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 PETROLIAM NASIONAL BERHAD (PETRONAS)

8 UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 9 OAKLAND DIVISION

10	PETROLIAM NASIONAL BERHAD)	CASE NO: 09-CV-5939 PJH
11	(PETRONAS),)	
	Plaintiff,)	Noticed Hearing Date: December 7, 2011
12)	Noticed Hearing Time: 9:00 a.m.
13	vs.)	
14	GODADDY.COM, INC.,)	
15	Defendant.)	

17 **NOTICE OF MOTION AND MOTION FOR**
 18 **PARTIAL SUMMARY JUDGMENT ON GODADDY'S LIABILITY FOR**
 19 **CONTRIBUTORY CYBERSQUATTING**
 20 **(COUNT II OF FIRST AMENDED COMPLAINT)**
AND
MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT

21 DOCUMENT SUBMITTED UNDER SEAL AND CHAMBERS COPY

28 NTC. OF MTN. AND MTN. FOR
 PARTIAL SUMMARY JUDGMENT
 Case No: 09-CV-5939 PJH

1 **NOTICE OF MOTION**

2 TO DEFENDANT GODADDY.COM, INC. AND TO ITS ATTORNEYS OF RECORD:

3 PLEASE TAKE NOTICE that on Wednesday, December 7, 2011, at 9:00 a.m., or as
4 soon thereafter as the matter may be heard by the Hon. Phyllis J. Hamilton in Courtroom 3, Third
5 Floor, United States Courthouse, 1301 Clay Street, Oakland, California, Plaintiff Petroliam
6 Nasional Berhad (Petronas) will and hereby does move this Court to grant summary judgment
7 that Defendant GoDaddy.com, Inc. is liable for Plaintiff’s claim for contributory cybersquatting
8 (Count II of Plaintiff’s First Amended Complaint (Doc. No. 69)). Plaintiff makes this motion
9 pursuant to Fed. R. Civ. P. 56.

10 The movant, Plaintiff Petroliam Nasional Berhad (Petronas), seeks the following relief:

11 1. An order granting partial summary judgment that Defendant GoDaddy.com, Inc.
12 is liable for Plaintiff’s claim for contributory cybersquatting (Count II of Plaintiff’s First
13 Amended Complaint (Doc. No. 69));

14 2. Alternatively, if the Court does not grant all of the relief requested in the
15 preceding paragraph 1, an order stating that all or some of the material facts established herein
16 are not genuinely in dispute and shall be treated as established in this case pursuant to Fed. R.
17 Civ. P. 56(g).

18 A proposed order is filed concurrently herewith.
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9 OAKLAND DIVISION

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(PETRONAS),)
11 Plaintiff,) Noticed Hearing Date: December 7, 2011
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13 vs.)
14 GODADDY.COM, INC.,)
15 Defendant.)

16
17 **MEMORANDUM OF POINTS AND AUTHORITIES**
18 **IN SUPPORT OF**
19 **PLAINTIFF'S MOTION FOR**
20 **PARTIAL SUMMARY JUDGMENT ON GODADDY'S LIABILITY FOR**
21 **CONTRIBUTORY CYBERSQUATTING**
22 **(COUNT II OF FIRST AMENDED COMPLAINT)**
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STATEMENT OF ISSUES TO BE DECIDED

Issue One:

Is GoDaddy shielded from liability for contributory cybersquatting as to PETRONASTOWERS.NET by any “safe harbor for registrars” in the ACPA or the *Lockheed* line of cases? No. GoDaddy’s liability for contributory cybersquatting as to PETRONASTOWERS.NET arises from its domain name forwarding service, which the undisputed evidence establishes is unrelated to its conduct as a registrar performing the registration or maintenance of a domain name. To the extent the ACPA or *Lockheed* afford registrars immunity for contributory cybersquatting, such immunity is strictly limited to the registrar’s conduct in registering or maintaining a domain name.

Issue Two:

Is there a genuine dispute as to any material fact establishing GoDaddy’s liability for contributory cybersquatting? No. The material facts establishing that GoDaddy continued to provide its domain name forwarding service for PETRONASTOWERS.NET with knowledge of Registrant’s cybersquatting are supported GoDaddy’s own documents, discovery responses, and the testimony of GoDaddy’s Fed. R. Civ. P. 30(b)(6) deponents. And the material facts establishing that GoDaddy had “direct control and monitoring” over the Registrant’s use of its domain name forwarding service to engage in cybersquatting are also supported by the same type of GoDaddy materials. As a result, there is no genuine dispute as to any material fact establishing GoDaddy’s liability for contributory cybersquatting with respect to the domain name PETRONASTOWERS.NET.

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SUCCINCT STATEMENT OF RELEVANT FACTS

The relevant facts are set forth in the following sections in connection with the arguments to which they relate.

ARGUMENT

I. GODADDY IS NOT SHIELDED BY ANY “SAFE HARBOR FOR REGISTRARS”

There is no “safe harbor” in the ACPA or the case law related to *Lockheed Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 984 (9th Cir.1999), that would shield GoDaddy from liability for contributory cybersquatting as to PETRONASTOWERS.NET. To the extent the ACPA and the *Lockheed* line of cases afford “immunity” to registrars, such “immunity” is strictly limited to liability arising from a registrar’s conduct *as a registrar* performing the registration and maintenance of a domain name and does not extend to other conduct or services by registrars, such as GoDaddy’s domain name forwarding service.

The “safe-harbor” provision of the ACPA states that “[a] domain name registrar . . . shall not be liable for damages under this section for the registration or maintenance of a domain name for another.” 15 U.S.C. § 114(2)(D)(iii). The *Lockheed* “safe harbor” is based on the Ninth Circuit’s holding that the defendant in that case, the domain name registrar NSI, was not liable for contributory trademark infringement because “[w]here domain names are used to infringe, the infringement does not result from NSI’s [the registrar’s] publication of the domain name list, but from the registrant’s use of the name on a website or other Internet form of communication” and “NSI’s involvement with the use of domain names does not extend beyond registration.” *Lockheed*, 194 F.3d at 984-985.

Courts interpreting the “safe harbor” for registrars in the ACPA and *Lockheed* have held repeatedly that a domain name registrar is only “immune when it acts as a registrar, *i.e.* when it accepts registrations for domain names from customers.” *Solid Host, NL v. Namecheap, Inc.*, 652 F. Supp.2d 1092, 1104 (C.D. Cal. 2009) (rejecting contention that *Lockheed* or the ACPA “affords registrars blanket immunity from liability”) *citing Lockheed Martin Corp. v. Network Solutions*,

1 *Inc.*, 141 F. Supp.2d 648, 655 (N.D. Tex. 2001) (finding that the ACPA does not extent “to a
2 person functioning solely as a registrar or registry of domain names.”)). At least one District
3 Court has held that a registrar is not immune from liability for contributory cybersquatting based
4 on “wrongful actions that occurred long after the registration of [the] domain name” or actions
5 associated with the maintenance of a customer’s registration account rather than maintenance of a
6 domain name itself. *Baidu, Inc. v. Register.com, Inc.*, 760 F. Supp. 2d 312 (S.D.N.Y. 2010)
7 (registrar not “immune” under ACPA for contributory cybersquatting where it allowed a third
8 party to take control of plaintiff’s domain name registration account and use the domain name to
9 engage in trademark infringement).

10 Here, GoDaddy was not acting as a domain name registrar performing the registration or
11 maintenance of the domain name PETRONASTOWERS.NET when it refused to stop providing
12 its domain name forwarding service linking that domain name to a pornographic website. To the
13 contrary, the undisputed evidence supports the deposition testimony of GoDaddy’s Vice President
14 and Corporate Controller, Ron Hertz, that “I don’t believe the forwarding service relates at all to
15 the registration of the domain name.” APP009¹ (Hertz at 13:7-12).

16 It is undisputed that GoDaddy did not begin to offer its domain name forwarding service to
17 customers until April 3, 2001, even though it began providing the registration and maintenance of
18 domain names for customers as an ICANN accredited registrar at least six months earlier, in
19 November 2000. APP016 (GoDaddy’s Response to Interrogatory No. 25 at 7:22); APP023
20 (Anderson Depo. (10/13/2011)) at 6:22-7:10, 8:12-16). Laurie Anderson, GoDaddy’s Fed. R. Civ.
21 P. 30(b)(6) deponent on GoDaddy’s domain name forwarding service, testified that “GoDaddy
22 could have performed the registration and maintenance of the domain names
23 PETRONASTOWER[.NET] and PETRONASTOWERS.NET without providing its domain name

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25 ¹ References to “APPXXX” are to pages in the Appendix of Fed. R. Civ. P. 56(c)(1)(A)
26 Materials In Support Of Motion For Partial Summary Judgment filed concurrently herewith.
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1 forwarding service.” APP028-29 (Anderson (10/13/2011) at 22:9-19, 27:13-23). Indeed,
2 GoDaddy was the registrar for PETRONASTOWERS.NET from April 1, 2007 to May 2, 2009
3 and did not provide its domain name forwarding service for PETRONASTOWERS.NET at all
4 during that two year period. APP013-14 (GoDaddy’s Response to Interrogatory No. 21 at 4:27-
5 28); APP035 (Decl. of Kelly Lewis, Esq. at 2:23-27). And GoDaddy has been the registrar of
6 PETRONASTOWERS.NET and performed all of the functions required for the registration and
7 maintenance of that domain name since it stopped providing its domain name forwarding service
8 on August 30, 2010. APP021 (GoDaddy’s Response to Interrogatory No. 21 at 5:7-8) APP038
9 (GD-000293); APP040-41 (GD-00560-561).

10 Moreover, the undisputed evidence shows that GoDaddy provides its domain name
11 forwarding service for the domain names of its hosting customers even though GoDaddy is not the
12 registrar of those domain names. APP006 (GoDaddy’s Response to Interrogatory No. 24 at 7:7-
13 11); APP043 (PET GD 002469); APP046 (Munson Depo. Ex. 32). Specifically, GoDaddy
14 admitted in an interrogatory response that the “External Domains” feature of its hosting accounts
15 is the same “routing/forward” service it provided for the PETRONASTOWES.NET domain name
16 and that GoDaddy provides this service for “domains registered elsewhere (not with GoDaddy).”
17 APP016 (GoDaddy’s Response to Interrogatory No. 24 at 7:7-11); APP043 (PET GD 002469).
18 On its website, GoDaddy describes its domain name forwarding service for its hosting customers
19 as allowing those hosting customers to “automatically send your website’s visitors to a chosen
20 destination, either a different location within the same site or a new site entirely,” which is
21 precisely what its domain name forwarding service did for PETRONASTOWERS.NET. APP046
22 (Munson Depo. Ex. 32). It is undisputed that GoDaddy provides hosting services to customers for
23 use with domain names that have registrars other than GoDaddy. APP047 (Anderson Depo.
24 (10/13/2011) at 15:5-19); APP051 (GD-002453).

25 Because the undisputed evidence establishes that GoDaddy’s domain name forwarding
26 service is not related and not necessary for the registration or maintenance of domain names, and
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1 is provided for domain names of GoDaddy’s customers for which GoDaddy is not the registrar,
2 the so-called “safe harbor” of the ACPA and the *Lockheed* line of cases does not apply.

3 **II. GODADDY COMMITTED CONTRIBUTORY CYBERSQUATTING AS TO**
4 **PETRONASTOWERS.NET**

5 The elements of proof needed to establish a cause of action for contributory cybersquatting
6 are well settled. The plaintiff must establish that the defendant continued to supply its products or
7 services to one who the defendant knew or had reason to know was using its services to engage in
8 trademark infringement. *Louis Vuitton Malletier, S.A. v. Akanoc Solutions, Inc.*, --F.3d-- (9th Cir.
9 2011), 2011 WL 4014320, *3 (9th Cir. Sept. 9, 2011) (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*,
10 456 U.S. 844, 854, 102 S.Ct. 2182, 72 L.Ed.2d 606 (1982). With respect to contributory
11 cybersquatting in particular, the knowledge prong includes both the specific identity of the third
12 party and sufficient evidence that the third party was engaged in cybersquatting. *Solid Host, NL v.*
13 *Namecheap, Inc.*, 652 F. Supp.2d 1092, 1104 (C.D. Cal. 2009) (“Where the demand [from a
14 trademark owner] is accompanied by sufficient evidence of a violation, the defendant may have a
15 duty to investigate.”). In addition, the plaintiff must establish that the defendant had “[d]irect
16 control and monitoring of the instrumentality used by a third party to infringe” the plaintiff’s
17 trademark. *Lockheed*, 194 F.3d at 984 (9th Cir.1999) (holding that the court must consider “the
18 extent of control exercised by the defendant over the third party’s means of infringement”).

19 **A. The Registrant of PETRONASTOWERS.NET Engaged in Direct**
20 **Cybersquatting**

21 The Registrant committed direct cybersquatting from May 2, 2009 to August 30, 2010 by
22 using GoDaddy’s domain name forwarding service to direct internet traffic from the domain name
23 PETRONASTOWERS.NET to a pornographic website. The Registrant’s direct cybersquatting is
24 established by the undisputed facts proving each element of a violation of 15 U.S.C. §
25 1125(d)(1)(A): (1) the Petronas mark was “distinctive at the time of registration of the domain
26 name” PETRONASTOWERS.NET; (2) the domain name PETRONASTOWERS.NET “is
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1 identical or confusingly similar to [Petronas’s] mark”; and (3) the Registrant “had a bad faith
2 intent to profit from [the Petronas] mark.”

3 First, the Petronas mark is inherently distinctive because it is a fanciful mark using the
4 “coined word” PETRONAS. *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1390-91 (9th Cir.
5 1993) (“A fanciful mark is a coined word or phrase, such as Kodak, invented solely to function as
6 a trademark.”). The Petronas mark has been owned by Petronas since at least December 28, 2001,
7 and was distinctive at the time the domain name PETRONASTOWERS.NET was registered on
8 May 8, 2003. APP053 (Gaik Depo. Ex. 13 (U.S. Trademark Reg. No. 2,969,707 filed December
9 28, 2001); APP058 (Slafsky Decl. Ex. A at GD-001596).

10 Second, the domain name PETRONASTOWERS.NET “is identical or confusingly similar
11 to” the Petronas mark. The Court’s August 27, 2010 Order in Case No. 10-03052 PJH (Doc. No.
12 11) transferring the domain name PETRONASTOWERS.NET (which was based on the reasons
13 set forth in Petronas’s unopposed motion (Doc. No. 9)) established that the Registrant’s use of the
14 domain name PETRONASTOWERS.NET was likely to cause confusion with the Petronas mark.
15 APP067 (Order at 1:2-3); APP071 (Mtn. at 2:20-3:1). The Court thus held that
16 PETRONASTOWERS.NET violated Petronas’s rights as “the owner of a mark registered in the
17 Patent and Trademark Office or protected under subsection (a) [false designation of origin] or (c)
18 [dilution] [of 15 U.S.C. § 1125].” APP067 (Order at 1:2-3); APP071 (Mtn. at 2:20-3:1).

19 Third, the undisputed evidence establishes that six of the nine factors identified in the
20 ACPA as indicative of a registrant’s bad faith intent are met with respect to the Registrant of
21 PETRONASTOWERS.NET:

- 22 • The Registrant had an “intent to divert customers from the mark owner’s
23 [Petronas’s] online line location to a site accessible under the domain name
24 [PETRONASTOWERS.NET] that could harm the goodwill represented by the mark,
25 either for commercial gain or with the intent to tarnish or disparage the mark, by creating a
26 likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the
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1 mark.” 15 U.S.C. § 1125(d)(1)(B)(i)(V). Specifically, the Registrant diverted customers
2 from Petronas’s online locations (PETRONASTWINTOWERS.COM.MY,
3 PETRONASTWINTOWERS.COM, WWW.PETRONAS.COM.MY,
4 WWW.PETRONAS.COM, WWW.PETRONAS.ORG, WWW.PETRONAS.MY) to
5 PETRONASTOWERS.NET. APP088 (Manokaran Decl. at ¶¶ 4 and 5 (GD-000699)).
6 The site to which the Registrant used GoDaddy’s domain name forwarding service to
7 divert internet traffic from PETRONASTOWERS.NET was located at
8 CAMFUNCHAT.COM, a domain name for which the Registrant was also the registrant.
9 APP091-92 (GD-0001326); APP104 (GD-000622). In addition, the Registrant used the
10 “masking” option within GoDaddy’s domain name forwarding service to cause internet
11 users clicking on “PETRONASTOWERS.NET” not to see the domain name
12 “CAMFUNCHAT.COM” in their web browser’s address bar and instead to see
13 “PETRONASTOWERS.NET,” thus intentionally amplifying the likelihood of confusion.
14 APP040 (GD-000560).

15 • The Registrant engaged in the “registration or acquisition of multiple domain
16 names which the person [Registrant] knew are identical or confusingly similar to marks of
17 others that are distinctive at the time of registration.” 15 U.S.C. § 1125(d)(1)(B)(i)(VIII).
18 In particular, the Registrant registered or acquired at least two domain names,
19 PETRONASTOWERS.NET and PETRONASTOWER.NET, which are identical or
20 confusingly similar to Petronas’s marks. APP014-15 (GoDaddy’s Response to
21 Interrogatory No. 22).

22 • The Registrant does not—and did not—have any “trademark or other intellectual
23 property rights . . . in the domain name” PETRONASTOWERS. 15 U.S.C. §
24 1125(d)(1)(B)(i)(I). Despite multiple emails, Federal Express letters, and attempts at
25 telephonic notification of Petronas’s trademark claims regarding the domain names at
26 issue, the Registrant never responded, much less provided any suggestion that he or she
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1 had any intellectual property rights in the domain names. APP072-73 (Motion at 3:22-4:9
2 (Doc. No. 9)). It also appears that GoDaddy sent a notification to the Registrant of
3 Petronas’s trademark claims and that the domain names were “locked” (and that GoDaddy
4 charged the Registrant a \$10 fee related to the claims), but that GoDaddy is not aware of
5 any response from the Registrant of any kind, much less a response asserting intellectual
6 property rights in PETRONASTOWERS.NET. APP039 (GD-000302); APP030-33
7 (Anderson Depo. at 44:23-45:2, 65:23-66:2).

8 • The domain name PETRONASTOWERS.NET does not “consist of the legal name
9 of the person [Registrant] or a name that is commonly used to identify that person
10 [Registrant].” 15 U.S.C. § 1125(d)(1)(B)(i)(II). The name of the Registrant in the official
11 “Whois” database for PETRONASTOWERS.NET was “Heiko Schoenekess.” APP092-93
12 (GD-001327-28). There is no connection of any kind between the name of the Registrant
13 and the domain name PETRONATOWERS.NET.

14 • The Registrant did not make any “bona fide noncommercial or fair use of the mark
15 in a site accessible under the domain name” PETRONASTOWERS.NET. 15 U.S.C. §
16 1125(d)(1)(B)(i)(IV). The website the Registrant linked to PETRONASTOWERS.NET
17 was pornographic and was neither noncommercial nor any kind of fair use. APP056
18 (Slafsky Decl. at ¶ 5 (GD-001594)); APP112 (GD-002870); APP113 (GD-002978);
19 APP114 (GD-001804).

20 • As set forth above, Petronas’s “mark incorporated into the person’s [Registrant’s]
21 domain name registration is . . . distinctive.” 15 U.S.C. § 1125(d)(1)(B)(i)(IX).

22 In summary, the foregoing undisputed evidence shows that six of the nine factors in 15
23 U.S.C. § 1125(d)(1)(B)(i) support a finding that the Registrant had a bad faith intent in using the
24 domain name PETRONASTOWERS.NET.

1 **B. GoDaddy’s Domain Name Forwarding Service Was the Instrumentality Used**
2 **By The Registrant To Engage In Direct Cybersquatting**

3 On May 2, 2009, the Registrant of the domain name PETRONASTOWERS.NET “logged
4 into his account on the GoDaddy website and directed the automated system to forward the
5 domain name to a pre-existing website [and] GoDaddy’s system the automatically forwarded
6 traffic to the existing website.” APP147 (GoDaddy’s Response Interrogatory No. 16 at 16:19-22).
7 The “existing website” was CAMFUNCHAT.COM and contained pornographic material (and was
8 the same website to which PETRONASTOWER.NET was forwarded). APP040-41 (GD-000560-
9 561); APP091-92 (GD-0001326-27); APP152 (GD-001899); APP035 (Lewis Decl at ¶7(b));
10 APP112 (GD-002870); APP113 (GD-002978). In response to an interrogatory asking GoDaddy
11 to “identify and describe in detail . . . the services provided by GoDaddy related to the disputed
12 domain names,” the only service GoDaddy identified was “‘forwarding’ the domain name.”
13 APP015 (GoDaddy’s Response to Interrogatory No. 16 at 16:3-25)). All of the evidence in the
14 record thus supports the inference that the domain name PETRONASTOWERS.NET only became
15 linked to the pornographic website when GoDaddy began providing its domain name forwarding
16 service on May 2, 2009.

16 **C. Godaddy Should Have Known The Registrant Was Using Its Domain Name**
17 **Forwarding Service To Engage In Cybersquatting Or Was Willfully Blind To**
18 **It**

19 In order to establish that a defendant “should have known” that its services were being
20 used to engage in trademark infringement, a plaintiff must show that the defendant knew or should
21 have known (1) the identity of the direct infringer and (2) that there were specific instances of
22 actual infringement. *Tiffany (NJ), Inc. v. eBay, Inc.*, 600 F.3d 93, 109 (2nd Cir. 2010) (“For
23 contributory trademark infringement to lie, a service provider must have more than a general
24 knowledge or reason to know that its service is being used to sell counterfeit goods. Some
25 contemporary knowledge of which particular listings are infringing or will infringe in the future is
26 necessary.”). In the context of contributory cybersquatting, the scope of a defendant’s knowledge
27 must “include sufficient evidence of a violation,” including that there was use of “a domain name
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1 **2. Godaddy Was In Possession Of Facts Proving That The Registrant**
2 **Was Engaged In Cybersquatting**

3 GoDaddy had information in its possession showing that the Registrant was committing
4 cybersquatting, including facts proving (1) that the Registrant’s use of the domain name
5 PETRONASTOWERS.NET was confusingly similar to Petronas’s mark and (2) that the
6 Registrant had a bad faith intent to profit from the Petronas mark.

7 GoDaddy had ample information demonstrating that Registrant’s use of
8 PETRONASTOWERS.NET was confusingly similar to Petronas’s mark, including this Court’s
9 Order requiring GoDaddy to transfer PETRONASTOWER.NET to Petronas because, among other
10 things, that domain name was “likely to cause confusion” with Petronas’s mark. APP157 (Order
11 5/13/2010 at 2:2-3 (GD-001923)); APP161 (Motion at 4:17-20)). The Court ordered GoDaddy to
12 transfer PETRONASTOWER.NET on May 13, 2010, more than one month before GoDaddy
13 received Petronas’s formal notice regarding PETRONASTOWERS.NET. *Id.*; APP092 (GD-
14 001327-28).

15 GoDaddy also was in possession a substantially body of facts establishing that the
16 Registrant had a bad faith intent to profit from Petronas’s mark with the domain name
17 PETRONASTOWERS.NET, including all of the facts set forth in Section II(A), above,
18 establishing six of the nine ACPA factors supporting the conclusion that the Registrant had a bad
19 faith intent.

20 Despite GoDaddy’s awareness of this information, GoDaddy deliberately refused to
21 investigate whether the Registrant was committing cybersquatting. According to GoDaddy’s Fed.
22 R. Civ. P. 30(b)(6) witness regarding its trademark policy and handling of Petronas’s claim
23 regarding PETRONASTOWERS.NET, GoDaddy maintained a policy against investigating any
24 claim of trademark of infringement that GoDaddy decided was related to “content not hosted on
25 GoDaddy’s servers.” APP177-79 (Hanyen 10/12/2011 Depo. at 17:24-19:19); APP168 (Hanyen
26 Depo. Ex. 15 at GD-000573). Although Petronas provided all of the information GoDaddy would
27 have needed under its policy to investigate a claim regarding “content hosted on GoDaddy’s
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1 servers,” GoDaddy refused to do so for PETRONASTOWERS.NET. APP091-92 (GD-001326).
2 As such, GoDaddy simply ignored all of the information cited above that put it on notice of
3 Registrant’s cybersquatting (the Court’s order transferring PETRONASTOWER.NET, that the
4 registrant was the same for both disputed domain names, that both domain names were forwarding
5 to the same website, Petronas’s formal notice of trademark infringement, etc.). APP180 (Hanyen
6 Depo. (10/13/2011) at 28:2-25).

7 Moreover, GoDaddy’s prior experience handling trademark claims should have led it to
8 suspect that the Registrant was engaged in trademark infringement because, for the trademark
9 claims that GoDaddy had actually chosen to investigate, the “vast majority” of them resulted in
10 GoDaddy deciding to stop providing its services to the customers in question. APP181-82
11 (Hanyen Depo. (10/13/2011) at 51:11-52:11). And only an “extremely low” percentage of such
12 customers submitted a “counter-notification” to GoDaddy disputing that they had committed
13 infringement. *Id.*

14 In light of the foregoing, GoDaddy at least had reason to suspect that the Registrant
15 identified by Petronas was committing cybersquatting as to PETRONASTOWERS.NET and, by
16 deliberately failing to investigate Petronas’s allegation, was willfully blind.

17 **D. Godaddy Exercised Direct Control And Monitoring Of Its Domain Name**
18 **Forwarding Service, Which Was The Instrumentality Used To Engage In**
19 **Cybersquatting**

20 Where, as here, the alleged contributory trademark infringement is based on the provision
21 of a service, the plaintiff must prove that the defendant “had direct control and monitoring of the
22 instrumentality used by a third party to infringe” the plaintiff’s mark. *Louis Vuitton*, --F.3d-- (9th
23 Cir. 2011), 2011 WL 4014320, *3 (9th Cir. Sept. 9, 2011) (affirming judgment of contributory
24 infringement against defendants that “had control over the services and servers provided to the
25 websites. Stated another way [defendants] had direct control over the ‘masterswitch’ that kept the
26 websites online and available.”). With respect to infringement by domain names, the focus of the
27 “direct control and monitoring” inquiry is on “the registrant’s use of [the domain] name on a web
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1 site or other Internet form of communication in connection with goods or services.” *Lockheed*
2 *Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 984-985 (9th Cir. 1999) (holding that a
3 registrar who simply registered a domain name did not have “direct control and monitoring” of the
4 registrant’s means of infringement because a registrar’s “involvement with the domain names does
5 not extend beyond registration.”).

6 Here, the instrumentality used by the Registrant to commit cybersquatting as to
7 PETRONASTOWERS.NET was GoDaddy’s domain name forwarding service. It is undisputed
8 that on May 2, 2009 GoDaddy began providing its domain name forwarding service for the
9 domain name PETRONASTOWERS.NET. APP040-41 (GD-00560). It is also undisputed that
10 GoDaddy’s domain name forwarding service caused internet traffic to be routed to the
11 pornographic website at CAMFUNCHAT.COM and “masked” the CAMFUNCHAT.COM
12 domain name with the PERTONASTOWERS.NET domain name. APP40-41 (GD-00560).

13 There also can be no dispute that GoDaddy had direct control over its domain name
14 forwarding service. GoDaddy employees wrote the code and created the software application that
15 implemented GoDaddy’s domain name forwarding service. APP187-88 (Munson Depo. at 12:-
16 16:10). And GoDaddy’s domain name forwarding service was implemented with servers owned
17 and exclusively controlled by GoDaddy. APP186 (Munson Depo. at 9:3-12:12).

18 In addition, GoDaddy was able to monitor the operation of its domain name forwarding
19 service as to PETRONASTOWERS.NET. When Petronas filed its formal trademark complaint on
20 July 7, 2010, GoDaddy was able to immediately determine that it was using its domain name
21 forwarding service to link PETRONASTOWERS.NET to the website at CAMFUNCHAT.COM
22 and to provide detailed information technical information about that website. APP091-92
23 (Hanyen Depo. Ex. 22 at GD-001342-1346). GoDaddy also knew as of at least December 21,
24 2009, that CAMFUNCHAT.COM was owned by and had the same registrant as
25 PETRONASTOWER.NET. APP104 (GD-000622). And GoDaddy knew that Petronas had
26 submitted a trademark infringement complaint regarding PETRONASTOWER.NET, which had
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1 the same Registrant and forwarded to the same website at CAMFUNCHAT.COM, and that the
2 Court had ordered that domain name transferred to Petronas. APP202 (Hanyen Depo. Ex. 24 at
3 GD-001312-1314); APP104 (GD-000622); APP157 (5/13/2010 Order); APP158 (3/25/2010
4 Motion (Doc. No. 7)).

5 In light of the foregoing, there should be no genuine dispute that GoDaddy exercised
6 “direct control and monitoring” over the instrumentality—its domain name forwarding service—
7 used by the Registrant to engage in cybersquatting as to PETRONASTOWERS.NET.

8 **CONCLUSION**

9 For the reasons set forth above, Petronas respectfully requests that the Court grant partial
10 summary judgment of GoDaddy’s liability for contributory cybersquatting or, in the alternative,
11 enter an order finding all or some of the material facts established herein are undisputed.

12 Dated: November 2, 2011

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