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Attorney(s) for Digital Verification Systems, LLC

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF NEW YORK**

**DIGITAL VERIFICATION SYSTEMS,
LLC**

Plaintiff,

v.

ODOO, INC,

Defendant.

Case No. 23-852

Jury Trial Demanded

ORIGINAL COMPLAINT FOR PATENT INFRINGEMENT

1 Plaintiff Digital Verification Systems, LLC (“Plaintiff” and/or “DVS”)
2 files this complaint against Odoo, Inc. (“Defendant”), for infringement of U.S.
3 Patent No. 9,054,860 (hereinafter “the ‘860 Patent”)¹ and alleges as follows:

4 **PARTIES**

5 1. Plaintiff is a Texas limited liability company with an address of 1
6 East Broward Boulevard, Suite 700, Ft. Lauderdale, FL 33301.

7 2. Defendant has an office located at 1 Seneca Street, Buffalo, NY
8 14203. On information and belief, Defendant has a registered agent, Odoo, Inc.,
9 c/o The Corporation 51 Federal St., Ste. 401, San Francisco, CA 94107.

10 **JURISDICTION AND VENUE**

11 3. This action arises under the patent laws of the United States, 35
12 U.S.C. § 271 *et seq.* Plaintiff seeks damages, as well as attorney fees and costs.

13 4. Jurisdiction is proper in this Court pursuant to 28 U.S.C. §§ 1331
14 (Federal Question) and 1338(a) (Patents).

15 5. On information and belief, this Court has personal jurisdiction over
16 Defendant because Defendant has committed, and continues to commit, acts of
17 infringement in this District, has conducted business in this District, and/or has
18 engaged in continuous and systematic activities in this District.

19 6. Upon information and belief, Defendant’s instrumentalities that are
20 alleged herein to infringe were and continue to be used, imported, offered for
21 sale, and/or sold in this District.

22 7. Venue is proper in this District under 28 U.S.C. §1400(b) because
23 Defendant is deemed to be a resident in this District. Alternatively, acts of
24 infringement are occurring in this District and Defendant has a regular and
25 established place of business in this District.

26
27
28 ¹ The ‘860 patent expires no earlier than April 7, 2034. The DVS patent family also includes U.S. Patent Nos. 9,917,834 and 10,498,732.

PATENT-IN-SUIT

1
2 8. On June 9, 2015, the United States Patent and Trademark Office
3 (“USPTO”) duly and legally issued the ’860 Patent, entitled “Digital Verified
4 Identification System and Method.” The ’860 Patent is attached as Exhibit A.

5 9. Plaintiff is the sole and exclusive owner, by assignment, of the ’860
6 Patent.

7 10. Plaintiff possesses all rights of recovery under the ’860 Patent,
8 including the exclusive right to recover for past, present and future infringement.

9 11. The inventor of the ’860 Patent, Mr. Leigh M. Rothschild, was
10 Chairman and Chief Executive Officer of IntraCorp Entertainment, Inc., a
11 consumer software company with worldwide product distribution. From October
12 1998 through February 2004, Mr. Rothschild was also Chairman and founder of
13 BarPoint.com, a NASDAQ publicly traded wireless company that was the leader
14 and early creator of connecting symbology, such as barcodes, to the Internet.

15 12. Mr. Rothschild is a former presidential appointee to the High-
16 Resolution Board for the United States under former President George H.W.
17 Bush, and has also served as an advisor for former President Ronald Reagan. Mr.
18 Rothschild served Governors on technology boards, served as a special advisor
19 to then Florida Secretary of Commerce John Ellis “Jeb” Bush, and served on the
20 IT Florida Technology Board as an appointee of former Governor John Ellis
21 “Jeb” Bush.

22 13. Mr. Rothschild chairs the Rothschild Family Foundation, which
23 endows outstanding charities and institutions around the world.

24 14. The ’860 Patent contains thirty-nine claims including four
25 independent claims (claims 1, 23, 26 and 39) and thirty-five dependent claims.

26 15. The priority date of the ’860 Patent is at least as early January 2,
27 2008. As of the priority date, the inventions as claimed were novel, non-obvious,
28 unconventional, and non-routine.

1 16. Plaintiff alleges infringement on the part of Defendant of the '860
2 Patent.

3 17. The '860 Patent teaches a system and method for verifying and/or
4 authenticating the identification of an entity associated with an electronic file,
5 such as, for example, the digital signatory thereof. *See* '860 Patent, Abstract. the
6 system and method include a module generating assembly structured to receive
7 at least one verification data element, and at least one digital identification
8 module structured to be associated with at least one entity. *Id.* The digital
9 identification module is capable of being disposed or embedded within at least
10 one electronic file. *Id.* Further, the digital identification module includes at least
11 one primary component structured to at least partially associate the digital
12 identification module with the entity, and one or more metadata components. *Id.*

13 18. As noted, the claims of the '860 Patent have priority date at least as
14 early as January 2, 2008. The present invention solves problems that existed with
15 then-existing methods for electronically signing a document. One common then-
16 existing method of electronically signing a document included placing a forward
17 or backward slash prior to and/or following the signatory's typed name. '860
18 Patent, 1:26-36. Accordingly, an individual named John Doe might electronically
19 sign a document by placing "/John Doe/" on a signature line that is typically at or
20 near the end of the document. *Id.* These various electronic signatures or
21 identifiers, however, are rather difficult to authenticate, and as such, it was an
22 arduous, if not impossible task to verify and/or authenticate the identity of the
23 signatory to a respectable degree. *Id.*

24 19. The claims of the '860 Patent overcome deficiencies existing in the
25 art as of the date of invention, and comprise non-conventional approaches that
26 transform the inventions as claimed into substantially more than mere abstract
27 ideas. For example, the inventive system includes a module generating assembly
28 structured to create at least one digital identification module, wherein the digital

1 identification module is structured to be embedded or otherwise disposed within
2 one or more electronic files. *Id.*, 1:65-2:3. Moreover, an entity, such as a
3 signatory of an electronic document, may communicate at least one verification
4 data element to the module generating assembly prior to creating the digital
5 identification module. *Id.*, 2:3-6. The verification data element(s) may include
6 any indicia or data structured to facilitate the verification or identification of the
7 corresponding entity. *Id.*, 2:6-9. For example, the verification data element(s)
8 may include a username and/or password, date of birth, social security number,
9 driver's license number, credit card number, etc. *Id.*, 2:9-12. In at least one
10 embodiment, the digital identification module includes at least one primary
11 component and at least one metadata component. *Id.*, 2:25-37. The primary
12 component may include, for example, a digital representation of a signature
13 and/or one or more reference codes, numbers, or characters. *Id.* The primary
14 component is generally visible or perceptible to a reader, recipient, or other user
15 of the electronic document. *Id.* In addition, the metadata components may be
16 representative of the one or more verification data elements, or other data
17 corresponding to the digital identification module and/or entity, including the
18 date and time, location of the entity, etc. *Id.*

19 20. The system(s) and methods of the '860 Patent include software and
20 hardware that do not operate in a conventional manner. For example, the
21 software is tailored to provide functionality to perform recited steps and the
22 hardware is configured (and/or programmed) to provide functionality recited
23 throughout the claims of the '860 Patent.

24 21. The '860 Patent solves problems with the art that are rooted in
25 computer technology and that are associated with electronically signing a
26 document. The '860 Patent claims do not merely recite the performance of some
27 business practice known from the pre-Internet world along with the requirement
28 to perform it on the Internet.

1 22. The improvements of the '860 Patent and the features recited in the
2 claims in the '860 Patent provide improvements to conventional hardware and
3 software systems and methods. The improvements render the claimed invention
4 of the '860 Patent non-generic in view of conventional components.

5 23. The improvements of the '860 Patent and the feature recitations in
6 the claims of the '860 Patent are not those that would be well-understood, routine,
7 or conventional to one of ordinary skill in the art at the time of the invention.

8 24. The '860 Patent was examined by Primary United States Patent
9 Examiner Oscar Louie. During the examination of the '860 Patent, the United
10 States Patent Examiner searched for prior art in the following US Classifications:
11 726/26; 713/176-180; and 380/59.

12 25. After conducting a search for prior art during the examination of the
13 '860 Patent, the United States Patent Examiner identified and cited the following
14 as the most relevant prior art references found during the search: US 6,757,826;
15 US 6,895,507; US 6,948,069; US 6,978,369; US 7,047,416; US 7,603,621; US
16 7,844,918; US 2002/0026575; US 2003/0115151; US 2003/0217275; US
17 2005/0050462; US 2005/0160272; US 2006/0173847; US 2008/0040693; and
18 US 2008/0082509.

19 26. After giving full proper credit to the prior art and having conducted
20 a thorough search for all relevant art and having fully considered the most
21 relevant art known at the time, the United States Patent Examiner allowed all of
22 the claims of the '860 Patent to issue. In so doing, it is presumed that Examiner
23 Louie used his knowledge of the art when examining the claims. *K/S Himpp v.*
24 *Hear-Wear Techs., LLC*, 751 F.3d 1362, 1369 (Fed. Cir. 2014). It is further
25 presumed that Examiner Louie had experience in the field of the invention, and
26 that the Examiner properly acted in accordance with a person of ordinary skill.
27 *In re Sang Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). In view of the
28 foregoing, the claims of the '860 Patent are novel and non-obvious, including

1 over all non-cited art which is merely cumulative with the referenced and cited
2 prior art. Likewise, the claims of the '860 Patent are novel and non-obvious,
3 including over all non-cited contemporaneous state of the art systems and
4 methods, all of which would have been known to a person of ordinary skill in the
5 art, and which were therefore presumptively also known and considered by
6 Examiner Louie.

7 27. The claims of the '860 Patent were all properly issued, and are valid
8 and enforceable for the respective terms of their statutory life through expiration,
9 and are enforceable for purposes of seeking damages for past infringement even
10 post-expiration. *See, e.g., Genetics Institute, LLC v. Novartis Vaccines and*
11 *Diagnostics, Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011) (“[A]n expired patent is
12 not viewed as having ‘never existed.’ Much to the contrary, a patent does have
13 value beyond its expiration date. For example, an expired patent may form the
14 basis of an action for past damages subject to the six-year limitation under 35
15 U.S.C. § 286”) (internal citations omitted).

16 28. The nominal expiration date for the claims of the '860 Patent is no
17 earlier than April 7, 2034.

18 **COUNT ONE**

19 **(Infringement of United States Patent No. 9,054,860)**

20 29. Plaintiff refers to and incorporates the allegations in Paragraphs 1 –
21 28, the same as if set forth herein.

22 30. This cause of action arises under the patent laws of the United States
23 and, in particular under 35 U.S.C. §§ 271, *et seq.*

24 31. Defendant has knowledge of its infringement of the '860 Patent, at
25 least as of the service of the present complaint.

26 32. The '860 Patent is valid, enforceable, and was duly issued in full
27 compliance with Title 35 of the United States Code.

28 33. Upon information and belief, Defendant has infringed and continues

1 to infringe one or more claims, including at least Claim 1, of the '860 Patent by
2 manufacturing, using, importing, selling, offering for sale, and/or providing (as
3 identified in the Claim Chart attached hereto as **Exhibit B**) its product that is a
4 process method for e-signing digital documents safely ("Product(s)"), which
5 infringes at least Claim 1 of the '860 Patent. Defendant has infringed and
6 continues to infringe the '860 patent either directly or through acts of contributory
7 infringement or inducement in violation of 35 U.S.C. § 271.

8 34. Defendant also has and continues to directly infringe, literally or
9 under the doctrine of equivalents, one or more claims, including at least Claim 1,
10 of the '860 Patent, by having its employees internally test and use these exemplary
11 Products.

12 35. The service of this Complaint, in conjunction with the attached
13 claim chart and references cited, constitutes actual knowledge of infringement as
14 alleged here.

15 36. Despite such actual knowledge, Defendant continues to make, use,
16 test, sell, offer for sale, market, and/or import into the United States, products
17 that infringe one or more claims, including at least Claim 1, of the '860 Patent.
18 On information and belief, Defendant has also continued to sell the exemplary
19 Products and distribute product literature and website materials inducing end
20 users and others to use its products in the customary and intended manner that
21 infringes one or more claims, including at least Claim 1, of the '860 Patent. *See*
22 Exhibit B (extensively referencing these materials to demonstrate how they direct
23 end users to commit patent infringement).

24 37. At least since being served by this Complaint and corresponding
25 claim chart, Defendant has actively, knowingly, and intentionally continued to
26 induce infringement of the '860 Patent, literally or by the doctrine of equivalents,
27 by selling exemplary Products to their customers for use in end-user products in
28

1 a manner that infringes one or more claims, including at least Claim 1, of the '860
2 Patent.

3 38. Exhibit B includes at least one chart comparing the exemplary claim
4 1 of the '860 Patent to Defendant's exemplary Products. As set forth in this chart,
5 the Defendant's exemplary Products practice the technology claimed by the '860
6 Patent. Accordingly, the Defendant's exemplary Products incorporated in this
7 chart satisfy all elements of the exemplary claim 1 of the '860 Patent.

8 39. Plaintiff therefore incorporates by reference in its allegations herein
9 the claim chart of **Exhibit B**.

10 40. Plaintiff is entitled to recover damages adequate to compensate for
11 Defendant's infringement.

12 41. Defendant's actions complained of herein will continue unless
13 Defendant is enjoined by this court.

14 42. Defendant's actions complained of herein are causing irreparable
15 harm and monetary damage to Plaintiff and will continue to do so unless and until
16 Defendant is enjoined and restrained by this Court.

17 43. Plaintiff is in compliance with 35 U.S.C. § 287.

18 **DEMAND FOR JURY TRIAL**

19 24. Plaintiff, under Rule 38 of the Federal Rules of Civil Procedure,
20 requests a trial by jury of any issues so triable by right.

21 **PRAYER FOR RELIEF**

22 WHEREFORE, Plaintiff asks the Court to:

23 (a) Enter judgment for Plaintiff on this Complaint on all cases of action
24 asserted herein;

25 (b) Enter an Order enjoining Defendant, its agents, officers, servants,
26 employees, attorneys, and all persons in active concert or participation with
27 Defendant who receives notice of the order from further infringement of United
28 States Patent No. 9,054,860 (or, in the alternative, awarding Plaintiff running

1 royalty from the time judgment going forward);

2 (c) Award Plaintiff damages resulting from Defendant's infringement in
3 accordance with 35 U.S.C. § 284;

4 (d) Award Plaintiff such further relief to which the Court finds Plaintiff
5 entitled under law or equity.

6
7 Dated: August 18, 2023

Respectfully submitted,

8 **KLUGER HEALEY, LLC**

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