

Ms Jo Lim  
Chief Policy Office  
AuDA  
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**RE: COMMENTS REGARDING PROPOSED RECOMMENDATION E MADE BY THE NEW NAMES ADVISORY PANEL**

Dear Ms Lim,

The Committee for Geographical Names in Australasia (CGNA) has major concerns regarding the proposed recommendation "e" made by the New Names Advisory Panel in October 2002.

CGNA would like to address the statements put forward in the New Names Advisory Panel Report to the auDA Board, October 2002 and other issues which highlight the problems in abolishing the current reserve listing on geographical names.

**New Names Advisory Panel Report to the auDA Board, October 2002**

Listed below is an excerpt of the recommendations published in the report relating to the restriction on geographic names in com.au and net.au

*"A majority of the Panel believes that the current policy is not effective in its stated aim of protecting geographic communities from commercial exploitation, because:*

- (a) there are a significant number of geographic names that were registered before the restriction was introduced in 1998, or have been mistakenly registered since 1998;*
- (b) new geographic names are being created all the time, and it is not possible to retrospectively apply the policy to existing domain names; and*
- (c) geographic domain names are widely used in other 2LDs, and in gTLDs and other ccTLDs.*

*There is evidence to suggest that most of those seeking to use geographic names in com.au and net.au do so because:*

- (a) they have a company or business name that happens to be a geographic name, but they are not located in the geographic area or associated with the local community in any way; or*
- (b) they represent the local community (eg. local council, chamber of commerce, tourist board, etc)."*

CGNA responses to these points are documented as follows:

***there are a significant number of geographic names that were registered before the restriction was introduced in 1998, or have been mistakenly registered since 1998;***

CGNA believes that the reserve name policy is not ineffective as reported in the Interim Report<sup>1</sup> but that the policy is not being policed by the responsible authority.<sup>2</sup>

***new geographic names are being created all the time, and it is not possible to retrospectively apply the policy to existing domain names; and***

CGNA has produced guidelines on issues of this nature. A similar model exists for trademarks where if the trademark has been in place prior to a proposed geographical name the geographical name proposal will not be adopted by the naming authority. It is proposed that CGNA could consider a similar guideline for geographical domain names.

***geographic domain names are widely used in other 2LDs, and in gTLDs and other ccTLDs.***

CGNA is of the opinion that auDA should base its policy on best practice rather than examples used in other Countries which are themselves flawed.

The protection of Geographical Names in other domains will become more prominent. After reviewing the OCOS proposal, CGNA believed the system outlined addressed many of the issues that related to geographical names in the domain environment. The proposal was subsequently endorsed by CGNA who then presented their own paper based on the OCOS submission at the Eighth United Nations Conference on the Standardization of Geographical Names, Berlin, 27 August - 5 September 2002.<sup>3</sup>

From feed back received at this forum it is suggested that many other Naming Authorities across the world are interested in the outcome of this proposal.

It is acknowledged that the OCOS National Portal system is centred on a simplified yet similar principle to that outlined in RFC1480<sup>4</sup>. The major difference between the two systems is that the proposed OCOS approach has an administration process for the allocation and ownership of the domain names. This process allows for the system to be more workable than that outlined in RFC 1480 as some guarantees can be given on the authenticity of

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<sup>1</sup> *New Names Advisory Panel Interim Report to the auDA Board, October 2002, Restrictions on geographic names in com.au and net.au, part (a).*

<sup>2</sup> *CGNA is happy to provide further information and evidence of this on request*

<sup>3</sup> *(Paper - E/CONF.94/CRP.100 The One City One Site (OCOS) Proposal - A Report by Australia on a Proposal to Secure Geographical Names for Community Use as Internet Domain Names)*

<sup>4</sup> *(Cooper A & Postel J, RFC 1480, The US Domain, (online), June 1993. <http://www.faqs.org/rfcs/rfc1480.html> [Accessed 19 September 2002])*

the site's content and structure. Other benefits include "guessability" of site names and a hierarchy to aid in easy navigation.

The simple but logical nature of the naming standard along with processes to guarantee community ownership of domain names will ensure the success of this project unlike similar schemes such as that outlined in RFC1480. It is obvious that the lifting of the reserve listing, however, may cause extra confusion in the community on what is seen as the official site. CGNA believes that this type of confusion may ultimately lead to the non-take up of the world class system presented by OCOS (and recognised by the New Names Panel as a necessary system) as was seen to be the case in RFC 1480.

CGNA believes that auDA should ensure the OCOS systems success by retaining the reserve listing thus making the rest of the world follow us not us follow the rest of the world.

***they have a company or business name that happens to be a geographic name, but they are not located in the geographic area or associated with the local community in any way; or***

In almost all cases a prefix or suffix exists in relation to a commercial name that is impart a geographical name.

For example, Bega Cheese, Bendigo Pottery, Orange Telecommunications

CGNA recommends the use of these suffixes and prefixes in domain names as shown in its policy

*" Place Names are public names and should be used in a way that will not preclude the use of a Place Name by the public. In the case of Internet Domain Names it is recommended that geographical names (including Place Names) be allowed only if they are used with either a suffix or prefix. ICSM encourages regulators to adopt this guideline to ensure that Australian Place Names remain in the Public Domain. "<sup>5</sup>*

The inclusion of this suffix or prefix provides a more comprehensive description of the company and its product, service or purpose ensuring proof in labeling.

***they represent the local community (eg. local council, chamber of commerce, tourist board, etc***

CGNA also believes that the OCOS model will provide an appropriate naming structure for registrants in this category.

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<sup>5</sup> (Committee for Geographical Names in Australasia: Internet Domain Names (online), <http://www.anzlic.org.au/icsm/cgna/internet.htm/> [Accessed 19 September 2002]).

## Other Issues in relation to the Report

The Panel has failed to recognise what must be seen as the major issue surrounding the unlimited use of geographical names in the .au namespace. The issue is that an individual or company should not obtain unfair competitive advantage over others through the use of geographical domain names.

The issues surrounding the incorrect use of geographical names are not new. The commercial use of these names has been around for many years. As this is the case, the rights of the individual to use a name seemingly belonging to the community to promote a commercial product have already been addressed by legislation in nearly every developed country in the World.

The USA has implemented legislation relating to the incorrect use of geographical names in respect to trade marks. The (Intellectual Property Update, July 2001)<sup>6</sup> states that the "Lanham Act prohibits registration of marks which are "primarily geographically descriptive or deceptively misdescriptive" of the goods or services."

This report goes on to state;

*"The prohibition derives from the common law concept<sup>7</sup> that no one person can obtain an exclusive right to the use of a geographic name so as to preclude others from truthfully representing to the public that their goods or services originate from the same place."*

Australia also has legislation and guidelines that protect geographical names from being misused in respect to trademarking. Section 61 of the Trademarks Act 1995<sup>8</sup> also stipulates similar prohibitions as does Chapter 15, part 22 of IP Australia's Trade Marks Manual of Practice and Procedure.

Although not substantiated, the similarities between the Lanham Act and the Trademarks Act 1995 would suggest that the common law principle outlined in the Dorsey & Whitney report would also be applicable in Australia. If this is the case, the question needs to be asked does this common law principle apply to domain naming in the .au namespace?

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<sup>6</sup> (Intellectual Property Update: What's In A Name, or, When Can Geographic Terms Be Appropriated As Trademarks? (online). July 2001), <http://www.dorseylaw.com/updates/IP/IPJul2001.asp> [Accessed 19 September 2002]

<sup>7</sup> (In Re Charles S. Loeb Pipes, Inc., 190 U.S.P.Q. 238 (TTAB 1976).  
Quoted in Intellectual Property Update: What's In A Name, or, When Can Geographic Terms Be Appropriated As Trademarks? (online). July 2001), <http://www.dorseylaw.com/updates/IP/IPJul2001.asp> [Accessed 19 September 2002].

<sup>8</sup> (Commonwealth Consolidated Acts: TRADE MARKS ACT 1995 SECT 61 (online), 1995.  
[http://www.austlii.edu.au/au/legis/cth/consol\\_act/tma1995121/s61.html](http://www.austlii.edu.au/au/legis/cth/consol_act/tma1995121/s61.html) [Accessed 19 September 2002])

To answer this question, trademarks have to be further investigated. In this instance, however, the issue will be how trademarks are considered in relation to domain names. A report by Gunning<sup>9</sup> states;

*“Domain names were created to serve the technical function of providing addresses for computers that were easier to remember than underlying IP addresses. However, with the dramatic increase in commercial activity on the Internet, domain names have become a standard part of the way in which many businesses communicate with their customers - they are used to identify the business and its goods and services. In this way a domain name, like a trademark, may also serve as a badge of origin. Indeed, many second level domain names are identical to registered trademarks”.*

From this statement it can be derived that domain names are in fact used for more than just the identification of an IP address and are a means by which businesses market goods to their customers. As this is the case it is suggested that the common law concept outlined in the Dorsey & Whitney report would apply to domain naming. As such, it is believed that the allocation of a geographical name as a domain name is in contravention of this common law principle.

Many cases of this nature have already been considered by the World Intellectual Property Organisation (WIPO). Thankfully, due to the reserved list initiated by CGNA, cases relating to Australian geographical names are few and far between. This is not to say they have not occurred. Geographical domain names registered in the .au namespace before the reserved listing was put in place and Australian geographical domain names registered outside the .au name space have already been contested.

The Sun Herald reported on 07 October 2001<sup>10</sup>, that Balmain’s local football team, the Balmain Rovers, had been contacted by lawyers for the famous French fashion house Couturier Pierre Balmain regarding the unlawful use of the name Balmain in the clubs domain name. The article suggests that the geographical name was in use 150 years prior to the commencement of the Company. The team manager was quoted as saying; *“while the club would be financially pressed to fight the matter through WIPO’s arbitration processes, its supporters felt strongly about the issue.”*

Brisbane City Council also referred a case to WIPO to seek arbitration on the use of the name “Brisbane” in a commercial web site owned by the Adelaide Company, Joyce Russ Advertising. A report published by ZDNet<sup>11</sup> stated that *“Brisbane City Council said that even though Brisbane.com was not a registered trademark of the Council, it believed it had more rights to the*

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<sup>9</sup> (Patrick Gunning, TRADE MARKS AND DOMAIN NAMES (online), Paper presented to College of Law, 16 March 2000, <http://www.austlii.edu.au/cgi-bin/disp.pl/au/other/CyberLRes/2000/1/z.html?query=%7e+cybersquatting> [Accessed 19 September 2002])

<sup>10</sup> (Daniel Dasey, 07 October 2001, The Sun Herald, Balmain Rovers hopping mad as couturier puts boot in, p 26)

<sup>11</sup> (Megan McAuliffe, ZDNet Australia, Gov “cybersquatting” claim taken to town (online), 10 July 2001. <http://www.zdnet.com.au/newstech/news/story/0,2000025345,20237690-1,00.htm> [Accessed 19 September 2002])

*name than the South Australian advertising agency”.....”A WIPO arbitration decision was made in May this year, dismissing the claim that the company didn’t have a legitimate interest in the Web site, finding Joyce Russ Advertising not guilty of cybersquatting”.*

This is not to say that WIPO’s decisions favour the freeing up of geographical names for the use of domain names. A report from the Industry Standard<sup>12</sup> stated;

*“In a landmark decision, the World Intellectual Property Organization says Barcelona can reclaim its domain name. The owners of Barcelona.com face a legal battle after losing their domain name in a decision issued this week. The company’s tourism Web site will be handed over to the Barcelona City Council in Spain.”*

As no generic advice has been issued by WIPO on whether geographical names should or should not be used as second and third level domain names a policy needs to be developed that limits litigation and respects the common law concept that no one person can obtain an exclusive right to the use of a geographic name so as to preclude others from truthfully representing to the public that their goods or services originate from the same place. As this is the case, CGNA firmly believes that the current reserved listing put in place to restrict the use of geographical names in the .com.au and the .net.au namespace should be retained. CGNA believes that the reserve name policy is not ineffective as reported in the Interim Report<sup>13</sup> but that the policy is not being policed by the responsible authority.<sup>14</sup> Further to this CGNA supports the model proposed by OCOS which sets out a fair and equitable system for communities to use their name.

Brian Goodchild  
Chairman of the Committee for Geographical Names in Australasia

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<sup>12</sup> (Louise Ferguson, *The Industry Standard, Geographic Domains on Shaky Ground* (online), 11 Aug 2000. <http://www.thestandard.com/article/display/0,1151,17627,00.html> [Accessed 19 September 2002])

<sup>13</sup> *New Names Advisory Panel Interim Report to the auDA Board, October 2002, Restrictions on geographic names in com.au and net.au, part (a).*

<sup>14</sup> CGNA is happy to provide further information and evidence of this on request

## Bibliography

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*(Daniel Dasey, 07 October 2001, The Sun Herald, Balmain Rovers hopping mad as couturier puts boot in, p 26)*

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*(Louise Ferguson, The Industry Standard, Geographic Domains on Shaky Ground (online), 11 Aug 2000.  
<http://www.thestandard.com/article/display/0,1151,17627,00.html> [Accessed 19 September 2002])*