

## Introduction of US Patent Claim Drafting Workshop 2014/05/01

### Gary Koo, US Patent Attorney



#### Background:

Gary Koo is a patent attorney with Shinjyu Global IP. His practice focuses on US patent prosecution in software, electronic, and mechanical technologies. Before joining Shinjyu Global IP, Mr. Koo was a patent examiner at the USPTO examining database patent applications. Mr. Koo holds a Bachelors of Science degree in Computer Science from the Illinois Institute of Technology, and a Juris Doctor degree from DePaul University College of Law.

#### Seminar:

Mr. Koo has been with Shinjyu Global IP for 2.5 years, and has had significant interaction with Japanese patent attorneys during that time. He has noticed a few basic principles of claim drafting are quite different between Japanese practice and US practice. Towards that end, Mr. Koo believes that highlighting and working together to explain these differences will help Japanese patent practitioners when preparing claims that take prosecution in the US into consideration.

Claim interpretation in the US is very different than claim interpretation in Japan. In Japan, claims are read as a part of an entire disclosure, and to be construed by a reasonable person when inspecting the disclosure as a whole. In the US, the claims are interpreted *in light* of the specification, but the specification may not be imported into the claims during claim construction. Because of this, claims that describe structure are preferred, and limitations that are based on function are discouraged.

To better draft claims that describe structure, Mr. Koo recommends an element by element style of drafting claims. Superficially, most claims directly translated from Japanese to English appear to be

written as a list of elements, however it is rarely true of the claims upon deeper inspection. While Japanese claims usually list the major components of the invention, the components are then described in a narrative style. Narrative style inserts ambiguity into the claims via unclear grammar, and parallel description of sub-elements.

Clients will benefit from claims for US prosecution that are written in element by element style. The quality of examination will be greater, the prosecution history will be shorter, and ensuing patents are stronger in litigation.

Mr. Koo will also briefly discuss related US issues. Broadest reasonable interpretation of the claims by Examiners and means-plus-function interpretation of the claims are issues that commonly arise during prosecution. These topics commonly arise due to sub-optimal descriptions of claimed subject matter, and differences in Japanese and US practice.

To help attendees grasp the concepts discussed during the seminar, Mr. Koo will lead a discussion on an assignment that is provided ahead of time. From the assignment, actual examples of sub-optimal practice, and how to fix or avoid them will be given. Attendees are encouraged to further have direct interaction and experience with Mr. Koo regarding actual US practice, even on topics that are not presented that day.