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

13 ROBERT JACOBSEN,) No. C-06-1905-JSW
14)
Plaintiff,)
15)
v.) **SUPPLEMENTAL DECLARATION OF**
16) **ROBERT JACOBSEN IN SUPPORT OF**
MATTHEW KATZER, an individual, and) **MOTION FOR PRELIMINARY**
17) **INJUNCTION**
KAMIND ASSOCIATES, INC, an Oregon)
18)
corporation dba KAM Industries,)
19)
Defendants.)
20)

Courtroom: 2, 17th Floor
Judge: Hon. Jeffrey S. White

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

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

25 GAINING ACCESS TO JMRI DECODER DEFINITION FILES

26 1. As one of the leaders of the JMRI Project since 2001, I know how JMRI distributes its software
27 through the SourceForge.net website. This software is subject to a license called the Artistic
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- 1 License. A true and accurate copy of this license is attached as Exhibit A.
- 2 2. There are two ways to download the software. A person can download a complete “released”
3 version, containing both the complete set of JMRI Decoder Definition Files and other
4 components. A person can download any of the individual files created by project members,
5 including the individual JMRI Decoder Definition Files.
- 6 3. To download a complete released version, a person clicks a URL such as
7 <http://prdownloads.sourceforge.net/jmri/JMRI.1.7.1.exe?download>, taking him or her to a web
8 page. A true and accurate copy of this webpage is attached as Exhibit B. Most web browsers
9 will also start downloading the version at this point. Some web browsers will require clicking
10 one of the "Download" links in the right-center of the page. Once the download is complete,
11 most browsers will start the installation process. Some browsers will require moving or
12 clicking the downloaded file to start the installation. At no point in this process does the
13 software or download present anyone with a license agreement to accept.
- 14 4. To download individual files, a person navigates from the main JMRI web site to the repository
15 that contains all of the JMRI source code. Individual files can then be examined. Attached as
16 Exhibit C is a typical web page from which a JMRI Decoder Definition file can be examined or
17 downloaded. At no point in this process does the software or download present anyone with a
18 license agreement to accept.

19 ATTEMPTING TO RECLAIM THE DECODERPRO.COM DOMAIN NAME

- 20 5. On or about Oct. 12, 2004, I learned that Defendant Katzer had registered the decoderpro.com
21 domain name.
- 22 6. Because of the significant controversy the discovery of this action had caused, I waited to see if
23 Defendant Katzer would relinquish the name voluntarily. He did not.
- 24 7. On Nov. 8, 2004, I wrote him a letter demanding that he transfer the name to me. A true and
25 accurate copy of this letter is attached as Exhibit D.
- 26 8. I never received a reply to this letter.
- 27 9. By Nov. 8, 2004, Katzer had already filed suit against Jerry Britton.

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1 WHEN INFRINGEMENT DISCOVERED

2 10. In May 2006 I began further investigation of Defendants’ software products in connection with
3 filing the opposition to the anti-SLAPP motions.

4 11. I did not have a copy of a recent version of Defendants’ software at that time. I also did not
5 have a computer with the correct Windows version to run Defendants’ software. I updated a
6 computer to the required Windows version and attempted to download a copy of Defendants
7 software. As part of this, I identified myself on Defendants’ web site, thus informing them that
8 I was trying to examine their software. Due to technical difficulties, I was not able to get a
9 complete version of their software.

10 12. I downloaded a copy of the Decoder Commander manual from the Defendants’ web site. This
11 manual was dated Oct. 4, 2005. The manual contains several figures showing Defendants’
12 program and text it displayed. I recognized the text as coming from the JMRI Decoder
13 Definition Files.

14 13. Based on this, I believed Defendants were infringing the JMRI copyright. Although very busy
15 with work on three oppositions and their declarations due by June 9, 2006, I immediately
16 started to gather assignments from my JMRI co-authors. I had an appropriate assignment
17 agreement prepared immediately, and sent it out to the co-authors June 5-6, 2006. I received
18 them back over the approximately the next week. I then submitted a copyright registration for
19 the JMRI Decoder Definition Files on June 13, 2006, paying approximately \$500 extra for
20 expedited handling due to pending litigation – this case. The registration was delayed in the
21 Copyright Office. I called the Copyright Office several times to follow up, sometimes waiting
22 an hour on hold. I eventually received the registration from the Copyright Office on Aug. 14,
23 2006. The registration is attached as Exhibit C to the Amended Complaint [Docket #96].

24 14. Meanwhile, on June 5, 2006, Alex Shepherd emailed me that he had downloaded from
25 Defendants’ web site a “utility that imports templates”. Attached as Exhibit E is a true and
26 accurate copy of this email. He included a copy of the download as a compressed file, and also
27 the contents of the “readme” information. This “readme” file says in part:

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1 4. If you wish to use third party templates, you can run the template conversion on
2 the third party template. We have added "tabs" in the menu to allow you to select
3 the format and convert it to the a Decoder Commander template.

3 and

4 As we become aware of third party templates, we will list them here for your
5 reference. Different software producers have different rules on the use of their
6 decoder templates. Please check with the produce and verify that you have the rights
7 to use there templates.

6 Non dtd templates

7 o Use the verifcaion tab for conversion

8 JMRI templates:

9 o These are located at <http://jmri.sourceforge.net/xml/decoders/>

10 o You will need to download the schema at <http://jmri.sourceforge.net/xml/DTD/>

11 o You can also download the s/w at <http://jmri.sourceforge.net/download/>

12 15. After receiving Alex Shepard's email, I downloaded Defendants' template tool from their web
13 site on June 6, 2006. I found that it worked as Alex Shepherd had described.

14 16. I sought a copy of Defendants' Decoder Commander product CD from several sources. I finally
15 obtained one on June 16, 2006. The CD, which was labeled as "TS3.30.304", contains version
16 304 of the software. I examined its contents, and found that the template files were named
17 exactly the same, except for file extension, as the JMRI Decoder Definition Files. I describe
18 my findings in the Declaration accompanying the Motion for Preliminary Injunction, thus I
19 won't repeat them again here.

20 17. The day I received the copyright registration, I ordered a copy of Defendants' Engine
21 Commander software from a supplier. I received it on Aug. 21, 2006. I examined the CD's
22 contents. It was labeled "TS3.30.304", and appeared to have contents identical to the Decoder
23 Commander CD I bought in June. It includes the KAM decoder templates that were copied
24 from the JMRI Decoder Definition Files.

25 18. Also on Aug. 14, 2006, I was again able to download the template verifier tool from the
26 Defendants' website.

27 19. During the period of June through August 2006, I made three trips of about a week each to
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1 Europe on University business. This included separate trips to Switzerland, Finland and
2 Denmark. I also traveled regularly out of state. These greatly reduced the amount of time I
3 could spend on installing and investigating Defendants software.

4 20. In September, I obtained copies of Engine Commander and Decoder Commander products.
5 They were both version 305. Both CDs included KAM decoder templates that were copied
6 from the JMRI Decoder Definition Files.

7 DEFENDANTS' INFRINGEMENT WILL NOT END AS DEFENDANT KATZER STATES

8 21. In his declaration [Docket # 124], Defendant Katzer stated his infringement will naturally end
9 due to technical limitations he has put in his software. Specifically, he says:

10 "All existing non-registered copies of V304 and V304A became non-functional on October
11 10, 2006."

12 22. I made several tests of this on November 10, 2006 using a computer on which a non-registered
13 copy of version 304 of Decoder Commander had been installed. I found:

- 14 i) Defendants template files, which had been copied from the JMRI Decoder
15 Definition Files, were still present and easily readable
- 16 ii) The template verifier tool still ran.
- 17 iii) The Decoder Commander program would not connect to the model railroad layout,
18 giving various error messages, but it would still display the infringing material from
19 the Decoder Definition Files.

20 23. Defendant Katzer also states: "Outstanding non-registered copies of V305 will become non-
21 functional on January 21, 2006". (I believe he meant January 21, 2007.) I tested this by
22 installing a non-registered copy of version 305 on a computer, and then setting the computer's
23 date to November 10, 2007, effectively making the program think it was after January 21,
24 2007.

- 25 i) The version V305 template files, which had been copied from the JMRI Decoder
26 Definition Files, were present and easily readable.
- 27 ii) The Decoder Commander program would not connect to the model railroad layout,
28 giving various error messages, but it would still display the infringing material from

1 the Decoder Definition Files.

2 24. I received a copy of version V306 of Defendants’ software in late September directly from
3 Defendant Katzer. V306 removed one template file that had been copied from the JMRI
4 Decoder Definition Files, but other material remains. Defendant Katzer states: “Outstanding
5 non-registered copies of V306 will become non-functional on March 21, 2006.” (I believe he
6 meant March 21, 2007.) I tested this by installing a non-registered copy of version 306 on a
7 computer, and then setting the computer’s date to November 10, 2007, effectively making the
8 program think it was after March 21, 2007.

- 9 i. The version V306 template files, which had been copied from the JMRI Decoder
10 Definition Files, were present and easily readable.
- 11 ii. The Decoder Commander program would not connect to the model railroad layout,
12 giving various error messages, but it would still display the infringing material from
13 the Decoder Definition Files. Exhibit F is a true and accurate copy of the screen
14 shot. Comparing this screen shot with paragraph 51 of this declaration, one can see
15 that the CV names were taken from the JMRI Decoder Definition Files.

16 25. Defendants make no statement about registered copies of their software – specifically, whether
17 a registered copy of their programs will ever expire and stop working. Cf. Declaration of
18 Matthew Katzer in support of Response to Opposition to Plaintiff’s Motion for a Preliminary
19 Injunction, at ¶¶ 21, 25, 28 (discussing “non-registered” copies of their software). I have no
20 reason to believe that registered copies of Defendants’ programs will not continue to use the
21 infringing information indefinitely.

22 26. On Nov. 15, 2006, I received Defendants’ product CD labeled as version 307. I inspected its
23 contents, and found no visible decoder template files. In Defendant Katzer’s declaration, he
24 states that “Decoder Commander V307 will now look to an entirely new database for
25 manufacturers’ specification data. JMRI decoder definition data was not used in any way to
26 construct this database.” I was unable to check this assertion because the installed version of
27 Decoder Commander would not run, preventing me from examining its screen displays.
28 Attached as Exhibit G is a true and accurate copy of a screen-shot of what happens when the

1 program is started.

2 INFRINGING ITEMS REMAIN AVAILABLE ON DEFENDANTS' WEB SITE

3 27. On November 10, 2006, I downloaded a copy of the "Decoder Commander software
4 Configuration and User Manual". It carries a revision date of 10/31/2006 on the second page.

5 28. Information copied from the JMRI Decoder Definition Files appears in figure 13 on page 20,
6 page 14 on page 21, and figure 15 on page 22 in this manual, among others. Attached as
7 Exhibit H is a true and accurate copy of this manual. Comparing figure 15 from Exhibit H with
8 my discussion in paragraph 21 of my declaration filed earlier with the Motion, one can see that
9 Defendants took their template from the JMRI Decoder Definition File.

10 29. These figures are screen shots taken from the running program.

11 30. On November 10, 2006, I downloaded a copy of Defendants' web page that describes their
12 Decoder Commander product from their web site. Attached as Exhibit I is a true and accurate
13 copy of this web page. It contained in part:

14 Decoder Commander can read third party decoder templates using our Smart
15 Decoder® editor. The smart decoder editor allows you to read third party templates,
16 create your own decoder template and verify existing Decoder Commander
17 templates.

18 To use this feature, download KAM's Smart Decoder Template utility form our
19 download area and convert the 3rd party templates to a Decoder Commander
20 format. This utility is not included in the Train Tools software release. The smart
21 decoder utility verifies the template information and adds additional information
22 that is needed to be used by Decoder Commander.

23 Note: Before you convert any third party template, you will need to verify that the
24 3rd party tempalte license agreement allows you to run the smart decoder
25 conversion utility on the 3rd party template. Kam software supports Microsoft
26 current operating systems, Win CE (PC2002-03, Mobile 5.x), Win 200x, Windows
27 XP and .NET servers.

28 31. On November 16, I downloaded a description of Defendants' Decoder Commander product
from the web site of their distributor in Cincinnati, Ohio. Attached as Exhibit J is a true and
accurate copy of this page. This page contains the same language about reading third party
decoder templates and Defendants' Smart Decoder Template utility.

32. On November 16, I downloaded a similar description of Defendants' Decoder Commander
product from the web site of their UK distributor. Attached as Exhibit K is a true and accurate

1 copy of this page. This page contains the same language about reading third party decoder
2 templates and Defendants' Smart Decoder Template utility.

3 33. On Nov. 10, 2006, I downloaded an advertising flyer from Defendants web site. Attached as
4 Exhibit L is a true and accurate copy of that flyer. It says in part:

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

8 CREATING THE DECODER DEFINITION FILES INVOLVES SELECTION, GROUPING
9 AND ORDERING OF VARIABLES

10 34. The computer chips, called decoders, in model trains control the train's operation. Modern
11 decoders can control lights and sounds from the locomotives, provide precise control of the
12 speed and power of the motor, and do other advanced functions. To adjust and configure these
13 functions, the user can put new values into "Configuration Variables" (CVs) in the decoder.
14 Each Configuration Variable controls one or more aspects of the decoder (and therefore, model
15 train's) operation.

16 35. For example, a particular CV may control the pitch of a sound. Another might control when
17 that sound is played. Another might provide a number of bits for selecting which lights come
18 on at the same time.

19 36. Basic decoders may have only a few Configuration Variables, because they have few
20 adjustments. More advanced decoders, such as those that provide sounds or complicated
21 lighting effects, will generally have many more Configuration Variables. All decoders have
22 certain CVs in common, but generally the number and ordering of CVs differ greatly from one
23 manufacturer's decoder to another.

24 37. To ease the task of setting proper values into a large number of Configuration Values (CVs),
25 several different programs exist that allow you to use a computer screen, keyboard and mouse
26 to set the values. JMRI provides one of these, called DecoderPro. Defendants' provide
27 another, called Decoder Commander. There are numerous others.

28 38. For these programs to function, they must have information about what each Configuration

1 Variable does. This information is called a decoder definition by JMRI, and a decoder template
2 by Defendants. (In contrast, the Decoder Definition Files are the files, in XML format, which
3 contain this information. Defendants' decoder template is in another format, but has the same
4 contents.)

5 39. Decoder definitions are separate from the programs that use them.

6 40. The decoder definition contains, in an organized way, the author's ideas about how best to
7 configure a specific type of decoder. A program can then use that information to create screens
8 and interact with the user to understand the user's desires, and then to properly configure the
9 decoder by setting Configuration Values.

10 41. Multiple decoder-setting programs can use the same decoder definition, just like differing MP3
11 players, say an iPod or a computer, can play the same songs. The internal operation of the
12 decoder programs, and the language in which they are written, is irrelevant to the end result –
13 setting Configuration Variables on the decoder. And like an iPod without songs, a decoder-
14 setting program is next to useless without a decoder definition. Without the definitions –
15 whether in a database or in their decoder templates, Decoder Commander would be essentially
16 inert and without value to the customers.

17 42. I have written a number of the JMRI Decoder Definition Files from scratch. I have edited
18 others. I have helped people create and edit Decoder Definition Files.

19 43. The process of creating a decoder definition file involves understanding information from a
20 number of sources, integrating it, and then expressing it in a way useful to model railroaders.

21 44. As an example, consider the first configuration variable (CV) present in the decoder, which is
22 numbered as CV 1. CV 1 contains an eight-bit number that determines the digital address to
23 which the decoder will respond. For technical reasons, it can only have values from 1 to 127.
24 This quantity is called different things in different documents.

25 45. The "Recommended Practices" document of the National Model Railroad Association
26 (NMRA) refers to CV1 as the "Primary Address". Exhibit M is a copy of this Recommended
27 Practice document.

28 46. Lenz, a prominent German manufacturer of decoders, refers to CV1 as "Locomotive Address"

1 in their manuals. Exhibit N is a copy of a Lenz manual that shows this on page 8.

2 47. Digitrax, a prominent manufacturer of decoders based in Norcross, Georgia, calls CV1 “2-digit
3 address” in their manuals. Exhibit O is a copy of a Digitrax manual that shows this on page 2.

4 48. Many model railroaders refer to this as the “short address”, because there is another place to
5 store addresses that can be up to four digits long, called the “long address”.

6 49. Decoder definitions express the author’s idea of how model railroaders can most easily use a
7 program to configure a decoder. As such, the author considers the names that both the NMRA
8 and the manufacturer uses, plus the several terms that are in common use, and then picks or
9 creates one to include in the decoder definition.

10 50. I wrote several of the early Decoder Definition Files. In them, I described CV 1 as “Primary
11 Address”. I did not include any of the manufacturer-specific forms, because they are less
12 commonly used. This is present in the JMRI Decoder Definition Files, and has been copied into
13 the KAM decoder templates.

14 51. The following tables show further examples. Each lists a Configuration Variable number, the
15 NMRA Recommended Practice for the name, the name given to it in Lenz and Digitrax
16 manuals, the name in the JMRI definition files, and the name in the KAM Lenz_51.tpl template
17 from version 306 of the KAM software.

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Configuration Variable 1	
NMRA	Primary Address
Lenz	Locomotive Address
Digitrax	2-digit address
JMRI	Primary Address
KAM	Primary Address

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Configuration Variable 2	
NMRA	Vstart
Lenz	Start Voltage
Digitrax	Start Voltage
JMRI	Start Volts
KAM	Start Volts

Configuration Variable 3	
NMRA	Acceleration Rate
Lenz	Acceleration Momentum
Digitrax	Acceleration Rate
JMRI	Accel
KAM	Accel

Configuration Variable 4	
NMRA	Deceleration Rate
Lenz	Brake Momentum
Digitrax	Deceleration Rate
JMRI	Decel
KAM	Decel

Configuration Variable 5	
NMRA	Vhigh
Lenz	Maximum Speed
Digitrax	Maximum Voltage
JMRI	Vhigh
KAM	Vhigh

1 Attached as Exhibits M, N and O are true and accurate copies of the NMRA, Lenz and Digitrax
2 documentation, respectively, for these variables.

3 52. To summarize, for CV 1 and 5 I chose the name from the NMRA; for CV 2 I chose an
4 abbreviated form of what two manufacturers were using; and for CV 3 and 4 I used an original
5 form. The KAM decoder templates exactly copy these choices.

6 53. There are numerous examples of this throughout the JMRI Decoder Definition Files, where the
7 author has chosen how to express the function that's controlled by a particular Configuration
8 Value.

9 54. Authors also must choose what information to represent. In the case of some very complicated
10 decoders, it might be better to omit some of the more esoteric options to avoid confusing the
11 user.

12 55. The decoder definition for the Digitrax DS54 decoder is an example of this. I am the original
13 author of this definition. Configuration Variable 9 is used as part of an extended address. Its
14 use is described in the Digitrax manual for the DS54 decoder. It is a complex feature, however,
15 easy to get wrong, so I chose not to include it in the JMRI Digitrax_yDS54 Decoder Definition
16 File. It is also not present in the KAM Digitrax_yDS54.tpl template file.

17 56. As a further example, model railroaders sometimes discover features in decoders that are not
18 documented by the manufacturer. Authors may choose to include these, rather than including
19 information from manuals only. For example, there is a bit in CV61 of the Digitrax DH163
20 decoder that can be used to turn on and off the decoder's protection against short circuits. The
21 DH163 manual does not document this feature. It is described in the JMRI Digitrax_01x3
22 Decoder Definition File as "Short-circuit protection" with value "Disabled"; it appears in the
23 KAM Digitrax_01x3.tpl template as "Short-circuit protection Disabled", merely merging the
24 two strings.

25 57. A more extensive example can be found in the Decoder Definition Files for the "MERC"
26 decoders. MERC is a group of electronic hobbyists and model railroaders in the UK. They
27 design and produce decoders. Like many hobbyist organizations, they are weak on
28 documentation. Creating the Decoder Definition Files for the MERC decoders involved

1 extensive discussions with the decoder designer (Michael Bolton) about what features were
2 present, how to operate them, and how best to explain their intended use. These conversations
3 then informed the choices about what to include in the Decoder Definition File, which was
4 copied exactly into a KAM template file.

5 58. There are multiple examples of JMRI Decoder Definition Files containing this type of non-
6 documented information, which was then directly copied into KAM template files.

7 59. For many Configuration Variables, the Decoder Definition File will include a “default” value.
8 What value to include, if any, is a choice of the definition’s author. In some cases, this is taken
9 from the manufacturer’s recommendation in the decoder manual. In others, the author will use
10 a value that, in his opinion, works better than the manufacturer’s default. An example of this
11 can be seen in the JMRI Lenz_51 decoder definition file, where CV 2 and CV 3 both have
12 default values of 4, although the manufacturer’s manual recommends values of 1. The value
13 from the JMRI file was copied into the KAM Lenz_51.tpl file.

14 OTHERS’ AUTHORIZED USE OF THE FILES

15 60. Several individuals and organizations are using JMRI software as part of their product without
16 any problems complying with license terms.

17 61. For example, GPP Software, located in Australia, uses the JMRI Decoder Definition Files as
18 part of its products. They distribute the JMRI files unmodified, without having removed any of
19 their contents, and credit JMRI as the source of them in their documentation.

20 62. MTS Associates distributes JMRI as part of its Model Railroad Manager product, including the
21 Decoder Definition Files. They credit JMRI on their web pages and in their documentation.
22 Tom Stack of MTS Associates has made some changes to JMRI files and contributed them
23 back to JMRI for inclusion in later releases.

24 63. Bruce Petrarca of Litchfield Station in Arizona distributes JMRI on CD along with additional
25 information for his customers. He gives JMRI credit.

26 NMRA WORKING GROUP EFFORT TO STANDARDIZE DECODER DEFINITIONS

27 64. During the Summer 2005 there was a discussion on the NMRA DCC Working Group mailing
28 list about whether it would make sense for the NMRA to standardize a format for decoder

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definitions.

65. As part of the investigative process surrounding that, the Working Group discussed the format used by JMRI and KAM. Defendant Katzer and Mr. Bouwens were a part of that discussion.

66. I did not take a major role in the discussion. I did post to the discussion occasionally. I took no official position in favor or opposed to the idea of a common standard.

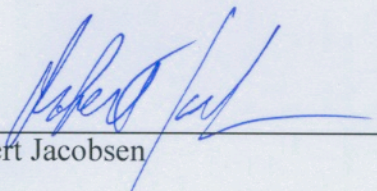
67. I did point out that even if the NMRA were to propose a common standard for writing these, the actual content would have to come from somewhere; people would have to be found to write them, which would be a major effort.

68. This discussion was in the context of a hypothetical merging of design effort. I did not imagine at the time that anybody would steal JMRI's copyrighted work, and promptly forgot the whole discussion when the group decided not to pursue development of a standard.

69. I do not remember seeing Bouwens' email (in my earlier Declaration) at the time he sent it. I found it only recently, as I was trying to determine when Defendants created the tool and began distributing their infringing decoder templates.

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

Executed this 17th day of November, 2006, in Berkeley, California.

By  _____
Robert Jacobsen