

SUBMISSION IN RELATION TO AUDA PUBLIC CONSULTATION REPORT

I am a solicitor who practises almost exclusively in the area of intellectual property. This is a personal submission and should not be taken to represent the views of my employer or its clients. While my comments below may have broader application, the focus of my submission relates only to registrations for domain names in the .com.au domain.

Where possible, I refer to the corresponding Recommendation in the Second Public Consultation Report (the *Report*). I have, however, found it more convenient to develop my submission using a structure which does not follow that of the Report.

My submission is structured as follows:

1. First the purpose of the .com.au domain is addressed, and the policies that I think best achieve each of the components of that purpose are discussed.
2. Secondly, this submission looks at how the policy should integrate with a UDRP type process in order to address the issues of “cyber-squatting”.
3. Finally, the submission addresses certain other Recommendations in the Report.

1 PURPOSE OF THE .COM.AU DOMAIN

In my view the fundamental question that must be resolved for the .com.au domain is -what is its purpose? This then dictates the most appropriate eligibility criteria.

Schedule A of the Report says that the purpose of the .com.au domain is “for commercial entities, currently registered in and trading in Australia”. In my view this purpose can, consistently with stated objectives contained elsewhere in the Report, be stated slightly differently:

The .com.au domain is for entities to use in good faith in Australia for a commercial purpose.

The components of this restated purpose are each discussed below:

1.1 entities

It should be the use of the domain name that is commercial, not the entity. Since individuals may own business name and trade mark registrations, clearly the “entity” itself need not be a “commercial entity”. A registered business name is **not** an entity.

1.2 to use

In the explanatory notes beneath Recommendation 4.1.1 in the Report it says that “cyber-squatting and domain name hoarding” are undesirable activities. Hoarding is an activity which does not involve the “use” of a domain name licence, and frequently “cyber-squatting” will involve no “use” of a domain name licence.

Recommendation **3.1.3(c)** says: “There must be a declaration of a bona fide intention **to use** the domain name licence for the purpose envisaged by the relevant 2LD.” (emphasis added).

In my view, the actual use of a domain name (allowing for a reasonable start-up period and for legitimate excuses) should be a criterion for the continued eligibility of a .com.au domain name licence. By “use” I mean that the domain name should be delegated and should direct an internet user who enters that domain name to an active website (whether or not it is hosted using that domain name address, or whether the internet user is directed to another related site owned by that entity or by a related entity). That is, it should not be what the Panel refers to as “passively held”.

This is hardly an unique concept. Under trade mark law a trade mark registration is generally able to be removed from the Register upon being challenged, if it has not been used in good faith during the preceding three years (provided that five years have elapsed since the filing date of the trade mark application). A non-use action may, however, be brought at any time where the challenger can show that the trade mark owner did not, at the time of filing, intend to use the trade mark (although this is generally very difficult to prove). See Part 9 of the *Trade Marks Act 1995*.

A trade mark registration provides its owner with a limited monopoly, being restricted to particular goods and/or services. A domain name, on the other hand, prevents anyone else from using that name to promote or sell **any** products or services. I therefore think that for a .com.au domain name licence, a shorter period of non-use than the three years for trade mark registrations should justify its removal since the scope of the monopoly is greater. I have therefore suggested 18 months.

I suggest that if a domain name registrant cannot show that it has used the domain name licence during the first 18 months (or other time period selected by the Panel) after registration, and it cannot demonstrate that there was a good reason why it could not commence use of the domain name, then it should be transferred to a challenger which itself satisfies the eligibility criteria for registering that .com.au domain name.

I further suggest that, if a challenger can show that the registrant did not, at the time of registering the domain name, intend to use the domain name for a good faith commercial purpose, then the domain name should be transferred to the challenger, provided that the challenger has satisfied the eligibility criteria.

I have suggested above that use of a domain name licence be a positive obligation. In contrast, Recommendation **3.1.3(e)(iv)** sets out when **non-use** of a domain name licence is objectionable. It provides that non-use of a registration is **not** a bona fide use of the domain name licence if the “sole purpose” is to prevent another from licensing it. It is implicit that this bad faith non-use of the domain name licence must be directed at a particular entity (a classic “cyber-squatting” scenario).

The question that I have, then, is - what non-use of a domain name licence does the Panel consider to be permissible? I have suggested above that a non-use period during the first 18 months of a domain name licence allows a registrant to protect its position while it prepares to use the domain name licence. The creation

of a positive obligation to “use” the domain name licence (subject to that 18 month start-up period, and any reasonable excuse) can only be objectionable if there is some other non-use of a domain name licence that the Panel considers to be legitimate. If none can be identified, I propose that the use requirement would effectively address many “cyber-squatting” and “domain name hoarding” issues.

1.3 in good faith

While lawyers love Latin phrases such as “bona fide”, I suggest that “in good faith” is a term that would be better understood by the general public.

This requirement is referred to in the Report in Recommendations **3.1.1(d)** and **3.1.1(e)**, but in my view it is more fundamentally related to the requirement discussed at **4.1.1** and **4.1.2** of the Report (the connection between the domain name and the registrant), which I propose to discuss first.

(1) Connection between domain name and the registrant

It is presumably intended that the requirement that a domain name be related to a registered company name, business name, and (under the new proposals) trade mark registration or trade mark application, will show that the registrant intends to use the domain name licence in good faith.

Of itself this connection is at best indicative of such an intention.

- **Registered company names** There are few restrictions under the Corporations Law on what names may be registered as a company name, and there is certainly no requirement that the company name relate in any way to the name that the company trades under or to any brands that it uses.
- **Business name registration** The fact is that, despite the penalties contained in the various State Business Names Acts for improper registration of a business name, there is little enforcement of those Acts. At the time of registration, it is my understanding that the relevant registries simply check that the business name does not conflict with other business name registrations, or with registered company names.
- **Trade mark registrations and applications** A self-filed trade mark application costs \$150. In practice there is little restriction upon what can be registered as a trade mark, provided that the appropriate class and specification of goods or services is selected (the only exceptions that I can think of is the registration of profanities, geographical names and surnames, or possibly certain extremely general descriptors such as “greatest”, subject to evidence of use). Unlike the Business Names Acts, there is no offence of registering, but not using, a trade mark, although the registration may then be vulnerable to a non-use action.

The connection with the registered name (or trade mark application), while indicative of good faith, is certainly not determinative. Moreover, a legitimate connection may still exist between a domain name and the domain name registrant’s business, even where that business does not have that name registered as a company name, business name or a trade mark. For example, in my experience there are many businesses with common law (unregistered) trade marks which should, in my view, legitimately be capable of supporting a .com.au domain name licence.

I do not take issue with the requirement that there be a substantial and close connection between the domain name and the domain name licence holder (Recommendation 4.1.1), but rather with the requirement that this be **proven** by reference to a registered name. I am certain that most practitioners will be aware of many clients who have registered business names in order to support a .com.au domain name licence for what would be generally considered to be a legitimate purpose, but who, in so doing, would be in breach of the relevant Business Names Act (see below).

The question, then, is - what purpose does this requirement really serve (other than, at present, to raise government revenue through increased business name registrations)?

Presumably it is thought that the \$70 business name registration fee (this is the present Victorian fee), and, possibly, the penalties under the Business Names Acts, provide a disincentive to would be “cyber-squatters”. Given that this registration fee is only 50% of the present online registration fee for a two year .com.au domain name licence, I cannot imagine that this in fact provides any significant additional disincentive.

In answer, it may be argued that **any** added disincentive to “cyber-squatters” is a good thing, and that any “good faith” domain name registrant would own the requisite registered company or business name, or (increasingly more likely) trade mark registration or trade mark application. **If** this view is taken by the Panel (and I do not think that any perceived advantage outweighs the inconvenience to legitimate users of the .com.au domain, some of whom do not own any such registrations or applications), then I agree with the recommendation contained in the notes beneath Recommendation 3.1.3(d) that a trade mark application should be able to support a domain name licence. The following paragraphs detail my reasons for this view.

In placing so much focus upon how to exclude “cyber-squatters”, it is important that the legitimate interests of a person who wishes to abide by all relevant laws, and register a .com.au domain name, not be forgotten. If an entity wishes to establish a new brand and to promote its products or services in the .com.au domain, then the first option of incorporating a company with an appropriate name is likely to be expensive. It could not legally register a business name since, under the Business Names Acts, the entity must intend to, and then actually, trade under that name, as opposed to offering goods for sale by reference to that name. For example, Bill’s Lollies may offer GUMBEARS, CHEWIES, and LIZARDS for sale, but it could only be said to be trading under the Bill’s Lollies name, and not as GUMBEARS, CHEWIES, or LIZARDS. These three names could not therefore be registered as business names, without breaching the relevant Business Names Act and rendering the registrant liable to a penalty (in Victoria the *Business Names Act 1962* provides for imprisonment). If a trade mark registration were the only alternative (a trade mark application being deemed insufficient), then the entity would have to wait for **at least** seven months for its trade mark application to mature into a trade mark registration, during which time that name would be a prime target for any “cyber-squatter”.

Again, **if** the approach of requiring proof of a registered name is to be adopted by the Panel, then I think that a trade mark application should still be allowed to support a domain name licence, even if it has not matured into a trade mark

registration at the time of renewal of the domain name licence. A trade mark application will not necessarily mature into a registration within the present two year licence period for a .com.au domain name. If it is opposed by another party, it will frequently take more than two years for this to be resolved. Until the Australian Trade Marks Office actually rejects a trade mark application, I think that it should still be able to form the basis for a domain name licence (if such a basis is to be required). This is because:

- (1) if a trade mark applicant is incurring the expense of defending an opposition, then this would strongly indicate that the applicant has a bona fide intention to use the name;
- (2) as discussed above, a “cyber-squatter” would have far simpler options for registering a name that would support the domain name licence (for example a business name, or even a trade mark in a completely different class for a different specification of goods or services); and
- (3) as discussed below, if the domain name registrant is a “cyber-squatter”, then there should be other bases upon which a challenger should be able to have the domain name licence transferred to it.

I concede that there may be one practical difficulty with my submission in those cases where a domain name applicant wishes to register a domain name that is different from a name that is associated with its business. It should have the right to know in advance whether its proposed name is “substantially and closely connected” with the name that it is associated with its business. Where its proposed name is different, then it should be able to have the issue of whether a “substantial and close connection” exists resolved in advance by an appropriate body (whether that be the Registrar, or some body set up by the Panel). Otherwise, the domain name licensee would risk losing the name in a subsequent challenge for lack of connection. Clear guidelines should also be produced as to what is a “substantial and close connection”.

(2) Good faith intention to use the domain name for a commercial purpose

Requiring that a connection exist between the domain name and the registrant would generally be sufficient to demonstrate good faith. Nevertheless there **may** be circumstances where use of a domain name would not be use in good faith, even where such a connection is shown.

For example, (and using the facts of the recent High Court decision of *Campomar v Nike* as a basis), Campomar could show a legitimate connection between www.nike.com.au and its registered trade mark NIKE for perfume. If, however, it used that website to offer adidas products for sale to the Australian public, then that would be use in Australia for a commercial purpose. It would not, however, in my opinion, be use in good faith. There is, then, a need (in what would be very limited circumstances) to define what use would be “use in good faith”. I agree that the Panel’s Recommendations in **3.1.3(d)** and **3.1.3(e)**, perhaps slightly reworked, would satisfactorily address this.

Recommendations **3.1.3(d)** and **3.1.3(e)** provide as follows:

3.1.3(d) “A bona fide intention to use the domain name licence for the purpose envisaged by the relevant 2LD, should be demonstrated in

accordance with the rules applicable in that 2LD. Schedule A lists the eligibility criteria for the current 2LDs.

3.1.3(e) “Purposes that would not be considered bona fide include but are not limited to:

“i. licensing a domain name for the sole purpose of selling it;

“ii. licensing a domain name for the purpose of diverting trade from another business or website;

“iii. deliberately licensing misspellings of another trader’s company or brand name in order to trade on the reputation of another trader’s goodwill; and

“iv. licensing and then passively holding a domain name licence for the sole purpose of preventing another (eg. an Australian Registered Trade Mark owner) from licensing it.”

As a general comment, and at the risk of repetition, if there were a requirement to use the domain name, and a requirement that the domain name be connected with the registrant’s business, then it is difficult to imagine many instances in which those four scenarios would exist.

The four scenarios in **3.1.3(e)** roughly correspond with the four non-exclusive criteria for evidencing bad faith in clause 4(b) of the UDRP:

- Recommendation **3.1.3(e)(i)** is similar to clause 4(b)(i), except that the Recommendation only refers to the sale of the domain name, and not to the rental or other transfer of the domain name. I think that there should also be a reference to rental of the domain name. I also think that having a “sole purpose” test invites technical avoidance, and a “dominant purpose” test is preferable.
- Recommendation **3.1.3(e)(ii)** is similar to clause 4(b)(iv) except that the Recommendation does not require there to be a commercial gain, or any likelihood of confusion.
- Recommendation **3.1.3(e)(iii)** is similar to how clause 4(b)(iv) has been applied in decisions using the UDRP (eg see *Encyclopedia Britannica Inc v John Zuccarini and the Cupcake Patrol* (WIPO D2000-0330)).
- Recommendation **3.1.3(e)(iv)** is similar to clause 4(b)(ii), although there is no requirement that there have been a pattern of such conduct. If my above suggestion were adopted and a registrant were required to use the domain name within 18 months of registration (unless it had a reasonable excuse), then this Recommendation could still apply during the intervening 18 months in those cases where the dominant motivation for registering the domain name is to prevent another person from licensing that domain name.
- Clause 4(b)(iii) of the UDRP is not specifically encapsulated in the Recommendations, although arguably this general clause is addressed by the remaining Recommendations of the Panel.

The Report sets out these four criteria as **non-exclusive** examples of conduct that is **not** bona fide. I think that it is preferable to have these four criteria as exclusive criteria, with amendments to the policy being made if it transpires that the criteria

do not have sufficient compass. I think that it is also important for a domain name licence holder to be protected from what has been termed “reverse domain name hijacking” (eg see *Rough Justice* report), and that, accordingly, any arbitrator under a UDRP-like process not be given too much latitude to avoid the clear terms of the policy.

It should not be forgotten that a challenger may have a legal remedy to address the conduct of a domain name registrant. The ideal scenario, discussed below beneath heading 2, is that recourse to a court of law should not be necessary. Nevertheless, for more imaginative abuses of the domain name system, a complainant is likely to be able to establish a cause of action pursuant to the provisions of either the *Trade Marks Act 1995*, or the *Trade Practices Act 1974*.

1.4 in Australia

This relates to Recommendation **3.1.3(a)**. As discussed above, it is clearly open for anyone, including an overseas entity, to abuse the trade marks system by applying for or registering a trade mark in a convenient class and for a convenient specification of goods or services. Therefore, I think it is more important to articulate the goal for the operation of the .com.au domain instead of formulating an eligibility criterion in order to achieve an unarticulated goal.

In my view, the .com.au domain should be used for websites which are connected in some way with Australia. As a practical consideration, and especially if a robust policy and set of procedures is developed to combat “cyber-squatting”, one would query why anyone would want a .com.au domain name registration if they did not have any connection with Australia.

Nevertheless, if the goal is that the .com.au domain is for commercial use that is connected with Australia, then I think that this goal should itself be a specific criterion for eligibility for a .com.au domain name licence, instead of requiring that the registrant be an Australian entity, or own an Australian trade mark registration or trade mark application. The connection, I suggest, could be whether the website is particularly targetted at the Australian market.

1.5 for a commercial purpose

Recommendation **3.1.3(c)** says that “There must be a declaration of a bona fide intention to use the domain name licence for the purpose envisaged by the relevant 2LD.”

As a matter of legal interpretation (and this policy will inevitably be subjected to legal interpretation) I do not think that a “declaration” is meaningful. While a declaration may, to some extent, dissuade a potential “cyber-squatter”, the declaration is not a statutory declaration (and therefore a mis-statement would not attract penalties for perjury). Instead, the use (as to which, see above) of the domain name for a commercial purpose should be a continuing criterion for eligibility for the domain name.

I do not consider that having, as a ground for the revocation/transfer of a .com.au domain name, the requirement that the domain name be used for a commercial purpose, to be a controversial proposal. I note that the JVTeam (the Registry Operator for the new .biz TLD), in its proposal to ICANN, outlined a similar concept (<http://www.icann.org/tlds/biz4/TLDPolicyPropbiz.htm> beneath heading III):

“JVTeam will require that registrars collect a certification from the registrant that they are a business, that the name is reasonably related to the registrant’s business, and that the domain name will be used for commercial purposes only. This certification will form the basis for the deletion of a registered name through the UCDRP where necessary and a registration will not be made without a completed certification. JVTeam will not, however, deny initial registrations except for duplicate requests.”

2 TACKLING “CYBER-SQUATTERS and the RESOLUTION of DISPUTES

The issue of “cyber-squatters” can be addressed at either or both of two stages. At the first stage by seeking to prevent or dissuade “cyber-squatters” from registering domain names in the first place, and at the second by putting in place measures for removing such domain name registrations.

I have sought to outline above why I think that the first approach is not practicable, and I think that any perceived benefit in preventing or dissuading “cyber-squatting” is outweighed by the inconvenience caused to legitimate users and potential users of the .com.au domain (the two obvious options being (1) requiring registered names to be used in support of a domain name registration, and (2) having high licence fees for .com.au domain names. Moreover, it seems to be an unquestioned wisdom that Australia’s present .com.au registration policy has resulted in less “cyber-squatting” activity in Australia. I first question whether this is true (I note that, for example, in the *Rough Justice* Report it is said that only with the introduction of the UDRP did the true scope of the “cyber-squatting” problem become apparent), and secondly I suggest that, if it is true, that it may have more to do with other factors, for example, the fact that many companies have placed far more value upon a .com registration than a .com.au registration, therefore providing far greater incentives for “cyber-squatting” in that domain.

It follows that I think that the issue of “cyber-squatting” is best addressed at the second stage, by facilitating the removal of improper domain name registrations.

The value to a “cyber-squatter” of a domain name registration is, in general terms, any monetary amount that is less than that which a challenger would incur in seeking to have the domain name licence transferred using an available dispute resolution process (including courts of law). Therefore, if a low cost dispute resolution mechanism can be introduced, this is likely to deter the practice of “cyber-squatting”. This is, of course, predicated upon having a dispute resolution process that effectively interacts with an effective policy so that any “cyber-squatter” would be required to transfer the domain name to a challenger.

Operation of an Australian version of the UDRP

The Report (at Recommendation 3.1.3(g) and at 6.2) generally supports the introduction of a dispute resolution process modelled upon the UDRP.

The Report also recommends that an applicant for a domain name licence demonstrate “a bona fide intention to use the domain name licence for the purpose envisaged by the relevant 2LD” (Recommendation 3.1.3(d)), and then seeks to provide a non-exclusive definition of what would **NOT** be considered to be a bona fide intention (Recommendation 3.1.3(e)).

ICANN's UDRP has been developed for use with the .com, .org and .net domains which do not have any pre-requisites for domain name registrations (other than, somewhat circularly, the fact that to be able to resist a UDRP challenge, the domain name registration should not satisfy the criteria under the UDRP for its potential removal).

The UDRP is primarily a low-cost process for hearing and resolving disputes (as set out in the Rules for the UDRP). I strongly agree that such a process should be adopted in Australia. As drafted, and as discussed above, the UDRP contains (at clauses 4(a), (b) & (c)) the continuing eligibility criteria for .com, .net and .org domain name licences. The Panel, in putting forward Recommendations **3.1.3(d)** and **3.1.3(e)**, appear to contemplate that for Australia these eligibility criteria will instead appear in the policy, rather than in any Australian version of the UDRP. I agree that this is less confusing.

If my suggestions above were adopted, then the Australian version of the UDRP would provide that a domain name could be challenged on the following (summarised) bases (which would operate by reference back to the Policy):

- (1) challenge on the basis of non-use after 18 months, or challenge at any time for lack of good faith intention to use;
- (2) challenge on the basis that there is no use in good faith because:
 - (i) there is no substantial and close connection between the domain name and the domain name licence holder; and/or
 - (ii) one of the four scenarios (as presently generally outlined in Recommendation **3.1.3(e)**) is established;
- (3) there is no connection with Australia; or
- (4) there is no use for a commercial purpose.

Each of these grounds are discussed in detail above. I suggest that for a challenge based on the third and fourth grounds, that the domain name registrant should first be given a three month period in which to rectify that situation (and thereafter must maintain this as a condition of eligibility).

Any challenger should, in my view, be an entity that would itself be eligible to register that domain name.

WHOIS function

The WHOIS function is an invaluable tool for a practitioner advising clients, and for the public generally. Further information that I think should be accessible is:

1. the renewal date for a domain name licence;
2. the complete ownership details of all previous registrants of that domain name and the periods of those ownerships; and
3. the ability to conduct a proprietorship search to discover what domain names are owned by an entity.

Certainly all of these details are readily available with respect to trade marks, and, for most States, business names.

3 OTHER RECOMMENDATIONS IN THE REPORT

“3.1.1 There should be no restriction on the number of domain name licences that may be held by a single entity or individual.”

I agree that there is no reason for such a restriction. There is no persuasive reason why an entity cannot own more than one domain name in the .com.au domain, and indeed many do, often supported by a suite of business name registrations.

“3.1.3(f) The domain name licence applicant must acknowledge at the time of application that their entitlement to a domain name may be challenged by a third party with superior legal rights in the words forming the domain name.”

A person will have a right to challenge the ownership using available legal remedies regardless of any such acknowledgment. Nevertheless, including such an acknowledgment **may** serve to dissuade would be “cyber-squatters”.

“4.3.1 Until an appropriate licence allocation method has been devised, the licensing of generic domain names should be prohibited and following ‘reserved list’ approach should be adopted:

- a. a definition of the term ‘generic’ will be developed;**
- b. domain names that have to date been rejected by the current registrars for being generic will be placed on a reserved list;**
- c. new applications for domain names that may be considered generic will be referred to auDA;**
- d. if the domain name is determined by auDA to be generic then it will be added to the reserved list; and**
- e. applicants may challenge domain names on the reserved list, and auDA will determine whether the name should remain on the reserved list or whether changed circumstances mean the name can be licensed.**

“4.3.2 Until an appropriate licence allocation method has been devised, the licensing of geographic domain names should be prohibited, using the same reserved list approach outlined in 4.3.1 (substituting ‘geographic’ for ‘generic’).”

In my view there is no persuasive reason why generic words or geographic names should not be available for registration in the .com.au domain. It is unfair to trade mark and business name owners who have adopted as their trade mark or business name a name that also happens to be a generic or a geographic word. And, as discussed below, it prevents the use of many desirable words as domain names.

generic words

It has been argued that, just as for trade marks, no individual should be able to monopolise a generic word (if it describes a particular product, service, or industry sector). However, for trade marks, a generic word is only rejected if it is descriptive of the particular goods or services the subject of the trade mark application. For example, while APPLE could not be registered as a trade mark for apples, there would be no difficulty in obtaining a trade mark registration for goods such as, say, computers.

Or another example, while there has been criticism of the registration (which occurred prior to the change in policy for the .com.au domain) of drive.com.au which is used by Fairfax to sell cars, I wonder whether the same criticism would

be levelled if instead Unilever had registered the domain name to promote or sell its DRIVE washing powder.

Ideally a domain name will be one that is easily remembered by a registrant's target market. "Generic" words will generally have the advantage that they are likely to be more easily remembered. The policy presently prevents anyone from registering a "generic" word as a domain name if it is used to represent goods, services, or an industry sector.

The issue, as I see it, is not one of protecting the public (consumer protection laws could be used if a generic word registered as a domain name were misused). The issue is who has the best right to obtain the registration for the domain name, especially since the first come first served rule cannot now fairly apply in this situation.

The discussion on the auDA DNS mailing list has recently dealt with this issue. I agree with those who argue that it would not be fair to simply look at records to determine who first applied to register a "generic" word as a domain name. This would prejudice those who were aware of the policy preventing the registration of those words.

I think that, as a transition measure, an auction system for generic words would be fairest with any proceeds in excess of the administration cost being donated to charity. While a ballot system (between applicants who would satisfy the eligibility criteria for a particular domain name) is an alternative, I think that:

1. this is likely to invite abuse by "cyber-squatters" notwithstanding that their registrations would be likely to be capable of challenge using a UDRP type process. It may also tempt entities who could legitimately register the domain names to apply to do so, knowing that it would not be unlikely that they would receive an offer from another party to purchase the domain name licence (and I query whether any UDRP type policy could adequately address this scenario without, at the same time, opening up the door too much to the practice of "reverse domain name hijacking"); and
2. the auction system has the ability to do social good.

Any registrant would still have to comply with the eligibility criteria for the .com.au domain.

geographic names

Again the argument is that no-one has a superior right to monopolise the use of a geographic name as a domain name. The result is that **no-one** can make any use of these names as domain names. Several companies have now discovered that their trade marks or business names are the same as some obscure geographical area in Australia. Some may have addressed this issue in registering that name as a trade mark, however they were extended the opportunity by the Trade Marks Office of showing that, because of their extensive use of the trade mark, the public would be unlikely to be confused and so the trade mark was registered.

Since no-one can presently register such names, the public cannot be said to have an expectation that the owner of such a geographic name is a representative body for that area. Presently the .gov.au domain could probably be used by local government (I am not familiar with the .gov.au registration requirements) to provide information and promotion of those areas. Alternatively, perhaps a new

2LD would best serve such a purpose, with any applicant having to establish that they have the right to represent that geographic area.

For the same reasons as above, I think that, as a transition measure, an auction should be held for geographic names.

Any registrant would still have to comply with the eligibility criteria for the .com.au domain.

“6.1 Changes to domain name eligibility and allocation policies should not have retrospective effect for current domain name licence holders, and should only apply to existing domain name licences if the licence is re-registered to a different entity, or when the existing licence holder’s licence expires. “

If “generic” words and geographic names are to remain unregistrable, then I agree that the registrant of such domain names should retain their domain name registration. I do think that the transfer of the licence to a related entity should be permitted - it is not uncommon for a company to wish to transfer intellectual property rights within the group of companies and this is not, in my view, objectionable.

I do, however, think that the four grounds for challenging a domain name registration, discussed above beneath heading 2, **should** apply to existing domain name registrations (including the requirement that the domain name be used). However, as a transition arrangement, no challenge on the basis of non-use should be allowed until 18 months (or whatever period were determined to be appropriate) had elapsed after the introduction of the new policy.