

Citius Minds helps a defendant side law-firm in identifying relevant prior arts to challenge the validity of asserted patent

Challenge:

A reputed law firm representing a multinational corporation was involved in a patent infringement lawsuit. The client desired to challenge the validity of the asserted patent. The asserted patent disclosed a method and apparatus for receiving signals which were transmitted in accordance with different transmission standards. The client wished to identify prior arts against the asserted independent claims of the patent, and its further asserted dependent claims. They had not been able to find any promising reference that could independently or in combination cover the novelty of the patent. Citius Minds was engaged to perform an analysis of the subject matter, identify prior arts suitable for challenging and proving the validity of the asserted patent.

Execution:

The team thoroughly investigated the disclosed technology and the file history of the subject patent to understand the technology and novel features of the invention. All the previously identified prior-arts and patent citations were thoroughly analyzed. A citation analysis of these references was performed to search in closely related prior-arts. A 'Same-Page Document' was shared with the client for sharing the team's understanding of the invention with the client. This document included key features of the invention based on team's understanding, several representative term-sets and important US, IPC, CPC classifications, which could potentially be used in conducting the search. Citius Minds used several paid and free databases to formulate various key strings using different term-sets and combinations to list the prior arts similar to subject patent. Further, several key strings were run on the identified major companies having patents in this technology area, including Qualcomm, Philips, Samsung, Motorola, Hitachi, and Harris Corporation. The final list consisted of more than 3000 unique patents, which were reviewed to shortlist the best available prior arts which disclosed all the key features of the patent in suit independently or in combination.

The shortlisted prior arts were also disclosing a similar receiver system which can receive signals transmitted from a different location in accordance with different transmission standards. One of the prior art identified by the team was disclosing a television receiver for receiving the television signals which were transmitted using different types



PRIOR ART SEARCH

of transmissions such as analog or digital, via cable, satellite, etc. which was the novelty of the asserted patent and also the missing piece of the client's invalidity claim.

All the identified references were listed in a detailed report which also included 'claim element-wise' color coded mapping of the asserted claims with relevant description of the prior arts, all possible 103 combinations, explanation of grounds of obviousness, ratings of the mapped relevant text against each element and commentary of the references wherever required.

Impact:

The client was very happy to find a reference that disclosed the novelty of the asserted patent. The 103 combinations and grounds of obviousness listed in the report enabled the client to prove the asserted claims of subject patent, obvious and unpatentable. The color coded claim mapping with commentary and element wise rating made it very easy for the client's attorney to understand the prior-arts comprehensively and leave the plaintiffs defenseless in the court. The client was able to win the case as the judge agreed that the patent was not novel and any person skilled in the art would have come up with such an invention, at the time, after reviewing the prior-art presented by us.

“We were about to lose the case. The judge had already given a decision in favor of the plaintiffs in pre-trial. I don't know how they did it, but the references they found and mapped convinced the jury to rule in our favor. We won only because of the extremely efficient and technically skilled team of Citius Minds.”

Partner – Reputed Law Firm

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