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Datasheet for the decision
of 1 June 2023

Case Number: T 1272/20 - 3.5.07

Application Number: 17196808.4

Publication Number: 3299973

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:
Site memory processing and clipping control

Applicant:
Evernote Corporation

Headword:
Search in internet and personal notes/EVERNOTE

Relevant legal provisions:
EPC Art. 56
RPBA 2020 Art. 13(2)

Keyword:
Inventive step - main request (no) - auxiliary request I (no)
- mixture of technical and non-technical features
Amendment after summons - exceptional circumstances (no)

Decisions cited:
G 0003/08, G 0001/19, T 0641/00, T 0643/00, T 0154/04,
T 1784/06, T 0844/09, T 0157/10, T 0306/10, T 0598/14,
T 2573/16, T 0697/17, T 0731/17, T 1924/17, T 1971/18

Case Number: **T 1272/20 - 3.5.07**

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 1 June 2023

Appellant: (Applicant)	Evernote Corporation 305 Walnut Street Redwood City, CA 94063 (US)
Representative:	Eisenführ Speiser Patentanwälte Rechtsanwälte PartGmbB Johannes-Brahms-Platz 1 20355 Hamburg (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 20 January 2020 refusing European patent application No. 17196808.4 pursuant to Article 97(2) EPC**

Composition of the Board:

Chair	J. Geschwind
Members:	P. San-Bento Furtado
	C. Barel-Faucheux

Summary of Facts and Submissions

I.   The appeal lies from the decision of the examining
         division to refuse European patent application
         No. 17196808.4 for lack of inventive step of the
         subject-matter of the claims of a main request and an
         auxiliary request ("auxiliary request I").

         The examining division was of the opinion that the
         claimed subject-matter related essentially to a non-
         technical computer program. In further remarks, the
         examining division considered that claim 1 of both
         requests was not inventive when taking the following
         document as the closest prior art:
         D1: US 6 282 548 B1, published on 28 August 2001.

II.   In the statement of grounds of appeal, the appellant
         requested that the decision under appeal be set aside
         and that a patent be granted on the basis of the main
         request or auxiliary request I, both considered in the
         appealed decision and annexed to the grounds of appeal.

III.   In a communication accompanying a summons to oral
         proceedings, the board expressed the view that the
         subject-matter of claim 1 of the main request and
         auxiliary request I was not inventive taking into
         account either a notoriously known web browser for
         personal computers or the disclosure of document D1.

IV.   With a letter of reply, the appellant submitted further
         arguments in favour of inventive step.

V.   Oral proceedings were held as scheduled. During the
         oral proceedings, the appellant submitted a new set of
         claims pursuant to auxiliary request I'. At the end of

the oral proceedings, the Chair announced the board's
decision.

VI.   The appellant's final requests were that the contested
        decision be set aside and that a patent be granted on
        the basis of one of the main request, auxiliary
        request I or auxiliary request I'.

VII.   Claim 1 of the main request reads as follows:
        "A computer-implemented method of searching personal
        information when a user performs an Internet search,
        comprising:
            receiving a search query from a user;
            extracting terms from the search query;
            determining that one or more relevant notes exist
        within a personal database of the user by comparing the
        extracted terms to stored notes of the user within the
        personal database;
            obtaining search results information by analyzing
        public search results for the search query;
            determining that one or more additional relevant
        notes exist by comparing the search results information
        to the stored notes of the user within the personal
        database;
            preparing note previews for the one or more relevant
        notes and the one or more additional relevant notes;
        and
            presenting the prepared note previews to the user,
        including altering content of a search result page to
        provide links to the relevant notes with search result
        listings;
            receiving a user selection of one of the presented
        note previews;
            retrieving the stored note corresponding to the
        selected note preview from the personal database; and
            presenting the stored note to the user."

VIII.   Claim 1 of auxiliary request I differs from claim 1 of
the main request in that the following text has been
added before the text "obtaining search results
information by analyzing public search results ...":
"wherein the stored notes of the user comprise at least
one handwritten note of the user, wherein determining
that a personal database of the user includes one or
more relevant notes corresponding to the extracted
terms includes utilizing natural handwriting
recognition (NHR) on the handwritten note;"

IX.   Claim 1 of auxiliary request I' differs from claim 1 of
the main request in that, apart from the change of "a
personal database" to "the personal database" and
"analyzing public search results" to "analyzing the
public search results", the first part of the claim up
to "receiving a search query from a user;" has been
replaced with the following text:
"A system for providing a personal database for storing
personal information, wherein the personal database is
maintained by a service to which a visitor of a website
subscribes, said system being configured to facilitate
the search for and presenting of relevant notes in
connection with search results from a public database
distinct from the personal database when a user
performs an Internet search, the system comprising a
memory storing executable code and at least one
processor, where the executable code, when executed by
the at least one processor causes the processor to
perform the steps of:
    receiving a search query from a user; wherein the
search query is received via a user entry in a web
browser;".

X.   In the decision under appeal, the examining division
stated, in reply to the applicant's reasoning based on

decision T 1351/04, that it agreed with the applicant
that retrieving given data, e.g. a file identified by a
file name, within a technical system, by using
information about the physical location, i.e. a memory
address, of the stored data had technical character.
However, the method of claim 1 was not about
retrieving/accessing information in a physical system,
except by using a database, but was essentially
directed to selecting/searching information which could
be relevant for the user. As the claimed method did not
take into account any technical constraints of the
underlying technical system, no technical
considerations were apparent. While retrieving a file
in a system could have technical character, this was
not the case with searching information in a file. The
examining division cited decision T 598/14 in support
of its reasoning (see decision under appeal,
point 14.1).

The inventive-step assessment of the decision under
appeal followed two lines of reasoning. In the first
line (points 20.1 to 20.3), the examining division
analysed the features as to whether they were technical
or non-technical when taken in isolation. The only
technical features were "computer-implemented",
"database" and "links". The database was considered
technical only to the extent that a computer was
involved in the search engine and the database.
However, the search functionality of the search engine
and the data, e.g. the personal data, stored in the
search engine were considered non-technical. The claim
related to a method carried out by a computer device
involving the use of a database and links specified by
a computer program. The computer program did not
contribute to the technical character of the invention

because it did not bring about a further technical effect and was not based on technical considerations.

In the second line of reasoning (points 21 to 24), the examining division stated that query enhancement, producing different results for the same query and better search results were non-technical effects according to decision T 598/14. No further technical considerations were apparent from the claim. The examining division considered that document D1, as the closest prior art, disclosed the features contributing to the technical character of the invention: a computer, search engines, databases to store information to be displayed on a web page and the use of links to allow access to (related) information. The objective technical problem was to configure the system of D1 to carry out the method specified by the non-technical computer program. The claimed solution did not go beyond executing the non-technical computer program on the known computing device and was straightforward.

XI.   In the grounds of appeal, the appellant disagreed with the examining division's identification of the features of claim 1 which had technical character. The examining division had equated features contributing to technical character with structural features and had excluded any non-structural features from the assessment of inventive step as being non-technical *per se*. This, however, was not the correct standard for establishing technical character. Furthermore, the examining division had not properly taken into account the technical considerations underlying the claimed invention.

The concept of supplementing information from one database with information from another was technical as it required a technical understanding of the underlying principles of how systems including multiple databases worked and how information from databases was processed.

The concept further provided a technical solution to a technical problem, namely the quick and efficient information collection from multiple databases. Contrary to the examining division's understanding, it could not be appreciated from decision T 598/14 that such a problem should be considered non-technical. According to the appellant, in T 598/14, Reasons 2.4, the board had found that the features distinguishing the claimed invention from the prior art related only to the non-technical semantic content of the retrieved data. The board had established that the concepts of "performing a better search" or "enhancing a query" within the meaning of the case dealt with in T 598/14 were subjective and non-technical.

According to the appellant, all steps of the computer-implemented method contributed to the technical character of the invention as they defined the way in which the computer performed the search. The non-technical aspects of the claims merely concerned the content of the data that was processed, namely whether the searched data concerned personal information and/or whether the entries in the database corresponded to notes, whether or not the databases were personal or public, etc.

Reasons for the Decision

Invention

1.   The invention concerns searching for and presenting to
       a user relevant notes in connection with other website
       content as result of an internet search performed by
       the user. According to the description, "note" is a
       general name for a piece of information (see original
       description, page 1, lines 18 and 19).

Main request

2.   *Claim interpretation – claim 1*

       Claim 1 recites a computer-implemented method for
       searching personal information when the user performs
       an internet search. In a first step, the claimed method
       receives a search query. It then extracts terms from
       the received search query and uses them to determine
       "relevant notes" of the user in a "personal database",
       e.g. data stored locally. The method obtains "search
       results information" by analysing "public search
       results for the search query" and uses the search
       results information to determine "additional relevant
       notes".

       Since the claim refers to an internet search, the
       "public search results" are results, for the search
       query, of an internet search performed by an internet
       search engine. This is also supported by the
       description (see e.g. page 7, line 30 to page 8,
       line 2; page 10, line 19 to page 11, line 8). Search
       results of the internet search are presented in "search
       result listings" on a "search result page".

In the method of claim 1, "note previews" of the
relevant and additional relevant notes are prepared and
presented to the user, including "altering content of
[the] search result page to provide links to the
relevant notes with search result listings". A user
selection of one of (the links associated with) the
prepared and presented note previews is received, and
the corresponding stored note is retrieved and
presented to the user.

3.   *Technical contribution and inventive step – claim 1*

3.1   The appellant has - correctly - remarked that in
        decision T 598/14 the board did not consider that none
        of the claimed features was technical but rather that
        the features distinguishing the claimed subject-matter
        from the prior art did not make a technical
        contribution. The board further agrees with the
        appellant that T 598/14 did not express that any manner
        in which a computer performs a search is non-technical
        for the sole reason that the result is a "better
        search". As with all subject-matter excluded **as such**
        under Article 52(2) and (3) EPC, it has to be
        established whether the non-technical features, to the
        extent that they interact with the technical subject-
        matter of the claim for solving a technical problem,
        provide a technical contribution and should be taken
        into account in assessing inventive step (see also
        T 154/04, Reasons 5; T 697/17, Reasons 4.2; T 2573/16,
        Reasons 4.4).

        In assessing a claim, it is therefore important to take
        into account the effect of the features in the claimed
        invention. An assessment based on an isolated analysis
        of the individual features of the claim without regard
        for possible interactions with the other claimed
        features may lead to ignoring features which make a

technical contribution (see also T 731/17, Reasons 6.2
and 6.4; T 697/17, Reasons 4.2).

An invention with an overall purpose which is non-
technical may nevertheless be a patentable solution to
the problem of finding a technical implementation for
achieving the non-technical purpose (T 1784/06,
Reasons 2.3). The board does not find any basis either
for considering that only hardware features are
technical. In decision G 1/19, the Enlarged Board was
of the opinion that while a direct link with physical
reality is in most cases sufficient to establish
technicality, it cannot be a necessary condition (see
Reasons 62, 88, 101 and 139).

The board further notes that a technical feature does
not lose its technical nature because it is too generic
or "functionally defined" (G 3/08, Reasons 10.8.7).

3.2   Applying these case-law principles to the current case,
        the board does not agree with the examining division
        that only the "physical features" of the claim, or that
        only the features "computer-implemented", "database"
        and "links", make a technical contribution within the
        context of claim 1. The claim specifies a computer-
        implemented method for searching personal information
        when a user performs an internet search. The claimed
        method involves retrieving data from the internet and
        from a separate database, the "personal database", and
        presenting to the user search results and links to
        access some of those search results. It also includes
        steps describing a user interaction with the computer
        system: receiving a user selection of one of the links
        and retrieving the respective data. Therefore, these
        features contribute to the technical effect of
        retrieving data in a computer system. One technical
        constraint is that the notes are stored in a personal

database which cannot be searched by the search engine. Even though, as explained below, the decision to present only previews of the notes, instead of the full notes, is not technical, technical considerations are involved, for example when deciding which user interaction means (e.g. links) to use for supporting user access to the data in the notes. Links were considered technical in the decision under appeal (see e.g. point 20.1). The mere fact that at least some of these technical features might be notoriously known or generically specified, or that some technical aspects might be implicit from the claim, does not mean that the corresponding subject-matter cannot make any technical contribution. Relevant is whether the criteria developed by the case law are fulfilled.

3.3   In order to correctly assess inventive step of an invention such as the current one, in which the non-technical aspects are tightly intermingled with the technical features, the board finds it preferable, if not necessary, to assess inventive step from a starting point closer to the invention than a general purpose computer.

3.4   At the date of priority of the current application (in 2010), web browsers for personal computers and web search engines were notoriously known. When such a web browser and search engine are used to perform a search query, a computer-implemented method is performed for searching information which comprises receiving a search query from a user, extracting terms from the search query and obtaining relevant search results (corresponding to "search results information" in claim 1) by "analyzing public search results for the search query". A search results page is then created with links to the relevant search results, where the

list of links to the relevant search results
corresponds to "search result listings".

When a user selects a link in the search results page,
the method includes further steps of receiving a user
selection of one of the links, retrieving the selected
search result corresponding to the selected link from
the web and presenting the selected search result to
the user.

The board further notes that each personal computer
stores personal data which constitutes "notes within a
personal database of the user".

3.5   The method of claim 1 differs from this notoriously
        known method using a web browser in that it further
        includes the steps of:
        (i)   determining relevant notes within the personal
               database by comparing the extracted terms to
               stored notes;
        (ii)   determining additional relevant notes by
               comparing the search results information to the
               stored notes;
        (iii) preparing note previews for the relevant notes
               and the additional relevant notes;
        (iv)   altering the content of the search results page
               to provide links to the relevant notes with the
               search result listings;
        (v)   receiving a selection of one of the presented
               note previews, retrieving the stored note
               corresponding to the selected note preview from
               the personal database and presenting the
               respective note to the user.

3.6   The appellant argued that even if the ultimate goal of
        the claimed invention was to serve the informational
        needs of the user, the technical teaching of the

invention was how to provide such content. Usually, it
was not possible to search a personal database with a
web browser. The concept of using a search query
provided to a web engine, as well as the public search
results, for searching a personal database did not
"serve the informational needs of the user" but was a
teaching on how to jointly provide information from two
databases to, subsequently, add relevant information to
one of the two databases. The term "relevant" related
to the search query; it did not pertain to what the
user found relevant. The purpose was to find notes
relevant to the search query. If anything, only the
last step (i.e. adding relevant notes) could be
considered as (also) serving an informational need.
However, even then, using search results from one
database to obtain search results from another in a
second round was a technical teaching in terms of "how
to combine content from two parallel databases" (see
the appellant's letter of reply of 2 May 2023, page 6).

The appellant cited decision T 844/09, Reasons 5.3, and
argued that combining data in the method of claim 1
required technical knowledge of the technical system.
In accordance with decision T 643/00, the mere fact
that a tool assisted the user in performing a mental
task did not exclude the tool from patentability. The
efficient search and retrieval of information stored in
a database was governed by technical considerations.

According to the appellant, the distinguishing features
did not relate to mere presentation of information.
Instead, they had the technical effect of providing
access to and effective and accurate search in two
databases. The relevant notes applied to supplement the
public search results were more thorough and accurate
compared to when only a search query was used to search

both the personal and public databases (see the letter
of reply, page 7).

At the oral proceedings, the appellant argued that the
technical problem solved could be regarded as how to
search personal information using an internet search
and how to make this search more thorough and accurate.

3.7   The board is, however, of the opinion that the idea of
        obtaining relevant notes and additional relevant notes
        reflects the interest of the user in receiving, in
        addition to the public search results, related
        information from the user's personal notes. Meeting the
        informational needs of a user is not *per se* a technical
        effect (T 306/10, Reasons 5.2; T 598/14, Reasons 2.4;
        T 1971/18, Reasons 2.4).

        The appellant's argument that relevance is a technical
        aspect as it concerns the search query and not the
        user's interest is not persuasive. In this case, there
        is no objectively defined set of data which constitutes
        the correct result for the search query. What is
        relevant has to be determined based on non-technical
        linguistic aspects and subjective user preferences (see
        also T 1924/17, Reasons 12).

        The distinguishing features essentially serve the
        informational need of the user to obtain, in addition
        to the results of the web search, information from the
        prior-art user's personal database which is related to
        search terms of the search query (relevant notes) and
        to the results of the search (additional relevant
        notes). These are merely non-technical aspects of how
        the public data is to be supplemented by personal
        notes.

In the claimed method, the decision to present the
relevant and additional relevant notes as "note
previews", instead of e.g. presenting the full content
of the notes in the search result page, does not serve
any technical purpose. It is a layout choice and/or a
user's preference. It therefore concerns the
presentation of information as such, which is excluded
from patentability under Article 52(2)(d) EPC.

Following the COMVIK approach (T 641/00), these non-
technical aspects may legitimately appear in the
formulation of the problem as part of the framework of
the technical problem to be solved, in particular as a
constraint to be met.

The presentation of links to the relevant notes of
feature (iv) facilitates user access to the relevant
notes.

3.8   The board is thus of the view that the distinguishing
        features solve, over the notoriously known method, the
        technical problem of facilitating, when a search query
        is performed, user access to personal notes related to
        search terms of the search query (relevant notes) and
        to the results of the search (additional relevant
        notes), where the notes should be presented in the form
        of "note previews".

3.9   The user's personal database with stored notes is
        already known from the prior art (see point 3.4 above).
        Features (i), (ii) and (iii) are directly mapped from
        the formulated problem. The board notes that these
        features do not describe any (inventive) technical
        details of the implementation of the non-technical
        constraints.

3.10   Links were notoriously known and already used in the
         search result page of the prior-art web browser for
         facilitating user access to web pages related to the
         public search results independently of their storage
         locations in a computer or computer network. It would
         thus have been obvious for the skilled person seeking
         to facilitate access to the full notes corresponding to
         the note previews, which are also search results, to
         additionally include, for each note preview on the
         search results page, a link to the note, as in
         feature (iv). The skilled person would thus also arrive
         at feature (v), which merely describes the notoriously
         known way a link works when a user selects it. The
         distinguishing features entail no inventive technical
         elements of the implementation.

3.10.1   The appellant argued that there was no teaching or
         suggestion in the prior art that the web browser could
         provide a link to local data. A web browser had no
         access rights to access personal data. For security
         reasons, the skilled person would not have provided
         links to the personal notes in the way claimed. At the
         priority date of the application in 2010 web browsers
         were not as advanced as today. At that time it would
         not have been obvious to add personal search results in
         the claimed manner. Even if a solution appeared
         relatively straightforward, the board should consider
         whether the skilled person would have been motivated to
         arrive at the solution (the appellant cited decision
         T 157/10, reasons 3.5).

3.10.2   These arguments are not persuasive. The distinguishing
         features do not solve any security problem of accessing
         personal data from a web browser. The description
         discloses embodiments based on web browsers (see e.g.
         page 5, line 28 to page 6, line 18), but is silent

about any security problems and corresponding
solutions.

3.11   Therefore, claim 1 of the main request does not meet
the requirements of Article 56 EPC for lack of
inventive step.

Auxiliary request I

4.   Claim 1 of auxiliary request I differs from claim 1 of
the main request in that it additionally specifies (see
point VIII. above) that
        (vi) the stored notes of the user comprise at least
              one handwritten note of the user, wherein
              determining that a personal database of the user
              includes one or more relevant notes corresponding
              to the extracted terms includes utilising natural
              handwriting recognition (NHR) on the handwritten
              note.

5.   *Inventive step – claim 1*

5.1   The appellant argued that while NHR was known at the
priority date of the current application, the concept
of using handwriting recognition in a combined personal
and public database search could not be considered
obvious. When searching the internet, handwritten
documents were rarely present as text documents.

5.2   The board does not find this reasoning convincing.
Claim 1 is not about searching handwritten documents on
the internet. The claim refers only to searching
handwritten notes in the personal database. The
additional feature of claim 1 of auxiliary request I
fulfils the user requirement of taking into account
handwritten notes and does not include any detail, or
at least any inventive detail, of the implementation of

this user requirement. Handwritten input of text and NH
R were well known at the priority date of the current
application. Furthermore, these features were known
from the prior art acknowledged in the description
(page 1, lines 17 to 19 and page 10, lines 14 to 17).

5.3   Therefore, claim 1 of auxiliary request I is not
        inventive (Article 56 EPC).

Auxiliary request I'

6.   Claim 1 of auxiliary request I' is directed to a system
        and, compared to claim 1 of the main request, adds new
        features including the following (see point IX. above):
            "the personal database is maintained by a service
            to which a visitor of a website subscribes, said
            system being configured to facilitate the search
            for and presenting of relevant notes in connection
            with search results from a public database distinct
            from the personal database when a user performs an
            Internet search" and "the search query is received
            via a user entry in a web browser".

7.   *Admissibility*

7.1   Since auxiliary request I' was filed during the oral
        proceedings, its admissibility is subject to
        Article 13(2) RPBA 2020.

7.2   Pursuant to Article 13(2) RPBA 2020, any amendment to a
        party's appeal case made after the expiry of a period
        specified by the board after notification of a summons
        to oral proceedings shall, in principle, not be taken
        into account unless there are exceptional circumstances
        justified with cogent reasons by the party concerned.

7.3   The appellant argued that auxiliary request I' was
        submitted in response to the board's arguments
        mentioned for the first time at the oral proceedings
        that it was unclear whether claim 1 of the main request
        related to a tool and excluded that the personal
        database was part of the internet, i.e was also public.

7.4   However, the board did not insist on these comments and
        its assessment of inventive step, which is explained
        above, does not rely on either of the allegations.
        Therefore, the two comments do not constitute an
        exceptional circumstance in accordance with
        Article 13(2) RPBA 2020.

7.5   With regard to the appellant's argument that oral
        proceedings are inconsequential if the appellant is not
        allowed to react to the focus of the discussion at the
        oral proceedings, the board refers to
        Article 13(2) RPBA 2020, in line with which claims
        submitted at the oral proceedings are admissible only
        under exceptional circumstances, and to the general
        principles deriving from the EPC that no further
        amendments at this late stage can be made without the
        consent of the board (Case Law of the Boards of Appeal,
        10th edn., 2022, V.A.4.1.1).

7.6   The board does not recognise any exceptional
        circumstances in the current case. At the oral
        proceedings, the board did not introduce any relevant
        changes to the inventive-step reasoning provided in its
        communication pursuant to Article 15(1) RPBA 2020.
        Claim 1 of auxiliary request I' adds new features which
        were not the subject of the board's assessment in its
        communication. The board used a different starting
        point for assessing inventive step than the examining
        division. However, in the case at hand, this cannot be
        considered an exceptional circumstance justifying

admitting the claims filed at the oral proceedings. The
claims according to auxiliary request I' could have
been submitted earlier, for example with the
appellant's reply to the board's communication in which
the board presented a complete inventive-step
assessment of the claimed invention on the basis of the
new starting point.

7.7   Taking the above into account, the board does not admit
        auxiliary request I' into the proceedings
        (Article 13(2) RPBA 2020).

Concluding remark

8.   Since none of the admitted requests is allowable, the
        appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chair:

S. Lichtenvort   J. Geschwind

Decision electronically authenticated