

In G 4/19 the Enlarged Board of Appeal decided that a European patent application can be refused **under Art. 97(2) and 125 EPC** if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art pursuant to Art. 54(2) and (3) EPC. The Enlarged Board also held that the application can be refused on that legal basis, irrespective of whether it: a) was filed on the same date as; or b) is an earlier application or a divisional application (Art. 76(1) EPC) in respect of; or c) claims the same priority (Art. 88 EPC) as the European patent application leading to the European patent already granted (for details, see below chapter II.F.5.2).

The technical boards have several times considered the notion of the "same subject-matter". According to established case law, a mere (partial) overlap does not prejudice the grant of a patent (see T 587/98, OJ 2000, 497; T 877/06; T 1491/06; T 1391/07; T 2402/10; T 2461/10; T 1780/12; T 621/15, T 1252/16; different view in T 307/03). See in this chapter II.F.5.3. On the relevance of the scope of protection for the issue of double patenting, see e.g. T 1780/12 and T 2563/11.

## 5.2. Legal basis for the prohibition of double patenting

In G 1/05 (OJ 2008, 271) and G 1/06 (OJ 2008, 307) the Enlarged Board of Appeal dealt with the issue of compliance with Art. 76(1) EPC. In this context the Enlarged Board stated that it accepted that the principle of prohibition of double patenting existed on the basis that an applicant had **no legitimate interest** in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor. Therefore, the Enlarged Board found nothing objectionable in the established practice of the EPO that amendments to a divisional application were objected to and refused when the amended divisional application claimed the same subject-matter as a pending parent application or a granted parent patent.

Some technical boards have sought to identify the **legal basis** for this prohibition in the EPC and have suggested Art. 125 EPC (see T 2461/10 highlighting that the "legitimate interest" was one of the principles of procedural law generally recognised in the contracting states; see also T 2563/11; but see also T 307/03, OJ 2009, 422 and T 1423/07), or Art. 60 EPC (T 307/03; but see also T 1423/07 and T 2461/10). As noted in T 2461/10, the EPC only contains a provision relevant to the prohibition on double patenting in the context of European and national applications and patents (see Art. 139(3) EPC). Some of these decisions are summarised in this chapter II.F.5.3. In T 318/14 (OJ 2020, A104) questions concerning the legal basis for the prohibition of double patenting were referred to the Enlarged Board of Appeal.

In G 4/19 (OJ 2022, A24) the Enlarged Board of Appeal decided that a European patent application can be refused under Art. 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art pursuant to Art. 54(2) and (3) EPC. The Enlarged Board also held that the application can be refused on that legal basis, irrespective of whether it: a) was filed on the same date as; b) is an earlier application or a divisional application