

O/108/12

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

IN THE MATTER OF APPLICATION NOS 2442444, 2442447 AND 2459605 BY

WAPPLE.NET LIMITED

AND

THE CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS 95786, 95787 AND 95890 BY

APPLE INC

1) The substantive decision in these proceedings was issued on 1 February 2012. In that decision the following was decided in relation to costs:

“203) Mr Engelman submitted that AI should be awarded costs outwith the scale in relation to the requirement for AI to prove its reputation, which he considered perverse. However, AI claimed a reputation for all of the goods and services of its registrations; something that was not substantiated by any means. The request for proof of use by WN was clearly focused on what its business was and seeking to find if there was clear, blue water between what it was doing and what AI established in relation to use. The request for proof of use in relation to software can hardly be considered perverse taking into account the findings in *Galileo International Technology, LLC v European Union (formerly European Community)*. It is not considered that there is any basis for an award of costs to AI outwith the scale.

204) AI provided a large amount of evidence. The survey, the evidence of Mr Blackett, Mr Wood and Mr Harris were of no assistance. The evidence of Mr Zook was excessive; the sole effect of that evidence was to establish that private individuals and sole traders have websites, something that could have been established in one page. Large parts of the evidence of Mr La Perle were not directed to the issues in play in these proceedings and have the appearance of being a standard format used by AI in proceedings. AI did not comply with Tribunal Practice Notice 5/2008; it did not paginate the original evidence that it furnished and it then supplied bundles for the hearing, after the indices for the case had been sent out by the Intellectual Property Office. AI provided a large amount of evidence that was not pertinent to the proceedings or of no assistance. In the case of the evidence of Mr Blackett, AI took no notice of the judgment of the Court of Appeal in relation to the value of evidence he had supplied in *esure Insurance Limited v Direct Line Insurance Plc*. The furnishing of large amounts of evidence can be oppressive, even if it is not so intended; especially if the parties have unequal resources. The other party has to pay its legal representatives to consider the evidence.

205) Taking into account the nature of the evidence that AI provided, even if it had been successful in all three oppositions, an award of costs would have been made against it. It is considered to make an award of costs outwith the scale to WN. WN has four weeks from the date of the issue of this decision to give a breakdown of costs in relation to the consideration of the evidence of AI and solely in relation to this matter. A supplementary decision will then be made in relation to costs.”

2) On 27 February 2012 a complete breakdown of the costs of WN was received. This breakdown itemised the costs. The following entries in relation to the costs in relation to considering the evidence of AI are considered pertinent:

Date	Description	Amount £
5/10/09	<i>considering evidence filed by Apple and letter to client enclosing copies of evidence</i>	412.50
30/10/09	<i>with Anne Thomas and Nicholas James of client to discuss evidence from Apple</i>	275
15/03/11	<i>brief read through and review of Apples evidence in response.</i>	412.50
15/03/11	<i>with Anne briefly re Opponent's evidence and how to address it</i>	27.50
16/03/11	<i>reading evidence of Apple in preparation for client meeting</i>	275
17/03/11	<i>with Anne and new MD re Apple to discuss Apple's evidence and how it may affect Wapple's position</i>	412.50
31/10/11	<i>with Anne Thomas to discuss all the Opponent's evidence, the Hearing, cross examination of witnesses and attendance</i>	330
9/11/11	<i>considering Opponent's evidence and drafting Brief to Counsel to appear at Hearing</i>	275
21/11/11	<i>with Counsel to discuss evidence and how he wants the Brief and the Skeleton Argument and Hearing</i>	550
6/10/10	<i>Counsel's Fee for considering the Opponent's evidence and advising the Applicant on its evidence and generally</i>	705

The shaded entries cover evidence and other matters and 50% of the sums will be taken into account for costs. This gives rise to a total sum of £2,745

3) In considering the award of costs, it is taken into account that AI succeeded in relation to one opposition. Consequently, outwith the costs calculated above, the costs that are to be awarded to WN are reduced by one third.

Preparing statements and considering the statements of AI:	£400
Preparing evidence:	£1,000
Preparation for and attendance at hearing:	£1,000

4) Apple Inc is ordered to pay Wapple.net Limited the sum of £5,145. 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.

5) The period for appeal against the substantive decision runs concurrently with the period for appeal against this supplementary decision.

Dated this 9th day of March 2012

**David Landau
For the Registrar
the Comptroller-General**