

## CHALLENGE

We had to execute an invalidation search for a proposed Inter-Partes Review (IPR) contention. This patent was related to the field of broadband network transmission. It disclosed a number of steps performed on both transmitter and receiver simultaneously.

## APPROACH

The crucial thing about this case was that high stakes were involved in this case and client didn't want to take any chances. In fact, multiple organizations had already conducted prior art search for this patent. As a matter of fact, client provided us with around 50+ prior arts, including patents and non-patent literature. Some of them were, in fact, very good, yet client didn't, what he was looking for. All of us got the feeling that this is going to be a devil of a job.

Once we have our shot at something, the next thing we know is that we were going to make it count. Now the question in front of us was a big "H O W". As time was a critical factor here, we needed to have appropriate course of action right from the start. In addition to our conventional search strategy we needed a non-conventional approach to start with and simultaneously evade barking up the wrong tree.

We jumped into the file history of subject patent and its family members. In case of a few of its family member, the data wasn't up to date. So, we tried to retrieve it from the client, as soon as we could. Meanwhile, search was ongoing in all areas. From these recovered files, we extracted some new key phrases and names. We exhausted all of them and got obviousness references, but nothing anticipatory.

Working on Plan-B we thought of alternatives like any type of communication including telephonic, satellites, setup-box to TV etc. or the fields where it could possibly be implemented. But as the mobile era was in its incipient stage near the priority date of the invention, we had a lot to ourselves to uncover. So, we listed down the players in the corresponding field at that time and looked particularly for that element, which was missing in all earlier prior arts. We had a few successes, but with the date issues.

All of us gathered for mid-project review. It looked like, we were in deep waters. One thing we knew by now was that patent prior art might be very difficult to locate in this case. So one of our team members suggested to try getting into the shoes of the inventor. There had to be something from which the inventor got this idea, though it might be from some other related domain. But finding 'it' was more like finding needle in haystack. So, we started digging into inventor's and assignee's background at that time including partnerships, collaborations, R&D, team info etc.

And Bingo!! There we had a very good lead. An article was uncovered which belonged to some other inventor of the same company which nearly disclosed all the essential elements of the subject invention. We thought of going the extra mile before submission and extracted the keywords, other than normative text from it. Simply, using that exact phrase along with 1-2 technology domain keywords on IEEE, we located another non-patent literature with enough disclosure to be classified as anticipatory prior art.

Well, clients feedback was, "we got exactly what we needed, thanks to you guys". And the smile across all our faces, proved the worth of all our efforts.