An Information Bulletin on Intellectual Property activities in the insurance industry

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Introduction

In this issue we address the issue of "utility" as it relates to insurance and financial services type business method patents in our *Feature Article* "Will it Fly?".

This ties directly to our sidebar comment on the recent In Re Lundgren decision by the USPTO board of appeals. This decision removes the requirement that inventions must be in the "technological arts" (e.g. run on a computer) in order to be patentable. It may open the door, at least a crack, to the possibility of directly patenting new insurance products.

We also point you to some free resources for doing patent research which are surprisingly useful.

In the Statistics section we point out that Class 705/4 (insurance business methods) already has more patents issued through 10/11/05 (24) as in all of last year (23). And, it is apparent that patent activity in all of class 705 is ramping up.

Enjoy the issue. Please let us know if you have any questions.

Our mission is to provide our readers with useful information on how intellectual property in the insurance industry can be and is being protected – primarily through the use of patents. We will provide a forum in which insurance IP leaders can share the challenges they have faced and the solutions they have developed for incorporating patents into their corporate culture.

Please use the FEEDBACK link above to provide us with your comments or suggestions. Use QUESTIONS for any inquiries. To be added to the Insurance IP Bulletin e-mail distribution list, click on ADD ME. To be removed from our distribution list, click on REMOVE ME.

Thanks, Tom Bakos & Mark Nowotarski

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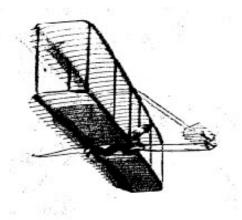
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Feature Article

Will it Fly?

By: Tom Bakos & Mark Nowotarski

In the spring of 1903, two independent inventors, Orville and Wilbur Wright, filed a patent application on a revolutionary technology for controlling a flying machine. In that application they included pictures of Orville flying it¹.



Orville providing evidence of utility for his and Wilbur's invention. The reason they provided pictures was to show the patent office that the invention actually worked. At that time the US patent office was inundated with patent application on alleged flying machines. They were all rejected. The patent office does not grant patents on inventions that clearly will not work. The Wright Brothers' photos showed that theirs' would. Of course today, with innovation in photo technology, a photo might not be so compelling a form of evidence.

The requirement that an inventor be able to show that their patent pending invention works is part of what is called the "utility requirement" (i.e. 35 U.S.C. 101). Inventors are rarely called upon make this demonstration, but if the examiner requires it, they have to in order to get a patent.

Demonstrating the utility of a physical invention is

straightforward. Follow the directions given in the patent, build it, and try it. If one works, they all work. It doesn't matter who makes it, as long as there is sufficient guidance in the patent application for someone of "ordinary skill in the art" to reproduce the invention.

Remember that patentable subject matter falls into one of four broad categories: *machine, article of manufacture, composition of matter*, or *process*. The first three have obvious physical manifestations and, therefore, if required, the "build it and try it" approach can be used to satisfy a utility requirement. Most process inventions involve physical steps (for example, the steps of combining materials) in order to produce a useful result (a new compound material). Thus, a patent can be granted not only for the new *composition of matter* but for the *process* used to create it as well. The usefulness of the process is easily determined because it produces a measurable result – the new compound. However, even if it were a new process used to produce an old compound, it might still be patentable since the measure of the usefulness of the process would rely on the fact that it produced the compound – not that the compound was new.

¹ Have a good eye for detail? Tell us what's missing from this "airplane" at <u>editors@insuranceIPbulletin.com.</u>

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But, underlying all of this is the additional requirement that in order for a new process to be patentable the result produced by the process must also be useful in that it provides a practical benefit or helps people complete real world tasks. In patent-speak, it must produce a "concrete, useful and tangible result".

An important distinction to have in mind throughout this discussion is that "usefulness" is not equivalent to "value", "commercial value", or "commercial success". So, a process is "useful", for example, if it produces a useful compound, even if the process itself or the compound it produces is not a commercial success.

We realize that the concept of "utility" is a difficult one to describe and understand because the common everyday meanings of the words used are often not applicable in exactly the same way in a patent examination. Patent examination is a process with its own field of art. It takes education and experience to apply it even to the level of "ordinary skill". With that said, it is with trepidation that we embark on a discussion of "utility" in the field of insurance business method patents. But, we will do our best and hope to encourage comments, suggestions, and questions from our readers.

Evaluating the "utility" of an insurance business method process invention is made difficult by the fact that the ultimate result of the application of the insurance business method is the transfer of the financial consequences of a <u>contingent event</u> from one entity (the insured) to another entity (the insurer) for a premium. Very basically, that "transfer" has some physical manifestations. Broadly, insurance is itself a business method process. However, the time has long since passed when a patent on the basic insurance process could be had. Rather, the insurance business method patents being filed today relate to parts of the insurance business.

A contingent event is a key component of any insurance process. A contingent event is an event which is <u>uncertain</u> with respect to its occurrence, timing, or severity. What makes the concept of "utility" difficult to evaluate is, precisely, this uncertainty in the insurance process. While the "uncertainty" relates to individual insureds, insurance products relate to a multiple of insureds. In this way an insurance company can spread or manage the financial consequences of the risk experienced by each individual. Therefore, it would seem that the "utility" of insurance product inventions, in general, needs to consider the usefulness or practical benefit enjoyed by a multiplicity of insureds not the usefulness relative to any one particular insured.

With respect to any individual, insurance is "useful" in the sense that it stands ready to offset a financial loss created by the actual occurrence of a contingent event by the payment of a benefit amount. That is, if you have automobile collision coverage and never have a crash, you will never have a claim under your policy. In retrospect, you might think you didn't need the coverage and it didn't work. On the other hand, if you did have a crash, you would have received a benefit, effectively transferring the financial consequences of your crash to the insurance company. So, is insurance only useful when you need it? Many people think that way. Those of us in the insurance business do not.

Many improvements on the insurance process are being patented. These take the form of what might be called sub-process business methods which address issues in underwriting selection, administration, premium calculation, claims processing, risk definition, and many other aspects of insurance. All are

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designed to make these insurance processes better in some way, such as faster, cheaper, more effective, more efficient, broader, etc. The true test, of course, of usefulness would involve a demonstration that the alleged result (e.g. faster, cheaper, ...) was actually achieved as this would mean the process had a practical benefit with respect to some real world task.

The utility requirement poses a challenge to those who would like to see patents granted directly on new insurance products instead of just on the technological inventions, such as novel computer systems, that enable them. Demonstrating that a new insurance product is useful and, therefore, works is a very different task than demonstrating that a technological invention works.

Essentially, for something to work it must do what it was intended to do and what it was intended to do must be useful, that is, have some practical value. Since, at the moment, insurance "product" claims are generally not allowed by the USPTO, any discussion of how to demonstrate an insurance "product" works is academic. We'll work ourselves back into this discussion should it ever look like insurance product claims may become a reality. (See sidebar on the recent In Re Lundgren decision)

However, one final point on this before we go.

Whether or not an insurance product works (meaning here the broad sense of doing what it was intended to do) can be a function of whether or not it is patented. Consider the recent test of "free" auto insurance run by Creative Innovators Associates in association with VW and Nationwide.

Creative Innovators Associates invented a new type of insurance product that allowed VW to provide one year of free auto insurance to anyone who bought particular models of their cars in a given test market. Creative Innovators Associates has a patent pending on the underwriting process that allows VW to offer the product. Until the patent issues, they are keeping the process secret. Hence they can offer the insurance product <u>exclusively</u> to VW. Nationwide underwrote the insurance and VW paid the one year premium out of the extra profit they made in selling more cars. They sold more cars because they were the only ones that could offer the free insurance due to their exclusive license.

Without a patent, other car companies would eventually figure out the underwriting process and be able to offer free insurance as well. Once enough companies offer it, the relative advantage will disappear, the increased car sales to any one manufacturer will disappear, car companies will no longer be able to pay for the insurance, and the "free" insurance product will no longer work. With a patent, however, Creative Innovators Associates can enforce exclusivity even after others figure out how to underwrite it and, hence the "free" insurance product will continue to work for them.

In order to get a patent, an inventor must at least theoretically be able to show that their invention works. With physical inventions, this merely involves producing at least one working example. With insurance inventions, however, "working" involves a very large number of individual instances of the product "working" together to produce a concrete, useful, and tangible result. This is due to the uncertain nature of the contingent events at the core of every insurance product which makes actual demonstrations of utility problematic. One of the challenges facing those that would like to directly patent new insurance products is finding a practical way to demonstrate that their new products actually fly.

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In Re Lundgren

A major barrier to the possibility of directly patenting new insurance products in the US has just been removed.

The USPTO board of appeals has recently published a decision, <u>In Re Lundgren</u>, where they have clearly said that inventions (in the U.S.) do <u>NOT</u> have to be in a technological art in order to be patentable. They must merely provide a "concrete, useful and tangible result".

The decision is "precedential" which means that patent examiners have to follow it. The examiner corps is now drafting new examination guidelines that will enforce the decision.

The immediate effect of this decision is that we no longer have to say that a given insurance process is carried out by technological means, such as a computer, in order for it to be patentable in the US. This, in and of itself, is not a big deal.

The longer term effects of this decision, however, could be much more profound. It opens the door to patenting inventions that are in what is now considered to be <u>non-technological</u> arts. While much of what is being done in the insurance industry (and financial services industry) today involves technology in that it is carried out on a computer, the added ability to seek patent protection on the non-technological arts include in most of what the insurance industry does, such as underwriting methodologies and actuarial science, can add increased breadth to the patent protection provided.

It remains to be seen just how much the door will be opened, but at the very least, this decision increases the likelihood of being able to get more and better patent coverage for innovations in insurance and the financial services industry, in general.

Patent Search

A New (Free) Patent Search Tool

<u>http://www.freepatentsonline.com/</u> is a new patent search tool where you can search and download patents images for free. The search engine is fairly powerful, but the collection is limited compared to what's available on paid sites (e.g. <u>www.delphion.com</u>).

Freepatentsonline has only US and European patents available. Japanese patent are promised soon. No word yet on when PCT applications will be available.

This site may give paid sites a run for their money when their collection expands. For those on a budget, however, it's a good place to start. We have added it to our links.

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Track the Progress of Pending US Applications

<u>http://portal.uspto.gov/external/portal/pair</u> lets you look over the shoulder of the patent examiner as a pending US patent application makes its way through the patent office. It provides a very detailed collection of all of the correspondence between applicants and examiners on published pending US patent applications. If you want to see the latest on what's happening with your competitor's pending patent application, it's the place to go. It's also a good place to go if you don't understand how a given issued patent could possibly have been allowed. Just type in the patent number and you will be able to see all of the arguments presented by both the examiner and the applicant including the specific reasons why the patent was granted.

One word of caution, the site can be a little quirky. For example, if you have Norton Internet Security, you will have to shut it off or you won't get any response from the site. We have added this site to our links although you can get there by clicking through from the USPTO home page.

Patent Q & A

Who gets the patent?

Question: If I make an invention as part of my job, who owns the patent, me or my employer?

Disclaimer: Patents are property. Questions of property ownership rights are legal questions. The answer below, therefore, is a discussion of typical practices and is not to be construed as legal advice of any kind. Readers are encouraged to consult with qualified counsel to answer their personal legal questions.

Answer: In the United States¹ under current law^2 only natural persons can apply for patents. All of the persons who are listed as inventors on a patent are the initial owners of the patent. When an invention is made on behalf of an employer and as part of a person's job, however, the employer typically files and pays for the patent application and the employee assigns their ownership rights to their employer. The employer then becomes the owner of the patent.

Occasionally an employee will not assign their ownership rights to their employer. This can happen, for example, when an employee leaves a corporation before an application is filed. If the former employee does not want to assign his or her ownership rights, then both sides may find themselves involved in a legal dispute. The situation can be particularly difficult to resolve if there is no prior employment agreement between the former employee and their employer. Employment agreements typically spell out the circumstances under which an employee is obligated to assign patent rights to their employer. The laws from State to State vary so without an employee agreement, there is no guarantee as to who has ultimate ownership rights.

¹ In Europe, Japan and other parts of the world, Companies can apply for patents.

² If the patent reform act currently before Congress is passed, then Corporations will be able to apply directly for US patents.

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Statistics

An Update on Current Patent Activity

The table below provides the latest statistics in overall class 705 and subclass 4. The data shows issued and published patents and published patent applications for this class and subclass.

Insurance Patents Issued by Year as of 10/11/05			
	Class 705	Subclass 4	
YEAR	#	#	
2005	1,114	24	
2004	998	23	
2003	969	21	
2002	886	15	
2001	880	19	
2000	1,062	29	
1999	1,005	36	
1998	745	20	
1978-1997	2,776	47	
1976-1977	80	0	
TOTAL	10,515	234	

Insurance Patents Pending by Year Published as of 10/13/05			
	Class 705 Subclass 4		
YEAR	#	#	
2005	5,053	110	
2004	5,590	156	
2003	6,009	128	
2002	6,135	164	
2001	1,326	30	
TOTAL	24,113	588	

Class 705 is defined as: DATA PROCESSING: FINANCIAL, BUSINESS PRACTICE, MANAGEMENT, OR COST/PRICE DETERMINATION.

Subclass 4 is used to identify claims in class 705 which are related to: *Insurance (e.g., computer implemented system or method for writing insurance policy, processing insurance claim, etc.).*

Highlight of Newly Issued Patents and Applications During Last Two Months

Our analysis and summary of issued patents and newly published patent applications is based on a quick read and interpretation of the published documents. It is not intended to be and should not be considered to be a complete or exhaustive analysis of the breadth of these inventions or claimed inventions. This information is provided to give our readers a way to quickly find patents or patent applications in their field of interest. Readers are encouraged to seek competent legal and professional opinions to determine what a patent or patent application does or does not cover.

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Issued Patents

Since our last issue 7 new patents with claims in class 705/4 have been issued: 1 is L&H; 3 are P&C; and 3 can be applied in all lines. All of these new issues have Assignees recorded. Patents are assigned to classes based on their claims. See the detailed list for a brief description of these new patents.

Published Patent Applications

Thirty (30) new patent applications with claims in class 705/4 have been published since our last issue. They are broken down by product line or type area as follows:

Health:	10
P&C:	7
Life:	6
All:	6
Pension:	1
TOTAL:	30

Again, a reminder -

Patent applications have been published 18 months after their filing date only since March 15, 2001. Therefore, there are many pending applications not yet published. A conservative assumption would be that there are about 150 applications filed every 18 months in class 705/4. Therefore, there are, probably, about 625 class 705/4 patent applications currently pending, only 473 of which have been published.

Because the pending patents total above includes <u>all</u> patent applications published since March 15, 2001, applications that have been subsequently issued will also appear in the issued patents totals.

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Resources

These are links to web sites which contain information helpful to understanding intellectual property.

United States Patent and Trademark Office (USPTO): *Homepage* - <u>http://www.uspto.gov</u>

United States Patent and Trademark Office (USPTO): *Patent Application Information Retrieval* - <u>http://portal.uspto.gov/external/portal/pair</u>

Free Patents Online - http://www.freepatentsonline.com/

World Intellectual Property Organization (WIPO) - http://www.wipo.org/pct/en

Patent Law and Regulation - http://www.uspto.gov/web/patents/legis.htm

Patent Agent services - http://www.marketsandpatents.com/

Actuarial services - <u>http://www.BakosEnterprises.com</u>

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Newly Issued Patents (8/15 – 10/11/05) in Class 705/4

- 6,934,686 Filed: June 30, 2000 Issued: August 23, 2005 Pendency: 4.2 years
- **P&C** *Warranty transaction system and method*

ASSIGNEE: i2 Technologies US, Inc. (Dallas, TX)

FIELD: Warrantees on consumer purchased items

- **PROBLEMS:** The customer typically has limited options regarding the features and price of the warranty.
- **SOLUTIONS:** The invention provides a customer with one or more customized warranty package options tailored to a customer's particular needs based on information gathered by the system. The invention allows the customer to select one or more of the warranty package options and to communicate that selection to one or more warranty providers. The warranty providers are given the ability to bid on the selected warranty package, and the customer can then choose one or more of the bids.
- <u>6,937,990</u> Filed: December 21, 1999 Issued: August 30, 2005 Pendency: 5.7 years
- **ALL** System for syndication of insurance

ASSIGNEE: Walker Digital, LLC (Stamford, CT)

- FIELD: Insurance syndication
- **PROBLEMS:** There is a need for a more efficient system, preferably implemented on a wide area communication network such as the Internet, whereby a stake in an insurance syndicate may be made widely available as an investment vehicle.
- **SOLUTIONS:** A large number of persons hold credit cards with unused credit lines. These unused credit lines potentially could be pledged in making an investment, which would enable the cardholder to realize a source of income from an otherwise untapped personal asset. Such a pledge could be secured against default by freezing a portion of the credit line.

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<u>6,938,006</u> Filed: June 26, 2001 Issued: August 30, 2005 Pendency: 4.2 years

ALL Sales method and system for selling tangible and intangible products

ASSIGNEE: Sony Corporation (Tokyo, JP)

FIELD: Marketing/distribution of insurance products in combination with associated other products

- **PROBLEMS:** Currently it is necessary to access separate Internet sites to buy intangibles like insurance and associated tangibles like an item to be insured.
- **SOLUTIONS:** A sales system by which users, or customers, of Internet shopping are able to buy combinations of intangibles and tangibles by a single access operation and an operational procedure as simple as possible. Such a sales system also allows the selling side to provide the sale of combinations of intangibles and tangibles which no previous system has done before, thereby significantly enhancing the sales efficiency.
- <u>6,944,597</u> Filed: October 30, 2001 Issued: September 13, 2005 Pendency: 3.9 years
- **P&C** *Providing termination benefits for employees*

ASSIGNEE: Spincor LLC (West Palm Beach, FL)

- FIELD: Termination benefits to employees involuntarily terminated
- **PROBLEMS:** Many employers incur large costs for non-voluntary terminations of their employees.
- **SOLUTIONS:** The invention overcomes previous concerns about the risks associated with adverse selection by employers in connection with employment termination insurance products and makes such products feasible and profitable.

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- <u>6,947,881</u> Filed: July 7, 1999 Issued: September 20, 2005 Pendency: 6.2 years
- **P&C** Shared vehicle system and method with vehicle relocation
 - **ASSIGNEE:** Honda Giken Kogyo Kabushiki Kaisha (Tokyo, JP); The Regents of the University of California (Oakland, CA)
 - FIELD: The sharing of a fleet of vehicles (electric) among a number of users
 - **PROBLEMS:** Public transportation systems do not entirely satisfy individual transportation requirements. In addition, the excessive use of private vehicles creates parking and other problems. Therefore, there is a need for an efficient and convenient way to share the use of private vehicles. An example is given of such a shared vehicle system that uses electric vehicles. *NOTE: It is not obvious in a quick reading why any of the claims of this invention were assigned to class 705/4.*
 - **SOLUTIONS:** User groups are created such that they can share a group of vehicles. The vehicles are positioned in such a way based on user data to make access to the vehicles convenient.
- <u>6,947,904</u> Filed: July 25, 2000 Issued: September 20, 2005 Pendency: 5.2 years
- **L&H** System and method for incorporating mortally risk in an investment planning model
 - ASSIGNEE: Macey-Holland & Co., LLC (Atlanta, GA)
 - FIELD: Retirement planning system
 - **PROBLEMS:** Retirement planning is a frustrating exercise because the future is uncertain. Deterministic models provide no indication of the likelihood that retirement goals will be achieved.
 - **SOLUTIONS:** A retirement planning system that uses Monte Carlo techniques to vary the life span of an investor and/or to vary the rate of return of a portfolio so as to more completely describe an investor's chances of achieving a retirement goal can be used to generate the probability that retirement goals can be achieved.

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- <u>6,954,741</u> Filed: August 6, 1999 Issued: October 11, 2005 Pendency: 6.2 years
- **ALL** *Computerized dispute resolution system and method*
 - **ASSIGNEE:** Cybersettle.com, Inc. (New York, NY)
 - FIELD: Claim dispute resolution
 - **PROBLEMS:** Conventional alternative dispute resolution systems, although sometimes helpful, are costly and the results are often unacceptable.
 - **SOLUTIONS:** A automated series of rounds in which the demands and offers of two opposing parties are matched against a predetermined set of guidelines in an effort to reach a settlement. All of this is based on input received from the opposing parties. This falls into class 705/4 because it can incorporate dispute resolution of insurance claims.

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Class 705/4 Patent Applications Published between (approximately) August 8, 2005 and October,13 2005

(In order latest to earliest)

CATAGORY	Publication Number	TITLE
Life – Optimizes state guarantee fund coverages	20050228701	Method for optimizing state guarantee fund coverage for insurance transactions
Health – Claim settlement system	<u>20050228700</u>	<i>Method and system for settling a patient's medical claim</i>
Health – Better cost projection method	<u>20050228699</u>	Cost projections for diagnoses Assignee = United Health Group Incorporated
Health – Insurance system	<u>20050222878</u>	<i>Method of managing the business of a medical scheme</i>
Health – Insurance system – see above	<u>20050222877</u>	<i>Method of managing the business of a medical</i> <i>scheme</i> Inventors are from South Africa – companion to application above.
Life – Life settlements	<u>20050216316</u>	Capital market products including SPIA securitized life settlement bonds and methods of issuing, servicing and redeeming same
Health – Loans collateralized by health claims	20050216315	Loan advancing system
Health – Vision protection insurance	<u>20050209894</u>	Systems and devices for vision protection policy Assignee = AFLAC
Health – Voluntary system to identify and track uninsured population	<u>20050209893</u>	System and method for identifying and servicing medically uninsured persons

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<u>20050209892</u>	Automated system and method for providing accurate, non-invasive insurance status verification NOTE: No patent agent/attorney involved – filed by inventor only.
<u>20050209866</u>	Method and apparatus and program storage device adapted for visualization of qualitative and quantitative risk assessment based on technical wellbore design and earth properties Assignee = Schlumberger Technology Corporation
<u>20050203781</u>	Vision care and protection policy Assignee = AFLAC Similar to 2005020894 above – contains "product" claims.
<u>20050203780</u>	<i>Method and apparatus for identifying uninsured motorists</i>
<u>20050203779</u>	Business structure for providing a representation and warranty insurance for mortgage loans
<u>20050203778</u>	Systems and methods for determining concentrations of exposure Assignee = Risk Management Solutions Inc. (based on PCT application)
<u>20050197866</u>	Preneed insurance services system
<u>20050192850</u>	Systems and methods for using data structure language in web services
<u>20050192849</u>	System for facilitating life settlement transactions
<u>20050187802</u>	Method and system for conducting customer needs, staff development, and persona-based customer routing analysis Assignee = Citibank (based on PCT application)
	20050209866 20050203781 20050203780 20050203779 20050203778 20050197866 20050192850 20050192849

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Pension – Use life settlements to fund pension plans	<u>20050187801</u>	<i>Method of enhancing value of pension system assets</i>
Health – Integrates health spending accounts into	<u>20050187800</u>	Integrating defined contribution accounts into a claim payment processing system Assignee = The Trizeito Group (based on PCT application)
payment systems P&C – Account management in underwriting processes	<u>20050187799</u>	Account level participation for underwriting components Assignee = Accenture Global Services GMBH (based on PCT application)
P&C – Insuring data protection services	<u>20050187798</u>	Systems and methods for providing insurance in conjunction with a data protection service Assignee = VIRTUAL BACKUP, INC.
Life – Premium financing	<u>20050182670</u>	Methods for reducing and eliminating risk exposure in life insurance transactions
ALL – Rating system data collection	<u>20050182669</u>	Supplemental rating and financial review questionnaire Assignee = A.M BEST COMPANY, INC., NJ
ALL – Insurance application processing	<u>20050182668</u>	System and method for electronically creating, filing and approving applications for insurance coverage Assignee = Real Consulting Inc. (based on PCT
ALL – Insurance application processing	<u>20050182667</u>	application) Systems and methods for performing data collection
ALL – Insurance application processing	<u>20050182666</u>	Method and system for electronically routing and processing information
Health – Describes healthcare marketplace	<u>20050182660</u>	Business method and system for providing an on- line healthcare market exchange for procuring and financing medical services and products Assignee = MED BID EXCHANGE LLC, New Haven, CT
ALL – Web based marketing	<u>20050177401</u>	System and method for performing Web based in- view monitoring Assignee = Capital One Financial Corporation