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# Ex. 23

1 Perry R. Clark, Esq.  
 2 Law Offices of Perry R. Clark  
 3 1245 Hamilton Avenue  
 4 Palo Alto, CA 94301  
 5 Telephone: (650) 248-5817  
 6 Facsimile: (650) 248-5816  
 7 perry@perryclarklaw.com  
 8  
 9 Attorney for Plaintiff  
 10 PETROLIAM NASIONAL BERHAD

11 UNITED STATES DISTRICT COURT  
 12 NORTHERN DISTRICT OF CALIFORNIA  
 13 OAKLAND DIVISION

14 PETROLIAM NASIONAL BERHAD,  
 15 Plaintiff,  
 16 vs.  
 17 GODADDY.COM, INC.,  
 18 Defendant.

) CASE NO: 09-CV-5939 PJH  
 )  
 ) Date: April 28, 2010  
 ) Time: 9:00 a.m.  
 ) Location: Courtroom 3  
 ) Third Floor

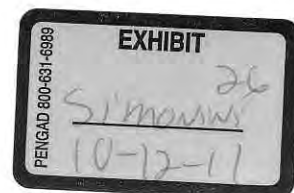
19 PETROLIAM NASIONAL BERHAD,  
 20 Plaintiff,  
 21 vs.  
 22 PETRONASTOWER.NET, an internet domain  
 23 name,  
 24 Defendant.

) CASE NO: 10-CV-00431 EMC

25 **NOTICE OF MOTION AND**  
 26 **MOTION FOR ORDER TRANSFERRING DOMAIN NAME**  
 27 **PURSUANT TO 15 U.S.C. § 1125(D) AND**  
 28 **FOR ENTRY OF JUDGMENT**

***UNOPPOSED MOTION FOR ENTRY OF STIPULATED ORDER RELATING CASES  
 PENDING***

NOTICE OF MOTION AND MOTION FOR ORDER TRANSFERRING DOMAIN NAME PURSUANT TO 15  
 U.S.C. § 1125(D) AND FOR ENTRY OF JUDGMENT  
 Case Nos: 09-CV-5939 PJH and 10-CV00431 EMC



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**I. NOTICE OF MOTION**

TO ALL PARTIES AND COUNSEL OF RECORD: Please take notice that pursuant to Civil Local Rule 7-11 Plaintiff Petroliam Nasional Berhad (“Plaintiff” or “Petronas”) hereby makes this unopposed motion for an order transferring the domain name “petronastower.net” to Plaintiff Petronas pursuant to 15 U.S.C. § 1125(D) and for entry of judgment.

**II. STATEMENT OF RELIEF REQUESTED**

Plaintiff Petronas requests that this Court issue an order directing GoDaddy.Com, Inc. to transfer the domain name “petronastower.net” to Plaintiff Petronas pursuant to 15 U.S.C. § 1125(D). Plaintiff Petronas further requests an order entering judgment in Petronas’s favor in this action. Counsel for GoDaddy has informed counsel for Petronas that GoDaddy is not taking any position with respect to this motion. On January 25, 2010, Plaintiff Petronas informed the registrant of the “petronastower.net” domain of this action at the address provided GoDaddy and as required by 15 U.S.C. § 1125(D). Ex. A. Petronas had previously tried to contact the registrant by mail, email, and telephone regarding the “petronastower.net” domain name. Ex. \_ at 3:8-19 and 26-30. Petronas has not received any communication from the registrant as of the date of this motion. Plaintiff Petronas is unaware of any other person or entity that does, or would, oppose the motion.

**III. MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF MOTION**

The “petronastower.net” domain name should be transferred to Plaintiff Petronas under the Anticyberpiracy section of the Lanham Trademark Act, 15 U.S.C. § 1125(D), because there is no dispute that all three of the requirements of the Anticyberpiracy section are met. First, the domain name “petronastower.net” infringes Plaintiff Petronas’s federally registered trademark for the mark “PETRONAS.” Second, Plaintiff Petronas has been unable to find the person who registered the “petronastower.net” domain name or obtain *in personam* jurisdiction over that person. Third, the internet registrar—GoDaddy—of the domain name “petronastower.net” has

NOTICE OF MOTION AND MOTION FOR ORDER TRANSFERRING DOMAIN NAME PURSUANT TO 15 U.S.C. § 1125(D)  
AND FOR ENTRY OF JUDGMENT  
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1 provided the information required by 15 U.S.C. § 1125(d)(2)(D)(i) which certifies that this Court  
2 has the control and authority to transfer the domain name.

3 **A. Procedural Posture and Related Case**

4 Plaintiff Petronas filed two actions in the Northern District related to the  
5 “petronastower.net” domain name and filed an unopposed motion to relate the two actions on  
6 March 24, 2010. Ex. B (Docket No. 31). This action against GoDaddy (09-5939 PJH) was filed  
7 first and concerns Petronas’s allegations that, among other things, Defendant GoDaddy.com  
8 indirectly infringes the “PETRONAS” mark by maintaining the registration of the  
9 “petronastower.net” domain name with actual knowledge that the domain name infringes the  
10 trademark rights of Petronas.

11 Petronas filed the second action as an *in rem* action under the Anticyberpiracy section of  
12 the Lanham Trademark Act against the “petronastower.net” domain name. The relief Petronas  
13 requested in its complaint in the *in rem* action is an order directing GoDaddy.com to transfer the  
14 “petronastower.net” domain name Petronas.

15 This Court has not yet had an opportunity to rule on Petronas’s unopposed motion  
16 relating the two actions. If the related case motion is granted, however, this Court can promptly  
17 consider this motion, which Petronas makes as part of the *in rem* action. If the related case  
18 motion is denied, this motion will need to be re-filed for consideration by the Judge in the *in rem*  
19 action.

20 **B. “Petronastower.net” Should be Transferred to Petronas**

21 Where, as in this case, a domain name infringes a registered trademark and the domain  
22 registrant either cannot be located or is not subject to *in personam* jurisdiction, the  
23 Anticyberpiracy section of the Lanham Act authorizes a Court to order the domain name  
24 registrar to transfer the domain name to the trademark owner. *See* 15 U.S.C. § 1125(d)(2)(A)(i)

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1 and (ii).<sup>1</sup> Because there is no dispute that the requirements of the Anticyberpiracy section are  
2 met in this case, this Court is authorized to order the domain name registrar of  
3 “petronastower.net”—GoDaddy.com—to transfer that domain name to Petronas, the owner of  
4 the “PETRONAS” mark.

5 **1. “Petronastower.net” Infringes the Trademark Rights of Petronas**

6 There can be no dispute that the first requirement for the transfer of the  
7 “petronastower.net” domain under the Anticyberpiracy section of the Lanham Act—that the  
8 domain name infringes the trademark rights of Petronas—is met in this case. Specifically, the  
9 Anticyberpiracy section applies to any domain name “that violates any right of the owner of a  
10 mark registered in the Patent and Trademark Office, or protected under subsection (a) [false  
11 designation of origin] or (c) [dilution] [of 15 U.S.C. § 1125].” 15 U.S.C. § 1125(d)(2)(A)(i).

12 Here, the “petronastower.net” domain name violates the rights of Petronas with respect to  
13 its federally registered “PETRONAS” mark because it infringes that mark under 15 U.S.C. §  
14 1114 and creates a false designation of origin under 15 U.S.C. § 1125(a). As an initial matter,  
15 Petronas is the owner of the duly registered federal trademark for the mark “PETRONAS.” Ex.  
16 D at 3:23-25 and 10-11. In addition, the “petronastower.net” domain name infringes the  
17 “PETRONAS” mark under 15 U.S.C. § 1114 because the domain name is “a use in commerce”  
18 of the “PETRONAS” mark that is “likely to cause confusion” among consumers as to whether  
19 the pornographic website using the “petronastower.net” domain name is associated with  
20 Petronas—which it is not. *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d  
21 1062, 1075-76 (9th Cir. 2006). Moreover, the “petronastower.net” domain name violates the  
22 rights of Petronas under 15 U.S.C. § 1125(a) by creating a “false designation of origin” as to the  
23 pornographic website found at the “petronastower.net” domain name because that site did not

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25 <sup>1</sup> For convenience, a complete copy of the Anticyberpiracy section (15 U.S.C. §  
26 1125(d)(2)(A)) is attached as Ex. C at 2 of 7.

1 “originate” with Petronas and, in fact, Petronas strongly objects to the site and its use of  
2 “PETRONAS.” *New West Corp. v. N.Y.M. Co. of California*, 595 F.2d 1194, 1201 (9th Cir.  
3 1979) (“Whether we call the violation infringement, unfair competition, or false designation of  
4 origin, the test is identical—is there a likelihood of confusion?”).

5 Accordingly, the first requirement for the transfer of the “petronastower.net” domain  
6 name to Petronas under the Anticyberpiracy section of the Lanham is met because that domain  
7 name infringes the trademark rights of Petronas.

## 8 2. The Registrant of “Petronastower.net” Is Unknown

9 The second requirement for the transfer of “petronastower.net” to Petronas under the  
10 Anticyberpiracy section is met because Petronas could not locate—despite due diligence—the  
11 registrant of the domain name nor could this Court obtain *in personam* jurisdiction over the  
12 registrant. Where, as here, the owner of a mark cannot “obtain *in personam* jurisdiction” or “was  
13 not able to find” the person who registered an infringing domain name with the “bad faith intent”  
14 to profit from the use of the domain name, the second requirement for the transfer of the domain  
15 under the Anticyberpiracy section is met. *See* 15 U.S.C. § 1125(d)(2)(A)(ii).

16 Here, according to GoDaddy’s records, the “petronastower.net” domain name was  
17 registered by “Heiko Schoneneke” whose address is “BPM 195226, 372 Old Street, London,  
18 Ec1V 9AU, United Kingdom.” Ex. A and E (detailing efforts to contact registrant). The internet  
19 registrant also provided an email address: “dd\_privat@hotmail.com.” Although Plaintiff  
20 Petronas tried repeatedly to locate and contact the registrant, including by Federal Express,  
21 email, and telephone, it was unable to do so. *Id.* Because the registrant of the  
22 “petronastower.net” domain could not be located or subjected to *in personam* jurisdiction, the  
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1 second requirement of the Anticyberpiracy section has been met with respect to the  
2 “petronastower.net” domain name.<sup>2</sup>

3 **C. GoDaddy Certifies This Court’s Authority to Transfer the**  
4 **“petronastower.net” Domain Name**

5 GoDaddy is the registrar of the domain name “petronastower.net” and, as required by the  
6 Anitcyberpiracy section, has provided certification that this Court has the “control and authority”  
7 to transfer the “petronastower.net” domain name to Petronas. Specifically, 15 U.S.C. §  
8 1125(d)(2)(D)(i) provides that, upon the filing of an Anticyberpiracy action, “the domain name  
9 registrar . . . shall expeditiously deposit with the court documents sufficient to establish the  
10 court’s control and authority regarding the disposition of the registration and use of the domain  
11 name to the court.” GoDaddy provided this information to Petronas and it is being filed along  
12 with this motion. Ex. F. As a result, all of the requirements for an order directing GoDaddy to  
13 transfer the “petronastower.net” domain name to Petronas under the Anticyberpiracy section  
14 have been met.

14 **D. Entry of Judgment**

15 In this action, Plaintiff Petronas seeks an order transferring the “petronastower.net”  
16 domain name. Upon the issuance of such an order, the Court will have granted complete relief to  
17 Petronas and entry of judgment will be proper under Fed. R. Civ. P. 54. Accordingly, Plaintiff  
18 Petronas requests that in addition to an order transferring the “petronastower.net” domain name,  
19 the Court also issue final judgment in favor of Petronas.

20 **IV. CONCLUSION**

21 For the foregoing reasons, Plaintiff Petronas respectfully requests an order directing  
22 GoDaddy.com to transfer the “petronastower.net” domain name to Petronas and the entry of

23 \_\_\_\_\_  
24 <sup>2</sup> Section 1125(d)(2)(A)(ii)(II)(bb) refers to “publishing notice of the action. . . as the Court  
25 may direct” as a means of locating a registrant in addition to providing notice at the mail and email  
26 addresses of the registrant. This publication requirement does not apply to the present case  
27 because the publication requirement is irrelevant where *in personam* jurisdiction cannot be  
obtained over the domain name registrant.

1 judgment in favor of Petronas. A proposed order and proposed final judgment are being filed  
2 with this motion.

3 Dated: March 25, 2010

LAW OFFICES OF PERRY R. CLARK

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By: /s/ Perry R. Clark.

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Perry R. Clark

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Attorney for Plaintiff  
PETROLIAM NASIONAL BERHAD

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