

Commercial Insights

Does your domain name meet the new trade mark eligibility rules?

From 12 April 2021, there will be new rules for ownership of .com.au and .net.au domain names. The new rules are designed to (among other things) enhance trust in the .au namespaces.

The changes being implemented from 12 April 2021 include changes to:

- eligibility and allocation rules for .com.au, .net.au, .org.au and .asn.au domains
- the terms and conditions for .au domain names
- the complaints process, and
- how the .au Domain Administrator (auDA) manages compliance with the rules.

As the auDR ownership rules currently apply, a .com.au or .net.au domain licence which is based on an owner having a relevant Australian trade mark, will be successful if the domain name is an exact match, abbreviation or acronym of the trade mark.

Notably under the new rules, the domain name must be an *'exact match'* of the words which are the subject of an Australian Trade Mark application or registration. *'Exact Match'* is defined in the new rules to mean:

'...that the domain name being applied for is identical to the words which are the subject of an Australian Trade Mark. The domain name must include all the words in the order in which they appear in the Australian Trade Mark, excluding (1) DNS identifiers such as .com.au, (2) punctuation marks such as exclamation points or an apostrophe; (3) articles such as 'a', 'the', 'and', 'or', 'of'; and (4) ampersands'.¹

Applications for domain names which are abbreviations and acronyms of Australian trade mark applications or registrations will no longer be accepted. For existing domain names that are due for renewal after 12 April 2021, the previous rules will apply until the end of the current licence period. Any domain names that have previously been registered on the basis of being an abbreviation or acronym of an Australian trade mark will lapse when the licence period is due for renewal.

We recommend that all owners of .com.au or .net.au domain name licences that have been registered on the basis of being a match with an Australian trade mark, review their domain names to consider whether the domain name meets the new eligibility rules.

¹ .au Domain Administration Rules: Licensing, section 1.4

This article was written by Special Counsel, Hayley Bowman. If you have any questions about the new rules of ownership for domain names, please contact Hayley.



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