

Review of Alpana Roy, Australian Domain Name Law

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(2016, Thomson Reuters) 258 pages including table of cases and domain name decisions, .AU dispute Resolution Policy (auDRP), Rules for .au Dispute Resolution Policy (auDRP Rules), Uniform Domain Name Dispute Resolution Policy (UDRP), Rules for Uniform Domain Name Dispute Resolution Policy (UDRP Rules) and index

As much as we tend to associate the internet with youth, the Domain Name System, the technological architecture underpinning the internet, is itself no youngster, having recently celebrated its thirty-third birthday. The birth of the Domain Name System, or 'DNS' as it is commonly known, is traced back by many industry experts to June 1983, when Paul Mockapetris, an American computer scientist working at the University of Southern California's Information Sciences Institute, first tested the system that revolutionised the budding internet and enabled its exponential expansion. Australia's .au internet domain, one of the first domains created in the DNS, celebrated its thirtieth birthday in May this year.

In the early 1980s, there was an 'internet', but it looked very little like what we know today. Only a few hundred computers, mostly in the United States due to the internet's origins as a research project of the United States Department

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See Internet Hall of Fame, Inductees: Paul Mockapetris <<http://internethalloffame.org/inductees/paul-mockapetris>>; Cade Metz, 'Why Does the Net Still Work on Christmas? Paul Mockapetris' on Internet Hall of Fame (23 July 2012)

<<http://internethalloffame.org/blog/2012/07/23/why-does-net-still-work-christmas-paul-mockapetris>>.

See David L Mills, *RFC 799: Internet Domain Names* (September 1981) <<http://www.rfc-editor.org/rfc/rfc799.txt>>.

N.b. Information about volumetric and EAP page numbering is set out on page *ii* of this issue.

of Defense, were connected. For all of the computers in the network to communicate with each other and thus be 'connected', it was necessary for each computer in the network to know the identity of every other computer in the network. This was achieved by maintaining a single list, called the 'hosts.txt' file.³ As the number of computers connected grew, so too did the hosts.txt file grow, to the point where concerns began to arise as to how to keep up with the task of maintaining the list. Mockapetris proposed a solution: maintain not one list, but many lists organised in a hierarchical structure which divides and apportiones the responsibility of maintaining each list to different parties at the various levels of the hierarchy.⁴

Australia owes its .au internet domain in part to Mockapetris's catalytic idea, which went beyond simply apportioning responsibility for maintaining the list of computers connected to the network. The true genius in Mockapetris' idea lay in the hierarchical structure of the network; the administrator of each network would be responsible for maintaining the list of all computers attached to that network, in a hierarchical form resembling a tree.⁵ To the tree trunk are connected the largest branches. Each large branch is responsible for maintaining a list of all of the connections to it. A smaller branch is then in turn responsible for maintaining a list of all of the connections to it, and so on down the hierarchy. Australia's .au, along with other country's domains such as the China's .cn and New Zealand's .nz and the popular .com domain, are the large branches that connect to the trunk of the tree. Because of their place at the top of the hierarchy, the first point of connection to the tree's trunk, they came to be known as 'top-level domains', or by their acronym 'TLDs'. Apportioning the network into domains in this way facilitated its administration and technical functionality, but also differentiation: with the DNS, the internet transitioned from a single network to a network of networks, each with the potential for developing its own character and identity. Indeed, recent studies have shown that the majority of Australian internet users differentiate .au web addresses from addresses in other internet domains and 'trust .au and interact with .au because of its connection to Australia'.⁶

³ See Committee on Internet Navigation and the Domain Name System: Technical Alternatives and Policy Implications and Computer Science and Telecommunications Board Division on Engineering and Physical Sciences, *Signposts in Cyberspace: The Domain Name System and Internet Navigation* (National Academies Press, 2005) 39 ('*Signposts in Cyberspace*').

⁴ See *ibid* 39-24; Barry M Leiner et al, 'Brief History of the Internet' on *Internet Society* <<http://www.internetsociety.org/internet/what-internet/history-internet/brief-history-internet>>.

⁵ See Metz, above n 1.

⁶ Zaw-Sing Su and Jon Postel, *RFC 819: The Domain Naming Convention for Internet User Applications* (1 August 1982) <<http://www.rfc-editor.org/rfc/rfc819.txt>>.

⁷ *AusRegistry, Behind the Dot: State of the .au domain – Edition 1* (October 2014) <<https://www.ausregistry.com.au/wp->

Australia also owes its .au domain in part to Jon Postel and Joyce Reynolds, who brought Mockapetris' hierarchical structure to life by defining the various levels of the DNS hierarchy. In 1984, they announced the creation of two types of TLDs: generic ('gTLD') and country-code ('ccTLD').⁵ So-called 'ccTLDs' would be delegated to individuals and entities associated with the territory represented by a country code, following the International Standardization Organization's ISO 3166-1 list of 'English country names and code elements' (the 'ISO 3166-1 list'). So-called 'gTLDs', by contrast, would be domains not associated with a country code; these were instead named and operated according to their proposed use. The only differences envisioned between the two types of TLD were thus their naming conventions and their administrators:⁶ there was then and remains today no technical difference between a gTLD and a ccTLD.

Not all appreciated the informal process by which Jon Postel allocated the first country codes to acquaintances mainly working in universities overseas.⁷ Records show that Australia was one of the first countries to receive a ccTLD, with the .au's official record dating back to 5 May 1986.⁸ Fitness to manage the operation of a ccTLD such as .au demanded an ability to manage the TLD in 'an equitable, just, honest and competent' manner.⁹ This relatively basic criterion aimed at ensuring the network's functionality having been satisfied, full responsibility for developing and implementing the policy and procedural frameworks underpinning operation of the ccTLD lay in the hands of its manager.

By examining in detail the policies and procedures that have been adopted in Australia's .au ccTLD, Alpana Roy, an Associate Professor in the School of Law at Western Sydney University, fills a gap that has existed in legal scholarship since .au's creation thirty years ago. Whilst much has been written

content/uploads/2016/01/SOTD_Final_Report.pdf?utm_source=download&utm_medium=research&utm_campaign=btd-1>.

⁵ Jon Postel and J Reynolds, *RFC 920: Domain Requirements* (October 1984) <<http://www.rfc-editor.org/rfc/rfc920.txt>>.

⁶ Ibid 2. See also ISO, *Country Codes: ISO 3166* <http://www.iso.org/iso/home/standards/country_codes.htm#2012_iso3166_MA>.

⁷ See Paul Mockapetris, *RFC 882: Domain Names Concepts and Facilities* (November 1983) <<http://www.rfc-editor.org/rfc/rfc819.txt>>.

⁸ See Erica Schlesinger Wass, 'Introduction: Lots of Dots', in Erica Schlesinger Wass (ed), *Addressing the World: National Identity and Internet Country Code Domains* (Rowman & Littlefield, 2003) xii.

⁹ Internet Assigned Numbers Authority (IANA), *Delegation Record for .AU* (last updated 4 January 2016) <<http://www.iana.org/domains/root/db/au.html>>.

¹⁰ Jon Postel, *RFC 1591: Domain Name System Structure and Delegation* (March 1994) <<http://www.rfc-editor.org/rfc/rfc1591.txt>>.

about the policies and procedures established for gTLDs, of which in particular the most popular and populous .com,¹⁴ relatively little has been written about individual ccTLDs, including Australia's .au. Although today's ccTLD managers have less open-ended freedom than those who filled their shoes in the early days of the DNS through coordination of the DNS at a global level by the Internet Corporation for Assigned Names and Numbers (or 'ICANN'), Roy aptly makes clear that there is good reason to devote attention to the specific policies and procedural rules applicable to .au.

The book comprises six chapters plus five appendices setting out in full the various policies and procedural rules at the heart of her study. Roy begins by providing an overview of the components of a domain name, relating these to the hierarchical structure of the DNS, and an overview of the international and domestic legal and regulatory frameworks for the resolution of domain name registration disputes. Her approach throughout the book is comparative, which is particularly useful given the conceptual linkages between the *Uniform Domain Name Dispute Resolution Policy* ('UDRP'), which all gTLD operators are required through their contractual relationship with ICANN to implement,¹⁵ and the equivalent .au policy, the *AU dispute Resolution Policy* ('auDRP').

Chapter Two appropriately drills deeper into the auDRP, focusing on its development, its implementation in 2002, and its application since. This discussion clearly differentiates the further hierarchy embedded in the structure of the .au domain, where domain names are registered not at the second level of the hierarchy, as in the popular gTLD .com, but rather at the next level down (the 'third level') within 'open' or 'closed' second-level categories including .com, .net, .edu, and .gov. This layer of categorisation and a corresponding restriction against registering names at the second level directly within the .au (a practice which leads, for example, to domain names such as 'hotels.com.au' rather than 'hotels.au') in the *Domain Name Eligibility and Allocation Policy Rules for Open 2LDs*, impact the implementation of the auDRP and inform its contrast with the UDRP. Chapter Three extends this comparison to the procedural rules underpinning the auDRP and UDRP, respectively the *Rules for .au Dispute Resolution Policy* ('auDRP Rules') and the *Rules for Uniform Domain Name Dispute Resolution Policy* ('UDRP Rules').

Chapters Four, Five and Six shift to detailed analysis of the three substantive elements upon which claims under the auDRP are based. In this analysis Roy substantiates the two principal objectives of the auDRP, and thus its key points of differentiation with the UDRP, which she notes in Chapter 2: a) policy rules that apply to .au domain names that do not apply to domain names in gTLDs

¹⁴ Verisign, *The Domain Name Industry Brief Vol 13 Issue 2* (July 2016) <<https://www.verisign.com/assets/domain-name-report-july2016.pdf>> (reporting .com to be the most populous TLD at nearly 127 million domain name registrations, while the second largest TLD, .tk, is less than 30% that size).

¹⁵ See, eg, ICANN, *.com Registry Agreement - version 1 December 2012* <<https://www.icann.org/resources/pages/com-2012-12-07-en>> section 3.1(b) (binding Registry Operator to 'Consensus Policies', which includes the UDRP and its rules).

(which are subject to the UDRP); and b) improvements in clarity of expression and mechanisms to address practical constraints of the UDRP. These three chapters examine each of the three elements of an auDRP complaint as set out in clause 4(a) of the policy, namely:

- your domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and
- you have no rights or legitimate interests in respect of the domain name; and
- your domain name has been registered or subsequently used in bad faith.

Chapter 4 thus considers the way in which the first element has been applied by auDRP panellists. Roy usefully integrates into this analysis the relevant wording of the UDRP, as well as relevant interpretive guidance from the World Intellectual Property Organization's *WIPO Overview of WIPO Panel Views on Selected UDRP Questions* and the auDA *auDRP Overview 1.0*, a useful resource published by the .au administrator, auDA, in July 2014. She probes eligibility under the auDRP by identifying differences in the application of the auDRP and UDRP on issues of the jurisdiction of a trade mark registration, trade mark applications not yet granted, common law and unregistered marks in Australia and unregistered overseas marks. She also notes positions taken on non-trade mark names such as personal, corporate and business names and 'smart numbers' or 'phone words' such as '1300homeloan'. In exploring the meaning of 'identical or confusingly similar', she comprehensively cites to relevant disputes under the auDRP and UDRP, clearly noting commonalities between their positions. Further, she comparatively analyses the positions on gripe sites and the predatory practice known as 'typosquatting'.

Chapter Five considers the application of the second element of the auDRP. Roy begins by noting that the wording of this element under the UDRP precisely mirrors the wording of the corresponding element under the UDRP. She finds that many – but not all – of the issues underpinning this element are approached in the same way in the application of each policy. Comparative analysis is undertaken in respect of the registration of generic words as domain names, as well as the use of domain names in the context of criticism and fan sites and parking and landing pages. Her analysis of the position on the 'rights or legitimate interests' of a reseller or distributor of trade marked goods or services is of unquestionable value to the many market players engaged in that type of business activity. Later in the chapter she returns to the implications on proving rights or legitimate interests of satisfying the *Domain Name Eligibility and Allocation Policy Rules for Open 2LDs*, an issue which does not arise under the UDRP due to the differing structure of gTLDs with domain registration at the second, rather than third, level.

Chapter 6 logically concludes the substantive analysis portion of book by considering the application of the third and final element of the auDRP, dealing with registration or subsequent use in bad faith. She begins the chapter by quoting an auDRP decision, *UFC Gym Australia Pty Ltd v The Trustee for*

Moose & I Trust:¹⁶ ‘This is probably the most important element of the Policy....’ With that in mind, Roy helpfully turns to clarifying the relationship (and indeed difference) between elements two and three of the auDRP, namely ‘rights or legitimate interests’ and ‘bad faith’, as well as the notable ‘or’ in the third element (ie, ‘registered *or* subsequently used in bad faith’). As to the latter, she crucially highlights a ‘substantial deviation’ from the UDRP. She compares typical types of bad faith conduct under the auDRP and UDRP, finding similarities between the two, and notes the absence in the auDRP of the UDRP’s requirement for proving that the respondent has ‘engaged in a pattern’ of bad faith conduct. The use of disclaimers is addressed, as are statements made in settlement discussions. Various issues in relation to which auDRP cases have notably not arisen are also usefully noted.

In conclusion, Roy capably delivers on the promise set out in the Preface of her book. Indeed this is the first monograph on Australian domain name law, and a comprehensive one at that. Her reliance on UDRP cases mainly administered by WIPO is understandable given that, of the five dispute resolution providers approved by ICANN, WIPO offers the most data given its position as the longest serving approved provider with the highest case load volume.¹⁷ While reference to domestic Australian court decisions involving .au domain names may in some instances have complemented her analysis of dispute resolution procedure decisions, these decisions have, as is duly noted at the start of the book, been covered elsewhere in intellectual property texts and related works.

Researching issues relating to the DNS demands a willingness to assume a higher level of anxiety and insecurity than is inherent in researching other areas of the law: because policy can be developed and implemented and applied and modified so much more swiftly than legislation, the sands are constantly shifting underfoot at an alarming pace. The researcher rarely feels in control, and the outcome of his or her work is but a mere snapshot of the state of affairs to a particular point. Roy ably rises to this challenge, joining the ranks of the few who have explored and documented the shifting sands, but have not as yet been willing to do so in the context of Australia’s .au ccTLD and its dispute resolution policy and procedural rules.

¹⁶ IAMA Case No 3712 (22 March 2013).

¹⁷ See Catherine Saez, ‘Internet Domain Name Expansion Pushes Dispute Resolution Cases up at WIPO’ on *Intellectual Property Watch* (18 March 2016) <<http://www.ip-watch.org/2016/03/18/internet-domain-name-expansion-pushes-dispute-resolution-cases-up-at-wipo/>>; Doug Isenberg, ‘Comparing and Contrasting Domain Name Statistics at the Forum and WIPO’ on *GigaLaw* (21 October 2015) <<http://www.gigalaw.com/2015/10/21/comparing-and-contrasting-domain-name-statistics-at-the-forum-and-wipo/>>.