

Ireland Update: New Irish High Court Intellectual Property and Technology List

In October 2020, the report of the Review of the Administration of Civil Justice Group was published. One of its recommendations was to establish a dedicated list to hear intellectual property ("IP") and technology disputes and that appropriate resources be made available to ensure that the Irish courts remain an attractive forum for resolving these disputes.

This has now been implemented by the Rules of the Superior Courts (Intellectual Property Proceedings) 2021¹ ("new Rules") which came into force on 22 October 2021 and apply to proceedings commenced after that date.

The new Rules amend Orders 63A and 94 of the Rules of the Superior Courts ("RSC") and set up a new dedicated IP and Technology List as a sub-division of the existing Commercial List of the High Court. A specialist judge will be appointed by the President of the High Court to manage these disputes.

Jurisdiction

Order 63A, which governs proceedings in the Commercial Court, has been amended to cover any IP proceedings, or proceedings involving issues of "technological complexity in any field of industry". These can now be assigned to the IP Property and Technology List by a Commercial Court judge. Judges have been granted a wide discretion in this regard. There is no guidance yet on what might be considered an issue "of technological complexity", however this will likely become clearer over the coming months.

Previously the jurisdiction of the Commercial Court to hear IP disputes under Order 63A was limited to proceedings under the:

- Patents Act 1992;
- Trade Marks Act 1996;
- Copyright and Related Rights Act 2000;
- Industrial Designs Act 2001; and
- Passing off.

The new Rules expand this list to include "any proceedings instituted, application made or appeal lodged" relating to:

- Copyright;
- Trade marks;
- Patents;
- Passing off;
- Unfair commercial practices;
- Protected designations of origin and protected geographical indications;
- Design rights;
- Database rights;
- Supplementary protection certificates;
- Trade secrets;
- Unregistered IP rights;
- A right of confidence in information; and
- Issues of technological complexity warranting a hearing.

Case Management

Detailed pre-trial procedures for proceedings falling under the new IP and Technology List are set out in the revised Order 63A. Under these, all cases in the new list will be subject to a case management conference after the close of pleadings. This is to ensure that the manner in which the cases proceed to trial is just and

¹ <https://www.irishstatutebook.ie/eli/2021/si/530/made/en/print>

proportionate in all the circumstances, expeditious and likely to minimise costs. The case management conference is intended to address case-specific issues including whether there is a need for further particulars:

- Expert evidence;
- Inspection;
- Amendments to the pleadings;
- Discovery; and
- The estimated trial duration and so on.

The proceedings can be heard on affidavit or heard on affidavit with oral evidence on a specific issues and / or be determined without discovery or with limited discovery at the judge's discretion.

IP Procedural Rules – Order 94

Order 94 previously set out the rules on patents, designs, trade marks and copyright proceedings. It has been renamed "Intellectual Property" and has been substituted by the new Rules to incorporate Irish and EU legislative developments over the last number of years, the initiation of proceedings, service and remedies as well as the specialised procedural steps for IP proceedings (in particular for patent actions).

Comment

Along with the recent changes to the Circuit Court Rules to extend its jurisdiction to a range of IP disputes for claims up to €75,000, the new Rules represent a much-needed modernisation of the Irish courts' approach to resolving disputes in these areas. These reforms will allow businesses (particularly for those operating in the technology sector or other IP-heavy industries) to effectively enforce their IP rights in a more timely and cost-efficient manner.

How the Maples Group Can Help

We can assist by providing up-to-date guidance in respect of IP right enforcement.

For further information, please reach out to your usual Maples Group contact or the contact below.

Dublin

Claire Morrissey

Head of Data, Commercial & Technology
+353 1 619 2113
claire.morrissey@maples.com

Kevin Harnett

Partner, Litigation
+353 1 619 2036
kevin.harnett@maples.com

Graham O'Doherty

Associate, Litigation
+353 1 619 2162
graham.o'doherty@maples.com

Gillian Ridgway

Professional Support Lawyer
+353 1 619 2130
gillian.ridgway@maples.com

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