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**Datasheet for the decision  
of 11 January 2023**

**Case Number:** T 1720/20 - 3.3.05

**Application Number:** 14746185.9

**Publication Number:** 2952596

**IPC:** C22C9/04

**Language of the proceedings:** EN

**Title of invention:**

LEAD-FREE EASY-TO-CUT CORROSION-RESISTANT BRASS ALLOY WITH GOOD THERMOFORMING PERFORMANCE

**Patent Proprietor:**

Xiamen Lota International Co., Ltd.

**Opponent:**

OTTO FUCHS - Kommanditgesellschaft

**Headword:**

BRASS ALLOY/Xiamen Lota

**Relevant legal provisions:**

EPC Art. 87(1), 111(1), 104(1), 112(1)(a)  
RPBA 2020 Art. 13(2), 12(2), 12(4), 12(6)  
EPC R. 103(1)(a)

**Keyword:**

Priority - (yes)  
Amendment after summons

**Decisions cited:**

G 0003/97, T 1031/12

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 1720/20 - 3.3.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.05**  
**of 11 January 2023**

**Appellant:** Xiamen Lota International Co., Ltd.  
(Patent Proprietor) 61 Xing Nan Road  
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**Representative:** Hamel, Armin  
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**Respondent:** OTTO FUCHS - Kommanditgesellschaft  
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**Representative:** Haverkamp Patentanwälte PartG mbB  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 18 June 2020  
revoking European patent No. 2952596 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** E. Bendl  
**Members:** J. Roider  
S. Fernández de Córdoba

## Summary of Facts and Submissions

I. The appeal lies from the opposition division's decision to revoke the patent.

II. The following documents cited in the decision under appeal are of relevance:

- D8 priority document CN 103114220 of the patent in suit
- D8a bibliographic data of CN 103114220, provided by the EPO
- D10 PCT application of the patent in suit claiming the priority of D8
- D11 certified copy of a print-out of a Chinese register of foreign trade companies

III. In its decision, the opposition division concluded that the priority document of the patent in suit was filed by "Lota (Xiamen) Industrial Co. Ltd.", whereas the PCT application of the contested patent was filed by "Xiamen Lota International Co. Ltd.", i.e. a different legal entity. The proprietor of the patent in suit was therefore not entitled to claim priority validly, and D8 destroyed novelty of the claimed subject-matter.

IV. In appeal proceedings, the proprietor (appellant) maintained the claims as granted referring to a corrosion-resistant brass alloy as its only request and submitted, among others, the following documents:

- D14 certified translation of the bibliographic data of D8 provided by the appellant
- D15 bibliographic data provided by the China Intellectual Property Administration (CNIPA)

V. The respondent (opponent) submitted in appeal procedure the following documents:

- D16 certified translation of the bibliographic data of D8
- D17 presentation by the respondent filed during the oral proceedings before the board

VI. The key arguments of the appellant can be summarised as follows.

D16 was not to be admitted.

To clarify issues of general legal interest, two questions should be submitted to the Enlarged Board of Appeal.

The first part of INID field 71 on the first page of a publication was for the applicant's name; the second part was for the address. Even the opposition division confirmed that the first parts of INID field 71 of the priority document (D8) and the PCT application of the patent in suit (D10) were identical. The difference the opposition division was referring to in its decision was contained in the second part, thus, the address. The Chinese patent register was corrected to reflect the proper name of the applicant of the priority document.

In view of a procedural violation of appellant's right to be heard, refund of the appeal fee was appropriate.

VII. The key arguments of the respondent can be summarised as follows.

D14 and D15 were not to be admitted.

To clarify issues of general legal interest, two questions should be submitted to the Enlarged Board of Appeal.

According to D8a, the priority document was filed by Lota Xiamen Industrial Co., Ltd., while the PCT-application was filed by Xiamen Lota International Co., Ltd.

The identity of the applicant in the corrected Chinese patent register entry could have changed due to a transfer of rights. There is no evidence showing why the CNIPA changed the applicant's identity. There was furthermore no basis in the EPC which allowed for a photographic comparison of the Chinese characters in D8 and D10. Moreover, small differences in the Chinese characters in D8 and D10 might originate from the fact that they relate to the names of different legal entities.

The late submission of evidence by the appellant justified an apportionment of costs (costs incurred by the respondent during the appeal proceedings and costs of the certified translation D16).

VIII. Requests as to the substance

- (a) The appellant requests that the decision under appeal be set aside and that the opposition be rejected.
- (b) The respondent requests that the appeal be dismissed.

## **Reasons for the Decision**

1. Admission of D14, D15 and D16 into the appeal proceedings
  - 1.1 The respondent argued that the appellant was invited three times to file a certified translation in the opposition procedure, including in the preliminary opinion of the opposition division. Documents D14 and D15 should thus have been filed during the opposition proceedings. Under Article 12(6) RPBA 2020, the board must not admit evidence which should have been submitted in the proceedings leading to the decision under appeal.

The filing of D16 by the respondent was a reaction to the board's unexpected announcement in its preliminary opinion to possibly admit D14 (and D15).
  - 1.2 The appellant argued that the opposition division incorrectly compared INID field 71 of documents D8 and D10 by focusing on the second part of it. Therefore, it was deemed necessary to file the certified translation (D14) and the bibliographic data from the CNIPA's web page (D15), confirming the applicant's identity. D16 should have been filed as an immediate reaction to D14 and not after receiving the board's preliminary opinion. For this reason, it should not be admitted.
  - 1.3 D14 and D15 were first filed in the appeal proceedings. Under Article 12(4) RPBA 2020, these documents are to be regarded as an amendment of the case which may be admitted at the discretion of the board. The board must

exercise its discretion in view of, *inter alia*, the suitability of the amendment for addressing the issues which led to the decision under appeal.

Furthermore, in accordance with Article 12(6) RPBA 2020, evidence which could and should have been filed in the opposition proceedings is not to be admitted unless the circumstances of the appeal case justify its admittance.

As apparent from the reasons on the validity of the priority claim (see below), the decision under appeal is based on an error of judgement when comparing the applicant's identity stated in INID field 71 of D8 and D10. In the current case, the board thus considers the filing of D14 and D15 a legitimate reaction to the decision of the opposition division. Both documents are suitable for addressing the issue of the identity of the applicant.

Therefore, D14 and D15 are admitted into the appeal proceedings.

D16 was filed after the notification of a summons to oral proceedings. Under Article 13(2) RPBA 2020, this document must, as a rule, not be taken into account unless there are exceptional circumstances justified with cogent reasons by the party concerned.

The board considers the filing of this document a legitimate reaction to the filing of document D14. It became apparent to the respondent only after the communication under Article 15(1) RPBA that the board intended to admit the appellant's certified translation into the proceedings although, in view of repeated



invitations in the proceedings leading to the decision under appeal, there was a reasonable expectation that this request would be refused. In view of the considerable cost of a certified translation, it is considered unreasonable that in such circumstances the respondent should have filed the certified translation as a precautionary measure in response to the statement of grounds of appeal.

D16 is thus admitted into the proceedings.

2. Validity of the priority claim, Article 87(1) EPC

Both parties submitted certified translations, D14 and D16, of the bibliographic data of the priority document D8.

D14 provides the following translation:

*"Applicant: Xiamen Lota International Co., Ltd.  
(Translator's note: English name according to  
company website: Xiamen Lota International Co.,  
Ltd.)  
Address: 361022 Province of Fujian, City of Xiamen,  
District of Jimei, Xingnan Rd. no. 61"*

D16 provides the following translation:

*"Anmelder Lota (Xiamen) Industrial Co., Ltd  
Adresse 361022 Provinz Fujian Stadt Xiamen Bezirk  
Jimei, Xingnan-Str. 61"*

2.1 Therefore, both translations provide the same translation for the address, the second part of INID field 71. The beginning of the second part is marked

with the word "address".

2.2 As to the first part of INID field 71, which states the name of the applicant, the certified translations propose different names.

However, D14 and D16 are consistent in so far as the name of the applicant is stated in the first part of INID field 71, while the address is stated in the second part.

When photographically comparing the Chinese characters of the first part of D8 and D10, no difference can be seen, as acknowledged by the opposition division. A comparison with D11, a document certified by a Chinese notary, leads to the same result.

Irrespective of the exact translation of the applicant's name into English, the Chinese characters stating the name of the applicant are identical in the priority document D8 and the corresponding PCT application D10.

2.3 The respondent argued that even small differences in Chinese characters may considerably change the significance of a word. To illustrate this, the respondent showed a presentation (D17) highlighting the small differences between some Latin letters such as "l" and "I" and continued to highlight possible small differences in the Chinese characters of the applicant's name in D8 and D10.

2.4 While it is acknowledged that small differences in characters may, in certain cases, change their meaning completely, the current dispute is about whether the alleged small differences in the Chinese characters highlighted by the respondent in D8 and D10 are due to

the fact that they relate to the names of different legal entities. No proof for this was submitted.

- 2.5 It is established case law (see Case Law of the Boards of Appeals, 10th ed., III.G.4.1 and III.G.4.2) that proceedings before the EPO are conducted in accordance with the principle of the free evaluation of evidence, on a case-by-case basis (see G 3/97, point 5 of the Reasons). Under this principle, no reason can be seen why in the case at issue a photographic comparison of the Chinese characters should not be suitable or applicable.
- 2.6 In addition, the appellant has submitted proof with its submission of D15 that the official English version of the CNIPA website now indicates "Xiamen Lota International Co. Ltd." as the (correct) applicant of the priority document D8.
- 2.7 The respondent's argument that a transfer of rights or a change of name may have taken place due to other reasons is an allegation for which, again, no proof has been submitted. However, the burden of proof lies on the party making the allegation, i.e. the respondent in this case.

Therefore, in view of the reasoning outlined above, the applicant of D10 enjoys the right to priority of D8 (Article 87(1) EPC).

3. Request under Article 112(1) (a) EPC

The parties jointly requested to refer the two questions quoted below to the Enlarged Board of Appeal. Since they could not find pertinent case law on the

photographic comparison of non-Latin characters and because they expected similar situations to arise in the future, the parties considered that the matter was a point of law of fundamental importance.

The questions as filed read:

*"1. Ist ein Schriftzeichenvergleich auf fotografischer Basis, etwa zum Feststellen einer Anmelderidentität im Rahmen eines Prioritätsanspruches, durch das EPA nach dem EPÜ zulässig, wenn die Schriftzeichen derselben Sprache angehören, aber nichtlateinische Zeichen (nicht Teil des Alphabets der EPA-Amtssprachen deutsch, englisch und französisch) sind?*

*2. Wenn ein Vergleich auf fotografischer Basis zulässig ist, wie groß dürfen die fotografischen Abweichungen der zu vergleichenden Schriftzeichen vis-a-vis sein? Wie wird mit verschiedenen Schriftformen (Typen, Art, Schnitt, etc.) umgegangen? Wie wird mit von Dokumenten angefertigten Kopien und den damit einhergehenden Qualitätsverlusten umgegangen?"*

English translation (done by the board):

*"1. Is a photographic comparison of characters, e.g. to determine an applicant's identity for a priority claim, permitted by the EPO under the EPC if the characters belong to the same language but are non-Latin characters (not part of the alphabet of the official EPO languages German, English and French)?*

*2. If a photographic comparison is permissible, how large may the photographic deviations between the characters be? How are different types of writing (types, type, style, etc.) handled? How are document copies and the associated loss of quality dealt with?"*

The board considers that the case at hand can be decided without doubt by the board itself on the basis of the principles established by the settled case law of the boards (see above). There is thus no need to refer questions to the Enlarged Board of Appeal.

Therefore, the request under Article 112(1)(a) EPC is refused.

4. Apportionment of costs, Article 104(1) EPC

The respondent requested that the appellant be charged the cost of the appeal proceedings, including those of the certified translation D16.

According to the respondent, the appellant was invited three times to provide the required translation. It chose, however, to rely on its arguments, even though the opposition division clearly emphasised that a translation was missing. Only in appeal proceedings a certified translation (D14) was filed. However, this document should have been filed in the opposition proceedings. The comment by the translator in the certified translation cast doubt on the correct translation of the name of the applicant. Therefore, the respondent commissioned its own certified translator, who came to a different conclusion, as apparent from D16. It was upon the appellant to

establish the correct translation.

Under Article 16(1) of the Rules of Procedure of the Boards of Appeal of the EPO, subject to Article 104(1) EPC, the board may, on request, order a different apportionment of costs. Under Article 104(1) EPC, each party must, as a rule, bear its own costs. However, a different apportionment of the costs incurred may be ordered for reasons of equity. Under the case law of the boards, this could be the case where facts and evidence are submitted at a late stage in the proceedings and the other party incurs considerably higher costs as a result.

In the current case, in opposition procedure, the appellant attempted to convince the opposition division of the correctness of the translation by providing D11. However, this attempt proved unsuccessful. Therefore, there was a need to provide further proof.

There was no evidence provided by the respondent, nor is it apparent, that higher costs due to the filing of the appellant's certified translation D14 in appeal proceedings have been incurred. As to the filing of D16, it lies within the discretion of the respondent to provide its own certified translation. If D14 had been filed during opposition proceedings, a similar amount of preparation or the filing of further documents, such as D16, would have been necessary.

Furthermore, the board cannot identify negligence or other circumstances that could amount to an abuse of procedure which could justify a different apportionment of costs.

There is therefore no reason to depart from the general

principle of Article 104(1) EPC that each party must bear its own costs.

5. Reimbursement of the appeal fee, Rule 103(1)(a) EPC

The appellant alleges a substantial procedural violation because the opposition division based its assessment on the differences in the second part of INID field 71 without communicating its intention in advance meaning that the appellant's right to be heard was violated (Article 113(1) EPC).

It was undisputed that INID field 71 was discussed during the oral proceedings before the department of first instance. There is no indication that the appellant had no opportunity to present its case on INID field 71.

The misinterpretation of INID field 71 by the opposition division thus constitutes an error of judgement but not an error of law (T 1031/12, point 2.3). Therefore, no procedural violation is apparent, let alone a substantial one.

The request to reimburse the appeal fee is thus refused.

6. Remittal to the department of first instance, Article 111(1) EPC

The revocation of the patent is based on the ground for opposition under Article 100(a) EPC in conjunction with Article 54(1) and (2) EPC. However, the decision assumes that the priority claim was invalid such that

the priority document, published shortly after its filing, was considered to anticipate the novelty of the patent in suit.

Furthermore, the decision does not cover Article 100(a) EPC in view of the other documents cited by the opponent.

As expressed in Article 12(2) RPBA 2020, it is the primary object of the appeal proceedings to review the decision under appeal in a judicial manner.

It is therefore not the function of the board to consider and decide on Article 100(a) EPC in view of the cited documents for the first time in appeal proceedings.

Thus, in this case, special reasons within the meaning of Article 11 RPBA 2020 exist. In addition, both parties agreed to a remittal of the case.

The board therefore decided to remit the case to the opposition division.



## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated