

Freedom of Information Act 2000 (Section 50)

Decision Notice

Date: 26 April 2011

Public Authority: Intellectual Property Office
Address: Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Summary

The complainant asked the Intellectual Property Office (the “public authority”) to provide information relating to a trade mark it had considered. The public authority advised the complainant that some information was already available to him but that the remainder was exempt under the exemption at section 44 (prohibitions on disclosure) of the Freedom of Information Act 2000 (the “Act”).

The Commissioner’s decision is that the exemption at section 44 is not engaged and the information requested should be disclosed unless the public authority chooses to cite section 36. The complaint is upheld.

The public authority’s handling of the request also resulted in breaches of certain procedural requirements of the Act as identified in this Notice.

The Commissioner’s role

1. The Commissioner’s duty is to decide whether a request for information made to a public authority has been dealt with in accordance with the requirements of Part 1 of the Freedom of Information Act 2000 (the “Act”). This Notice sets out his decision.

Background

2. According to its website¹: *“The Intellectual Property Office can help you get the right type of protection for your creation or invention”*. This request relates to trade marks, which it describes as: *“... signs (like words and logos) that distinguish goods and services in the marketplace”*. It provides this further information:

“What is a trade mark?”

A trade mark is a sign which can distinguish your goods and services from those of your competitors. It can be for example words, logos or a combination of both.

You can use your trade mark as a marketing tool so that customers can recognise your products or services.

A trade mark must be:

- *distinctive for the goods and services you provide. In other words it can be recognised as a sign that differentiates your goods or service as different from someone else's”.*

“Trade marks are not registrable if they:

- *describe your goods or services or any characteristics of them, for example, marks which show the quality, quantity, purpose, value or geographical origin of your goods or services;*
- *have become customary in your line of trade;*
- *are not distinctive;*
- *are three dimensional shapes, if the shape is typical of the goods you are interested in (or part of them), has a function or adds value to the goods;*
- *are specially protected emblems;*
- *are offensive;*
- *are against the law, for example, promoting illegal drugs;*
or;
- *are deceptive. There should be nothing in the mark which would lead the public to think that your goods and services have a quality which they do not.*

A registered trade mark must be renewed every 10 years to keep it in force”.

3. The complainant requested similar information about several different trade mark applications, one of which was his own. A total of six

¹ <http://www.ipo.gov.uk/?toggle=true>

related requests have resulted in Decision Notices which are all issued at the same time as this Notice. The other five reference numbers are: FS50321698, FS50359455, FS50359467, FS50359480 and FS50359525.

4. At the time of the request, all the related trade mark files were considered to be 'open' to the public other than the complainant's own application.

The request

5. On 21 May 2010 the complainant made the following information request:

"I write in order to request, under the Freedom of Information Act, the release copies of the following documents to me:

- 1) Copies of all internal process manuals used by in connection with the initial assessment of the trademark "Grey Matters";*
- 2) All internal check sheets, notes, and procedural logs associated with the abovementioned trademark application;*
- 3) Information, as described in (1) and (2) above used in connection with subsequent requests for further review or hearings relating to the abovementioned mark".*

6. On 9 June 2010 the public authority sent its response. The complainant was directed to an online manual and also advised that some of the requests he had made:

"... will have been examined using earlier versions of the Trade Marks Manual and I will send you four PDF files of the 2004 and 2007 Examination and Practice chapters from the manual which are still available, each in two parts. (I will send them separately because they are large files which you may have trouble opening if attached to one email.) You may view old Practice Amendment Circulars relevant to the old manuals on the website at:

<http://www.ipo.gov.uk/pro-types/pro-tm/t-law/t-pan/t-pan-previous.htm>

You have also requested all internal check sheets, notes, and procedural logs associated with the abovementioned trademark applications. The only such information held would be on the case files and as all these marks are either registered or advertised they are all open to public inspection.

However, the information held on the files is exempt under section 21 of the Freedom of Information Act, as it is readily available by other means. What this means is we are not obliged to provide it freely, but we must levy a handling charge in accordance with the requirements of the Trade Marks Act and Rules.

Each file may be inspected or copies requested for £5 per file (or possibly more in the case of very large files). You can find further information on file inspection at <http://www.ipa.gov.uk/t-status.htm> . Please note that some papers will not be available as their release is prohibited by Rule 50 of the Trade Mark Rules, and that prohibition cannot be circumvented by the FOI Act”.

7. It also advised the complainant that any internal check sheets or logs were exempt under section 44 of the Act by virtue of a prohibition under the Trade Marks Act. It provided links to this legislation and the associated Trade Mark Rules.
8. On 9 June 2010 the complainant sought an internal review. He included the following arguments in support of his case to seek disclosure:

“Rule 50 (3) [of the Trade Mark Rules] removes the right of inspection for certain documents, but does not actually prohibit disclosure of documents detailed therein. The difference is subtle but important insofar as the IPO, at its option, can elect to release documents otherwise covered by Rule 50... after all, it would be farcical for statute to prohibit the subsequent release of all documentation initially intended for internal IPO consumption”.

“Since Rule 50 does not describe an outright prohibition (due to it permitting discretionary disclosure), Section 44 of FOIA cannot apply in this case, and the information requested remains subject to full disclosure. I therefore request you review this FOI request and release to me the withheld documentation forthwith (other documentation, available through the standard inspection process, I shall request in due course via the relevant channel as outlined by your FOI Records Officer)”.

9. On 6 July the public authority provided its response. It upheld its previous position and advised the complainant that:

“Section 44 is an absolute exemption. The right of access to information contained within a Trade Marks file is set out in the Trade Mark Rules 2008. You argue that we can elect to release

the internal documentation. However, the Freedom of Information Act cannot be used to circumvent the statutory provisions set out in the Trade Marks Rules 2008. I refer you to paragraph 58(3a) which states that the right of inspection does not apply to "any document prepared in the Office solely for its own use".

The investigation

Scope of the case

10. On 7 July 2010 the complainant contacted the Commissioner to complain about the way his request for information had been handled. The complainant specifically asked the Commissioner to consider the public authority's interpretation of the aforementioned legislation as providing a prohibition on disclosure.
11. During the opening stages of the investigation the complainant confirmed with the Commissioner that he was only seeking access to those documents which were not otherwise available to him, i.e. those check sheets, notes, and procedural logs being withheld by virtue of section 44. He also wished the Commissioner to consider whether there was any other information concerning any "further review" for any of the cases.
12. To clarify, the complainant did not dispute his alternative access to any 'open' material held on the files and this will not therefore be considered.

Chronology

13. In correspondence to the Commissioner dated 1 September 2010 the public authority advised as follows:

"In our opinion if s.44 were not available as an exemption, file notes of this type would qualify for exemption under s.36, being in many cases examples of free and frank exchanges of views for the purposes of deliberation".

14. On 2 November 2010 the Commissioner wrote to the complainant to advise him that he was commencing his investigation. He asked whether the complainant wanted all six of his complaints investigating. The complainant confirmed that he did.

15. On 15 November 2010 the Commissioner raised his initial enquiries with the public authority.
16. On 22 November 2010 the Commissioner clarified the scope of his investigation with the complainant, as outlined above. The complainant submitted more arguments to support his belief that there was no statutory bar on disclosure of the requested information.

Findings of fact

17. The two pieces of legislation that have been relied on by the public authority is The Trade Marks Act 1994² (the "TMA") and The Trade Marks Rules 2008³ (the "TMR"). The relevant sections are cited below:

"The Trade Marks Act 1994

67 Information about applications and registered trade marks.

(1) After publication of an application for registration of a trade mark, the registrar shall on request provide a person with such information and permit him to inspect such documents relating to the application, or to any registered trade mark resulting from it, as may be specified in the request, subject, however, to any prescribed restrictions.

Any request must be made in the prescribed manner and be accompanied by the appropriate fee (if any)."

(2) Before publication of an application for registration of a trade mark, documents or information constituting or relating to the application shall not be published by the registrar or communicated by him to any person except—
(a) in such cases and to such extent as may be prescribed, or
(b) with the consent of the applicant;
but subject as follows.

(3) Where a person has been notified that an application for registration of a trade mark has been made, and that the applicant will if the application is granted bring proceedings against him in respect of acts done after publication of the application, he may make a request under subsection (1) notwithstanding that the application has not been published and that subsection shall apply accordingly.

"The Trade Marks Rules 2008

² <http://www.legislation.gov.uk/ukpga/1994/26/contents>

³ <http://www.legislation.gov.uk/uksi/2008/1797/contents/made>

Request for information; section 67(1) (Form TM31C)

56. A request for information relating to an application for registration or to a registered trade mark shall be made on Form TM31C.

Inspection of documents; sections 67 & 76(1)

58.—(1) Subject to paragraphs (2) and (3), the registrar shall permit all documents filed or kept at the Office in relation to a registered mark or, where an application for the registration of a trade mark has been published, in relation to that application, to be inspected.

(2) The registrar shall not be obliged to permit the inspection of any such document as is mentioned in paragraph (1) until the completion of any procedure, or the stage in the procedure which is relevant to the document in question, which the registrar is required or permitted to carry out under the Act or these Rules.

(3) The right of inspection under paragraph (1) does not apply to—

(a) any document prepared in the Office solely for its own use;”

Analysis

Substantive procedural matters

Section 1 – general right of access

18. The complainant has asked the Commissioner to consider whether or there was any other information concerning any “further review” in relation to this or any of the other five requests he made.

19. Section 1(1) of the Act states:

‘Any person making a request for information to a public authority is entitled –

a) to be informed in writing by the public authority whether it holds information of the description specified in the request, and

b) if that is the case, to have that information communicated to him.’

20. The test which the Commissioner applies in determining whether a public authority holds any requested information is the balance of probabilities. This is in line with the approach taken by the Information Tribunal in the case of *Bromley & others v the Environment Agency (EA/2006/0072)*, in which it stated:

"...we must consider whether the IC's decision that the EA did not hold any information covered by the original request, beyond that already provided, was correct. In the process, we may review any finding of fact on which his decision is based. The standard of proof to be applied in that process is the normal civil standard, namely, the balance of probabilities..." (paragraph 10)

because

"...there can seldom be absolute certainty that information relevant to a request does not remain undiscovered somewhere within a public authority's records" (paragraph 13).

21. In deciding where the balance lies in cases such as this one the Commissioner will look at both:

- the scope, quality, thoroughness and results of the searches; and
- other explanations offered as to why the information is not held.

The nature of the searches / other explanations offered

22. As a result of concerns raised by the complainant the Commissioner raised some further queries with the public authority. He sought to ascertain how the public authority held the information and whether or not there may be further information other than what it had already considered.

23. The Commissioner asked the public authority about the information it holds for each case considered. It advised him that:

- There is only a single trade mark file for each of the six marks requested by the complainant.
- The outcomes of any hearings for trade mark cases are within the 'open' part of the file and are therefore available for public inspection - they are also available online⁴.
- There were no hearings for "*Grey Matters*".

⁴ <http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results.htm>

24. In an email of 29 November 2010 the public authority further informed the Commissioner that:
- It uses no other forms or templates which are not in the 'open' part of the files.
 - Everything that relates to an application will be kept on the relevant file, e.g. emails.
 - If an application was discussed at a meeting than any notes would appear on the file as well.

Conclusion

25. In reaching a decision in this case the Commissioner has considered the information he would expect the public authority to hold and whether there is any requirement for it to hold anything further to the files it has already advised that it does hold.
26. The Commissioner accepts that the public authority would wish to hold information about each trade mark it considers in a central location, i.e. a single paper file in this particular case. Whilst he understands that the application may be discussed at a meeting he also accepts the public authority's position that, if this were the case, then a note of any meeting would be placed on the file itself. This appears to the Commissioner to be a sensible way of managing cases which ensures that any party who wished to look at an application would be fully informed about that application by examining one file without the need to look further afield.
27. Having considered what information it does hold, the Commissioner therefore concludes that, on the balance of probabilities, the public authority does not hold any further information other than that which is already retained on the file for each trade mark application considered.

Exemptions

Section 36 – prejudice to effective conduct of public affairs

28. The public authority referred to this exemption in correspondence with the Commissioner. However, it did not include a Qualified Person's opinion, or any other reasoning relevant to the section 36 exemption. Since no Qualified Person's opinion was obtained, the exemption cannot be engaged at this time. The Commissioner has therefore not considered this exemption further.

Section 44 – prohibitions of disclosure

29. Section 44(1) states that:

“Information is exempt information if its disclosure (otherwise than under this Act) by the public authority holding it –

*(a) is prohibited by or under any enactment,
(b) is incompatible with any Community obligation, or
(c) would constitute or be punishable as a contempt of court.”*

30. If engaged, this exemption is absolute and there is no need to consider the public interest in disclosure against the public interest in withholding the information.
31. The public authority has not cited the subsection of this exemption upon which it seeks to rely. However, based on the wording of its responses, the Commissioner has assumed that this is subsection (1)(a).
32. In this case the public authority has said that the relevant statutory prohibition is section 67 of the TMA along with section 58(3)(a) of the TMR (Statutory Instrument 1797 of 2008) as cited in ‘*Findings of fact*’ above. It advised: *“The right of access to information contained within a Trade Marks file is set out in the Trade Mark Rules 2008”*. This right states that the registrar shall permit inspection of all documents relating to a registered or published trade mark except for *“any document prepared in the Office solely for its own use”*.
33. The public authority has confirmed that information under consideration in this case relates to a trade mark which is either registered or advertised and therefore is considered as being “open” to public inspection. It has therefore apprised the complainant of this fact. However, it has then gone on to rely on section 58(3)(a) of the Rules to prevent disclosure of the small amount of information which it states has been prepared solely for its own use.
34. The TMA clearly specifies that before publication of a trade mark, access to related documentation can only be provided in very limited circumstances. The Commissioner accepts that section 67(2) of the TMA clearly provides a statutory bar on general disclosure under the Act.
35. However, after a trade mark’s publication, section 67(1) of the TMA comes into effect. This section clearly states that: *“any request must*

be made in the prescribed manner and be accompanied by the appropriate fee (if any)". This clearly therefore relates to requests which are made in such a "*prescribed manner*", i.e. on Form TM31C as indicated in section 56 of the Rules (see '*Findings of fact*' above).

36. The Commissioner does not consider a request made under the terms of the Act to be one which is made in such a "*prescribed manner*" as implied by this section of TMA. Therefore, although the Rules cover requests made on the Form TM31C, they do not cover requests made under the Act; the Act is a separate access regime.
37. To conclude, the Commissioner accepts that prior to its publication a trade mark is 'protected' from disclosure under the Act by virtue of section 67(2) of the TMA. However, he does not agree that section 67(1) of the TMA applies to a request made under the Act as a request under the Act is not one which is made in the "*prescribed manner*" laid down under the TMA and the associated Rules. Accordingly, he concludes that there is no statutory bar to rely on for requests made, under the Act, for published trade marks.
38. The Commissioner upholds the complainant's position and concludes that section 44 of the Act is not engaged in respect of a published trade mark.

Procedural requirements

Section 1 – general right of access to information

Section 10 - time for compliance

39. Section 1(1)(b) of the Act requires a public authority to provide information to an applicant in response to a request. Section 10 of the Act states that a public authority must comply with section 1(1) promptly and, in any event, not later than 20 working days after the request has been received.
40. or the reasons set out above the Commissioner is of the view that section 44 does not apply and that the requested information should therefore be disclosed. As this information was wrongly withheld the Commissioner concludes that the public authority failed to comply with section 1(1)(b) of the Act. By failing to supply this information within 20 working days the Commissioner finds that the public authority also failed to comply with section 10(1) of the Act.

Section 17 – refusal of request

41. Section 17(1) of the Act requires that, where a public authority is relying on a claim that an exemption in Part II of the Act is applicable to the information requested, it should in its refusal notice:
- (a) state that fact,
 - (b) specify the exemption in question,
 - (c) state why the exemption applies.
42. In this case, the public authority stated that it was relying on section 44 but failed, by the time of the completion of the internal review, to specify the subsection of the exemption upon which it was relying. It therefore breached section 17(1)(b).

The Decision

43. The Commissioner's decision is that the public authority did not deal with the request for information in accordance with the Act:
- it incorrectly withheld the information under the exemption at section 44(1)(a);
 - in failing to provide the requested information it breached sections 1(1)(b) and 10(1); and,
 - in failing to specify which subsection of section 44 it was relying on it breached section 17(1)(b).

Steps required

44. The Commissioner requires the public authority to take the following steps to ensure compliance with the Act:
- it should either disclose the requested information or issue a valid refusal notice under section 36.
- The public authority must take the steps required by this notice within 35 calendar days of the date of this notice.

Right of Appeal

45. Either party has the right to appeal against this Decision Notice to the First-tier Tribunal (Information Rights). Information about the appeals process may be obtained from:

First-tier Tribunal (Information Rights)
GRC & GRP Tribunals,
PO Box 9300,
Arnhem House,
31, Waterloo Way,
LEICESTER,
LE1 8DJ

Tel: 0845 600 0877

Fax: 0116 249 4253

Email: informationtribunal@tribunals.gsi.gov.uk.

Website: www.informationtribunal.gov.uk

If you wish to appeal against a decision notice, you can obtain information on how to appeal along with the relevant forms from the Information Tribunal website.

Any Notice of Appeal should be served on the Tribunal within 28 calendar days of the date on which this Decision Notice is sent.

Dated the 26th day of April 2011

Signed

**Jon Manners
Group Manager**

**Information Commissioner's Office
Wycliffe House
Water Lane
Wilmslow
Cheshire
SK9 5AF**