



STATUTORY INSTRUMENTS.

S.I. No. 284 of 2020



DISTRICT COURT (INTELLECTUAL PROPERTY) RULES 2020

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The District Court Rules Committee, in exercise of the powers conferred on them by section 91 of the Courts of Justice Act 1924, section 72 of the Courts of Justice Act 1936, section 34 of the Courts (Supplemental Provisions) Act 1961, section 24 of the Interpretation Act 2005, and of all other powers enabling them in this behalf, do hereby, with the concurrence of the Minister for Justice and Equality, make the following rules of court.

Dated this 7th day of February 2020.

Colin Daly

Chairperson

Brian Sheridan

Conal Gibbons

Anne Watkin

Riobard Pierse

Edel Haughton

James Finn

Michelle Johnston

I concur in the making of the foregoing rules

Dated this 27th day of July 2020

Helen McEntee

Minister for Justice and Equality

S.I. No. 284 of 2020

DISTRICT COURT (INTELLECTUAL PROPERTY) RULES 2020

The District Court Rules Committee, in exercise of the powers conferred on them by section 91 of the Courts of Justice Act 1924, section 72 of the Courts of Justice Act 1936, section 34 of the Courts (Supplemental Provisions) Act 1961 and section 24 of the Interpretation Act 2005, do hereby, with the concurrence of the Minister for Justice and Equality, make the following rules of court:-

1. (1) These rules may be cited as the District Court (Intellectual Property) Rules 2020.

(2) These rules shall come into operation on the 12th day of August 2020 and shall be read together with all other District Court Rules for the time being in force.

(3) The District Court Rules as amended by these Rules may be cited as the District Court Rules 1997 to 2020.

2. The District Court Rules 1997 (S.I. No. 93 of 1997) are hereby amended:

- (i) by the insertion, immediately following Order 40E, as Order 40F, of the Order set out in Schedule 1, and
- (ii) by the deletion of Order 99C.

3. (1) The Forms numbered respectively as 40F.01, 40F.02, 40F.03 and 40F.04 in Schedule 2 shall be added to Schedule C to the District Court Rules, immediately following Form 40E.01.

(2) The Forms 99C.1, 99C.2, 99C.3 and 99C.4 shall be deleted from Schedule C to the District Court Rules.

Schedule 1

Order 40F

Intellectual Property

1 Definitions

1. In this Order, unless the context or subject matter otherwise requires—

the “*1992 Act*” means the Patents Act 1992 (No. 1 of 1992);

the “*1996 Act*” means the Trade Marks Act 1996 (No. 6 of 1996);

the “*2000 Act*” means the Copyright and Related Rights Act 2000 (No. 28 of 2000);

the “*2001 Act*” means the Industrial Designs Act 2001 (No. 39 of 2001).

the “*2019 Act*” means the Copyright and Other Intellectual Property Law Provisions Act 2019 (No. 19 of 2019);

“*intellectual property claim*” has the same meaning as in section 2 of the 2000 Act.

2 Requirements of this Order additional to Order 40

2. (1) The provisions of this Order apply to intellectual property claims in the Court.

(2) The requirements of this Order are additional to the requirements of Order 40 as regards claim notices.

3 Additional particulars required in claim notice in intellectual property claim

3. (1) An intellectual property claim notice must:
- (i) state the registered number of any registered intellectual property right to which the claim relates;
 - (ii) set out full particulars of the ownership of any unregistered intellectual property right concerned in the proceedings, or of the right of the claimant to claim infringement;
 - (iii) include particulars of the nature and extent of any intellectual property right relied upon by the claimant

(including the capacity in which the claimant sues if not the registered proprietor or proprietor of the intellectual property right concerned);

- (iv) include particulars of the nature and extent of the alleged infringement of any intellectual property right relied on by the claimant;
- (v) set out the material facts relied on in support of the intellectual property claim;
- (vi) state specifically the relief sought against each respondent and every provision or rule of law relied on in support of each such relief and, where relief under the 1992 Act, 1996 Act, 2000 Act and/or 2001 Act is sought, the particular provisions under which relief is sought and the grounds for each such relief;
- (vii) set out clearly the basis upon which the Court has jurisdiction to hear and determine the intellectual property claim;
- (viii) set out the appropriate costs in the Schedule of Costs payable if the claimant's claim is settled before appearance and defence.

(2) A claim notice in an intellectual property claim must be in accordance with Form 40.01 Schedule C with the modifications necessitated by this rule.

4 Service of claim notice

4. A claim notice in an intellectual property claim must name as respondent, and must be served on, every person against whom relief is sought.

5 Civil application for delivery up

5. (1) An application to the Court in or by way of a civil proceeding for the delivery up of:

- (i) infringing goods, material or articles under section 20 of the 1996 Act; or
- (ii) an infringing article, copy, or device under section 131 of the 2000 Act; or
- (iii) an illicit recording, article or device under section 255 of the 2000 Act; or
- (iv) an infringing product or article under section 61 of the 2001 Act

may be made *ex parte* to any sitting of the Court for the Court District wherein it is believed that the infringing matter concerned is or are in the possession, custody of control of any person.

(2) The application may be grounded upon an information on oath and in writing by or on behalf of the proprietor of the registered trade mark concerned, or the copyright owner or a person having rights conferred by Part III of the 2000 Act or the registered proprietor or his or its authorised representative, as the case may be.

(3) Where an application has been made, and remains undetermined, in a criminal proceeding, for the delivery up of some or all of the same article(s), copies, devices or products, an application under this rule shall not be determined until the determination of the application in the criminal proceeding.

6 Court may direct service of notice of application for delivery up

6. (1) The Court may adjourn an application under rule 5 and direct that person against whom relief is sought be served with notice of the application, in the Form 40F.01, Schedule C, by personal service or by prepaid registered post, on the respondent thereto and on any other person directed by the Court to be served with such notice.

(2) If served personally, the notice must be served at least seven days before the date of the sitting of the Court to which it is returnable; if served by prepaid registered post, the notice must be served at least 14 days before the date of the sitting of the Court to which it is returnable.

7 Form of order for delivery up

7. An order made on an application under rule 5, whether *ex parte* or *inter partes*, may be in the Form 40F.02, Schedule C.

8 Civil application for erasure etc of offending sign or for forfeiture or disposal

8. (1) Subject to sub-rule (4), an application to the Court in or by way of a civil proceeding for:

- (i) an order to cause an offending sign to be erased, removed or obliterated from any infringing goods, material or articles, or to secure the destruction of infringing goods, materials or articles under section 19 of the 1996 Act, or
- (ii) an order for the destruction or forfeiture of infringing goods, material or articles under section 23 of the 1996 Act, or
- (iii) an order for the forfeiture or disposal of an infringing copy, article or, device under section 145 of the 2000 Act, or
- (iv) an order for the forfeiture or disposal of an illicit recording, article or device under section 264 of the 2000 Act, or
- (v) an order for the forfeiture or disposal of an infringing product or article under section 72 of the 2001 Act,

must be in the Form 40F.03, Schedule C, and must be served by the applicant, by personal service or by prepaid registered post:

- (a) on the respondent thereto,
- (b) on any other person appearing to have an interest in the goods, materials, articles, copies, devices or products concerned, and
- (c) on any other person directed by the Court to be served.

(2) If served personally, the notice must be served at least seven days before the date of the sitting of the Court to which it is returnable; if served by prepaid registered post, the notice must be served at least 14 days before the date of the sitting of the Court to which it is returnable.

(3) Where an application has been made, and remains undetermined, in a criminal proceeding, for the delivery up of some or all of the same article(s), copies, recordings, devices or products, an application under this rule shall not be determined until the determination of the application in the criminal proceeding.

(4) Notwithstanding sub-rules (1), (2) and (3), the Court may, where it has determined an intellectual property claim, determine an application under section 19 of the 1996 Act made orally to the Court concerning infringing goods, material or articles which were the subject of that intellectual property claim, without the necessity for the issue of a further notice of application, provided that the Court is satisfied that all persons having an interest in the infringing goods, material or articles are before the Court and have had an opportunity to be heard.

9 Form of order for erasure etc of offending sign or for forfeiture or disposal

9. An Order of the Court on an application under rule 8 may be in the Form 40F.04, Schedule C.

Schedule 2

Schedule C

O. 40F, r.6

No. 40F.01

***Trade Marks Act 1996, section 20**

***Copyright and Related Rights Act 2000, section 131 and section 255**

***Industrial Designs Act 2001, section 61**

Notice of Application for Order for delivery up

District Court Area of

District No.

A.B,

Applicant

C.D,

Respondent

TAKE NOTICE THAT the above-named applicant intends to apply to the sitting of the District Court to be held at on the day of at ... am/pm for an order that

*goods *material *articles *copies *devices *recordings *products in your possession, custody or control infringing the right of the applicant as the

*proprietor of a registered trade mark

*copyright owner in a work

*owner of rights in a performance

*registered proprietor of a design,

namely:.....

be delivered up toof

to be retained by him/her pending the making by the Court of a final order under *section 23 of the Act of 1996 *section 145 *section 264 of the Act of 2000 *section 72 of the Act of 2001 or of a decision not to make such order.

Dated this day of 20

Signed _____
Applicant/Solicitor for the Applicant

To: District Court Clerk at

*To:of....., Respondent

[* delete as appropriate]

***Trade Marks Act 1996, section 20**

***Copyright and Related Rights Act 2000, *section 131 *section 255**

***Industrial Designs Act 2001, section 61**

Order for Delivery Up

District Court Area of

District No.

A.B,

Claimant /Applicant

[C.D,

Defendant/Respondent]

WHEREAS on the application of the above-named A.B., [and having heard said C.D.]

I AM SATISFIED that the said defendant/respondent C.D. has in his/her possession, custody or control

*[in the course of a business or otherwise for the purpose of dealing in any way (including offering or exposing for sale or hire), infringing goods, material or articles]

*[(a) in the course of a business, trade or profession, a copy of a work, knowing or having reason to believe it to be an infringing copy (within the meaning of section 44 of the said Act of 2000) or (b) an article specifically designed or adapted for making copies of a work, knowing or having reason to believe that it had been or was to be used to make infringing copies, or (c) a protection-defeating device article, within the meaning of section 2 of the said Act of 2000]

*[(a) in the course of a business, trade or profession, a recording of a performance, knowing or having reason to believe it to be an illicit recording (within the meaning of section 210 of the said Act of 2000) or (b) an article

specifically designed or adapted for making recordings of a performance, knowing or having reason to believe that it had been or was to be used to make illicit recordings, or (c) a protection-defeating device article, within the meaning of section 2 of the said Act of 2000]

*[(a) in the course of a business, trade or profession, a product knowing or having reason to believe it to be an infringing product or (b) an article, knowing or having reason to believe it to be an infringing article, each within the meaning of section 54 of the said Act of 2001],

namely

IT IS ORDERED that the said infringing *goods *material *article *copy *device *recording *product be delivered up to

of [being the *proprietor of a registered trade mark *copyright owner *owner of rights in the performance *registered proprietor of the design]

AND IT IS ORDERED THAT SAID *GOODS *MATERIAL *ARTICLE *COPY *DEVICE *PRODUCT BE RETAINED BY HIM/HER PENDING THE MAKING BY THIS COURT OF A FINAL ORDER UNDER *SECTION 23 OF THE ACT OF 1996 *SECTION 145 *SECTION 264 OF THE ACT OF 2000 *SECTION 72 OF THE ACT OF 2001 OR OF A DECISION NOT TO MAKE SUCH ORDER.

Dated this day of 20

Signed

Judge of the District Court

[* delete as appropriate]

***Trade Marks Act 1996, section *19 *23**

***Copyright And Related Rights Act 2000, section *145 *264**

***Industrial Designs Act, 2001 section 72**

Notice of Application for Erasure/Forfeiture/ Disposal

District Court Area of

District No.

[A.B,

Claimant /Applicant

C.D,

Defendant/Respondent]

*WHEREAS you have been found to have infringed the registered trade mark of, TAKE NOTICE that application will be made to the sitting of the District Court to be held at ... on the ... day of at ... am/pm for an order to cause an offending sign namely to be erased, removed or obliterated from any infringing goods, material or articles in your possession, custody or control or if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, materials or articles in question.

*WHEREAS *goods *material *copies *articles *recordings *devices *products, namely which you have had in your possession, custody or control or in which you may have or claim a right or interest have been *delivered up *seized and detained under the provisions of said Act, TAKE NOTICE that application will be made to the sitting of the District Court to be held at ... on the ... day of at ... am/pm for an order that the said goods be forfeited or destroyed or otherwise dealt with.

Dated this ... day of 20

Signed

Applicant/Solicitor for the applicant

To: Clerk of the District Court at.....

And to:

And to:

[* delete as appropriate]

***Trade Marks Act 1996, section *19 *23**

***Copyright And Related Rights Act 2000, section *145 *264**

***Industrial Designs Act 2001, section 72**

Order for Erasure/Forfeiture/ Disposal

District Court Area of

District No.

[A.B,

Claimant /Applicant

C.D,

Defendant/Respondent]

WHEREAS ON APPLICATION OF made under [*section 19 *section 23 of the Trade Marks Act 1996] [*section 145 *section 264 of the Copyright and Related Rights Act 2000] [*section 72 of the Industrial Designs Act 2001] in respect of

*signs infringing the registered trade mark of,

*goods *material *copies *articles *recordings *devices *products *delivered up *seized and detained under the provisions of said Act,

namely

AND HAVING HEARD all persons appearing before the Court appearing to have an interest, IT IS ORDERED THAT

*an offending sign namely be erased, removed or obliterated from infringing goods, material or articles, namely in the possession, custody or control of the said respondent

*it not being reasonably practicable for an offending sign namely to be erased, removed or obliterated from infringing goods, material or articles,

namely, that the destruction of said infringing goods, material or articles be secured by **[e.g. their being delivered to and destroyed by and under the supervision of the Superintendent of the Garda Síochána at*]

**said *goods *material *copies *articles *recordings *devices *products be delivered to and forfeited absolutely up toof [being the *proprietor of a registered trade mark *registered proprietor of the design *owner of rights in the performance *copyright owner]*

**said *goods *material *copies *articles *recordings *devices *products be delivered to and destroyed by **[e.g. their being delivered to and destroyed by and under the supervision of the Superintendent of the Garda Síochána at*]*

**said *goods *material *copies *articles *recordings *devices *products be dealt with by[e.g. by sale of them and distribution of the proceeds of sale among the persons appearing to the Court to be interested in them, in the following proportions,*]

THIS ORDER shall not take effect before the expiry of the time within which notice of appeal from this order may be given by any person and, if any such appeal is taken, before the determination of any such appeal.

Dated this ... day of 20

Signed

Judge of the District Court

[*delete as appropriate]

EXPLANATORY NOTE

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

These rules insert a new Order 40F and associated forms to prescribe procedure in respect of the extended jurisdiction in intellectual property in civil matters conferred on the District Court by the Copyright and Other Intellectual Property Law Provisions Act 2019 and amend and update previous provisions in the Rules.

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