

9 November 2017

Policy Review Panel
c/o .au Domain Administration Ltd
PO Box 18315
MELBOURNE VIC 3001

By email: policy.review@auda.org.au

Dear Policy Review Panel

Implementation of Second Level Domain Name Registrations

1. The Intellectual Property Committee (**IPC**) of Business Law Section of the Law Council of Australia is grateful for the opportunity to provide comments in response to the .au Domain Administration Ltd (**auDA**) issues paper, dated October 2017, and entitled "Implementation of Second Level Domain Name Registrations (**Direct Registration**)" (**Issues Paper**).

2. The IPC makes the following comments in relation to the Issues Paper.

1. What date should be chosen as the cut-off date for determining registrant eligibility for priority registration of the second level domain name, and why?

3. The IPC prefers a later cut-off date to preserve the rights of registrants who have lawfully registered a third level domain (**3LD**) name after the announcement of Direct Registration. The increased number of conflicting registrations should be resolved through an appropriate competing claims resolution process which can take into account nuanced entitlement to registration issues, rather than an arbitrary cut-off date.

2. Should registrants of domain names at the fourth level within edu.au and gov.au be eligible for priority registration? If so, what rules should apply?

4. As a general principle, the IPC prefers an assumption that existing registrants in all second level domains (**2LD**) are eligible for priority registration unless there are legitimate reasons for their exclusion. Where competing claims to the same domain name arise, the prioritisation of those existing registrants should be a matter for the competing claims process.

5. The IPC is not aware of any compelling reasons why registrants of fourth level domain (**4LD**) names within edu.au and gov.au should not be eligible for priority registration.

6. If these registrants are not able to achieve their equivalent 2LD under the competing claims process, auDA should consider giving priority to a 2LD registration that includes the distinguishing features of the 3LD in which the relevant 4LD is registered. For example, if the registrant of the 4LD "fairtrading.nsw.gov.au" did not achieve

priority registration for fairtrading.au, it should have priority for "fairtradingnsw.au" or "nswfairtrading.au".

3. What process should be implemented to resolve competing claims to the same .au name and why?

7. Priority should be given to entities with a legitimate interest in the relevant domain name as evidenced by, among other things, the longest continuous registrant (who complies with the eligibility criteria and otherwise lawfully holds the domain name), identical registrations in other existing second level domains (such as lawful defensive registrations) and/or relevant trade mark rights (registered or at common law). A combination approach should be adopted to prevent the outcome where a domain name squatter defeats an entity with a more recent used and well-known domain name (albeit in in another existing 2LD) solely by duration of the domain name squatters' registration.
8. It is important that the prior legal and proprietary rights of registered and common law trade mark owners are not defeated or undermined by any new domains that come into existence. It is also important that domains are not used to mislead or deceive consumers, or damage or erode consumer protection mechanisms by facilitating misleading or deceptive conduct.
9. The IPC does not favour market-based approaches to resolving competing claims that do not align with the policy underpinning the .au domain name registration system. This would include an auction process or the prioritisation of .com.au over .net.au on the basis that some industry stakeholders have marketed .com.au as the premium domain extension.

4. Should registrants whose claim is unsuccessful be given priority to register another second level domain name?

10. Yes. Where a shorter version, or related variation, of the unsuccessful registrant's domain name is available, and that variation and registrant are eligible, the unsuccessful registrant should be given priority in relation to the proposed alternative domain name, provided it does not conflict with another person's registered or unregistered trade mark rights.

5. How much time should priority registrants have to exercise their right to register the matching second level name before it is made available to the public for registration?

11. The date needs to give entitled priority registrants time to properly assess their rights and act, taking into account the expected timeframes for the roll out of the auDA's public awareness campaign. The IPC has no comment on the specific length of time required by priority registrants for this assessment.

6. Should certain names be reserved for future use as 2LDs? Please indicate which names and why they should be reserved as future 2LDs?

12. The IPC agrees that this is an opportunity to reserve names required for future use, such as "hcourt.au" or "nation.au". However, the IPC considers that it should not be for auDA to determine, nor should auDA be obliged to determine, how governments, courts or other relevant parties should manage their domain name registrations into the future, and an objective, principled and rules-based approach should be adopted

instead. The IPC also recommends that auDA consider alternative processes, such as an opportunity for relevant parties to nominate future 2LDs those parties think should be reserved.

7. Are there names whose use is not prohibited at law that should be reserved?

13. Domain names that confusingly or misleadingly create an appearance of authority or government affiliation should be reserved. This includes names of existing government agencies or government owned corporations (e.g., "AustraliaPost.au"), domain names that refer to a traditional government function (e.g., "SocialServices.au") or existing well known authoritative 2LDs from other jurisdictions (e.g., ".sch.au" or ".mil.au" from the UK system).

8. Should names that are potentially confusing or misleading when registered at the second level be reserved (i.e. not available for registration)?

14. Yes. In addition to those discussed in response to question 6 above, domain names that are misleading or confusing when compared to existing 3LD domain names should be reserved (e.g., "abccom.au").

9. Should names that are a deliberate misspelling of the existing 2LDs be prohibited from being registered at the second level?

15. The IPC considers that this is one category of the confusing or misleading domain names discussed in response to question 7 above. The approach to confusing or misleading domain names must be consistent, and the Law Council cautions against separate rules for particular examples of potential confusion.
16. In relation to questions 6, 7 and 8 generally, the IPC recommends development of clearly articulated rules that govern of the types of domain names that are to be reserved, with lists of domain names that fit the rules (e.g., deliberate misspellings of existing 2LDs) exemplified in the relevant schedules to the rules.

10. Should direct registration be implemented in .au using a staged process or concurrent reservation and open availability process, and why?

17. The IPC makes no comment on this practical matter which appears heavily influenced by the economic implications of staged implementation for registrars, balanced against the potential activity stimulated concurrent reservation and open availability.

11. Should other registrants or rights holders be given priority during the landrush or reservation period to register a second level domain name (trademark owners)?

18. The IPC has no comment on this policy matter. However, the IPC Committee notes that it will be crucial for auDA to remain vigilant in ensuring that existing eligibility criteria and disputes resolution procedures are correctly and consistently enforced by registrars during this period.

Please do not hesitate to contact Wayne Condon (wayne.condon@griffithhack.com.au) if you would like to discuss the views of the IPC on this issue.

Yours sincerely,

Teresa Dyson, Chair
Business Law Section