



International Trademark Association
Representing the Trademark Community since 1878

Comments of the International Trademark Association

auDA Whois Policy Review

Introduction

The International Trademark Association (INTA) is grateful for the opportunity to respond to auDA's request for comment on the existing .au Whois policy. INTA is a 127 year-old global organization with members in Australia and more than 180 additional countries. One of INTA's goals is the promotion and protection of trademarks as a primary means for consumers to make informed choices regarding the products and services they purchase. For the last 10 years, INTA has also been the leading voice of trademark owners within the Internet community, serving as a founding member of the Intellectual Property Constituency of the Internet Corporation for Assigned Names and Numbers (ICANN).

INTA respectfully submits that auDA should provide full registrant contact information through the Whois service¹ because it:

- aids consumers and the general public in identifying online merchants, whether companies or individuals;
- greatly assists intellectual property owners in identifying online infringers such as cybersquatters, counterfeiters and copyright infringers; and
- helps law enforcement in identifying counterfeiters and other criminals.

Our position is supported by Australian privacy law, the need for consistency with other Australian and international registries, new Australian anti-spamming laws and the otherwise avoidable high costs associated with other investigative tools.

In the alternative, but as a bare minimum, physical address details for the registrant should be provided in the results of a Request for Domain Name Creation Date application.² This is particularly important in the cases where the registrant is an

¹ We note that this position is consistent with the historical purpose of the Whois database. As stated in RFC 2167 further developing the Whois database for the .com top level domain, "[t]he original Whois function was to be a central directory of resources and people on [the Internet]." *See* <http://www.faqs.org/rfcs/rfc2167.html>.

² INTA understands that auDA has a procedure to allow a consumer to obtain a domain name creation date provided it warrants that the information requested is sought for the sole purpose of establishing rights in connection with a proposed claim against the domain name registrant under the .au dispute resolution policy or other court proceedings.

individual as there are limited resources otherwise available to a consumer or trademark owner to identify and contact the registrant.

INTA regards this review as timely, as the Whois problem has been further exacerbated by the 2002 revisions to the domain name eligibility requirements. By removing the requirement for a domain name to correspond to a trading name registration, these revisions made it easier for individuals to register domain names on the basis of unsubstantiated assertions that the domain name has a connection with their business. Such a move to easier registration should have been matched by a move to greater accountability of registrants through strengthened Whois disclosure requirements, which would have maintained the balance between the interests of domain name registrants and the protection of consumers seeking to identify the parties behind particular websites.

Current auDA Policy

Under the current auDA Whois policy, the following information is publicly available:

- domain name;
- status of the domain name;
- name of registrant
- ID number associated with the registrant, if any (*e.g.*, Australian company number for company or Australian registered business number for business);
- name of the contact person for the registrant (may be the same as the registrant);
- e-mail address for the registrant;
- name of the registrar of record and registrar ID; and
- date the domain name record was last modified

In addition to the above, if technical contact details or name server details are recorded against a domain name then these will be disclosed.

The Australian Privacy Law Permits Disclosure of Additional Information

Clause 4.2 of the current Whois policy states that “in order to comply with Australian privacy legislation, the *street address, telephone and facsimiles* of the registrant will not be disclosed” (emphasis added).

The National Privacy Principles (NPPs) in the Privacy Act, which govern the application of privacy law in Australia,³ can permit the disclosure of additional data that falls within the definition of personal information, including the name and address of the registrant. In particular, under NPP 2.1(b), having the consent of the individual concerned provides sufficient authorization for a disclosure, which would be otherwise prohibited. Any

³ Privacy Act 1988 (Cth), at <http://www.privacy.gov.au/act/index.html>. We note that the Australian privacy laws apply only to identifying data about individuals and do not protect against the disclosure of information identifying companies or other legal entities. Therefore, there is no basis in privacy law for any restriction on the disclosure of corporate registrant data.

privacy issues can therefore be remedied by requiring registrants to expressly give their consent to the disclosure of personal information in the Whois data. Consent can also be implied as well as expressed; so if registrants were advised of disclosure requirements and proceeded to register a domain name, consent could arguably be implied even if not overtly expressed.

Mandatory provisions which must be included in the .au registrant agreement, also address the issue of the registrant's consent to the disclosure of Whois data.⁴ Under those provisions, the registrant currently grants the registrar and registry operator rights to disclose information in accordance with the auDA published policies, including information that would enable the registry operator to maintain a public Whois service, provided that such disclosure is consistent with the NPPs.⁵ These mandatory provisions provide a clear basis for allowing greater disclosure under the current registration agreement with no further consent required from existing registrants.

NPP 2.1(a) also permits the disclosure of personal information for a "secondary purpose" where that secondary purpose is related to the primary purpose of collection, and the person "would reasonably expect the organization to use or disclose the information for that secondary purpose." In these circumstances, the primary purpose of collection of the personal information is to register the domain name. A secondary purpose related to that primary purpose and arguably reasonably expected, is to inform third parties of the identity of the registrant.

This secondary purpose meets the requirement that it is a purpose related to the primary purpose of collection. The person making the disclosure would reasonably have the expectation that, given the public nature of their potential use of the domain name, the information about their identity would be disclosed in some form, just as with other company and business name registrations in Australia. Under the Guidelines to the National Privacy Principles, which the privacy commissioner has released,⁶ these circumstances certainly give rise to the "reasonable expectation" that the information would be disclosed, making the disclosure permissible under the NPPs and privacy laws.

Consistency with Other Australian and International Registries

Disclosure of contact details not currently provided in .au would be consistent with other Australian and international registries.

For example, an individual who carries on business under a name other than his or her own name must register that name in order to legally carry on business in any Australian state or territory. The individual's contact information is publicly available.

⁴ See the .au Domain Administration Registrar Agreement, Approved Version 2, Schedule B, clause 3, at <http://www.auda.com.au/pdf/auda-registrar-agreementv2.pdf>.

⁵ See, e.g., Melbourne IT Limited "Terms and Conditions for .au Domain Names," Clause 11, at <http://www.melbourneit.com.au/policies/aupolicy.php>.

⁶ Office of the Federal Privacy Commissioner, Guidelines to the National Privacy Principles, 2001, at http://www.privacy.gov.au/publications/nppgl_01.pdf.

Also, an individual in Australia wishing to apply for registration of a trademark must supply his/her name and address in addition to an address for service for official correspondence. This contact information is publicly available.

In addition, registrars in the familiar .com, .net, .org and other global top-level domains, which are available in Australia, the United States and in many other countries, must provide a free, publicly accessible online database of domain name registrant information. The information includes the registrant's name and postal address, and the administrative contact's and the technical contact's names, postal addresses, e-mail addresses, telephone numbers, etc.⁷ And, with respect to ccTLDs, we note that the World Intellectual Property Organization has published a guide on "ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes," which states:

One of the key components of an intellectual property compliant domain name registration system is a robust policy concerning registrant contact details. The collection and making available of registrant contact details is critically important because it is impossible to take informal steps or initiate formal procedures aimed at redressing infringements if the registrants who are guilty of them cannot be contacted.

New Australian Anti-Spamming Laws

We understand that one of the arguments for maintaining restrictions on providing Whois data is to limit the use of bulk access to the data in connection with mass unsolicited communications. INTA agrees with the need for such precautions. However, Australia now has anti-spamming laws that prohibit the sending of unsolicited commercial electronic messages (*i.e.*, e-mails and marketing messages to mobile phones). These laws would prevent the use of this data for electronic marketing (in the absence of consent) and provide strong remedies for any such misuse.⁸ There is therefore no need or basis on which to continue to assert that there are privacy grounds for restricting access to information, which continues to create difficulties for rights owners seeking to ascertain the identity of domain name owners, in order to pursue legitimate claims against them, where appropriate, in connection with a domain name or the use of a website for the display or transmission of infringing material.

High Costs and Inconvenience

⁷ ICANN Registrar Accreditation Agreement, Section 3.3, at www.icann.org/registrars/ra-agreement-17May01.htm.

⁸ Spam Act 2003 (Cth.), at [http://www.comlaw.gov.au/ComLaw/Legislation/ActCompilation1.nsf/0/DED153276FD7C6F9CA2570260013908A/\\$file/SpamAct03WD02.pdf](http://www.comlaw.gov.au/ComLaw/Legislation/ActCompilation1.nsf/0/DED153276FD7C6F9CA2570260013908A/$file/SpamAct03WD02.pdf).

If a company or individual is carrying on business through a website, consumers should have the right to contact the owner of the related domain name in a quick and easy manner. This is not the case under the current auDA Whois policy; the information currently available through Whois differs depending on whether the registrant is a company or individual.

Under the auDA policy, if the registrant is a company or business then a Whois search will disclose an Australian Company Number (ACN) or an Australian Registered Business Number (ARBN) together with the name of the entity. A third party wishing to obtain further information about the registrant may then undertake a company and business name search through the relevant government authority. This search will provide a principal place of business and registered office, along with information on directors and persons carrying on the relevant business. As such, this contact information is readily available through other means and we see no reason why auDA should not provide that information through the Whois database. Moreover, having to resort to these additional searches adds a layer of expense and delay to the consumer.

In the event that the registrant is an individual, the only identifying information that is provided is the individual's name and an e-mail address. That e-mail address need not be a direct address to the individual, but rather a chain of contact through the registrar. Accordingly, a third party seeking to contact the individual at a physical address only has at his/her disposal a search of telephone directories and/or an electoral roll search. This gives rise to obvious logistic difficulties in identifying the correct registrant, particularly where the registrant's name is common, *e.g.*, John Smith, and if there are multiple individuals under that name possibly in multiple states and/or territories. This problem is obviously exacerbated where an individual is intending to hide their identity, and uses or assumes a name which will not lead to their being identifiable from any other public records.

Renewal Deadline Information

In addition to issues relating to identity, the current Whois policy does not allow for disclosure of renewal deadlines for .au domain names. This issue is particularly significant because Australia is a first to use jurisdiction for trademarks, and the inability to see when a domain name was first registered makes it extremely difficult for trademark owners to determine what their rights might be against potentially infringing domain name registrants. The fact that auDA provides renewal information on the basis of a statement indicating that the enquirer intends to pursue legal action may not always solve the problem, as in some cases where there may not be the requisite intent to take legal action (*e.g.*, where the enquirer suspects that the domain name registration predates its own rights). Supplying information about renewal dates would provide an immediate means for rights owners to determine whether their rights may have been infringed without unnecessary legal costs or delay, or indeed administrative burden on auDA.

INTA is not convinced that this information should continue to be withheld. Renewal information is not affected by privacy laws as it is not personal information. Although

we understand that the rationale for removing this information from the public register was to reduce renewal scams, we also understand that the removal of the information has not eliminated the problem, but simply re-directed it away from renewal dates.

Many other domains include renewal deadlines in Whois records (*e.g.*, .uk, .ca and .us), and such information is publicly available for trade marks and business name registrations. Although both trademark and domain name owners in other jurisdictions face the problem of scam renewal advices, INTA is not aware of any evidence that these scams are more of an issue in Australia than in other countries, and in any event, the current absence of the data has not resolved the problem. Query limits and bulk access restrictions remain appropriate, as do warnings to owners.

Domain Name Portfolio Information

auDA currently does not supply lists of all domain names owned by a particular registrant, and it is not possible to search this information through the public records. There is no means of searching this information without specialized and expensive software, and it is not clear that the software, which can be used to search proprietor details for gTLD names, could be used for the .au domain in any case.

In these circumstances, INTA submits that auDA should consider adopting a policy whereby a list of all domain names owned by a particular registrant can be requested, subject to the provision of a reasonable basis for requiring that information, which should include alleged cybersquatting and other violations of trademark law. As multiple registrations are regarded as evidence of bad faith for the purposes of UDRP proceedings, which is likely to be followed under the auDRP, having access to such material would be very useful in terms of obtaining evidentiary material in the case of disputes.

Conclusion

INTA believes that providing full Whois information for both individual and organizational registrants is in the best interest of consumers and the general public. As such, INTA submits that the following changes to the policy are desirable:

- Provision of full contact information for the registrant including physical address, telephone number and facsimile number, as well as renewal information, consistent with Whois information in the generic top level domains.
- In the alternative, but at a bear minimum, the full address details should be provided pursuant to a “Request for Domain Name Creation Date.”

INTA appreciates the opportunity to make these submissions in response to auDA’s Policy review, and INTA would welcome the opportunity to respond to any questions auDA may have regarding this submission.