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 6 ENOM, INC.

7 **UNITED STATES DISTRICT COURT**  
 8 **NORTHERN DISTRICT OF CALIFORNIA**  
 9  
 10 **OAKLAND DIVISION**

11 PETROLIAM NASIONAL BERHAD  
 ("PETRONAS")

12 Plaintiff,

13 vs.

14 GODADDY.COM, INC.

15 Defendant(s).  
 16

CASE NO. C09-5939 PJH (JCS)

**MOTION FOR LEAVE TO FILE BRIEF  
 OF AMICUS CURIAE ENOM, INC. IN  
 SUPPORT OF DEFENDANT  
 GODADDY.COM, INC.'S MOTION FOR  
 SUMMARY JUDGMENT**

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 MOTION FOR LEAVE TO FILE BRIEF OF AMICUS CURIAE ENOM, INC.

1 **TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:**

2 PLEASE TAKE NOTICE THAT eNom, Inc. (“eNom”) hereby moves the Court for permission  
3 to appear and file the amicus curiae brief tendered with this motion and attached hereto as Addendum A.

4 Courts have liberally exercised their broad discretion to permit a non-party to participate in an  
5 action as *amicus curiae*. See *Woodfin Suite Hotels, LLC v. City of Emeryville*, No. C 06-1254 SBA,  
6 2007 WL 81911, at \*3 (N.D. Cal. Jan. 9, 2007) (granting motion for leave to file brief by amici curiae;  
7 stating “[w]hether to allow Amici to file a brief is solely within the Court’s discretion, and generally  
8 courts have ‘exercised great liberality . . . [t]here are no strict prerequisites that must be established prior  
9 to qualifying for amicus status; an individual seeking to appear as amicus must merely make a showing  
10 that his participation is useful or otherwise desirable to the court.’”) (quoting *In re Roxford Foods Litig.*,  
11 790 F. Supp. 987, 997 (E.D. Cal. 1991)); *Sonoma Falls Developers, LLC v. Nevada Gold & Casinos,*  
12 *Inc.*, 272 F. Supp. 2d 919, 925 (N.D. Cal. 2003) (“District courts frequently welcome amicus briefs from  
13 non-parties concerning legal issues that have potential ramifications beyond the parties directly involved  
14 or if the amicus has ‘unique information or perspective that can help the court beyond the help that the  
15 lawyers for the parties are able to provide.’”) (quoting *Cobell v. Norton*, 246 F Supp 2d 59, 62 (D. D.C.  
16 2003); *Natural Resources Defense Council v. Evans*, 243 F. Supp. 2d 1046, 1047 (N.D. Cal. 2003)  
17 (“*Amici* . . . may file briefs and may possibly participate in oral argument”).

18 eNom is one of the world’s leading domain name registrars accredited by ICANN. eNom  
19 provides domain name registration and maintenance services similar to those provided by defendant  
20 GoDaddy.com, Inc. (“GoDaddy”), and therefore is interested in the outcome of this case. Accordingly,  
21 the Court should permit eNom to appear as *amicus curiae* and file its proposed brief in support of  
22 GoDaddy’s motion for summary judgment. See *Sonoma Falls Developers*, 272 F. Supp. 2d at 925  
23 (granting amicus curiae leave to file a brief where the court found that it had was involved in the events  
24 leading to the case and had interests in the contracts at issue).

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DATED: November 2, 2011

Respectfully submitted,  
GREENBERG TRAURIG, LLP

By s/IanCBallon/  
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# **Addendum A**

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CASE NO. C09-5939 PJH (JCS)

**BRIEF FOR AMICUS CURIAE ENOM,  
INC.**

1 **I. INTRODUCTION AND STATEMENT OF AMICUS CURIAE**

2 eNom, Inc. (“eNom”) seeks leave to file an *amicus* brief in this case to address an issue of great  
3 importance to all domain name registrars and registries—and ultimately to brand owners as well. eNom  
4 is the second largest ICANN accredited domain name registrar that provides domain name registration  
5 and related services. The process is fast, simple and relatively inexpensive. A central part of registering  
6 a domain name is logically associating the domain name with a location on the Internet so that the  
7 domain name resolves to a website, rather than generating an error message. Brand owners commonly  
8 register multiple domain names that, through the use of a domain name forwarding service, may resolve  
9 to separate locations or to a single location. Domain name forwarding allows brand owners to deter  
10 cybersquatting by registering different variations of their marks without having to set up different  
11 websites for each name or generating error messages that may discourage users who are trying to locate  
12 a website by guessing its address based on the site owner’s marks. Domain name forwarding is a  
13 standard feature provided by eNom, GoDaddy and most other registrars. Treating domain name  
14 forwarding services as different from other registration services, or requiring advance screening, would  
15 run counter to the policy objectives of the Anti-Cybersquatting Consumer Protection Act (“ACPA”) and  
16 controlling Ninth Circuit precedent, and would impose the type of policing functions on registrars that  
17 both Congress and courts in this Circuit have concluded would be impractical and unreasonable (and  
18 would ultimately slow down and make substantially more expensive the process of registering domain  
19 names).

20 Congress, in enacting the ACPA, sought to compel trademark owners to resolve disputes through  
21 direct litigation against cybersquatters or dispute resolution procedures (such as ICANN’s Uniform  
22 Dispute Resolution Procedure (“UDRP”)), rather than suits against registrars or registries. The plaintiff  
23 in this case in fact successfully obtained the domain name registrations at issue through an *in rem* action  
24 under the ACPA. By contrast, the ACPA provides broad immunity to registrars (and registries) for  
25 refusing to register, remove or disable a domain name in compliance with a court order or in  
26 implementing a reasonable policy prohibiting the registration of infringing marks; and limited liability  
27 to only the narrow circumstances in which “bad faith intent to profit from such registration or  
28 maintenance of the domain name” is proven. 15 U.S.C. § 1114(2)(D)(i) & (iii). The act of registering

1 domain names, including allowing those names to resolve to websites (whether new ones or preexisting  
2 locations to which a domain name is forwarded), does not and cannot in and of itself support a finding  
3 of bad faith under the ACPA or otherwise serve as the basis for finding a domain name registrar liable  
4 for any misconduct by third party users. Indeed, the ACPA makes clear that “[a] person shall be liable  
5 for using a domain name [with the bad faith intent to profit from another’s trademark] . . . only if that  
6 person is the domain name *registrant* or that registrant’s authorized *licensee*.” 15 U.S.C. §§  
7 1125(d)(1)(A) & (D) (italics added). By its terms, the ACPA does not authorize the imposition of  
8 liability on registrars such as GoDaddy and neither does Lanham Act case law.

9 This Court should decline plaintiff’s invitation to expand the scope of liability for cybersquatting  
10 beyond what Congress and the Ninth Circuit intended by parsing through the process employed by  
11 legitimate domain name registrars for registering domain names to determine if any of these neutral  
12 functions should form the basis for liability. To do otherwise would alter the careful balance created by  
13 Congress and the courts and substantially disrupt registration services to the public, likely slowing down  
14 and increasing the cost of registration for trademark owners such as the plaintiff and other Internet users.

## 15 **II. ARGUMENT**

### 16 **A. Domain Name Registrars Are Intermediaries That Perform Neutral Functions On** 17 **Behalf Of Registrants**

18 GoDaddy and eNom are among nearly one thousand domain name registrars accredited by  
19 ICANN.<sup>1</sup> “ICANN is a private not-for-profit corporation that coordinates the Internet domain name  
20 system (‘DNS’) on behalf of the United States Department of Commerce (‘DOC’).” *Coalition for*  
21 *ICANN Transparency Inc. v. Verisign, Inc.*, 464 F. Supp. 2d 948, 951 (N.D. Cal. 2006).<sup>2</sup> The DNS, in  
22 turn, operates through a registration system, and a domain name exists and is created by virtue of its  
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24 <sup>1</sup> A full list of ICANN-accredited registrars is available on its website at  
25 <http://www.icann.org/en/registrar/accredited-list.html>. As shown on ICANN’s website, there are  
26 currently 995 accredited registrars, over half of which are located in the United States.

27 <sup>2</sup> “Every computer connected to the Internet has a unique Internet Protocol (‘IP’) address” which  
28 comprises a “long string[] of numbers, such as 64.233.161.147.” *Id.* at 951-2. A domain name is an  
“alphanumeric shorthand for [an] IP address.” *Id.* at 952. A domain name contains at least two parts, a  
top-level domain (“TLD”) (i.e., the domain to the right of the first period, e.g., “.com”) and a second-  
level domain (i.e., the domain to the left of the first period, e.g., “enom” in “enom.com”). *See id.* “Each  
domain name is unique and thus can only be registered to one entity.” *Id.*

1 registration “with the appropriate registry operator.” *See id.* at 952. “A registry operator maintains the  
2 definitive database, or registry, that associates the registered domain names with the proper IP numbers  
3 for the respective domain name servers,” which “direct Internet queries to the related web resources.”  
4 *Id.* “A registrant can register a domain name only through companies that serve as registrars for second  
5 level domain names.” *Id.* “Registrars accept registrations for new or expiring domain names, connect  
6 to the appropriate registry operator’s TLD servers to determine whether the name is available, and  
7 register available domain names on behalf of registrants.” *Id.* In this regard, registrars are  
8 intermediaries of the DNS that process registrations and maintain domain names on behalf of  
9 registrants.

10 ICANN accredited registrars require registrants to consent to online arbitration through the  
11 UDRP, which has been very successful in helping trademark owners quickly and easily resolve domain  
12 name disputes. *See Ian C. Ballon, E-Commerce and Internet Law: Treatise with Forms 2d Edition* §  
13 7.05 (West 2d ed. 2011). Registration services are neutral and were never intended by Congress to be  
14 actionable. For example, in describing the services of Network Solutions (“NSI”), one of the largest  
15 domain name registrars, the Ninth Circuit explained that the “applicant submits NSI’s ‘template’  
16 electronically over the Internet,” and when the domain name application is approved (after NSI  
17 performs a “conflicts check” by comparing the requested domain name to all registered names), “NSI  
18 puts the domain-name combination in its database in conjunction with the correct IP Address,” and  
19 “then routes Internet users who enter a certain domain-name combination to the registrant’s computer.”  
20 *Lockheed Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 982 (9th Cir. 1999). All of this is  
21 performed with little (if any) human intervention by NSI. *See id.* As analogized by the Ninth Circuit in  
22 *Lockheed*, a registrar functions much in the same as the U.S. Postal Service:

23 NSI’s role differs little from that of the United States Postal Service:  
24 when an Internet user enters a domain-name combination, NSI translates  
25 the domain-name combination to the registrant’s IP Address and routes the  
26 information or command to the corresponding computer. Although NSI’s  
27 routing service is only available to a registrant who has paid NSI’s fee,  
28 NSI does not supply the domain-name combination any more than the  
Postal Service supplies a street address by performing the routine service  
of routing mail.



1 *Id.* at 984-85. Much in the same way that the U.S. Postal Service offers mail forwarding services on its  
2 website for a fee of \$1.00 (*see* Postal Service website at [https://moversguide.usps.com/icoa/icoa-main-](https://moversguide.usps.com/icoa/icoa-main-flow.do?execution=e1s4)  
3 [flow.do?execution=e1s4](https://moversguide.usps.com/icoa/icoa-main-flow.do?execution=e1s4)), registrars such as eNom typically provide domain name forwarding as a free  
4 service to registrants who choose to point domain name registrations to existing websites, rather than  
5 create new ones.<sup>3</sup> However, it is irrelevant whether domain name forwarding is offered free of charge  
6 or for an additional fee because it is a neutral tool intended for lawful purposes. Domain name  
7 forwarding does not promote infringement any more so than any other aspect of domain name  
8 registration service which, by definition, allows users to logically associate domain name registrations  
9 with Internet websites, whether new or preexisting.

10 eNom, GoDaddy and many other registrars operate in the same manner. They provide tools to  
11 trademark owners and other users to quickly, automatically and inexpensively register domain names,  
12 facilitating the development of e-commerce.<sup>4</sup> Significantly, registrars do not monitor the activities of  
13 registrants or their subsequent use of the domain names, including the use of a domain name forwarding  
14 service, and play no role in maintaining the websites associated with the domain names. *See Lockheed,*  
15 *194 F.3d at 982; Lockheed Martin Corp. v. Network Solutions, Inc., 985 F. Supp. 949, 962 (C.D. Cal.*  
16 *1997), aff'd, 194 F.3d 980 (9th Cir. 1999)* (“NSI neither controls nor monitors the Internet. A domain  
17 name, once registered, can be used in connection with thousands of pages of constantly changing  
18 information. . . . [And] NSI cannot reasonably be expected to monitor the Internet.”). Nor did Congress  
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21 <sup>3</sup> For trademark owners, this utility provides added value to e-commerce and deters cybersquatting by  
22 encouraging owners to register a variety of domain names (and exclude them from registration by  
23 potential squatters) and enabling them to point the domains to a primary website, rather than multiple  
24 websites, or none at all (which could cause users to become discouraged and not search further for a  
25 brand owner’s main site.

26 <sup>4</sup> To set up domain forwarding, the registrant provides information akin to filling out a “Change Of  
27 Address” form with the Postal Service (available online at [https://moversguide.usps.com/icoa/icoa-](https://moversguide.usps.com/icoa/icoa-main-flow.do?execution=e1s4)  
28 [main-flow.do?execution=e1s4](https://moversguide.usps.com/icoa/icoa-main-flow.do?execution=e1s4)) to forward mail from an old address to a new address. In both instances,  
the registrar and Postal Service performs limited “checking” or verification of the request. eNom, for  
instance, only checks that the request is being made by the authorized registrant, and does not  
investigate the circumstances of the new IP address. Similarly, when a “Change of Address” request is  
made online, the U.S. Postal Service verifies the request by matching an address with its database of  
U.S. addresses (to correct for zip code or other errors) and make sure it matches the user’s credit card  
billing address.

1 believe that they could or should be required to do so. *See* S. Rep. No. 106-140, 1999 WL 594571, at \*4  
2 & \*11.

3 **B. The ACPA Provides Broad Exemption To Domain Name Registrars**

4 There is a clear statutory immunity provided to domain name registrars and registries that applies  
5 broadly to claims arising under the Anti-Cybersquatting Consumer Protection Act (“ACPA”), 15 U.S.C.  
6 § 1125(d), as confirmed by congressional intent and Ninth Circuit precedent. When Congress enacted  
7 the ACPA in 1999, it created a cause of action based on the bad faith use of, registration or trafficking in  
8 domain names with intent to profit from the trademarks of another, to combat cybersquatting, but at the  
9 same time made explicit that such a claim could not be brought against registrars or registries by  
10 unequivocally providing that only a “domain name *registrant* or that registrant’s authorized *licensee*”  
11 may be held liable for use of a domain name with the requisite bad faith. 15 U.S.C. §§ 1125(d)(1)(A) &  
12 (D) (*italics added*). The Act further created an exemption for domain name registrars and registries by  
13 providing that:

14 A domain name registrar, a domain registry, or other domain name  
15 registration authority shall not be liable for damages under this section for  
16 the registration or maintenance of a domain name for another absent a  
17 showing of bad faith intent to profit from such registration or maintenance  
18 of the domain name.

19 15 U.S.C. § 1114(2)(D)(iii). In addition, under the Act, registrars and registries may not be held liable  
20 for monetary awards for “refusing to register, remove from registration, transferring, temporarily  
21 disabling, or permanently cancelling a domain name” in compliance with a court order or in  
22 implementing “a reasonable policy . . . prohibiting the registration of a domain name that is identical to,  
23 confusingly similar to, or dilutive of another’s mark.” 15 U.S.C. §1114(2)(D)(i). In short, the ACPA’s  
24 purpose was twofold—to protect trademark owners against cybersquatters and also ***shield domain name***  
25 ***registrars and registries from “overreaching trademark owners”*** seeking to impose liability based on  
26 the bad faith conduct of registrants. *See* S. Rep. No. 106-140, 1999 WL 594571, at \*4 (“The purpose of  
27 the bill is to protect consumers and American businesses, to promote the growth of online commerce,  
28 and to provide clarity in the law for trademark owners by prohibiting the bad-faith and abusive  
registration of distinctive marks as Internet domain names with the intent to profit from the goodwill

1 associated with such marks—a practice commonly referred to as ‘cybersquatting.’”) & \*11 (“The  
2 amended bill goes further, however, in order to protect the rights of domain name registrants against  
3 overreaching trademark owners.”).

4 In creating a statutory immunity under the ACPA for registrars and registries, Congress codified  
5 an exemption to liability existing under case law at that time. See S. Rep. No. 106-140, 1999 WL  
6 594571, at \*11 (“The bill, as amended, also promotes the continued ease and efficiency users of the  
7 current registration system enjoy by codifying current case law limiting the secondary liability of  
8 domain name registrars and registries for the act of registration of a domain name.”) (citing *Lockheed*  
9 *Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980 (9th Cir. 1999), *aff’d* by 194 F.3d 980 (9th Cir.  
10 1999), and *Academy of Motion Picture Arts & Science v. Network Solutions, Inc.*, 989 F. Supp. 1276  
11 (C.D. Cal. 1997), which held that Network Solutions, Inc. (“NSI”), a domain name registrar, could not  
12 be held liable for trademark infringement). As discussed below, the relevant case law concludes that  
13 registrars are not involved in the potentially infringing uses of a domain name, and lack the ability to  
14 monitor and police infringing activities by its users.<sup>5</sup>

15 **C. Courts And Congress Have Made Clear That Registrars Have No Duty To Police**  
16 **The Domain Name System For Infringing Activities**

17 Under *Lockheed* and its progeny, domain name registrars are exempt from liability for trademark  
18 infringement and contributory liability because a registrar is not involved in “the use of domain names  
19 in connection with goods and services on the Internet,” i.e., “uses that are capable of infringement.” See  
20 *Lockheed*, 985 F. Supp. at 959-62.<sup>6</sup> A registrar’s “acceptance of domain name registrations is not a  
21 ‘commercial use’ within the meaning of the Federal Trademark Dilution Act,” and its other “use” is not  
22 “trademark use” but rather “the pure machine-linking function is the only use at issue.” *Id.* at 958-59;  
23 *see also id.* at 956 (“When a domain name is used only to indicate an address on the Internet, the domain

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24 <sup>5</sup> Plaintiff’s reliance on the services defined in the ICANN Registrar Accreditation Agreement is of no  
25 moment as there is nothing in the statute or legislative history to suggest that the ICANN agreement is at  
26 all relevant or that it was even considered by Congress, which largely acted on the statute before the first  
27 version of this agreement was even adopted by ICANN on November 4, 1999 (See  
28 <http://www.icann.org/en/nsi/icann-raa-04nov99.htm>), the same month the ACPA was signed into law by  
President Clinton.

<sup>6</sup> Congress’ codification of a broad statutory immunity for registrars and registries under the ACPA was  
premised on the lower court’s rationale in *Lockheed*. See S. Rep. No. 106-140, 1999 WL 594571, at \*11.

1 name is not functioning as a trademark.”) and 960 (“NSI’s use of domain names is connected to the  
2 names’ technical function on the Internet to designate computer addresses, not to the names’ trademark  
3 function to distinguish goods and services. The fact that NSI makes a profit from the technical function  
4 of domain names does not convert NSI’s activity to trademark use.”).

5 *Lockheed* further held that a domain name registrar “has no affirmative duty to police the  
6 Internet in search of potentially infringing uses of domain names,” and concluded that registrars were in  
7 no position to evaluate whether a registrant’s use of a domain name is infringing and had no legal duty  
8 to do so. *Id.* at 963 & 966. Not only does a registrar lack sufficient knowledge of a registrant’s use of a  
9 domain name, but the determination of whether a use is infringing is complicated by the “existence of  
10 numerous legitimate, non-infringing uses” of a domain name. *See id.* at 964 & 966 (“NSI is not  
11 involved with uses of domain names in connection with Internet resources such as Web sites and e-mail.  
12 Therefore, the Court cannot impute knowledge of potential infringement merely from the fact that such  
13 uses occurred.”). The same mark legitimately may be used by companies in different industries (such as  
14 Delta Airlines and Delta Faucets) and internationally where the same mark may be owned by different  
15 companies in different countries. Accordingly, “the degree of uncertainty over infringing uses of  
16 domain names makes it inappropriate to impose contributory liability” on registrars. *Id.* at 964.

17 As the court concluded in *Lockheed*, registrars are ill-suited to be the arbiter of domain name  
18 trademark disputes, and courts and Congress have declined to impose those obligations on registrars.<sup>7</sup>  
19 *Id.* at 966; S. Rep. No. 106-140, 1999 WL 594571, at \*11; *see also id.* at \*7 (“Abusive conduct, like  
20 cybersquatting, threatens the continued growth and vitality of the Internet as a platform for all these  
21 uses. But in seeking to curb such abuses, Congress must not cast its net too broadly or impede the  
22 growth of technology, and it must be careful to balance the legitimate interests of Internet users with the  
23 other interests sought to be protected.”).<sup>8</sup>

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24 <sup>7</sup> For this reason, eNom expresses no view on whether the registrant in this case intended to infringe on  
25 plaintiff’s rights in registering and using the “peteronastower.net” and “petronastowers.net” domain  
26 names and directing them to pornographic sites. eNom merely points out that the neutral act of allowing  
a domain forwarding service could not form the basis for imposing liability on a registrar.

27 <sup>8</sup> Other jurisdictions have since relied on *Lockheed* and the immunity under the ACPA to deny similar  
28 claims asserted against registrars. *See, e.g., Bird v. Parsons*, 289 F.3d 865, 878-79 (6th Cir. 2002)  
(holding that a domain name auction site cannot be held liable for infringement because “[t]he  
possibility that its customers might buy or sell infringing domain names does not alter the fact that

1           **D.     Holding GoDaddy Liable In This Case Would Be Contrary To Existing Law And**  
2           **Would Negatively Impact The Court System And DNS Industry**

3           To hold GoDaddy liable for maintaining the third-party registration of “peteronastower.net” and  
4 “petronastowers.net,” and for implementing a domain forwarding function set up by the registrant,  
5 would run contrary to existing case law and create an unsupported narrowing of the blanket exemption  
6 applied to registrars under the ACPA. *See Lockheed*, 985 F. Supp. at 959-62; 15 U.S.C. § 1114(2)(D)(i)  
7 & (iii). Congress and courts have cautioned against “overreaching trademark owners” and “improperly  
8 broadening” their existing rights. *See Lockheed*, 986 F. Supp. at 967 (“Trademark law does not give  
9 Lockheed the right to interfere with all uses of the term ‘skunk works’ by current domain name holders.  
10 . . . “[A]n extension of contributory liability here would improperly broaden Lockheed’s property rights  
11 in its service mark.”); S. Rep. No. 106-140, 1999 WL 594571, at \*11.

12           There are real limitations to what a registrar can do, and those practicalities underlie the  
13 exemption carved out under *Lockheed* and the ACPA. *See Lockheed*, 985 F. Supp. at 962 (“NSI neither  
14 controls nor monitors the Internet. A domain name, once registered, can be used in connection with  
15 thousands of pages of constantly changing information. . . . [And] NSI cannot reasonably be expected  
16 to monitor the Internet.”). These were plainly illustrated in *Lockheed II*:

17                     It is quite understandable that Congress did not cause defendant as a  
18                     domain name registrar, or as keeper of the registry, to be subject to civil  
19                     liability under § 1125(d). Although plaintiff now tries to backtrack  
20                     somewhat from the position that defendant as registrar should perform  
21                     gatekeeper functions for mark owners, even the modified gatekeeper role  
                          it now proposes is untenable. **Sheer volume alone would prohibit  
                          defendant performing the role plaintiff would assign. Defendant**

22 [defendant] does not use those names”; “[m]oreover, even a domain name that could be used to violate a  
23 registered trademark does not necessarily do so”); *Am. Girl, LLC v. Nameview, Inc.*, 381 F. Supp. 2d  
24 876, 881-82 (E.D. Wis. 2005) (“[R]egistrars are not obliged to examine domain names to ensure that the  
25 registrant is not violating the rights of a third-party”); *see also Lockheed Martin Corp. v. Network Solutions,*  
26 *Inc. (Lockheed II)*, 141 F. Supp. 2d 648, 655 (N.D. Tex. 2001) (stating that “that Congress did not cause  
27 defendant as a domain name registrar, or as keeper of the registry, to be subject to civil liability under  
28 [the ACPA]”); *Size, Inc. v. Network Solutions, Inc.*, 255 F. Supp. 2d 568, 573 (E.D. Va. 2003) (“This  
Court agrees with the *Lockheed II* analysis, and finds that NSI’s domain name registration service is just  
that-a service. The registrant selects the domain name and provides any content associated with that  
domain name; all that NSI does is ‘translate’ the domain name into the registrant’s IP address and route  
users to that address. In this regard, NSI’s function is more equivalent to the passive messenger service  
provided by the United States Postal Service . . .”). 8

1 **simply could not function as a registrar, or as keeper of the registry, if**  
2 **it had to become entangled in, and bear the expense of, disputes**  
3 **regarding the right of a registrant to use a particular domain name.**

4 The fact that defendant could theoretically do what plaintiff asks does not  
5 mean that defendant is obligated to do so at the risk of financial ruin. The  
6 reason the UDRP was developed was to provide the mechanism to resolve  
7 these disputes. Not only would imposing plaintiff's scheme render the  
8 UDRP nugatory, it would cause the domain name registration system in its  
9 entirety not to be feasible.

10 *Lockheed II*, 141 F. Supp. 2d at 655 (emphasis added). If registrars were required to pre-screen  
11 registrations for potential infringement and monitor all subsequent activities, business would contract  
12 and be delayed by backlogs caused by the new burdens (registrations would no longer be  
13 straightforward to process), and operational costs would no doubt escalate and flow to users. *See also*  
14 Ian C. Ballon, *E-Commerce and Internet Law: Treatise with Forms 2d Edition* §§ 7.01-7.03 (West 2d  
15 ed. 2011) (providing a history of early domain name disputes, the business problems NSI faced when it  
16 was the sole registrar handling these disputes, and the subsequent expansion of the DNS and reduction  
17 in costs). In enacting the ACPA, Congress provided broad immunities to registrars so that they would  
18 not be required to take extra-judicial actions in resolving domain name disputes. *See* S. Rep. No. 106-  
19 140, 1999 WL 594571, at \*4 & \*7 (stating that the ACPA's purpose was also to "promote the growth of  
20 online commerce," "provide clarity in the law for trademark owners" while "balanc[ing] the legitimate  
21 interests of Internet users with the other interests sought to be protected").

22 Plaintiff here seeks to impose upon GoDaddy and all registrars alike a policing duty that is not  
23 required under law, and impossible to realize. The unfairness of plaintiff's position is also underscored  
24 by its refusal to engage in effective and expedient dispute resolution under the UDRP (as advised by  
25 GoDaddy), choosing instead to file seriatim lawsuits in federal court. *See* FAC ¶¶ 49-55; *see also*  
26 *Nameview, Inc.*, 381 F. Supp. 2d at 883 ("The UDRP is an administrative alternative dispute resolution  
27 policy which creates a procedure specifically designed to provide a fast and cheap means for resolving  
28 domain name disputes. . . . [and] most likely will provide plaintiff with effective relief faster than any  
procedure available to this court."). Should liability be held against GoDaddy, courts can expect their  
dockets will be flooded with domain name disputes. *See E-Commerce and Internet Law 2d Edition* §  
7.01 at 7-18 ("Disputes over Internet domain names account for by far the largest single category of  
Internet-related civil disputes resolved in litigation or arbitration."). Courts and businesses should not

1 be burdened by the excessive obligations plaintiff seeks to impose where the law neither requires nor  
2 supports a narrowing of the broad immunities granted to registrars under the ACPA and *Lockheed*.

3 **III. CONCLUSION**

4 For the foregoing reasons, eNom respectfully asks that the Court reject plaintiff's argument for  
5 new case law imposing impractical (and ineffective) monitoring obligations on the part of domain name  
6 registrars that would be inconsistent with Congressional intent, Ninth Circuit precedent and sound  
7 policy.

8  
9 DATED: November 2, 2011

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