

**Decision of the Information Commissioner in his capacity as Appeal Commissioner on an appeal made under Regulation 10 of the European Communities (Re-Use of Public Sector Information) Regulations 2005 (as amended by the European Communities (Re-use of Public Sector Information) (Amendment) Regulations 2015) (the PSI Regulations)**

**Case RPSI/16/02**

**Date of decision:** 16 December 2016

**Appellant:** Vizlegal Limited (the appellant)

**Public Sector Body:** The Patents Office

**Issue:** Whether a decision of the Patents Office on the appellant's request for re-use of documents was in compliance with Regulations 5 and 6 of the PSI Regulations.

**Summary of Commissioner's Decision:** In accordance with Regulation 12(2) of the PSI Regulations, the Information Commissioner reviewed the decision of the Patents Office on the appellant's request. He found that the appellant was not entitled to seek re-use of unpublished documents by making a request under Regulation 5(1)(a) in circumstances where a right of access to such documents had not been established.

He found that the Patents Office was justified in refusing to release the Patents Database and the Design Database for re-use in open and machine readable format as the limitations on the right of re-use under Regulation 5(5)(b)(i) and (ii) apply to these databases, and accordingly there is no obligation on the Patents office to adapt or to provide extracts from the databases.

He found that the charges applicable for use of the computerised trade mark database under Rule 77 of the Trade Mark Rules 1996 and under the Patents, Trade Marks and Designs (Fees) Rules 2001 do not conflict with Regulation 6 of the PSI Regulations. In particular, he found that although the charges appear to exceed the marginal cost of reproduction, provision and dissemination of the database, the

charges are nevertheless within the terms of Regulation 6(1A)(a)(ii), as the Patents Office is required to generate sufficient revenue to cover a substantial part of the costs relating to the collection, production, reproduction and dissemination of the database.

Accordingly, the Commissioner affirmed the decision of the Patents Office in full.

**Right of Appeal:** A party to this appeal or any other person affected by this decision may appeal this decision to the High Court on a point of law from the decision, as set out in Regulation 15 of the PSI Regulations. Such an appeal must be initiated not later than eight weeks after notice of this decision was given to the person bringing the appeal.

## **The right of re-use of documents**

Public sector bodies create, collect, and publish valuable information in the course of their public functions. Directive 2003/98/EC creates a general legal framework for the conditions governing re-use of public sector documents. Directive 2013/37/EU amends and expands on the earlier Directive, creating a broader right of re-use of documents in some circumstances, subject to conditions. Directive 2013/37/EU also provides for new rules governing charges, licences and conditions for re-use. The above Directives were transposed into Irish law by the European Communities (Re-Use of Public Sector Information) Regulations 2005 as amended by the European Communities (Re-use of Public Sector Information) (Amendment) Regulations 2015 (the PSI Regulations).

Under Regulation 5(1)(a) of the PSI Regulations, an individual or a legal entity may make a request to a public sector body to release documents for re-use.

The PSI Regulations define “re-use” as the use by an individual or legal entity of a document for commercial or non-commercial purposes other than the initial purpose within the public task for which the document was produced. The term “document” is defined as all or part of any form of document, record or data, whether in physical, electronic or other form.

Regulation 5(2) provides that on receipt of a request under paragraph 5(1), a public sector body must allow the re-use of the document for commercial or non-commercial purposes in accordance with the conditions and time limits provided for by the PSI Regulations.

## **Background to review**

The Patents Office provides access to three electronic databases on its website ([www.patentsoffice.ie](http://www.patentsoffice.ie)). The Patent Register and Database, the Trade Mark Database, and the Design Register and Database are published online, and can be accessed using an online search form.

A re-use notice published on the Patents Office website states “All of the information featured on our website is the copyright of the Patents Office unless otherwise indicated. You may re-use the information on this website free of charge in any format”. The Patents Office stipulates a number of conditions for re-use of documents published on its website.

Separately to its free online databases, the Patents Office provides bulk access to the trade mark register through a “computerised trade mark database”. Access to the computerised trade mark database is subject to licence and payment of fees.

On 13 September 2016, the appellant made a request for re-use of documents to the Patents Office in the following terms:

"Under the European Communities (Re-Use of Public Sector Information) Regulations 2015 (rPSI) I wish to request the following data for the purposes of re-use:

- 1) The Patents database
- 2) The Trademarks database
- 3) The Designs database

I wish to receive the data in open, machine-readable formats, such as CSV."

In a reply of 16 September 2016, the Patents Office refused to release the databases underpinning the Patents and Designs registers, stating that these documents were not available for re-use. The Patents Office informed the appellant that its primary database contained both confidential and public information. The Patents Office invited the appellant to apply for a licence to use the computerised trade mark database.

In a reply of 18 September, the appellant clarified that it was not seeking to re-use confidential parts of the databases, and requested more details on the fees for the licensed Trade Marks database. The Patents Office replied on 20 October, stating that the PSI Regulations do not create a right of access to documents. The Patents Office referred the appellant to the existing modes of access to the databases, and stated that bulk access to the underlying patents and designs databases was not possible, on account of the need to protect third party rights. The Patents Office also cited the technical effort and expense required to separate confidential information from public information on the patents and designs databases as grounds for refusal, and referred to Regulations 5(5)(a) and 5(5)(b) in this regard. The Patents Office did not contend that the licencing of the computerised trade mark database is outside its public task.

The appellant appealed the decision of the Patents Office to my Office on 20 September 2016. Regulation 7(3) provides that public sector bodies must ensure that requesters are informed of available means of redress. It does not appear that the Patents Office informed the appellant of the availability of a right of appeal to my Office in this case. Although no detriment resulted from this failure on this occasion, I must emphasise the importance of this provision in every case as there is a limited period for making an appeal to my Office.

### **Scope of review**

The PSI Regulations provide for an appeal by a requester to an "appeal commissioner". Regulation 2(1) of the PSI Regulations provides that the person who holds the office of Information Commissioner under the Freedom of Information Act 2014 is the appeal commissioner for the purposes of the PSI Regulations. Accordingly, as I am the person who holds the office of Information Commissioner for the time being, I am the designated appeal commissioner under the PSI Regulations. Regulation 12 provides that, on receipt of a valid request for an appeal, I must carry out a review in accordance with the PSI Regulations. Following this review, I may decide to affirm, vary or annul the decision under review.

The appellant requested that I review two aspects of the decision of the Patents Office: the refusal to release documents for re-use in an open and machine-readable format as required by Regulation 5(5)(a), and the charges for use of the computerised Trade Mark database.

In the course of this review, I have had regard to Department of Finance Circular 32/2005, and Department of Public Expenditure and Reform Circulars 16/2015 and 12/2016, as well as the European Commission Notice "Guidelines on recommended standard licences, datasets and charging for the re-use of documents" (2014/C 240/01) (the EC Guidance) published in July 2014.

As a preliminary point, I considered whether I have jurisdiction to review a decision by a public sector body concerning its obligations to release documents for re-use in certain formats under Regulations 5(5)(a) and Regulation 5(5)(b).

Regulation 10(1) of the PSI regulations provides four specific grounds of appeal:

“...Where a public sector body decides—

- (a) to refuse to allow a requester to re-use a document,
- (b) to refuse to grant an exclusive right to a requester to re-use a document,
- (c) to allow the re-use of a document but subject to a proposed fee being paid which the requester believes does not accord with the requirements of these Regulations in setting the amount of the proposed fee, or
- (d) to allow the re-use of a document subject to imposing conditions...”

I consider that the right of appeal under Regulation 10(1)(a) on foot of a decision “to refuse to allow a requester to re-use a document” includes a negative decisions on re-use under Regulations 5(5)(a) or 5(5)(b), notwithstanding the fact that a public sector body may decide at the same time to make a document available for re-use in a different format to that requested. I am therefore satisfied that I have jurisdiction to review decisions on re-use under Regulations 5(5)(a) and (b).

My Investigator asked Vizlegal to clarify whether its request was solely for re-use of data published on the Patents Office website. Vizlegal stated that it wished to re-use the data published on the website in open and machine-readable format, and that it also sought to re-use non-confidential parts of underlying databases if such data existed.

### **Analysis and Findings**

#### **Can the appellant seek access to unpublished data under the PSI Regulations?**

The appellant requested re-use of published documents as well as any unpublished and non-confidential parts of the databases. In its correspondence with the Patents Office, the appellant stated “The new law actually expands access rights, and places new obligations on public bodies”. I have therefore considered to what extent the PSI Regulations operate as a right of access.

Recital 8 to the Preamble of Directive 2013/37/EU states the objective of the Directive as being:

“to lay down a clear obligation for Member States to make all documents re-usable unless access is restricted or excluded under national rules on access to documents and subject to the other exceptions laid down in this Directive. The amendments made by this Directive do not seek to define or to change access regimes in Member States, which remain their responsibility”

This is reflected in Article 1(3) of the amended Directive which clearly limits the scope of the Directive, providing that “this Directive builds on and is without prejudice to access regimes in the Member States.” I am therefore satisfied that a right of access is an essential precursor to a

right of re-use, and that rights of access to documents are primarily defined by national legislation and not by the PSI Regulations.

In Ireland, legislative mechanisms for access to documents (or information) are provided under the Freedom of Information Act 2014, the European Communities (Access to Information on the Environment) Regulations 2007 to 2014, and the Data Protection Act 2003. Access to specific documents may also be provided by legislative enactment, such as section 70 of the Trade Mark Act 1996. Legal rights of access are not identical: rights can be more or less extensive depending on the legislation applied, the subject of the request, and the identity of the applicant.

In the present case, I accept that there is a right of access to documents provided through the online web search facilities and the computerised trade mark database, as well as a right to re-use such documents subject to conditions. However, the appellant's request did not specify the legal right of access it wished to avail of in order to re-use unpublished parts of databases held by the Patents Office. I consider that it would be premature to request re-use of a document where the mode of legitimate access has not first been established, or indeed where the existence of the document itself has not been established.

I am satisfied that a person may not request access to documents solely by reference to the PSI Regulations, and accordingly the appellant's request to re-use unpublished data held by the Patents Office does not fall to be considered. I therefore consider that the scope of this appeal is limited to questions arising from the appellant's request to re-use documents published as searchable databases on the Patents Office website, and as the computerised trade mark database.

### **Compliance with Regulation 5(5)(a) and 5(5)(b)**

Regulation 5(5)(a) of the PSI Regulations provides that, where a public sector body makes a document available for re-use it is obliged make the document available in any pre-existing format or language, and, where possible and appropriate, in open and machine-readable format together with its metadata, in compliance with formal open standards.

Regulation 5(5)(b) provides that nothing in the PSI Regulations requires a public sector body to create or adapt any document in order to comply with a request, or to provide extracts from documents where this would involve disproportionate effort, going beyond a simple operation.

Regulation 5(5)(a) creates an express obligation on public sector bodies to ensure that where documents are made available for re-use, standards which facilitate re-use are adhered to. However, this is a limited obligation, which is capable of being dislodged where re-use of a document in open and machine-readable format would not be "possible or appropriate", or where any of the limitations under 5(5)(b) apply.

In its correspondence with the Patents Office, the appellant contended that exporting data from a database is usually a simple operation with negligible cost implications. The appellant stated that it was not seeking the creation of any new information, merely requesting existing information.

To clarify matters, my Investigator contacted the Patents Office and requested a description of the content management system underpinning the website databases. The Patents Office stated

that the primary data it holds is stored and managed through Structured Query Language (SQL). All Patents Office data is stored in a single database, which is comprised of over 100 interlinked tables (i.e. sub-databases). The Patents Office stated that no single table holds all of the data relating to patents or trade marks or designs, and that data for an individual record may be stored across a number of tables. The Patents Office stated that the primary database includes confidential information which cannot be published by law.

The Patents Office stated that the computerised trade mark database is available to the appellant in an open and machine-readable format (subject to charges which I address below). The Patents Office stated that a custom software application was developed to extract information from its primary database for bulk dissemination as the computerised trade marks database.

The Patents Office stated that it is not obliged to create new databases or adapt its primary database in this case, as such an operation would constitute a disproportionate effort going beyond a simple operation.

The Patents Office also contended that the obligations under Regulation 5(5)(a) do not apply, as it would not be possible or appropriate to provide the website databases in open and machine-readable format. The Patents Office stated that in order to make these documents available in open and machine-readable format, two new databases containing only public and non-confidential information would have to be created in an appropriate machine-readable format. The Patents Office stated that the effort and expense in creating these new databases would be prohibitive, and would therefore not be possible or appropriate.

Details of the Patents Office content management practice were furnished to the appellant for comment, however no submission was received in this regard.

While I agree with the appellant to the extent that this request is not for “new information”, I am nevertheless satisfied that in order to meet the appellant’s request the Patents Office would have to adapt the primary database underpinning the patents and design databases in order to separate confidential and non-confidential information, and in order to provide the documents requested in open and machine-readable format. Regulation 5(5)(b)(i) specifically excludes any obligation on the Patents Office to adapt documents for the purpose of reuse. I therefore find that there is no obligation on the Patents Office to provide an open and machine-readable version of the patents and design databases which are otherwise available on the website, as to do so would be to require the adaptation of a document, contrary to Regulation 5(5)(b)(i).

Further to this, to the extent that the appellant has requested an extract of the Patents Office primary database, I have considered whether this would involve a disproportionate effort for the purpose of Regulation 5(5)(b)(ii). Having had regard to the complex nature of the primary Patents Office database, which includes over 100 separate tables and includes confidential elements, I am satisfied that creation of an extract of the patents and design databases to meet the appellant’s request would involve a disproportionate effort, going beyond a simple operation. Accordingly I find that Regulation 5(5)(b)(ii) precludes any obligation on the Patents Office to provide extracts from its primary database to meet the appellant’s request, as to do so would require a disproportionate effort going beyond a simple operation.

In circumstances where the appellant's request for re-use exceeds the limitations set out in Regulation 5(5)(b), it is not necessary for me to directly consider the obligations under Regulation 5(5)(a).

### **Compliance with Regulation 6 of the PSI Regulations – charging for re-use of documents**

In reply to the appellant's request for re-use of the trade marks database, the Patents Office proposed that the appellant could apply for a licence to use the computerised trade marks database. The appellant sought to appeal the charges for the computerised trade marks database to my Office. The appellant contended that the proposed charge did not accord with the PSI Directive, and further stated that the Patents Office had not specified how the PSI charging rules applied to the database.

In a submission to my Office, the Patents Office contended that the charges applied are in accord with the PSI Regulations, as they do not exceed the relevant marginal costs. In the alternative, the Patents Office contended that it was required to generate sufficient revenue to cover a substantial part of the costs of the database, and therefore exempt from the marginal cost rule.

Section 70(1) of the Trade Marks Act 1996 provides that the Controller of the Patents Office must, on request by persons, provide certain information relating to trade marks and allow for inspection of certain trade mark documents. Section 70(2) provides that requests under Section 70(1) must be accompanied by the appropriate fee.

Rule 77 of the Trade Mark Rules 1996 provides that the Controller of the Patents Office may, "on application...and on payment of the prescribed fee, grant or refuse to grant to the person a licence...authorising the use by that person of part or all of the computerised trade mark data base open to public inspection".

The standard fees for use of the computerised trade mark database are jointly set by the Minister for Public Expenditure and Reform and the Minister for Jobs, Enterprise and Innovation. Items 29 and 37 of Schedule 3 to the Patents, Trade Marks and Designs (Fees) Rules, 2001 prescribe standard fees for use of the computerised trade mark database and trade mark register.

To the extent that Rule 77 provides for re-use of information subject to charges, I have considered whether such charges are in accord with Regulation 6 of the PSI Regulations.

#### Are charges limited to the marginal costs incurred?

Regulation 6(1)(a) of the PSI Regulations provides that a public sector body may charge for the re-use of documents. Regulation 6(1)(b) provides that as a general rule, charges must be limited to the marginal costs incurred by the public sector body for the reproduction, provision and dissemination of the documents.

The PSI Regulations do not define the term "marginal cost", however this term is generally understood to mean the change in the total cost that arises when the quantity produced is

incremented by one unit. The EC Guidance suggests that where documents are disseminated electronically, marginal costs of dissemination can often be negligible.

The Patents, Trade Marks and Designs (Fees) Rules, 2001 prescribe an initial once off connection fee of €2500 in respect of on-line dial-in access for searches and inspections of the trade mark register. A standard fee of €125 applies for a licence authorising use of the computerised trade mark data base, with fortnightly database updates costing €625. The Patents Office submitted that income from the computerised trade mark database in 2016 was approximately €50,000, and that there are currently three licensees.

The Patents Office estimated that the marginal cost of adding a new licensee to be more than €2,800 based on increased staff costs, secure online distribution costs, and database costs resulting from the provision of the computerised trade mark database.

I accept that the secure platform used to disseminate the computerised trade mark database results in higher than average database costs. The Patents Office stated that it was in the process of improving the method by which it provides updates to the database, which would make the dissemination process more cost efficient in future.

In contending that the charges for the computerised trade mark database were less than marginal cost, the Patents Office compared the costs it incurred by adding a new user to its secure dissemination platform (€2800) with the fees paid by a user for first time connection to the system (€2650). I note however that charges for use of the database are potentially recurring in the form of a €625 charge for fortnightly updates. When comparing the marginal cost with charges, I consider that the relevant comparison should be the marginal cost against charges for a typical re-use scenario. The computerised trade mark database is not a static document; its value to re-users depends on its currency and the provision of updates. Based on current annual fee income from three licensees, it is obvious that re-users avail of frequent updates and that charges for updates exceed the estimated marginal cost within a short period of time.

Accordingly, I am not satisfied that the charges levied under the Patents, Trade Marks and Designs (Fees) Rules 2001 can be regarded as less than the marginal cost of reproduction, provision and dissemination of the computerised trade mark database.

#### Is the Patents Office entitled to apply charges exceeding marginal costs?

The PSI Regulations provide for exceptions to marginal cost charging in certain circumstances in order not to hinder the normal running of public sector bodies. Regulation 6(1A)(a)(ii) provides that the marginal cost rule does not apply where the public sector body concerned is required to generate sufficient revenue to cover a substantial part of the costs relating to the collection, production, reproduction and dissemination of the documents. The Patents Office submitted that charges for the computerised trade mark database accord with the exception under Regulation 6(1A)(a)(ii).

The Patents Office stated that, although it is not expressly required by statute to generate sufficient revenue to cover its costs, the intent of the statutory fee is to ensure that the Office generates sufficient income to cover a substantial part of the cost of extracting, disseminating and providing updates of the computerised trade mark database to licence holders.

I am satisfied that the Patents Office is required by law to apply the relevant fees in respect of the database. The Patents Office stated that its income in 2016 from the three licence holders is approximately €50,000. I am satisfied that this represents a substantial cost recovery requirement, and not merely an administrative or nominal fee. I am therefore satisfied that the Patents Office is required to generate sufficient revenue to cover a substantial part of the costs of the computerised trade mark database, based on the current fee income and costs.

Regulation 6(1B)(a) provides that, where charges in excess of marginal cost are applied, the public sector bodies concerned shall calculate charges for the re-use of documents according to objective, transparent and verifiable criteria laid down by the Minister from time to time.

Regulation 6(1B)(b) provides that the total income of the public sector bodies concerned from supplying and allowing re-use of documents over the appropriate accounting period shall not exceed the cost of collection, production, reproduction and dissemination, together with a reasonable return on investment. ).

I note that Department of Public Expenditure and Reform Circular 16/2015 sets out criteria for charges under the PSI Regulation where Regulation 6(1A)(a)(ii) applies. At paragraph 5 of the Circular, it states:

“if [a public service body seeks] to apply a charge for the re-use of information under the Regulations such charge should not exceed the sum of—

- (a) the direct costs incurred by the body;
- (b) a reasonable apportionment of indirect and overhead costs attributable to chargeable activity; and
- (c) a reasonable return on investment.”

The appellant submitted the Patents Office failed to meet its obligations under Regulation 6(1B)(a) and that the current fees are prohibitively expensive, and run counter to the purpose of the Directives and the PSI Regulations.

The Patents Office submitted that the prescribed fees do not exceed the current cost of extracting, disseminating and providing updates of the trade mark data so as to confine it to data which can be made publicly available. The Patents Office submitted that its annual fixed costs in respect of all database services are in excess of €100,000. Further to this, the Patents Office submitted that it incurs significant costs in the form of providing support to licensees, staffing requirements, database development and an ongoing programme of modernisation that will allow for new formats of trade mark to be registered. The Patents Office submitted that the direct and indirect costs of ongoing administration, adjustments, modifications, maintenance and support as well as the provision of a secure method of dissemination for database had the effect that charges do not exceed the sum allowed by Regulation 6(1A)(a)(ii).

The appellant was provided with details of the Patents Office licence income for comment, however no submission was received in this regard. In the circumstances, I accept the Patents Office submission with regard to cost recovery.

I therefore find that since the Patents Office is required to recover a substantial part of the relevant costs, and since income from charges does not exceed the sum of costs set out in Regulation 6(1B)(b) as calculated in line with Circular 16/2015, I am satisfied that the fees applicable are in accord with Regulations 6(1B)(a) and 6(1B)(b).

On the basis of the foregoing, although I am not satisfied that the proposed charges are less than the relevant marginal costs, I am satisfied that the fees are otherwise in accord with the requirements of Regulation 6 of the PSI Regulations.

### **Decision**

In accordance with Regulation 12(2) of the PSI Regulations, I have reviewed the decision of the Patents Office on the appellant's request. I find that the appellant was not entitled to seek re-use of unpublished documents by making a request under Regulation 5(1)(a) in circumstances where a right of access to such documents had not been established.

I find that the Patents Office was justified in refusing to release the Patents Database and the Design Database for re-use in open and machine readable format as the limitations on the right of re-use under Regulation 5(5)(b)(i) and (ii) apply to these databases, and accordingly there is no obligation on the Patents office to adapt or to provide extracts from the databases.

I find that the charges applicable for use of the computerised trade mark database under Rule 77 of the Trade Mark Rules 1996 and under the Patents, Trade Marks and Designs (Fees) Rules 2001 do not conflict with Regulation 6 of the PSI Regulations. In particular, I find that although the charges appear to be in excess of the marginal cost of reproduction, provision and dissemination of the database, the charges are nevertheless within the terms of Regulation 6(1A)(a)(ii), as the Patents Office is required to generate sufficient revenue to cover a substantial part of the costs relating to the collection, production, reproduction and dissemination of the database.

Accordingly, I affirm the decision of the Patents Office in full.

### **Right of Appeal**

A party to this appeal or any other person affected by this decision may appeal this decision to the High Court on a point of law from the decision, as set out in Regulation 15 of the PSI Regulations. Such an appeal must be initiated not later than eight weeks after notice of this decision was given to the person bringing the appeal.

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Peter Tyndall  
Information Commissioner  
16 December 2016