



WINTERFELDT IP GROUP

CLIENT ADVISORY – MARCH 18, 2021

Impending Changes to .AU Domain Name Registration Eligibility: Are Your .AU Domains Safe?

On April 12, 2021, several key changes to the registration eligibility criteria for all .AU (the country-code Top-Level Domain for Australia) domain names will go into effect. These changes will apply specifically to all .AU second-level domain (SLD) extensions, including any .COM.AU or .NET.AU domain names, and will go into effect for all .AU domain names directly below the TLD later in the year at a date yet to be determined by the registry operator.

All registrations for .AU domains will continue to have to satisfy “Australian presence” requirements, but some of these have been tightened under the updated registration policy. **In particular, non-Australian entities that have registered .AU domain names on the basis of an Australian trademark registration will no longer be able to maintain registrations for domain names that do not exactly match such trademark (ignoring punctuation marks, articles, and the domain extension itself).** Entities with an Australian business number will not be effected by the updated policy, as this will remain a sufficient basis for demonstrating Australian presence regardless of any Australian trademark registrations.

Example	Domain Name(s)	Registrant	Outcome
Example 1	australianbusiness.com.au	Registrant holding Australian business license	Registration not affected
Example 2	exactautrademark.com.au theexactautrademark.com.au exact-au-trademark.com.au	Registrant does not hold Australian business license, but holds an Australian trademark registration for EXACT AU TRADEMARK	Registrations not affected
Example 3	exactautrademarklogin.net.au exactautrademark-australia.com.au	Registrant does not hold Australian business license, but holds an Australian trademark registration for EXACT AU TRADEMARK	Registrations affected

The updated registration rules will immediately go into effect as of April 12 for all new .AU registrations. The updated rules will go into effect for all .AU registrations in effect prior to April 12 at the time of their next renewal. Owners of .AU domain names who are found to be out of compliance with the updated rules, once in effect for their particular domain name(s), may have their .AU domain name registration(s) suspended or cancelled.

In order to ensure that any .AU domain names you maintain are in compliance with the updated registration requirements, we recommend taking the following steps prior to April 12:

1. Review your domain name portfolio and identify all .AU domain names
2. For all .AU domain names in your portfolio, confirm whether the registrant holds an Australian business license – if so, no further action is needed
3. If the current registrant does not hold an Australian business license, identify which .AU domain names correspond exactly to your Australian registered trademark(s) and which do not
4. For all .AU domain names that exactly match your Australian registered trademark(s) (ignoring punctuation marks, articles, and the domain extension itself), no further action is needed
5. If you maintain any .AU domain names that do not exactly match your Australian registered trademark(s), you have three possible options:

- Secure an Australian business license directly or through an Australian affiliate in order to satisfy the eligibility criteria in this way rather than on the basis of your Australian registered trademarks (if you obtain an Australian business license through an affiliate, you would need to transfer your .AU domain names to this affiliate)
- Apply for trademark registration(s) that exactly matches the domain name(s) (an application is sufficient to maintain the domain name even without fully securing the registration, although the domain may later be subject to suspension/cancellation if the application fails)
- Release the domain name (of course it is generally preferable to maintain domain names containing your trademarks, as they could be put to malicious use in the hands of unauthorized third parties)

If you maintain any .AU domain names that may be impacted by the updated registration rules, you might consider renewing them prior to April 12, even if their renewals will not be due by then, to buy additional time before the updated policy will apply so you can consider your options for long-term maintenance.

If you have any questions regarding this alert or wish to discuss these matters in more detail, please contact any of the following Winterfeldt IP Group team members:

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