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Clerk of Court

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IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF WYOMING

ONSTREAM MEDIA CORPORATION, Plaintiff, v. ZERIFY INC., Defendant.	Case No. 22-cv-00195-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. 9,467,728 (the "patent-in-suit") attached 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.

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[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. 9,467,728

13.   On October 11, 2016, the USPTO duly and legally issued United States Patent No. 9,467,728 ("the '728 patent") entitled "Remotely Accessed Virtual Recording Room" to inventor Gregory Ellis.

14.   The '728 patent is presumed valid under 35 U.S.C. § 282.

15.   Onstream owns all rights, title, and interest in the '728 patent.

16.   Onstream has not granted Zerify an approval, an authorization or a license to the rights under the '728 patent.

17.   The '728 patent relates to, among other things, an audio and video stream recording, storage, and delivery system.

18.   The claimed invention(s) of the '728 patent sought to solve problems with, and improve upon, existing audio and video recording, storage, delivery systems. For example, the '728 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 productively of online business-related communications and transactions is to increase the number of people who are participating in these online business-related transactions.

See '728 Specification at col. 1, ll. 48-56.

19.   The '728 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 '728 Specification at col. 1, ll. 56-61.

20.   The '728 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 '728 Specification at col. 1, ll. 62-col. 2, ll. 2.

21.   The invention(s) claimed in the '728 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. 9,467,728

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 '728 patent.

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

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

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

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/

> 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, one or more components of the Zerify System employs and provides an Internet-based recording method comprising transmitting, to the user front end from the host back end via a network, (*e.g.*, the Internet), a platform-independent web application, wherein the web application initiates the streaming of audio and video material from a receiving device on the user front end to the host back end as it is being captured with the receiving device. *See e.g., Id.*

> **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).
>
> **Second**, you need to authenticate every user. Currently, when you get a meeting link (from Zoom, Teams or any one else) and you click on it, you are taken into the meeting. At most you are challenged for a meeting password. There is no user authentication unless your company has setup Single Sign On (SSO), in which case, you will be directed to a SSO page to authenticate (typically via 2FA or AD/LDAP) prior to proceeding to the meeting page. The problem with this is that all the meeting participants should be enrolled in the same authentication system. This does not work for meetings among participants who belong to diverse organizations. The challenge is to authenticate all users, even those who are not enrolled in the authentication system.

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

26.   On information and belief, one or more components of the Zerify System employs and provides an Internet-based recording method comprising recording the audio and video material on the host back end (*e.g.*, one or more servers of the Zerify System) via the web application and storing the recorded audio and video material as a complete video file. *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

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/

27.   On information and belief, one or more components of the Zerify System employs and provides an Internet-based recording method comprising generating code associated with the recorded and stored audio and video material to facilitate accessing the recorded and stored audio and video material from an additional location, wherein the content of the generated code depends on a type of code supported by the additional location. *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
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See e.g., https://www.strikeforcetech.com/wp-content/uploads/SafeVchat-Whitepaper-Final.pdf

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/

28.   On information and belief, one or more components of the Zerify System employs and provides an Internet-based recording method comprising generating code associated with the recorded and stored audio and video material to facilitate accessing the recorded and stored audio and video material from an additional location because after a meeting is subsequently recorded to the host back end the complete audio and video file is made available as an mp4 file.
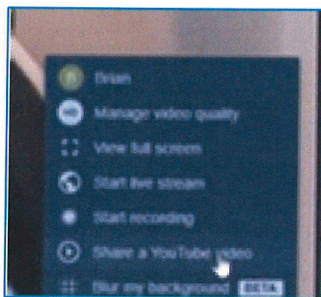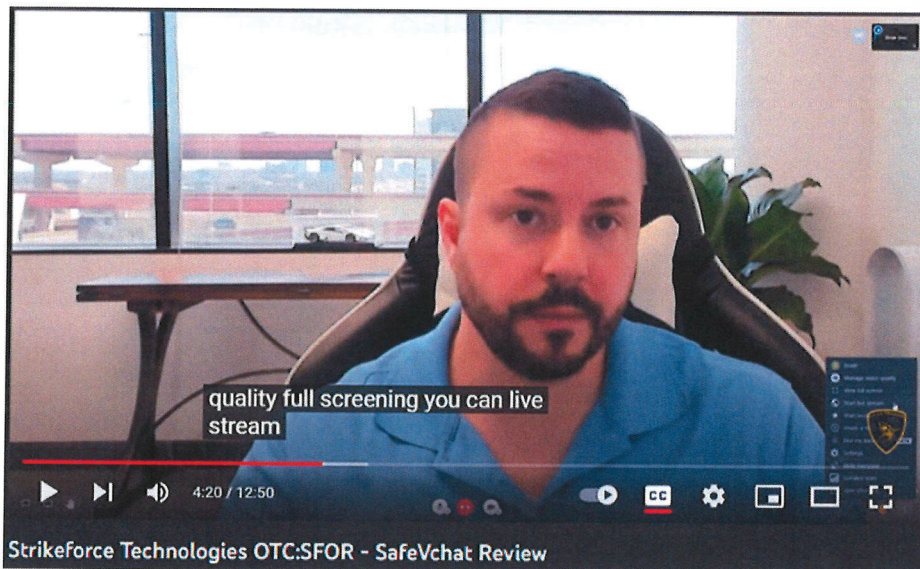
See e.g., https://www.youtube.com/watch?v=A4hfc-erdwI at 4:15 (" . . . and then over here on the right you have various options . . . you can live stream your video conference. You can also just record your video conference into an mp4 file . . .")

29.   On information and belief, one or more components of the Zerify System employs and provides an Internet-based recording method comprising enabling the generated code to be copied and pasted to the additional location, wherein activating the generated code provides access to the recorded audio and video material from the additional location. *See e.g., Id.*

30.   On information and belief, Zerify directly infringes at least claim 1 of the '728 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.

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

JURY DEMANDED

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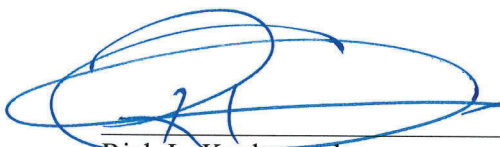
PRAYER FOR RELIEF

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 '728 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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