

1 Perry R. Clark (197101)
 Jia Jia Gu (244863)
 2 perry.clark@kirkland.com
 zhuanjia.gu@kirkland.com
 3 KIRKLAND & ELLIS LLP
 950 Page Mill Road
 4 Palo Alto, California 94304
 Telephone: (650) 859-7000
 5 Facsimile: (650) 859-7500

6 Sarah L Forney (254769)
 sarah.forney@kirkland.com
 7 KIRKLAND & ELLIS LLP
 555 California Street, Suite 2700
 8 San Francisco, California 94104
 Telephone: (415) 439-1400
 9 Facsimile: (415) 439-1500

10 Attorneys for Plaintiff

11 **UNITED STATES DISTRICT COURT**
 12 **NORTHERN DISTRICT OF CALIFORNIA**
 13 **SAN FRANCISCO DIVISION**

13 Petroliam Nasional Berhad,
 14 Plaintiff,

15 v.

17 GoDaddy.com, Inc.
 18 Defendant.

) CASE NO. 09-CV-_____
)
) **COMPLAINT FOR TRADEMARK**
) **INFRINGEMENT, UNFAIR**
) **COMPETITION, CYBER-SQUATTING**
) **AND REQUEST FOR INJUNCTIVE**
) **RELIEF**
)
) **JURY TRIAL DEMANDED**
)
) Complaint Filed: 12/18/2009
)
) Hearing Date: 12/18/2009
)

COMPLAINT

1 Plaintiff Petroliam Nasional Berhad (“PETRONAS”) for its Complaint, alleges as follows
2 against Defendant, GoDaddy.com, Inc. (“GoDaddy”):

3 **THE PARTIES**

4 1. Plaintiff Petroliam Nasional Berhad, also known as PETRONAS, is wholly-owned
5 by the Government of Malaysia and is vested with the entire ownership and control of the petroleum
6 resources in Malaysia. PETRONAS is a corporation duly organized under the laws of Malaysia with
7 a principal place of business located at Tower 1, PETRONAS Twin Towers, Kuala Lumpur City
8 Centre, 50088 Kuala Lumpur, Malaysia.

9
10 2. Upon information and belief, Defendant GoDaddy.com, Inc. (“GoDaddy”) is an
11 Arizona Corporation with a principal place of business at 14455 N. Hayden Rd. Suite 219,
12 Scottsdale, AZ 85260.

13
14 **JURISDICTION AND VENUE**

15 3. This case arises under the Lanham Act, 15 U.S.C. §§ 1051, *et seq.* There is also
16 diversity of citizenship between the parties and there is at least \$75,000 in controversy. As such, this
17 Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. § 1331, 1332, and
18 1338(a) and (b) as well as principles of pendant jurisdiction. The Court has supplemental
19 jurisdiction over all other claims under U.S.C. § 1367.

20
21 4. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b) and (c).

22 5. This Court has personal jurisdiction over the Defendant GoDaddy because of
23 GoDaddy’s contacts with this forum, including doing business with residents of the forum.

24
25 **INTRADISTRICT ASSIGNMENT**

26 6. This is an Intellectual Property case and, as a result, there is no basis for assignment
27 to any particular division pursuant to Civil L.R. 3-2(c).

1 **FACTUAL ALLEGATIONS**

2 7. Plaintiff is a fully-integrated oil and gas corporation and is ranked among Fortune
3 Global 500's largest corporations in the world. Plaintiff's business encompasses the full spectrum of
4 oil and gas operations in the areas of upstream oil and gas exploration and production, downstream
5 oil refining, marketing and distribution of petroleum products, trading, gas processing and
6 liquefaction, gas transmission pipeline network operations, marketing of liquefied natural gas,
7 petrochemical manufacturing and marketing, shipping and property investment.
8

9 8. Plaintiff has operations in more than thirty-three (33) countries worldwide and
10 employs approximately 16,000 people.

11 9. The PETRONAS Twin Towers house PETRONAS' headquarters and are one of the
12 most well-known landmarks in Asia. The PETRONAS Twin Towers are extremely closely
13 identified with PETRONAS. The PETRONAS Twin Towers attract visitors from Malaysia and the
14 rest of the world for the commercial, cultural and other offerings housed at the PETRONAS Twin
15 Towers.
16

17 10. Plaintiff's sole and official website is "www.petronas.com.my" ("Official Petronas
18 Website"). PETRONAS also owns "www.petronastwintows.com.my" along with several U.S.-
19 based "mirror" websites including the URLs "www.petronas.com," "www.petronas.org,"
20 "www.petronas.my," and "www.petronastwintowers.com."
21

22 11. The Official Petronas Website is a widely viewed manifestation of the PETRONAS
23 corporate identity. Among other things, PETRONAS uses the Official Petronas Website to project a
24 corporate image that reflects the values of the employees, management, and shareholders of
25 PETRONAS, including the people of Malaysia who, through the Government of Malaysia, own a
26 stake in the company. PETRONAS also uses the Official Petronas Website to provide news and
27 information about its business, communicate with customers, potential customers, and employees,
28

1 recruit and hire employees for its locations around the world, advertise its products, and promote its
2 brand.

3 12. PETRONAS uses the “petronastwintowers.com.my” domain name for the official
4 website of the PETRONAS Twin Towers and uses “petronastwintowers.com” to redirect to
5 “petronastwintowers.com.my.” The “petronastwintowers.com.my” website is intended to provide
6 information to as many people as possible about the PETRONAS Twin Towers.
7

8 13. PETRONAS owns all right, title, and interest in U.S. Trademark No. 2969707 for
9 “PETRONAS.”

10 14. PETRONAS has not authorized the use of the PETRONAS mark in connection with
11 the “petronastower.net” domain name or website.

12 15. On or about November 26, 2009, PETRONAS learned that the domain name
13 “petronastower.net” (“Infringing Domain Name”) had been registered with Defendant, GoDaddy.
14

15 16. The website affiliated with the Infringing Domain Name, (the “Infringing Website”)
16 found at “petronastower.net” contains highly offensive, obscene, and pornographic material.

17 17. Beginning on or about November 26, 2009, PETRONAS contacted GoDaddy
18 repeatedly to inform it of the unauthorized use of the “PETRONAS” mark in connection with the
19 “petronastower.net” in the Infringing Domain Name, that highly offensive, obscene, and
20 pornographic material was being displayed on the Infringing Website associated with the Infringing
21 Domain Name, and requested that GoDaddy cease its direct and contributory infringement of
22 Plaintiff’s mark.
23

24 18. On or about December 1, 2009, GoDaddy’s “Spam and Abuse Department”
25 responded to PETRONAS stating that it is “prohibited from becoming involved in domain name
26 ownership disputes” and refusing to take any action with respect to the Infringing Domain Name and
27 offensive Infringing Website. According to GoDaddy, any dispute over the “ownership or wording
28

1 of the domain name itself will need to be sent to either the registrant, through an arbitration forum
2 such as the World Intellectual Property Organization, or the local court system.”

3 19. On December 14, 2009 PETRONAS contacted GoDaddy via telephone to inform it
4 that the Infringing Domain Name and offensive Infringing Website remained active, and requested
5 that GoDaddy cease its direct and contributory infringement of Plaintiff’s mark.
6

7 20. On December 16, 2009, PETRONAS again contacted GoDaddy to provide a formal
8 Notice of Trademark Infringement and to request that the Infringing Website be disabled.

9 PETRONAS provided GoDaddy with a signed declaration identifying the address of the offensive
10 Infringing Website, the registrant information for the Infringing Website as obtained from the
11 WHOIS database, and information regarding PETRONAS’ trademark rights, including
12 PETRONAS’ registration of U.S. Trademark No. 2969707 for “PETRONAS.”
13

14 21. On December 16, 2009 GoDaddy responded to PETRONAS stating that it would not
15 disable the Infringing Domain Name or Infringing Website and that any disputes over the
16 “ownership or wording of the domain name itself will need to be sent to either the registrant, through
17 an arbitration forum such as the World Intellectual Property Organization, or the local court system.”

18 22. GoDaddy does not occupy the neutral position of a registrar and is not working with
19 trademark owners to prevent cyber-squatting. GoDaddy offers “unlisted” private domain name
20 registration services. On information and belief, GoDaddy’s “unlisted” registration services provide
21 Defendant has refused to cooperate with PETRONAS and has acted in bad faith and with reckless
22 disregard of PETRONAS’ known trademark rights.
23

24 23. As of the filing of this Complaint, GoDaddy has not taken any steps to remove or
25 otherwise disable the offensive Infringing Website.
26
27
28

1 COUNT ONE

2 Cybersquatting and Contributory Cybersquatting Under 15 U.S.C. § 1125(d)

3 24. Plaintiff realleges and incorporates by reference each of the allegations contained in
4 Paragraphs 1 through 23 of this Complaint as though fully set forth herein.

5 25. Plaintiff is the owner of and has full right, title and interest in U.S. Trademark No.
6 2969707 for "PETRONAS."

7 26. Plaintiff has used the "PETRONAS" mark continually since at least 2005.

8 27. The "PETRONAS" mark was distinctive and federally registered at the USPTO at the
9 time the Infringing Website was registered and used.

10 28. On information and belief, Defendant GoDaddy registered, trafficked in, or used the
11 Infringing Website in bad faith and with a bad faith intent to profit from the goodwill Plaintiff has
12 established in its "PETRONAS" mark.

13 29. Defendant GoDaddy does not have any intellectual property rights or any other rights
14 in the "PETRONAS" mark.

15 30. On information and belief, the Infringing Website does not consist of the legal name
16 of the registrant, host, or registrar of the Infringing Domain Name, including GoDaddy, nor a name
17 that is otherwise commonly used to identify any of these individuals or entities.

18 31. On information and belief, the registrant, host, or registrar of the Infringing Domain
19 Name, including GoDaddy, have not made any prior use of any Infringing Domain Name or
20 Infringing Website in connection with any *bona fide* offering of any goods or services.

21 32. On information and belief, the registrant, host, or registrar of the Infringing Domain
22 Name, including GoDaddy, not made any *bona fide* fair use of the "PETRONAS" mark on the
23 Infringing Website.

24 33. On information and belief, the registrant, host, or registrar of the Infringing Domain
25 Name, including GoDaddy, registered and used the Infringing Website to divert consumers from
26
27
28

1 PETRONAS' website to the Infringing Website accessible under the infringing domain name for
2 commercial gain by creating a likelihood of confusion as to the source, sponsorship, affiliation, or
3 endorsement of the website.

4 34. The registration, use, or trafficking in the Infringing Website and infringing domain
5 name constitutes cybersquatting in violation of 15 U.S.C. § 1125(d), entitling Plaintiff to relief.

6 35. By reason of the acts alleged herein, Plaintiff's remedy at law is not adequate to
7 compensate it for its injuries. Accordingly, Plaintiff is entitled to preliminary and permanent
8 injunctive relief pursuant to 15 U.S.C. § 116.

9 36. By reason of the acts alleged herein, Plaintiff is entitled to recover Defendant's
10 profits, actual damages, and the costs of the action, or statutory damages under 15 U.S.C. § 1117, on
11 election by Plaintiff, in an amount of one hundred thousand dollars (\$100,000) for the domain name
12 infringement.

13 37. This is an exceptional case making Plaintiff eligible for an award of attorney's fees
14 under 15 U.S.C. § 1117.

15
16
17
18 **COUNT TWO**
Trademark Infringement and Contributory Infringement Under § 1114(1)

19 38. Plaintiff realleges and incorporates by reference each of the allegations contained in
20 Paragraphs 1 through 37 of this Complaint as though fully set forth herein.

21 39. Plaintiff is the owner of and has full right, title and interest in U.S. Trademark No.
22 2969707 for "PETRONAS".

23 40. Plaintiff has used the "PETRONAS" mark in commerce continually since at least
24 2005.

25 41. The use of Plaintiff's "PETRONAS" mark on the Infringing Website is without
26 permission or consent.
27
28

1 42. The use of Plaintiff's "PETRONAS" mark has caused and is likely to continue to
2 cause confusion, mistake, and deception among the public, including Plaintiff's customers and
3 employees.

4 43. The use of the "PETRONAS" mark is likely to cause initial interest confusion among
5 the general public.
6

7 44. The use of Plaintiff's "PETRONAS" mark in the Infringing Domain Name
8 constitutes trademark infringement in violation of 15 U.S.C. § 1114(1), entitling Plaintiff to relief.

9 45. Defendant GoDaddy has contributed to, intentionally induced, and facilitate the
10 infringement of Plaintiff's "PETRONAS" mark by registering the Infringing Domain Name.

11 46. Defendant GoDaddy continues to permit the Infringing Domain Name and Infringing
12 Website despite repeated requests that it be removed or disabled and with knowledge that the
13 Infringing Domain Name and Infringing Website infringe Plaintiff's "PETRONAS" mark.
14

15 47. GoDaddy has unfairly profited from the infringing actions alleged.

16 48. By reason of the acts alleged herein, Plaintiff has suffered damage to the goodwill
17 associated with the "PETRONAS" mark.

18 49. The acts alleged herein have irreparably harmed and, if not enjoined will continue to
19 irreparably harm Plaintiff and its log-used and federally registered "PETRONAS" mark.
20

21 50. The acts alleged herein have irreparably harmed, and if not enjoined, will continue to
22 irreparably harm the general public, who has an interest in being free from confusion, mistake, and
23 deception.

24 51. By reason of the acts alleged herein, Plaintiff's remedy at law is not adequate to
25 compensate it for its injuries. Accordingly, Plaintiff is entitled to preliminary and permanent
26 injunctive relief pursuant to 15 U.S.C. § 1116.

27 52. By reason of the willful acts alleged herein, Plaintiff is entitled to damages, and that
28

1 those damages be trebled under 15 U.S.C. § 1117.

2 53. This is an exceptional case making Plaintiff eligible for an award of attorney's fees
3 under 15 U.S.C. § 1117.
4

5 **COUNT THREE**
6 **False Designation of Origin of the "PETRONAS" Mark**

7 54. Plaintiff realleges and incorporates by reference each of the allegations contained in
8 Paragraphs 1 through 53 of this Complaint as though fully set forth herein.

9 55. The use in commerce of the "PETRONAS" mark in the Infringing Domain Name and
10 associated with the Infringing Website is likely to cause confusion, or to cause mistake, or to deceive
11 the relevant public that the Infringing Domain Name displayed at the offensive Infringing Website is
12 authorized, sponsored, approved by, or affiliated with Plaintiff.

13 56. The use of the "PETRONAS" mark and the Infringing Domain Name is likely to
14 cause initial interest confusion among the general public.
15

16 57. The above-described acts constitute trademark infringing of the "PETRONAS" mark
17 and false designation of origin in violation of 15 U.S.C. § 1125(a), entitling Plaintiff to relief.

18 58. On information and belief, the registrant, host, or registrar of the Infringing Domain
19 Name, including GoDaddy, have unfairly profited from the acts alleged herein.

20 59. By reason of the acts alleged herein, Plaintiff has suffered damage to the goodwill
21 associated with the "PETRONAS" mark.
22

23 60. The acts alleged herein have irreparably harmed and, if not enjoined will continue to
24 irreparably harm Plaintiff and its log-used and federally registered "PETRONAS" mark.

25 61. The acts alleged herein have irreparably harmed, and if not enjoined, will continue to
26 irreparably harm the general public, who has an interest in being free from confusion, mistake, and
27 deception.
28

1 62. By reason of the acts alleged herein, Plaintiff's remedy at law is not adequate to
2 compensate it for its injuries. Accordingly, Plaintiff is entitled to preliminary and permanent
3 injunctive relief pursuant to 15 U.S.C. § 1116.

4 63. By reason of the willful acts alleged herein, Plaintiff is entitled to damages, and that
5 those damages be trebled under 15 U.S.C. § 1117.

6 64. This is an exceptional case making Plaintiff eligible for an award of attorney's fees
7 under 15 U.S.C. § 1117.
8

9
10 **COUNT FOUR**
11 **Dilution Under 15 U.S.C. §1125(c)**

12 65. Plaintiff realleges and incorporates by reference each of the allegations contained in
13 Paragraphs 1 through 64 of this Complaint as though fully set forth herein.

14 66. Plaintiff's "PETRONAS" mark is famous, as that term is used in 15 U.S.C. § 1125(c),
15 and was famous before the use, registration and trafficking of the "PETRONAS" mark in the
16 Infringing Domain Name. Plaintiff's mark is famous based on, among other things, the inherent
17 distinctiveness and federal registration of the "PETRONAS" mark and the extensive, and exclusive
18 nationwide use, advertising, promotion, and recognition of the "PETRONAS" mark.

19 67. The use of the "PETRONAS" mark and the related Infringing Domain Name and
20 Infringing Website in commerce is likely to cause dilution by blurring or dilution by tarnishment of
21 the "PETRONAS" mark.

22 68. The above-described acts constituted dilution by blurring and dilution by tarnishment
23 in violation of 15 U.S.C. § 1125(c), entitling Plaintiff to relief.

24 69. On information and belief, the registrant, host, or registrar of the Infringing Domain
25 Name, including GoDaddy, have unfairly profited from the acts alleged herein.
26

27 70. By reason of the acts alleged herein, Plaintiff has suffered damage to the goodwill
28

1 associated with the “PETRONAS” mark, and has suffered irreparable harm.

2 71. The acts alleged herein have irreparably harmed and, if not enjoined will continue to
3 irreparably harm Plaintiff and its long-used and federally registered “PETRONAS” mark.

4 72. By reason of the acts alleged herein, Plaintiff’s remedy at law is not adequate to
5 compensate it for its injuries. Accordingly, Plaintiff is entitled to preliminary and permanent
6 injunctive relief pursuant to 15 U.S.C. § 1116.

7 73. By reason of the willful acts alleged herein, Plaintiff is entitled to damages, and that
8 those damages be trebled under 15 U.S.C. § 1117.

9 74. This is an exceptional case making Plaintiff eligible for an award of attorney’s fees
10 under 15 U.S.C. § 1117.

11
12
13 **COUNT FIVE**
14 **Trademark Infringement Under California Business & Professions Code § 14320 and**
15 **California Common Law**

16 75. Plaintiff realleges and incorporates by reference each of the allegations contained in
17 Paragraphs 1 through 78 of this Complaint as though fully set forth herein.

18 76. Defendant GoDaddy has contributed to, intentionally induced, and facilitated the
19 unauthorized used in commerce of the “PETRONAS” mark, the Infringing Domain Name and the
20 Infringing Website in connection with its business.

21 77. The use in commerce of the “PETRONAS” mark, the Infringing Domain Name, and
22 the Infringing Website in connection with GoDaddy’s services is likely to cause confusion or
23 mistake or to deceive as to the source of origin of those services.

24 78. The above-described acts constitute trademark infringement in violation of California
25 Business & Professions Code § 14320 and under the common law of the State of California, entitling
26 Plaintiff to relief.

27 79. On information and belief, the registrant, host, or registrar of the Infringing Domain
28

1 Name, including GoDaddy, have unfairly profited from the acts alleged herein.

2 80. By reason of the acts alleged herein, Plaintiff has suffered damage to the goodwill
3 associated with the "PETRONAS" mark, and has suffered irreparable harm.

4 81. By reason of the acts alleged herein, Plaintiff's remedy at law is not adequate to
5 compensate it for its injuries. Accordingly, Plaintiff is entitled to preliminary and permanent
6 injunctive relief pursuant to California Business & Professions Code § 14335.
7

8
9 **COUNT SIX**
Unfair Competition Under California Business & Professions Code § 17200 and California
Common Law

10 82. Plaintiff realleges and incorporates by reference each of the allegations contained I
11 Paragraphs 1 through 85 of this Complaint as though fully set forth herein.

12 83. Defendant GoDaddy has contributed to, intentionally induced, and facilitated the
13 unauthorized used in commerce of the "PETRONAS" mark, in violation of Plaintiff's proprietary
14 rights. Such acts constitute unfair trade practices and unfair competition under California Business
15 and Professions Code §§ 17200 *et seq.*, and under the common law of the State of California,
16 entitling Plaintiff to relief.
17

18 84. Pursuant to California Business and Professions Code § 17203, Defendant is required
19 to disgorge and restore to Plaintiff all profits and property acquired by means of Defendant's unfair
20 competition.
21

22 85. Due to the Defendant GoDaddy's conduct, Plaintiff has suffered irreparable harm,
23 suffered injury in fact, and has lost money or property as a result of Defendant's acts of unfair
24 business practices alleged herein. It would be difficult to ascertain the amount of money damages
25 that would afford Plaintiff adequate relief at law for Defendant's acts. Plaintiff's remedy at law is
26 not adequate to compensate it for its injuries. Accordingly, Plaintiff is entitled to preliminary and
27 permanent injunctive relief pursuant to California Business and Professions Code § 17203.
28

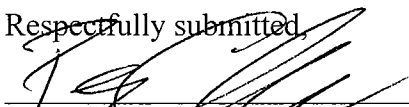
1 (k) Defendant GoDaddy pay Plaintiff's attorney's fees, prejudgment interest, and
2 costs of this action under 15 U.S.C. § 1117 and under California Business and Professions Code
3 § 17200, and under the California common law;

4 (l) Defendant GoDaddy be ordered to account to Plaintiff for, and disgorge, all
5 profits it may have derived by reason of the unlawful acts complained of above;

6 (m) Plaintiff is awarded any other further relief as the Court may deem just and
7 proper.

8
9 DATED: December 18, 2009

Respectfully submitted,


Perry B. Clark (197109)
Jia Jia Gu (244863)
KIRKLAND & ELLIS LLP
950 Page Mill Road
Palo Alto, California 94304
Telephone: (650) 859-7000
Facsimile: (650) 859-7500

Sarah L Forney (254769)
KIRKLAND & ELLIS LLP
555 California Street, Suite 2700
San Francisco, California 94104
Telephone: (415) 439-1400
Facsimile: (415) 439-1500

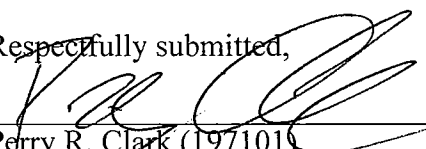
Attorneys for Plaintiff
Petroliam Nasional Berhad

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

DEMAND FOR JURY TRIAL

Plaintiff, Petroliam Nasional Berhad (“PETRONAS”), hereby demands a jury trial to decide all issues so triable in this case pursuant to Rule 38(b) of the Federal Rules of Civil Procedure.

DATED: December 18, 2009

Respectfully submitted,


Perry R. Clark (197101)
Jia Jia Gu (244863)
KIRKLAND & ELLIS LLP
950 Page Mill Road
Palo Alto, California 94304
Telephone: (650) 859-7000
Facsimile: (650) 859-7500

Sarah L Forney (254769)
KIRKLAND & ELLIS LLP
555 California Street, Suite 2700
San Francisco, California 94104
Telephone: (415) 439-1400
Facsimile: (415) 439-1500

Attorneys for Plaintiff
Petroliam Nasional Berhad