

Overview of the Case

Jacobsen v. Katzer was a lawsuit between Robert Jacobsen ([plaintiff](#)) and Matthew Katzer (defendant), filed March 13, 2006 in the [United States District Court for the Northern District of California](#). The case addressed claims concerning [copyright](#), [patent](#), [cybersquatting](#) and [Digital Millennium Copyright Act](#) issues. The case settled February 16, 2010.^{[1][2]} The litigation encompassed 405 Federal District Court document filings and two appeals to the Circuit Court of Appeals. The case has aided in the clarification and the establishment of the enforceability for the licensing of both [open-source software](#) and [commercial software](#) under [United States copyright law](#).

Background

Robert Jacobsen along with other software developers started the [Java Model Railroad Interface \(JMRI\) Project](#)^[3] in the year 2000, on the [open-source](#) incubation web-site [Sourceforge.net](#).^{[4][5]} The goal of the project was to create interfaces that would allow various model trains to be controlled on a given layout of model train tracks. The software created by JMRI community was distributed without charge on the Internet, subject to the terms of the [Artistic License](#).^[4]

Katzer owns KAMIND Associates Inc., an Oregon company doing business under the name KAM Industries. KAM produces a commercial product for hobbyists and the [model train](#) industry by the name of Train Tools. In 1997, Katzer sold client-server model train software.^{[6][7]} Jacobsen has a hobby of Model Railroading.^[8]

Jacobsen also distinguishes between his "day job" and JMRI hobby activities.^[8] Jacobsen also refers to JMRI as a non-commercial activity by hobbyists.^[8] Jacobsen sent a letter on March 26, 2005 to Mr. Hamilton of the MRIA stating that JMRI sells custom software directly to modelers and to dealers for resale.^[9] Sales for 2004 exceeded \$5,000 and expected significant growth in 2005.^[10] Jacobsen believes JMRI's sales qualify JMRI for MRIA membership.^[11] MRIA May 2005 Newsletter welcomes Jacobsen/JMRI as a business.^[12]

Katzer is also the owner of several patents that may apply to the model railroad industry, one of which he alleged the JMRI project may infringe.^[4] On March 8, 2005, Katzer sent a letter and later sent additional notices and bills^{[13][14][15][16]} to Jacobsen, informing him that the code in the JMRI software may infringe a KAM Industries [patent](#), and that more than \$200,000 were due for licensing fees of previously distributed versions of the software.^[13] On October 7, 2005 Katzer sent a [Freedom of Information Act](#) (FOIA) request^[17] to the [United States Department of Energy](#), based on Jacobsen's lbl.gov email address.^{[18][19]}

Jacobsen alleged that Katzer's software utilizes textual files from the JMRI project, in violation of copyright and the DMCA. Katzer subsequently countersued Jacobsen for \$6 million for copyright infringement.^[6] In addition to the patent claim that Katzer made against Jacobsen, in February, 2004, Katzer also registered the web domain decoderpro.com.^[20] DecoderPro is the trademarked^[21] name of a program that is part of the JMRI project, and Jacobsen attempted under the [Lanham Act](#) to obtain the return of the domain name and damages for Katzer's

[cybersquatting](#). Both Jacobsen and Katzer moved for [summary judgment](#)^{[22][23]} and the district court ruled on their motions in December 2009. The parties reached settlement on February 16, 2010, and the settlement fee was fully paid on March 5, 2010.^[21]

Settlement

The case Jacobsen v Katzer has been settled.^[11] The basic elements of the Settlement Agreement include:

1. The plaintiff and defendants stipulate to entry of a permanent injunction containing the following terms; "Defendants and any and all persons or entities acting at their direction or in concert with them are permanently enjoined from reproducing, by download or others, JMRI material, modifying JMRI material or distributing JMRI material".
2. "Plaintiff and defendants release and forever discharge each other from any and all manner of claims, demands, liabilities or causes of action, of any kind whatsoever that exist as of the date of the signed settlement agreement" subject to the stipulated injunction provisions. This release also applies to JMRI users and JMRI developers. "This general release extends to any and all claims based on or related to JMRI Material; it includes, without limitation, any and all claims that were asserted or could have been asserted by either party in Jacobsen v Katzer".
3. Plaintiff and defendants agree to dismiss the pending Federal Circuit appeal, Jacobsen v Katzer et al., No. 2009-1221.
4. Defendants agree to pay plaintiff a settlement fee of \$100,000 no later than 18 months after the Settlement Agreement Signing Date.
5. The settlement agreement states "This agreement incorporates all prior agreements, oral and otherwise", and in doing so has terminated any oral agreement or implied licenses.
6. Both parties (Jacobsen and Katzer/KAM) agree not to initiate legal proceedings against each other for a 10 year period and future disputes between Robert Jacobsen and Matthew Katzer/KAM are to be resolved through mediation and arbitration. The ADR process (Mediation and Arbitration) is applicable only to Robert Jacobsen and Matthew Katzer/KAM. The ADR process does not apply to JMRI, JMRI end users or JMRI developers.^{[24][25]}

The Settlement agreement is a release for plaintiff Jacobsen, JMRI developers and JMRI end users for the latest version of JMRI software that may infringe upon Matthew Katzer's issued IP as of the date of signing, February 16, 2010 (Settlement Agreement Signing Date) up to the date of receipt of the \$100,000 settlement fee by the plaintiff's attorney for Robert Jacobsen, March 5, 2010 (Settlement Agreement Payment Date). This 17-day period provides a release to Robert Jacobsen, JMRI developers and JMRI end users for Matthew Katzer's issued IP.

The Settlement Agreement does not cover any newly issued Matthew Katzer IP appearing after March 5, 2010 and/or any evolving and/or derivative JMRI software versions appearing after the March 5, 2010 Settlement Agreement Payment date. Patents that cover inventions dating to the release date (March 5, 2010^[26]) and are incorporated by JMRI and/or in parallel with JMRI's code that predate the settlement release date (March 5, 2010) are covered through the "claims

that could have been asserted" language within the settlement agreement. The settlement agreement states "This agreement incorporates all prior agreements, oral and otherwise", and in doing so has terminated any oral agreement or implied licenses (A release is not a license and does not extend to any claims that may apply after the final payment date, March 5, 2010 of full settlement fee payment (\$100,000) per the terms of the Settlement Agreement)^[24] The \$100,000 settlement fee, less \$31,462.93 paid to Katzer/KAM and his lawyer Kevin Russell for an Anti-SLAPP judgment against Jacobsen because the Court decided that Katzer had sent the Freedom of Information Act request to Jacobsen's employer as part of Katzer's "litigation privilege (Matthew Katzer's First Amendment "Free Speech Rights")" in preparation for suing Jacobsen (Federal District Court Document #111, October 20, 2006), has resulted in net proceeds of \$68,537.07 over the four-year litigation period to Robert Jacobsen.^[27] The net payment was insufficient to reimburse Jacobsen for his out of pocket expenses.^[28]

Summary judgment

[Summary judgment](#) encompasses a series of submissions presented by Jacobsen (plaintiff) and Katzer (defendant). On October 13, 2009, both parties filed initial submissions.^{[29][30]} Responses to initial submissions were filed on November 13.^{[31][32][33][34]} Both plaintiff and defendant further replied to responses on November 19 and 20.^{[35][36][37][38]} Prior to oral arguments on December 4, Judge White issued a Notice of Tentative Ruling and Questions, tentatively affirming in part and denying in part Jacobsen's motion for summary judgment and tentatively denying Katzer's motion for summary judgment.^[39]

On December 10, 2009, Judge White denied Katzer's motion, concluding that Jacobsen could copyright the selection and ordering of the decoder definition files and could show monetary damages for copyright infringement. In the same ruling, Judge White granted in part and denied in part Jacobsen's motion, finding that Katzer did register the decoderpro.com domain name in bad faith, that Katzer is liable for copyright infringement of the decoder definition files and that Katzer's counterclaim for copyright infringement is barred by the [doctrine of laches](#) (damaged argument), and ruled that Jacobsen had a license under an "Implied License" doctrine. Judge White did not rule on damages for copyright infringement and determined that the questions of Katzer's knowledge or intent in removing copyright notices are triable issues.^[40]

Copyright claims

KAM received a copyright infringement notification from Jacobsen on September 11, 2009.^[41] On the same day Jacobsen filed an amended complaint that included a claim for copyright infringement.^[42] On the same day KAM removed allegedly infringing materials from KAM's website.^[43] In Jacobsen's declaration, in support of a motion for a preliminary injunction, he specifically identified examples of alleged copyright infringement.^[44] As declared in Jacobsen's declaration,

"[t]he author of the JMRI file used “and” and “+” to represent the word “and”. This appears in the following choices: o “Directional Headlight + Directional Mars Light” o

“Directional Headlight + Directional Ditch Lights” o “Scale mph Report and Status Report” o “Squealing Brakes + Air Brakes”.^[44]

Also, Jacobsen stated that

"[t]he author of the JMRI file used lower case in “Scale mph Report and Status Report” although one might expect the “MPH” to be capitalized.”^[44]

Bouwens Engineering began developing programmer software years before JMRI developed the decoder programmer.^[45] In 2004 KAM purchased the programmer software which would later be named Decoder Commander.^[46] A template verifier tool was used to extract data from JMRI decoder definition files.^{[47][48][49]} In August 2007, the district court denied Jacobsen's request for declaratory judgment, holding that the "defendants' alleged violation of the conditions of the license may have constituted a breach of the nonexclusive license, but does not create liability for copyright infringement."^[50] The Judge stated that JMRI failed to allege claims to have incurred that were the proximate cause of a breach of the Artistic License.^[51]

In August 2008, with the support of an [amicus brief](#), the [United States Court of Appeals for the Federal Circuit](#) vacated the district court's ruling, holding that the terms of the [Artistic License](#) are enforceable copyright conditions, and remanded the case back to the district court to consider whether other conditions required for an injunction were met in this case.^[52] The court said, "Open source licensing has become a widely used method of creative collaboration that serves to advance the arts and sciences in a manner and at a pace that few could have imagined just a few decades ago," and cited as examples "the GNU/Linux operating system, the Perl programming language, the Apache web server programs, the Firefox web browser, and a collaborative web-based encyclopedia called Wikipedia."^[53] Professor [Lawrence Lessig](#) called the ruling "a very important victory" that applies to all open source licenses,^[54] and many other news organizations commented on the finding.^{[55][56][57]}

In January 2009, the District Court again ruled on the preliminary motions. The court ruled that it would hear Jacobsen's copyright claims but dismissed his breach of contract claims. Regarding the preliminary injunction that was the focus of the Court of Appeals decision, the District Court again denied Jacobsen a preliminary injunction due to a lack of evidence showing any specific and actual harm suffered or imminent as a result of the copyright infringement. However, this ruling does not prevent the court from issuing an injunction after ruling on the merits of the case.^[58] An issue that has yet to be resolved is whether Jacobsen is the copyright holder of the claimed decoder files, with Katzner having provided evidence that their contents were partially copied from a manual under his copyright.^{[58][59][60][61][62]}

Jacobsen basis his copyright case on an assertion of a fairly thin copyright on behalf of a free software project that otherwise is extremely generous in granting permissions for downstream copying, modifying, and distributing its works.^[63] Jacobsen explains that the basis of his copyright claims is that 102 files defining 291 decoders of the 500 decoders available on the market are at issue in this claim. JMRI developers chose the decoders they found most interesting and useful, and then structured the resulting definition files in a unique way, not

based upon manufacturer or NMRA approaches, but reflecting the judgment of the JMRI developers as to their preferred arrangement, particularly choosing an arrangement appropriate for integrating these files with the rest of the JMRI software.^[63] Put in context, this is equivalent to having a box of 500 crayons and selecting your favorite 291 crayons, then arranging the 291 crayons on your desk and claiming a copyright in the selection of the 291 crayons arranged on your desk. In June 2009, the [Software Freedom Law Center](#) filed an [amicus brief](#) before the [Court of Appeals for the Federal Circuit](#) (CAFC) calling for injunctive relief for open source developers. In the brief, SFLC argues that a [Free, Libre, and Open Source Software](#) (FLOSS) developer whose license has been violated should be able to call upon the courts to prevent further infringing distributions. The brief outlines harms to developers, development communities, and project productivity related to open source license violations.^[64]

Patent claims

Katzner asserted to the Court^[65] that he shipped model train software, within the one year statutory time period for filing a patent in the United States,^[66] that used a [client/server protocol](#)^[67] in July 1997.^[67] Katzner filed a [patent](#) in June 1998 with the [United States Patent and Trademark Office](#),^{[68][69]} consisting of 53 [method claims](#) involving client/server control of model trains which can be infringed by computer software.^[70] On April 14, 2002, the JMRI project published^[71] a new capability in their code, over 4 years after KAM presented their client/server architecture,^[67] which allowed a computer to control the layout of a model railroad via a client/server protocol.

On April 17, 2002, Katzner filed a continuation patent application, with a priority date back to 1998, with the patent office claiming those exact capabilities.^[72] On March 11, 2003 the patent office granted the patent claiming those exact capabilities.^[73] On September 17, 2002, Katzner sent infringement letters to two model railroad hobbyists companies, DigiToys Systems and Freiwald, for patent infringement and filed lawsuits.^{[74][75]} These lawsuits were never served and were dropped in December 2002.^{[76][77]} DigiToys Systems noted WinLok 1.5 from 1993 (which DigiToys Systems did not indicate was client-server), WinLok 2.0 from 1995 (which DigiToys Systems did not indicate was client-server), and ROSA from 1997 (which DigiToys Systems did not indicate was client-server).^[78] DigiToys Systems also noted WinLok released in 1998 which is not prior art.^{[67][79]} This information was provided to the file history of the '329 patent, by the two model railroad hobbyists,^[80] which is the parent of the pending continuation patent.^[81] Manual Patent Examining Procedures 707.05 states "In all continuation and continuation-in-part applications, the parent applications should be reviewed for pertinent prior art."^[82] Accordingly, the references cited by the two model railroad hobbyists were before the patent office in the '329 patent.^[83]

On March 8, 2005, Katzner sent patent infringement letters and later notices^[13] <refname="notice2"/> and bills^{[15][16]} to Jacobsen, informing him that the code in the JMRI project infringed his patent,^[84] and that more than \$200,000 was due for licensing fees of previously distributed versions of the project.^[13] On October 7, 2005 Katzner sent a [Freedom of Information Act](#) (FOIA) request^[17] to the [United States Department of Energy](#), based on use of a Department of Energy e-mail address used to sponsor the JMRI project.^{[18][19]} This letter was

based upon JMRI including the "exact same capabilities" in its software.^[85] The Department of Energy determined that Mr. Bob Jacobson apparently used his LBNL e-mail account in connection with JMRI related correspondence,^[86] and that the JMRI project is not an LBNL funded, sponsored or supported activity,^[87] and nor performs any duties for or in support for the JMRI project.^[88] Jacobsen filed for a [declaratory judgment](#) against Katzer.^[89] In it, Jacobsen alleged that the June 1998 patent is invalid due to [prior art](#), and that Katzer's patents have been granted by the patent office in error. He further alleged that Katzer deliberately failed to provide the patent office with the prior art.^[90] Prior to the second Settlement Conference, the settlement judge requested that Katzer had to "provide to Plaintiff basic supporting facts and legal argument sufficient to explain its position on validity, enforceability and infringement of the [disputed] patent."^[91] On February 1, 2009, Katzer filed two disclaimers with the U.S. Patent Office, effectively making two of his patents unenforceable in their entirety.^[92] The result of the disclaimer was to remove all patent issues from the case. As stated by the Court:

"Counts one, two and three of the second amended complaint must be dismissed as moot because of Defendants' disclaimer of the patent sued upon. The Defendants filed a Disclaimer in Patent under 37 C.F.R. § 1.321(a) with the Patent and Trademark Office on February 1, 2008, disclaiming all claims in the '329 patent. ... There is no dispute that the patent at issue in this case has been disclaimed and there is therefore no further substantial controversy between the parties of "sufficient immediacy and reality to warrant the issuance of a declaratory judgment." See *MedImmune, Inc. v. Genentech, Inc.*, 127 S. Ct. 764, 771 (2007).^[93]

After these patents were disclaimed by Katzer, Jacobsen attempted to include other Katzer patents in the case based on Katzer's use of the plural "patents" in the earlier demand letters and legal filings. In oral argument, Katzer's lawyer told the Court that Katzer was not then considering, and never had considered, JMRI to infringe other patents, and the court mooted those claims.^{[94][95]} The Court stated in its order that:

"Jacobsen also alludes to the possibility that Defendants own other patents which may be relevant to this litigation. However, there is nothing in the record to support the position that there is a substantial controversy between the parties to merit retaining jurisdiction over the declaratory claim. Defendants maintain they have no intent to sue Jacobsen over alternate patents and any determination regarding patents not yet in suit would render the Court's opinion merely, and impermissibly, advisory. See *Micron Technology, Inc. v. Mosaid Technologies, Inc.*, 518 F.3d 897, 901-02 (Fed. Cir. 2008).^[96]

KAM stated, under oath in a declaration, that KAM disclaimed the '329 patent because patent litigation is extremely expensive and time-consuming, especially given the aggressive litigation tactics of Jacobsen.^[97] KAM further stated, under oath in a declaration, that the disclaimer of the '329 patent was purely based upon economic considerations to avoid the cost of patent litigation.^[98]

Cybersquatting claims

Beginning in July, 2001, the JMRI project began referring one of its subprojects as DecoderPro.^[99] In February, 2004, Katzer purchased the domain decoderpro.com. On October 14, 2004, this was mentioned on a (non-JMRI) model railroad software mailing list.^[100] on October 26, 2004, Jerry Britton, in response threatened to point KAM's computerdispatcherpro.com to a "good porn site".^[101]

On October 29, 2004 Britton posted to JMRI mailing list that included Jacobsen and other JMRI members about computerdispatcherpro.com domain.^[102] On November 8, 2004 Jacobsen sent a letter to Katzer, and requested Katzer to transfer the decoderpro.com domain to Jacobsen.^[20] Around this time, Jerry Britton (a JMRI user/member) purchased and began using the domain name computerdispatcherpro.com, which violated Katzer registered trademark Computer Dispatcher and common law trademark Computer Dispatcher Pro, both of which were in use before existed and before JMRI started distributing product.^{[72][103]} on October 26, 2004, Jerry Britton, in response threatened to point KAM's computerdispatcherpro.com to a "good porn site".^[101] Katzer sued Britton to force him to stop infringing on the computerdispatcherpro.com trademark, and prevent Britton from pointing the domain name to a "good porn site".

A [settlement agreement](#) between Britton and Katzer resulted in Britton transferring computerdispatcherpro.com to Katzer, and Katzer in turn transferring decoderpro.com to Britton (a JMRI User/developer). The agreement allowed Britton to point the domain to the JMRI decoderpro project site, but also prohibited Britton from transferring the domain name without Katzer's permission. Both Britton and Katzer agreed that their settlement agreement would remain confidential, except that Katzer's company KAM could "issue a press release that fairly and reasonably [reported] on the settlement of the lawsuit."^[104]

The agreement had a mutual [confidentiality](#) clause which stipulated that the party who broke the agreement would be subject to a \$20,000 fee, payable to the opposing party.^[104] Jacobsen included a demand for return of decoderpro.com in his lawsuit against Katzer. Katzer filed a motion to dismiss this motion, because Jacobsen had not also sued Britton. Jacobsen filed an action with the [World Intellectual Property Organization](#) (WIPO) against fellow JMRI user Jerry Britton, asking that they settle the matter per the [Uniform Domain Name Dispute Resolution Policy](#) (UDNDP). Jerry Britton did not respond to the action.^[99] On July 26, 2007, WIPO found in favor of Jacobsen, because Katzer's many actions were found to be in "bad faith".^[99] Specifically cited were

1. "Indeed, the evidence supports the conclusion that Katzer had no purpose in registering the name except to keep it out of others' hands, including Complainant's hands."^[99]
2. "It is difficult to conceive of a legitimate use Katzer could make of the Domain Name."^[99]
3. "In the Panel's view, there is essentially a purpose on the part of Katzer to disrupt the business of a competitor by interfering with Complainant's exercise of his trademark rights."^[99]
4. "After registering the Domain Name, Katzer then made no use of it."^[99]
5. "In addition WIPO found that Jerry Britton by knowingly acting in concert with Katzer pursuant to the terms of their 2005 Settlement Agreement, is in effect carrying out

Katzer's bad faith agenda with the result that Respondent too is interfering with Complainant's exercise of legitimate trademark rights and preventing Complainant from controlling use of his own registered trademark"^[199]

WIPO ordered "that the domain name decoderpro.com be transferred to [Jacobsen]"^[199] However, Jacobsen did not supply WIPO with his email to Britton where Jacobsen stated "my intent is to write the UDRP request so that it puts blame on Katzer and argues that you've been forced to continue his bad actions"^[105] In the December 2009 Summary Judgement decision, the Federal Court held that Katzer had illegally cybersquatted on the decoderpro.com domain name.

Digital Millennium Copyright Act claims

In his second amended complaint against Katzer, Jacobsen included a section alleging that Katzer violated section 102 of the [Digital Millennium Copyright Act](#).^[41] In the complaint he alleged that Katzer "intentionally removed from or altered copyright management information, without authority from the copyright holder", and that he "distributed works or copies of works, knowing that the copyright management information had been removed from or altered in the JMRI Decoder Definition Files".^[41] In response, Katzer filed a [motion to dismiss](#) the DMCA claims, stating that "information [that] does not encrypt or control access to the work, but rather 'functions to inform people who make copyright decisions'" did not count under the DMCA case history (quotation in original).^[106] However, in January, 2009, the court found that "it would be premature to dismiss the claim on the facts as alleged."^[53] and in ruling on the summary judgment motions in December 2009, the court ruled that Katzer's removal of the JMRI copyright information was a removal of copyright management information under the DMCA, leaving the question of intent under the DMCA, and damages under the DMCA to be proved at trial.^[40]

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- [Timeline on Katzer's web site](#)
- [Timeline on Ploucher's web site](#)
- [Jacobsen interviewed on FLOSS Weekly](#)

Further reading

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External links

- [Java Model Railroad Interface \(JMRI\) Open Source Project on SourceForge](#)
- [KAM Model Railroad Software](#)
- [Uniform Domain Name Dispute Resolution Policy](#)