

### 5.3. Different subject-matter and scope of protection; overlapping subject-matter

In G 4/19 (OJ 2022, A24) the Enlarged Board of Appeal noted that the definitions of "the same subject-matter" or "the same applicant" in the context of double patenting were not the subject of the referral before it.

In T 118/91 and T 80/98, care was taken to avoid any risk of double patenting by ensuring that the subject-matter of the divisional application differed from that of the parent application. In T 118/91, in particular, the board stated that it could find nothing to support the contention that features forming part of the subject-matter of the divisional application could not be the subject of a dependent claim in the parent application. The board agreed with the Guidelines that, as a general rule, one application may claim its own subject-matter in combination with that of the other application. This approach does not lead to "double patenting" in its normal sense. In this particular case, the board was satisfied that any danger of "double patenting" had been eliminated by extensive restriction of the claims in the divisional application.

In T 587/98 (OJ 2000, 497) the examining division, relying on the Guidelines prohibiting "conflicting" claims, had refused a European patent application, filed as a divisional application, on the grounds that its subject-matter overlapped with that of the parent application and that in the overlapping region the same subject-matter was claimed; as legal basis for the refusal it invoked Art. 125 EPC. The board held that Art. 125 EPC was not applicable to the case at issue since this article required "the absence of procedural provisions in the Convention" but the provisions governing divisional applications were self-contained and complete. In addition a prohibition of "conflicting" claims in the wide sense applied by the examining division would be a matter of substantive law rather than a matter of procedure. The board also found that there was no express or implicit provision in the EPC prohibiting the presence in a divisional application of an independent claim related to an independent claim in the parent application (or patent, if it had already been granted) in such a way that the "parent" claim included all the features of the "divisional" claim combined with an additional feature.

In T 307/03 (OJ 2009, 422) the board held that the principle of the prohibition of double patenting, namely that the inventor (or his successor in title) has a right to the grant of one and only one patent from the EPO for a particular invention as defined in a particular claim, can be deduced from Art. 60 EPC 1973. Once a patent had been granted, this right to a patent had been exhausted (for a different view, see T 1423/07). Furthermore, a double patenting objection can also be raised where the subject-matter of the granted claim is encompassed by the subject-matter of the claim later put forward, that is where the applicant is seeking to re-patent the subject-matter of the already granted patent claim, and in addition to obtain patent protection for the other subject-matter not claimed in the already granted patent. In particular, where the subject-matter which would be double patented is the preferred way of carrying out the invention both of the granted patent and of the pending application under consideration, the extent of double patenting cannot be ignored as de minimis. See however T 1391/07 and T 2402/10 (both summarised below). In T 1252/16 the board noted that, contrary to the view adopted in T 307/03, according to established case law, any prohibition of double patenting only applied to the "same