

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MINDGEEK USA INC., MINDGEEK S.A.R.L., MG FREESITES LTD., MG
FREESITES II LTD., MG CONTENT RK LTD., MG CONTENT DP LTD., MG
CONTENT RT LTD., MG PREMIUM LTD., MG CONTENT SC LTD., MG
CYPRUS LTD., LICENSING IP INTERNATIONAL S.A.R.L., 9219-1568
QUEBEC INC. d/b/a ENTERPRISE MINDGEEK CANADA, and COLBETTE II
LTD.,
Petitioners,

v.

UNIVERSITY OF SOUTHERN CALIFORNIA,
Patent Owner.

Case IPR2019-00422
Patent 6,212,527

**PATENT OWNER UNIVERSITY OF SOUTHERN CALIFORNIA'S
PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107**

TABLE OF CONTENTS

I. INTRODUCTION1

II. STATEMENT OF MATERIAL FACTS IN DISPUTE1

III. STATEMENT OF RELIEF REQUESTED2

 A. OVERVIEW OF THE '527 PATENT2

 B. LEVEL OF ORDINARY SKILL IN THE ART4

 C. CLAIM CONSTRUCTION5

IV. THE PETITION FAILS TO MEET THE REQUIREMENTS FOR
INSTITUTING AN *INTER PARTES* REVIEW5

IV. CONCLUSION6

I. INTRODUCTION

Patent Owner University of Southern California (“Patent Owner”) respectfully submits this Patent Owner Preliminary Response under 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a) in response to a Petition filed by Petitioners MindGeek USA, Inc. and MindGeek S.A.R.L., among other MindGeek entities (collectively, “Petitioners”). It is being timely filed on or before May 6, 2019 pursuant to 37 C.F.R. § 42.107(b).

“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Here, institution should be denied because Petitioners admit they are time barred under 35 U.S.C. § 315(b) because the Petition was filed more than one year after the date on which Petitioners were served with a complaint alleging infringement of the patent:

The complaint was served on October 14, 2014 [more than 1 year before the filing of the instant petition]. Petitioners acknowledge recent Federal Circuit precedent that even if a complaint is voluntarily dismissed, the one year IPR time bar applies to such a complaint.

Paper 1 (Petition) at 5-6.

II. STATEMENT OF MATERIAL FACTS IN DISPUTE

Petitioners did not submit a statement of material facts in its Petition for *inter*

partes review. Paper 1 (Petition). Accordingly, no response to a statement of material facts is due pursuant to 37 C.F.R. § 42.23(a). Patent Owner notes Petitioners do not dispute that Preservation Technologies LLC, the exclusive licensee of the '527 patent, served on Petitioners a complaint alleging infringement of the '527 patent on October 14, 2014, more than 1 year prior to the filing date of the Petition. Paper 1 (Petition) at 5-6. Although the case at issue, *Preservation Technologies LLC v. MindGeek USA Incorporated*, 1:14-cv-01292-SLR (D. Del.), was dismissed without prejudice, it is also undisputed service of this complaint triggered the one year time bar under 35 U.S.C. § 315(b). *Id.*; see *Click-To-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1328 (Fed. Cir. 2018).

III. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 314(a), Patent Owner respectfully requests that the Board deny institution of a trial with respect to all claims of the '527 Patent.

A. OVERVIEW OF THE '527 PATENT

The USC Shoah Foundation, formerly known as Survivors of the Shoah Visual History Foundation, (the "Shoah Foundation") developed the patented technology described in the '527 patent. In the mid-1990s, Steven Spielberg founded the Shoah Foundation to preserve the testimonies of the then living 50,000 holocaust survivors before their first-hand accounts of the Holocaust were lost as that generation passed away. The Shoah Foundation's impetus was to gather, catalog, and make available for access thousands of video testimonies. In doing so,

the Shoah Foundation sought to build one of the largest video libraries in the world comprising nearly 52,000 video testimonies in 32 languages from 56 countries.

In 1996, there was no digital library or other multimedia system that could handle the large volume of video testimonies collected and maintained by the Shoah Foundation. At the time of invention, development of multimedia distribution systems was in its infancy. Transmission of video and multimedia over existing computer communication networks, including the Internet, struggled with bandwidth and compatibility issues that impeded the development of early multimedia distribution systems. No system existed that could catalogue, store, and deliver tens of thousands of videos in an effective manner, so Samuel Gustman, CTO of the Shoah Foundation and an inventor of the '527 patent, set out to design one.

The invention developed by Gustman and claimed by the '527 patent filled this absence in the art by providing a unique modular, distributed infrastructure incorporating techniques for indexing, accessing, distributing, and surveying multimedia data. Gustman created a digital library system that incorporated generalized interfaces to connect numerous multimedia components. The invention includes a data capture and cataloguing system that catalogues portions of multimedia data using specific data structures referred to as catalogue elements and attribute elements. '527 patent, 8:9-11:13. The catalogue and attribute

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