



## Trivial or dangerous?

### Global wrangling about Blackboard's patent

Washington, August 2006 – The case is delicate and uncertainty abounds. On July 26, US provider Blackboard announced that it has been granted a U.S. patent for technology used in internet-based education support systems and tools. Because the patent, Nr. 6,988,138, covers core technology used in most of the Learning Management Systems (LMS) and because Blackboard has filed a lawsuit against the Canadian company Desire2Learn for patent infringement, the whole eLearning industry is alarmed. While patent experts and lawyers are sounding all-clear signals, the open source community in particular is furious.

### **The Scope of the Patent**

"On first sight it looks as if Blackboard has patent protection on the whole technological application of eLearning, but if you read the patent well, there is no cause for concern. The patent claim is specific in such a manner that protection exists only for the quoted combination of features in the quoted interdependence. This is probably only in use within the Blackboard LMS", is the rating of Manfred Postel, CEO of the German-based Open Source initiative Campussource.

In his opinion, the 44 features mentioned in the Blackboard patent claim are not protected separately but only in the fixed combination. Postel, who is a former patent engineer, has analysed the text in detail. His summary: "Because of the interdependent embodiment, the protection scope is very low."

In the words of Blackboard's general counsel, Matthew Small, the scope of the patent is characterized by independent and dependent parts. As he said in an interview with Inside Higher Ed, the former are the central claims and the latter parts are only relevant when applied to the central claims. So a reference to chat rooms does not mean that Blackboard claims to have invented them or has a right to royalties on their use - unless they are part of a larger system that makes use of Blackboard's patented technologies.

"Much of the criticism of Blackboard is based on reading the dependent patent clauses as if they were independent. In reality, the patent covers only specific functionality that was invented by Blackboard," he said. "This is not a patent on eLearning. We are not bullying anyone. We are not looking to put anyone out of business. We are looking to obtain a reasonable royalty for use of our intellectual property."

## **The Validity of the Patent in Europe**

So far the patent is in effect in the US, Australia, New Zealand, and Singapore, but pending almost globally, amongst other places in the European Union, where the application for patent – not yet granted - was filed in 2001. According to lawyer Dr. Wolf Günther of the German-based solicitor's office Dr. Erben, "For European companies there is no danger to be sued for patent infringement except if their technology is in use in one of the four countries mentioned. Blackboard's being awarded the patent in Europe is unlikely to happen."

Dr. Günther, who specialises in legal consulting in the field of Information and Communication Technology, added, "To get a patent in Europe, an invention has to be new and also has to be technical in the sense of affecting a physical phenomenon, affecting a Law of Nature. European Patent Convention explicitly says that software as such is not patentable."

But there are software patents in Europe, even ones that protect commonly used basic functionality. For example in January 2004, Siemens was awarded a patent on the exchange of data packages via mobile networks between a mobile client and a server. Affecting Law of Nature? Dr. Günther: "The big juristic question is what is meant by the expression 'software as such'. Within the discussion about the European Software Patent Directive, for a while it was easier to get a software patent. Since the Directive's failure, patent offices have returned to a much stricter practice and interpretation of the technical condition."

## **CEO pours oil on troubled water**

In terms of validity of the patent in the US, Blackboard is facing a big front of resistance. Especially the open source community is full of indignation, even though in an interview with the Chronicle of Higher Education, Blackboard CEO Michael Chasen assured that no legal action would be taken against open source developments. He also emphasized in an open client letter that the patent covers only specific features and functionality contained in the Blackboard system that were developed by the Blackboard team. "We certainly did not invent eLearning or course management systems, and I am personally embarrassed that this is what some people thought Blackboard was claiming."

Concerning the lawsuit filed against Canadian provider Desire2Learn, he said: "We are asking Desire2Learn for a reasonable royalty for their use of our intellectual property, which is in line and consistent with industry practices. Blackboard, for one, pays royalties to numerous companies, and we are asking Desire2Learn to do the same in return. We hope that you will come to see that our patent and law suit are not a dramatic change for the industry but a fair course for us to protect our investments."

## **Global Resistance continues**

Unimpressed, the open source community is still up in arms. While indignation in the blogosphere even produced a call for a boycott and conspiracy theories are still scattered, more considerate contemporaries are busily collecting proof of "Prior Art" to overthrow the patent by demonstrating earlier use of the features concerned. At Wikipedia, a special site on the history of virtual learning environments was launched as

a central point for gathering evidence.

The Sakai Foundation, which helps universities worldwide to build up and run open source course management systems, has engaged the Software Freedom Law Center (SFLC) to evaluate the recent Blackboard patent, its impact on the educational community, and to advise on legal matters regarding the patent. The Center is an organization directed by Eben Moglen and dedicated to providing advice and legal services to protect and advance free and open source software.

The Foundation's announcement says, "The recent announcement by Blackboard that it is attempting to assert patent rights over simple and longstanding online technologies as applied to the area of course management systems and eLearning technologies and its subsequent litigation against a smaller commercial competitor constitute a threat to the effective and open development of software for higher education and the values underlying such open activities".

Matthew Small, Blackboard's general counsel, pointed out that he welcomes Sakai's decision. Getting legal advice will dispose the misinformation and misunderstanding of what the patent represents and what it doesn't represent once and for all, he said.

Meanwhile another case is pending. On August 9, 2006, a complaint was filed against Blackboard, Inc. by Atlanta-based Portaschool of in the United States District Court of the Northern District of Georgia for deceptive business practices and knowingly and wilfully misrepresenting themselves in a patent application.

Overview about the case and updates on the discussion  
Patent information provided by Backboard