

subject-matter" and did not extend to claims that conferred a scope of protection overlapping each other only partially (citing T 2461/10).

In T 1391/07 the board noted that the practice of prohibition of "double patenting" was confined to patents and applications relating to the same invention as defined by the subject-matter of the corresponding claims and therefore confined to claims conferring notionally the same **scope of protection**. It saw no basis for extending this practice to cover claims not defining the same subject-matter but conferring – as in the case before it – a scope of protection overlapping with each other only partially in the sense that some, but not all of the embodiments notionally encompassed by one of the claims would also be encompassed by the other one of the claims. In particular, the lack of legitimate interest of an applicant in obtaining two patents for the same subject-matter – as invoked by the Enlarged Board of Appeal in decisions G 1/05 (OJ 2008, 271) and G 1/06 (OJ 2008, 307) – cannot be invoked when the scopes of protection conferred by the respective subject-matters **overlap only partially** with each other as there is no manifest objective reason to deny the legitimate interest of the applicant in obtaining a protection different from – although partially overlapping with – that of the parent patent already granted. Accordingly, the board concluded that the mere fact that the scope of protection notionally conferred by the claim in suit would partially overlap with that of the granted parent patent did not prejudice the grant of a patent (see also T 587/98, OJ 2000, 497; T 877/06; T 1491/06; T 1780/12; T 2461/10; T 2563/11).

In T 2402/10 the respondent raised an objection of double patenting, since claim 1 had been amended during the opposition/appeal proceedings in such a manner that its scope fully **encompassed** the scope of the claims of the patent granted from the grand parent application. The board recalled the well-established case law that a 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" (G 1/05, OJ 2008, 271; G 1/06, OJ 2008, 307; see also T 1391/07, T 877/06, T 1708/06, T 469/03). In the case at issue, claim 1 contained technical features not required by any claim of the patent granted from the grant parent application. Since the patent granted from the parent application and the patent in suit claimed different subject-matter, the question of double patenting could not arise. The board noted that the respondent also referred to the headnote of T 307/03, according to which a double patenting objection could also be raised where subject-matter of the granted claim was encompassed by the subject-matter of the claim later put forward. The board, however, saw this as no reason to depart from the mandatory requirement of "same subject-matter" invoked in decisions G 1/05 and G 1/06 and in the established case law. See also T 1155/11.

In T 1766/13 the board held that, with respect to the case at issue, a product and a method for its manufacture were not "the same subject-matter" in the sense of G 1/05 and G 1/06. According to T 1765/13, the same was true for the use of a product and a method of fabricating it. For a further case where parent application and divisional application did not relate to the same subject-matter, see T 1708/06.

In T 1780/12 the board held that the category of a claim and its technical features constituted its subject-matter and determined the protection conferred (see G 2/88,