

1 **David M. Zeff (S.B. #63289)**
2 **Law Offices of David M. Zeff**
3 **1388 Sutter St., Suite 820**
4 **San Francisco, CA 94109**
5 **Telephone: (415) 923-1380**
6 **Facsimile: (415) 923-1382**
7 **ZeffLaw1@aol.com**

8 **Attorneys for Defendant**
9 **Kevin Russell**

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

13 **ROBERT JACOBSEN,**
14 **Plaintiff,**

15 **vs.**

16 **MATTHEW KATZER, KAMIND**
17 **ASSOCIATES, INC., and KEVIN**
18 **RUSSELL,**
19 **Defendants.**

) **Case No. C 06 1905 JSW**

) **DECLARATION OF KEVIN RUSSELL IN**
) **SUPPORT OF SPECIAL MOTION TO**
) **STRIKE [Cal. Civ. Proc. Code § 425.16]**

) **Date: June 23, 2006**
) **Time: 9:00 a.m.**
) **Dept: Courtroom 2, 17th floor**
) **Hon. Jeffrey S. White**

20 I, Kevin Russell, declare:

21 1. I am a defendant in this action, and an attorney licensed to practice before the
22 United States Patent and Trademark office ("Patent Office"). My business address is 601
23 SW 2d Avenue, Suite 1600, Portland, OR 97204. If called as a witness, I would and
24 could testify to the following as a matter of personal knowledge.

25 2. One of my clients is Kamind Associates, Inc. ("KAM"). I have reviewed the
26 complaint on file in this action ("Complaint"). To the extent I actually performed acts
27 described in the Complaint, I acted on behalf of KAM and at the direction of its
28

1 responsible officer Matthew Katzer. I have no personal financial interest in KAM, in any
 2 of its patents, or in any matter or transaction described in the complaint over and above
 3 fees paid to the law firm which employs me for work I perform as KAM's attorney.
 4

5 3. With regard to allegations contained in Paragraphs 43 through 49 of the
 6 complaint, on September 17, 2002 on behalf of KAM, prior to sending the letter to Dr.
 7 Tanner and Friewald Software, I filed complaints in the District of Oregon alleging patent
 8 infringement against Dr. Tanner and Friewald Software but did not ever serve the
 9 complaints nor inform Dr. Tanner or Friewald of the complaints alleging patent
 10 infringement.
 11
 12

13 4. Attached as Exhibit 1 is a true copy of the 2-page letter I wrote Jacobsen on
 14 March 8, 2005, cautioning Jacobsen that the JMRI product may infringe KAM'S '329 B2
 15 patent, stating the reasons it may infringe, suggesting how the JMRI product may be
 16 modified to be potentially non-infringing, and offering to license the patent to Jacobsen.
 17 The letter states in abbreviated form my informal analysis of similarities between the
 18 '329 patent and the JMRI product which were the basis of my belief that the JMRI
 19 product infringed our patent. The letter was sent in a good faith to attempt to resolve
 20 differences without litigation. The attachment to that letter is extremely bulky and
 21 appears as Attachment A to the complaint. It is omitted to avoid unduly burdening the
 22 record.
 23
 24
 25

26 5. Attached as Exhibit 2 is a one-page message from Jacobsen, dated March 29,
 27 2005, indicating he did not intend to comply with KAM's requests.
 28


1 6. Attached as Exhibit 3 is a true copy of a 2-page letter I sent to Jacobsen on
 2 August 24, 2005, repeating my suggestions for modification of the JMRI product to be
 3 potentially non-infringing with increased specificity, and requesting royalty payments for
 4 distribution of infringing software by the JMRI product.
 5

6 7. Other correspondence followed, including a letter from Jacobson suggesting
 7 that the patents should be put in the public domain, without leading to any result. I sent
 8 several royalty invoices to Jacobsen for royalties in hope of engaging his attention to this
 9 manner.
 10

11 8. Attached as Exhibit 4 is a true copy of the FOIA request sent to the United
 12 States Department of Energy on October 7, 2005. The exhibits that were attached to the
 13 request are omitted to avoid unduly burdening the record. At the time I sent the request I
 14 was informed that a DOE e-mail account was being used to promote the JMRI product,
 15 and I believed that such usage indicated that possibly because of Jacobsen's influence
 16 with the Government, the DOE sponsored the JMRI project, and it appeared important
 17 that the DOE be aware that we considered some of its activities questionable.
 18
 19
 20

21 I declare under penalty of perjury that the foregoing is true and correct.

22 Executed on May 11, 2006.

23
 24 
 25 Kevin Russell
 26
 27
 28

Russell Declaration: Exhibit 1

Russell Declaration: Exhibit 1



LAW OFFICES
CHERNOFF, VILHAUER, McCLUNG & STENZEL, LLP

INTELLECTUAL PROPERTY LAW
INCLUDING PATENT, TRADEMARK, COPYRIGHT
AND UNEFAIR COMPETITION MATTERS

1600 ODS TOWER
601 S.W. SECOND AVENUE
PORTLAND, OREGON 97204-3157
TELEPHONE: 503-227-5631
FAX: 503-228-4373

- * JACOB E. VILHAUER, JR.
- * DENNIS E. STENZEL
- * CHARLES D. McCLUNG
- * DONALD B. HASLETT
- * J. PETER STAPLES
- * WILLIAM O. GENY
- * NANCY J. MORIARTY
- * JULIANNE R. DAVIS
- * KEVIN L. RUSSELL

- * TIM A. LONG
- * KURT ROHLFS
- * BIENNA K. LEGAARD
- * SCOTT C. KRIEGER**
- * SUSAN D. PITCHFORD

* REGISTERED PATENT ATTORNEY
** MEMBER UTAH AND D.C. BARS

DANIEL P. CHERNOFF
(1935-1995)

DAVID S. FINE
SENIOR LAW CLERK

March 8, 2005

CERTIFIED MAIL
Return Receipt Requested

Mr. Robert G. Jacobsen
1927 Marin Avenue
Berkeley, CA 94707-2407

Re: Kam Industries' U.S. Patent No. 6,530,329 B2
Our File No.: 7431.0081

Dear Mr. Jacobsen:

We represent KAM Industries ("KAM") with respect to their intellectual property matters. KAM is the owner of U.S. Patent No. 6,530,329 B2, issued March 11, 2003, a copy of which is enclosed herewith for your convenience.

Our preliminary analysis of the JMRI software indicates that it currently includes several separate distinct programs (e.g., interface instances), namely, Throttle, PanelPro, DecoderPro, and Loco Tools. Each of these programs appears to be a separate Java application instance that may be run simultaneously on a computer. During operation of the JMRI software programs, our analysis indicates that the software includes the functionality to communicate over a TCP/IP connection with an installed JMRI server. The JMRI server in turn communicates with a command station for a model railroad. Our analysis further indicates that the JMRI server is capable of receiving commands from all of the Java application instances and then the commands are forwarded to the command station, and likewise retrieving commands from the command station and providing them to the corresponding separate Java application instance.



Mr. Robert G. Jacobsen
March 9, 2005
Page Two

Claim 1 of U.S. Patent No. 6,530,329 claims a method of operating a digitally controlled model railroad comprising the steps of: (a) transmitting a first command from a first program to an interface; (b) transmitting a second command from a second program to said interface; and (c) sending third and fourth commands from said interface representative of said first and second commands, respectively, to a digital command station.

It is our opinion that the JRMI software may infringe claim 1 of the '329 patent.

By way of assistance, in order to avoid further infringement of claim 1 of the '329 patent, I would suggest rewriting all of the Java application instances in a single instance where JMRI instance manager can only satisfy one creation request.

KAM currently has an active licensing program for each copy of infringing software downloaded or otherwise installed on a computer at \$19 per copy. KAM would be interested in licensing its patent rights to the JRMI software.

Please provide us with a response within 10 days.

Sincerely,

A handwritten signature in black ink, appearing to read 'Kevin L. Russell', with a long horizontal line extending to the right.

Kevin L. Russell

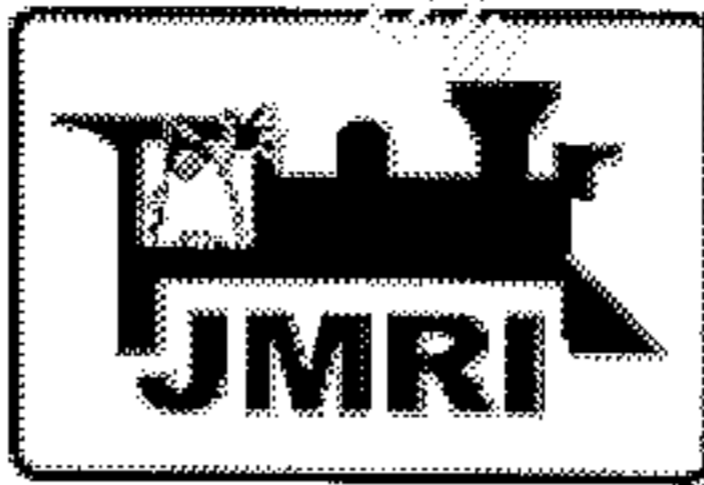
KLR:kk
Enclosure

Russell Declaration: Exhibit 2

Russell Declaration: Exhibit 2

March 29 2005

Mr Kevin Russell
Chernoff, Vilhauer, McClung
& Stenzel, LLP
1600 ODS Tower
601 S. W. Second Ave
Portland, Oregon, 97204-3157



Bob Jacobsen

JMRI Project
1927 Marin Avenue
Berkeley, CA 94707-2407

jmri@pacbell.net

Dear Mr. Russell:

The JMRI project is committed to the appropriate and legal use of intellectual property, both ours and that belonging to others.

In response to your letter of March 8, 2005, we have examined the JMRI code in the light of your statements. We were unable to locate any functionality that infringes on valid claims in U.S. Patent 6,530,329 B2.

We request that you provide us with the results of your preliminary analysis of the JMRI software in sufficient detail that we can determine how best to proceed. It would be most helpful if you could indicate the particular software modules that you think infringe. For your reference, the entire software source code is available at <http://sourceforge.net/projects/jmri> and additional design documentation is available via <http://jmri.sourceforge.net>.

We look forward to resolving this.

Sincerely,

Bob Jacobsen

Russell Declaration: Exhibit 3

Russell Declaration: Exhibit 3



LAW OFFICES
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 INTELLECTUAL PROPERTY LAW
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1600 ODS TOWER
 601 S.W. SECOND AVENUE
 PORTLAND, OREGON 97204-3157
 TELEPHONE: 503-227-5631
 FAX: 503-228-4373

August 24, 2005

* JACOB E. VILHAUER, JR.
 * DENNIS E. STENZEL
 * CHARLES D. McCLUNG
 * DONALD B. HASLEY
 * J. PETER STAPLES
 * WILLIAM O. GENY
 * NANCY J. MORIARTY
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 * SUSAN D. PITCHFORD
 * J. DOUGLAS WELLS

* REGISTERED PATENT ATTORNEY

DAVID S. FINE
 SENIOR LAW CLERK

Our File No.: 7431.0081

CERTIFIED MAIL
Return Receipt Requested

Mr. Robert Jacobsen
 1927 Martin Avenue
 Berkeley, CA 94707-2407

Dear Mr. Jacobsen:

In response to your letter of March 29, 2005 we appreciate your acknowledgement of the need to respect the intellectual property of KAM.

The JMRI software that you distribute on your website continues to infringe U.S. Patent No. 6,530,329 B2. In particular, claim 1 claims transmitting a first command from a first program to an interface; transmitting a second command from a second program to the interface, and sending third and fourth commands from the interface representative of the first and second commands, respectively to a digital command station.

In essence, claim 1 provides patent protection for when at least two programs provide commands to the interface which are in turn provided to a digital command station. This technology is proprietary to KAM.

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 for a model railroad. In addition, our analysis indicates that the JMRI server is capable of receiving commands from all of the Java application instances.

In order to avoid further infringement, you will need to modify the JMRI software so that it is a single program. You will need to include controls to ensure that only one single program is running and capable of providing commands to the model railroad. If you want to execute another program you will need to terminate the current program prior to starting the other program.

Russell Declaration: Exhibit 3



Mr. Matthew A. Katzer
August 24, 2005
Page Two

We are in the process of further reviewing the JMRI software with respect to other patents owned by KAM. These patents are available at www.uspto.gov.

Once you have completed these changes, please send me a copy of the software distribution on CD-ROM so that we may confirm that the code no longer infringes U.S. Patent No. 6,530,329.

In a posting by you on June 14, 2005 to dcc-eg-tech@yahoogroups.com you admitted that you have provided the user community over 7,000 copies of the infringing JMRI software. The current software patent licensing fee from KAM is \$29 per copy.

Could you please provide me with an accounting of all copies of the infringing JMRI software that has been distributed, downloaded, or otherwise made available in any fashion? For the admitted 7,000 copies of the infringing JMRI software I have included an invoice from KAMIND Associates, Inc. in the amount of \$203,000.00 currently owed by you to KAMIND Associates, Inc. If you require account information so that you can wire the amount to their bank account, please let me know.

Another potential design for future non-infringing software would involve removing the existing communications interface of the JMRI software, adding an interface to KAM's Open XML interface, and requiring user's to purchase a copy of train server from KAM at \$29 per copy. Once such a program has been developed we would be willing to provide you with an indication of whether it would infringe any of KAM's intellectual property rights.

Please provide us with your assurances that the JMRI software no longer infringes and confirm the payment within 15 days.

Best,

A handwritten signature in black ink, appearing to read 'Kevin L. Russell', written over a horizontal line.

Kevin L. Russell

KLR:kk
Enclosure

cc: Matt Katzer



KAMIND Associates, Inc

2373 NW 185th Ave
Hillsboro, OR 97124
(503) 291-1221
(503) 291 1221

Sales Receipt

Transaction #: 40
Account #: 0010008
Page: 1 of 1
Date: 8/18/2005
Time: 4:47:03 PM
Cashier: MK
Register #: 1

Bill To: Bob Jacobson
1927 Martin Ave
Berkeley, CA 94707 2407

Ship To: Bob Jacobson
1927 Martin Ave
Berkeley, CA 94707-2407

Rep	Item Lookup Code	Description	Quantity	MSRP	Price	Extended
	TrainServerLic	Train Server Single User	7000	\$29.00	\$29.00	\$203,000.00

Thank you for your order. All payments net 30
 All returns subject to 20% restocking fee
 1.5% monthly finance charge unpaid balance
<http://www.kamind.com>
 KAMIND Associates, Inc

Sub Total \$203,000.00
 Sales Tax \$0.00
 Total \$203,000.00
 Store Account \$203,000.00
 Previous Balance \$0.00
 New Balance \$203,000.00
 Change Due \$0.00

Russell Declaration: Exhibit 4

Russell Declaration: Exhibit 4



LAW OFFICES
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- * J. DOUGLAS WELLS
- HOLLY L. BONAR

* REGISTERED PATENT ATTORNEY

DAVID S. FINE
SENIOR LAW CLERK

October 27, 2005

FOIA Officer
Office of Science
US. Department of Energy
1000 Independence Avenue, SW
Washington, DC 20585

**Re: Freedom of Information Act Request for all Documents
Related to Patent Infringement, Status, Funding, Distribution
of Contributions and Management Practices Associated with the
JMRI Project by Berkley Labs.
Our File No.: 7431.0081**

Dear FOIA Officer:

This request for documents is made pursuant to the Freedom of Information Act, 5 U.S.C. §§ 552 *et seq.* This request is made on behalf of KAMIND Associates, Inc. ("KAM") and relates to information gathered by the Physics Division Berkley Livermore Labs (LAB) regarding their duties for JMRI project. KAMIND Associates, Inc. is a small software vendor that has patents being infringed by the JMRI project sponsored by the LAB.

Please consider documents to include all writings, memoranda, letters, notes, working papers, minutes of meetings, photocopies, data, graphs, charts, photographs, inspection reports, compliance reports, records, e-mails (sent, received or drafts), digitized voice communications and any other format of information regarding the JMRI program project (hereafter referred to as COMMUNICATIONS).



FOIA Officer
 Office of Science
 U.S. Department of Energy
 October 27, 2005
 Page 2

Specifically, KAM requests:

1. Funding information from the Department of Energy for the JMRI program at the LAB.
2. All COMMUNICATIONS about the JMRI program and proceedings from Robert Jacobsen (LBNL, 1 Cyclotron Rd, MS 50A2160, Berkley Ca, 94720 email address Bob.Jacocobsen@lbl.gov). [Exhibit 1, 2, 3]
3. Complete financial records and all COMMUNICATIONS from contributions (PAYPAL) to support the JMRI program. [Exhibit 4, 5]
4. Complete financial records verifying that the funds received for Government project JMRI were deposited in US Treasury.
5. Transcripts of communications (COMMUNICATIONS) to any JMRI team members regarding KAM. [Exhibit 6]
6. All COMMUNICATIONS regarding patent investigation of KAM. [Exhibit 6]
7. All draft COMMUNICATIONS to any member of the JMRI development community. There are 18 members as of 10/24,2005. [Exhibit 2]
8. All COMMUNICATIONS to any member of the JMRI_STRATEGY group. [Exhibit 7]
9. All COMMUNICATIONS regarding legal opinion on Department of Energy personal at any locations regarding the JMRI activities.
10. All COMMUNICATIONS from email archives (2000 to present) to any member on the Yahoo Groups: JMRI DEVELOPERS. [Exhibit 2]
11. All COMMUNICATIONS from email archives (2000 to present) to any member on the Yahoo Groups: JMRI STRATEGY. [Exhibit 7]
12. All COMMUNICATIONS from email archives (2000 to present) to any member on the Yahoo Groups: JMRI USERS. [Exhibit 8, 9]
13. All COMMUNICATIONS and logs from Skype ID: JacobsenRG related to JMRI activities.
14. Copies (and all drafts) of the welcome letter from the LAB by Bob Jacobson to JMRI members posted on Yahoo groups and or source forge.
15. All information related to the KAM legal action in federal court.
16. All travel activities that relate to the JMRI activities during July 2001, 2002, 2003 and 2004 period.

Tuesday, May 09, 2006 (3).map

Russell Declaration: Exhibit 4



FOIA Officer
Office of Science
U.S. Department of Energy
October 27, 2005
Page 3

17. All COMMUNICATIONS between the following Allen Bryne, Ralph Kimball, Michael Woodman, Graham Plowman, and Jerry Britton. **[Exhibit 10, 11, 12]**
18. All COMMUNICATIONS about JMRI Royalty payment of \$203,000 for KAM Train Server licenses. **[Exhibit 13]**

Sincerely,

A handwritten signature in black ink, appearing to read 'Kevin L. Russell', written over a horizontal line.

Kevin L. Russell

KLR:kk
Enclosures

cc: KAMIND Associates, Inc.
(w/enclosures)