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Margaret Botkins
Clerk of Court

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF WYOMING

ONSTREAM MEDIA CORPORATION,

Plaintiff,

v.

ZERIFY INC.,

Defendant.

Case No. 22-cv-00191-ABJ

Jury Trial Demanded

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff Onstream Media Corporation (“Onstream”) files this Complaint against Defendant Zerify Inc. (“Zerify”) for patent infringement of United States Patent No. 9,161,068 (the “patent-in-suit”) attached as an exhibit, respectively, and alleges as follows:

NATURE OF THE ACTION

1. This is an action for patent infringement arising under the patent laws of the United States, 35 U.S.C. §§ 1 *et seq.*

THE PARTIES

2. Onstream is a corporation organized under laws of the State of Florida with its principal place of business at 1451 West Cypress Creek Road, No. 204, Ft. Lauderdale, Florida, 33309.

3. On information and belief, Zerify is a corporation organized under the laws of the State of Wyoming with its principal place of business at 1090 King Georges Post Road, Suite 603, Edison, NJ 08837.

4. On information and belief, Zerify may be served with process by serving its registered agent Wyoming Corporate Services, Inc at 1712 Pioneer Avenue Suite 101, Cheyenne, Wyoming 82001.

JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338(a) because this action arises under the patent laws of the United States, 35 U.S.C. §§ 1 *et seq.*

6. This Court has personal jurisdiction over Zerify in accordance with due process and/or the Wyoming Long Arm Statue because, because it is organized in the State of Wyoming and has committed and continues to commit acts of infringement giving rise to this action in the State of Wyoming in violation of at least 35 U.S.C. §§ 271(a). In particular, on information and belief, Zerify has made, used, offered to sell and/or sold infringing products, services and/or systems in the State of Wyoming.

7. On information and belief, Zerify, directly or indirectly, designs, develops, manufactures, makes, sells, offers for sale, imports, distributes, advertises, and/or otherwise

promotes the accused infringing methods, products, and services in the United States, the State of Wyoming, and this judicial district.

8. On information and belief, Zerify has made, used, offered to sell and/or sold products and services, including its live streaming / broadcasting platform. (As used herein, one or more of the forgoing products and services are individually and collectively referred to as the accused Zerify Video Products and Services).

9. On information and belief, Zerify has made, used, offered to sell and/or sold products and services, including the following specifically accused products and services: (1) Zerify Meet, formerly known as SafeVChat;¹ (2) and all other current or legacy products and services imported, made, used, sold, or offered for sale by Zerify that operate in a substantially similar manner as the above-listed products and services, (collectively and individually referred to herein as the “Zerify Products and Services”).

On information and belief, Zerify, as well as the hardware and software components comprising the Zerify Video Products and Services and/or that enable the Zerify Video Products and Services to operate, including but not limited to servers, server software, client software, front-end hardware, endpoint hardware, endpoint software, back-end hardware, encoders, transcoders, cloud-based software, and other hardware and software computer systems and components (collectively referred to herein as the “Zerify System”), infringes at least one claim of the patent-in-suit both literally and/or under the doctrine of equivalents.

¹ See <https://www.zerify.com/>

10. This Court also has personal jurisdiction over Zerify because Zerify has sufficient minimum contacts with this forum as a result of business conducted within the State of Wyoming and this judicial district. In particular, this Court has personal jurisdiction over Zerify because, *inter alia*, Zerify, on information and belief (directly and/or through its subsidiaries, affiliates, or intermediaries), has substantial, continuous, and systematic business contacts in this judicial district, and derives substantial revenue from goods and services provided to individuals in the State of Wyoming and this judicial district.

11. Zerify (directly and/or through its subsidiaries, affiliates, or intermediaries) has purposefully availed itself of the privileges of conducting business within the State of Wyoming and in this judicial district, has established sufficient minimum contacts with this judicial district such that it should reasonably and fairly anticipate being hauled into court in this judicial district, has purposefully directed activities at residents of this judicial district, and at least a portion of the patent infringement claim alleged in this Complaint arise out of or are related to one or more of the foregoing activities.

12. Venue is proper pursuant to 28 U.S.C. §§ 1391(b), (c), (d) and/or 1400(b), at least because Zerify is a Wyoming company and, therefore, resides in this judicial district.

United States Patent No. 9,161,068

13. On October 13, 2015, the United States Patent and Trademark Office (“USPTO”) duly and legally issued United States Patent No. 9,161,068 (“the ’068 patent”) entitled “Remotely Accessed Virtual Recording Room” to inventor Gregory Duane Ellis.

14. The ’068 patent is presumed valid under 35 U.S.C. § 282.

15. Onstream owns all rights, title, and interest in the ’068 patent.

16. On information and belief, Onstream has not granted Zerify an approval, an authorization, or a license to the rights under the '068 patent.

17. The '068 patent relates to, among other things, an audio and video stream recording, storage, and delivery system.

18. The claimed invention(s) of the '068 patent sought to solve problems with, and improve upon, existing audio and video recording, storage, delivery systems. For example, the '068 patent states:

Unfortunately, new systems and methods for increasing the capabilities of online business-related communications and transactions often result in increased intellectual complexity and/or increased computer system requirements. This tendency is undesirable because another main avenue for increasing the productivity of online business-related communications and transactions is to increase the number of people who are participating in these online business-related transactions.

See '068 Specification at col. 1, ll. 31-39.

19. The '068 patent then states:

Accordingly, it would be highly valuable if any new systems and methods for increasing the capabilities of online business-related communications and transactions also could be simple enough to help attract new users to the online business market and also not have extensive computer system requirements.

See '068 Specification at col. 1, ll. 39-44.

20. The '068 patent then also states:

Accordingly, there has been a long existing need for a system that improves the level of communication possible with respect to online business-related transactions. Further, there is a continuing need for an improved system and/or method that is simple, efficient, and does not have extensive computer system requirements. Accordingly, those skilled in the art have long recognized the need for a system and method that addresses these and other issues.

See '068 Specification at col. 1, ll. 45-52.

21. The invention(s) claimed in the '068 patent solves various technological problems inherent in the then-existing audio and video recording, storage, and delivery systems and enables audio and video recording, storage, and delivery systems to, among other things, (1) function more efficiently, (2) lower the required level of expertise for users of such systems, (3) avoid the need to install and burden front end computer and electronic devices with additional software, (4) reduce or eliminate entirely the need for local memory storage devices and other specialized recording equipment, and (5) reduce or eliminate other hardware and software requirements inherent in prior art audio and video recording and distribution systems.

CLAIM FOR RELIEF

Count – Infringement of United States Patent No. 9,161,068

22. Onstream repeats, realleges, and incorporates by reference, as if fully set forth here, the allegations of the preceding paragraphs above.

23. On information and belief, Zerify (or those acting on its behalf) makes, uses, sells, imports and/or offers to sell the Zerify Video Products and Services; and makes, uses, sells, sells access to, imports, offers to sell and/or offers to sell access to the Zerify System in the United States that infringe (literally and/or under the doctrine of equivalents) at least claim 1 of the '068 patent.

24. On information and belief, one or more components of the Zerify System employs and provides a method that records audio and video material over an Internet browser connection established between a user front end and a host back end.

*SafeVchat is now Zerify Meet


See e.g., <https://www.zerify.com/>



Secure Video Conferencing

Video conferencing and collaboration have become the new "normal" allowing businesses and consumers to connect from anywhere in the world. Current industry options were not designed with protection in mind. Secure your meetings with the industry's most secure video conferencing system to hit the market.

See e.g., <https://www.strikeforcetech.com/safevchat/>



System Features

- ✓ No Desktop Client - Entirely Web Based Conferencing
- ✓ Mobile Application for Apple & Android
- ✓ Audio & Video Conferencing
- ✓ Desktop Sharing Raise Hand Functionality
- ✓ Instant Chat
- ✓ Mute Participants

See e.g., <https://www.strikeforcetech.com/safevchat/>

7) Meeting Management:

- Shared Corporate Database- Toggle between personal and corporate database
- Mobile Applications- iOS and Android
- User Self Administration Portal
- Multi-level Admin Portal – User Management and Audit Reports
- Add meeting agenda
- Add meeting minutes, notes and related links
- Desktop sharing
- Raised hand functionality
- Instant chat
- Mute participants
- Video Recording
- Live Stream

See e.g., <https://www.strikeforcetech.com/wp-content/uploads/SafeVchat-Whitepaper-Final.pdf>

6) Flexible Deployment:

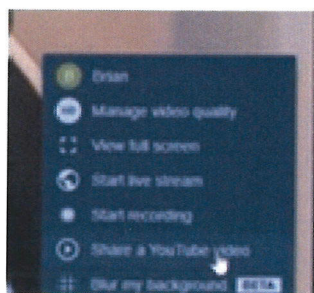
- 100% Cloud-based:

See e.g., <https://www.strikeforcetech.com/wp-content/uploads/SafeVchat-Whitepaper-Final.pdf>

all competitors. Two weeks ago, we finished adding a new recording feature, an upgraded performance platform and just this week we added facial recognition for quick and super-secure access control. From what we can tell by all the competitor's websites, that we have built more cyber security into our SafeVchat than all the competitors combined.

See e.g., <https://www.globenewswire.com/en/news-release/2022/01/18/2368450/0/en/StrikeForce-Technologies-Provides-a-Business-Update-for-2022.html>

25. On information and belief, when a user wants to begin streaming using the Zerify Video Products and Services, servers of the Zerify System deliver a code, which can be executed by a browser.



See e.g., <https://www.youtube.com/watch?v=A4hfc-erdwI> at 4:15 (“ . . . and then over here on the right you have various options . . . you can live stream your video conference. You can also just record your video conference into an mp4 file . . .”)

26. On information and belief, one or more components of the Zerify System delivers a code that enables the streaming of audio and video material. See e.g., *Id.*



5- Level Meeting Security

- ✓ Meeting Password
- ✓ Meeting Authentication - Every participant is authenticated by Secure 2FA
- ✓ Meeting Authorization - Only participants listed for the meeting are granted access
- ✓ Meeting Endpoint Secured from Malware Spying
- ✓ Encrypted Audio & Video

See e.g., <https://www.strikeforcetech.com/safevchat/>

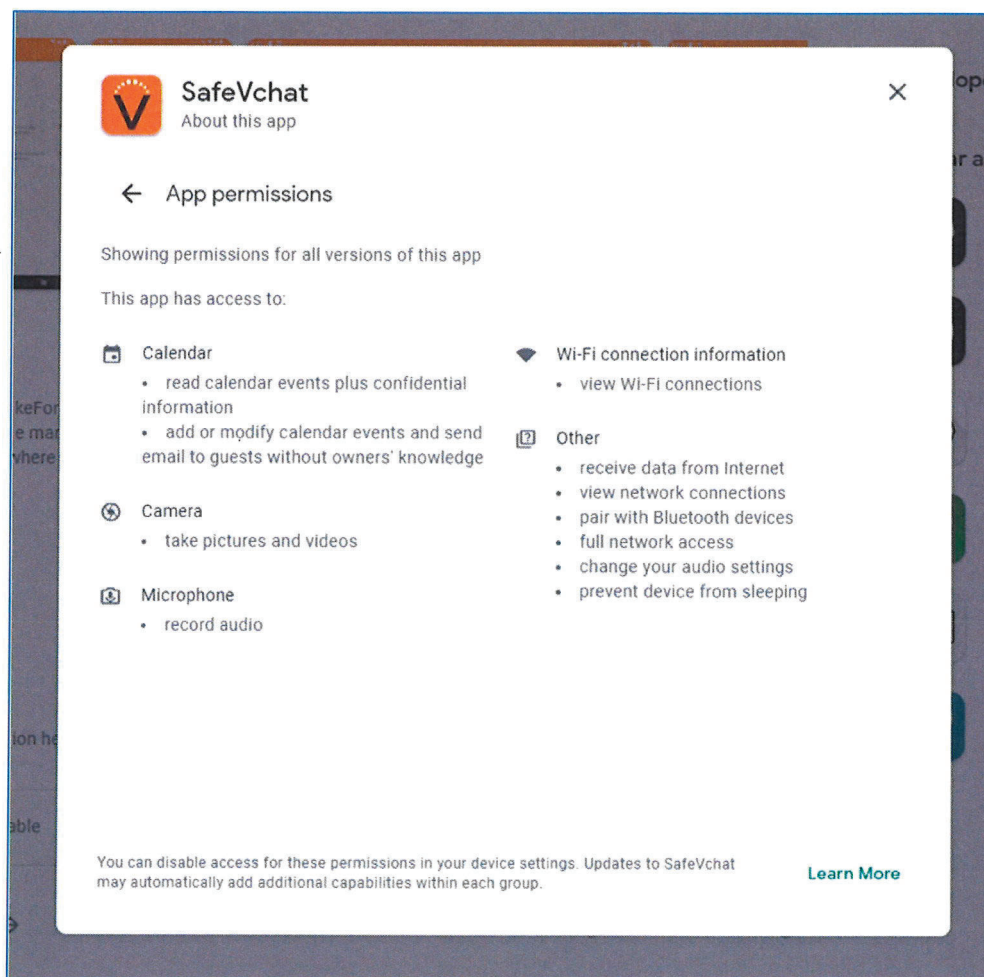
27. On information and belief, one or more components of the Zerify System delivers a browser-executable-code that is a browser independent recording application that initiates the audio and video stream to be recorded. See e.g., *Id.*

28. On information and belief, one or more components of the Zerify System delivers a code that is executed through a browser at the user front end.

- **Clientless** - SafeVchat is desktop free and completely browser-based, which means hackers do not have an extra client they can leech onto and cause havoc

See e.g., <https://www.globenewswire.com/en/news-release/2020/12/21/2148670/0/en/StrikeForce-Unveils-SafeVchat-Delivering-First-Fully-Secure-Video-Conferencing-Platform.html>

29. On information and belief, one or more components of the Zerify System uses an Internet connection. See e.g., *Id.*



See e.g.,

https://play.google.com/store/apps/details?id=com.strikeforcetech.safevchat&hl=en_US&gl=US

30. On information and belief, one or more components of the Zerify System uses and provides a method that does not require transmission of a complete audio and video file from the user front end. Rather, on information and belief, a stream of audio and video material is transmitted to the servers of the Zerify System as the audio and video material is being captured.

See e.g., Id.

- 7) Meeting Management:
- Shared Corporate Database- Toggle between personal and corporate database
 - Mobile Applications- iOS and Android
 - User Self Administration Portal
 - Multi-level Admin Portal – User Management and Audit Reports
 - Add meeting agenda
 - Add meeting minutes, notes and related links
 - Desktop sharing
 - Raised hand functionality
 - Instant chat
 - Mute participants
 - Video Recording
 - Live Stream

See e.g., <https://www.strikeforcetech.com/wp-content/uploads/SafeVchat-Whitepaper-Final.pdf>

See e.g., <https://www.youtube.com/watch?v=A4hfc-erdwI> at 4:15 (“ . . . and then over here on the right you have various options . . . you can live stream your video conference. You can also just record your video conference into an mp4 file . . .”)

First, you need to build the video conferencing piece. At a minimum this consists of the following - (1) a XMPP server which hosts the meeting room and chat server, (2) a video/audio bridge for mixing the media streams, (3) a Controller that sets up the meeting room and acts as the go-between the conference participants and conference resources, and (4) the participant software which could be a desktop program, a mobile app or a browser (implementing the webRTC API).

See e.g., <https://www.strikeforcetech.com/the-safevchat-story/>

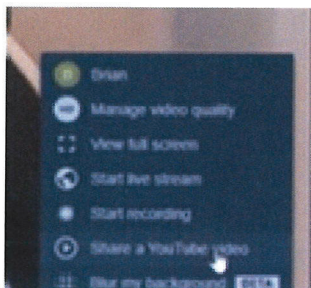
31. On information and belief, one or more components of the Zerify System uses and provides a method wherein the audio and video recordings are made and stored on the host back end as a complete file. See e.g., *Id.*

Second, we added the ability to create a Meeting Agenda and Meeting Notes. This was important because though storing a recording is nice (which we will also have), it can be a pain to go over a couple of hours to find out what happened in the meeting. Also, the recording is not stored permanently whereas the Meeting Notes will be always available.

See e.g., <https://www.strikeforcetech.com/the-safevchat-story/>

32. On information and belief, one or more components of the Zerify System uses and provides a method wherein after the recording of audio and video material is complete, Zerify provides access to the entire audio and video recording. See e.g., *Id.*

33. On information and belief, Zerify provides access to a complete audio and video file as a downloadable mp4 file after recording is complete.



See e.g., <https://www.youtube.com/watch?v=A4hfc-erdwI> at 4:15 (“ . . . and then over here on the right you have various options . . . you can live stream your video conference. You can also just record your video conference into an mp4 file . . .”)

34. On information and belief, one or more components of the Zerify System uses and provides a method wherein audio and video material is captured without using any recording software installed on the user front end.

4) 100% web-based; No Client Agent to install:

See e.g., <https://www.strikeforcetech.com/wp-content/uploads/SafeVchat-Whitepaper-Final.pdf>

35. On information and belief, one or more components of the Zerify System employs and provides a method wherein audio and video material is streamed over the Internet as the audio and video material is captured by a recording device.

- 7) Meeting Management:
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See e.g., <https://www.strikeforcetech.com/wp-content/uploads/SafeVchat-Whitepaper-Final.pdf>

See e.g., <https://www.youtube.com/watch?v=A4hfc-erdwI> at 4:15 (“ . . . and then over here on the right you have various options . . . you can live stream your video conference.”)

36. On information and belief, Zerify directly infringes at least claim 1 of the ‘068 patent, and is in violation of 35 U.S.C. § 271(a) by making, using, selling, importing, and/or offering to sell the Zerify Video Products and services; and making, using, selling, selling access to, importing, offering for sale, and/or offering to sell access to the Zerify System.

37. Zerify’s direct infringement has damaged Onstream and caused it to suffer and continue to suffer irreparable harm and damages.

JURY DEMANDED

38. Pursuant to Federal Rule of Civil Procedure 38(b), Onstream hereby requests a trial by jury on all issues so triable.

PRAYER FOR RELIEF

Onstream respectfully requests this Court to enter judgment in Onstream’s favor and against Zerify as follows:

- a. finding that Zerify has infringed one or more claims of the ‘068 patent under 35 U.S.C. §§ 271(a);

- b. awarding Onstream damages under 35 U.S.C. § 284, or otherwise permitted by law, including supplemental damages for any continued post-verdict infringement;
- c. awarding Onstream pre-judgment and post-judgment interest on the damages award and costs;
- d. awarding cost of this action (including all disbursements) and attorney fees pursuant to 35 U.S.C. § 285, or as otherwise permitted by the law; and
- e. awarding such other costs and further relief that the Court determines to be just and equitable.

Dated: September 7, 2022

Respectfully submitted,



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