

Indefinite Contradiction or Inartful Claim Narrowing?

A photograph of a modern building with a curved facade and large glass windows, set against a light blue sky. The building's lines curve from the bottom right towards the top left of the page.

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By: Chantelle D. Ankerman

Earlier today the Federal Circuit in *Maxell v. Amperex*, No. 23-1194, vacated a District Court's indefiniteness determination after distinguishing an indefinite patent claim having contradictory claim limitations from a patent claim having a second limitation that narrows (albeit inartfully) the first limitation.

I summarized the facts of this case in my earlier posts of [February 6, 2024](#) and [February 21, 2024](#).

An internal contradiction between claim elements can render a patent claim indefinite (e.g., not reasonably certain). However, the Federal Circuit explained that “[i]f there are two requirements, and it is possible to meet both, there is no contradiction.” Because it was possible to satisfy both the first broader limitation (i.e., “at least one transition metal element selected from Co, Ni and Mn”) and the second narrower limitation (i.e., “content of Co . . . is from 30% by mole to 100% by mole”), a fatal contradiction supporting the District Court's indefiniteness holding did not exist.

Judge Taranto, who authored the opinion, used a parallel to a dependent claim to illustrate that the disputed claim had been narrowed. A dependent claim narrowing the range of Co in the transition metal would not be indefinite and therefore an independent claim having an element that narrows another element should also not be indefinite. The Federal Circuit explained that

“[t]he placement of the two requirements does not create an otherwise-nonexistent contradiction. That is so even if there was a more artful way of stating the two requirements within the same claim.”

What’s the takeaway? A contradiction giving rise to an indefiniteness problem may not lie, even when a second claim element excludes what expressly satisfies a first element so long as it remains possible to satisfy both elements. Litigants should take note of this issue when evaluating issues of indefiniteness and infringement. Even if an invalidating contradiction does not exist, a second element operating to narrow a first could substantively alter the infringement calculus. If whether one claim limitation merely narrows a second limitation or creates an untenable contradiction is unclear, a defendant may be wise to sufficiently preserve an indefiniteness argument in claim construction proceedings.

“If there are two requirements, and it is possible to meet both, there is no contradiction.”

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