



## Patent FAQ

### Blackboard Patent Re-examination Filing FAQ

#### 1. What has happened?

The SFLC has filed a formal request to have the USPTO re-examine the BB patent with the goal of revoking its claims on the basis of prior art. Prior art here consists of patents that predate the purported BB invention or other kinds of documents published before BB filed the patent, describing everything that BB claims in the patent; in other words, clear cases that show the claim is unoriginal and thus should not have been granted the protection of a patent.

#### 2. Why does the SFLC think the Patent Office will revoke the patent?

The examples of prior art in this case are extremely, convincingly, strong. There were many software systems out before the filing of the BB patent that assigned roles to users and used those roles to determine access to files in the system. The examples the SFLC chose to use are some of the best examples of this and should make clear the unoriginality of the patent claims. It is interesting to note that in a re-examination there is no presumption of validity of the patent, unlike in a court proceeding.

#### 3. What comes next?

We see if the USPTO grants the re-examination. They must say yes or no within 90 days. Often they rule sooner than that. If they do undertake the re-examination, then they will consider the arguments and prior art presented by the SFLC and either let the patent stand or invalidate the patent as a whole or parts of it.

In detail: If the USPTO does order the reexamination, Blackboard is first given an opportunity to file a statement; if it chooses to do so, SFLC then has an opportunity to file a reply. At that point, what happens is that the USPTO begins to examine the Blackboard patent all over again, just as it did when Blackboard initially filed for the patent, but this time in an expedited manner. The USPTO will hopefully use the prior art cited in the reexamination request to formally "reject" Blackboard's claims as being unpatentable. Blackboard must then cancel its claims, amend them to make them narrower in scope, or make arguments to distinguish its claims over the cited prior art (which will also have the effect of narrowing the scope of the claims). Ultimately the USPTO will decide whether to cancel some or all of the claims, possibly narrowed by Blackboard's own amendments, and will issue a certificate containing the results of that determination.

#### 4. Why is this patent so important?

a) It's a bad patent and should not have been granted. Bad patents should not be allowed to stand. The patent system in the US is seriously broken and this patent was obtained in a fashion that is becoming all too familiar to those concerned about runaway patents in the software field. Little or no prior art was presented to the patent examiners. Indeed, from looking at the file wrapper (the record of the prosecution history of the patent at the USPTO), it appears BB submitted no prior art other than a few news articles discussing e-learning on a non-technical and superficial level. The only prior art that the patent examiner considered were prior patents (patents that the examiner uncovered in his own search), leaving a huge amount of real, existing practice (i.e., art) unexposed to the patent examiner in this case. The actual case for prior art here is overwhelming. See the immense amount of relevant material at [noedupatents.com](http://noedupatents.com) and the wikipedia site ([http://en.wikipedia.org/wiki/History\\_of\\_virtual\\_learning\\_environments](http://en.wikipedia.org/wiki/History_of_virtual_learning_environments)). The Computer and Communications Industry Association (CCIA) has recently released a paper on what they call the current "patent crisis" in the US. See <http://www.ccianet.org/modules.php?op=modload&name=News&file=article&sid=646&mode=thread&order=0&thold=0>

b) It is distorting the market and harming our community. Patents like this are used to FUD, to spread fear, uncertainty and doubt, in a community in order to keep people from adopting alternative software solutions. This distorts the open and free market that supports innovations in software, in its features and business models, and especially harms open source communities, which are founded on the amazing transparency and communication capabilities of the web and the various forms of trust it engenders. We are being hurt and need to remedy that. While BB claims that it will not pursue the Sakai Foundation itself, a not-for-profit corporation that is responsible for the open source Sakai software release, BB has explicitly said that it would pursue commercial entities in the field of educational software. All of the Sakai Commercial Affiliates fit into this category; they are all commercial vendors of open source software, and key components of the Sakai Community ecology. When confronted with this directly, BB responds with the irrelevant, or simply misleading, statements that it would not pursue the Sakai Foundation, and that it is a friend of open source, and follows with the non-sequitur that it uses open source itself (which has no bearing on this at all). We have decided that this is all FUD. BB's patent poses a clear and present danger to our community and we are taking the steps necessary to remove that danger as quickly and completely as possible.

With the CCIA we are concerned that the whole patent system in the US is broken, and interfering with the natural development of open source communities world-wide. We have to fix the system, or find ways to stop it from harming us. Revoking BB's patent is a good first step, both in obtaining immediate relief from the onerously broad patent claims of this patent, and in signaling to others that we will aggressively fight similar efforts to distort both the patent process and the free flow of ideas and innovation in the open source educational software community.

## **5) What else is important about this for the future?**

This is an educational opportunity for the community. This will not be the last patent that threatens the free flow of communication, innovation and development of educational software. The emergence of the open web sites [noedupatents.org](http://noedupatents.org) and the prior art wiki at [http://en.wikipedia.org/wiki/History\\_of\\_virtual\\_learning\\_environments](http://en.wikipedia.org/wiki/History_of_virtual_learning_environments) are clear examples of education in action, and the development of front-line defense mechanisms

for the open source and educational software communities. Understanding more about the actual revocation or invalidation of a bad patent can only help overall understanding of the difficult position we are in with regards to software patents and, on the other hand, the emerging effective methods for combating patent distortion of our activities.

So, this allows us to exercise emerging community defense mechanisms, like the SFLC, and to discuss further routes to protecting the community from a patent system that is seriously broken. Once a patent is granted, no matter how poorly the patent process was followed or how clearly it was manipulated, the patent holder has the advantage that courts, which must be appealed to for both enforcement or relief from the patent, assume the patent is valid. This places the burden of proof on those claiming the patent is invalid or was obtained in an unfair fashion. The open source software community, in particular, and the educational software community in general, must develop methods that other sectors of the software industry have found helpful in mitigating the damage caused by the dysfunctions of the patent system. Donation of a patent to the public domain, or a patent commons, is one way to alleviate the uncertainty surrounding the granting if a patent considered a threat to further innovation and development. BB has refused to do this in this case, even though encouraged to do so by individuals and by organizations such as the Sakai Foundation and Educause. Still, other patent holding organizations have contributed significant patents to the community, as IBM has done, and more should be encouraged to do so. Other deterrents, such as community defense funds, patent trusts that hold patents for defensive/offensive use, and efforts to change the patent process and patent law in the US, such as the efforts before Congress, should be discussed openly and urgently in the wider community, as they were at a conference recently (Nov 16. 17, 2006) at MIT and Boston University (<http://www.researchoninnovation.org/swconf/home.htm>).