

THE HIGH COURT

[2002 No. 6045P]

BETWEEN

JOHNNY DUHAN

PLAINTIFF

AND

RADIUS TELEVISION PRODUCTION LIMITED, TV MATTERS B.V. AND RTE COMMERCIAL ENTERPRISES LIMITED

DEFENDANTS

Judgment of Mr. Justice Herbert delivered on the 18th day of July, 2007.

1. This application for discovery of documents, brought against the first and the second named defendants, was referred to this court by the Master of the High Court, in exercise of the jurisdiction conferred upon him by the provisions of O. 63 r. 7 of the Rules of the Superior Courts.

2. In his statement of claim delivered on 23rd December, 2002, the plaintiff claims to be the author and entitled to the copyright and moral rights in the music and words of a song called "The Voyage".

3. In their amended defence delivered on 28th April, 2006, the defendants plead that they are strangers to the precise authorship and copyright entitlements alleged by the plaintiff to subsist in the said song and make no admissions in this regard.

4. In his statement of claim, the plaintiff asserts that this court has power, by virtue of Council Regulation (EC) No. 44/2001, of 22nd December, 2000, to hear and determine his claim against the defendants and, this court should assume jurisdiction accordingly pursuant to the provisions of Articles 5(1) and 3 of the said Regulation. This is denied by the defendants in their amended defence, who also plead, in the alternative, that no cause of action subsists on the part of the plaintiff in respect of the following matters:-

(a) Complaints arising out of or in connection with the Copyright and Related Rights Act, 2000 which pre-date 1st January, 2001, and,

(b) Complaints which relate to Acts or the authorisation of Acts outside this State or alternatively, outside the European Union.

5. It is pleaded in the statement of claim that the first named defendant is a limited liability company engaged, *inter alia*, in the business of music and television production and has its registered office at 37-39 Fitzwilliam Square, Dublin. The second named Defendant is described as, "a Dutch Company" engaged, *inter alia*, in the business of television production with its registered office at De Ruyterkade 142, 1011 AC, Amsterdam.

6. In the statement of claim it is alleged that on a date unknown in or about 1999, at the premises of the Royal Dublin Society and on diverse dates and at diverse venues in the United States of America, particulars of which would be furnished following discovery, certain persons - believed to be Anthony Kearns, Ronan Tynan and Finbar Wright, performing under the style and title of, "The Irish Tenors", without the licence or consent of the plaintiff, performed in public the said song, or an unlicensed adaptation thereof, thereby infringing the plaintiff's copyright in the work. In replies to particulars dated 6th June, 2003, this adaptation is identified as consisting of a small number of unlicensed alterations to the words of the song. The plaintiff alleges that the defendants were at all times aware that these alleged performances infringed his copyright in the said song.

7. The plaintiff claims, that following upon this performance at the premises of the Royal Dublin Society, the first and second named defendants and each of them, their servants or agents, have infringed his copyright by, *inter alia*, without his consent:-

"[Paragraph 11] Reproducing or causing to be reproduced the said song or the unlicensed adaptation of it, performed by, "The Irish Tenors" in the form of video recordings, compact discs, radio cassettes or gramophone records.

[Paragraph 12] Accompanying these reproductions with literature containing the words of the song or the unlicensed adaptation of it.

[Paragraph 14] Selling or offering for sale to the public, large numbers of the items described at paragraphs 11 and 12 above."

8. In addition to injunctive relief, an order for delivery-up and interest pursuant to the provisions of s. 22 of the Courts Act, 1981, the plaintiff also claims:-

"[Paragraph 8] An inquiry as to damages, including additional damages for infringement of copyright and infringement of moral right or, at his option, an account of the profits made by the Defendants, their servants or agents, by reason of their infringement of copyright and infringement of moral rights, and

[Paragraph 9] An Order for the payment of all sums found due to the Plaintiff upon taking such inquiry or account."

9. In their amended defence, in addition to the pleadings to which I have already referred and, to a general joinder of issue on each of the several allegations contained in the statement of claim, the Defendants also plead as follows:-

"[Paragraph 2] They deny any liability for breach of copyright by reason of the alleged publication, manufacture, copying or distribution of all or any of the alleged works outside this State.

[Paragraph 4] that they will rely, *inter alia*, upon the following licensing and licence-fee payment arrangements, which they plead were in place at all material times in relation to the manufacture distribution, sale and broadcasting of the said work by means of CD/MC, Video, VHS and TV:-

CD/MC

(a) The manufacture, distribution and sale of CD/MC Worldwide was granted to Point Entertainment Limited and/or Point

Entertainment Inc. Pursuant to this Point Entertainment Inc. was licensed under American law by way of compulsory licence provision to manufacture and/or distribute CD/MC within the United States by virtue of licence No. 100-322/0178. The manufacture and/or distribution of such products was governed by American law and Point Entertainment Limited/Point Entertainment Inc. were entitled to seek and receive such licence from and were liable on foot of such licence to make appropriate payments for and on behalf of the Plaintiff. In the premises, any liability arising in relation to the sale, manufacture or distribution of CD/MC was the liability of Point Entertainment Inc/Point Entertainment Limited. These Companies went into Receivership or Liquidation in or about March, 2000, following which the First and/or Second-named Defendants sought to deal directly with the Plaintiff in respect of the further exploitation of rights. The First and Second-named Defendants deny any liability to the Plaintiff arising from the exploitation of rights by Point Entertainment Limited/Point Entertainment Inc.

(b) Subsequently, such distribution took place in the United States and Canada through Navarre and in Ireland through RMG from the 10th March, 2000. The Plaintiff was made aware of this and the First and Second-named Defendants offered to pay the appropriate market rate relative to rights of this type.

(c) MCPS Licence was issued dated the 23rd November, 1999 in respect of CD/MC sales in this jurisdiction, the distribution of monies which was a matter for MCPS which at all times acted as agent for the Plaintiff. The First and Second-named Defendant are strangers to the precise amounts received by MCPS or the Plaintiff arising in relation to these Licences but will assert that such exhausts the Plaintiff's rights in respect of such copyright and/or that the amounts payable should be given as credit to these Defendants.

VIDEO

(a) All video copies distributed and/or sold in the United States or Canada were manufactured by Point Entertainment Inc/Point Entertainment Limited until the 10th March, 2000 and it is denied that any liability arises on the part of the First and Second-named Defendants arising from such importation, distribution or sale. Distribution in a sale in the United States and Canada was effected via Navarre as from the 10th March, 2000. The Defendants will rely on any payments made to the Plaintiff by or on behalf of Navarre as being in satisfaction of the Plaintiff's claim.

(b) The sale-manufacture or distribution of VHS in Ireland was carried out by the Third-named Defendant and the First and Second-named Defendants will rely upon any arrangements or payments made by or on behalf of the Third-named Defendant. Insofar as any liability may be established by the Plaintiff, they will seek credit against the amounts paid in respect of the aforesaid rights.

T.V.

(a) In relation to broadcasting by television, the necessary Synchronisation Licences were obtained for PBS/USA and Canada.

(b) The First and Second-named Defendants will accordingly contend that any liability arising in respect of CD's, tapes or similar media up until the 10th March, 2000 are the responsibility of Point Entertainment Inc/Point Entertainment Limited and not that of the First and Second-named Defendants. The First and Second-named Defendants will seek credit from the Plaintiff in respect of any monies paid to the Plaintiff or his agent in respect of the alleged exploitation of his Copyright without prejudice to the First and Second-named Defendant's contention that such was not the liability of those Defendants."

10. The defendants deny that the plaintiff has suffered the alleged or any loss and damage and in the alternative plead that any loss and damage suffered by him, (which they plead he has failed to mitigate), was caused and/or contributed by the wrongful acts or omissions of the third named defendant for which they plead they are not liable in law. At para. 22 of their amended defence the first and second named defendant's state that they have paid money into court without admission of liability and say that it is sufficient to satisfy the plaintiff's claim.

11. By a notice for particulars dated 3rd December, 2002 or 27th February, 2003, Patrick S. Cahill, then solicitor for the second named defendant only, sought particulars arising from the plaintiff's statement of claim. The plaintiff furnished replies to these particulars dated 6th June, 2003. By notice dated 4th July, 2003 Patrick S. Cahill, then solicitor for the second named defendant only, sought further and better particulars arising out of the replies of 6th June, 2003. By a notice of change of solicitor dated 18th July, 2003 Patrick S. Cahill, solicitor was appointed solicitor for the first named defendant also. The papers lodged for the use of this court at the hearing of this application do not contain any replies to this request for further and better particulars or make any reference to steps on the part of the first and second named defendants to compel the plaintiff to furnish answers to the same. A notice of intention to proceed dated 15th February, 2006 was served on behalf of the Plaintiff on the solicitors on the Court Record representing the first and second named defendants and also on the solicitors representing the third named defendant. However, no objection was taken at the hearing of this motion for discovery that the pleadings were not closed or that particulars remained outstanding.

12. The present motion on notice was brought pursuant to the provisions, - though not so expressly stated in the motion paper, - of O. 31, r. 12 of the Rules of the Superior Courts as inserted by the Rules of the Superior Courts (No. 2) (Discovery) 1999, (Statutory Instrument No. 233/1999) which came into operation on 3rd August, 1999. Application was not made pursuant to the provisions of the European Communities (Enforcement of Intellectual Property Rights) Regulations, 2006 (Statutory Instrument No. 360/2006) which became operational on 5th July, 2006. These Regulations, transposed into Irish law - but outside the time stipulated by Articles 20 and 21 of The Directive 2004/48 EC of the European Parliament and of the Council of 29th April 2004 on the Enforcement of Intellectual Property Rights. Regulation 3 of S.I. No. 360 of 2006, makes provision for an order for disclosure of various categories of information if the Court considers it just and proportionate.

13. Regulation 3(1) of S.I. No. 360 of 2006, provides:-

"A claimant may apply to the court for an order that information regarding the origin and distribution networks of goods or services which infringe [the emphasis is mine] an intellectual property right shall be disclosed to the claimant by one or more of the relevant persons specified in paragraph (5)."

14. Whether or not the power of ordering disclosure applies only after an infringement has first been established or admitted must await argument in another case and if so, whether the transposition of Regulation 3(1) is in accordance with the terms of Article 8, ("Right to Information") of Directive 2004/48/EC, which provides that:-

"... in the context of proceedings concerning an infringement [the emphasis is mine] of an intellectual property right ... the competent judicial authorities may order, ... etc."

15. The issue of whether the provisions of S.I. No. 360 of 2006, are procedural rather than substantive so as to apply to events which occurred prior to 5th July, 2006, would also have to be addressed.

16. Even though Directive 2004/48/EC was transposed into Irish law outside the date fixed by the terms of Article 20 and 21 of the Directive and, perhaps, also transposed incorrectly, it still cannot be applied with direct horizontal effect in litigation between citizens - see Case C - 192/94 *El Corte Ingles S.A. v. Rivero* [1996] E.C.R. I - 1281; Case C - 148/78 *Pubblica Ministero v. Ratti* [1979] E.C.R.I. - 1629; Case C - 51/76 *Verbond van Nederlandse Ondernemingen v. Inspecteur der Invoerrechten en Accijnten* [1977] E.C.R.I. - 113. However, it was not argued, much less demonstrated on behalf of the defendants that the power of ordering discovery of documents on oath, confirmed to this Court by the provisions of O. 31, r. 12 of the Rules of the Superior Courts are in conflict with the provisions of Directive 2004/48/EC, as transposed by S.I. No. 360 of 2006 and should not be therefore applied by this court in the instant case - see *Factorame Limited v. Secretary of State for Transport* (No. 2) [1991] 1 A.U.E.R. 70.

17. It is provided by Article 2(1) of Directive 2004/48/EC, that:-

"Without prejudice to the means which are or may be provided for in Community or national legislation, in so far as these means may be more favourable for rightholders, the measures, procedures and remedies provided for by this Directive shall apply in accordance with Article 3, to any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member State concerned."

18. Regulation 3(6) of S.I. No. 360 of 2006 provides that:

"(6) Nothing in this Regulation affects -

(a) any right of the claimant to receive information under any other enactment or rule of law, and

(b) any other power of the court."

19. Having regard to the judicial development of the law relating to discovery in intellectual property cases in this State, it is clear that an order for discovery may be made in aid of establishing an infringement of copyright as well as in aid of providing a just, effective and sufficient remedy to the copyright owner or licensee whose right has been infringed. It is a condition precedent to the making of an order for disclosure of information pursuant to the provisions of Regulation 3 of S.I. No. 360 of 2006, - European Communities (Enforcement of Intellectual Property Rights) Regulations, 2006, (and provided in the instant case that this Regulation applies to pre 5th July, 2006 infringements), that infringement is first established. Consequently, the discovery procedure provided by the terms of O. 31, r. 12 of the Rules of the Superior Courts is manifestly more favourable to rightholders as more extensive in the scope of its application.

20. Regulation 3(2) of S.I. No. 360 of 2006, provides that the court may order information to be disclosed if it considers it just and proportionate, having regard to the rights and privileges of the alleged primary infringer and also of any alleged secondary infringers. In my judgment, this Regulation confers no wider power on this Court of ordering disclosure of documents than the provisions of O. 31, r. 12(1) of the Rules of the Superior Courts as explained by Finlay C.J., in *Ryanair plc v. Aer Rianta* (Unreported, Supreme Court, 2nd December, 2003), nor does it establish a procedure more favourable to the rightholder. I am quite satisfied therefore, that this Court may continue to apply the provisions of O. 31, r. 12 of the Rules of the Superior Courts in this case.

21. Generally, an application for discovery of documents by an alleged rightholder in copyright cases may arise in one or more of the following circumstances: where infringement is disputed; in aid of proof of infringement within the normal principles as laid out in *Sterling-Winthrop Group Limited v. Fabenfabriken Bayer A.G.* [1967] I.R. 97; to enable the rightholder to exercise the option of seeking an inquiry as to damages or an account of profits (even though ultimately the latter remedy is at the discretion of the court); and to assist in establishing damages for infringement of copyright and/or conversion or alternatively, the amount of profits wrongfully made by the infringer.

22. In his masterly judgment in *House of Spring Gardens Limited, Armourshield Limited and Sacks v. Point Blank Limited and Others* [1984] I.R. 611, (a case which involved *inter alia*, a claim for infringement of copyright in cutting patterns for body armour), Costello, J. (as he then was) at p. 626 noted that:-

"In February, 1982 Anton Piller orders (see *Anton Piller K-G v. Manufacturing Processes Ltd.*) were made in this country, in England and in Jersey and these were followed by orders for discovery. As a result a great deal of documentary evidence was produced at the hearing and in addition I heard a considerable amount of oral evidence."

23. In *Norwich Pharmacal v. Customs and Excise Commissioners* [1974] A.C. 133 (an action for discovery; names and addresses of importers infringing the plaintiff's patent were not known to them but were known to the defendants), at 139 Lord Denning held as follows:-

"The cases warrant two propositions. First, discovery can be granted in aid of any reasonable action which the plaintiff has brought, or is intending to bring, or is capable of bringing, against the defendant. Thus, where the defendant has been found guilty of infringing a patent, he can be ordered to give the names and addresses of persons to whom he has sold the goods, both in aid of damages (see *Murray v. Clayton* [1872] L.R. 15 Ex 115) or of an account of profits (see *Saccharin Corporation v. Chemicals and Drugs Company* [1900] 2 Ch. 556.) But that it only in aid of an existing or future action against the defendant."

24. In *CHC Softwear Care Limited v. Hopkins and Wood* [1993] F.S.R. 241, the plaintiff claimed an inquiry as to damages for slander of title, malicious falsehood and trade libel alleged to be contained in a letter sent by the defendants to a named person on 4th November 1991 and, in a number of similar letters sent to other persons around that time. The majority of these other persons were not known to the plaintiff. Five such other persons were however named in the statement of claim. The defendants delivered a full defence but did not deny sending these letters. The plaintiff sought an order that the defendants disclose the names and addresses

of all persons to whom the defendants had sent letters similar in content (in whole or in part) to the letter of 4th November, 1991. At p. 249 of the judgment Mummery J. stated as follows:-

"The plaintiff wishes to discover the identity of the recipients of the letters so that it can then communicate with the recipients and disabuse them of any false impression created in their minds by the defendants' letter and to diminish or eliminate the risk that Crescendo software is being withdrawn or not acquired because of problems of infringement of intellectual property rights. The plaintiff hopes by sending such letters to mitigate the alleged damage.

The motion is supported by evidence that letters were indeed sent in similar terms to persons other than Roger Thomas. A copy of a similar letter sent on 6 November to Mr. Noseley, manager of the NHS procurement centre at Bristol is produced. Although the letters were not produced, there is evidence that similar letters were sent to the Trent Regional Health Authority and to the North Western Regional Area Authority. The probabilities are that letters in similar terms were circulated to other hospitals and health authorities."

25. At p. 250 of the judgment Mummery J. then continues as follows:-

"In my judgment, the court has jurisdiction at this stage to order the defendants against whom a reasonable cause of action is pleaded, to make full discovery of names and addresses of the persons to whom the letters alleged to be actionable were sent.

26. The recipients of the letters are not wrongdoers, but, in my view, the jurisdiction of the court is not confined to the case of identifying wrongdoers. The copies of the letters sent by the defendants and any distribution list of names and addresses of recipients are documents relevant to the issues pleaded in this action. The fact that the immediate purpose for which the defendant seeks discovery is to write to the recipients to set straight the record does not oust the jurisdiction of the court to order discovery of relevant documents. The plaintiff's purpose is a legitimate purpose relating to the issues raised in the action. The plaintiff wishes to take reasonable steps to protect itself against the damaging consequences of the alleged tortious document disseminated by the defendants. The plaintiff is not seeking to use the process of discovery against the defendants for some extraneous or improper purpose. It is not seeking to obtain documents on which to found, create or complete a cause of action against persons who are not presently parties to the proceedings. It is not seeking to use the documents for any purpose which is an abuse of the process of discovery. In those circumstances I am satisfied that the court has jurisdiction."

27. Finally at p. 251 of the judgment the learned Judge holds that:-

"The order sought for disclosure of names is not an oppressive fishing expedition for the purposes of maintaining an action or bringing other actions against other persons. There is before the Court uncontradicted evidence that letters were sent in identical or similar terms to other persons other than the particular one (Roger Thomas) identified in the statement of claim."

28. In the instant case, by the notice of motion dated 21st February, 2007 the plaintiff seeks the following reliefs:-

"1. An order for discovery of all documents, files, notes, records, correspondence and memoranda in the first and second defendant's power possessions or procurement relating to the matters at issue herein and in particular:-

(a) All the videos, compact disks, DVDs, MCs, audio cassettes and audio-video recordings in any other medium of each and every recording of every performance of the Plaintiff's song "The Voyage" or any alteration thereof, produced by or on behalf of the Defendants their servants or agents.

(b) All documents, literature, packaging sleeves, inserts, booklets and lyric notes produced by or on behalf of the Defendants, their servants or agents, containing any reference whatsoever to the song "The Voyage" the words of the said song or any adaptation thereof.

(c) All documents referring to or evidencing the geographical extent of circulation and the number of copies circulated of all recordings of the song "The Voyage" or any alteration thereof or any literature containing a reference to the said song, the words of same or any alteration of the words thereof.

(d) All documents, accounts, invoices, sales records, distribution records and stock records in relation to and arising out of the circulating and making available to the public by the Defendants and each of them their servants or agents, of recordings of the song "The Voyage" and/or literature relating to same.

(e) All documents evidencing all payments alleged to have been received by the Plaintiff in respect of the exploitation of his work as alleged at para. 4 of the defence."

29. The motion is grounded on the pleadings and on the affidavit of Edward McGarr, solicitor for the Plaintiff, wherein he deposes *inter alia* as follows:-

"8. I say and believe that the documents requested at para. 1(a) of the notice of motion are both relevant and necessary in the context of the allegation that the defendants and each of them reproduced the Plaintiff's song or an adaptation of the Plaintiff's song and thereby infringed the Plaintiff's copyright.

9. I say and believe that the documents requested at para. 1(b) of the notice of motion are relevant and necessary in the context of the allegation by the Plaintiff that the Defendants made available to the public the Plaintiff's work or adaptation of the Plaintiff's work.

10. I say and believe that the documents at para. 1(c) of the notice of motion are relevant and necessary in order to enable the Plaintiff to ascertain the full geographical extent of the infringement of the Plaintiff's copyright by the Defendants and each of them.

11. I say and believe that the documents requested at para. 1(d) of the notice of motion are relevant and necessary in the context of enabling the Plaintiff and the Court to ascertain the extent of the infringement of the plaintiff's work and to enquire into and take an account of the profits earned by the Defendants, their servants or agents by reason of their infringement of the plaintiff's copyright.

12. I say and believe that the documents requested at para. 1(e) of the notice of motion are relevant and necessary in the context of the allegation by the First and Second Defendants that the plaintiff received such payment.

13. I say and believe that discovery of each of these categories of documents is necessary for the purpose of disposing of the action fairly and necessary for the resolution of the matters in issue between the parties and is likely to lead to a saving in costs. In the event of discovery of each of these categories of documents being made it shall be open to the parties to seek admission to those documents (by way of interrogatories or notice to admit) thereby reducing the amount of oral evidence required to be given and consequently reducing the costs of the trial of the action.

14. Furthermore, I say and believe that each of the categories of documents relate to facts which are material to the central issue of liability in the proceedings and without which the plaintiff shall be unable to prosecute his case."

30. By a letter dated 28th February, 2006, sent in compliance with the provisions of O. 31, r.12 of the Rules of the Superior Courts, the solicitors for the plaintiff sought voluntary discovery of these documents and others. By a letter dated 2nd May, 2006, the solicitors for the defendants agreed to make voluntary discovery of three categories of documents but declined to make discovery of the categories of documents in respect of which the plaintiff now seeks an order for discovery from this court. I believe that it is important that I set out in full what I consider to be the relevant paragraphs of this lengthy letter of 2nd May, 2006, which are echoed in the replying affidavit of Eamonn Shannon, solicitor, of Patrick S. Cahill, solicitors for the Defendants. I have taken the liberty of renumbering the paragraphs of this letter so that it may correspond with the terms of the notice of motion herein.

"Category 1(a)

This request is declined in the first instance, it is not a request for documents at all. It is something in the nature of a product recall and requires production of every video, disc, DVD and other media used for the performance of a song and neither accords with the definition of "document" nor does it have even the most peripheral connection with the issues in the case.

Category 1(b)

This suffers from the same deficiency as the previous request in the first instance, it does not limit itself even to samples of the relevant documents, literature or sleeves but purports to seek discovery of every item of produce, packaging, despite the fact the many of these will undoubtedly have been sold, distributed or otherwise disposed of. Apart from establishing the content of the song or its adaptation which can be done by reference to a sample, the remainder of the request appears to have no connection with the issues in the case whatsoever. We also note that it does not attempt to clarify what geographical ambit it is supposed to have and we take it that you have no intention of clarifying this position.

Category 1(c)

It would be more helpful if the Plaintiff, in the first instance, were to make clear with reference to what circulation he himself is making the claim. The Plaintiff has insisted in producing a claim in terms which are barely comprehensible as to the geographical ambit. Read literally the request would be in producing every invoice, shop receipt or other document relating to the distribution of product across a number of Continents. Our client has no difficulty in principle with attempting to deal with the issue of circulation but in the first instance, it would be helpful if the Plaintiff made clear what complaint he was making as regards the circulation and in what Countries. It would then be possible to establish the character of documentation which might conceivably have some relevance to this. We appreciate fully that the Plaintiff has made a decision not to provide any useful information about the nature of his claim but, in seeking Discovery, he will have to make clear what is the purpose of documentation sought. We, therefore, invite you to respond setting out with some degree of clarity the nature of the request you are making.

Category 1(d)

In keeping with the previous request, this appears to be unlimited as to geographical extent, time or character. The purpose is allegedly to assist the Court to ascertain the extent to an infringement of Plaintiff's work and take an account of profits. The Plaintiff is again invited to indicate what Countries or even Continents are envisaged in this request. If it assists, the Defendant would suggest that it would make available its own records in relation to turnover of the product and we are prepared to allow your client to examine those records if they assisted. This would both be an ease of our client by not being required to discover the irrelevant and the trivial while allowing your client an opportunity to form a view on both the extent of the circulation and likely profits. This can be done without prejudicing your right to seek further documents if you are dissatisfied with what is produced.

Category 1(e)

The Defendants are strangers to the precise payments received by the Plaintiff but the Defendants are prepared to furnish such documents as they have relating to the payment to the Plaintiff in respect of the exploitation of his work.

We find it bizarre that you would suggest that the request should be in any sense likely to reduce the amount of costs and we would again invite the Plaintiff to attempt to set out, in a lucid and moderately coherent form, the extent and character of the documents which he requires and not merely to demand access to each and every single item of product and each and every document however trivial.

...

As an entirely different course, however, we would like to make clear our willingness to in principle to allow your client's accountant to have access to the records of the First and Second-named Defendants and, for that purpose to ensure that they are brought into the jurisdiction to facilitate your client's Accountant. Ordinarily these records would be located at TV Matters BV De Ruyterkade 142, 1011 AC Amsterdam, The Netherlands, but we are prepared to facilitate your client and to make available records to the Accountant which will serve a far more useful purpose than simply providing a blizzard of documents of the most tenuous relevance. When your client and his Accountant have had an opportunity to consider this documentation it will then be possible to deal with any outstanding matters which you think may be relevant, and we would be prepared to undertake this course by way of a genuine mitigation of costs as well as of avoiding the situation where there is simply a vast amount of utterly useless paper."

31. Issue is joined, even though by a pleading in the alternative – in the amended defence on the question of whether alleged infringements of copyright by the defendants outside this Member State of the European Union are justiciable before this court, having regard to the provisions of the Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters 1968, [The Brussels Convention]. No application has been made by any party to these proceedings for a trial of this issue as a preliminary point of law pursuant to the provisions of O.25, r. 1, of the Rules of the Superior Courts. Therefore, in my judgment, the Court should proceed – without prejudice to its ultimate decision on this issue of jurisdiction – to determine the present interlocutory application on the basis of the certificates as to jurisdiction endorsed on the plenary summons and on the statement of claim.

32. The effect of what is pleaded a paras. 1, 2, 4 and, 21 of the amended defence is to put in issue the existence of and, not merely the alleged infringement by the defendants of, the alleged intellectual property rights of the plaintiff in the United States of America and Canada. In my judgment this court should decline to investigate these matters. Accordingly the Court will decline to order discovery of any documents touching upon events which occurred in the various States of the United States of America or Canada.

33. In the case of *Pearce v. Ove Arup Partnership Limited and Others* [2000] Ch. 403, Roch, L.J., (giving the judgment of the Court of Appeal), and referring to the decision of Vinelott J. at first instance, said at pp. 439 and 440:-

“It is important to keep in mind that the question which he actually had to decide was whether to make a declaration that the defendant had no rights under the copyright, unfair competition or trademark laws of the United States which would be infringed by what the plaintiff was purporting to do. He was invited to investigate the existence and validity of the rights claimed; not to decide whether there had been infringement of rights the existence and validity of which were not an issue. He was, in our view, plainly correct to refuse to make the declaration sought, for the reason given in the penultimate paragraph of his judgment, at p. 89:

‘in the instant case there is no evidence that, if the validity of the rights claimed were justiciable in the English courts, the decision of the English courts would be treated as binding on any of the States of the United States of America and it would, in my judgment be an exercise in futility to allow these claims, which raise complex issues which may require a survey by the English courts with the assistance of experts of the laws of each of the State of the United States of America, to continue.’”

34. I adopt what was held by the Court of Appeal as being an accurate reflection of the law in this Member State of the European Union also.

35. Unlike what occurred in *Allibert S.A. v. O'Connor and Can-am Containers Limited* [1982] I.L.R.M. 40, there is no agreement in the instant case between the parties – at least the court was informed of none at the hearing of this application – that the issue of damages should be deferred until the issue of liability had been determined. This is unfortunate, as such a course could lead to a very considerable saving in time and costs spent on discovery, but the court must accept the situation as it finds it and, cannot impose such a course on unwilling parties.

36. Without in any way departing from the requirements of O. 31, r. 12 of the Rules of the Superior Courts, as explained by Finlay C.J. in *Ryanair plc v. Aer Rianta* (above cited), in my judgment this Court must now construe this rule so far as the language of the rule permits, consistently with Directive 2004/48/EC on the Enforcement of Intellectual Property Rights and, in particular with Article 8 thereof – see *Marleasing S.A. v. La Comercial Internacional de Alimentación S.A.* [1990] E.C.R. I-4135. In my judgment, while the burden of establishing a case for discovery of documents rests on the claimant, under the provisions of Article 8 of Directive 2004/48/EC as well as under O.31, r. 12 of the Rules of the Superior Courts, as interpreted in *Ryanair plc v. Aer Rianta* (above cited), the clear purpose of the Directive is to ensure that the rightholder, consistent with justice and proportionality, is given every assistance in establishing his claim not alone against the primary infringer but also against any secondary infringers of his copyright. In my judgment this means that this COURT should now adopt a positivist approach in favour of the claimant in considering whether discovery of documents should be granted and if so what level of discovery was necessary and relevant for disposing fairly of the cause or matter.

37. Of course, the COURT must be satisfied, to repeat the words of Mummery J. that:-

“The order sought for disclosure is not an oppressive fishing expedition for the purpose of maintaining an action or brining other actions against other persons.”

38. The motion seeking discovery of documents must be supported by affidavit evidence sufficient to satisfy the court that the plaintiff's claim is *bona fide* and is not vexatious or frivolous or an abuse of process. Without discovery, the plaintiff must be able to point to some tangible material capable of giving rise to a reasonable inference of infringement of the plaintiff's alleged copyright. It may be the product of such matters as correspondence between the defendants and others coming into the possession of the plaintiff, or public advertisements or public performances, or ordinary or “trap” purchases or information received from reliable and disclosable sources, or the investigations of inquiry agents or even from Anton Piller type orders obtained from the courts.

39. The grounding affidavit in the instant case is somewhat laconic and bordering on the merely formalistic so far as the reasons offered to satisfy the provisions of O. 31, r. 12, of the Rules of the Superior Courts are concerned. I am, however, satisfied from the pleadings in this case and from the correspondence exhibited in the affidavit grounding this motion and to which I have already made reference, that the plaintiff's claim is *bona fide* – whether it is or is not ultimately successful is not a consideration to be taken into account at this point – and I am satisfied that the plaintiff is not seeking discovery of documents in the hope that these will disclose a cause of action against the defendants or one or other of them or against some non-party to this action.

40. The extent to which discovery of documents is necessary to enable the plaintiff to make a meaningful claim for damages for infringement or for profits *in lieu* and, to make an informed decision with regard to which remedy he wishes to pursue is manifest from the judgment in *Allibert S. A.* (above cited) and the judgment in *House of Spring Gardens Limited* (above cited).

41. Section 127(2) of the Copyright and Related Rights Act, 2000, provides that:-

“In an action for infringement of the copyright in a work under this section, all relief by way of damages, injunction, account of profits or otherwise is available to the plaintiff as it is available in respect of the infringement of any other property right.”

42. Section 22(2) of the Copyright Act, 1963 is in essentially the same terms.

43. Section 128(1) of the same Act of 2000, provides that:-

"The court may, in an action for infringement of copyright award such damages as, having regard to all the circumstances of the case, it considers just."

44. Subsection (3) of this section provides, that in addition to or as an alternative to compensating the plaintiff for financial loss, the court may award aggravated or exemplary damages or both aggravated and exemplary damages. Generally similar provisions are to be found in s. 22(4) of the Copyright Act, 1963.

45. Section 134(1) of the Act of 2000, which echoes the provisions of s. 24(1) of the Copyright Act, 1963, provides that the owner of any copyright shall be entitled to all such rights and remedies in respect of the conversion or detention by any person of (a) infringing copies of a work, (b) articles that have been or are to be used to make infringing copies or, (c) protection – defeating devices, as he or she would be entitled to if he or she was the owner of any such copy, article, or device and had been the owner thereof since the time when it was made. Subsection (3) of this section further provides that in awarding damages for conversion the court shall take into account the circumstances of the case and shall award such sum as it considers just.

46. Section 137(2) of the Act of 2000, provides that a person entitled to a moral right conferred by ss. 107, 109, 113 or 114 of that Act, may apply to the appropriate court for damages or other relief in respect of an infringement of that right.

47. In *House of Spring Gardens Limited* (above cited), Costello J., (as he then was) at p. 184, accepted that the plaintiffs were entitled to elect in lieu of damages, to have an account taken of the profits made by the wrongful acts. I am satisfied that this remedy has its origin in the doctrine of unjust enrichment, see *Hickey and Company Limited v. Roches Stores (Dublin) Limited* [1980] I.L.R.M. 107. At p. 686 of the judgment in *House of Spring Gardens Limited*, the learned Judge stated as follows:-

"When a plaintiff elects in favour of an account of profits he will in the normal case get an account of what the defendant expended upon manufacturing the goods [and transport costs], the price received for their sale and obtain an order for payment of the difference (see the judgement of Pennycuik, J. in *Peter Pan Manufacturing Corporation v. Corsets Silhouette Limited* [1964] 1 W.L.R. 96)."

48. In the older case of *Stevens v. Brett* [1863] 12 W.R. 572, it was held that in a claim for profits a plaintiff was entitled to disclosure on oath of full particulars of, (a) the number of copies produced, and (b) the number of copies sold by the defendant and, (c) the costs of production and distribution incurred by the defendant, together with all vouchers and receipts necessary to verify the same.

49. The court will decline to make a general order for discovery in this case, if in fact this is sought by the plaintiff.

50. At para. 1(a) of the notice of motion, the plaintiff seeks discovery upon oath of all documents, files, notes, records, correspondence and memoranda in the power, possession or procurement of the defendants or either of them relating to all videos, compact disks, DVDs, MCs, audio cassettes and audio-video recordings in any other medium of each and every recording of every performance of the plaintiff's song "The Voyage" or any alteration thereof, produced by or on behalf of the defendants their servants or agents. I reject the contention of the defendants that this requires production of the physical objects themselves and amounts of some form of indirect recall of all such products.

51. In my judgment the disclosure sought by the plaintiff is, however, too extensive in content and time and, would amount to an oppression of the defendants if granted. As a matter of justice and proper proportion and having regard to the issues joined between the parties on the pleadings, discovery should be limited under this category to all documents, files, notes records, correspondence and, memoranda in the power, possession or procurement of the defendants or either of them relating to the number of each type of recording in any medium of any performance of the plaintiff's alleged song, "The Voyage" or of any alteration thereof, produced by or on behalf of the defendants or either of them within the European Union, in the period 1st January, 1999 to 31st December, 2002. With regard to this time frame, para. 6 of the statement of claim refers to the initial infringing performance as having taken place on a date unknown in or about 1999 whilst, the statement of claim itself was delivered on 23rd December, 2002. In the absence of any sort of positive evidence on affidavit that production of recordings continued, despite the service of the plenary summons, (concurrent summons issued on the 26th April, 2002), and despite the formal pleading at para. 18 of the statement of claim that, "the defendants threaten and intend unless restrained ... to continue the reproduction and sale", I consider that it is altogether unlikely that the defendants or either of them persisted in the alleged infringement of the plaintiff's alleged copyright despite the service of the plenary summons and delivery of the statement of claim herein.

52. The Court should in my judgment, and, will for similar reasons, limit the scope of the discovery sought by the plaintiff at para. 1(b) in the notice of motion to all documents, files, notes records, correspondence and memoranda in the power, possession or procurement of the defendants or either of them relating to the number of documents, items of literature, packaging sleeves, inserts, booklets and lyric notes produced by or on behalf of the Defendants and each of them within the European Union in the period 1st January 1991 to 31st December, 2002, containing any reference whatsoever to the plaintiff's alleged song "The Voyage", or the words of that song or any adaptation thereof.

53. In my judgment, the discovery sought at para. 1(c) of the notice of motion relates to the distribution to trade or members of the public of the various items specified at paras. 1(a) and 1(b) above, and to the geographical extent of the circulation of those items. In my judgment the plaintiff is entitled to the discovery on oath, but within certain limits, of all documents, files, notes, records, correspondence and memoranda, relating to the former but not to the latter. The limits must be that the discovery is confined to the Member States of the European Union, to the period 1st January, 1999 to 31st December, 2002 and, to distribution by or on behalf of the defendants and each of them. The geographical extent of the circulation of these items, even within the European Union is in my judgment something altogether incapable of being known to the defendants or, of even being accurately ascertained by them by any form of reasonable enquiry. Such an order, if made, in addition to imposing an altogether unreasonable unjust and disproportionate burden on the defendants would be incapable of being enforced by this court for lack of precision.

54. With respect to the discovery sought at para. 1(d) of the notice of motion, in my judgment the plaintiff is entitled to discovery on oath of all documents, files, notes, records, correspondence and memoranda, (including vouchers receipts, invoices and accounts), relating to the storage, transport, sale or other making available to the trade or to the general public of the various items specified at paras. 1(a) and 1(b) above, within the European Union in the period 1st January, 1999 to 31st December 2002, by or on behalf of the defendants and each of them.

55. In my judgment the plaintiff is clearly entitled to discovery of all of the documents specified at para. 1(e) of the notice of motion.

At para. 4, sub paragraph entitled "Video" (a) and (b) and subparagraph entitled "TV" (b) of the their amended defence the respondents plead that, without prejudice to the remainder of their defence, they will rely upon and seek credit for "any payments" made to the plaintiff by or on behalf of Navarre, RTE Commercial Enterprises Limited, Point Entertainment Inc/Entertainment Limited and, on amounts received by MCPS on his behalf in respect of an alleged MCPS Licence issued on 23rd November, 1999 in respect of CD/MC sales in this State. In their letter of 2nd May, 2006 the solicitors for the defendants state that the defendants are strangers to the precise payments received by the plaintiff, "but are prepared to furnish such documents as they have relating to the payment of the plaintiff in respect of the exploitation of his work". In my judgment, while it is in the Defendants' own interest to make such an offer, the plaintiff is nonetheless entitled to discovery on oath in relation to the payments pleaded at para. 4 of the amended defence. Such offers, and offers of inspection of documents by the plaintiffs' accountant may be relevant to the question of costs when that falls to be determined.

56. The Court will hear submissions from the parties as to the identity of the person to swear the Affidavits as to documents on behalf of each of the defendants and, as to the time to be limited by this court within which such Affidavits as to documents must be furnished to the solicitors for the plaintiff. The court will reserve the question of the costs of this motion to the hearing of the action.