usenet or an equivalent medium,
14 or placing the modifications on a major archive site such as ftp.uu.net, or by
15 allowing the Copyright Holder to include your modifications in the Standard
16 Version of the Package.

17 b) use the modified Package only within your corporation or organization.

18 c) [...]

19 d) make other distribution arrangements with the Copyright Holder.

20 252. The Artistic License also states:

21 4. You may distribute the programs of this Package in object code or executable
22 form, provided that you do at least ONE of the following:

23 a) distribute a Standard Version of the executables and library files, together with
24 instructions (in the manual page or equivalent) on where to get the Standard
25 Version.

26 b) accompany the distribution with the machine-readable source of the Package with
27 your modifications.

28 c) [...]

d) make other distribution arrangements with the Copyright Holder.

253. The Artistic License also states:

5. You may charge a reasonable copying fee for any distribution of this Package.
You may charge any fee you choose for support of this Package. You may not
charge a fee for this Package itself. However, you may distribute this Package in
aggregate with other (possibly commercial) programs as part of a larger (possibly
commercial) software distribution provided that you do not advertise this Package
as a product of your own.

254. On or about July 14, 2002, Plaintiff announced the JMRI 1.0 release via email and

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1 on the JMRI SourceForge website. Like earlier versions, it is subject to the original Artistic
2 License. Plaintiff is the owner and assignee of the copyright in this version. The copyright
3 registration is in Appendix D.

4 255. On or about Oct. 7, 2002, Plaintiff announced the JMRI 1.1 release via email and on
5 the JMRI SourceForge website. Like earlier versions, it is subject to the original Artistic
6 License. Plaintiff is the owner and assignee of the copyright in this version. The copyright
7 registration is in Appendix E.

8 256. By at the latest May 2, 2003, Defendant Katzer knew about JMRI Decoder
9 Definition files.

10 257. Defendant Katzer sent an email to the loconet_hackers Yahoo! email listserv, asking
11 about the type of files JMRI uses. Plaintiff responded to Defendant Katzer that “JMRI uses
12 XML files to store information (decoder definitions, layout configuration, etc), ...”

13 258. On or about Aug. 8, 2003, Plaintiff Jacobsen replied to an email question from
14 Katzer with information about the files and where to obtain them.

15 259. On or about Aug. 17, 2003, Plaintiff announced the JMRI 1.2.5 release via email
16 and on the JMRI SourceForge website. Like earlier versions, it is subject to the original
17 Artistic License. Plaintiff is the owner and assignee of the copyright in this version. The
18 copyright registration is in Appendix F.

19 260. On or about Mar. 30, 2004, Defendant Katzer wrote to Plaintiff directly via email,
20 saying, “Currently you are supply (sic) software under the GNU license”.

21 261. Later that day, Plaintiff wrote Defendant Katzer to correct him. Plaintiff pointed
22 Defendant Katzer to the license, the Artistic License, and a discussion of its terms.

23 262. On or about Apr. 8, 2004, Plaintiff announced the JMRI production version 1.4
24 release via email and on the JMRI SourceForge website. Like earlier versions, it is subject
25 to the original Artistic License. Plaintiff is the owner and assignee of the copyright in this
26 version. The copyright registration is in Appendix G.

27 263. On or about Sept. 7, 2004, Defendant Katzer posted an email on the loconet_hackers
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1 Yahoo email listserv, indicating familiarity with JMRI’s license. Katzer stated, “JMRI
2 license agreement requires them to ship source, and dictates what can be charge (sic)”.

3 264. On information and belief, Robert Bouwens of Bouwens Engineering began
4 working for Defendants in 2004.

5 265. On Dec. 31, 2004, Bouwens posted a note about looking at a specific JMRI Decoder
6 Definition file on the web.

7 266. On or about Apr. 24, 2005, Defendant Katzer published an announcement on
8 Defendant KAMIND Associates’ “The Conductor” Yahoo email listserv for “Train Server
9 3.0”, including “Decoder Commander”. Defendant Katzer’s announcement said, “Our
10 users tell us that Decoder Commander far surpasses any other solution available in the
11 market (free or commercial)”. This indicated that Defendant Katzer had a working Decoder
12 Commander product. The announcement also stated it included “Decoder Commander® - a
13 distributed GUI programmer for loco programming allowing importing of ours or other
14 third party decoder templates”. The announcement stated the new version would be
15 available on the KAM web site June 1, 2005, and from dealers on June 30, 2005.

16 267. On or about May 1, 2005, Plaintiff used an automated software script to complete
17 adding copyright notices in all JMRI decoder definition files. Plaintiff had begun adding
18 copyright notices after Defendant Katzer was caught having registered decoderpro.com, as
19 discussed later. Plaintiff wanted to protect JMRI intellectual property from any others who
20 sought to misappropriate JMRI intellectual property for their own use.

21 268. On or about June 18, 2005, Plaintiff announced the JMRI production version 1.6
22 release via email and on the JMRI SourceForge website. Like earlier versions, it is subject
23 to the original Artistic License. Plaintiff is the owner and assignee of the copyright in this
24 version. The copyright registration is in Appendix H.

25 269. On or about June 18, 2005, Plaintiff announced the JMRI test version 1.7.1 release
26 via email and on the JMRI SourceForge website. The QSI files, including QSI_Electric and
27 QSI_Steam, first appeared in this version. QSI are a brand of decoder that is complex to
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1 program, but popular with model railroaders because of decoder's versatility in producing
2 locomotive sounds.

3 270. Like earlier versions, JMRI 1.7.1 is subject to the original Artistic License. Plaintiff
4 is owner and assignee of the copyright in this version. The copyright registration is in
5 Appendix I.

6 271. Defendant Katzer and Mr. Bouwens downloaded the JMRI Decoder Definition files
7 from JMRI's website on or after June 18, 2005.

8 272. They proceeded to convert the JMRI files to files Defendants could use in their
9 products. One file they converted was QSI_Electric.xml which they changed to
10 QSI_Electric.tpl.xml and later to qsi.tpl.xml.

11 273. They stripped the author's name from each Decoder Definition file.

12 274. They stripped the JMRI copyright notice from each Decoder Definition file.

13 275. They stripped the reference to the license, which lists the terms and conditions of
14 use of the Decoder Definition files.

15 276. They changed the titles of the works.

16 277. They converted the JMRI Decoder Definition file into a file that could be read by
17 their Decoder Commander.

18 278. Evidence of copying, such as the dates of creation and version numbers and various
19 misspellings and other quirks, remained.

20 279. They did not insert a prominent notice in each changed file stating how and when
21 they changed the file.

22 280. They did not place their modifications in the public domain.

23 281. They did not make their modifications freely available to others.

24 282. They did not allow Plaintiff to include the modifications in the Standard Version of
25 the JMRI software.

26 283. They did not use the modified Decoder Definition files only within Defendant
27 KAMIND Associates, Inc.

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1 284. The names they chose for the new files were a slight variation of the Decoder
2 Definition files.

3 285. They did not provide with their products, the standard JMRI executables and library
4 files together with instructions on where to get the Standard Version.

5 286. They did not distribute JMRI source code with their product so they did not
6 “accompany the distribution with the machine-readable source”.

7 287. They did not make other distribution arrangements with the Copyright Holder.

8 288. By selling them as an integral part of their products, Defendants charged a fee for
9 the modified JMRI Decoder Definition files.

10 289. Defendants advertised the modified JMRI Decoder Definition files as their own.

11 290. In his Decoder Commander manual, Katzer stated: “All decoders have unique
12 characteristics. KAM has created a set of Decoder Templates that has these characteristics
13 in an XML configuration file.” (emphasis added).

14 291. The KAM website stated, “In June 2005 at the [NMRA] Cincinnati convention we
15 introduced Decoder Commander. The first XML based distributed programmer. This
16 application has been under development since 2001.”

17 292. Defendant Katzer and Mr. Bouwens then released a tool, which they called the
18 “template verifier” [hereinafter the “infringing tool”] to extract various information from
19 JMRI’s Decoder Definition files, and convert it to a form that Defendants could use in their
20 products, including Decoder Commander. On information and belief, the infringing tool
21 was created in 2004.

22 293. The infringing tool had no other use but to convert JMRI Decoder Definition files
23 into files for use in Defendants’ products.

24 294. The infringing tool stripped the author’s name from each Decoder Definition file.

25 295. The infringing tool stripped the JMRI copyright notice from each Decoder
26 Definition file.

27 296. The infringing tool stripped the reference to the license, which lists the terms and
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- 1 conditions of use of the Decoder Definition files.
- 2 297. The infringing tool changed the titles of the works.
- 3 298. The infringing tool converted the JMRI Decoder Definition file into a file that could
4 be read by Defendants' Decoder Commander.
- 5 299. The infringing tool left evidence of copying, such as the dates of creation and
6 version numbers and various misspellings and other quirks.
- 7 300. The infringing tool did not insert a prominent notice in each changed file stating
8 how and when it changed the file.
- 9 301. On information and belief, customers using the infringing tool did not place their
10 modifications in the public domain.
- 11 302. On information and belief, customers using the infringing tool did not make their
12 modifications freely available to others.
- 13 303. Customers using the infringing tool did not allow Plaintiff to include the
14 modifications in the Standard Version of the JMRI software.
- 15 304. On information and belief, customers using the infringing tool did not use the
16 modified Decoder Definition files only within their organizations.
- 17 305. The names customers using the infringing tool chose for the new files were slight
18 variations of the Decoder Definition files.
- 19 306. On information and belief, customers using the infringing tool did not distribute a
20 Standard Version of the executables and library files, together with instructions on where to
21 get the Standard Version.
- 22 307. On information and belief, customers using the infringing tool did not make other
23 distribution arrangements with the Copyright Holder.
- 24 308. On or about July 1, 2005, Defendant Katzer begins to promote Decoder
25 Commander, including a giveaway at the NMRA Convention 4 days later.
- 26 309. On information and belief, Defendant Katzer distributed 10 copies of Decoder
27 Commander on July 6, 2005.
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1 310. Between July 2005 and June 2006, Defendants copied and distributed at least 300
2 copies of their infringing products.

3 311. On information and belief, in late July through August 2005, Defendant Katzer and
4 Mr. Bouwens attempted to get the NMRA to use JMRI copyrighted material as its standard.
5 Neither Katzer nor Bouwens had Plaintiff's permission to do so.

6 312. On or about Feb. 27, 2006, Plaintiff announced the JMRI test version 1.7.3 release
7 via email and on the JMRI SourceForge website. Like earlier versions, it is subject to the
8 original Artistic License. Plaintiff is the owner and assignee of the copyright in this
9 version. The copyright registration is in Appendix J. Registration is pending.

10 313. On or about June 3, 2006, while investigating KAM products in connection with
11 opposing Defendants' anti-SLAPP motions, Plaintiff first learned of Defendants'
12 infringement. He downloaded a Decoder Commander manual (dated 10/4/2005) from
13 Defendant KAMIND Associates' web site and found the manual contained screen displays
14 indicating that Decoder Commander was displaying JMRI data.

15 314. The next day, Plaintiff ordered a copy of Decoder Commander from Southern
16 Digital, a KAM dealer. The dealer said Defendants would ship directly to Plaintiff.
17 Defendants never shipped the order.

18 315. On information and belief, Defendants did not ship the order because they wanted to
19 keep their infringement secret for as long as possible.

20 316. On June 5, 2006, Alex Shepherd, another JMRI member, discovered that Defendant
21 KAMIND Associates' web site had available for download the infringing tool to convert
22 JMRI files, and notified Plaintiff via email.

23 317. On June 13, 2006, Plaintiff filed an application to register the copyright on the JMRI
24 1.7.1 Decoder Definitions.

25 318. Plaintiff had obtained assignments from all authors who contributed to this set of
26 files covered by the registration.

27 319. On June 14, 2006, Jacobsen ordered KAM Decoder Commander from DCC Train, a
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KAM dealer. The CD arrived June 16. It was version 304.

320. On July 4, 2006, Plaintiff announced the JMRI 1.7.5 release via email and on the JMRI SourceForge website. Like earlier versions, it is subject to the original Artistic License.

321. On Aug. 14, 2006, Plaintiff received the 1.7.1 copyright registration from the copyright office.

322. The same day, Plaintiff ordered a copy of Engine Commander from Southern Digital. Plaintiff downloaded the infringing tool from Defendant KAMIND Associates' web site.

323. Engine Commander arrived August 21, and contained a V304 CD, including Decoder Commander and the template files.

324. On or about Aug. 19, 2006, Plaintiff downloaded "Smart Decoder Editor manual.pdf" and "Decoder Commander Manual.pdf" from the KAM web site. Both contained JMRI material from a Lenz_51.xml file, the QSI files, and other files.

325. In late August 2006, Plaintiff obtained Defendants' version 305 CD. The release notes said "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."

326. Plaintiff filed the Amended Complaint on Sept. 11, 2006. He included a cause of action for copyright infringement.

327. Defendants continued to modify JMRI files, copy them, distribute them, and advertise them as their products.

328. In doing so, Defendants actively encouraged their customers to copy and modify the infringing KAM files, and use the infringing tool to copy and modify JMRI files.

329. On information and belief, Defendants' customers continued to copy and modify the infringing KAM files.

330. On information and belief, Defendants' customers continued to use the infringing tool to copy and modify JMRI files.

1 331. Seeing no changes in Defendants' infringing conduct, Plaintiff sent a cease and
2 desist letter on Sept. 21, 2006 requesting action by Sept. 27, 2006.

3 332. On or about Sept. 26, 2006, Plaintiff received Defendants' 306 CD at his home
4 address.

5 333. One file named in the Amended Complaint had been removed. Other files were still
6 present with copied information and with the copyright notice and author names stripped.
7 The infringing tool remained available on the web.

8 334. Having seen that Defendants had not stopped their infringing activities, nor
9 contacted their customers to halt use of Defendants' infringing products, Plaintiff filed a
10 Motion for Preliminary Injunction on Oct. 25, 2006.

11 335. On Nov. 8, 2006, Plaintiff conducted Google searches for various phrases present in
12 the JMRI decoder definition files. He found hits on the KAM web site. On information and
13 belief, these hits came from a 302 Retail CD available online.

14 336. On or about June 8, 2007, Plaintiff announced the JMRI test version 1.7.7 release
15 via email and on the JMRI SourceForge website. Like earlier versions, it is subject to the
16 original Artistic License. Plaintiff is the owner and assignee of the copyright in this
17 version. The copyright registration is in Appendix K. Registration is pending.

18 337. On or about July 22, 2007, Plaintiff announced the JMRI production version 1.8
19 release via email and on the JMRI SourceForge website. Like earlier versions, it is subject
20 to the original Artistic License. Plaintiff is the owner and assignee of the copyright in this
21 version. The copyright registration is in Appendix L. Registration is pending.

22 338. On or about Sept. 20, 2007, Plaintiff announced JMRI software is now subject to
23 GNU's General Public License 2.0, also known as GPL 2.0.

24 339. On information and belief, Defendants have downloaded the latest versions of JMRI
25 software, and incorporated them in their software.

26 340. Thus, Defendants' infringing use of JMRI material is continuous.

27 341. Defendants maintain they no longer use JMRI materials, but provide no explanation
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1 as to how they re-created, virtually overnight, the same files and information that it took
2 JMRI developers more than 5 years to create.

3 342. Defendants maintain that unregistered copies of their infringing products cease to
4 operate.

5 343. Defendants have not stated whether registered copies of their infringing products
6 continue to operate. On information and belief, registered copies continue to work and are
7 not subject to an expiration date.

8 344. Either way, Defendants' infringing products continue to function if a customer
9 changes the clock date on his computer.

10 345. The infringing copies of the JMRI Decoder Definition files remain on Defendants'
11 existing CDs and on customers' computers.

12 346. Defendants claim the infringing tool no longer works.

13 347. The infringing tool continues to function as before. It takes JMRI files and converts
14 them into a version that can be used with Defendants' infringing products.

15 348. Defendants never made recent versions of their products available in a working
16 form to Plaintiff to prove they are no longer using JMRI materials.

17 349. Defendants never provided any evidence that their new source of decoder
18 information was independently created, and thus they never would return to using JMRI
19 material.

20 350. Defendants never contacted their customers to tell them not to use, copy, modify, or
21 distribute the infringing products.

22 351. On information and belief, Defendants' current products do not work, or have
23 substandard performance, without JMRI Decoder Definition files. Thus, their and their
24 customers' only recourse is to use the infringing products.

25 352. Thus Defendants are continuing to infringe.

26 353. Defendants are liable for copyright infringement.

27 354. Defendants are also liable for providing false copyright management information
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1 when they claimed the modified Decoder Definition files as their own.

2 355. Defendants are also liable for removing or altering JMRI's copyright management
3 information from the Decoder Definition files.

4 356. Defendants did not end their theft there. Defendant Katzer knew DecoderPro, JMRI
5 Project trademark, belonged to the JMRI Project. DecoderPro is a distinctive mark or
6 descriptive mark with secondary meaning, having been on the market for more than 5 years
7 and having been reviewed in model train magazines.

8 357. Katzer registered the domain decoderpro.com with the intent to profit from the
9 JMRI Project's goodwill in the trademark.

10 358. Jacobsen registered DecoderPro with the U.S. Trademark Office on Oct. 27, 2004
11 (Reg. No. 3092440). The Trademark Office published the mark on the Principal Register.

12 359. As a part a settlement agreement in a trademark infringement case filed against
13 Jerry Britton in Oregon, Katzer transferred rights to decoderpro.com to Mr. Britton on the
14 condition that Mr. Britton not transfer them to anyone else, including the rightful owner
15 Jacobsen. In the settlement agreement, Katzer required Mr. Britton to pay him \$20,000 if
16 Mr. Britton transferred the domain name to anyone else.

17 360. Katzer intended to profit from decoderpro.com, until a WIPO UDRP panel ordered
18 transfer of the domain name to Plaintiff in August 2007, in Case No. D2007-0763.

19 361. Katzer regularly included JMRI trademarks in search engines to trick consumers to
20 go to his website, among other acts, to trade on the goodwill of JMRI marks.

21 362. Katzer also stole JMRI technology and patented it. The JMRI Project released
22 software on a regular basis, and announced the releases and other news on a Yahoo!
23 listserv. On information and belief, Katzer belonged to the listserv and received these
24 announcements. He watched as yet another producer enjoyed the success that he could not.

25 363. On April 14, 2002, the JMRI Project released software with client-server
26 capabilities. Three days later, Katzer, through his attorney Russell, claimed those exact
27 capabilities in a patent application, the '878 application, although the application did not
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1 meet the written description or enablement requirements of 35 U.S.C. § 112. The Katzer
2 specification had focused only on Katzer’s “advance” of queuing commands, and what
3 Katzer called “asynchronous communication”. It does not describe what it claimed, the use
4 of networks for model train layout control, nor did the specification show a person of
5 ordinary skill in the art how to practice the use of networks for model train layout control.
6 The application issued as the ‘329 patent on March 11, 2003.

7 Katzer, through his attorney Russell, begins unfair enforcement tactics

8 364. Because Defendant Katzer and Mr. Russell withheld material references and
9 because Defendant Katzer and Mr. Russell knew prior art either anticipated or made
10 obvious the inventions in the ‘329 patent, Defendant Katzer and Mr. Russell knew the ‘329
11 patent, and other patents issued to Katzer which he and Mr. Russell made veiled threats to
12 enforce, were neither valid nor enforceable.

13 365. Despite knowing that the patents were invalid and unenforceable, Katzer through his
14 attorney Russell embarked on a scheme to enforce them and collect patent royalties.

15 366. On Sept. 18, 2002, Russell filed patent infringement lawsuits in U.S. District Court
16 for the District of Oregon, on behalf of Katzer and KAM against Mireille Tanner of
17 DigiToys, and Freiwald Software and certain distributors. Mireille Tanner is the wife of Dr.
18 Hans Tanner. Dr. Tanner was not named. The complaint against Mireille Tanner alleged
19 that DigiToys’ WinLok infringed patents issued to Katzer. The complaint against Freiwald
20 Software alleged that Mr. Juergen Freiwald’s Railroad & Co. software infringed the patents
21 issued to Katzer. Concurrent with filing the lawsuit, Mr. Russell sent 100-page cease and
22 desist letters to Mireille Tanner, Juergen Freiwald, and dealers who sold WinLok or
23 Railroad & Co. software.

24 367. As discussed earlier, Dr. Hans Tanner responded to Russell’s letter. As a result,
25 Russell and Defendants dropped the lawsuit against Mireille Tanner.

26 368. On Oct. 15, 2002, Mr. Freiwald wrote Russell regarding the patent infringement
27 cease and desist letter. Mr. Freiwald told Russell that his Railroad & Co. software program
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1 had been sold since summer 1996. Like Dr. Tanner, Mr. Freiwald pointed out that WinLok
2 1.5 and 2.0, the Spanish MES program, the German SoftLok program pre-dated Katzer's
3 patent application by more than 1 year. Mr. Freiwald also noted that the German program
4 MpC also had capabilities claimed by the Katzer patent and was sold beginning in 1996.
5 Thus these would bar Katzer's patents. Then, Mr. Freiwald told Russell: "Furthermore, it
6 can be assumed that Katzer, as an expert in the market of software for model railroad
7 computer control, was aware of the programs listed above when he filed his patents." Mr.
8 Freiwald then accused Katzer of withholding references, in violation of Rule 1.56.

9 369. On information and belief, Katzer and Russell discussed the letters from Dr. Tanner
10 and Mr. Freiwald. Realizing that the patents they had worked together to obtain would be
11 held unenforceable and/or invalid, they decided to dismiss the lawsuit. At the time, Russell
12 and Katzer had 2 patent applications open for prosecution on the merits, including the '878
13 application. Although confronted with material references, they withheld them from the
14 Patent Office. They also did not seek re-examination of the patents-in-suit in the Tanner
15 and Freiwald lawsuits.

16 370. Katzer's lawsuits against Mireille Tanner and Mr. Freiwald was dismissed on Dec.
17 20, 2002.

18 371. On information and belief, Defendant Katzer and Mr. Russell conspired to find
19 other easier targets against whom to enforce patents issued to Katzer. On information and
20 belief, during 2003 and 2004, Defendant Katzer and Mr. Russell contacted several other
21 hobbyists who offered software for controlling model trains.

22 372. On information and belief, Defendant Katzer and Mr. Russell threatened them with
23 patent infringement lawsuits.

24 373. On information and belief, Defendant Katzer and Mr. Russell forced them to pay
25 patent royalties.

26 374. One such victim of these tactics was Glen Butcher who had offered free model
27 railroad control system software called "loconetdd" and "railroadd" on his website. In
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1 September 2004, Mr. Butcher posted that he had been contacted by Katzer via e-mail. On
2 information and belief, Katzer and/or Russell threatened Mr. Butcher with a patent
3 infringement lawsuit and forced him to pay patent royalties. On information and belief,
4 Defendants and Mr. Russell forced Mr. Butcher to take down his free software program.
5 After Sept. 8, 2004, “loconetdd” and “railroadd” were no longer available for download.

6 375. Then, Defendants turned their attention to the JMRI Project.

7 376. On information and belief, in late 2004 and early 2005, Defendants and Mr. Russell
8 conferred to discuss the JMRI Project software, which allows, in an atypical mode of
9 operation, for model train control through a client-server system. JMRI has a following
10 among model train enthusiasts who use model train control systems. Katzer and Russell
11 know JMRI competes with Katzer’s products. They set upon a plan, using various harassing
12 tactics, to force the JMRI Project to shut down or to pay royalties to KAM.

13 377. On or about March 8, 2005, Russell, acting upon Katzer’s instructions, sent
14 Jacobsen a letter accusing Jacobsen of infringing Claim 1 of the ‘329 patent. In this letter,
15 Russell stated that KAM had an active licensing program, and wanted to license its patent
16 to Jacobsen at \$19 per program installed on a computer. On information and belief, this
17 license was to be paid for past downloads and any future downloads. Knowing that Dr.
18 Tanner and Mr. Freiwald were threatened in 2002, and knowing Katzer’s substantial wealth
19 allowed him to sue him, Jacobsen was concerned that he faced a patent infringement
20 lawsuit. Jacobsen investigated Russell’s assertion, but concluded that he did not infringe
21 any valid claims.

22 378. Jacobsen responded to Russell’s letter on March 29, 2005. He asked for information
23 on the preliminary analysis that Russell had done and asked for Russell to show which
24 JMRI modules infringed Claim 1 of the ‘329 patent. Russell did not respond for several
25 months.

26 379. On or about Aug. 24, 2005, Russell wrote back with essentially the same response
27 he provided in his March 8, 2005 letter. He also stated that he was reviewing whether JMRI
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1 infringed any other patents issued to Katzer. Russell included no detailed explanation of
2 what JMRI modules infringed any claim in any Katzer patent. Russell claimed the license
3 for Claim 1 of the '329 patent had risen \$10 to \$29 per license, and demanded \$203,000 for
4 the 7,000 copies that Jacobsen had said, at the end of summer 2005, had been distributed.
5 On information and belief, the \$29 license was to be a license paid not only for past
6 downloads, but for future downloads. Russell enclosed a solicitation for an order and a
7 "sales receipt" from Defendants. Russell requested a response in 15 days.

8 380. On Oct. 20, 2005, Russell sent another letter to Jacobsen. He included as another
9 solicitation for an order, a statement showing an invoice for \$203,000 and finance charges.
10 The new total was more than \$206,000.

11 381. Russell had continued to send letters to Jacobsen on a roughly monthly basis.
12 Jacobsen responded on Jan. 31, 2006, stating that multiple examples of prior art anticipated
13 claims in the '329 patent and other patents supposedly invented by Katzer, and that both
14 Katzer and Russell knew about them.

15 382. On or about Feb. 7, 2006, Russell responded, and continued to accuse Jacobsen of
16 infringing the '329 patent.

17 383. On or about Oct. 27, 2005, Russell, on Katzer's and KAM's behalf, filed a Freedom
18 of Information Act request with the U.S. Department of Energy ("DOE"), seeking e-mails
19 and other communications between Jacobsen and others regarding JMRI Project software.
20 This embarrassed Jacobsen in front of his employer. Jacobsen's employer, the Lawrence
21 Berkeley National Laboratory at the University of California, has a contract with DOE, and
22 Jacobsen had used his DOE email address account on occasion to send messages to a public
23 mailing list. Jacobsen had to explain Defendants' harassing conduct to his employer and
24 DOE.

25 384. The increase in exchanges between Russell, done on behalf of Katzer and KAM,
26 and Jacobsen, has left Jacobsen in reasonable and serious apprehension that Katzer and
27 KAM will sue him, despite all parties knowing that the patents are not infringed, and are
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1 invalid and unenforceable.

2 385. A full version of the accused JMRI Project software was released in July 2007. This
3 and future versions will have the same capabilities as the accused prior version, which
4 Defendants and Mr. Russell maintain infringes the ‘329 patent. Jacobsen expects
5 Defendants, through Mr. Russell, to repeat their accusations that the new version infringes
6 the ‘329 patent.

7 386. Jacobsen seeks resolution of this matter, seeks to end Defendants’ harassment, and
8 wants redress for the harm that Defendants’ have inflicted on him and the JMRI Project –
9 even more so because, when the truth comes to light, this Court will find Plaintiff is not
10 liable for infringement.

11 Plaintiff does not use JMRI to engage in infringing activity, nor encourage others to use JMRI to
12 infringe

13 387. Plaintiff is not liable for infringement because normal operation of JMRI software
14 does not infringe claim 1 of the ‘329 patent. He also knows of no one in the United States,
15 on or after the date the ‘329 patent issued, who has used JMRI to practice the method in
16 claim 1 of the ‘329 patent.

17 388. JMRI software has several applications: DecoderPro, PanelPro, and LocoNet Tools.
18 JMRI software, and its source code, is available for download, free of charge, on the JMRI
19 website. DecoderPro, PanelPro, and LocoNet Tools have always been part of one written
20 program, in one file called jmri.jar. They have never been separate files.

21 389. Because it is written in Java, JMRI can operate on various platforms – Windows,
22 Apple Macintosh, Linux, etc.

23 390. Also, because it is written in Java, JMRI applications run within a single Java
24 Virtual Machine instance, or process, on the computer’s operating system.

25 391. Plaintiff did not write the JMRI server code.

26 392. The JMRI server code was not written in the United States.

27 393. As noted earlier, DecoderPro, the most popular JMRI application, permits model
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1 railroaders to configure a decoder chip in a model train. Chips in model trains range from
2 simple to highly complex, with multiple features to simulate a real train. Using DecoderPro,
3 a model railroader can designate that a train will act like a fast passenger train, or a slower
4 freight train, how its horn will whistle, and how its lights will flash.

5 394. PanelPro controls the operation of the model train layout. Through PanelPro, a
6 model railroader can create a replica of his hardware layout on a computer screen. This
7 allows him to shift a model train to a different track, set signals for the operator to follow,
8 and receive feedback from the layout on what each switch, train, and other hardware is
9 doing.

10 395. LocoNet Tools is a set of software tools that allow model railroaders to get or send
11 information via a LocoNet network, and to configure the LocoNet network. All its tools are
12 available through DecoderPro and PanelPro. It is a distant third in popularity.

13 396. Normal operation of JMRI software involves downloading one copy of JMRI to a
14 personal computer and installing it.

15 397. This installs a file called jmri.jar which contains DecoderPro, PanelPro and
16 LocoTools, among other JMRI offerings.

17 398. Normal operation is using one computer and one digital command station to run a
18 model train layout.

19 399. JMRI has a user group on Yahoo!, which allows JMRI users to ask others for help
20 on using the software, spread news regarding gatherings on using the software, and report
21 success in installing and using the software on their layouts. This email listserv is available
22 to the public.

23 400. Defendant Katzer has been a member of this listserv since at least Jan. 11, 2004.

24 401. Defendant Katzer could have researched through this listserv to determine if there
25 were any model railroaders who said they were using two JMRI clients and a separate
26 JMRI server to operate a model train layout.

27 402. Defendant Katzer could have also searched this listserv to determine if Plaintiff
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1 specifically encouraged a particular model railroader in the United States to use two JMRI
2 clients and a JMRI server, and if that model railroader had had any success in setting up the
3 software.

4 403. Defendant Katzer could have searched through the 5 years' worth of private emails
5 between him and Plaintiff to determine if Plaintiff had reported any model railroader in the
6 United States who was using two JMRI clients and a separate JMRI server to operate a
7 model train layout.

8 404. Neither Defendant Katzer nor Mr. Russell, identified any emails or postings
9 showing model railroaders in the United States who were using two JMRI clients and a
10 separate JMRI server to operate a model train layout.

11 405. Neither Defendant Katzer nor Mr. Russell identified any emails or postings showing
12 Plaintiff specifically encouraged a particular model railroader in the United States, on or
13 after Mar. 11, 2003, to use two JMRI clients and a separate JMRI server to operate a model
14 train layout and if that model railroader had had any success in setting up the software.

15 406. Neither Defendant Katzer nor Mr. Russell identified any emails between Defendant
16 Katzer and Plaintiff showing Plaintiff had reported a model railroader in the United States
17 who was using two JMRI clients and a separate JMRI server to operate a model train
18 layout.

19 407. Infringement of a method patent requires that someone practice the claimed method.

20 408. There is no infringement unless someone, in the United States, practices the method.

21 409. Plaintiff is not liable for infringement if he neither practiced the method nor
22 specifically encouraged another to practice the method.

23 410. On March 8, 2005, Russell wrote Plaintiff, accusing Plaintiff of infringing claim 1
24 of the '329 patent. Russell also advised Plaintiff what did not infringe claim 1 of the '329
25 patent.

26 411. In his letter, Russell said, "By way of assistance, in order to avoid further
27 infringement of claim 1 of the '329 patent, I would suggest rewriting all of the Java
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1 application instances in a single instance where JMRI instance manager can satisfy one
2 creation request.”

3 412. In fact, JMRI, whose applications are in one file, jmri.jar, runs within a single
4 instance of the Java Virtual Machine on a computer’s operating system. When a user starts
5 a JMRI application, the user invokes the same jmri.jar file that other JMRI applications use.
6 The commands that a JMRI application sends come from the jmri.jar/Java Virtual Machine
7 process and are sent to the digital command station.

8 413. There are no such things as separate Java application instances because when a Java
9 program is invoked, it runs within a single Java Virtual Machine instance. No matter how
10 many Java applications are invoked, there remains only one Java Virtual Machine instance.

11 414. There is no such thing as a JMRI instance manager that creates “application
12 instances.” The InstanceManager class within JMRI provides functions to create and
13 manage objects within a single application such as sets of railroad turnouts and sets of
14 sensors. InstanceManager is not a program by itself, but instead an integral part of a single
15 program that is not accessible from the outside.

16 415. Thus using Russell’s definition of non-infringement, normal operation of any
17 version of JMRI software does not infringe claim 1 of the ‘329 patent.

18 416. Also in his March 8, 2005 letter to Plaintiff, Mr. Russell stated,
19 During operation of the JMRI software programs, our analysis indicates that the
20 software includes the functionality to communicate over a TCP/IP connection with
21 an installed JMRI server. The JMRI server in turn communicates with a command
22 station for a model railroad. Our analysis further indicates that the JMRI server is
23 capable of receiving commands from all of the Java application instances and then
24 commands are forwarded to the command station, and likewise retrieving
25 commands from the command station and providing them to corresponding separate
26 Java application instance.

27 417. On information and belief, neither Defendants nor Mr. Russell actually operated and
28 analyzed JMRI code to conduct a detailed and competent infringement analysis.

418. Normal operation of JMRI does not use the TCP/IP connection.

419. In the next paragraph of the letter, Mr. Russell states, “Claim 1 of U.S. Patent
6,530,329 claims a method of operating a digitally controlled model railroad....” (emphasis

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added).

420. Mr. Russell never identified any person who used JMRI software to communicate over a TCP/IP connection to a JMRI server.

421. Mr. Russell never identified how Plaintiff encouraged any person to use two JMRI client programs with a JMRI server to operate a model train layout.

422. Plaintiff knows no one who has used two JMRI client programs with a separate JMRI server to operate a model train layout in the United States on or after Mar. 11, 2003. Nearly all who use JMRI use the program on one computer, and only one computer. They have no need to set up three separate computers to accomplish what one computer will do.

423. Even if a person could use JMRI to practice the method in claim 1 of the ‘329 patent, JMRI has significant non-infringing uses under Russell’s definition of non-infringement.

424. Mr. Russell wrote Plaintiff again on Aug. 24, 2005.

425. In his letter, Mr. Russell said, “The JMRI software that you distribute on your website continues to infringe U.S. Patent No. 6,530,329 B2.” Mr. Russell accused Plaintiff of infringing claim 1 of the ‘329 patent.

426. Mr. Russell said,

Our analysis of your existing implementation of the JMRI software indicates that it includes several distinct programs (e.g., interface instances) which communicate over a TCP/IP connection with an installed JMRI server. The JMRI server in turn communicates with a command station or a model railroad. In addition, our analysis indicates that the JMRI server is capable of receiving commands from all of the Java application instances.

427. On information and belief, neither Defendants nor Mr. Russell actually operated and analyzed JMRI code or conducted a detailed and competent infringement analysis.

428. Mr. Russell never identified what the “several distinct programs” or “interface instances” were.

429. He never identified which of these “several distinct programs” and “interface instances” used the TCP/IP connection.

430. Mr. Russell never identified any person who used JMRI to communicate over a

1 TCP/IP connection to a JMRI server.

2 431. Mr. Russell never identified any person who used the JMRI server to run a model
3 railroad layout.

4 432. Further in his Aug. 24, 2005 letter, Mr. Russell said, “In order to avoid further
5 infringement, you will need to modify the JMRI software so that it is a single program.”

6 433. As noted earlier, the “programs” – LocoNet Tools, DecoderPro and PanelPro – are
7 part of a single written file, jmri.jar. Thus, under Mr. Russell’s definition, JMRI does not
8 infringe because there is no second program. Furthermore, when the JMRI applications are
9 in regular use, they do not use the TCP/IP connection or the JMRI server.

10 434. Mr. Russell went on to say,
11 You will need to include controls to ensure that only one single program is running
12 and capable of providing commands to the model railroad. If you want to execute
13 another program you will need to terminate the current program prior to starting the
14 other program.

15 435. Russell did not explain why Plaintiff should be required to put in any controls when,
16 in normal operation, only a single file – jmri.jar – is running and thus no infringement of
17 claim 1 of the ‘329 patent will occur.

18 436. Had Russell done a competent and detailed infringement analysis, he would have
19 known that JMRI did not infringe claim 1 of the ‘329 patent.

20 437. Because Russell had not done the required analysis, Russell’s and Defendants’
21 demands were made in bad faith.

22 438. After failing to review the JMRI software, and producing an incomplete and
23 incompetent analysis, Mr. Russell demanded \$203,000 for what he maintained was
24 infringing JMRI software that had been downloaded 7,000 times.

25 439. Defendant Katzer prepared, and Russell included, an invoice for 7,000 copies of
26 KAM software that Plaintiff never ordered and never owed to Defendants.

27 440. Because neither he nor anyone else has practiced the method in claim 1 of the ‘329
28 patent in the United States on or after March 11, 2003, Plaintiff is not liable for
infringement.

1 441. Because there is no evidence that Plaintiff has encouraged anyone to practice the
2 method in the United States on or after March 11, 2003, Plaintiff is not liable for indirect
3 infringement.

4 442. Because JMRI's normal operation involves using only one program to transmit
5 commands to a digital command station, and the claims require three programs (2 JMRI
6 clients and 1 JMRI server), using JMRI in its normal operation will not infringe claim 1 of
7 the '329 patent.

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9 Summary

10 443. Aware that many others had practiced using networks to control model train layouts,
11 Defendants and Mr. Russell nevertheless claimed that very subject matter in claim 1 of the
12 '329 patent. They did not produce material references – Railroad & Co, WinLok, ROSA,
13 Digitrax, Webster, Bushby, or Digitrax – to the examiners.

14 444. When an accused infringer, Dr. Tanner of DigiToys, confronted them with their
15 inequitable conduct and fraud on the Patent Office, Defendants and Mr. Russell hid the
16 prior art from the Patent Office examiners.

17 445. Defendants and Mr. Russell engaged in a pattern of fraud on the Patent Office and
18 inequitable conduct, in obtaining patents.

19 446. In U.S. Application No. 10/889,995, Defendants and Mr. Russell submitted the
20 exact same claims as those in the patent-in-suit, U.S. Patent No. 6,530,329. Although
21 required under MPEP, neither Defendants nor Mr. Russell told the examiner that they were
22 submitting claims that were invalid for Sec. 101 double patenting. The examiner rejected
23 all claims of the '995 application as invalid under Sec. 102(e) or as obvious under Sec. 103.
24 The bulk of the rejections were based on (1) the massive quantity of references – more than
25 5,000 pages – that Defendants and Mr. Russell finally produced in May and June 2006 after
26 Plaintiff accused them of inequitable conduct, and (2) DigiToys, applicant-admitted prior
27 art. Defendants and Mr. Russell had withheld and/or misrepresented these references.

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Thus, all claims of the '329 patent, including the claim asserted against Plaintiff, should also be invalid and unenforceable.

447. Defendants infringed Plaintiff's copyrights and continue to do so with no remorse.

448. Defendants cybersquatted on Plaintiff's domain name, and have been misusing other JMRI intellectual property. Defendants show no remorse for their actions.

449. Because only one file is used in normal operation of JMRI, neither Defendants nor Mr. Russell ever had any evidence that JMRI was used to infringe claim 1 of the '329 patent and certainly no evidence that 7,000 users were infringers.

COUNT ONE

Declaratory Judgment of Unenforceability of the '329 patent

Against all Defendants

450. Jacobsen repeats and realleges each and every allegation in paragraphs 1 through 449.

451. Through their conduct, Katzer and KAM claim that the '329 patent is enforceable.

452. Jacobsen contends that the patent is unenforceable because of the fraud which Katzer and Russell committed on the Patent Office, and inequitable conduct including withholding material references and lying about being the sole inventor.

453. By reason of paragraphs 450 through 452, an actual controversy exists between Jacobsen and Katzer and KAM as to the enforceability of the '329 patent. Jacobsen desires a judicial determination and declaration of respective rights and duties of the parties. Such a determination is necessary and appropriate at this time in order that the parties may ascertain their respective rights and duties.

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COUNT TWO

Declaratory Judgment of Invalidity of the '329 patent

Against all Defendants

454. Jacobsen repeats and realleges each and every allegation in paragraphs 1 through 449.

455. Through their conduct, Katzer and KAM maintain that claim 1 of the '329 patent is valid.

456. Jacobsen contends that many, if not all, enforceable claims in the '329 patent are invalid under 35 U.S.C. §§ 102(a), 102(b), 102(e), 102(f), 102(g)(2), 103 and 112 ¶ 1.

457. By reason of paragraphs 454 through 456, an actual controversy exists between Jacobsen and Katzer and KAM as to the validity of the '329 patent. Jacobsen desires a judicial determination and declaration of respective rights and duties of the parties. Such a determination is necessary and appropriate at this time in order that the parties may ascertain their respective rights and duties.

COUNT THREE

Declaratory Judgment of Non-infringement

Against all Defendants

458. Jacobsen repeats and realleges each and every allegation in paragraphs 1 through 449.

459. Katzer and KAM claim products that Jacobsen distributes, infringe claim 1 of the '329 patent.

460. Jacobsen contends that that he does not, and has not, infringed any valid and enforceable claim of the '329 patent, because (1) there are no valid and enforceable claims, (2) no one in the United States, on or after March 11, 2003, has practiced the claimed

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methods using JMRI applications, (3) the methods normally practiced by JMRI applications do not read on claim 1 of the '329 patent, and/or (4) because Katzer has granted implied licenses to hobbyists such as Jacobsen through free distribution of Katzer's own products on KAM CDs.

461. By reason of paragraphs 458 through 460, an actual controversy exists between Jacobsen and Katzer and KAM as to the non-infringement of claim 1 of the '329 patent. Jacobsen desires a judicial determination and declaration of respective rights and duties of the parties. Such a determination is necessary and appropriate at this time in order that the parties may ascertain their respective rights and duties.

COUNT FOUR

VIOLATION OF COPYRIGHT LAWS

Against all Defendants

462. Jacobsen repeats and realleges each and every allegation in paragraphs 1 through 449.

463. Plaintiff's work, and the work of other authors, is original. He created the work, and for work created by others, plaintiff received valid assignments of the copyright from the other creators. Thus, he is the owner and assignee of valid copyrights.

464. The copyrighted works are the subject of valid Certificates of Copyright Registration issued by the Register of Copyrights, or pending registrations.

465. Among the exclusive rights granted to plaintiff under the Copyright Act are the exclusive rights to reproduce the copyrighted work, distribute the copyrighted work to the public, and make derivative works from the copyrighted work.

466. Defendants had access to plaintiff's work.

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467. Defendants copied original elements from the copyrighted work. There are substantial similarities between Defendants' work and original elements of plaintiff's copyrighted work.

468. Plaintiff is informed and believes that Defendants, without permission or consent, have made copies, distributed copies to the public, or created derivative works in violation of the exclusive rights. Defendants' actions constitute infringement of plaintiff's copyright and exclusive rights under the Copyright Act.

469. Plaintiff placed proper notices of copyright pursuant to 17 U.S.C. Sec. 401 on the works.

470. Plaintiff is informed and believes that the foregoing acts of infringement have been willful, intentional, in disregard of and with indifference to the rights of plaintiff.

471. Defendants have a financial interest and the right and ability to supervise others' infringing activities, such a reproducing, preparing derivative works, distributing and using the works.

472. Defendants knew or should have known of infringing activity and induced or caused or materially contributed to the activity.

473. Plaintiff seeks statutory damages under 17 U.S.C. Sec. 504 for Defendant's infringement of JMRI Decoder Definitions v. 0.9 (Reg. No. TX6-507-133), JMRI Decoder Definitions v. 1.0 (Reg. No. TX6-504-013), JMRI Program and Decoder Definitions v. 1.1 (Reg. No. TX6-611-720), JMRI Decoder Program and Definitions v. 1.2.5 (Reg. No. TX6-611-718), JMRI Program and Decoder Definitions v. 1.4 (Reg. No. TX6-611-719), JMRI Program and Decoder Definitions v. 1.6 (Reg. No. TX6-586-384), JMRI Program and Decoder Definitions v. 1.7.3 (registration pending), JMRI Program and Decoder Definitions

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474. Plaintiff seeks actual damages and disgorgement of profits, under 17 U.S.C. Sec. 504 for Defendants' conduct that infringed JMRI Decoder Definitions v. 1.7.1 (Reg. No. TX6-373-493, and Reg. No. TX6-580-850), and for infringement of copyright registrations for which this Court, at a later date, finds statutory damages are not available.

475. Where available, Plaintiff seeks enhanced statutory damages for willful infringement under 17 U.S.C. Sec. 504, and attorney's fees and costs under 17 U.S.C. Sec. 505.

476. Unless Defendants are enjoined in their wrongful conduct, Jacobsen will suffer irreparable injury and harm for which there is no adequate remedy at law. Thus, pursuant to 17 U.S.C. Sec. 502 and 503, plaintiff is entitled to injunctive relief prohibiting Defendants from further infringing plaintiff's copyrights and an order directing Defendants to deliver and destroy all copies of infringing products made in violation of Plaintiff's exclusive rights.

COUNT FIVE

Violation of DMCA § 1202

Against Defendants Katzer and KAMIND Associates, Inc

477. Jacobsen repeats and realleges each and every allegation in paragraphs 1 through 449.

478. Jacobsen holds valid copyright registrations for the JMRI Decoder Definition Files, and is the owner and assignee of the copyrights.

1 479. Each JMRI Decoder Definition Files had an author's name, a title, a reference to the
2 license and where to find the license, a copyright notice, and the copyright owner. This
3 information constitutes copyright management information under Sec. 1202.

4 480. Plaintiff used a software script to automate adding copyright notices to the files.

5 481. Defendants Katzer and KAMIND Associates, Inc. intentionally removed from or
6 altered copyright management information, without authority from the copyright holder,
7 Plaintiff, or the law, in the JMRI Decoder Definition Files.

8 482. Defendants Katzer and KAMIND Associates, Inc. distributed copyright
9 management information knowing that copyright management information had been
10 removed from or altered in the JMRI Decoder Definition Files, without the authority of the
11 copyright owner, Plaintiff, or the law.
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13 483. Defendants Katzer and KAMIND Associates, Inc. distributed works or copies of
14 works, knowing that the copyright management information had been removed from or
15 altered in the JMRI Decoder Definition Files, without the authority of the copyright owner,
16 Plaintiff, or the law.
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18 484. Defendants knew, or had reasonable grounds to know, that their actions would
19 induce, enable, facilitate, or conceal an infringement of Plaintiff's exclusive rights in his
20 copyrights.
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22 485. Defendants Katzer and KAMIND Associates, Inc. provided and/or distributed, or
23 caused to be provided and/or distributed, KAMIND Associates, Inc.'s software, made from
24 the JMRI Decoder Definition Files, with a false or misleading copyright management
25 information, including a false or misleading title, a false or misleading author, a false or
26 misleading copyright holder and a false or misleading terms and conditions of the work.
27 Defendants took these actions knowingly, and with the intent to induce, enable, facilitate, or
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conceal infringement. Thus, Defendants Katzer and KAMIND Associates, Inc. should pay statutory damages, attorneys fees and costs for each of their willful violations of the DMCA Sec. 1202(a) and 1202(b).

COUNT SIX

Breach of Contract under California law

Against Defendants Katzer and KAMIND Associates, Inc

- 486. Jacobsen repeats and realleges each and every allegation in paragraphs 1 through 449.
- 487. Jacobsen offers use of the Decoder Definition files to others, under the Artistic License.
- 488. Beginning in 2005, Defendants accepted Plaintiff's offer to permit use of the Decoder Definition files. The use was subject to the Artistic License which had conditions.
- 489. Plaintiff performed his part of the contract.
- 490. Defendants failed and refused to perform the agreement because they made no effort to honor any of the terms or conditions of the Artistic License.
- 491. By reason of breach, Plaintiff has been harmed.
- 492. Plaintiff seeks rescission, and disgorgement of the value he conferred on Defendants, plus interest and costs.

COUNT SEVEN

CYBERSQUATTING IN VIOLATION OF 15 U.S.C. § 1125(d)

Against Defendants Katzer and KAMIND Associates, Inc.

- 493. Jacobsen repeats and realleges each and every allegation in paragraphs 1 through 449.
- 494. Jacobsen and the JMRI Project are the owners of the trademark DECODERPRO.

- 1 495. Katzer knew that DECODERPRO is a JMRI Project trademark.
- 2 496. On information and belief, Defendants registered the domain name decoderpro.com,
3 in violation of Section 43 of the Lanham Act, 15 U.S.C. § 1125(d).
- 4 497. Jacobsen had rights to the trademark DECODERPRO before Defendants registered
5 the name.
- 6 498. Defendants trafficked in the domain name when they transferred it to Jerry Britton
7 and held on to rights in the domain name by threatening to force Mr. Britton to pay \$20,000
8 and attorneys' fees if Mr. Britton transferred the domain name to another person, including
9 the rightful owner, Jacobsen.
- 10 499. Thus, Defendants intended to profit in bad faith from the goodwill of Jacobsen's
11 mark.
- 12 500. Jacobsen seeks statutory damages under 15 U.S.C. § 1117.
- 13 501. Unless Defendants are enjoined in their wrongful conduct, Jacobsen will suffer
14 irreparable injury and harm for which there is no adequate remedy at law.

15 PRAYER FOR RELIEF

16 WHEREFORE, Jacobsen respectfully requests that the Court enter

- 17 A. A declaration that Jacobsen has not and does not infringe any valid and enforceable claim
18 of the '329 patent.
- 19 B. A declaration that the '329 patent is invalid.
- 20 C. A declaration that the '329 patent is unenforceable because of fraud on the Patent Office
21 during the prosecution of the '461 application.
- 22 D. A declaration that the '329 patent is unenforceable because of inequitable conduct during
23 the prosecution of the '461 application.
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- 1 E. A declaration that the '329 patent is unenforceable because of fraud on the Patent Office
- 2 during the prosecution of the '878 application.
- 3 F. A declaration that the '329 patent is unenforceable because of inequitable conduct during
- 4 the prosecution of the '878 application.
- 5 G. An injunction prohibiting Defendants, their officers, agents, employees, assigns, attorneys,
- 6 parents, subsidiaries or other persons in active concert or participation with Defendants
- 7 from asserting any claim of the '329 patent against any other person in the United States.
- 8 H. An order finding that Katzer has cybersquatted on the trademarked name, decoderpro.com,
- 9 owned by Jacobsen in violation of the Lanham Act, 15 U.S.C. § 1125(d).
- 10 I. An order enjoining Katzer and KAM, and all persons and entities under their direction or
- 11 control, from engaging in or carrying out any further conduct in violation of the Lanham
- 12 Act.
- 13 J. An award for statutory damages pursuant 15 U.S.C. § 1117.
- 14 K. An accounting by Defendants of any and all profits derived from Defendants' wrongful acts
- 15 and an award to plaintiff of such profits made by Defendant, in an amount to be proven at
- 16 trial pursuant to 15 U.S.C. § 1117(a).
- 17 L. An award of treble damages of enhanced profits on account of Defendants' willful,
- 18 intentional, and bad faith conduct, pursuant to 15 U.S.C. § 1117(b).
- 19 M. An order finding that Katzer has willfully infringed copyrights, and an award for statutory
- 20 damages and enhanced statutory damages for infringement of JMRI Decoder Definitions v.
- 21 0.9, JMRI Decoder Definitions v. 1.0, JMRI Program and Decoder Definitions v. 1.1, JMRI
- 22 Program and Decoder Definitions v. 1.2.5, JMRI Program and Decoder Definitions v. 1.4,
- 23 JMRI Program and Decoder Definitions v. 1.6, JMRI Program and Decoder Definitions v.
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1.7.3, JMRI Program and Decoder Definitions v. 1.7.7, and JMRI Program and Decoder Definitions v. 1.8.

N. An order finding that Katzer has willfully infringed copyrights, and an award for actual damages and disgorgement of profits for infringement of JMRI Decoder Definitions v. 1.7.1.

O. For copyrights for which statutory damages are not available, an order finding that Katzer has willfully infringed copyrights, and an award for actual damages and disgorgement of profits for willful infringement of those copyrights.

P. An order requiring Katzer and KAM, and all persons and entities under their direction or control, to deliver and destroy all infringing products.

Q. An order finding that Defendants have violated 17 U.S.C. Sec. 1202(a), and an award of statutory damages of \$25,000 for each violation.

R. An order finding that Defendants have violated 17 U.S.C. Sec. 1202(b), and an award of statutory damages of \$25,000 for each violation.

S. An order enjoining Defendants from violating 17 U.S.C. Sec. 1202, or encouraging others to violate 17 U.S.C. Sec. 1202.

T. An order rescinding any contract between Plaintiff and Defendants, and, finding that Katzer has unjustly enriched himself and KAM, ordering Defendants to provide restitution and/or disgorgement of the value Plaintiff conferred on Defendants.

U. A determination by the Court that this is an exceptional case and that therefore plaintiff be awarded costs and attorney's fees as permitted by law, including 35 U.S.C. § 285, 17 U.S.C. § 505, 15 U.S.C. § 1117(a), and 28 U.S.C. § 1927.

V. An order granting any other damages or remedy to which plaintiff may be entitled.

W. An order granting any other relief the court finds just.

