

**BLACKBOARD, INC. V. DESIRE2LEARN, INC.**

**DECIDED JULY 27, 2009**

**A PARTICULAR LIMITATION IN A DEPENDENT CLAIM GIVES RISE TO A PRESUMPTION THAT THE LIMITATION IS NOT PRESENT IN THE INDEPENDENT CLAIM**

**By: Thomas McKiernan**

Blackboard filed an action against Desire2Learn in the United States District Court for the Eastern District of Texas for infringement of Blackboard's U.S. Patent No. 6,988,138 ("the '138 patent"), which claims an Internet-based educational support system and related methods. Blackboard asserted that the "single login" feature is the '138 patent's essential improvement over the prior art and is a part of every claim of the patent.

After a Markman hearing, the District Court entered partial summary judgment for Desire2Learn, holding claims 1-35 of the patent invalid for indefiniteness. The District Court held that the specification contained insufficient structure to support one of the means-plus-function limitations in claim 1 and, by incorporation, claims 2-35.

The District Court then conducted a jury trial that addressed whether Desire2Learn had infringed claims 36-38 of the patent; Desire2Learn asserted that those claims were anticipated and would have been obvious in light of prior art. The jury found that claims 36-38 were neither anticipated nor obvious, and that Desire2Learn had infringed those claims.

Desire2Learn then filed motions for judgment as a matter of law ("JMOL"), contending that claims 36-38 were invalid for both anticipation and obviousness, which the District Court denied.

The Federal Circuit reversed the failure to grant JMOL, holding that claims 36, 37, and 38 are invalid for anticipation as a matter of law by two references in the prior art.

The Federal Circuit reasoned that a close examination of the specification makes clear the "single login" limitation is not present in each of the patent's claims. Claim 1, moreover, cannot be construed to include a single login without making claim 25 redundant, which implies that claim 36, which contains the same pertinent language as claim 1, also does not require access to all courses with a single login.

Blackboard cross-appealed the District Court's ruling that claims 1-35 were invalid for indefiniteness. The Federal Circuit agreed with the District Court, stating that programming a general purpose computer describes an outcome, not a means for achieving that outcome, and thus does not constitute sufficient disclosure of structure to support a claimed function in a means-plus-function claim. When a computer is referenced as support for a function in the means-plus-function claim, there must be some explanation of how the computer performs the claimed function. A patentee cannot avoid providing specificity as to structure simply because someone skilled in the art would be able to devise a means to perform the claimed function.