

O-317-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 2515448  
IN THE NAME OF ALEXANDER CHARLES HODGETTS  
OF THE TRADE MARK**

**TILEBACKER**

**IN CLASS 19**

**AND**

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO 84652**

**BY  
BPB UNITED KINGDOM LIMITED**

## Background and pleadings

1. TILEBACKER is a trade mark registration standing in the name of Alexander Charles Hodgetts. It was applied for on 11 May 2009 and completed its registration procedure on 14 October 2011. TILEBACKER is registered for the following goods in class 19:

*Rubber coated tiles for dampening the sounds of footsteps; wall and floor panels made of stoneware or natural stone; wall and floor tiles; expansion joints.*

2. BPB United Kingdom Limited (“the applicant”) filed an application on 21 January 2013 to have the trade mark declared invalid. The applicant claims that TILEBACKER offends sections 3(1)(a), (b), (c) and (d) of the Act. These state:

“3.— (1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practice of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

3. The applicant’s claim under Section 3(1)(a) of the Act is that TILEBACKER is incapable of distinguishing Mr Hodgetts’ goods from those of other undertakings. The claims under sections 3(1)(b) and (c) are identical:

“It [the trade mark] comprises the word TILE (being a noun meaning a flat thin slab of fired clay, rubber, linoleum, etc, usually square or rectangular and sometimes ornamental, used with others to cover a roof, floor, wall etc) conjoined with the word BACKER (being a noun meaning something that furnishes something else with a back and or provides the function of a backing). Therefore the mark TILEBACKER simply conveys the intended purpose or use of the goods, namely a backing for tiles that either supports the tiles or sits between the front surface of a roof, floor, wall etc and the rear face of the tile(s). The goods covered by the registration are all goods which could act as backers for tiles:

- *Rubber coated tiles for dampening the sounds of footsteps* – such rubber coated tiles could sit between the front surface of a floor and the rear face of a top layer of tiles to provide a backing for the top layer;
- *wall and floor panels made of stoneware or natural stone* - such panels could support the tiles or could sit between the front surface of a roof, floor, wall etc and the rear face of a layer of tiles to provide a backing for the tiles;
- *wall and floor tiles* – such tiles could sit between the front surface of a roof, floor, wall etc and the rear face of a top layer of tiles to provide a backing for the top layer;
- *expansion joints* – such joints could sit between the front surface of a roof, floor, wall etc and the rear face of a layer of tiles to back the top layer.”

4. The claim under section 3(1)(d) is that TILEBACKER or TILE BACKER was widely used in the building trade prior to 11 May 2009 to describe a backing that can be positioned between the surface of a roof, floor, wall etc, on which tiles are to be provided, and the rear face of tiles.

5. Mr Hodgetts filed a counterstatement, denying the grounds and stating that it is not the function of the goods to act as a backing for tiles (wall, floor or roof); and that it is not customary in the trade or trade practice, or even practical, to use the goods for the use claimed by the applicant. Mr Hodgetts supplied a full counterstatement which I will not summarise here, but I will keep in mind its contents in reaching a decision.

6. Both parties filed evidence and written submissions. The matter then came to be heard before me on 7 July 2014. The applicant was represented by Mr Huw Evans, of Chapman Molony, who appeared in Newport. Mr Hodgetts attended by video conference. The submissions made in writing and during the hearing have been fully considered in reaching this decision and will be referred to as and when appropriate.

## **EVIDENCE**

7. The applicant’s evidence takes the form of witness statements from Huw Evans, Bruce Hazell, Martin Burrowes and Jonathan Cherry. Mr Hodgetts' evidence is from himself. This summary addresses the key points but is not an exhaustive list of all the information contained in the various witness statements (which I have borne in mind in reaching my decision).

### Huw Evans

8. Mr Evans is the applicant’s trade mark attorney. He states that he has been a representative of the applicant and the group of companies to which it belongs, Saint Gobain, since 2004. The Saint Gobain group, and the applicant, are in the building trade. Mr Evans states that his instructions come from Ms Sedella Hearson, Intellectual Property Coordinator, at Saint Gobain’s gypsum activity division. In relation to Mr Hodgetts' defence that wall and floor tiles would not be used as an intermediate substrate layer or provide the function of a tile backer, Mr Evans states

that this was discussed with Ms Hearson. She informed Mr Evans that the term tile backer has been the established term in the trade (for immediate substrates for laying between a floor or wall and a layer of tiles) for many years prior to the date of application, although she provided no evidence herself. Mr Evans' statement, in this respect, is hearsay. Mr Evans states that Ms Hearson, at the time of his statement (16 June 2013) was endeavouring to obtain further witness statements to corroborate this but that the person coordinating the matter with other companies in the group was off work due to illness; hence, Mr Evans has exhibited internet results from his own research. These are:

- A print from the website "oxforddictionaries.com" providing a definition of the word 'tile' (this formed the basis for the definition in the pleadings);
- An extract from "thefreedictionary.com" website and another from the 1971 version of the Compact Edition of the Oxford English Dictionary, providing definitions for the word 'backer'. One of the definitions is material used for backing;
- Exhibit HE4 contains the unexpanded results of internet searches which Mr Evans carried out for the terms "tilebacker" and "tile backer", limited to UK websites prior to 10 May 2009. Mr Evans states that the searches revealed 96 and 162 hits respectively;
- Exhibit HE5 contains brochures, data sheets and other documents which Mr Evans located by clicking on some of the hits listed in exhibit HE4. He states that the documents either bear dates or contain copyright notice dates prior to 10 May 2009 and that they all mention tilebacker(s). A selection is shown below in which I can see dates (which is not the case with all the documents in the exhibit):

## 1 Description

1.1 No More Ply Tile Backer Boards are fibre-reinforced cement sheets available in the sizes and nominal characteristics given in Table 1.

Table 1 Nominal dimensions and characteristics

Product	No More Ply (6 mm)	No More Ply (9 mm)
Colour	Grey	Grey
Thickness (mm)	6 (±5%)	9 (±5%)
Width (m)	600	900
length (m)	1200	1200
Max board weight (kg)	6.5	14.5
Bending strength <sup>(1)</sup> (dry) (MPa)		
longitudinal	≥ 17	≥ 10
transverse	≥ 15	≥ 9

(1) Based on results of BBA tests carried out in accordance with BS EN 12467 : 2004.

1.2 The products are manufactured by a batch blending operation, followed by the Hatchek process and high-pressure steam autoclaving. Quality control is maintained over raw materials, during processing and on the final product.

1.3 Ancillary materials for use with the products include:

- No More Ply self-drilling screws – available in 25 mm and 38 mm sizes with a 7.5 mm diameter countersunk head
- No More Ply Megastrength adhesive – a one-component polyurethane adhesive for use when fixing No More Ply backer boards to timber floors, available in 310 ml tubes
- No More Ply SBR primer available in 1 litre and 5 litre packs
- waterproof ceramic tile adhesives to BS EN 12004 : 2001
- waterproof grout to BS EN 13888 : 2002.

## 2 Delivery and site handling

2.1 The boards are delivered on wrapped pallets holding up to 170 (6 mm thick) boards and 100 (9 mm thick) boards with a maximum pallet weight of 1200 kg. The boards can be offloaded either by mechanical handling equipment or manually removing individual boards.

2.2 The sheets should be stored flat, under cover, and on a dry, level surface ensuring that loose boards are stacked in a stable manner and not exceeding 1 m in height.

2.3 Each sheet is marked with the trade name 'No More Ply'.

2.4 The boards include crystalline silica and reference should be made to EH40/2002 *Occupational Exposure Limits*, 2002. In particular, when cutting, drilling or sanding in confined areas, dust levels should be controlled using suitable extraction equipment.

2.5 No More Ply Megastrength adhesive and No More Ply SBR Primer must be stored under dry conditions and protected from frost and high temperatures. The manufacturer's Material Safety Data Sheets should be consulted to ensure the safe use of the products.

## Assessment and Technical Investigations

The following is a summary of the assessment and technical investigations carried out on No More Ply Tile Backer Boards.

## Design Considerations

### 3 Use

3.1 No More Ply Tile Backer Boards are satisfactory for use on walls and floors as an intermediate substrate to ceramic and natural stone tiling for internal use.

3.2 They are suitable as part of a system comprising tiles, waterproof tile adhesive and grout, to form a stable, water-resistant tile substrate in showers, bathrooms and wet areas (excluding shower floors).

3.3 Walls and subfloors to be tiled should comply with the requirements of BS 5385-1 : 1995 and BS 5385-3 : 2007 respectively, including the provision of movement joints as appropriate. Where necessary, reference should also be made to BS 5385-4 : 1992.



The exhibit shown above has a copyright date of 2008. The one below is dated July 2005.



CUSPB  
 | Y3 |  
 July 2005

**The Choice of the Professional**

**PRODUCT INFORMATION 1 • 2**

**BAL-WALL GREEN STAR**

**DESCRIPTION**

A white, ready-mixed ceramic wall tile adhesive suitable for use in interior dry and intermittently wet service conditions.

**STANDARDS**

BAL-WALL GREEN STAR exceeds the requirements of BS EN 12004 Adhesives for tile definitions and specifications for a C2 adhesive.

**APPLICATIONS & PERFORMANCE**

PRODUCT	USE & SERVICE CONDITIONS										
	Walls	Floors	Wet	Dry	Interior	Domestic Showers (2)	Communal Showers	Exterior	Swimming Pools	Worktops	
BAL-WALL GREEN STAR	✓	-	✓ (1)	✓	✓	✓	-	-	-	-	
SURFACE WALLS											
	Rendering	Dense Brickwork/Concrete	Clay Brick/Medium Density Concrete (3)	Lightweight Blockwork	Sheets & Boards (4),(5)	Tile Backer Boards	Plasterboard (5)	Plaster (5)	Glazed Tile & Brick	Painted Surface	
BAL-WALL GREEN STAR	✓	-	✓	-	✓	✓	✓	✓	✓	✓	
TECHNICAL DATA											
Typical Results at 20°C											
	Bed-Thickness	Application	Coverage	Open Time	Setting Time	Temperature Resistance	14 Days in Dry Conditions(kN)		Shelf-Life/Storage		
BAL-WALL GREEN STAR	3mm	Notched trowel (dry areas) Solid-bed trowel (intermittently wet areas)	Depends on flatness of surface & notched trowel used: dry areas from 1.4kg/sq.m., wet areas from 2.9kg/sq.m.	25 mins	24 hours (6)	-30°C - 100°C (7)	Typical Value 3.04	BS 5980 Min 0.95	Typical Value 19.2	BS 5980 Min 8.9	12 months in normal, dry conditions (ideally 5°C - 32°C). If affected by colder temperatures, placing in warmer temperatures & stirring should reconstitute product. Protect from frost.

- (1) Intermittently wet areas only.
- (2) Do not use shower for at least 2 weeks following completion of grouting - BS 5385 : Part 4:1992, clauses 6.3(f) and 6.4(h).
- (3) Provided surface is sufficiently flat.
- (4) Check suitability of sheets/boards for the intended purpose with the manufacturer.

- (5) For water sensitive backgrounds in domestic showers tank out with WP1 Tanking System.
- (6) The drying time will be extended in colder temperatures, when fixing to impervious backgrounds.
- (7) Cured adhesive.

**SURFACE CONSIDERATIONS**

**NEW CONCRETE/BRICK/BLOCK WALLING:** Before rendering/plastering/tiling allow walls to dry out by exposure to air for at least 6 weeks. Direct fixing to brickwork or concrete may be carried out, providing the surface is sufficiently flat. However, direct fixing to blockwork is not recommended.

**NEW CEMENT/SAND RENDERING.** Before commencing tiling, allow new rendering to dry out by exposure to air for at least 2 weeks or for rendering based on BAL-QUICKSET CEMENT, 24 hours.

**PLYWOOD/CHIPBOARD/FIBRE-REINFORCED CEMENT SHEETS:** Sheet/boards must be dry, securely fixed and rigid, e.g. screwed to a seasoned timber framework at 300mm centres vertically and horizontally. Moisture resistant or exterior grade boards should be used. Seal the reverse side and edges with BAL-BOND SBR to prevent distortion from atmospheric changes. Do not seal or prime surfaces to be tiled. Check suitability of sheets/boards for the intended application with the manufacturer.

**GYPSUM PLASTERBOARD BACKGROUNDS:** Ensure that boards are dry, securely fixed and rigid with no protruding fixings and the face intended to receive the decorative finish is exposed.

**NEW GYPSUM PLASTER:** Before commencing tiling, ensure that the plaster has been allowed to dry out by exposure to air for at least 4 weeks. Ensure that the finish coat has been applied and that the plaster is free from dust, efflorescence and friable material. Cut back any defective areas, including badly cracked plaster, to straight horizontal and vertical edges. Thoroughly dry brush background and edges and make good with plaster or a suitable non-shrinking filler. Plaster having a shiny, polished surface should be thoroughly brushed with a stiff bristled brush, followed by priming with a 1:4 BAL-BOND SBR:water mix or a 1:1 BAL-PRIME APD:water mix. Allow the primer to dry.

**FIBRE MESH REINFORCED CEMENT FACED TILE BACKER BOARDS:** Ensure that boards are dry, securely fixed and rigid and that any fixings do not protrude. Do not seal or prime surfaces to be tiled.



#### Backgrounds and bases

A cement-sand render or screed substrate is generally recommended for backgrounds and bases in which deviations from a true flat surface are to be expected and which may be too much to accommodate within the thickness of the bedding material. The more accurate surfaces that can be provided by such substrates permit the use of adhesive bedding, which has many advantages over traditional mortar bedding. Mosaics generally require flatness but not a high degree of dimensional accuracy; tiling requires both. The visual success of tiling depends on constant tile and joint sizes. .

Although internal wall tiling can be successfully applied to plaster or plasterboard surfaces, cement: sand rendering provides a stronger background and is preferred. For advice on mix proportions and thickness of rendering see BS 5385-1 clause 3.3, BS 5385-2 clause 19 and NBS Section M20. For screeds see BS 5385-3 Appendix C, BS 8204-1 and NBS Sections M10 and M13.

#### Proprietary intermediate substrates – tilebacker boards and matting

The use of intermediate substrates between backgrounds/bases and tiles is widespread in continental Europe and North America. In recent years products have been introduced in the UK, some of which have British Board of Agreement (BBA) certification. Two basic types of product are available, tilebacker boards and mattings.

Tilebacker boards have rigid cores (usually extruded polystyrene, or less frequently, cementitious material) and are faced with mortar/adhesive tolerant material reinforced with glass fibre mesh. All types of board provide a durable, flat and stable backing for tiling and are suitable for fixing boards to walls and floors.

Matting made from polyethylene with an underside bonding fleece provides a layer that accommodates background/base movement without affecting tiles and bedding. Installed with sealed joints it can provide a waterproof layer for applications not exposed to constant water pressure. Matting can prepare new concrete or screed bases for tiling once they can accept foot traffic. However, adhesives suitable for bonding matting to green concrete and screed are very limited, with most negating the time saving aspects of the product by requiring curing and drying of the base in accordance with BS 8204-1. Once installed air channels on the underside of the matting allow the base to continue drying. Matting can also be used on timber boarded suspended floors. It is essential to consult the matting and adhesive manufacturers to determine the correct base preparation, adhesive and jointing specification.

PORCELANOSA



May 05 [www.porcelanosa.co.uk](http://www.porcelanosa.co.uk) technical and samples hotline t: 08702 240245

This exhibit is from May 2005.

## Bruce Hazell

9. Mr Hazell is a partner in Trimline, which is a supplier of tiling materials, tools and accessories. He states that the term TILEBACKER was widely used in the tiling trade prior to 11 May 2009 to describe an intermediate substrate layer between a floor or wall and a layer of tiles, being available in a wide range of materials. Mr Hazell states that his company has produced a tilebacker board since 2001, under the mark DUKKABOARD. Exhibits BH1 and BH2 consist of his company's 2009<sup>1</sup> DUKKABOARD brochure and his company's current Tile Backer Board & Waterproofing brochure. The 2009 brochure is marked as "1/09", suggesting it was the first brochure issued during 2009. Page 3 of the 2009 brochure mentions tile backerboards. Mr Hazell states that his company's tile backer boards are made from a variety of materials, including rigid polystyrene and finished on both sides with a synthetic mortar, reinforced with a glass fibre reinforced cement sheets. He gives his opinion that rubber coated tiles for dampening the sounds of footsteps, wall and floor panels made of stoneware or natural stone, and wall and floor tiles are all items which are capable of being used as a tilebacker. Mr Hazell states that his company's tilebacker product could be considered as wall and floor panels made of natural stone, because they are made of cement, which comprises limestone.

10. Mr Hazell states that his company's tilebacker is suitable for use with all types of ceramic and natural stone. He says that a person seeing the term tilebacker used in relation to such goods and floor/wall tiles would just think that such goods are suitable for use with tilebackers.

11. Mr Hazell states that his company sells soundproof rubber matting for laying under tiles (and has done prior to 1999) and that it is perfectly conceivable that such matting could be provided as tiles.

## Martin Burrowes

12. Mr Burrowes is the Managing Director of Specialist Tiling Supplies Limited. Some of his witness statement is framed in similar terms to that of Mr Hazell. However, Mr Burrowes also gives information specific to his company's products. He states that his company has produced a tilebacker board since 2004, sold under the mark NO MORE PLY (as in the example shown in paragraph 8 of this decision). About £25,000 of this product was sold each month prior to 10 May 2009. The products are fibre-reinforced cement sheets for lining floors and walls prior to tiling: the tiles are laid directly onto the sheets. Exhibit MB1 is a certificate dated 1 August 2008, issued to Mr Burrowes' company by the British Board of Agrément (BBA) for the NO MORE PLY product:

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<sup>1</sup> Mr Hazell refers to the brochure as dating from 1999, but the exhibit bears a copyright date of 2009.



## Specialist Tiling Supplies

Unit 5  
Wortley Trading Estate  
Wortley Moor Lane  
Leeds  
West Yorkshire LS12 4HX  
Tel: 0113 2022010 Fax: 0113 2022015  
e-mail: info@specialisttilingsupplies.com



Agrément Certificate  
**08/4575**  
Product Sheet 1

### SPECIALIST TILING SUPPLIES NO MORE PLY TILE BACKER BOARDS

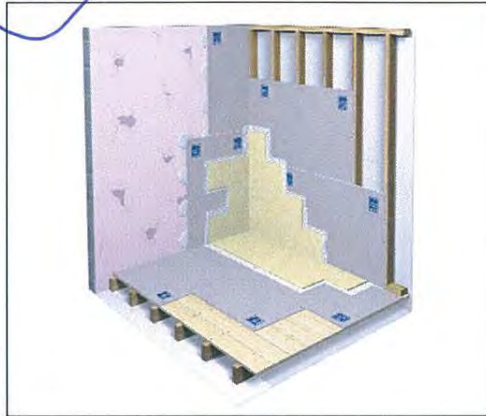
### NO MORE PLY TILE BACKER BOARDS

#### PRODUCT SCOPE AND SUMMARY OF CERTIFICATE

This Certificate relates to No More Ply Tile Backer Boards for use as intermediate substrates for the internal application of ceramic and natural stone tiles.

#### AGRÉMENT CERTIFICATION INCLUDES:

- factors relating to compliance with Building Regulations where applicable
- factors relating to additional non-regulatory information where applicable
- independently verified technical specification
- assessment criteria and technical investigations
- design considerations
- installation guidance
- regular surveillance of production
- formal three-yearly review.



#### KEY FACTORS ASSESSED

**Properties in relation to fire** — the products do not change the fire resistance of the wall on which they are installed (see section 5).

**Resistance to mechanical damage** — the products will accept the normal impacts likely to occur in service (see section 6).

**Durability** — the products have acceptable durability and will have a service life equal to that of the structure onto which they are fixed (see section 9).

The BBA has awarded this Agrément Certificate to the company named above for the products described herein. These products have been assessed by the BBA as being fit for their intended use provided they are installed, used and maintained as set out in this Certificate.

On behalf of the British Board of Agrément

Date of First issue: 1 August 2008

Simon Wroe  
Head of Approvals — Materials

Greg Cooper  
Chief Executive

*The BBA is a UKAS accredited certification body — Number 113. The schedule of the current scope of accreditation for product certification is available in pdf format via the UKAS link on the BBA website at [www.bbacerts.co.uk](http://www.bbacerts.co.uk)*

*Readers are advised to check the validity and latest issue number of this Agrément Certificate by either referring to the BBA website or contacting the BBA direct.*

British Board of Agrément  
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website: [www.bbacerts.co.uk](http://www.bbacerts.co.uk)

13. Mr Burrowes gives a similar opinion to that of Mr Hazell in respect of Mr Hodgetts' goods being capable of being used as a tilebacker, and that his own company's product could be considered to be wall and floor panels of natural stone because cement includes limestone. Further, Mr Burrowes states that wall and floor panels made of gypsum, a natural stone, were widely available prior to 11 May 2009. He says that the fact that some of the items might not be currently used as tilebackers is irrelevant. Mr Burrowes gives his opinion that rubber coated tiles for dampening the sounds of footsteps, wall and floor panels made of stoneware or natural stone, wall and floor tiles, and expansion joints are all items which could be used in conjunction with tilebackers.

#### Jonathan Cherry

14. Mr Cherry has been head of Product Management at British Gypsum since 2010. His company is one of the UK's major suppliers of building materials, including plasterboards and plasters used in the construction of partitions and ceilings in bathrooms and kitchens where they are used as a substrate for the adhesion of ceramic and other tiles. Mr Cherry states that, prior to 2009, tilebacker was a term widely used in the tiling trade to describe an intermediate substrate layer between a floor or wall and a layer of tiles. They were available in a wide range of materials, including materials made from cement and gypsum, a kind of natural stone. The remainder of his statement follows a similar line to that taken by Messrs Hazell and Burrowes.

#### Alexander Hodgetts

15. Mr Hodgetts' evidence is given from the position that none of the goods in his specification are intermediate substrate products or tilebackers. Mr Hodgetts states that he is a Master Tiler with many years' experience and is currently engaged in designing and manufacturing wet room drainage products.

16. Mr Hodgetts refers to his trade mark application resulting in an *ex parte* hearing before the Registrar before the application could be accepted. Mr Hodgetts exhibits the Hearing Officer's note of the hearing. The original specification of goods was reduced by the Hearing Officer to that which proceeded to registration (and which is the subject of the present invalidation action) on the basis that the remaining goods did not describe backers/backing for tiles.

17. Mr Hodgetts states that there is a distinction between a proprietary intermediate substrate, other tileable backgrounds and bases and the top decorative or functional surface, whether this is rubber coated tiles for dampening the sound of footsteps; wall and floor panels made of stoneware or natural stone; or wall and floor tiles. Mr Hodgetts refers to exhibit HE5 of the applicant's evidence, specifically the Porcelanosa prints, which give information about the differences. He states that the applicant claims changeability between intermediate substrates and his products, which sit on top of an intermediate substrate, providing a decorative and/or practical surface. He states that there is no evidence that his goods would actually function as a backing for tiles.

18. Mr Hodgetts refers to the evidence of Messrs Hazell and Burrowes and states that their intermediate substrate products (Dukkaboard and No More Ply) contain Portland cement, crushed sand, calcium silicate and cellulose fibres that produce a resilient impact resistant board. He points out that Messrs Hazell and Burrowes consider that their cement coloured intermediate substrate products could be considered as wall and floor panels made of natural stone, and that they imply that their products could be used as a top decorative and practical finish, without any evidence. Mr Hodgetts exhibits hearsay evidence<sup>2</sup> in the form of emails from Gareth Kennedy, Technical Sales Representative of James Hardy Building Products Ltd, who gives his opinion that Dukkaboard and No More Ply are just tilebacker boards.

19. Mr Hodgetts explains that *rubber coated tiles for dampening footsteps* is a composite product, consisting of a floor tile with an acoustic grade of rubber bonded to the rear surface of the tile. The product is delivered to the user as a complete unit and loose laid on the prepared floor substrate/intermediate substrate. Mr Hodgetts refers to pages 6 and 7 of his evidence which he states shows that such a product would not be an intermediate substrate and clearly would not function as a backing for tiles:

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<sup>2</sup> ACH page 5.

## Packaging

1 Pallet = 30 Square Meters

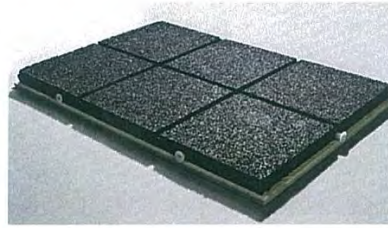
Plastic Dowels - 1M<sup>2</sup> / 2M<sup>2</sup> / 5M<sup>2</sup> and 10M<sup>2</sup> Bags (included in price)

- Acoustic Guarantees
- Insulating Back
- Loose Lay System
- Easy to Install
- Highly Durable
- Frost Resistant
- Solar Reflective
- Free Drainage
- Choice of Colours
- Non Slip - Riven Finish
- Easy to Clean



## Acoustic Guarantees

The material has a decibel reduction of 21dB and therefore is excellent Acoustically.



## Insulated Back

The back of the Tile is Recycled Granulate Rubber and has good insulation properties.



## Loose Lay System

The system is installed loose laid.

*Please note when laying on uneven surfaces, such as felt etc please contact the Technical Department about our Packer System.*



20. Mr Hodgetts exhibits an extract from Mr Hazell's company's brochure showing a roll of rubber soundproof matting which is installed between the Dukkaboard and the substrate (the bare floor):



## Tile Backer Board & Waterproofing

### Acoustic-si

- Excellent sound-reduction product for reducing footfall noise
- A cocofibre and latex-based board offering up to 17dB reduction in impact sound transmission
- Suitable for use under ceramic, natural stone & timber floor coverings
- Only 6mm in height and can be fixed down with standard flexible tile adhesive
- Adhere with C2F grade adhesive
- For sound proofing in wet areas choose the Acoustic-ss matting

STOCK NO	THICKNESS MM	SIZE MM	PRICE EACH
5190	6	1000 x 600	17.93

For primer use the Aqua 77 Pro-Tile Primer on page 51



Adhesive for TL562 is the Python Flexible Adhesive - see page 181

### Rubber Soundproof Matting



- 3mm thick
- Up to 20dB impact sound reduction when used with 7mm laminate flooring
- Use 5220 adhesive - as listed below
- 5mm thick version available to special order

STOCK NO	ROLL WIDTH M	ROLL LENGTH M	PRICE EACH
5199	1	20	237.33

5mm thick version available to special order

### Perimeter Movement Strips

- Foam strip designed to absorb movement and decouple hard floor surfaces from surrounding walls
- Attached at skirting height and fixed prior to substrate preparation
- Can be used with acoustic matting for sound-reduction purposes

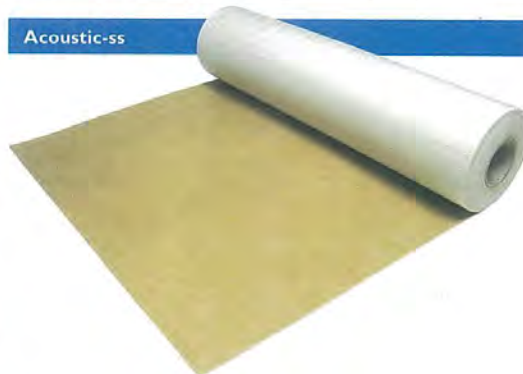


STOCK NO	THICKNESS MM	LENGTH M	ROLLS PER PACK	PRICE EACH
5195	5	50	15	17.01
5196	8	50	12	23.20
5197	10	25	12	29.17

### JM 400 Adhesive

STOCK NO	TYPE	SIZE L	PRICE EACH
5220	NEW JM 400	15	93.63

### Acoustic-ss



- A combined impact-soundproofing and decoupling matting suitable for use under hard floor coverings
- Specially bonded, made from polyester fleece and quartz sand
- Offers up to 17dB reduction in impact sound transmission as specified in Building Regulations Approved Document E for use on type 1 floors
- Only 3mm in height
- Adhere with VS90 Adhesive - see page 35
- When used in wet zones the top surface must be waterproofed with MIRA 4400 Multicoat

STOCK NO	ROLL WIDTH MM	ROLL LENGTH M	PRICE PER ROLL
5191	750	10	216.85

### Installation



Preparation of floor with primer



Applying polymer modified cement-based flexible tile adhesive, spreading with an 8mm notched trowel



Acoustic-si firmly bedded



Spreading polymer modified cement-based tile adhesive with an 8mm notched trowel on to Acoustic-si



Tiles are laid using polymer modified cement-based tile adhesive



Laminate or parquet flooring can be laid directly on to Acoustic-si

The purpose of this exhibit (page 8 of ACH) is to draw a distinction between Mr Hodgetts' prefabricated, finished top surface product, and intermediate substrates or backing for tiles. The page also shows movement strips which, acting as expansion joints, contribute to sound reduction. Mr Hodgetts also points to various pages in the

applicant's evidence showing movement joints, which he states support his point that they cannot be used to back tiles, because they sit on an intermediate substrate and are flush with the top of the tiles. To explain further the distinction between backing for tiles and tiles as a decorative layer, Mr Hodgetts says:

"... a tiling installation would have a top surface of wall or floor tiles (item 1) which would be fixed with adhesive (item 2) and subject to specification or site conditions, to a tile backing board (intermediate substrate) (item 3) which is in turn fixed with adhesive (item 2) to the main construction substrate (which could be new or existing) (item 6) and an expansion joint (movement joint) may be incorporated (item 4) in conjunction with a sound proofing rubber matting (item 5)."

The six items interrelate but are all separate and distinct products."

## **DECISION**

### **Material dates**

21. Section 72 of the Act states:

"In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it."

Section 47(1) of the Trade Marks Act 1994 ("the Act"). Section 47(1) states:

"The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection 1(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered."<sup>3</sup>

22. The date of application for the trade mark was 11 May 2009. Under section 47(1), the question of whether the mark was registered in breach of section 3(1)(a), (b), (c) and (d) falls to be decided as of this date. Mr Hodgetts has not relied upon the proviso to section 47(1) to show that the mark has acquired distinctiveness through the use which has been made of it, and has not filed any evidence of use of his mark. This means I can only consider the *prima facie* case, not whether the mark has acquired distinctiveness as a result of the use made of it.

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<sup>3</sup> "The proviso".

## Section 3(1)(a)

23. This section states:

“3.— (1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),”.

24. Section 1(1) states:

“1.—(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

25. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch), Arnold J said:

“44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4 , the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:

"80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark* [2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*,

paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that "the goods or services" referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argued. Rather, the question under Article 4 is whether the sign is capable of distinguishing any goods or services."

26. Article 4 of Regulation 207/2009 of 26 February 2009 on the Community trade mark (codified version) is the equivalent to section 1(1) of the Act, set out above. TILEBACKER is not incapable of distinguishing any goods and services. It follows from this authority that the ground of opposition under section 3(1)(a) must fail.

#### **27. The ground under section 3(1)(a) fails.**

28. It is well established in law that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between sections 3(1)(b), (c) and (d) of the Act: see *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57, the Court of Justice of the European Union ("CJEU"), paragraphs 67 to 70. That degree of overlap is reflected in the applicant's pleadings in which, effectively, descriptiveness (i.e. section 3(1)(c)) is given as a reason for lack of distinctive character under section 3(1)(b).

29. In relation to section 3(1)(b), the CJEU said in *SAT.1 Satellitenfernsehen GMBH v OHIM*, case C-329/02 P [2005] E.T.M.R. 20:

"23 First, the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, in particular, Case 102/77 *Hoffmann-La Roche* [1978] ECR 1139, paragraph 7, and Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 30). Article 7(1)(b) of the regulation is thus intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling that essential function.

24 Secondly, in order to determine whether a sign presents a characteristic such as to render it registrable as a trade mark, it is appropriate to take the viewpoint of the relevant public. Where the goods or services with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (see



Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26, and Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 46).

25 Thirdly, it is important to observe that each of the grounds for refusal to register listed in Art.7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] E.C.R. I-0000 , [45] and [46]).

....

27 Furthermore, in view of the extent of the protection afforded to a trade mark by the regulation, the public interest underlying Article 7(1)(b) of the regulation is, manifestly, indissociable from the essential function of a trade mark, as observed in paragraph 23 above.”

30. In relation to section 3(1)(c), the CJEU said in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*:

“54 As the Court has already held ( *Windsurfing Chiemsee* , para.[25], *Linde*, para.[73], and *Libertel* , para.[52]), Art.3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

55 That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Art.3(3) of the Directive applies.

56 In those circumstances, the competent authority must, under Art.3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect *Windsurfing Chiemsee* , para.[31]). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57 It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Art.3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs

or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

58 Similarly, whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small is not decisive. Any operator at present offering, as well as any operator who might in the future offer, goods or services which compete with those in respect of which registration is sought must be able freely to use the signs or indications which may serve to describe characteristics of its goods or services.”

31. Even if a mark is not descriptive for the goods for which the application has been made, it may still be non-distinctive for those goods if it cannot do the job of distinguishing the goods of one trader from another. If a mark is non-distinctive, it is objectionable under section 3(1)(b) of the Act. In *Combi Steam Trade Mark*<sup>4</sup>, Ms Anna Carboni, sitting as the Appointed Person, described section 3(1)(b) in the following way:

“7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd’s Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Case C-363/99 *Koninklijke KPN Nederland BV v Benelux-Merkenbureau* (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (ibid.).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: Joined Cases C-53/01 to C- 55/01 *Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 at [41].

9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: Case C-329/02P *SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, Case T-34/00 *Eurocool*

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<sup>4</sup> BL O/363/09.

*Logistik GmbH & Co. KG v OHIM* (“EUROCOOL”) [2003] ETMR 4 at [39]; Case T-128/01 *Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; Case T-320/03 *Citicorp v OHIM* (“LIVE RICHLY”) at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM* (“COMPANYLINE”) [2002] ECR I-7561 at [20].

10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive/7(1)(b) CTMR, which in the Court’s view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin: *SAT.1 v OHIM* at [23]; Case C-37/03 P *BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27].”

32. Where a mark is made up of two words which have been joined together, creating a new word (neologism), such a mark may still be objectionable if all the mark does is describe some characteristic(s) of the goods applied for, as per *Campina Melkunie BV and Benelux-Merkenbureau*, C-265/00 (CJEU):

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

33. I think the evidence of both sides in this dispute shows that, as of 11 May 2009, ‘tilebacker’, which is a conjoining of the word tile and backer, was in use in the trade to denote boards placed between a substrate (such as a bare floor) and the top decorative layer of tiles, which appear to be either made from cement or gypsum. I did not understand Mr Hodgetts to dispute this<sup>5</sup>. “Tile backer” seems to be a natural term to describe such goods, which are backers for tiles. Nothing extra is brought to the term tilebacker for these goods by the conjoining of tile and backer, so tilebacker describes goods which are backers for tiles. Although the term was in use as a trade term for a particular type of tiling product (the panels or boards), it seems to me to be an apt term to describe any goods which act as a backer or backing for tiles.

34. However, by the time Mr Hodgetts’ application had been objected to by the trade mark examiner and he had had an *ex parte* hearing, the specification as originally

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<sup>5</sup> Part of Mr Hodgetts’ counterstatement says “Wall and floor tiles would not be used as an intermediate substrate layer or provide the function of a tilebacker/tile backer or as a backing for a further layer of tiles or mosaic. Even the most humble DIY person...would know that a tilebacking board such as Wedi...and plywood would be the correct choice.”

filed had been restricted, the intention of which was to remove goods which corresponded to intermediate substrate boards – tilebackers. The question for me now is whether there are still goods which remain in the registered specification which could be used for such purposes (section 3(1)(c)) or whether even though the mark does not describe those goods the average consumer would nevertheless not regard the mark as a trade mark because the goods left in the specification are closely associated with tilebackers. The pleadings could have made a better job of identifying the difference between the enquiries under section 3(1)(b) and (c), which are separate, but it does not matter a great deal because, as can be seen from the caselaw cited above, there is a degree of overlap between them.

35. The evidence (from both sides) shows that, as in Mr Hodgetts' goods, one can buy tiles which are a composite product, already having a backing of rubber to dampen sound. The alternative solution is to use rubber matting as the backing and to lay tiles on top of the matting. The applicant submits that such rubber matting could be in the form of tiles, and so the mark describes Mr Hodgetts' *rubber coated tiles for dampening the sound of footsteps* because this term covers rubber coated tiles as an alternative to the rubber matting, for use as backing for decorative tiles. I agree; as these goods could function as tile backers, these goods are objectionable under section 3(1)(c) of the Act. For the same reason, *floor tiles*, which covers rubber floor tiles, is objectionable under section 3(1)(c).

36. With respect to *wall and floor panels made of stoneware or natural stone*, the evidence shows that some tilebacker boards are made of cement. I would not regard stoneware and natural stone as natural descriptors for cement, which is a composite product. However, there is evidence that there were goods in 2005 described as gypsum plasterboards: this term appears in the exhibit reproduced on page 6 of this decision, above “fibre mesh reinforced cement faced tile backer boards’ and ‘new gypsum plaster’. Gypsum is a stone. Consequently, panels of gypsum used as tile backers fall within the goods *wall and floor panels made of stoneware or natural stone* and so these goods are objectionable under section 3(1)(c) of the Act.

37. This leaves *wall tiles* and *expansion joints*. The consideration here is whether the mark is objectionable for these goods because they are closely allied to tile backers. Mr Geoffrey Hobbs QC, sitting as the Appointed Person, considered this in *The Range Cooker Co Plc v The Fourneaux De France Limited*, BL O/240/02. The mark in that case was FOURNEAUX DE FRANCE which translates into ‘cookers from France’. The mark was objectionable under section 3(1)(c) as describing cookers (from France)<sup>6</sup>. The issue was whether closely allied goods, which comprised cooker hoods and extractor fans, “should be treated as goods so closely related to cookers as to be an integral part of the commercial context in which the meaning and significance of the words FOURNEAUX DE FRANCE is to be regarded as essentially descriptive.” Mr Hobbs concluded that cooker hoods and extractor fans were items of commerce which were closely connected with cookers and that it would be unrealistic to treat FOURNEAUX DE FRANCE as descriptive of cookers and not of such closely connected goods.

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<sup>6</sup> The grounds of invalidity in that case were 3(1)(a), 3(1)(c) and 3(3)(b) of the Act. There was no section 3(1)(b) ground.

38. In BL O/218/02, Mr Hobbs, sitting as the Appointed Person, considered the mark “Tools and Middleware” to be devoid of any distinctive character (section 3(1)(b)) for a wide range of goods in class 9. The applicant had tried to overcome the examiner’s descriptiveness objection (3(1)(c)) to the mark by limiting the specification away from tools and middleware; tools describing a type of software, and middleware describing computer products which sit between hardware and software. Mr Hobbs considered that the mark was “an ordinary way of designating the general nature of the goods of interest to the Applicant and are not likely to trigger origin-specific perceptions and recollections in the mind of the average consumer of the goods concerned.”

39. In a decision for the Registrar<sup>7</sup>, Mr Allan James, the Hearing Officer, considered the mark COMPUTER BOOKSHOPS in classes 9, 16 and 41. The mark had been objected to by the examiner under sections 3(1)(b) and (c) of the Act on the basis that it described goods and services relating to a shop which sells books about computers. Mr James waived the objection raised under section 3(1)(c) but maintained that the objection under section 3(1)(b) was validly raised and that the mark was devoid of any distinctive character for the goods and services in the application. He observed that:

“... the Registrar has long been reluctant to register the name of one product as a trade mark for another product in a closely related sector of the market: see Portogram Radio Electrical Company Limited’s Application 69 RPC [1952] 241 at 245. I believe that it is self evident why the word “duvet”, for example, would not be able to function as a trade mark for bed sheets, or why the word “shirt” would not function as a trade mark for ties. In use in relation to such goods these signs would be, at best, ambiguous as to their meaning, and would probably just result in confusion. A similar point arose in a recent decision dated 2 May 2002 of Mr G Hobbs QC as Appointed Person in Fourneaux de France Limited v The Range Cooker Co. plc, SRIS 0-240-02.”

40. In my view, TILEBACKER, for goods which are closely allied to tile backers, such as wall tiles and expansion joints, falls into the same camp as DUVET for bed sheets and SHIRT for ties. Whilst not directly descriptive of tile backers, TILEBACKER for these goods would be ambiguous and confusing because there is insufficient clear blue water between goods for which the description is obvious and those which are closely allied to those goods. For this reason, the mark would not be able to do the job of identifying the commercial source of the goods and would not, therefore, perform the essential function of a trade mark which is to distinguish the applicant’s goods from those of other traders. **For wall tiles and expansion joints, TILEBACKER is objectionable under section 3(1)(b) of the Act.**

41. It follows from the fact that I have found the other goods to be objectionable under section 3(1)(c) of the Act that they are also objectionable under section 3(1)(b). I also consider them to be devoid of any distinctive character, and therefore objectionable under section 3(1)(b), for the same reason as I have just explained that wall tiles and expansion joints are objectionable under section 3(1)(b). So, all the

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<sup>7</sup> BL O/266/02.

goods of the application are objectionable under section 3(1)(b), independently of the section 3(1)(c) objection.

42. As the application for a declaration of invalidity has been successful under sections 3(1)(b) and (c) of the Act, for economy of process, there is no need to examine the ground raised under section 3(1)(d).

### **Outcome**

**43. The application for a declaration of invalidity succeeds. Accordingly, under section 47(6) the registration is deemed never to have been made.**

### **Costs**

44. The applicant has been successful and is entitled to an award as a contribution towards its costs. Mr Evans told me that he was content for the scale to apply, which is published in Tribunal Practice Notice 4/2007. Mr Hodgetts asked me to bear in mind that exhibit HE1, running to 23 pages, was entirely irrelevant. I have not included this exhibit in the evidence summary because, as Mr Hodgetts said, it was of no relevance or assistance in making this decision. Exhibit HE1 consisted of a report on the Saint Gobain group of companies. It did not shed any light on the term TILEBACKER. I will reduce the amount I award for evidence accordingly.

45. Mr Hodgetts also raised the fact that the applicant gave him no warning of its application, leaving no room for negotiations or discussion. This is regrettable; litigation should be a last resort. Unfortunately, once a defence has been filed, rather than the mark being surrendered and no defence being filed, lack of notice is not something which I can take into account in assessing the contribution to the costs of the proceedings in the Trade Mark Registry.

46. I make a reduced award for Mr Evans' attendance at the hearing, since his skeleton argument was late and his oral submissions were, in large part, a repeat of the applicant's written submissions dated 17 June 2013 and 6 December 2013.

47. I assess the costs payable to the applicant as follows:

Preparing a statement and considering Mr Hodgetts' statement	£250
Application fee	£200
Preparing evidence and considering Mr Hodgetts' evidence	£500
Attendance at a hearing	£150
<b>Total</b>	<b>£1100</b>

48. I order Alexander Charles Hodgetts to pay BPB United Kingdom Limited the sum of £1100. This sum is to be paid within seven days of the expiry of the appeal period

or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 21st day of July 2014**

**Judi Pike  
For the Registrar,  
the Comptroller-General**