

**Review of Policies in
.AU SECOND LEVEL DOMAINS**

**Proposed changes of domain name eligibility and
allocation policies in the .au domain space**

Introduction

The following is our submission as part of the policy review into domain name policy conducted by auDA. Our comments refer to the Public Consultation Report published by the auDA Name Policy Advisory Panel in November 2000. After reading the report we thought it worthwhile to comment on a few matters that stood out to us in light of our experience as intellectual property lawyers operating in this area. Therefore, we have not focused on what may be the key issues arising out of the Report but made submissions based on practical experience with the present system. Our submissions below follow through the Report sequentially.

Trade Marks

We consider it a good idea to require a **trade mark** as an added alternative criteria for lodgement. We do not consider a requirement of a trade mark as a "pre-requisite" for registration (as we have seen reported in the press) to be appropriate. We think it appropriate that a person with a business name should be able to provide that as satisfactory evidence to the domain name registrar. We also think that in cases where organisations have a trade mark, but not a business name it is appropriate for them to be able to register a domain name (if only to protect it from cybersquatting), without having to register a business name. We do a considerable amount of work in the wine industry and find that often companies wish to protect their brand name (often a registered trade mark) from cybersquatters but they should not have to register a business name for just this purpose.

We agree with statements, made by a representative of Melbourne IT on the AuDA DNS list, that a **trade mark application should not be sufficient** for registration of a domain name. From our experience as intellectual property lawyers working with trade mark applications, a trade mark application is not certain to proceed to registration. Third parties may elect to oppose the application and succeed in defeating it. IP Australia may determine that the mark, for one of many reasons, is not suitable as a trade mark. An undesirable scenario would be where the domain name applicant cites a trade mark application in support of their claim to the domain name, obtains domain name registration and then the trade mark application fails – there is no longer a valid basis for the domain name registration.

We support the renewal period recommendation in 4.1.5 and believe this may alleviate any problem arising as described above. In summary, to clarify what is meant in the recommendation, it should be clear that a **registered trade mark** is required to support a domain name application in the absence of a business name or company name.

Multiple Domain Name Ownership

We agree that a person should be able to hold greater than one domain name in accordance with 4.1.2.

Cases where protection of name requires domain name registration variations.

In our practice we have some clients who wish to obtain domain names to protect their name, not only from cybersquatting but from individuals who may wish to harm their business reputation. In most circumstances there may be more than one domain name applicable to that organisation. A simple example of this is where an organisation's trading name contains the word "Mount" or "Saint" – there are two potential domain names, mtwhatever.com.au and mountwhatever.com.au. We have seen this example with a private school and again with the wine industry.

Whilst we agree that persons can hold multiple domain names, there should remain the requirement to establish a connection to each domain name, whether that is a business name, company name or otherwise.

"Direct Derivation"

We believe that the rules of "direct derivation" between an organisation's name and its domain name should be relaxed. The acceptance of trade marks and names derived from trade marks should alleviate the strictness of this rule. However, there are likely to continue to be circumstances when the "direct derivation" rules continue to be unfairly harsh.

We have read and understand the "pros" and "cons" listed in connection to proposal 4.1.3. To further alleviate, but perhaps not eliminate, unfairness, we suggest the following:

The current automated process that looks for a "direct derivation" from either a business name or company name could be expanded to check for direct derivation from a trade mark. If the automated process detects that the applicant has failed to establish a direct derivation, a "complaints hyperlink" should be available, whereby the registration request can be referred to an arbitrator. Arbitrators should apply common sense and consistency in determining the applicants entitlement to the domain name. There should be two publicly available (and easy to find!) documents for registrants: a set of rules by which arbitrators determine such disputes and a body of precedent decisions based upon those rules.

If the registrant disagrees with the arbitrators decision, review of the decision should be available to an appropriate independent judicial body (either an existing body or new body). The costs of each appeal should be appropriate to act as a disincentive for individuals to abuse the process.

Duration of Registration

Registrations should be allowed for between 1 and 10 years as is the case with US domain names. This allows persons to choose the length of their domain name registration to meet their business needs and plans.

Domain Name Disputes and "Freezing" the Domain Name

We are concerned about the implied suggestion in 4.5.2 where a domain name would be "frozen" until a dispute over that domain name is resolved. Unless we have misunderstood what is meant by "frozen", it would be unfair to someone with a website located at a domain name to have to shut down their web site until the domain name dispute is resolved. There should be a clarification to the references to "frozen" to explain that the status of the domain name is frozen (eg it cannot be transferred to another person) but the web site operating at the disputed domain remains unaffected. We assume that "frozen" does not refer to a shut down of the web address in dispute, as then a competitor or troublemaker could lodge domain name dispute proceedings to cause harm to the owner of the domain name.

Maintaining Address Details

We think it appropriate that the domain name registrar takes responsibility for ensuring that address details are kept up-to-date. This may be as simple as a regularly sent automatic email to a domain name's administrative contact requesting an address update. If the email bounces, the registrar should send a letter to the address given by the registrant.

Yours faithfully

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