

# “Inelegant” Language Does Not an Indefinite Claim Term Make

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To follow up on my February 6, 2024 [post](#), Federal Circuit Judges Prost, Taranto, and Chen heard oral argument on February 9, 2024 in *Maxell v. Amperex*, No. 23-1194, concerning a claim term that the District Court had found indefinite, rendering U.S. Patent No. 9,077,035 invalid. The District Court found the disputed term contradictory because the term's first part (“M1 represents at least one transition metal element selected from Co, Ni and Mn”) renders cobalt (“Co”) optional, whereas the second part (“wherein the content of Co in the transition metal M1... is from 30% by mole to 100% by mole”) requires cobalt. Maxell disagreed, arguing that it was clear that cobalt was required.

Judge Taranto was the most vocal judge on the panel and showed a clear leaning towards reversing the District Court. He interrupted Maxell's counsel almost immediately, stating that although the claim term used “inelegant” and “unfortunate language,” the second part of the claim term “wouldn't even raise an eyebrow” if in a dependent claim. Judge Chen ran with Judge Taranto's comment, pressing Amperex as to whether, if the second part of the claim term was in a dependent claim, it would be indefinite. Amperex conceded that it would not be, but pointed to Section 2173.05(c) of the MPEP, warning that using both broad and narrower ranges within the same claim may render it indefinite. Maxell called Amperex's concession “critical,” as dependent claims incorporate all the limitations of the independent claims from which they depend.

Amperex argued that the first part of the claim term, a Markush group, recites a closed list of alternatives. Judge Taranto explained his reading of the claim term as a Venn diagram, in which the first part excluded others from three circles (i.e. using Cobalt, Nickel, and Manganese), but the second part shrunk the Cobalt circle to exclude others only from using a certain percentage range. Judge Taranto emphasized that claim language should be read as defining excluded territory rather than listing options. Amperex countered that the phrase “at least one” in the claim term “has to mean something.” In other words, that no particular metal of the three was actually required.

The claim term allows for M1 to be any of the three metals alone, or any combination of those three metals. This results in seven potential options: Co; Ni; Mn; Co & Ni; Co & Mn; Ni & Mn; and Co, Ni & Mn. If a POSA makes one of the three options without cobalt (Ni alone, Mn alone, or Ni with Mn), they might reasonably but mistakenly think that they are infringing the claim. But according to Maxell’s argument that the claim requires cobalt, the POSA would actually be *outside* the claim’s scope. The Federal Circuit did not address this problem, which undermines Maxell’s position that a POSA would have reasonable certainty of the invention’s scope.

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