

Patents and Patent Applications Related to New Medical Product Alpha

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Executive Summary

An audit was performed on the pending XYZ, Inc. patent applications primarily related to medical therapies related to the medical products division. This comprised 78 applications filed from 2000 of which 11 have matured into issued patents (about 1.1 per year), 30 have been abandoned (several without a patent examiner reviewing the application), and the rest have either been rejected by the Patent Office (some with as 8 or more rejections) or are waiting for an office action.

A detailed audit of the process used by XYZ, Inc.'s attorneys to prosecute these patent applications was then conducted. This revealed that XYZ, Inc. has not been following best-in-class processes to secure intellectual property. This is evidenced by some applications being handled by as many as 8 different attorneys and others by 3 different law firms. XYZ, Inc. has used 38 different attorneys in 6 different firms to prosecute these 78 applications.

Of the 11 patents issued to XYZ, Inc. 2 patents have already been abandoned by XYZ, Inc. due to failure to pay maintenance fees. One of the patents issued to XYZ, Inc. was at first abandoned, because XYZ, Inc. simply failed to pay the issuance fee on time. Only by special petition and a kindly patent examiner was the patent allowed to be issued.

Furthermore, the claims of 2 were substantially altered by amendments in response to rejection notices. The claims of these 2 patents are directed to protecting products XYZ, Inc. does not build and does not intend to build.

These issues indicate that even when XYZ, Inc. gets patents they may not support its business and that XYZ, Inc. is not able to manage the portfolio on a timely basis.

XYZ, Inc. should examine its patent process carefully to determine that it is serving its interests. However, the result is that XYZ, Inc. has been granted few patents related to its new medical product Alpha and none in the important area of advanced safety systems.

This is compared against at least competitor ABC, Inc. that has been granted several patents related to critical elements of product Alpha in the past 10 years. Furthermore, it is estimated that ABC, Inc. has probably spent \$1,000,000 to get their patents while XYZ, Inc. has spent over \$3,000,000 to get many fewer and less desirable patents in the same time.

Introduction

Background

The 658 patent applications XYZ, Inc. since 2000 were audited. The purpose of this audit was to analyze a significant group of XYZ, Inc.'s patent applications, especially those related to the development of new medical product Alpha. From the analysis of the collected information trends in XYZ, Inc. patent process were determined.

All of the patent applications were obtained as text and as PDF files. Related transaction information were also obtained. The most relevant information was organized in a spreadsheet allowing it to be sorted using a variety of criteria.

New Medical Product Alpha Patent Applications

Of the 658 applications, 78 (approximately 12% of the total) were determined to relate primarily to the development of new medical device Alpha. This was determined by scanning all the XYZ, Inc. patent applications for certain key words, which revealed 165 potential patent applications. However, with a multi-factor search, several of these were determined not to relate the new medical product development Alpha and apply to other product lines. These were eliminated, yielding the 78 applications.

This is an average of 10 applications per year, which does not seem to be very many for a division the size of the project Alpha group. However, of more concern is that only 11 have matured as patents, and average of only 1.1 patents per year. This seems to be very few in a competitive environment. Even of these 11, two have already been abandoned by XYZ, Inc. for failure to pay maintenance fees.

Of the 78 applications, 21 have been abandoned by failing to respond to examiner rejections. However, another 7 applications were abandoned for failure to respond to a request for information before the examiner had even examined these applications. It is hard to develop a powerful intellectual property portfolio if applications are abandoned prior to examination.

The remaining applications have not been assigned to an examiner (recently submitted applications), have been examined and rejected by an examiner, or XYZ, Inc. has filed a response or is considering a response.

XYZ, Inc. clearly is interested in having certain patent applications being approved. This evidenced by the number of times that XYZ, Inc. has requested continued examination of applications after a final rejection notice has is sent. Several applications have had 6 or more non-final and final rejections and are still being prosecuted, some have been submitted for a ruling by the board of appeals, and others have been finally abandoned.

Of the applications that are pending, 54% of their claims have been withdrawn or canceled. This can be the result of overly broad claim drafting or a realization that the examiner has found prior art that limits the claims that can be obtained.

Of the 58 applications that have been reviewed by the examiners 24% have had 4 or more non-final and final rejections (12% have more than 6 rejections).

The average page count for XYZ, Inc.'s applications is 68 pages, which is substantially longer than the average patent length. Ten applications exceeded 150 pages. Some applications are continuations in part of other applications, and so do not necessarily reflect all new specification text. However, some of the longest patent applications have been abandoned without any office action, which makes one wonder why so much effort was spent preparing applications that would be abandoned like this.

The following table summarizes the status of the 78 applications that were tracked. More detailed information for each section (including specific application numbers and hyperlinks to appropriate documents) is provided below.

XYZ, Inc. New Medical Product Alpha Applications

Patents		
Patented Case		9
	Total	9

Application Rejections		
Final Rejection Mailed		6
Non Final Action Counted, Not Yet Mailed		1
Non Final Action Mailed		4
Response after Final Action Forwarded to Examiner		1
Response to Non-Final Office Action Entered and Forwarded to Examiner		1
Advisory Action Mailed		1
	Total	14

Application Appeals		
Appeal Awaiting BPAI Docketing		1
	Total	1

Abandoned Applications		
Abandoned Applications and Expired Patents		
Abandoned -- After Examiner's Answer or Board of Appeals Decision		1
Abandoned -- Failure to Pay Issue Fee		1
Abandoned -- Failure to Respond to an Office Action		25
Expressly Abandoned -- During Examination		1

Patent Expired Due to Non Payment of Maintenance Fees Under 37 CFR 1.362	2
Total	30

New Applications Waiting for Review

Docketed New Case - Ready for Examination	7
TSS review complete	6
Total	13

• • • Additional information would follow here • • •

Sample Spreadsheet Contents for Each Application/Patent

Hyperlinks provide direct link to application text, application PDF files, background information and recent office actions or attorney filings.

Hyperlinks have been disabled in this document.

All patent, application numbers, inventors' names, and titles have been changed to protect the identity of the company.

[20050078231](#) [PDF](#) Serial No.: [10/463,833](#) Filing Date: 6/2/2004
 Title: System and method for decision making regarding the administration of treatment to a patient
 Inventor: Simon, Gordon J.
 Status: Abandoned -- Failure to Respond to an Office Action
 Status Date: 9/4/2007
 Status Link: [Abandonment + No Rejection](#)
 Rejections: 0 Claims: 0/54 Attorneys: 1 Pages: 142
 U.S. Class: 705/002 DATA PROCESSING: FINANCIAL, BUSINESS PRACTICE

[20060055244](#) [PDF](#) Serial No.: [10/890,841](#) Filing Date: 7/14/2005
 Title: Wireless communication with medical treatment system
 Inventor: Dorsey, Janet
 Status: Abandoned -- Failure to Respond to an Office Action
 Status Date: 4/7/2009
 Status Link: [Abandonment + No Rejection](#)
 Rejections: 0 Claims: 0/7 Attorneys: 1 Pages: 209
 U.S. Class: 705/002 DATA PROCESSING: FINANCIAL, BUSINESS PRACTICE

[20040141981](#) [PDF](#) Serial No.: [10/069,939](#) Filing Date: 1/29/2003
 Title: System for operating medical treatment devices
 Inventor: Smith, Tom
 Status: Appeal Brief (or Supplemental Brief) Entered and Forwarded to Examiner
 Status Date: 5/5/2009
 Status Link: [Appeal Brief Filed](#)
 Rejections: 4 Claims: 191/191 [Attorneys: 4](#) Pages: 83
 U.S. Class: 340/608 COMMUNICATIONS: ELECTRICAL

[20050104271](#) [PDF](#) Serial No.: [10/730,766](#) Filing Date: 11/24/2004
Title: System for the sage delivery of medication to a patient
Inventor: Martin, James
Status: Final Rejection Mailed
Status Date: 5/8/2009
Status Link: [Final Rejection](#)
Rejections: 9 Claims: 5/6 Attorneys: 8 Pages: 52
U.S. Class: 235/472 REGISTERS

[20040135388](#) [PDF](#) Serial No.: [10/044,891](#) Filing Date: 1/11/2003
[Patent: 6,885,872](#)
Title: Patient medication safety system
Inventor: Martin, James
Status: Patented Case
Status Date: 12/21/2005
Status Link: [Abandonment: Failure to Pay Issuance Fee and Then Petitioned for Reissuance \(Granted\)](#)
Rejections: 2 Claims: 0/64 Attorneys: 1 Pages: 60
U.S. Class: 705/2 DATA PROCESSING: FINANCIAL, BUSINESS PRACTICE

• • • Additional applications would follow here • • •