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PETROLIAM NASIONAL BERHAD (PETRONAS)

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
OAKLAND DIVISION

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

**PLAINTIFF PETRONAS'S  
REPLY IN SUPPORT OF ITS MOTION FOR  
PARTIAL SUMMARY JUDGMENT ON GODADDY'S LIABILITY FOR  
CONTRIBUTORY CYBERSQUATTING**

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## INTRODUCTION

Even if the Court were to disregard all of the facts that GoDaddy disputes, Petronas’s motion for partial summary judgment should be granted in light of the remaining, undisputed facts.

With respect to “registrar immunity,” GoDaddy does not contend that its domain name forwarding service constitutes the “maintenance” of a domain name. And GoDaddy does not dispute the facts establishing that an ICANN-accredited registrar can perform “the registration or maintenance of a domain name” without providing domain name forwarding. Instead, GoDaddy concedes that “the act of initially registering, or obtaining, a domain *is* different from forwarding (or otherwise resolving) a domain.” Opp. at 11:25-27 (emphasis original). Nonetheless, GoDaddy argues that “registrar immunity” applies to its domain name forwarding service because it is “routing” or a “basic registrar service.” But the “registrar immunity” of the ACPA and the case law is limited to, as Congress stated in the ACPA’s legislative history, “the act of registration of a domain name” and there is no legal authority to support GoDaddy’s expansive interpretation to the contrary.

GoDaddy also does not dispute the facts establishing its liability for contributory cybersquatting and contends instead that Petronas is not entitled to judgment as a matter of law. But in so doing, GoDaddy simply ignores undisputed facts establishing its liability. Thus, with respect to the Registrant’s “bad faith intent,” GoDaddy fails to address the undisputed facts establishing three of the six ACPA “bad faith” factors. Likewise, for both the “direct monitoring and control” and “knowledge” elements, GoDaddy opts to “cherry pick” facts and ignore others to argue that the evidence is legally insufficient to support liability. And on the issue of “willful blindness,” GoDaddy fails to address the facts cited in Petronas’s motion establishing the grounds for GoDaddy to at least *suspect* the Registrant’s cybersquatting.

As a result, Petronas’s motion for partial summary judgment as to GoDaddy’s liability for contributory cybersquatting should be granted.

1 **I. THE UNDISPUTED FACTS ESTABLISH THAT GODADDY IS NOT IMMUNE**  
2 **FROM LIABILITY FOR CONTRIBUTORY CYBERSQUATTING AS A**  
3 **MATTER OF LAW**

4 GoDaddy now concedes—as it must—that “the act of initially registering, or obtaining, a  
5 domain *is* different from forwarding (or otherwise resolving) a domain.” Opp. at 11:25-27  
6 (emphasis original). Indeed, all of the undisputed facts are consistent with the Fed. R. Civ. P.  
7 30(b)(6) testimony of GoDaddy’s vice-president and Corporate Controller, Ron Hertz, that “I  
8 don’t believe the domain name forwarding service relates at all to the registration of the domain  
9 name.”

10 GoDaddy’s new argument—that “the ACPA immunity applies to *all conduct* engaged in  
11 by a registrar functioning as a registrar”—contradicts the plain language of the ACPA and the  
12 case law. Opp. at 11:4-5 (emphasis added). And it cannot be reconciled with Congress’s intent  
13 that the ACPA “encourage domain name registrars and registries to work with trademark owners  
14 to prevent cybersquatting.” 1999WL59471 \*11.

15 **A. The Undisputed Facts Establish That GoDaddy Was Not Acting As A**  
16 **Registrar Providing The Registration And Maintenance Of A Domain Name**

17 GoDaddy fails to address the evidence cited in Petronas’s Opening Brief establishing that  
18 an ICANN-accredited registrar can perform all of the functions required for the “registration and  
19 maintenance” of a domain without providing domain name forwarding and, pursuant to Fed. R.  
20 Civ. P. 56(e), they should be considered undisputed. Opening Brief at 3:16-4:1 and 4:5-9.

21 In addition, GoDaddy fails to show that there is a genuine dispute as to the fact that it  
22 provides its hosting customers with domain name forwarding for domains not registered by  
23 GoDaddy. Opening Br. at 4:10-24. First, GoDaddy fails to address Petronas’s assertion of fact  
24 that GoDaddy provides its hosting service to customers for use with domain names for which  
25 GoDaddy is not the registrar. Opening Br. at 4:22-24. As such, that fact should be considered  
26 undisputed pursuant to Fed. R. Civ. P. 56(e).  
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1 Second, GoDaddy fails to show that there is a genuine dispute as to the fact that it  
2 provides domain name forwarding to its hosting customers for domain names not registered by  
3 GoDaddy in light of the following evidence:

4 • On its website, GoDaddy describes its domain name forwarding service for its  
5 hosting customers as allowing them to “automatically send your website’s visitors to your  
6 chosen destination, either a different location within that same site or a new site entirely.”

7 AP046.

8 • “GoDaddy hosting customers can have traffic routed to GoDaddy-hosted websites  
9 from domains registered elsewhere (not with GoDaddy) (‘external domains’) [and s]uch  
10 routing is the same as ‘routing/forwarding’ as referenced in GoDaddy’s supplemental  
11 initial disclosures.” APP016 (GoDaddy’s Response to Interrogatory No. 25). The  
12 “routing/forwarding” to which GoDaddy referred in its supplemental initial disclosures is  
13 the “routing/forwarding of the disputed domain names” “provided by GoDaddy related to  
14 the disputed domain names.”

15 GoDaddy cites to two pieces of “evidence” in support of its contention that “the evidence  
16 establishes unequivocally that GoDaddy’s forwarding service is only available for domains  
17 registered with GoDaddy”—neither of which create a genuine dispute. Opp. at 4:18-20. The  
18 first is “Munson Decl. ¶ 10,” which does not exist—the Munson declaration only has nine  
19 paragraphs. See Munson Decl. The second is deposition testimony from GoDaddy’s employee  
20 John Roling who, when asked “were you aware that GoDaddy offered URL redirecting with  
21 hosting accounts?” responded, “[a]s I said I’m not familiar with the hosting account, so –.”  
22 Lansky Decl. Ex. 1 at 48:4-7. Given Mr. Roling’s lack of knowledge, the deposition testimony  
23 that GoDaddy cites is inadmissible because it lacks foundation and is insufficient to create a  
24 genuine dispute as to the facts established by GoDaddy’s verified interrogatory response, initial  
25 disclosures, and APP046. *Carmen v. S.F. Unified School Dist.*, 237 F.3d 1036, 1028 (9th Cir.  
26 2001) (Federal Rule of Evidence 602 prevents a witness from testifying on a matter “unless  
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1 evidence is introduced sufficient to support a finding that the witness has personal knowledge of  
2 the matter.”).

3 With respect to the description on GoDaddy’s website of its domain name forwarding  
4 service for use by its hosting customers (APP046), GoDaddy points to the declaration of Scott  
5 Brown to argue that there is a genuine dispute of fact. The Brown declaration, however, should  
6 be stricken and should not be considered. Mr. Brown was not identified in GoDaddy’s initial  
7 disclosures or in any other documents served or produced by GoDaddy prior to the filing of its  
8 opposition brief on November 18, 2011, well after the close of fact discovery on October 19,  
9 2011. Clark Decl. Ex. B. GoDaddy knew at least as early as June 30, 2011 that whether  
10 GoDaddy provided its domain name forwarding service for domains not registered with  
11 GoDaddy was an issue in this case because its Amended Answer and Counterclaim contained the  
12 following “Sixth Affirmative Defense”:

13 The Complaint is barred, in whole or in part, by the defense of misrepresentation  
14 of material facts. The Complaint contains numerous factually incorrect  
15 allegations, including *inter alia*, that “GoDaddy provides its ‘domain name  
forwarding’ service to registrants who registered their domain names with  
registrars other than GoDaddy.” Complaint ¶ 30.

16 Amended Answer and Counterclaim ¶ 107.

17 Under Fed. R. Civ. P. 37(c), “[i]f a party fails to provide information or identify a witness  
18 as required by Rule 26(a) or (e), the party is not allowed to use that information or witness to  
19 supply evidence on a motion, at a hearing, or at trial, unless the failure was substantially justified  
20 or harmless.” Fed. R. Civ. P. 26(g)(3); *see also* Shwarzer, *et al.*, Federal Civil Procedure Before  
21 Trial at 11:1330 (“A party’s or attorney’s signature on a disclosure document constitutes  
22 *certification* that it is complete and correct to the best of the signer’s knowledge and belief,  
23 formed after a reasonable inquiry. . . [i]f that certification is violated, the court *must* (on a motion  
24 or sua sponte) impose an appropriate sanction on the signer unless substantial justification for the  
25 failure is shown.” (emphasis original)). Accordingly, the Brown declaration should be stricken  
26 and not considered.

1 As for GoDaddy’s verified response to Interrogatory No. 25 (APP016), GoDaddy’s  
2 attorneys argue that a sentence in that response—“GoDaddy does not provide any services for  
3 the external domains themselves”—means that the “routing/forwarding” it refers to is provided  
4 “by the registrar of such domains, not by GoDaddy.” Opp. 4:28-5:1. But the fact that  
5 “GoDaddy does not provide services for the external domains” establishes only that GoDaddy is  
6 providing the forwarding service to it hosting customers and not to the registrants of the  
7 “external domains.” It does not contradict the meaning of the rest of the interrogatory response  
8 that the “routing” GoDaddy provides for domains not registered with GoDaddy is “the same as”  
9 “the routing/forwarding service GoDaddy provided for the disputed domains.”

10 Even if the language of its response to Interrogatory No. 25 was ambiguous, GoDaddy  
11 should be precluded from arguing for an alternative interpretation because its attorneys  
12 improperly instructed the GoDaddy employee who verified that response not to answer any  
13 deposition questions about GoDaddy’s interrogatory responses, including Go Daddy’s Response  
14 to Plaintiff’s Third Set of Interrogatories which contains GoDaddy’s response to Interrogatory  
15 No. 25:

16 Q. Let me now hand the witness what’s been marked as Exhibit 45. And do you  
17 recognize Exhibit as Go Daddy’s Response to Plaintiff’s Third Set of  
18 Interrogatories?

19 MS. KLAUSNER: And I'm going to make the same objection and instruct the  
20 witness not to answer, and I'm going to do it for all of these documents unless you  
21 can explain how they pertain to the topic for which the witness has been  
22 designated.

23 Q. I’m now handing the witness what’s been marked as Exhibit 46. And do you  
24 recognize Exhibit 46 as the verification of Go Daddy’s Response to Plaintiff’s  
25 Third Set of Interrogatories signed by you and dated October 14, 2011?

26 MS. KLAUSNER: I object again on the same grounds. It’s outside the scope of  
27 the topics for which this witness has been designated. She's not here as a personal  
28 witness. Instructing her not to answer.

Clark Reply Decl. Ex. A at 10:23-12:25.

These instructions not to answer were improper. Fed. R. Civ. P. 30(b)(6) (“A person may  
instruct a deponent not to answer only when necessary to preserve a privilege, to enforce a court

1 order, or to present a motion under Rule 30(d)(3).”). “Except as stated, it is generally improper  
2 to instruct a deponent (counsel’s own client or anyone else) not to answer a question, and doing  
3 so may warrant sanctions.” Shwarzer, *et al.*, Federal Civil Procedure Before Trial at 11:1570  
4 (citing cases). “If irrelevant questions are asked, the proper procedure is to answer the questions,  
5 noting them for resolution at pretrial or trial.” *Id.* citing *In re Stratosphere Corp. Secur. Litig.*,  
6 182 F.R.D. 614, 618-619 (D. Nev. 1998) (party may object to irrelevant line of questions, but  
7 instructing witness not to answer is sanctionable.).

8 If, as GoDaddy now contends, its response to Interrogatory No. 25 should not be  
9 understood to mean that GoDaddy provides its domain name forwarding service to hosting  
10 customers for domains registered elsewhere, Petronas should have been permitted to examine the  
11 GoDaddy employee who verified the interrogatory response. Because GoDaddy improperly  
12 prevented Petronas from doing so, however, it should be precluded from arguing that there is a  
13 genuine dispute as to whether GoDaddy provides its domain name forwarding service for  
14 domain names that are not registered with GoDaddy.

15 **B. GoDaddy Is Not Immune As A Matter Of Law For Its Conduct As**  
16 **Established By The Undisputed Facts**

17 Regardless of whether the Court determines that there is a genuine dispute regarding  
18 whether GoDaddy provides its domain name forwarding service for domains with other  
19 registrars, GoDaddy is not immune from liability for contributory cybersquatting under either  
20 ACPA or the case law in light of the undisputed facts.

21 **1. The ACPA’s Immunity For Registrar’s Is Limited To The**  
22 **Registration And Maintenance Of A Domain Name**

23 The section of the ACPA on which GoDaddy relies, 15 U.S.C. § 1114(2)(D)(iii), states in  
24 relevant part that “[a] domain name registrar . . . shall not be liable for damages under this  
25 section for the registration or maintenance of a domain name for another.” This section says  
26 nothing about “forwarding,” “routing,” or “basic registrar services.” And it does not say, as  
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1 GoDaddy contends, that “the ACPA immunity applies to all conduct engaged in by a registrar  
2 functioning as a registrar.” Opp. at 11:4-5.

3         Such blanket immunity would not only be contrary to the plain language of the ACPA  
4 but also to the intent of Congress. The legislative history of the ACPA establishes that Congress  
5 intended to limit—rather than eliminate—secondary liability for registrars by “codifying current  
6 case law limiting the secondary liability of domain name registrars and registries for the act of  
7 registration of a domain name.” 1999WL594571 \*11. Had Congress intended to create  
8 immunity for “all conduct engaged in by a registrar functioning as registrar” or eliminate liability  
9 for contributory cybersquatting altogether, it would not have limited “secondary liability” to only  
10 “the act of registration of a domain name.”

11         Moreover, if Congress had intended to provide blanket immunity for registrars, it would  
12 not have amended the ACPA to include a second limitation on registrar liability “for domain  
13 name registrars and registries that suspend, cancel, or transfer domain names pursuant to a court  
14 order or in the implementation of a reasonable policy prohibiting the registration of infringing  
15 domain names.” 1999WL594571 \*11. And this second amendment shows that Congress  
16 intended the phrase “registration and maintenance” to be construed literally and narrowly—not  
17 even to include the conduct of a registrar in suspending, cancelling, or transferring of a domain  
18 name.

19         Fundamentally, GoDaddy’s contention that Congress intended to confer immunity on  
20 registrars for conduct like GoDaddy’s in this case cannot be reconciled with Congress’s intent to  
21 “encourage domain name registrars and registries to work with trademark owners to prevent  
22 cybersquatting.” If, as GoDaddy contends, the ACPA provides immunity for its decision to  
23 ignore the evidence of the Registrant’s cybersquatting as to PETRONASTOWERS.NET, then  
24 there is nothing in the ACPA to “encourage domain name registrars to work with trademark  
25 owners to prevent cybersquatting.” Had Congress intended the ACPA to allow a registrar to do  
26 nothing, it would not have included the limitation on a registrar’s liability for the suspension,  
27 cancellation, or transfer of a domain name “pursuant to a reasonable policy prohibiting the  
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1 registration of infringing domain names” or limited a registrar’s secondary liability to only the  
2 “registration and maintenance of a domain name.”

3         GoDaddy’s assertion that “the ACPA immunity applies to all conduct engaged in by a  
4 registrar functioning as a registrar” is also not support by the cases in its brief. Opp. at 11:4-5.  
5 First, GoDaddy cites to *Baidu, Inc. v. Register.com, Inc.*, 760 F. Supp. 2d 312, 320-321  
6 (S.D.N.Y. 2010), which it claims “recognize[d] immunity applies not only to registration but also  
7 to conduct amounting to subsequent maintenance of [a] domain name.” Opp. at 115-7. The  
8 *Baidu* case, however, actually says that “the first prong of the motion fails, as the statutory  
9 immunity for domain registrars is inapplicable.” *Id.* Specifically, the Court in *Baidu* found that  
10 the defendant, Register.com, “was not registering or maintaining a domain name . . . [i]t’s  
11 purportedly wrongful actions occurred long after the registration of Baidu’s domain name.” *Id.*  
12 The Court also addressed “maintenance,” finding “while Register’s actions arguably concerned  
13 the maintenance of Baidu’s account with Register, they did not concern the maintenance of  
14 Baidu’s domain name. . . Register’s challenged actions went well beyond those of a mere  
15 registrar. The immunity defense is rejected.” *Id.*

16         GoDaddy also cites *Solid Host, NL v. Namecheap, Inc.*, 652 F. Supp. 2d 1092, 1105  
17 (C.D. Cal. 2009) and *Lockheed Martin Corp. v. Network Solutions, Inc.*, 141 F. Supp. 2d 648  
18 (N.D. Tex. 2001) (“*Lockheed II*”), in support of its blanket ACPA immunity argument. But the  
19 Court in *Solid Host* not only found that the plaintiff had stated a claim for contributory  
20 cybersquatting but also that “a close examination of *Lockheed II* reveals that it merely stands for  
21 the proposition that a registrar is not liable under § 1125(d) when it acts[as] a registrar, i.e.,  
22 when it accepts registrations from customers.” *Solid Host, NL*, 652 F. Supp. 2d at 1104  
23 (emphasis original).

24         The language of ACPA is plain and unambiguous and is supported by the legislative  
25 history and the cases interpreting it: the “registrar immunity” only applies to the conduct of a  
26 registrar providing the “registration and maintenance” of a domain name. It does not apply to  
27 “routing” or “basic registrar services.” And it does not apply to GoDaddy’s refusal to stop  
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1 providing its domain name forwarding service for PETRONASTOWERS.NET with full  
2 knowledge that the Registrant was using that service to commit cybersquatting.

3  
4 **2. There Is No Case Law That Expands The ACPA Registrar Immunity  
To GoDaddy's Conduct With Respect To Petronastowers.net**

5 GoDaddy is wrong that “[t]he Ninth Circuit, in the *Lockheed* opinion that Congress  
6 intended to codify when it enacted the ACPA, has already concluded that domain name routing  
7 is a basic registrar service for which secondary liability will not lie.” Opp. at 2:20-21. As an  
8 initial matter, the Ninth Circuit issued its *Lockheed* opinion in October 1999, after Congress  
9 considered the ACPA in August 1999 and there is no reference to that decision anywhere in the  
10 ACPA or its legislative history.

11 Moreover, the Ninth Circuit’s and District Court’s *Lockheed* decisions make clear that  
12 GoDaddy’s conduct with respect to PETRONASTOWERS.NET is different from the conduct for  
13 which Network Solutions was found *not* liable. The Ninth Circuit found that “[a]s the district  
14 court correctly observed, [w]here domain names are used to infringe, the infringement does not  
15 result from NSI’s publication of the domain name list, but from the registrant’s use of the  
16 domain name on a web site or other Internet form of communication with goods or services . . .  
17 NSI’s involvement does not extend beyond registration.” *Lockheed*, 194 F.3d at 985.

18 Here, it is undisputed that GoDaddy provided the means that allowed what the Ninth  
19 Circuit referred to as “the registrant’s use of the domain name on a web site or other Internet  
20 form of communication.” Specifically, GoDaddy does not dispute that “the Registrant of the  
21 domain name PETRONASTOWERS.NET ‘logged into his account on the GoDaddy website and  
22 directed the automated system to forward the domain name to a pre-existing website [and]  
23 GoDaddy’s system then automatically forwarded traffic to the existing website.” Opening Br. At  
24 9:2-5 (APP147 (GoDaddy’s Response to Interrogatory No. 16 at 16:19-22)). As such,  
25 GoDaddy’s conduct is not like NSI’s in *Lockheed* because there the Court found that “NSI is not  
26 part of the process of linking domain names with potentially infringing resources such as  
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1 websites” and “NSI is not involved with Internet resources such as Web sites and e-mail.”

2 *Lockheed*, 985 F. Supp. at 961, 965.

3 In addition, GoDaddy does not dispute that its domain name forwarding service was  
4 implemented with servers owned and exclusively controlled by GoDaddy and was implemented  
5 with a software application created by GoDaddy employees, who wrote the code. Opening Br. at  
6 13:16-17 (APP186 (Munson Depo. at 9:3-12:12); APP187-88 (Munson Depo. at 12:16-16:10)).

7 GoDaddy thus did do what the *Lockheed* court found NSI did not do: “[t]he domain name  
8 servers, which are outside of NSI’s control, connect domain names with internet resources such  
9 as websites and email systems.” *Lockheed*, 985 F. Supp. at 953.

10 Despite the finding in *Lockheed* that “NSI is not part of the process of linking domain  
11 names with potentially infringing resources such as websites,” *Lockheed*, 985 F. Supp. at 961,  
12 965, GoDaddy contends that “the Ninth Circuit held that the registrar defendant was not liable  
13 for contributory infringement based on its registration of domain names . . . *and routing of those*  
14 *domain names to websites created by the registrant.*” Opp. at 11:19-21 (citing *Lockheed*, 194  
15 F.3d at 982-985) (emphasis added).

16 Contrary to GoDaddy’s assertion, however, the Ninth Circuit’s opinion says nothing  
17 about “routing domain names to websites created by the registrant.” Instead, the opinion states:  
18 “when an internet user enters a domain-name combination, NSI translates that domain name  
19 combination to the registrant’s IP address and *routes the information or command to the*  
20 *corresponding computer.*” *Lockheed*, 194 F.3d at 985. The reference to “routing” in the Ninth  
21 Circuit’s opinion is thus to routing the “information or command” that results from “NSI’s  
22 translation of a domain name combination to the registrant’s IP address.” *Id.* Nowhere does the  
23 Ninth Circuit’s opinion state that NSI routes “domain names to websites created by the  
24 registrant,” as GoDaddy contends. Thus, when discussing the U.S. Postal Service, the Ninth  
25 Circuit does not refer to NSI “routing domain names to websites,” as GoDaddy contends, but  
26 instead states that “NSI does not supply the domain name combination any more than the U.S.  
27 Postal Service supplies a street address by performing the routine service of routing mail.” *Id.* at  
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1 984-985. To the contrary, NSI’s “routing service” was simply a “rote translation service” that is  
2 not described by either the Ninth Circuit or the District Court as “routing domain names to  
3 websites created by the registrant.”

4           Accordingly, neither *Lockheed* nor the ACPA supports GoDaddy’s proposed blanket  
5 immunity for registrars or shields it from liability for contributory cybersquatting as to  
6 PETRONASTOWERS.NET.

7 **II. THE UNDISPUTED EVIDENCE SUPPORTS ALL OF THE ELEMENTS OF**  
8 **CONTRIBUTORY CYBERSQUATTING**

9           GoDaddy does not assert that there is a genuine dispute as to any of the material facts  
10 identified by Petronas in its opening brief establishing contributory cybersquatting. Instead,  
11 GoDaddy either ignores or mischaracterizes those facts to argue that they do not entitle Petronas  
12 to judgment as a matter of law.

13 **A. The Undisputed Facts Establish The Registrant’s Direct Cybersquatting As**  
14 **A Matter Of Law**

15           GoDaddy fails to address the undisputed facts establishing two of the three elements of  
16 Registrant’s direct cybersquatting under 15 U.S.C. § 1125(d)(1)(A): (1) the Petronas mark was  
17 “distinctive at the time of registration of the domain name” PETRONASTOWERS.NET and (2)  
18 the domain name PETRONASTOWERS.NET “is identical or confusingly similar to [Petronas’s]  
19 mark. Opening Br. at 5:25-6:2. For the remaining element, the Registrant’s “bad faith intent to  
20 profit,” GoDaddy argues only that the undisputed facts to which Petronas points are legally  
21 insufficient to establish the Registrant’s “bad faith intent.” GoDaddy fails to address, however,  
22 three of the six factors in the ACPA for which Petronas identified undisputed evidence proving  
23 the Registrant’s bad faith intent. 15 U.S.C. § 1125(d)(1)(B)(i) (II, IV, and IX); Opening Br. at  
24 8:8-21. As a result, these three factors alone support a finding of Registrant’s “bad faith intent to  
25 profit.”

26           For the remaining three factors, GoDaddy cites to no legal authority and offers only  
27 attorney argument to contend that the material facts identified by Petronas are somehow  
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1 insufficient to prove the Registrant’s “bad faith.” For factor (V)—the Registrant’s “intent to  
2 divert customers from the mark owner’s online line location”—GoDaddy argues only that  
3 Petronas “does not provide any proof that any customers actually were diverted from Petronas’s  
4 websites to the Registrant’s.” Opp. at 17:9-11. Evidence that customers were actually diverted  
5 is not required, however, because factor (V) refers to the Registrant’s “*intent* to divert customers  
6 from the mark owner’s online location.” And because GoDaddy does not contend that the  
7 evidence proffered by Petronas is insufficient to establish the Registrant’s “intent to divert  
8 customers,” (Opening Br. at 6:22-7:14), factor (V) supports a finding of the Registrant’s bad  
9 faith intent.

10 As for factor (VII)—the Registrant’s “registration or acquisition of multiple domain  
11 names which the person knows are identical or confusingly similar to marks of others that are  
12 distinctive at the time of registration,” 15 U.S.C. § 1125(d)(1)(B)(i)(VIII)—GoDaddy argues that  
13 there is “no evidence of what the registrant ‘knew’ about the word ‘Petronas’ at the time of  
14 registration.” Opp. at 17:14-16. But this is obviously false: the Registrant knew he was  
15 registering the domain name PETRONASTOWERS.NET. As such, it can hardly be disputed  
16 that he knew the domain name he was registering was “identical or confusingly similar” to the  
17 word “Petronas,” which GoDaddy concedes was distinctive at the time of registration and a mark  
18 owned by Petronas.

19 **B. GoDaddy Had Direct Control And Monitoring Of The Instrumentality The**  
20 **Registrant Used to Commit Cybersquatting**

21 GoDaddy’s argument regarding “direct control and monitoring” is indistinguishable from  
22 an argument that the Ninth Circuit rejected in *Louis Vuitton Malletier, S.A. v. Akanoc Sols., Inc.*,  
23 -- F.3d --, 2011 WL4014320 (9th Cir. 2011). Specifically, GoDaddy argues that it did not have  
24 “direct control and monitoring” over the Registrant’s infringement because “there is no evidence  
25 that GoDaddy had any control over the operation or content of the website to which the registrant  
26 caused the Disputed Domain to be routed.” Opp. at 18:13-20.

1 In *Louis Vuitton*, the appellants similarly argued that there was insufficient evidence of  
2 their “direct control and monitoring” of the third party’s “means of infringement” because “the  
3 servers and services they provided and operated were not the ‘means of infringement’; instead  
4 they maintain, the websites selling the infringing goods were the sole means of infringement.”  
5 *Louis Vuitton*, 2011 WL4014320 at \*3. Thus, the *Louis Vitton* appellants contended the District  
6 Court erred because it “failed to distinguish between the servers or services provided by  
7 Appellants and the websites maintained by Appellants’ customers.” *Id.*

8 The Ninth Circuit rejected these arguments: “websites are not ethereal: while they exist  
9 virtually, in cyberspace, they would not exist at all without physical roots in servers and internet  
10 services.” *Id.* Thus, “Appellants had control over the services and servers provided to the  
11 websites. Stated another way, Appellants had direct control over the ‘master switch’ that kept  
12 the websites online and available.” *Id.*

13 While it is true that GoDaddy did not host the pornographic website, it is undisputed that  
14 GoDaddy used its servers to provide its domain name forwarding service that routed internet  
15 traffic between the PETRONASTOWERS.NET domain name and the pornographic website.  
16 Opening Br. at 9:2-15. And it is undisputed that after GoDaddy stopped providing its domain  
17 name forwarding service, the PETRONASTOWERS.NET domain name was no longer linked to  
18 the pornographic website. Opening Br. 4:5-9.

19 Accordingly, GoDaddy is incorrect when it argues that “[f]orwarding, like any form of  
20 routing, merely delivers Internet users from a domain name to a website [and] [b]y providing a  
21 forwarding service, GoDaddy in no way exercises the type of control over its registrant’s intent  
22 and use of domain names that would justify imposing a landlord-like duty to monitor.” Opp. at  
23 19:1-4. To the contrary, as the Ninth Circuit held in *Louis Vuitton*, “Appellants ‘physically host  
24 websites on their servers and route internet traffic to and from those websites. This service is the  
25 Internet equivalent of leasing real estate.’” *Louis Vuitton*, 2011 WL4014320 at \*3.

26 Because it is undisputed that GoDaddy used its servers to provide its domain name  
27 forwarding service for routing internet traffic between PETRONASTOWERS.NET and the  
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1 pornographic website, GoDaddy “had direct control over the ‘master switch’ that kept the  
2 website online and available” to internet traffic destined for PETRONASTOWERS.NET. Its  
3 domain name forwarding service was thus “the Internet equivalent of leasing real estate.” *Louis*  
4 *Vuitton*, 2011 WL4014320 at \*3.

5 **C. The Undisputed Facts Establish, At Least, GoDaddy’s Willful Blindness To**  
6 **The Registrant’s Cybersquatting**

7 GoDaddy does not contend that the materials cited on pages 10-14 of Petronas’s opening  
8 brief do not establish the absence of a genuine dispute as to each of the facts establishing  
9 GoDaddy’s knowledge of or “willful blindness” to the Registrant’s cybersquatting. Instead,  
10 GoDaddy picks and chooses among the evidence cited and contends that it “does not come close  
11 to the type of ‘exceptional circumstances’ that might trigger a duty to investigate.” Opp. at 20:9-  
12 14 and 21:2-5. Because GoDaddy fails to address the assertions of fact on pages 10-14 of  
13 Petronas’s opening brief, those facts should be considered undisputed pursuant to Fed. R. Civ. P.  
14 56(e).

15 But even if GoDaddy had addressed all of those facts, it fails to answer the larger  
16 question raised by its argument, namely, if these facts do not establish “exceptional  
17 circumstances” requiring a registrar to *at least investigate* a trademark owner’s claim of  
18 cybersquatting, what conceivable set of facts would?

19 For the undisputed facts GoDaddy contends are legally insufficient to establish its  
20 knowledge, its arguments are unavailing. First, GoDaddy argues that “mere notice from a  
21 trademark owner of alleged cybersquatting is not enough to trigger a duty to investigate.” Opp.  
22 at 20:1-2. GoDaddy ignores, however, that Petronas provided notice containing “all of the  
23 information GoDaddy would have needed under its policy to investigate a claim regarding  
24 ‘content hosted on GoDaddy’s servers.’” Opening Br. at 11:26-12:1. And GoDaddy’s ignores  
25 the facts establishing that its knowledge also included, among other things, (1) that this Court  
26 had ordered GoDaddy to transfer PETRONASTOWER.NET to Petronas, (2) that both disputed  
27 domains were pointing to the same pornographic website, (3) that both disputed domains were  
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1 registered by the same Registrant, (4) that the pornographic website used a domain registered by  
2 the same Registrant of both of the disputed domains, and (5) that it was aware of the facts  
3 establishing six of the nine ACPA factors demonstrating the Registrant’s bad faith intent.

4 Opening Br. 9-14.

5 In addition, GoDaddy does not dispute that the “vast majority” of the trademark claims it  
6 has investigated resulted in GoDaddy terminating its services to the offending customers.

7 Opening Br. at 11:19-12:6. Instead, GoDaddy argues that this fact is “insufficient to impute to  
8 GoDaddy knowledge of specific infringing activity.” Opp. at 20:24-28. In support, GoDaddy  
9 cites to *Tiffany (NJ), Inc. v. eBay, Inc.*, 600 F.3d 93, 109 (2nd Cir. 2010), for the proposition that  
10 “a service provider must have more than general knowledge or reason to know that its service is  
11 being used to sell counterfeit goods.” Opp. at 20:26-28. Yet the only way GoDaddy could  
12 contend that the foregoing quote from *Tiffany* is relevant is if it ignores all of the other evidence  
13 cited by Petronas and summarized above regarding GoDaddy’s specific knowledge.

14 Finally, GoDaddy never offers any explanation as to why its policy is to investigate only  
15 claims of trademark infringement for websites that it hosts and not to investigate claims of  
16 trademark infringement like the one it received regarding PETRONASTOWERS.NET. Opening  
17 Br. at 11:25-12:1; APP169-171. But it is this policy of deliberately not investigating legitimate  
18 complaints from trademark owners that establishes GoDaddy’s willful blindness in this case. As  
19 the Second Circuit explained, “[a] service provider is not, we think, permitted willful blindness.  
20 When it has reason to suspect that users of its service are infringing a protected mark, it may not  
21 shield itself from learning of the particular infringing transaction by looking the other way.”

22 *Tiffany*, 600 F.3d at 109.

### 23 CONCLUSION

24 For the reasons set forth above, Petronas respectfully requests that the Court grant its  
25 motion for partial summary judgment on GoDaddy’s liability for contributory cybersquatting.

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Dated: November 23, 2011

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