



STATUTORY INSTRUMENTS.

S.I. No. 499 of 2021



CIRCUIT COURT RULES (INTELLECTUAL PROPERTY) 2021

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We, the Circuit Court Rules Committee, constituted pursuant to the provisions of section 69 of the Courts of Justice Act 1936, by virtue of the powers conferred on us by section 66 of the Courts of Justice Act 1924 and section 70 of the Courts of Justice Act 1936, (as applied by section 48 of the Courts (Supplemental Provisions) Act 1961), section 27 of the Courts (Supplemental Provisions) Act 1961 and of all other powers enabling us in this behalf, do hereby, with the concurrence of the Minister for Justice, make the annexed Rules of Court.

Dated this 27th day of July 2021.

Patricia Ryan Chairperson

John F. Aylmer

Tomás Keys

Tracy Ennis Faherty

Fiona Duffy

Michele O'Boyle

Sabina Purcell

Mairead Ahern

Rita Considine

James Finn

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

Dated this 24th day of September 2021.

HEATHER HUMPHREYS
MINISTER FOR JUSTICE

S.I. No. 499 of 2021

CIRCUIT COURT RULES (INTELLECTUAL PROPERTY) 2021

1. (1) These Rules, which may be cited as the Circuit Court Rules (Intellectual Property) 2021, shall come into operation on the 12th day of October 2021.

(2) These Rules shall be construed together with the Circuit Court Rules 2001 to 2021.

(3) The Circuit Court Rules 2001 to 2021 as amended by these Rules may be cited as the Circuit Court Rules 2001 to 2021.

2. The Circuit Court Rules 2001 to 2021 are hereby amended by the insertion, immediately following Order 5C, as Order 5D, of the Order set out in the Schedule.

Schedule

“Order 5D

Intellectual Property Claims

Definitions

1. In this Order, unless the context or subject matter otherwise requires—
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 “2019 Act” means the Copyright and Other Intellectual Property Law Provisions Act 2019;
“intellectual property claim” has the same meaning as in section 2 of the 2000 Act.

Additional particulars required in civil bill in intellectual property claim

- 2.(1) An intellectual property claim shall be commenced by the issue and service of an ordinary civil bill, in the Form 2A in the Schedule of Forms, with the modifications necessitated by this rule, which shall:
 - (i) state the registered number of any registered intellectual property right to which the intellectual property 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 plaintiff to claim infringement;
 - (iii) include particulars of the nature and extent of any intellectual property right relied upon by the plaintiff (including the capacity in which the plaintiff 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 plaintiff;
 - (v) set out the material facts relied on in support of the intellectual property claim;
 - (vi) state specifically the relief sought against each defendant 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) state such facts as shall show jurisdiction in accordance with reference number 30 in the Third Schedule to the Courts (Supplemental Provisions) Act 1961.
- (2) The requirements of this Order are additional to the requirements of Order 5 as regards civil bills.

Civil application for delivery up

3.(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 in the Circuit wherein it is believed that such infringing articles, copies or devices are in the possession, custody or control of any person.

(2) The application shall be grounded upon an affidavit sworn by or on behalf of the proprietor of the registered trade mark, the copyright owner or a person having rights conferred by Part III of the 2000 Act, or his or its authorised representative.

(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.

(4) The Court may adjourn an application under this rule and direct that a person against whom relief is sought be served with notice of the application, in such manner as the Court directs.

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

4.(1) Subject to sub-rule (3), 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,

shall be by originating notice of motion grounded upon an affidavit, and shall be served by the applicant, by personal service or by prepaid registered post, at least seven days before the date of the sitting of the Court to which it is returnable:

- (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) 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.

(3) Notwithstanding sub-rules (1) and (2), 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 originating notice of motion, provided that the Court is satisfied that all persons having an interest in the infringing goods, material or articles concerned are before the Court and have had an opportunity to be heard.”

EXPLANATORY NOTE

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

These rules amend the Circuit Court Rules by the insertion of a new Order 5D to prescribe the procedure in intellectual property claims.

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