



STATUTORY INSTRUMENTS.

**S.I. No. 530 of 2021**



**RULES OF THE SUPERIOR COURTS (INTELLECTUAL PROPERTY  
PROCEEDINGS) 2021**

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We, the Superior Courts Rules Committee, constituted pursuant to the provisions of the Courts of Justice Act 1936, section 67, and reconstituted pursuant to the provisions of the Courts of Justice Act 1953, section 15, by virtue of the powers conferred upon us by the Courts of Justice Act 1924, section 36, the Courts of Justice Act, 1936, section 68 (as applied by the Courts (Supplemental Provisions) Act 1961, section 48), the Courts (Supplemental Provisions) Act 1961, the European Communities (Rules of Court) Regulations 1972 (S.I. No. 320 of 1972) and of all other powers enabling us in this behalf, do hereby make the following Rules of Court.

Dated this 23rd day of June 2021.

Frank Clarke (Chairperson)

George Birmingham

Mary Irvine

Elizabeth Dunne

John A. Edwards

Brian R. Murray

Richard Humphreys

Conor Dignam

Grainne Larkin

Stuart Gilhooly

Liam Kennedy

James Finn

John Mahon

I concur in the making of the following Rules of Court.

Dated this 14th day of October 2021.

HEATHER HUMPHREYS

Minister for Justice

S.I. No. 530 of 2021

RULES OF THE SUPERIOR COURTS (INTELLECTUAL PROPERTY  
PROCEEDINGS) 2021

1. (1) These Rules, which may be cited as the Rules of the Superior Courts (Intellectual property proceedings) 2021, shall come into operation on the 22nd day of October 2021.

(2) These Rules shall be construed together with the Rules of the Superior Courts.

(3) The Rules of the Superior Courts as amended by these Rules may be cited as the Rules of the Superior Courts 1986 to 2021.

2. The Rules of the Superior Courts are amended:

- (i) by the substitution for Order 63A of the Order set out in Schedule 1, and
- (ii) by the substitution for Order 94 of the Order set out in Schedule 2.

3. All intellectual property proceedings and proceedings concerning intellectual property rights commenced in the High Court before the coming into force of these Rules may be continued and completed as if these Rules had not come into force.

## Schedule 1

### “Order 63A

#### Commercial Proceedings

##### *I. Preliminary*

##### *Definitions*

1. In this Order unless the context or subject matter otherwise requires –  
“Commercial List” means the list in which proceedings have been entered in accordance with rule 4;

“commercial proceedings” means:

- (a) proceedings in respect of any claim or counterclaim, not being a claim or counterclaim for damages for personal injuries, arising from or relating to any one or more of the following:
  - (i) a business document, business contract or business dispute where the value of the claim or counterclaim is not less than €1,000,000;
  - (ii) the determination of any question of construction arising in respect of a business document or business contract where the value of the transaction the subject matter thereof is not less than €1,000,000;
  - (iii) the purchase or sale of commodities where the value of the claim or counterclaim is not less than €1,000,000;
  - (iv) the export or import of goods where the value of the claim or counterclaim is not less than €1,000,000;
  - (v) the carriage of goods by land, sea, air or pipeline where the value of the claim or counterclaim is not less than €1,000,000;
  - (vi) the exploitation of oil or gas reserves or any other natural resource where the value of the claim or counterclaim is not less than €1,000,000;
  - (vii) insurance or re-insurance where the value of the claim or counterclaim is not less than €1,000,000;
  - (viii) the provision of services (not including medical, quasi-medical or dental services or any service provided under a contract of employment) where the value of the claim or counterclaim is not less than €1,000,000;
  - (ix) the operation of markets or exchanges in stocks, shares or other financial or investment instruments, or in commodities where the value of the claim or counterclaim is not less than €1,000,000;

- (x) the construction of any vehicle, vessel or aircraft where the value of the claim or counterclaim is not less than €1,000,000;
- (xi) business agency where the value of the claim or counterclaim is not less than €1,000,000;
- (b) proceedings in respect of any other claim or counterclaim, not being a claim or counterclaim for damages for personal injuries, which the Judge of the Commercial List, having regard to the commercial and any other aspect thereof, considers appropriate for entry in the Commercial List;
- (c) any application or proceedings under the Arbitration Act 2010 (other than an application in pursuance of Article 8 of the Model Law set out in Schedule 1 to the Arbitration Act 2010 to stay proceedings in respect of a matter referred to arbitration) where the value of the claim or any counterclaim is not less than €1,000,000;
- (d) intellectual property proceedings, within the meaning of this rule;
- (e) proceedings which in the opinion of the Judge of the Commercial List are sufficiently concerned or connected with rights protected under the laws or instruments referred to in the definition of “intellectual property proceedings” so as to warrant assignment to the Intellectual Property and Technology List;
- (f) proceedings which in the opinion of the Judge of the Commercial List involve issues of technological complexity in any field of industry so as to warrant assignment to the Intellectual Property & Technology List;
- (g) any appeal from, or application for judicial review of, a decision or determination made or a direction given by a person or body authorised by statute to make such decision or determination or give such direction, where the Judge of the Commercial List considers that the appeal or application is, having regard to the commercial or any other aspect thereof, appropriate for entry in the Commercial List;

“initial directions hearing” means a hearing in accordance with rules 4 (5) (b) or 6 for the purpose of the giving of directions or making of orders as to preparation of the proceedings for trial and case management, and for the other purposes mentioned in rule 6;

“Intellectual Property and Technology List” means the sub-division of the Commercial List to which proceedings have been assigned following entry in the Commercial List;

“intellectual property proceedings” means:-

- (a) any proceedings instituted, application made or appeal lodged under the following legislation or instruments, or concerned with the licensing of rights protected thereunder-

- (i) the Trade Marks Act 1996;
- (ii) Regulation (EU) No 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark;
- (iii) the Copyright and Related Rights Act 2000;
- (iv) the Patents Act 1992, not including an application under section 108(4) of that Act;
- (v) Regulation (EC) No 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products;
- (vi) the Industrial Designs Act 2001;
- (vii) Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs;
- (viii) Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights;
- (ix) the European Union (Protection of Trade Secrets) Regulations 2018 (SI 188 of 2018);  
or any successor or related legislation or instrument of the EU;
- (b) proceedings instituted for relief in respect of unregistered intellectual property rights;
- (c) proceedings instituted for relief in respect of the right to prevent passing off or to prevent unfair commercial practices, and
- (d) proceedings in respect of a right of confidence in information;

“Intellectual Property and Technology List Judge” means any Judge of the High Court, including the Judge of the Commercial List, assigned for the time being by the President of the High Court to hear and determine proceedings, or any application in relation to proceedings, entered in the Intellectual Property and Technology List;

“Judge of the Commercial List” means the Judge of the High Court for the time being assigned by the President of the High Court to carry out the functions of Judge of the Commercial List conferred by this Order;

“Judge” means any Judge of the High Court, including the Judge of the Commercial List, assigned for the time being by the President of the High Court to hear and determine proceedings, or any application in relation to proceedings, entered in the Commercial List;

“Registrar” means the registrar, for the time being and with the approval of the President of the High Court, assigned by the officer for the time being having the management of the Central Office to carry out the functions of Registrar conferred by this Order.

*Application of this Order*

2. (1) Save where otherwise expressly provided by this Order, in the event that any conflict shall arise between the provision of any rule of this Order and any other provision of these Rules, the provision of the rule of this Order shall, in respect of any proceedings entered in the Commercial List in accordance with rule 4 including any such proceedings assigned to the Intellectual Property and Technology List, prevail.

(2) The provisions of Parts II to VII inclusive, but not Part VIII, apply to proceedings which have been entered in the Commercial List but not assigned to the Intellectual Property and Technology List.

(3) The provisions of Parts II to VII inclusive, other than rule 6(1)(xii), rule 14 and rule 15, and of Part VIII apply to proceedings which have been entered in the Commercial List and assigned to the Intellectual Property and Technology List.

*Use of forms*

3. (1) The forms in Appendix X shall be used as provided for in this Order in applications for the entry of proceedings in the Commercial List or in proceedings entered in the Commercial List, including such proceedings assigned to the Intellectual Property and Technology List, as the case may be, with such variations as the Judge of the Commercial List or the Registrar may permit or circumstances may require. The directions contained in any form shall be observed in relation thereto. Where such forms are applicable, any costs occasioned by failure to comply with the provisions of any rule relating to the content of a form or by failure to comply with any directions contained in a form shall be borne by or disallowed to the party using the same, unless the Judge shall otherwise direct.

(2) Applications made to the Judge of the Commercial List for the entry of proceedings in the Commercial List, and all proceedings entered therein shall be entitled:

"THE HIGH COURT  
COMMERCIAL".

(3) Applications made to the Judge of the Commercial List for the entry of proceedings in the Commercial List and the assignment of such proceedings to the Intellectual Property and Technology List, and all proceedings so entered and assigned, shall be entitled:



"THE HIGH COURT  
COMMERCIAL - INTELLECTUAL PROPERTY & TECHNOLOGY".

4. (1) Upon application made in accordance with sub-rule (2), commercial proceedings may be entered in the Commercial List by order of the Judge of the Commercial List and, in an appropriate case, may be assigned to the Intellectual Property and Technology List.

(2) A party to commercial proceedings may, at any time prior to:

- (a) the close of pleadings, in the case of plenary proceedings, or
- (b) completion of the filing of affidavits, in the case of summary proceedings or any other proceedings to be heard on affidavit without pleadings,

by motion on notice to the other party or parties to those proceedings, apply to the Judge of the Commercial List for an order entering the proceedings in the Commercial List and, where relevant, assigning the proceedings to the Intellectual Property and Technology List. The notice of motion shall have appended thereto a certificate of the solicitor for the applicant to the effect that the proceedings are appropriate to be treated as commercial proceedings within the meaning of rule 1, and setting out such facts relating to the proceedings as shall demonstrate this.

(3) Where, in an application under sub-rule (2), the assignment of the proceedings to the Intellectual Property and Technology List is also sought, the certificate of the solicitor for the applicant shall certify that the proceedings are commercial proceedings within sub-paragraphs (d), (e) and/or (f) of the definition of "*commercial proceedings*" in rule 1, and shall set out such facts relating to the proceedings as shall demonstrate this.

(4) At the hearing of the motion referred to in sub-rule (2), the applicant shall produce the certificate appended to the notice of motion, or a certified copy or certified copies thereof.

(5) Upon the hearing of the motion referred to in sub-rule (2), the Judge of the Commercial List may direct that the proceedings be entered in the Commercial List, or may direct that the proceedings be entered in the Commercial List and assigned to the Intellectual Property and Technology List.

(6) Subject to sub-rule (8), where the Judge of the Commercial List directs that proceedings be entered in the Commercial List:

- (a) he shall:
  - (i) fix a date for the initial directions hearing; or
  - (ii) treat the hearing of the motion as the initial directions hearing,  
and
- (b) all further motions or applications in respect of such proceedings shall be made to a Judge.

(7) Where the proceedings which are the subject of an application pursuant to sub-rule (2) are proceedings falling within sub-paragraph (d) of the definition

of “commercial proceedings” in rule 1, the proceedings shall be entered in the Commercial List and assigned to the Intellectual Property and Technology List, save where such entry and assignment of the proceedings would be contrary to the interests of the efficient and just conduct of the Commercial List or the Intellectual Property and Technology List.

(8) Where the Judge of the Commercial List directs that proceedings be assigned to the Intellectual Property and Technology List:

- (a) he shall:
  - (i) fix a date for the initial directions hearing; or
  - (ii) treat the hearing of the motion as the initial directions hearing, and
- (b) all further motions or applications in respect of such proceedings shall be made to an Intellectual Property and Technology Judge.

## *II. Pre-trial procedure*

### *General*

5. A Judge may, at any time and from time to time, of his own motion and having heard the parties, give such directions and make such orders, including the fixing of time limits, for the conduct of proceedings entered in the Commercial List, as appears convenient for the determination of the proceedings in a manner which is just, expeditious and likely to minimise the costs of those proceedings.

### *Initial directions*

6. (1) Without prejudice to the generality of rule 5, a Judge may, at the initial directions hearing –

- (a) of his own motion and after hearing the parties, or
- (b) on the application of a party by motion on notice to the other party or parties returnable to the initial directions hearing,

give any of the following directions to facilitate the determination of the proceedings in the manner mentioned in that rule:

- (i) as to whether the proceedings shall continue –
  - (I) with pleadings and hearing on oral evidence,
  - (II) without formal pleadings and by means of a statement of issues of law or fact, or of both law and fact,
  - (III) without formal pleadings and to be heard on affidavit with oral evidence, or
  - (IV) without formal pleadings and to be heard on affidavit without oral evidence;
- (ii) fixing any issues of fact or law to be determined in the proceedings;

- (iii) for the consolidation of the proceedings with another cause or matter pending in the High Court;
- (iv) for the defining of issues by the parties, or any of them, including the exchange between the parties of memoranda for the purpose of clarifying issues;
- (v) allowing any party to alter or amend his indorsement or pleadings, or allowing amendment of a statement of issues;
- (vi) requiring delivery of interrogatories, or discovery or inspection of documents;
- (vii) requiring the making of inquiries or taking of accounts;
- (viii) requiring the filing of lists of documents, either generally or with respect to specific matters;
- (ix) directing any expert witnesses to consult with each other for the purposes of –
  - (a) identifying the issues in respect of which they intend to give evidence,
  - (b) where possible, reaching agreement on the evidence that they intend to give in respect of those issues, and
  - (c) considering any matter which the Judge may direct them to consider,

and requiring that such witnesses record in a memorandum to be jointly submitted by them to the Registrar and delivered by them to the parties, particulars of the outcome of their consultations:

provided that any such outcome shall not be in any way binding on the parties;

- (x) providing for the exchange of documents or information between the parties, or for the transmission by the parties to the Registrar of documents or information electronically on such terms and subject to such conditions and exceptions as a Judge may direct;
- (xi) for the examination upon oath before a Judge, Registrar or other officer of the Court, or any other person, and at any place, of any witness, in accordance with Part II of Order 39;
- (xii) as to whether or not the proceedings should, by virtue of their complexity, the number of issues or parties, the volume of evidence, or for other special reason, be subject to case management in accordance with rules 14 and 15;
- (xiii) on the application of any of the parties or of his own motion, that the proceedings or any issue therein be adjourned for such time, not exceeding 28 days, as he considers appropriate to allow the parties time to consider whether such proceedings or issue ought to be referred to a process of mediation, conciliation or arbitration, and where the

parties decide so to refer the proceedings or issue, to extend the time for compliance by any party with any provision of these Rules or any order of the Court.

(2) Without prejudice to any enactment or rule of law by virtue of which documents or evidence are privileged from disclosure, to assist him in deciding whether or not to make any order or give any direction in accordance with sub-rule (1), a Judge may direct the parties, or any of them, to provide information in respect of the proceedings, including:

- (a) a list of the persons expected to give evidence;
- (b) particulars of any matter of a technical or scientific nature which may be at issue or may be the subject of evidence;
- (c) a reasoned estimate of the time likely to be spent in -
  - (i) preparation of the proceedings for trial, and
  - (ii) the trial of the proceedings;
- (d) particulars of any mediation, conciliation or arbitration arrangements which may be available to the parties.

(3) A Judge may, where he deems fit, at the initial directions hearing, hear any application for relief of an interlocutory nature, whether in the nature of an injunction or otherwise.

#### *Motions and Applications*

7. All notices of motion, applications and the affidavits or other documents grounding the same shall be lodged with the Registrar and shall bear the code or number assigned to the application or proceedings, as the case may be, in accordance with rule 27.

8. (1) A Judge may direct that the parties to a motion or application shall prepare a written submission, bearing the name of the author, which submission shall be concise and avoid lengthy argument, specifying:

- (i) the nature of the case generally and the background facts insofar as they are relevant to the matter before the court;
- (ii) the submissions of law to be relied upon, citing the supporting authorities;
- (iii) the submissions of fact to be made with reference to the evidence;

(2) The written submissions shall be lodged with the Registrar not less than one clear day prior to the date of the hearing of the motion or application.

#### *Interrogatories*

9. A party to proceedings entered in the Commercial List may at any time after delivering his statement or points of claim, or defence or points of defence, as the case may be, deliver interrogatories in writing for the examination of any

other party to the proceedings, and such interrogatories when delivered shall have a note at the foot thereof, stating which of such interrogatories each of such persons is required to answer, provided that no party shall deliver more than one set of interrogatories to the same party without an order for that purpose; provided also that interrogatories which do not relate to any matters in question in the proceedings shall be deemed irrelevant, notwithstanding that they might be admissible on the oral cross-examination of a witness.

10. Interrogatories delivered in accordance with rule 9 shall be in the Form No. 1 in Appendix X.

11. Answers to interrogatories shall be made by affidavit to be filed within 21 days from receipt thereof, or within such other time as a Judge may allow.

12. An affidavit in answer to interrogatories shall be in the Form No. 2 in Appendix X.

13. The provisions of rules 3, 5, 6, 7, 10 and 11 of Order 31 shall, with any necessary modifications, apply to any interrogatories delivered or to be delivered in accordance with this rule.

#### *Case management*

14. (1) Where, in accordance with rule 6, a Judge directs that the proceedings be subject to case management, he shall fix a date for a case management conference, and may give any further directions for the completion prior to such conference of such, if any, steps in the proceedings (including the preparation of a case booklet in accordance with sub-rule (9)) as he considers appropriate.

(2) The case management conference shall be chaired and regulated by a Judge.

(3) Where the case management conference is adjourned, it shall be adjourned to a specific date.

(4) The case management conference shall be attended by the solicitors appearing for each of the parties or, where a party, not being a body corporate, is not represented by a solicitor, by the party himself. Where the Judge chairing the case management conference considers it necessary or desirable, he may direct that party, or, where the party is a body corporate, the proper officer of a party, attend the case management conference, notwithstanding the fact that the party may be represented by a solicitor.

(5) Each solicitor attending the case management conference shall ensure that he is sufficiently familiar with the proceedings, and has authority from the party he represents to deal with any matters that are likely to be dealt with at the conference.

(6) Where a party is represented by counsel, such counsel may attend the case management conference, but the attendance of only one of such counsel will be allowed in the taxation or fixing of costs.

(7) The purpose of the case management conference shall be to ensure that the proceedings are prepared for trial in a manner which is just, expeditious and likely to minimise the costs of the proceedings, and in particular that, as soon as may be in advance of the trial:

- (a) the issues, whether as to fact or law, are defined as clearly, as precisely and as concisely, as possible;
- (b) all pleadings, affidavits and statements of issues are served;
- (c) any applications by letter for particulars and replies thereto, any admissions, or requests for admissions, notices to admit documents or facts and replies thereto, and any affidavits made in pursuance of any notices to admit facts or documents, are served or delivered, as the case may be;
- (d) all applications for relief of an interlocutory nature intended to be made by any of the parties are made;
- (e) any directions given or orders made at the initial directions hearing, or in the course of a case management conference have been complied with.

(8) Where no direction has been given that the proceedings be subject to case management, either party may, at any time before the trial, apply to the Judge of the Commercial List by motion on notice to the other party or parties for a direction that a case management conference be held. The affidavit grounding the motion shall set out clearly and concisely the grounds on which the case management conference is sought. Where any party objects to such a direction, they shall furnish their objections by replying affidavit.

(9) The plaintiff, applicant or other party prosecuting the proceedings shall, in consultation with the other party or parties, prepare a case booklet to be lodged with the Registrar and served on the other party or parties not later than four clear days prior to the first date fixed for the case management conference.

(10) The case booklet shall contain –

- (a) a case summary, comprising
  - (i) an agreed outline of the case and sequence of relevant events not in dispute;
  - (ii) a list of those issues which are not in dispute;
  - (iii) an agreed statement of those issues that are in dispute, and
- (b) pre-trial documentation in chronological sequence, including (where appropriate) copies of pleadings exchanged, affidavits filed (other than affidavits of service), statements of issues, orders made or directions given, and any correspondence between the parties, not being expressed to be “without prejudice”, relating to the preparation of the case for trial.

(11) The case booklet shall be produced and maintained by the party responsible for preparing the same in such form, including electronic form as the Judge of the Commercial List may direct and, where the Judge so directs, shall be lodged or served by electronic means, and on such conditions and subject to such exceptions as he may prescribe.

(12) The party responsible for preparing the case booklet shall, in consultation with the other party or parties, revise or add to its contents from time to time as necessary.

15. At the case management conference the Judge chairing the case management conference may:

- (a) fix a timetable for the completion of preparation of the case for trial, and may for that purpose adopt any proposed timetable agreed by the parties if satisfied that it is reasonable;
- (b) make any orders or give any directions which he may make or direct under rule 6(1) or (2);
- (c) if he considers that there is undue delay in, or he is otherwise dissatisfied with, the conduct of the proceedings, and without prejudice to any powers conferred on the Judge by Order 33, rule 11, require the party appearing to be responsible therefor, or the proper officer of or solicitor instructed in the proceedings by that party, to attend before him to explain the delay or other conduct with which he is dissatisfied, and may thereupon make or give such ruling or direction as he may consider appropriate for the purposes of expediting the proceedings or the conduct thereof;
- (d) without prejudice to any powers conferred on the Judge by Order 99, disallow the costs of any indorsement of claim, pleading statement of issues or other document in the proceedings which contains unnecessary matter, or is of unnecessary length, and award against that party the costs thereby occasioned to any other party;
- (e) without prejudice to any powers conferred on the Judge by Order 33, rule 11 and Order 99, disallow the costs of any party occasioned by a delay or default by that party in complying with a time limit for doing any act or taking any proceeding, and award against that party the costs thereby occasioned to any other party.

#### *Preparation for trial*

16. (1) Where no direction has been given that the proceedings be subject to case management, once the exchange of pleadings, affidavits or statements of issues has been completed, any of the parties may apply to the Registrar for the fixing of a date for a pre-trial conference.

(2) Where a direction has been given that the proceedings be subject to case management, the Judge chairing the case management conference shall fix a date

for a pre-trial conference once all orders made or directions given in the course of the case management conference have been complied with.

17. Each party shall, in consultation with their respective counsel, complete and lodge with the Registrar not later than four clear days before the date fixed for the pre-trial conference a pre-trial questionnaire in the Form No. 3 in Appendix X to these Rules.

18. (1) The pre-trial conference shall be chaired and regulated by a Judge.

(2) Where the pre-trial conference is adjourned, it shall be adjourned to a specific date.

(3) (a) Where a party intends to be represented at the trial by a solicitor then the leading solicitor whom it is intended shall so represent the party shall attend the pre-trial conference.

(b) Where a party intends to be represented at the trial by solicitor and counsel then the leading counsel whom it is intended shall so represent the party shall attend the pre-trial conference.

19. At the pre-trial conference the Judge chairing the same shall establish what steps remain to be taken to prepare the case for trial, the likely length of the trial and the arrangements, if any, for witnesses, information and communications technology (including video conferencing) and any other arrangements which require to be made for the trial, and may make any orders and give any directions in respect of arrangements for the trial as he considers necessary.

20. When the Judge chairing the pre-trial conference is satisfied that the proceedings are ready to proceed to trial, he shall fix a trial date.

21. (1) Subject to sub-rule (2), unless the Judge chairing the pre-trial conference otherwise directs, the plaintiff, applicant or other party prosecuting the proceedings shall, in consultation with the other party or parties, prepare and lodge with the Registrar, not less than four clear days prior to the date fixed for the trial:

(a) a trial booklet, indexed and in chronological sequence, and containing copies of any pleadings, affidavits, statements of issues, documents or extracts therefrom in respect of which agreement has been reached between the parties under sub-rule (2), statements provided for in rule 22, correspondence and any other documents intended to be relied upon at the trial, and

(b) a case summary, comprising -

(i) an agreed outline of the case and sequence of relevant events not in dispute;



- (ii) a list of those issues which are not in dispute;
  - (iii) a list of the persons principally involved in the matters or events the subject of the proceedings and,
  - (iv) where appropriate, a glossary of technical terms which are likely to be used in the course of the trial.
- (2) (a) The Judge chairing the pre-trial conference may request the parties to consult with each other with a view to agreeing, where possible, upon a list of the documents and, as appropriate, any extracts from documents intended to be relied upon at the trial.
- (b) In the event of any such agreement being reached by the parties, the plaintiff, applicant or other party prosecuting the proceedings shall, in consultation with the other party or parties, prepare and lodge with the Registrar, not less than four clear days prior to the date fixed for the trial, a booklet indexed and in chronological sequence, containing copies of such documents or extracts and, where appropriate, indicating, by means of tags, colour highlighting or otherwise as the Judge of the Commercial List or the Registrar may direct, any relevant extracts therefrom intended to be relied upon at the trial.
- (c) In the event that the parties are unable to reach any such agreement they shall notify the Registrar and, unless the Judge chairing the pre-trial conference shall otherwise order, the plaintiff, applicant or other party prosecuting the proceedings shall proceed in accordance with sub-rule (1) as if no request had been made by the Judge under paragraph (a).
- (3) The trial booklet shall be produced by the party responsible for preparing the same in such form, including electronic form as the Judge of the Commercial List may direct and, where the Judge of the Commercial List so directs, shall be lodged or served by electronic means, and on such conditions and subject to such exceptions as he may prescribe.

### *III. Evidence*

#### *Oral evidence*

22. (1) Unless a Judge shall otherwise order, a party intending to rely upon the oral evidence of a witness as to fact or of an expert at trial shall, not later than one month prior to the date of such trial in the case of the plaintiff, applicant or other party prosecuting the proceedings and not later than seven days prior to that date in the case of the defendant, respondent or other party defending the proceedings, serve upon the other party or parties a written statement outlining the essential elements of that evidence signed and dated by the witness or expert, as the case may be.
- (2) A Judge may, in exceptional circumstances to be recited in the order and after hearing all of the parties, make an order directing that the written statement referred to in sub-rule (1) or any part thereof shall be treated as the evidence in

chief of the witness or expert concerned but only after it has been verified on oath by such witness or expert.

*Evidence by video link or other means*

23. (1) A Judge may allow a witness to give evidence, whether from within or outside the State, through a live video link or by other means.

(2) Evidence given in accordance with sub-rule (1) shall be recorded by video or otherwise as the Judge may direct.

*IV. Trial venue*

24. All applications made to the Judge of the Commercial List for the entry of proceedings, all proceedings entered in the Commercial List, and all trials of such proceedings shall, unless a Judge shall in any particular proceedings and for special reason otherwise order, take place in an appropriate courtroom designated by the President of the High Court in consultation with the Judge of the Commercial List and situate in Dublin.

*V. The Registrar*

*Functions*

25. The Registrar may refer to a Judge proceedings listed in the Commercial List in respect of which he considers there has been undue delay.

*Records*

26. (1) The Registrar shall establish and maintain the following records:

- (a) a register of applications for entry of proceedings in each of the Commercial List and the Intellectual Property and Technology List;
- (b) a register of proceedings entered in each of the Commercial List and the Intellectual Property and Technology List;
- (c) a register of orders made or directions given by Judges in proceedings listed in each of the Commercial List and the Intellectual Property and Technology List,
- (d) calendar of sittings of Judges;
- (e) a record of progress in each of the proceedings entered in each of the Commercial List and the Intellectual Property and Technology List.

(2) Such records may be held electronically and may be held separately or in an amalgamated form.

27. The Registrar shall establish and maintain a file for each application for entry of proceedings in, and for each of the proceedings entered in the

Commercial List, which file may, in whole or in part, be in electronic form, and each such application or proceedings shall be assigned a code or number in sequence for the purposes of identification.

#### *VI. Costs*

28. The costs of the initial directions hearing shall, unless the Judge before whom that hearing takes place otherwise orders, be deemed to be costs in the cause.

29. The Judge of the Commercial List may prescribe requirements as to the form and content of bills of costs to be prepared in respect of proceedings entered in the Commercial List. Where he has not done so, such bills of costs shall be prepared in the manner prescribed by Order 99.

30. Upon the determination of any interlocutory application by a Judge, the Judge shall make an award of costs save where it is not possible justly to adjudicate upon liability for costs on the basis of the interlocutory application.

#### *VII. Electronic service, exchange and lodgement of documents*

31. (1) Documents required under these Rules to be served or exchanged in commercial proceedings entered in the Commercial List may, where the President of the High Court by practice direction permits, and on such terms and conditions and subject to such exceptions as the President of the High Court may by such practice direction specify, be served or exchanged, as the case may be, electronically.

(2) Documents required under these Rules to be filed in commercial proceedings entered in the Commercial List may, where the President of the High Court by practice direction permits, and on such terms and conditions and subject to such exceptions as the President of the High Court may by such practice direction specify, be filed electronically with the Registrar and stored by the Registrar in like manner.

(3) Without prejudice to the generality of sub-rules (1) or (2), a practice direction given by the President of the High Court in pursuance of either of those sub-rules may prescribe requirements as to-

- (a) the hardware and other equipment, diskettes or CD-Roms and communications protocol or protocols to be employed by parties filing, serving or exchanging documents electronically;
- (b) the use of passwords, electronic signatures, digital signatures or other means of authenticating documents filed, served or exchanged electronically;

- (c) the use of firewalls, anti-virus tools or other devices or applications for the purpose of avoiding damage to the information system of the Courts Service or of any party or their solicitor or counsel;
- (d) compliance with practices or protocols for the purpose of ensuring that harmful, deleterious or offensive material does not enter the information system of the Courts Service or of any party or their solicitor or counsel;
- (e) the formatting, organising, identifying, coding and indexing of documents to be filed, served or exchanged electronically;
- (f) the manner in which documents filed, served or exchanged electronically, or copies of such documents, may be presented or otherwise used in Court.

### *VIII Intellectual Property and Technology List*

#### *Pre-Trial Procedure in Proceedings in the Intellectual Property and Technology List*

32. (1) Having given directions in accordance with rule 6 at the initial directions hearing in proceedings assigned to the Intellectual Property and Technology List, the Judge of the Commercial List shall adjourn the directions hearing to a date after the close of the pleadings or to such other date as the Judge may direct, except where the Judge is satisfied that no case management conference is required in the proceedings. In the event that the Judge is so satisfied, the Judge may make all appropriate directions and orders pursuant to rule 33 for the conduct of the proceedings.

(2) On the date to which the directions hearing is adjourned pursuant to sub-rule (1), the Judge of the Commercial List shall fix a date for the holding of a case management conference in accordance with rule 33 before an Intellectual Property and Technology List Judge, unless the Judge determines that the fixing of a date for the case management conference ought to be adjourned in the particular circumstances.

(3) The court may at any other time fix a date for the holding of a case management conference.

33. (1) The purpose of the case management conference in proceedings in the Intellectual Property and Technology List is to ensure that each of:-

- (a) the manner in which the proceedings are prepared for trial;
- (b) the manner in which the evidence to be presented at trial is identified and gathered, and
- (c) the manner in which the proceedings are heard and determined,

is just and proportionate in all the circumstances, whilst also the manner which is most expeditious and likely to minimise the costs of the proceedings.

(2) The Judge of the Commercial List may direct, when fixing the date for the case management conference:-

- (a) that correspondence is first exchanged between the parties in respect of the matters listed at sub-paragraphs (a) to (c) of sub-rule (1) and fixing a timetable in respect thereof, and
- (b) that any application for a direction or order concerned with the matters listed at sub-paragraphs (a) to (c) of sub-rule (1) is made returnable to the case management conference,

and may give any other directions as, in the view of the Judge, are appropriate in respect of preparation for and conduct of the case management conference.

(3) At the case management conference the Intellectual Property and Technology List Judge chairing the conference shall, to the extent appropriate and practical at the relevant time, address:-

- (a) whether there is a need for further particulars to be furnished by any party;
- (b) whether any amendments to the pleadings ought to be made;
- (c) whether discovery of any documents is necessary;
- (d) whether any inspection or experiment is necessary;
- (e) whether there is any matter in respect of which interrogatories ought to be delivered;
- (f) what issues appear to call for expert evidence in order to fairly dispose of the proceedings and when that intended evidence, if any, ought to be delivered;
- (g) what issues appear to call for factual evidence in order to fairly dispose of the proceedings, and when that intended evidence, if any, ought to be delivered;
- (h) whether the trial should proceed by way of separate hearing of certain issues in advance of other issues;
- (i) whether the appointment of an assessor is necessary;
- (j) the estimated duration of the trial and/or portions thereof;
- (k) the time likely to be required by the trial judge for advance reading.

(4) The Intellectual Property and Technology List Judge chairing a case management conference may, of his or her own motion and having heard the parties, or on the application of a party by motion on notice to the other party or parties returnable to the case management conference:-

- (a) make any orders or give any directions which he may make or direct under rule 6(1)(i) to (xi) and (xiii) or rule 6 (2);
- (b) direct that the proceedings:-
  - (i) be heard on affidavit;

- (ii) be heard on affidavit with oral evidence on a specific issue or issues, and/or
- (iii) be determined without discovery of documents, or with discovery of documents only in respect of specific matters;
- (c) determine any application for a direction or order and make such directions or orders as necessary and appropriate to achieve the purpose of the case management conference, having heard the parties prior to so determining;
- (d) adjourn the case management conference to a date which allows time for compliance with directions or orders of the Court and for further consideration of the matters before the case management conference.

(5) Rules 14(3) to (5) shall apply to a case management conference in the Intellectual Property and Technology List.

(6) Unless otherwise directed, the plaintiff, applicant or other party prosecuting the proceedings must lodge with the Registrar and serve on the other party or parties not later than four clear days prior to the first date fixed for the case management conference a case booklet or booklets containing:-

- (a) the pleadings;
- (b) any affidavits filed in the proceedings intended to be relied upon at the hearing, and
- (c) motion papers in respect of any application for directions or orders listed for hearing at the case management conference.

(7) The parties must endeavour to agree orders and directions for the conduct of the proceedings and submit any agreed directions with the case booklet. Where the Court approves agreed directions the case management conference may be vacated by the Court.”

**Schedule 2**  
**“Order 94**  
**Intellectual Property**  
**I. General**

1. This Order applies to all intellectual property proceedings including those which relate to—

- (1) registered intellectual property rights including –
  - (a) patents;
  - (b) registered designs; and
  - (c) registered trade marks;
  - (d) plant breeders rights; and
  - (e) Community plant variety rights;
- (2) unregistered intellectual property rights including –
  - (a) copyright;
  - (b) design rights;
  - (c) the right to prevent passing off;
  - (d) moral rights;
  - (e) database rights;
  - (f) unauthorised decryption rights;
  - (g) topography rights in semiconductor products;
  - (h) hallmarks;
  - (i) the right of confidence in commercial information, including trade secrets; and
  - (j) rights in protected designations of origin, protected geographic indications and traditional speciality guarantees.

2. In this Order –

the “1992 Act” means the Patents Act 1992;

the “1996 Act” means the Trade Marks Act 1996;

the “2000 Act” means the Copyright and Related Rights Act 2000;

the “2001 Act” means the Industrial Designs Act 2001;

the “Acts” means the 1992 Act, 1996 Act, 2000 Act and 2001 Act;

the “EU (Protection of Trade Secrets) Regulations” means the European Union (Protection of Trade Secrets) Regulations (SI 188 of 2018);

“European Patent Convention” means the Convention on the Grant of European Patents of 5th October 1973 as amended from time to time;

“Community Design Court” means the High Court;

the “Controller” means the Controller of Intellectual Property;

the “Journal” means the Journal published pursuant to section 100 of the 1992 Act;

“patent” means a patent under the 1992 Act or a supplementary protection certificate granted by the Intellectual Property Office of Ireland under Article 10(1) of Council Regulation (EC) No. 469/2009 or of Regulation (EC) No. 1610/96 of the European Parliament and the Council and includes any application for a patent or supplementary protection certificate;

“register” means whichever of the following registers or successor register as is appropriate—

- (i) the register of patents maintained by the Controller under section 84 of the 1992 Act;
- (ii) the register of designs maintained by the Controller under section 30 of the 2001 Act;
- (iii) the register of trade marks maintained by the Controller under section 66 of the 1996 Act;
- (iv) the register of European trade marks maintained by the European Union Intellectual Property Office under Article 111 of Council Regulation (EC) 2017/1001;
- (v) the register of Community designs maintained by the European Union Intellectual Property Office under Article 72 of Council Regulation (EC) No. 6/2002;
- (vi) the register of plant breeders’ rights maintained by the Controller under section 20 of the Plant Varieties (Proprietary Rights) Act 1980; and
- (vii) the register of Community plant variety rights maintained



by the Community Plant Variety Rights Office under Article 87 of Council Regulation (EC) No. 2100/94;

“right” means one of the rights specified in rule 1(1) and (2), unless the context or subject matter otherwise requires.

3. (1) Where any order of the Court affects the validity of an entry in a register, the party in whose favour the order is made must serve a copy of such order on the relevant office within 14 days or such other period as the Court may direct.

(2) Where the order affects more than one party, a copy of the order must be served by such party as the Court directs.

4. This Order shall apply *mutatis mutandis* to any European Union instrument or enactment other than those mentioned in rule 2 which confers any intellectual property right.

#### *Initiating Proceedings*

5. Intellectual property proceedings must be initiated by:

- (a) a plenary summons or counterclaim in actions which relate to an alleged infringement or breach of a right;
- (b) a plenary summons or counterclaim in actions which relate to the alleged invalidity of a right or the entitlement to a right;
- (c) a special summons in actions solely seeking amendment or rectification in respect of a right;
- (d) a special summons in appeals from decisions of the Controller.

6. In the case of proceedings concerning rights which are entered on a register, the summons or counterclaim must state the registration number of the intellectual property right to which the proceedings relate.

#### *Other applications*

7. Save as otherwise provided by the Acts or by this Order, every application to the Court in intellectual property proceedings shall be made by special summons. The summons shall be served upon the Controller and upon

all other persons (if any) interested.

8. (1) A party seeking a decision of the Court on a dispute under section 77 of the 1992 Act or section 86 of the 2001 Act (other than where validity of the patent or registered design is put in issue, or its revocation is sought by the relevant Minister), shall apply by special summons.

(2) Where the application is by a patentee, or by a proprietor of a registered design, the Minister, head of the Department of State concerned, shall be named as defendant, and the summons shall be served on the Chief State Solicitor.

(3) Where the application is by a Minister, the patentee or the proprietor of the registered design (as the case may be) shall be named as defendant.

9. Where the Attorney General or the Controller under section 81 of the 2001 Act, or the Controller under section 91 of the 1992 Act, section 72 of the 1996 Act or section 364 of the 2000 Act, has made an order that costs be paid by any party, such order may be made a rule of Court on the application of the party to whom such costs are payable. Such application may be made *ex parte* grounded on an affidavit entitled in the matter of the Act concerned and the proceedings before the Attorney General or Controller (as the case may be).

### *Assessors and Advisers*

10. (1) On application by any of the parties or of its own motion the Court may give directions including for –

- (a) the preparation of a document setting out basic undisputed technology;
  - (b) the appointment of an assessor to assist the Court in accordance with Order 36, rule 41 or, where applicable, section 95 (1) of the 1992 Act.
- (2) Order 36, rule 41(4) and (5) shall not apply where the remuneration of the assessor is to be paid out of money provided by the Oireachtas.

## **II. Patent and certain other proceedings**

### *Application of this Part*

11. Part II applies to –

- (1) any claim under –

- (a) the 1992 Act;
  - (b) the 2001 Act;
  - (c) the EU (Protection of Trade Secrets) Regulations; and
- (2) any claim relating to—
- (a) Community registered designs;
  - (b) semiconductor topography rights;
  - (c) plant varieties; or
  - (d) a right of confidence in commercial confidential information, including trade secrets.

12. Where proceedings relate to a patent which has not been published in either the English or Irish language, a translation of the patent must be delivered with the pleading.

***Proceedings for infringement or challenges to validity***

13. (1) In proceedings for infringement of a patent the statement of claim or counterclaim must include or be accompanied by particulars which—

- (a) state which of the claims in the specification of the patent are alleged to be infringed, and
- (b) give at least one example of each type of infringement alleged.

(2) Where the validity of a patent or registered design is challenged the statement of claim or counterclaim must include or be accompanied by a document entitled “Grounds of Invalidity” which must—

- (a) specify the grounds on which validity of the patent or registered design is challenged, and
- (b) include particulars that clearly define every issue (including any challenge to any claimed priority date) which it is intended to raise.

(3) Where, in proceedings in which the validity of a patent or a registered design is challenged, the Grounds of Invalidity include an allegation—

- (a) that the invention is not a patentable invention because it is not new or does not include an inventive step, the particulars must specify details of the matter in the state of the art relied on, as set out in rule 13(4);
- (b) that the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a

person skilled in the art, the particulars must state, if appropriate, which examples of the invention cannot be made to work and in which respects they do not work or do not work as described in the specification; or

- (c) that the registered design is not new or lacks individual character, the particulars must specify details of any prior design relied on, as set out in rule 13(4).
- (4) The details required under rules 13(3)(a) and 13(3)(c) are –
- (a) in the case of matter or a design made available to the public by written description, the date on which and the means by which it was so made available, unless this is clear from the fact of the matter; and
  - (b) in the case of matter or a design made available to the public by use –
    - (i) the date or dates of such use;
    - (ii) the name of all persons making such use;
    - (iii) the place of such use;
    - (iv) any written material which identifies such use;
    - (v) the existence and location of any apparatus employed in such use; and
  - (c) all facts and matters relied on to establish that such matter was made available to the public.

(5) In any proceedings in which the validity of a patent is challenged, where a party alleges that machinery or apparatus was used before the priority date of the claim, the Court may order inspection of that machinery or apparatus.

(6) If the validity of a patent is challenged on the ground that the invention did not involve an inventive step, a party who wishes to rely on the commercial success of the patent must state in the statement of claim or counterclaim the grounds on which that party so relies.

14. In proceedings for breach of a right of confidence in commercial information or brought under the EU (Protection of Trade Secrets) Regulations the statement of claim or counterclaim must include or be accompanied by particulars of the commercial information or trade secret which is the subject-matter of the proceedings.

#### *Provision of Product or Process Description*

15. Where a party to proceedings notifies another party of its intention to deliver–

- (a) full particulars of the features of the product or process alleged to infringe or breach another party's rights; and

- (b) any necessary drawings or other illustrations,

it shall not be necessary for the notifying party to make discovery of documents relating to the features of the product or process which is the subject matter of the notification, unless the Court, for special reasons to be set out in the Court's order, otherwise orders.

***Provision of Schedule in respect of Alleged Commercial Success***

16. Where a patentee relies upon the commercial success of a patent in proceedings concerned with its validity, unless the Court, for special reasons to be set out in the Court's order, otherwise orders, it shall not be necessary for the patentee to make discovery of categories of documents related to the issue of commercial success where the patentee has offered to deliver within a reasonable time a schedule containing:

- (a) where the commercial success relates to an article or product –
  - (i) an identification of the particular article or product which the patentee asserts has been made in accordance with the claims of the patent;
  - (ii) a summary by convenient periods of sales of any such article or product;
  - (iii) a summary for the equivalent periods of sales, if any, of any equivalent prior article or product marketed before the article or product in paragraph (i); and
  - (iv) a summary by convenient periods of any expenditure on advertising and promotion which supported the marketing of the articles or products in paragraphs (i) and (iii); or
- (b) where the commercial success relates to the use of a process –
  - (i) an identification of the process which the patentee asserts has been used in accordance with the claims of the patent;
  - (ii) a summary by convenient periods of the revenue received from the use of such process;
  - (iii) a summary for the equivalent periods of the revenues, if any, received from the use of any equivalent prior art process; and
  - (iv) a summary by convenient periods of any expenditure which supported the use of the process in paragraphs (i) and (iii).

***Verification of Particulars***

17. The particulars delivered under rule 15 and the schedule delivered under rule 16 must be accompanied by an affidavit which must aver that the deponent

–

(1) is personally acquainted with the facts to which the particulars or schedule relate;

(2) verifies, as the case may be, that:

- (i) the particulars are a true and complete description of the product or process alleged to infringe or breach the right in question; or
- (ii) the schedule represents a true and complete account of the commercial success of the product or process, and

(3) understands that he or she may be required to attend in Court in order to be cross-examined on the contents of the particulars or schedule.

### *Experiments*

18. (1) A party seeking to establish any fact by experimental proof conducted for the purpose of intellectual property proceedings must, as soon as is practicable after the close of pleadings, serve on all of the other parties a notice—

- (a) stating the facts which the party seeks to establish; and
- (b) giving full particulars of the experiments proposed to establish them.

(2) A party served with a notice under sub-rule (1)—

- (a) must within 21 days after such service, serve on the other party a notice stating whether or not each fact is admitted; and
- (b) may request the opportunity to inspect a repetition of all or a number of the experiments identified in the notice served under rule 18(1).

(3) Where any fact which a party seeks to establish by experimental proof is not admitted, that party must apply to the Court for permission to conduct the experiments and for directions in respect of the conduct thereof, including as to the presence of the parties, the taking of samples or the recording thereof.

### *Use of models or apparatus*

19. (1) A party that intends to rely upon any models, drawings, designs or apparatus at the trial shall give notice in writing of such intention to all the other parties. Every other party shall be entitled, within 14 days of the service of such notice or such other time as the Court may direct, to inspect the same and shall be entitled, on request, to be provided with copies or illustrations of such model, drawing, design or apparatus.

(2) No further or other model, drawing, design or apparatus may be relied upon in evidence by any party save by consent of all of the parties or by permission of the Court.

### *Confidentiality of Documents*

20. Where, upon application made in this regard or otherwise, the Court is satisfied that a document may contain confidential information, the Court may by order limit inspection thereof to a limited class of persons, upon such terms or conditions as appear appropriate to it. The Court may make further orders, upon application or of its own motion, varying the class of persons or terms or conditions, or vacating its order.

#### *Application to amend a patent specification in existing proceedings*

21. (1) An application under section 38 of the 1992 Act by its proprietor for an order to amend the specification of a patent which is the subject of proceedings must be made by motion on notice.

(2) The notice of motion must—

(a) give particulars of—

(i) the proposed amendment sought, and

(ii) the grounds upon which the amendment is sought;

(b) state whether the applicant will contend that the claims prior to the amendment are valid, and

(c) be served by the applicant on all parties and the Controller within 7 days of it being filed.

(3) Unless the Court otherwise orders, the Controller will, as soon as practicable, advertise the application to amend in the Journal.

(4) The advertisement will state that any person may apply to the Controller for a copy of the notice of motion.

(5) Within 14 days of the first appearance of the advertisement, any person who wishes to oppose the application must file and serve on all parties and the Controller a notice opposing the application which must include the grounds relied on.

(6) Within 28 days of the first appearance of the advertisement, the applicant must apply to the Central Office for a return date for the hearing of the application and the applicant shall notify the Controller and all persons opposing the application of that date, upon which the Controller and the persons opposing the application shall be entitled to appear and be heard.

(7) The Controller shall be entitled to appear and be heard on the hearing of the application and shall so appear if so directed by the Court.

(8) Unless the Court otherwise orders or the Controller appears, the applicant must within seven days serve on the Controller any order of the Court on the application.

*Court's determination of question or application*

22. (1) This rule applies where the Controller under section 57(6)(b) of the 1992 Act certifies that the Court should determine the question whether a patent should be revoked.

(2) Any person seeking the Court's determination of that question or application must initiate proceedings for that purpose within 14 days of receiving notification of the Controller's decision.

(3) A person who fails to initiate proceedings within the time prescribed by rule 22(2) will be deemed to have abandoned the reference or application.

(4) A party may apply to the Court to extend the period for initiating proceedings prescribed by rule 22(2) even where the application is made after expiration of that period.

*Request to limit a European patent designating the State under the European Patent Convention*

23. (1) Rules 23(2) to 23(3) apply where there are proceedings before the Court in which the validity of a European patent designating the State may be put in issue.

(2) Where the proprietor of the European patent designating the State intends to file a request under Article 105a of the European Patent Convention to limit the European patent designating the State by amendment of the claims, the proprietor must serve on all the parties to the proceedings a copy of the intended request (including a copy of the intended complete version of the amended claims and, as the case may be, of the amended description and drawings) at least 28 days prior to filing the request with the European Patent Office.

(3) Where a copy of an intended request is served on the party in accordance with rule 23(2), any party may apply to the Court for such directions or other order as may be appropriate.

*Communication of information to the European Patent Office*

24. (1) The Court may authorise the communication of any such information in the Court file in any intellectual property proceedings as the Court thinks fit to –

- (a) the European Patent Office; or
- (b) the competent authority of any country which is a party to the European Patent Convention.

(2) Before authorising the communication of information under rule 24(1), the Court will permit any party who may be affected by the disclosure to make submissions, in writing or otherwise as the Court directs, on the question of



whether the information should be disclosed.

### *European Community designs*

25. (1) Notwithstanding Order 21, where any defence and counterclaim in intellectual property proceedings before the Court sitting as the Community Design Court includes a claim for a declaration of invalidity of a registered Community design:

- (a) the defence and counterclaim shall be filed in the Central Office together with a letter stating that the defence and counterclaim is filed for the purpose of enabling notification in accordance with Article 86(2) of Council Regulation (EC) 6/2002, and
- (b) the proper officer in the Central Office, on behalf of the Court sitting as the Community Design Court will inform the European Union Intellectual Property Office of the date on which the counterclaim was filed, in accordance with Article 86(2) of Council Regulation (EC) 6/2002.

(2) On filing a counterclaim under rule 25(1) the party filing it must inform the Community Design Court in writing that it is a counterclaim to which rule 25(1) applies and that the European Union Intellectual Property Office needs to be informed of the date on which the counterclaim was filed.

(3) Where a Community Design Court has given a judgment which has become final on a counterclaim for a declaration of invalidity of a registered Community design, the registrar on behalf of the Court sitting as the Community Design Court will send a copy of the judgment to the European Union Intellectual Property Office, in accordance with Article 86(4) of Council Regulation (EC) 6/2002.

(4) The party in whose favour judgment is given under rule 25(3) must inform the Community Design Court at the time of judgment that rule 25(3) applies and that the European Union Intellectual Property Office needs to be sent a copy of the judgment.

## **III REGISTERED TRADE MARKS**

26. Except as where otherwise specified, this Part applies to registered trade marks.

### *Reference to the Court by the Controller*

27. (1) This Rule applies where an application is made to the Controller under the 1996 Act and the Controller refers the application to the Court;

(2) Where rule 27(1) applies, the applicant must cause the issue of a special summons seeking the Court's determination of the reference within 14 days of receiving notification of the decision to refer.

(3) If the person referred to in rule 27(2) does not initiate proceedings within the period prescribed by that rule, that person will be deemed to have abandoned the reference.

(4) The period prescribed under rule 27(2) may be extended by –

- (a) the Controller; or
- (b) the Court,

where a party so applies, even if the application is not made until after the expiration of that period.

### *Application to the Court under section 23 of the 1996 Act*

28. An application under section 23 of the 1996 Act must be on notice to all identifiable persons having an interest in the goods, materials or articles.

### *European Union trade marks*

29. (1) Notwithstanding Order 21, where any defence and counterclaim in intellectual property proceedings before the Court sitting as a European Union Trade Mark Court of first instance for the purposes of Article 123 of Council Regulation (EC) 2017/1001, includes a claim for revocation or for a declaration of invalidity of a European Union trade mark:

- (a) the defence and counterclaim shall be filed in the Central Office together with a letter stating that the defence and counterclaim is filed for the purpose of enabling notification in accordance with Article 128(4) of Council Regulation (EC) 2017/1001 and
- (b) the proper officer in the Central Office, on behalf of the Court sitting as the European Union Trade Mark Court will inform the European Union Intellectual Property Office of the date on which the counterclaim was filed, in accordance with Article 128(4) of Council Regulation (EC) 2017/1001.

(2) Where Court sitting as the European Union Trade Mark Court has given a judgment which has become final on a counterclaim for revocation or for a declaration of invalidity of a European Union trade mark, the registrar on behalf of the Court sitting as the European Union Trade Mark Court will send a copy of the judgment to the European Union Intellectual Property Office, in accordance with Article 128(6) of Council Regulation (EC) 2017/1001.

(3) The party in whose favour judgment is given under rule 29(2) must inform the European Union Trade Mark Court at the time of judgment that rule 29(2) applies and that the European Union Intellectual Property Office needs to be sent a copy of the judgment.

(4) The provisions of this rule shall apply *mutatis mutandis* to the Court of Appeal (or, as the case may be, the Supreme Court) sitting as a European Union Trade Mark Court of second instance.

#### IV REMEDIES

30. Except as is otherwise specified or context requires, this Part applies generally to intellectual property proceedings.

##### *Claim for exemplary or aggravated damages*

31. Where a party claims exemplary or aggravated damages under section 128(3) or section 304(3) of the 2000 Act, or section 59 of the 2001 Act, or under common law, the statement of claim or counterclaim must include –

- (1) a statement to that effect; and
- (2) the grounds for claiming such damages.

##### *Applications for delivery up, forfeiture or destruction*

32. (1) A party who applies under section 131 or 255 of the 2000 Act for delivery up or disposal, or under section 61 or 72 of the 2001 Act for delivery up, or under Regulation 14 of the European Union (Protection of Trade Secrets) Regulations 2018 for delivery up or destruction, or for the destruction or recall or removal from channels of commerce under Regulation 4 of the European Communities (Enforcement of Intellectual Property Rights) Regulations 2006 must serve the summons on all identifiable persons who have an interest in either:

- (i) the goods, material or articles within the meaning of sections 131 or 255 of the 2000 Act or section 61 of the 2001 Act; or
- (ii) all or part of any document, object, material, substance or electronic file containing or embodying the trade secret under Regulation 14 of the European Union (Protection of Trade Secrets) Regulations 2018, or
- (iii) goods or materials or implements used in the manufacture of goods within the meaning of Regulation 4 of the European Communities (Enforcement of Intellectual Property Rights) Regulations 2006.

(2) The Court may, insofar as it is appropriate, make provision for the hearing of any person to whom the summons is served under rule 32(1).

## V SERVICE OF DOCUMENTS AND PARTICIPATION BY THE CONTROLLER

### *Service of documents*

33. (1) A summons relating to a registered right may be served –
- (a) on a party who has registered the right at the address for service given for that right in the appropriate register at—
    - (i) the Intellectual Property Office of Ireland; or
    - (ii) the European Union Intellectual Property Office, provided the address is within the State; or
  - (b) in accordance with Order 11A on a party who has registered the right at the address for service given for that right in the appropriate register at—
    - (i) the Intellectual Property Office of Ireland; or
    - (ii) the European Union Intellectual Property Office.
- (2) Where a party seeks any remedy (whether by summons or counterclaim) which would if granted affect an entry in any Intellectual Property Office of Ireland register, that party must serve on the Controller—
- (a) the summons or counterclaim;
  - (b) any statement of claim where relevant (including any amended statement of claim); and
  - (c) any accompanying documents.

### *Participation by the Controller*

34. Where the documents set out in rule 33(2) are served, the Controller –
- (a) may take part in proceedings; and
  - (b) need not serve a defence or other statement of case unless the Court orders otherwise.

## VI APPEALS

35. (1) Every appeal to the Court from an order or decision of the Controller or from the award of an arbitrator under section 74(3) of the 1992 Act, or section 367 of the 2000 Act, shall be made by special summons. The summons shall be served upon the Controller and upon any other interested persons.

(2) Every appeal to the Court from an order of the Minister under section 168 or section 169 of the 2000 Act shall be made by special summons. The

summons shall be served upon the Minister and upon any other interested persons.

(3) Subject to the provision of statute providing for any such appeal, every such appeal to the Court shall be by way of rehearing.

36. The special summons shall state whether the appeal is from the whole or part only, and if so what part, of the order, decision or award, and shall also state concisely the grounds of the appeal. No grounds other than those so stated shall, except with the leave of the Court to be given on such terms and conditions as may seem just, be allowed to be taken by the appellant at the hearing.

37. The special summons shall be issued within such period as is prescribed by the provision of statute providing for such appeal or, in the absence of such provision prescribing a period for appeal, within one calendar month from the date of the order or decision of the Controller, the award of the arbitrator or the order of the Minister (as the case may be) appealed against, or within such further time as the Controller may have allowed for the purpose.”

EXPLANATORY NOTE

*(This note is not part of the Instrument and does not purport to be a legal interpretation.)*

These rules substitute Order 63A and Order 94 of the Rules of the Superior Courts to provide for the establishment of an Intellectual Property and Technology List as a sub-division of the Commercial List and to provide for efficient disposal of Intellectual Property cases in the High Court.

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