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**Datasheet for the decision
of 06 May 2011**

Case Number: T 0263/09 - 3.2.05

Application Number: 02737004.8

Publication Number: 1387769

IPC: B41M5/00

Language of the proceedings: EN

Title of invention:

INK JET RECORDING MEDIUM COMPRISING AMINE-TREATED SILICA

Patentee:

CABOT CORPORATION

Opponent:

Evonik Degussa GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 54

Keyword:

"Novelty - no"

Decisions cited:

Catchword:

-



Case Number: T0263/09 - 3.2.05

D E C I S I O N
of the Technical Board of Appeal 3.2.05
of 06 May 2011

Appellant:
(Opponent)

Evonik Degussa GmbH
Intellectual Property
Rodenbacher Chaussee 4
D-63457 Hanau (DE)

Respondent:
(Patent Proprietor)

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Representative:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 18 November 2008
rejecting the opposition filed against European
patent No. 1387769 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman: W. Zellhuber
Members: S. Bridge
E. Lachacinski

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division rejecting the opposition filed against the European patent No. 1 387 769.
- II. The appellant requested that the decision under appeal be set aside and that the patent in suit be revoked.

With a letter dated 27 November 2009, the respondent (patent proprietor) announced that it is no longer interested in the patent and will thus not respond to any further communications.

- III. With a communication of 2 December 2010 the parties were informed of the Board's provisional opinion that the decision under appeal was liable to be set aside and the patent revoked. In particular, the parties attention was drawn to the question of the lack of novelty of the subject-matter of claim 45 with respect to the method disclosed in the context of example 1 of document E5.
- IV. Independent claims 1 and 45 of the patent as granted read as follows:

"1. An ink jet recording medium comprising a flexible substrate and a coating composition coated on at least one surface of the substrate, wherein the coating composition comprises the product formed from the contact between fumed silica particles and at least one aminoorganosiloxane in an amount of 0.05-3% by weight of the fumed silica."

"45. A method of preparing a dispersion useful in preparing an ink jet recording medium of claim 1, comprising

(a) mixing fumed silica particles with an aqueous vehicle under high shear conditions to form a mixture of fumed silica, such that the mixture does not coagulate, and

(b) adding at least one aminoorganosiloxane in an amount of 0.05-3% by weight of the fumed silica to the mixture of (a), so as to form a dispersion of the product formed from the contact between the fumed silica particles and the at least one aminoorganosiloxane."

V. The following documents are referred to in the present decision:

E4: US-A-4,618,556

E5: US-A-4,816,366

VI. In the written procedure, the appellant inter alia agreed to the analysis of the provisional opinion of the Board that the subject-matter of claim 45 of the patent in suit was not new in view of document E5.

VII. The respondent did not provide any arguments during the appeal proceedings.

Reasons for the Decision

1. Objection of lack of novelty, Article 54 EPC

1.1 Document E5 (Example 1: column 17, line 65 to column 18, line 22) discloses a method of preparing a dispersion, comprising combining:

- (a) mixing fumed silica particles ("*10g of colloidal silica (#200, mfd. by Nihon Aerosil K.K.)*") with an aqueous vehicle ("*ion exchange water*") under high shear conditions ("*at 10,000 rpm (peripheral speed of about 13 m/sec) by means of an TK-homomixer*") to form a mixture of fumed silica, such that the mixture does not coagulate, and
- (b) adding at least one aminoorganosiloxane ("*0.3g of gamma-aminopropyltriethoxysilane*") in an amount of $0.3g \times 100\% / 10g = 3\%$ by weight of the fumed silica to the mixture of (a), so as to form a dispersion of the product formed from the contact between the fumed silica particles and the at least one aminoorganosiloxane.

"*Aerosil 200*" is a known fumed silica product (document E4, column 7, lines 36 to 45). Its dispersion "*at 10,000 rpm (peripheral speed of about 13m/sec) by means of an TK-homomixer*" (document E5, column 17, line 65 to column 18, line 4) corresponds to "*high*" shear conditions so that the mixture does not coagulate as such coagulation would appear to be incompatible with the stated purpose of obtaining a "*prepared colloidal silica in a dispersion state*" (document E5, column 18, lines 12 to 14).

In addition, the subjective value judgement "*useful in preparing an ink jet recording medium of claim 1*" does not as such imply any additional technical features of the claimed method.

In consequence, the method of preparing a dispersion according to claim 45 of the patent as granted is not new with respect to the method disclosed in the context of example 1 of document E5.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside
2. The patent is revoked.

The Registrar:

The Chairman:

D. Meyfarth

W. Zellhuber