

## Indefiniteness Standard Less Strict Where Claim Term Does Not Concern Point of Novelty

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Addressing indefiniteness under *Nautilus*, the US Court of Appeals for the Federal Circuit reversed a district court's finding that the claim term "effective for catalyzing" was indefinite even though the claim did not specify a way of measuring or a standard for determining "effectiveness." *BASF Corporation v. Johnson Matthey Inc.*, Case No. 16-1770 (Fed. Cir., Nov. 20, 2017) (Taranto, J).

BASF sued Johnson Matthey for infringement of a patent directed to systems for performing catalytic conversion of nitrogen oxides in an exhaust gas stream. The claimed systems included a novel arrangement of two catalytic surfaces, one coated with "material composition A" and the other with "material composition B." Each of these materials was claimed as being "effective for catalyzing" or "effective to catalyze" respective chemical reactions. The district court found the claims indefinite because they did not recite a minimum level of function necessary to meet the "effective" limitation or a particular measurement method to determine whether a composition is "effective" enough to fall within the claims. Thus, the district court reasoned that a person of ordinary skill in the art could not determine which materials were within the "material composition A" or "material composition B" limitations and which were not. BASF appealed.

On appeal, the Federal Circuit found that it was the arrangement of the catalysts, rather than the selection of particular catalysts, that purportedly rendered the claimed inventions a patentable advance over the prior art. The Court interpreted the functional language of the claims to refer to any known catalysts for the particular chemical reactions and considered significant that both the claims and the specification provide exemplary material compositions. The Court further stated that although the class of known catalysts was large, "the inference of indefiniteness simply from the scope finding is legally incorrect." Accordingly, the Court reversed the district court's indefiniteness finding and remanded for further proceedings.

**Practice Note:** The Federal Circuit has signaled a relaxed standard for definiteness when a claim term does not concern an invention's point of novelty. Practitioners should be aware of the context of a claim term in developing arguments under 35 USC § 112.

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