

Court to Decide Indefiniteness Issues (Caused by PTO Error) at Rule 12 Stage; Reasonable Venue Discovery Allowed

MAY 22, 2020

On April 30, 2020, Judge Albright held a telephonic hearing in the *Castlemorton v. Bose* matter, 6:20-cv-00029-ADA. During the hearing, the Court addressed Bose's motion to dismiss the only claim in the Complaint—Claim 6 of U.S. Patent No. 7,835,421—on indefiniteness grounds. Bose alleges that Claim 6 is defective because it uses the term “an frequency” in a context where there is ambiguity as to whether the claim covers “a frequency” or “any frequency.” The Court ruled that the indefiniteness issue occasioned by PTO error was ripe for decision now, at the Rule 12(b)(6) stage. He noted that it would be inefficient to litigate the case further if there is a defect that he cannot cure. Judge Albright cited his familiarity with the law based on his own involvement in the *Microsoft v. Lucent* matter, where a similar issue was raised. See *Lucent v. Microsoft*, 02CV2060-B, 03CV0699-B, 03CV1108-B, Dkt. 325 (SDCA August 11, 2005) (Brewster, J.) (finding claims indefinite based on errors that could not be corrected by the court). Judge Albright indicated that he would rule shortly and that if he could not correct the error based on the face of the patent, he would dismiss the complaint. When Judge Albright indicated that dismissal would moot any issues surrounding Bose's motion into transfer, Castlemorton represented that if the court dismisses claim 6, it would pursue claim 1. In response, the court took up the transfer issues, followed the precedent it set in *Parus Holdings v. Google*, and allowed limited venue discovery. Judge Albright agreed to venue discovery by both parties, including permitting Bose to take the deposition of Castlemorton's sole owner. When asked whether the venue deposition hours would count against each party's total deposition hours in the case, the Judge made clear that he will not bind parties to strict discovery limits and will allow any reasonable discovery in the case.

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