



Australian Government

National Office for the Information Economy

Mr Jeff Roberts
Secretariat
Advisory Council on Intellectual Property
PO Box 200
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Dear Mr Roberts

NOIE comments on the review of the relationship between trade marks and business names, company names and domain names

Thank you for the opportunity to comment on the Issues Paper prepared by the Advisory Council on Intellectual Property (ACIP) as part of their review of the relationships between business names, company names, trade marks and domain names. The following comments are provided on behalf of the National Office for the Information Economy (NOIE).

ACIP invited comment on the implications of domain name registration for trade marks, business and company names. In particular the following issues raised are of interest to NOIE:

- effectiveness of the Dispute Resolution Policy administered by .au Domain Administration Ltd (auDRP) and its remedies;
- the extent to which complaints are being made under the auDRP in bad faith and how it might be prevented; and
- the extent of trade mark infringement through good faith registration of a domain name and measures to minimise the likelihood of such trade mark infringement.

These issues are addressed in the following sections.

Effectiveness of the auDA Dispute Resolution Policy (auDRP)

The auDRP was put in place in August 2002 and is managed by .au Domain Administration (auDA) the not-for-profit domain name regulator endorsed by the Government. This policy is an adaptation of the Uniform Dispute Resolution Policy (UDRP) relating to generic top level domains (that is, .com, .org etc) implemented by the International Corporation for Assigned Numbers and Names (ICANN) as the body responsible for the management of issues relating to the domain name system.

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The ICANN policy was based largely on the recommendations made by the World Intellectual Property Organisation (WIPO) after an extensive study it undertook on the problems caused by the conflict between trademarks and domain names. Under the UDRP WIPO is also the accredited dispute resolution service provider.

The auDRP relates to disputes involving .au domain names and complaints made under this policy can be submitted to one of a range of approved dispute resolution service providers. This range includes a number of domestic service providers but also offers the opportunity to have a case presented to the international authoritative body on intellectual property issues, WIPO.

To our knowledge there has not been a review of the auDRP since its implementation however auDA is best placed to respond to this. One reason for there being no review may be that it is an effective mechanism and responsive to the needs of its users.

With regard to the remedies available to complaints of bad faith registration of domain names, the existing solutions to transfer or cancel the subject domain name appear to be suitable.

WIPO has established a Working Group which is likely to further examine best practices for preventing intellectual property disputes and expected to report to ICANN by the end of March. This report is very likely to closely relate to the current review being held by ACIP.

Bad faith registration of a domain name

A large majority of disputes over the registration of domain names are related to bad faith registration of domain names. Also known as 'cybersquatting', this practice involves the pre-emptive registration of domain names that is usually connected with a trademark (and can also occur in relation to well-known organisations and people) with the intent of selling or auctioning the name for a price higher than that paid for registration.

NOIE would welcome auDA's views on the extent to which bad faith registration of domain names is a real problem in Australia.

With regard to preventing complaints of bad faith registrations being made under the auDRP it is NOIE's view that there is no arbitrary way to decide intent of registration other than through the auDRP process. The decision about whether a registration has been made in bad faith is a matter for the dispute resolution service provider engaged through the auDRP process. All users of the domain name system should be afforded the opportunity to the full scope of the dispute resolution process.

In relation to preventing bad faith registration of domain names in general, and in an Australian context, a declaration should be made at the time of registration that certain databases (for the management of trade marks) have been checked. This is discussed in greater detail in the following section.

Trade mark infringement through use of a domain name

The current registration process for domain names places responsibility on the registrant to ensure they do not infringe potential or actual trade marks' rights. This could be an

underlying reason why there are some cases of trade mark infringements. auDA and IP Australia are the most appropriate organisations to comment on the extent of the problem in Australia and NOIE looks forward to information from these agencies as part of this review by ACIP.

NOIE believes that greater onus should be placed on registrants to ensure they do not infringe trade mark rights by ensuring, as part of the registration process, that they check certain databases. For example a simple change to the 'paperwork' that needs to be completed when registering a domain name, registrants could be asked to declare that trade marks databases have been referred to before proceeding with the registration.

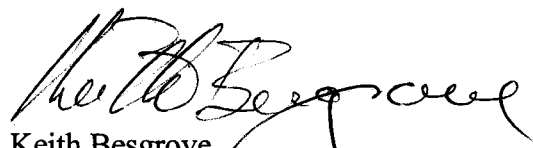
In the joint publication by auDA, NOIE, IP Australia and the Department of Industry, Tourism and Resources, entitled *it's your domain*, information about the relationships between domain names and trade marks is provided and refers to IP Australia's trade marks database. Similar information should be provided alongside the national Whois database (which is used by potential domain name registrants to identify the availability of specific domain names) and by auDA, the registry, registrars and resellers. This information could potentially provide a checklist to trade mark databases in other jurisdictions.

Attachment A to the Issues Paper

NOIE would appreciate advice on the comments in Attachment A in relation to proprietary rights being granted to domain names in other jurisdictions.

Please contact Ms Adrienne Lucas for clarification of any of the issues discussed in this document (email Adrienne.Lucas@noie.gov.au or telephone 02 6271 1465).

Yours sincerely



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