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**Commercial Litigation Association of Ireland**

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**Commentary on the New Rules on  
Intellectual Property & Technology Proceedings**

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## **The New Rules**

1. The Rules of the Superior Courts (Intellectual Property Proceedings) 2021, S.I. 530/2021, came into effect on 22 October 2021, substituting Order 63A and Order 94 of the Rules of the Superior Courts with new provisions. The new rules apply only to cases commenced after 22 October 2021.

## **Purpose and Nature of this Document**

2. This document sets out some background information as to the origin of the new rules and a discussion of their content. It is important to stress this document represents solely the views of the author and the proper interpretation and manner of implementation of the new rules will be something which will of course be addressed and developed over time by the judiciary. Nonetheless, the CLAI believes that the provision of this document will be of assistance to practitioners in giving them an initial understanding of the main features of the new rules.

## **Origin of the New Rules**

3. The introduction of an IP and Technology List in the High Court was first mooted in the Bar Council submission in respect of having an Irish seat of the new Unified Patent Court in 2015. A CLAI Group of practitioners in this area from both sides of the profession was formed in 2016 to consider the desirability and, if so, the feasibility of a specialist list.
4. The solicitors in the Group said that parties involved in potential IP disputes frequently queried whether Ireland had a specific court for the disposal of IP (particularly patent) disputes, comparable with those in (for instance) the Netherlands and England & Wales. The Group noted that the Commercial Court was very highly rated amongst industry based in Ireland, this being confirmed by the results of a survey conducted by the IDA of foreign direct investment industries. The Group also noted that, nonetheless, there were a range of factors which to one degree or another deterred indigenous and overseas clients from IP proceedings in Ireland, such as:
  - uncertainty in gaining access to the Commercial List (reflecting that it is frequently not practical to seek to dispose of these sort of disputes without the case management features of the Commercial Court Rules);
  - the duration of IP trials before the Irish courts;
  - the cost and extent of discovery;
  - the absence of reading time for the judge to prepare;
  - the delays in appeals.
5. In tandem, Order 94, governing IP proceedings generally, required modernisation as every legislative instrument referred to in it had been repealed at least a quarter of a century previously.

6. Several of the issues noted above are addressed in the new Rules, and others, particularly the delay in appeals and the cost and extent of discovery, have been considerably ameliorated by separate developments in the interim.
7. The CLAI Group adopted a business case pointing out the direct and indirect impacts on the administration of justice, jobs and revenue of the absence of a specialist court in Ireland and gained IDA and other industry support for a specialist court in Ireland. The proposal was adopted by the Civil Justice Administration Review Group, chaired by the former President of the High Court, Mr. Justice Kelly, after extensive amendment of the proposal through consultation with the Judges of the Commercial List. The CLAI Group developed draft Rules, with the CLAI funding the engagement of junior counsel to prepare the new Order 94. The Ireland for Law Group under the chairmanship of former Taoiseach John Bruton gave its active support to the adoption of the proposed new rules. After examination and some further amendment the Superior Courts Rules Committee approved the new rules in June 2021.

#### **Partial Precedent in the England and Wales Civil Procedures Rules**

8. Practitioners may find it of assistance to be aware that the Civil Procedure Rules for the England and Wales Patents Court were used as a guide, but there are key differences.
9. The relevant CPR Rules are to be found in Order 63, Practice Direction 63 and the Patent Court User's Guide.
10. Proceedings in the England & Wales Patents Court are subject to a case management conference 14 days after the delivery of the Defence. Case management directions as regards disclosure, trial preparation, etc, are sought to be made at that point with the objective of bringing the case to trial within 12 months. Directions are to be made in accordance with the CPR's "*overriding objective of enabling the court to deal with cases justly and at proportionate cost*" (in terms of both the parties' resources and those of the court).
11. In the new Irish rules, the same level of "frontloading" of directions which is a feature of the England & Wales rules is not adopted as that was felt to be insufficiently flexible.

#### **The New Commercial Court Rules: Order 63A**

12. Rule 1 is amended so that it now captures within "*commercial proceedings*" the following:-
  - (d) "*intellectual property proceedings*" - covering proceedings under IP legislation, or for passing off or breach of confidence.

- (e) proceedings connected with IP rights, such as licensing disputes.
- (f) proceedings involving issues of technological complexity in any field of industry – this is the “Technology” rubric.

13. Other definitions also bring out some critical key features of the sub-division:-

- The definition of “*Intellectual Property and Technology List*” makes clear that this is a *subdivision* of the Commercial List.
- Any Judge, including the Judge of the Commercial List, may be assigned as an “*Intellectual Property and Technology List Judge*” to hear “*applications*” or “*proceedings*” in this subdivision.
- Accordingly, whilst special rules apply to proceedings assigned to the IP & T List, there is *no separate presiding* Judge of the IP & T List provided for: IP & T List Judges instead are assigned to hear applications and proceedings in that list, with the Judge of the Commercial List retaining overall control of the IP&T List as it is a sub-division of the Commercial List.

14. The development of the proposal explains this structure. It was originally envisaged that the IP & T List would be a free-standing list similar to, for instance, the Competition List. After consultation with the judiciary, it was proposed that it instead be a sub-division of the Commercial List as it would make the new Court resource-neutral – specifically, without the need for a permanently assigned Judge and Registrar - and instead would use the existing resources and expertise of the Commercial Court. This seemed a good solution given the relatively low volumes of caseload involved.

#### **Entry of IP & T Proceedings into the Commercial List - Assignment to the IP & T List**

15. Rule 4(3) addresses how, in an application to enter proceedings into the Commercial List, assignment to the IP & T List may also be sought.
16. The Solicitor’s Certificate is to address how the proceedings fall within paragraph (d), (e) or (f) of the definition of “*commercial proceedings*” in Rule 1.
17. Rule 4(5) sets out the existing rule that the Judge of the Commercial List “*may direct*” that proceedings be entered into the Commercial List, and now adds that the Judge of the Commercial List “*may direct*” that proceedings be entered into the Commercial List and be assigned to the IP & T List.

18. Critically, Rule 4(7) provides that where the proceedings are IP proceedings within paragraph (d) *“the proceedings shall be entered in the Commercial List and assigned to the Intellectual Property and Technology List, save where such entry and assignment ... would be contrary to the interests of the efficient and just conduct of”* either List.
19. The impact of Rule 4(7) is that the Judge may not refuse IP proceedings entry into either List unless he or she is in a position to conclude that it would undermine the conduct of the lists. The intention is to remove the discretion to refuse entry by reference to the underlying facts of the proceedings in and of themselves (e.g. delay), whilst retaining the ability of the court to exclude proceedings where the court apprehends the resource-heavy manner in which they might be conducted would be unfair to other litigants. This seeks to remove the uncertainty arising from the possibility that factors such as delay would prejudice admission, in circumstances where it is frequently not practical to conduct High Court intellectual property proceedings outside of the Commercial List.
20. The wider discretion continues to exist in its original form for proceedings under (e) (proceedings connected with IP rights) and (f) (technology cases).

#### **Conduct of Proceedings Assigned to the IP & T List – First Phase before the Commercial List Judge**

21. After the initial directions hearing *“further motions or applications”* are to be made to an IP & T Judge: Rule 4(8).
22. All the usual rules regarding pre-trial procedure set out in Section II of Order 63A apply to IP & T proceedings, except the Case Management Conference rules (being Rule 6(1)(XII), Rule 14 and Rule 15): Rule 2(3).
23. This is because the nature of the Case Management Conference (CMC) provided for by these existing rules (the occurrence of which is subject to the discretion of the Court) is limited in nature, being concerned primarily with the clarification of the issues and steps towards ensuring readiness for hearing. CMCs are generally rare, although they have taken place on occasion in certain IP proceedings and with what is perceived to have been some success in narrowing the issues and/or evidence.
24. Section VIII, Rules 32 and 33, make specific additional provision about pre-trial procedure in proceedings in the IP & T List. The steps envisaged by the new rules are as follows:-

- firstly, the Judge of the Commercial List will make directions at the initial directions hearing in the usual way (it is anticipated that these will normally concern the exchange of pleadings);
  - secondly, the Judge then “*shall adjourn the directions hearing*” – save where no CMC is necessary at all - to a date after the close of the pleadings, or such other date as may be directed: Rule 32(1);
  - thirdly, on the adjournment date the Judge of the Commercial List “*shall fix*” a date for the holding of a CMC under Rule 33 before an IP & T Judge designated by the Judge of the Commercial List to hear it, unless the Judge determines that the fixing of the date ought to be adjourned in the particular circumstances.
25. As noted above, in particular cases the Judge of the Commercial List may be satisfied that no CMC is required: it may be unnecessary, for instance, if the proceedings can be heard without any further pleadings or further evidence (proceedings seeking website blocking orders against ISPs who are adopting a neutral position would be an example, or appeals under the Trade Marks Act from the Controller). In that event the Judge of the Commercial List has full power to deal with the proceedings in the normal way, including by way of proceeding immediately to fix a hearing date, or adjourning the motion for directions to give further directions in the usual way.
26. Again, as noted above, the Judge of the Commercial List may not fix a date for the holding of the CMC on the adjournment date, if he or she considers fixing a date for it ought to be adjourned: this might, for instance, arise if it was too early to fix a date due to a jurisdictional dispute or an issue arising in connection with the pleadings.

### **Preparation for the Case Management Conference**

27. Rule 33(6) provides for the lodgement prior to the CMC of books of the pleadings, any affidavits and motion papers.
28. There is a specific emphasis on agreement of orders and directions where possible: Rule 33(7) says that the parties “*must endeavour to agree orders and directions*” and Rule 33(2) provides the Judge of the Commercial List may direct when fixing the date for the CMC that the parties exchange correspondence to that end. It is anticipated that that will typically be directed by the Court.
29. The Judge of the Commercial List may direct that any application for a direction or order as regards the three “matters” (addressed below - manner of preparation for trial, manner of evidence-gathering and manner of hearing) is made returnable to the CMC.

30. This is not to shut out any interlocutory application postdating a CMC should the need arise, such as in respect of discovery or some other matter.

### **Second Phase before IP&T Judge Assigned to the Case Management Conference**

31. CMCs are the exception in normal Commercial Court proceedings, but in the IP&T List the Court is obliged to set a date for a CMC save where the Judge of the Commercial List determines that none is required, as outlined above. In an IP&T List CMC the Court is empowered to control the evidence to an extent beyond the CMCs previously provided for, in non-IP & T List proceedings. This is the technique used, in particular, to seek to sharpen the focus of discovery and reduce the duration of the trial.

32. Rule 33(1) says the purpose of the CMC is to ensure that:-

- the manner in which the proceedings are *prepared* for trial;
- the manner in which the evidence to be presented at trial is *identified and gathered*; and
- the manner in which the proceedings are *heard* and determined

is “*just and proportionate in all the circumstances*”, and represents the most expeditious and cost-minimising manner of undertaking these tasks.

33. As to the second point, the manner of identifying and gathering evidence, the “relevant and necessary” test for discovery is unaffected. The CLAI IP & Technology Court Group deliberately did not seek to address the substantive law in respect of discovery as that was the subject matter of separate consideration by the Civil Justice Administration Review.

34. However, it is most important to note that over the last number of years caselaw in this field has led to a significant reduction in the breadth of categories of discovery routinely ordered by the Court.

35. Largely reflecting existing discovery case-law, the CMC Judge will have to be satisfied that the discovery process sought is one which is just and proportionate in all the circumstances, and the most expeditious and cost-minimising method of identifying and gathering the evidence.

36. The consideration of proportionality, in the context of a CMC where the court has the opportunity to address not only what are the issues, but also the manner in which the issues will be addressed in the anticipated evidence at the trial of the proceedings, may serve to further sharpen the focus of discovery. For instance, the consideration of matters such as :-

- what issues appear to call for expert and factual evidence;
- the precise nature of that anticipated evidence; and
- what is a reasonable trial duration, and thus the extent to which matters can be addressed in evidence

may result the court being in a position to make an informed assessment of the practical degree to which discovery of documents will advance the respective cases of the parties.

37. Furthermore, and importantly, the new Order 94 addresses two specific aspects of discovery in certain IP proceedings.

### **Agenda for the CMC**

38. This is set out in Rule 33(3) and addresses;-

- the need for further/amended particulars and pleadings;
- whether discovery, inspection, experiment and/or interrogatories is/are necessary;
- the issues which appear to call for expert or factual evidence and when evidence ought to be delivered;
- modularisation of the trial;
- appointment of any assessor;
- the estimated duration of trial and time required for advanced reading.

### **Powers of the CMC**

39. These are the same powers as an existing CMC under Rule 6 but the IP & T List CMC additionally possesses the power to determine applications for any direction or order, and to make such directions or orders, to achieve the purpose of the IP&T List CMC.

40. The CMC may be adjourned to allow for compliance and further consideration, e.g., whether some specific discovery might arise out of expert evidence, or setting the duration of the trial in the light of the expert evidence.



## **Options for a Streamlined Procedure**

41. Under Rule 33(4) the IP& T List CMC Judge can direct that the proceedings:-

- be heard on affidavit - the evidence, including expert evidence, could be placed on affidavit if largely uncontroverted;
- be heard with oral evidence only on a specific issue or issues – this would involve the CMC Judge determining the issue or issues which called for evidence in chief and for cross examination, and those which did not;
- be determined without discovery or only limited discovery.

## **The New Order 94**

42. Whilst making important and long overdue provision for the operation of modern Irish and EU legislation in this field, the new Order largely involves an updating of the previous Order 94 without any substantial departure from the overall approach of the previous Order 94.

43. Impacting on discovery is:

- provision for a Product or Process Description, meaning that it not necessary to make discovery of documents about the features of a relevant product or process save where the Court orders it for special reasons;
- provision for a schedule as to the commercial success of a product or process.

44. Order 94, Rule 17 provides for verification of the description or schedule by affidavit: if it cannot be verified (in whole or part) there will have to be discovery to the extent necessary to address the nature of the product or process.

45. New provision is made for advanced notice of experiments (Rule 18) and new provision is made for the use of models or apparatus upon notification (Rule 19).

46. For the first time express provision is made for the Court making an order limiting the inspection of confidential documentation (Rule 20).

**End of Note**