

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Responses from Ireland

Addendum

I. ANSWERS TO QUESTIONS ON PATENTS, DESIGNS AND TRADEMARKS

Civil and Administrative Procedures and Remedies

(a) *Civil judicial procedures and remedies*

1. Specify the courts which have jurisdiction over IPR infringement cases.

The Courts with jurisdiction over IPR infringement cases are the District Court, the Circuit Court, the High Court and the Supreme Court.

2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the rightholder?

Generally the proprietor of an IPR is the party who institutes proceedings. Exclusive licensees may also do so in certain circumstances. Such persons may be legally represented. Proceedings for interim and interlocutory injunctions may take place on affidavit in which case a personal appearance by the right holder would not be necessary.

3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?

Courts may issue a subpoena or order discovery of documents.

4. What means exist to identify and protect confidential information brought forward as evidence?

Justice is required to be administered in public under the Constitution, unless otherwise prescribed by law. The circumstances in which a hearing or part of a hearing may take place in private will be where the interests of justice may otherwise be defeated, such as in proceedings involving the disclosure of business secrets or of secret manufacturing processes.

The parties seeking to protect confidential information must claim privilege and must justify their refusal to produce a document to answer a question on the usual grounds of privilege.

¹Document IP/C/5

5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:

- **injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

Judicial authorities may order interim and interlocutory injunctions and damages pursuant to common law.

Section 47 of the Patents Act 1992 authorises the Courts to order such remedies as injunction, damages, the delivery up or destruction of infringing material, an account of profits derived and declaratory relief. However, it is provided that the Court may not, in respect of the same infringement, both award the proprietor of the patent damages and order that he be given an account of the profits.

Section 78 of the Industrial and Commercial Property (Protection) Act 1927 authorizes such remedies as injunction, damages and the recovery by the proprietor of the design of a sum not exceeding fifty pounds as a contract debt.

Section 18 of the Trade Marks Act 1996 provides that in an action for infringement of a registered trademark all such relief by way of damages, injunctions, accounts or otherwise shall be available to the proprietor as is available in respect of the infringement of any other property right.

6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?

None.

7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

An interlocutory injunction is usually granted on the undertaking of the person seeking it to pay damages. If it transpires that the defendant was wrongfully enjoined, the person seeking the injunction may have to pay damages to the defendant. This may also apply to public authorities and officials.

8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

Length and costs of proceedings vary considerably depending on the type of case. Data are not available on the actual duration of proceedings and their costs.

(b) *Administrative procedures and remedies*

9. **Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.**

There are no applicable administrative procedures and remedies.

Provisional Measures

(a) *Judicial measures*

10. **Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.**

Judicial authorities may order interim and interlocutory injunctions, *Anton Piller* orders and *Mareva* injunctions pursuant to common law.

11. **In what circumstances may such measures be ordered *inaudita altera parte*?**

Measures may be ordered *inaudita altera parte* where an application is of an urgent or surprise nature, or where advance notice of a particular application would result in the destruction of vital evidence.

12. **Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.**

Interim injunctions are generally grounded by the issuing of a writ or summons together with an affidavit which discloses all the relevant and material facts in the case. An interim injunction will generally have force for up to four days. This is done by service of a court order granting the interim injunction.

13. **Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

Length and costs of proceedings vary considerably depending on the type of case. Data are not available on the actual duration of proceedings and their costs.

(b) *Administrative measures*

14. **Reply to the above questions in relation to any administrative provisional measures.**

There are no applicable administrative provisional measures.

Criminal Procedures

20. **Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.**

The courts with jurisdiction over criminal acts of infringement of IPRs are the District Court, the Circuit Court, the High Court and the Supreme Court.

21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?

The Patents Act 1992 in Sections 111, 112 and 113 provides for the following offences:

- Falsification of the register;
- Unauthorised claim of patent rights; and
- False suggestion of official connection with the Patent Office.

The Industrial and Commercial Property (Protection) Act 1927 in Section 150 provides for the following offences:

- Falsely representing a design as registered;
- False suggestion of official connection with the Industrial and Commercial Property Registration Office; and
- Unauthorised use of State emblems.

The Trade Marks Act 1996 in Sections 92, 93, 94 and 97 provides for the following offences:

- Fraudulent application or use of a trademark in relation to goods;
- Falsification of the register;
- Falsely representing a trademark as registered; and
- Unauthorised use of State emblems of Ireland.

22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?

- (i) Both the Gardaí and the Director of Public Prosecutions are responsible for initiating criminal proceedings.
- (ii) Criminal proceedings are generally initiated in response to complaints.

23. Do private persons have standing to initiate criminal proceedings and, if so, who?

- (i) Yes, private persons have standing to initiate criminal proceedings.
- (ii) Common informer: a common informer has a common law right of access to the courts to lay a complaint and to prosecute for an offence in a court of summary jurisdiction unless statute otherwise provides.

24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:

- **imprisonment;**

- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

The Patents Act 1992 in Section 111 provides that a person guilty of falsification of the register shall be liable on summary conviction to a fine not exceeding £1,000 or, at the discretion to the Court, to imprisonment for any term not exceeding six months or to both such fine and to such imprisonment. The Patents Act 1992 at Section 112 provides that a person guilty of an unauthorised claim of patent rights shall be liable on summary conviction to a fine not exceeding £1,000. The Patents Act 1992 in Section 113 provides that a person guilty of falsely suggesting an official connection with the Patent Office shall be liable on summary conviction to a fine not exceeding £500.

The Industrial and Commercial Property (Protection) Act 1927 at Section 150 provides that a person guilty of falsification of the register shall be liable on summary conviction to a fine not exceeding £5. It provides that a person guilty of falsely representing a design as registered shall be liable on summary conviction to a fine not exceeding £5. It provides that a person guilty of falsely suggesting an official connection with the Industrial and Commercial Property Registration Office shall be liable on summary conviction to a fine not exceeding £20. Section 151 provides that a person guilty of unauthorised use of State emblems shall be liable on summary conviction to a fine not exceeding £20 and in the case of a continuing offence a further fine not exceeding £5 for every day on which the offence continues.

The Trade Marks Act 1996 in Section 92 provides that a person engaging in the fraudulent application or use of a trademark in relation to goods will be liable on summary conviction to imprisonment for a term not exceeding six months or to a fine not exceeding £1,000 or to both; that person may be liable on conviction and indictment to imprisonment for a term not exceeding five years or to a fine not exceeding £100,000, or to both.

The Trade Marks Act 1996 in Section 93 provides that a person who commits the offence of falsification of the register shall be liable on summary conviction to imprisonment for a term not exceeding six months or to a fine not exceeding £1,000 or to both, or on conventional indictment shall be liable to imprisonment for a term not exceeding two years or to a fine not exceeding £200,000, or to both. The Trade Marks Act 1996 in Section 94 provides that in the case of an offence of falsely representing a trademark as registered a person guilty of such an offence shall be liable on summary conviction to a fine not exceeding £1,000 and, in the case of a continuing offence, to a further fine not exceeding £100 for every day in which the offence continues. The Trade Marks Act 1996 in Section 97 provides that a person guilty of unauthorised use of State emblems of Ireland shall be liable on summary conviction to a fine not exceeding £1,000 and, in the case of a continuing offence, to a further fine not exceeding £100 for every day the offence continues.

25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.

Length and costs of proceedings vary considerably depending on the type of case. Data are not available on the actual duration of proceedings and their costs.