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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,   )   **DECLARATION OF HANS TANNER IN**
)   **OPPOSITION TO MOTION TO DISMISS**
15   v.   )   **FOR LACK OF PERSONAL**
)   **JURISDICTION**
16 MATTHEW KATZER, et al.,   )
)   Date: Aug. 11, 2006
17   Defendants.   )   Time: 9:00 a.m.
)   Courtroom: 2, 17th Floor
18   )   Judge: Hon. Jeffrey S. White
)
19   )
)
20

21   I, HANS TANNER, based upon personal knowledge hereby declare as follows:

22   1.   I am co-owner (with my wife Mireille Tanner) of DigiToys Systems which makes

23 model train control systems software, among other products.

24   2.   Matthew Katzer (Mr. Katzer) and I have known each other for a number of years.

25 Mr. Katzer has been an active member of various Digital Command Control (DCC) groups.

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1   History of DigiToys and Its WinLok Software

2   3.   I started DigiToys under the name TannerSoft in 1989 in Switzerland. After

3   moving to the United States in 1997, I founded DigiToys Systems AG in Switzerland and DigiToys

4   Systems in the US. DigiToys Systems and DigiToys Systems AG (collectively DigiToys) have

5   been in business for 9 years, and are currently in business.

6   4.   DigiToys' main software product is called WinLok, the first version of which (i.e.,

7   WinLok 1.0) was released in 1992.

8   5.   In 1993 DigiToys' released a software version 1.5 which came with a printed user's

9   manual describing the various functionality associated with the WinLok 1.5 software.

10   6.   WinLok 1.5 came with a feature called "MultiDrive", which was described in the

11   user's manual. MultiDrive can selectively send commands from a plurality of graphical user

12   interfaces within the software, via different communications links, to operate a plurality of digital

13   command stations simultaneously.

14   7.   WinLok 1.5 was reviewed and described in a publicly available printed publication

15   called Model Railroading magazine in March 1995. Attached hereto as Exhibit A is a true and

16   correct copy of the magazine article.

17   8.   The next version of WinLok was called WinLok 2.0, and was released in 1995.

18   Version 2.0 also had the MultiDrive capability. This capability was described in the user's manual.

19   9.   Attached hereto as Exhibit B is a true and correct copy of the relevant pages from

20   the user's manual for WinLok 2.0.

21   10.   WinLok 2.0 was reviewed in Model Railroading magazine in December 1995.

22   11.   Attached hereto as Exhibit C is a true and correct copy of the article from the

23   December 1995 edition of Model Railroading magazine.

24   12.   From 1994 to 1997, WinLok was distributed in the United States by Tell's Apple,

25   Inc. in Florida. It was advertised in model railroading magazines and was readily available.

26   13.   In July 1997, I gave a presentation on Railroad Open System Architecture (ROSA)

27   at the National Model Railroad Association (NMRA) National Convention. Mr. Katzer, a member

28   of the DCC Working Group, was in the audience.

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14.   This presentation described using a variety of devices for multi-train control through a network server. It included the capability of providing commands to one of a plurality of digital command stations for operating a model railroad. The slides of the presentation were then publicly available for download for several years on DigiToys' web server.

15.   Attached hereto as Exhibit D is a true and correct copy of the slides from the ROSA presentation.

16.   The next version of WinLok was called WinLok 2.1. It was released in 1998. The MultiDrive capability present in this version was the same capability present in WinLok 1.5 and 2.0.

KAM Industries' Allegations of Patent Infringement

17.   In September 2002, DigiToys received a letter dated Sept. 18, 2002 of approximately 100 pages. It included a 2-page letter from Kevin Russell.

18.   Mr. Russell stated the letter was written on behalf of his client, KAM Industries. In this letter, Mr. Russell accused DigiToys of infringing Matt Katzer's and KAM Industries' patents. In particular, he stated that "the WinLok software is capable of providing commands to one of a plurality of digital command stations for operating a model railroad." He listed the following U.S. Patents: 6,065,406 (the '406 Patent) 6,270,040 (the '040 Patent) and 6,267,061 (the '061 Patent) (collectively Katzer patents) and identified several claims. Among the claims he stated that WinLok 2.1 infringed Claim 27 of the '406 patent and Claim 10 of the '061 patent.

19.   A true and correct copy of the September 2002 letter from Mr. Russell is attached as Exhibit E.

DigiToys Response to KAM Industries' Allegations

20.   After reviewing Mr. Russell's letter, I determined that many of the claims disclosed in the Katzer patents were anticipated or rendered obvious by WinLok version 1.5, and 2.0.

21.   On Oct. 3, 2002 I sent a responsive letter to Mr. Russell with supporting attachments including relevant parts describing MultiDrive from the user's manual for WinLok 2.0.

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1   22.   A true and correct copy of the Oct. 3, 2002 letter to Mr. Russell, and its appendices,

2   is attached hereto as Exhibit F.

3   23.   In this letter, I told Mr. Russell that I believed Mr. Katzer and KAM Industries had

4   obtained copies of my products in the mid-1990s, well before Mr. Katzer filed his first patent

5   application.

6   24.   Furthermore, I told Mr. Russell that the reference in the Background sections of the

7   Katzer patents to a program by DigiToys could only be the WinLok 1.5 and 2.0 applications.

8   25.   Moreover, I told Mr. Russell that the allegedly infringing capabilities in WinLok 2.1

9   were present in WinLok 1.5 and 2.0.

10   26.   I told Mr. Russell that my product could not infringe Matt Katzer's patent because

11   WinLok 1.5 and 2.0 had been sold and distributed more than 1 year before Matt Katzer's first

12   patent application, and thus my product would bar his patent if my product did in fact infringe.

13   27.   I produced to Mr. Russell sales receipts from 1996 for these WinLok products.

14   28.   Further, I also told him that my products had been reviewed in Model Railroading

15   and another magazine. I produced those articles to Mr. Russell.

16   29.   Additionally, I identified other prior art for Mr. Russell, specifically Railroad &

17   Co.'s TrainController software, which has the capability to connect to a plurality of digital

18   command stations. This software was sold and distributed more than 1 year before Matt Katzer's

19   first patent application.

20   30.   I also identified to Mr. Russell Soft-Lok, a program by W. Schapals of Germany,

21   which demonstrated multiple digital command station capability in the early 1990s, and the MES

22   software by Heinrich Maile of Spain, which is capable of driving a plurality of digital command

23   stations. The MES software, sold in 1985, was reviewed in the German railroad magazine MIBA.

24   I produced documentation relating to MES for Mr. Russell.

25   31.   Moreover, I told Mr. Russell that it was almost certain that the claims were pre-

26   dated by prior art from several software vendors, and that the use of queues, synchronous and

27   asynchronous communication mechanisms, as well as message processing functions, which were

28   claimed by Mr. Katzer, were standard programming techniques for the Windows operating system

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1   by at least 1995.

2   32.   Any other statements in the Oct. 3, 2002 letter to Mr. Russell which I have not

3   testified to in the preceding paragraphs, I testify to now as true at the time I wrote the letter and

4   true today, and I incorporate those statements by reference.

5   33.   In addition to sending this letter to Mr. Russell, I also sent this letter to the U.S.

6   Patent and Trademark Office to include with the file wrappers of the three Katzer patents.

7   34.   A true and correct copy of the cover sheet, stamped received by the U.S.P.T.O. on

8   Oct. 7, 2002, for the letter sent to file wrapper of the 6,267,061 patent at the U.S. PTO is attached

9   hereto as Exhibit G.

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11   Other Katzer Patents

12   35.   Since 2002, I have reviewed other Katzer patents including United States Patent No.

13   6,530,329 (the '329 Patent). Common to the previous cited Katzer Patents and the '329 Patent is

14   the reference to technology produced by DigiToys. Specifically, the both the '329 Patent and the

15   Katzer patents describe in their background sections how "DigiToys Systems of Lawrenceville, Ga.

16   has developed a software program for controlling a model railroad set from a remote location." As

17   with the Katzer patents, the language of the '329 Patent can only be referring to the various

18   versions of WinLok including 1.5, and 2.0.

19   36.   Attached hereto as Exhibit H is a true and correct copy of the '329 Patent.

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21   Knowledge of JMRI

22   37.   As a manufacturer, I am familiar with other model train control systems software

23   manufacturers in the U.S. and abroad.

24   38.   I am familiar with the JMRI software.

25   39.   It is produced by a group of software developers who write code as a hobby.

26   40.   I have seen the JMRI group at NMRA conferences, and talk with Robert Jacobsen

27   on a regular basis.

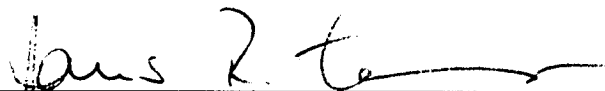28   41.   At the conferences and during discussions with Mr. Jacobsen, I have never seen

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anything that suggests JMRI software is sponsored by the U.S. Department of Energy.

42. I have never heard of anyone who believed that the U.S. Department of Energy sponsored the JMRI project.

43. To my knowledge, JMRI is not sponsored by any entity, but is a group of hobbyists who write code for others to use in running model trains.

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

Executed this 9th day of June, 2006.

By _____
Hans Tanner