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Ex. 12

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14 GoDaddy.com, Inc.

15 UNITED STATES DISTRICT COURT
16 NORTHERN DISTRICT OF CALIFORNIA

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CASE NO: 09-CV-5939 PJH

**AMENDED ANSWER AND
COUNTERCLAIM**

DEMAND FOR JURY TRIAL

PETROLIAM NASIONAL BERHAD,

Plaintiff,

vs.

GODADDY.COM, INC.,

Defendant.

GODADDY.COM, INC.,

Counterclaimant,

vs.

PETROLIAM NASIONAL BERHAD,

Counterclaim Defendant.

ANSWER

Defendant and Counterclaimant GoDaddy.com, Inc. (“Go Daddy”), by and through its attorneys, hereby answers the First Amended Complaint (“Complaint”) of Plaintiff and Counterclaim Defendant Petroliam Nasional Berhad (“Plaintiff” or “Petronas”) as follows:

1 **THE PARTIES**

2 1. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
3 paragraph 1 of the Complaint and on that basis denies them.

4 2. Go Daddy admits the allegations as set forth in paragraph 2 of the Complaint.

5 **JURISDICTION AND VENUE**

6 3. Go Daddy admits that this action purportedly arises under the Lanham Act and that the
7 Court has subject matter jurisdiction over the claims asserted in the Complaint. Go Daddy lacks
8 sufficient knowledge to admit or deny the remaining allegations set forth in paragraph 3 of the
9 Complaint and on that basis denies them.

10 4. Go Daddy denies the allegations as set forth in paragraph 4 of the Complaint.

11 5. Go Daddy denies the allegations as set forth in paragraph 5 of the Complaint.

12 **INTRADISTRICT ASSIGNMENT**

13 6. Go Daddy admits the allegations as set forth in paragraph 6 of the Complaint.

14 **FACTUAL ALLEGATIONS**

15 7. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
16 paragraph 7 of the Complaint and on that basis denies them.

17 8. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
18 paragraph 8 of the Complaint and on that basis denies them.

19 9. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
20 paragraph 9 of the Complaint and on that basis denies them.

21 10. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
22 paragraph 10 of the Complaint and on that basis denies them.

23 11. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
24 paragraph 11 of the Complaint and on that basis denies them.

25 12. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
26 paragraph 12 of the Complaint and on that basis denies them.

27 13. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
28 paragraph 13 of the Complaint and on that basis denies them.

1 14. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
2 paragraph 14 of the Complaint and on that basis denies them.

3 15. Go Daddy admits that according to the official website for the Internet Corporation for
4 Assigned Names and Numbers (ICANN), ICANN is responsible for managing and coordinating
5 the Domain Name System. Go Daddy denies the remaining allegations set forth in paragraph 15
6 of the Complaint.

7 16. Go Daddy admits that Verisign is the registry operator for “.com” and “.net” domain
8 names. Go Daddy denies the remaining allegations set forth in paragraph 16 of the Complaint.
9 The “Registry Agreement” speaks for itself.

10 17. Go Daddy admits that Verisign maintains a database of registered “.net” domain names
11 and any Internet Protocol addresses provided for issued “.net” domain names. Go Daddy denies
12 the remaining allegations set forth in paragraph 17 of the Complaint.

13 18. Go Daddy admits that Verisign receives information about domain name registrations
14 from registrars, and that registrars enter into registration accreditation agreements with ICANN.
15 Go Daddy denies the remaining allegations set forth in paragraph 18 of the Complaint. The
16 agreements speak for themselves.

17 19. Go Daddy admits that it has entered into a registrar accreditation agreement with
18 ICANN. Go Daddy denies the remaining allegations set forth in paragraph 19 of the Complaint.

19 20. Go Daddy admits that it has entered into a registrar accreditation agreement with
20 ICANN. Go Daddy denies the remaining allegations set forth in paragraph 20 of the Complaint.
21 The agreement speaks for itself.

22 21. Go Daddy admits that it has entered into a registrar accreditation agreement with
23 ICANN. Go Daddy denies the remaining allegations set forth in paragraph 21 of the Complaint.
24 The agreement speaks for itself.

25 22. Go Daddy admits that it has entered into a registrar accreditation agreement with
26 ICANN. Go Daddy denies the remaining allegations set forth in paragraph 22 of the Complaint.
27 The agreement speaks for itself.
28

1 23. Go Daddy admits that it has entered into a registrar accreditation agreement with
2 ICANN. Go Daddy denies the remaining allegations set forth in paragraph 23 of the Complaint.
3 The agreement speaks for itself.

4 24. Go Daddy admits that it has entered into a registrar accreditation agreement with
5 ICANN. Go Daddy denies the remaining allegations set forth in paragraph 24 of the Complaint.
6 The agreement speaks for itself.

7 25. Go Daddy admits that it has entered into a registrar accreditation agreement with
8 ICANN. Go Daddy denies the remaining allegations set forth in paragraph 25 of the Complaint.
9 The agreement speaks for itself.

10 26. Go Daddy admits that it has entered into a registrar accreditation agreement with
11 ICANN. Go Daddy denies the remaining allegations set forth in paragraph 26 of the Complaint.
12 The agreement speaks for itself.

13 27. Go Daddy denies the allegations set forth in paragraph 27 of the Complaint.

14 28. Go Daddy admits that it offers a domain name hosting service. Go Daddy denies the
15 remaining allegations set forth in paragraph 28 of the Complaint.

16 29. Go Daddy admits that it offers a domain name forwarding service. Go Daddy denies
17 the remaining allegations set forth in paragraph 29 of the Complaint.

18 30. Go Daddy denies the allegations set forth in paragraph 30 of the Complaint.

19 31. Go Daddy admits the allegations set forth in paragraph 31 of the Complaint.

20 32. Go Daddy admits that it entered into a domain name registration agreement with the
21 registrant of the <petronastower.net> and <petronastowers.net> domain names. Go Daddy denies
22 the remaining allegations set forth in paragraph 32 of the Complaint.

23 33. Go Daddy admits that ICANN has a registrar transfer dispute resolution policy. Go
24 Daddy denies the remaining allegations set forth in paragraph 33 of the Complaint.

25 34. Go Daddy admits that it has a trademark and/or copyright infringement policy. Go
26 Daddy denies the remaining allegations set forth in paragraph 34 of the Complaint.

27 35. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
28 paragraph 35 of the Complaint and on that basis denies them.

1 36. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
2 paragraph 36 of the Complaint and on that basis denies them.

3 37. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
4 paragraph 37 of the Complaint and on that basis denies them.

5 38. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
6 paragraph 38 of the Complaint and on that basis denies them.

7 39. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
8 paragraph 39 of the Complaint and on that basis denies them.

9 40. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
10 paragraph 40 of the Complaint and on that basis denies them.

11 41. Go Daddy admits that it was contacted on November 26, 2009 concerning the domain
12 name <petronastower.net>. Go Daddy denies the remaining allegations set forth in paragraph 41
13 of the Complaint.

14 42. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
15 paragraph 42 of the Complaint and on that basis denies them.

16 43. Go Daddy admits the allegations set forth in paragraph 43 of the Complaint.

17 44. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
18 paragraph 44 of the Complaint and on that basis denies them.

19 45. Go Daddy admits that it was contacted on November 26, 2009 concerning the domain
20 name <petronastower.net>. Go Daddy denies the remaining allegations set forth in paragraph 45
21 of the Complaint.

22 46. Go Daddy admits that it sent an e-mail message concerning the domain name
23 <petronastower.net> on or about December 1, 2009. Go Daddy denies the remaining allegations
24 set forth in paragraph 46 of the Complaint.

25 47. Go Daddy admits that it was contacted on December 14, 2009 concerning the domain
26 name <petronastower.net>. Go Daddy denies the remaining allegations set forth in paragraph 47
27 of the Complaint.

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1 48. Go Daddy admits that it was contacted concerning the domain name
2 <petronastower.net> on December 16, 2009. Go Daddy denies the remaining allegations set forth
3 in paragraph 48 of the Complaint.

4 49. Go Daddy admits that on December 16, 2009 it sent an e-mail message concerning the
5 domain name <petronastower.net>. Go Daddy denies the remaining allegations set forth in
6 paragraph 49 of the Complaint.

7 50. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
8 paragraph 50 of the Complaint and on that basis denies them.

9 51. Go Daddy admits that plaintiff requested a temporary restraining order of December
10 18, 2009, and that the request was denied on December 23, 2009. Go Daddy denies the remaining
11 allegations set forth in paragraph 51 of the Complaint.

12 52. Go Daddy admits that plaintiff filed an *in rem* action against the domain name
13 <petronastower.net> on January 29, 2010, and that the *in rem* action resulted in an order
14 transferring the domain name <petronastowner.net> to plaintiff on May 13, 2010. Go Daddy
15 denies the remaining allegations set forth in paragraph 52 of the Complaint.

16 53. Go Daddy admits that it was the registrar of the domain name <petronastowers.net>.
17 Go Daddy denies the remaining allegations set forth in paragraph 53 of the Complaint.

18 54. Go Daddy admits that it was contacted on July 7, 2010 concerning the domain name
19 <petronastowers.net>. Go Daddy admits that it sent an e-mail message concerning the domain
20 name <petronastowers.net> on July 8, 2010. Go Daddy denies the remaining allegations set forth
21 in paragraph 54 of the Complaint.

22 55. Go Daddy admits that plaintiff filed an *in rem* action against the domain name
23 <petronastowers.net> on July 12, 2010, and that the *in rem* action resulted in an order transferring
24 the domain name <petronastowers.net> to plaintiff on August 27, 2010. Go Daddy denies the
25 remaining allegations set forth in paragraph 55 of the Complaint.

26 56. Go Daddy admits the allegations set forth in paragraph 56 of the Complaint.

27 57. Go Daddy denies the allegations set forth in paragraph 57 of the Complaint.

28 58. Go Daddy denies the allegations set forth in paragraph 58 of the Complaint.

COUNT ONE

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

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3 59. Go Daddy incorporates by reference its responses to paragraphs 1 through 58,
4 inclusive, as if fully set forth herein.

5 60. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
6 paragraph 60 of the Complaint and on that basis denies them.

7 61. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
8 paragraph 61 of the Complaint and on that basis denies them.

9 62. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
10 paragraph 62 of the Complaint and on that basis denies them.

11 63. Go Daddy denies the allegations as set forth in paragraph 63 of the Complaint.

12 64. Go Daddy denies the allegations as set forth in paragraph 64 of the Complaint.

13 65. Go Daddy denies the allegations as set forth in paragraph 65 of the Complaint.

14 66. Go Daddy denies the allegations as set forth in paragraph 66 of the Complaint

15 67. Go Daddy denies the allegations as set forth in paragraph 67 of the Complaint.

16 68. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
17 paragraph 68 of the Complaint and on that basis denies them.

18 69. Go Daddy admits that it does not charge a fee for its domain name forwarding service.
19 Go Daddy denies the remaining allegations set forth in paragraph 69 of the Complaint.

20 70. Go Daddy admits that it charges registrants in general, and the registrant of the
21 <petronastower.net> and <petronastowers.net> domain names in particular, a standard registration
22 fee that does not relate in any way to any trademark rights of plaintiff or anyone else. Go Daddy
23 denies the remaining allegations set forth in paragraph 70 of the Complaint.

24 71. Go Daddy admits that every year hundreds of proceedings under the Uniform Domain
25 Name Dispute Resolution Policy have been filed concerning the domain names that are registered
26 with Go Daddy. Go Daddy denies the remaining allegations set forth in paragraph 71.

27 72. Go Daddy denies the allegations set forth in paragraph 72 of the Complaint.

28 73. Go Daddy denies the allegations set forth in paragraph 73 of the Complaint.

1 74. Go Daddy denies the allegations set forth in paragraph 74 of the Complaint.

2 75. Go Daddy denies the allegations set forth in paragraph 75 of the Complaint.

3 76. Go Daddy denies the allegations set forth in paragraph 76 of the Complaint.

4 **COUNT TWO**

5 **Contributory Liability for Cybersquatting**

6 77. Go Daddy incorporates by reference its responses to paragraphs 1 through 76,
7 inclusive, as through fully set forth herein.

8 78. Go Daddy lacks sufficient knowledge to admit or deny the allegations as set forth in
9 paragraph 78 of the Complaint and on that basis denies them.

10 79. Go Daddy denies the allegations set forth in paragraph 79 of the Complaint.

11 80. Go Daddy denies the allegations set forth in paragraph 80 of the Complaint.

12 81. Go Daddy denies the allegations set forth in paragraph 81 of the Complaint.

13 82. Go Daddy denies the allegations set forth in paragraph 82 of the Complaint.

14 83. Go Daddy denies the allegations set forth in paragraph 83 of the Complaint.

15 84. Go Daddy denies the allegations set forth in paragraph 84 of the Complaint.

16 85. Go Daddy denies the allegations set forth in paragraph 85 of the Complaint.

17 86. Go Daddy denies the allegations set forth in paragraph 86 of the Complaint.

18 87. Go Daddy denies the allegations set forth in paragraph 87 of the Complaint.

19 88. Go Daddy denies the allegations set forth in paragraph 88 of the Complaint.

20 89. Go Daddy denies the allegations set forth in paragraph 89 of the Complaint.

21 90. Go Daddy denies the allegations set forth in paragraph 90 of the Complaint.

22 91. Go Daddy denies the allegations set forth in paragraph 91 of the Complaint.

23 92. Go Daddy denies the allegations set forth in paragraph 92 of the Complaint.

24 93. Go Daddy admits that it does not claim ownership of the PETRONAS trademark. Go
25 Daddy denies the remaining allegations set forth in paragraph 93 of the Complaint.

26 94. Go Daddy admits that its legal name is not incorporated in the <petronastower.net> or
27 <petronastowers.net> domain names. Go Daddy denies the remaining allegations set forth in
28 paragraph 94 of the Complaint.

1 95. Go Daddy denies the allegations set forth in paragraph 95 of the Complaint.

2 96. Go Daddy denies the allegations set forth in paragraph 96 of the Complaint.

3 **COUNT THREE**

4 **Unfair Competition under California Bus. & Prof. Code § 17200**

5 **and California Common Law**

6 97. Go Daddy incorporates by reference its responses to paragraphs 1 through 96,
7 inclusive, as though fully set forth herein.

8 98. Go Daddy denies the allegations set forth in paragraph 98 of the Complaint.

9 99. Go Daddy denies the allegations set forth in paragraph 99 of the Complaint.

10 100. Go Daddy denies the allegations set forth in paragraph 100 of the Complaint.

11 101. Go Daddy denies the allegations set forth in paragraph 101 of the Complaint.

12 **AFFIRMATIVE DEFENSES**

13 Go Daddy alleges the following affirmative and other defenses, reserving the right to
14 modify, amend, and/or expand upon these defenses as discovery proceeds.

15 **FIRST AFFIRMATIVE DEFENSE**

16 102. The Complaint, and each claim asserted within it, fails to state a claim upon which
17 relief can be granted.

18 **SECOND AFFIRMATION DEFENSE**

19 103. The Complaint is barred, in whole or in part, by the Lanham Act safe harbor for
20 domain name registrars. 15 U.S.C. §1114.

21 **THIRD AFFIRMATIVE DEFENSE**

22 104. The Complaint is barred, in whole or in part, by the equitable doctrines of waiver,
23 estoppel and laches. On information and belief, the domain names at issue were registered in
24 2003, and have pointed to pornographic content since that time. On information and belief,
25 Petronas waited until 2009 to take any action with regard to one of the domain names at issue and
26 waited until 2010 to take action with regard to the other domain name at issue.

1 **FOURTH AFFIRMATIVE DEFENSE**

2 105. The Complaint is barred, in whole or in part, by the doctrine of acquiescence. On
3 information and belief, Petronas did not take any action with regard to the domain names at issue
4 for approximately six years and thereby acquiesced and forfeited any right to complain about the
5 conduct that forms the basis for its allegations.

6 **FIFTH AFFIRMATIVE DEFENSE**

7 106. The Complaint is barred, in whole or in part, by failure to bring this action within the
8 time allowed under the applicable the statute of limitation(s). *See, e.g.*, Cal. Bus. & Prof. Code §
9 17208.

10 **SIXTH AFFIRMATIVE DEFENSE**

11 107. The Complaint is barred, in whole or in part, by the defense of misrepresentation of
12 material facts. The Complaint contains numerous factually inaccurate allegations, including, *inter*
13 *alia*, that “GoDaddy provides its ‘domain name forwarding’ service to registrants who registered
14 their domain names with registrars other than GoDaddy.” Complaint ¶ 30. In addition, on
15 information and belief, Plaintiff has made false or improper representations with the intent to
16 induce the U.S. Patent and Trademark Office to issue a trademark registration.

17 **SEVENTH AFFIRMATIVE DEFENSE**

18 108. Plaintiff’s alleged trademark is invalid and therefore cannot support Plaintiff’s claims
19 because, on information and belief, Plaintiff has abandoned the alleged mark, has never used it in
20 the United States, or otherwise does not have valid United States trademark rights in the alleged
21 mark. Plaintiff’s alleged trademark registration is invalid for the reasons set forth in the below
22 counterclaim and therefore cannot support Plaintiff’s claims.

23 **EIGHTH AFFIRMATIVE DEFENSE**

24 109. Plaintiff lacks standing to bring these claims because it does not possess valid United
25 States trademark rights in the alleged trademark.

26 **NINTH AFFIRMATIVE DEFENSE**

27 110. The Complaint is barred, in whole or in part, by the failure of Plaintiff to mitigate
28 damages, if any, by waiting approximately six years to take action with regard to the domains at

1 issue and choosing not to seek transfer of the domains at issue by the fastest available means,
2 including a Uniform Domain-Name Dispute-Resolution Policy proceeding before an arbitrator
3 accredited by the Internet Corporation for Assigned Names and Numbers, which proceeding
4 would typically have been resolved far faster than the proceedings Plaintiff chose to pursue.

5 **TENTH AFFIRMATIVE DEFENSE**

6 111. The Complaint is barred, in whole or in part, by the failure of Plaintiff to join an
7 indispensable party as defendant in this action, including the domain name registrant, the company
8 responsible for hosting the alleged website content, and anyone else that may be involved in the
9 operation of the alleged websites.

10 **ELEVENTH AFFIRMATIVE DEFENSE**

11 112. The Complaint is barred, in whole or in part, by the equitable doctrine of unclean
12 hands. On information and belief, Plaintiff has made false or improper representations with the
13 intent to induce the U.S. Patent and Trademark Office to issue a trademark registration. On
14 information and belief, Plaintiff has wielded this registration against Go Daddy in this action
15 while knowing that it is invalid, in whole or in part. As set forth below, the alleged trademark
16 registration is therefore subject to cancellation or partial cancellation.

17 **COUNTERCLAIM FOR CANCELLATION**

18 Go Daddy hereby counterclaims against Petronas:

19 **JURISDICTION AND VENUE**

20 1. The Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C.
21 §§ 1331 and 1338(a), as this action arises under the trademark laws of the United States.

22 2. Venue is proper and should be maintained in this Court pursuant to 28 U.S.C. § 1391.

23 **INTRADISTRICT ASSIGNMENT**

24 3. This action is an intellectual property action. Pursuant to Civil Local Rule 3-2(c), it
25 may be assigned on a district-wide basis. This Counterclaim, however, is properly filed in the
26 Oakland Division, because the original Complaint was assigned in this Division and the case is
27 currently pending in this Division.
28

1 **THE PARTIES**

2 4. Based on the allegations in Paragraph 1 of the Complaint, Go Daddy is informed and
3 believes and therefore alleges that Counterclaim Defendant Petronas is a Malaysian corporation
4 with its principal place of business in Kuala Lumpur, Malaysia.

5 5. Counterclaimant Go Daddy is an Arizona corporation with its principal place of
6 business in Scottsdale, Arizona.

7 **COUNTERCLAIM**

8 6. Based on the allegations in Paragraph 60 of the Complaint, Petronas claims to be the
9 owner of United States Trademark Registration No. 2,969,707 for PETRONAS & Design (the
10 “Petronas Registration”). Petronas claims that the Petronas Registration is outstanding and valid.

11 7. Based on public information made available by the United States Patent and
12 Trademark Office, the Petronas Registration lists the following goods and services:

13 International Class: 001

14 Goods & Services: Chemicals and petrochemicals for use in the manufacture of
15 pharmaceuticals, cosmetics, detergents, packaging, wire and cable
16 installation, cassette tapes, pipes, toys, films, floorings, synthetic
17 rubber, paints and coatings, adhesives, fuel additives and lubricants,
18 textiles, agriculture, electrical and electronic components,
19 automotive parts, aerospace and aviation, building and construction
20 materials, plastics, foods, and diagnostic equipment; chemical and
21 petrochemical in the nature of methanol, ethylene, methyl tertiary
22 butyl ether (MTBE), vinyl chloride monomer, polyvinyl chloride,
23 polyethylene, polypropylene, propylene, ethyl benzene, and styrene
24 monomer all for use in industrial, forestry, agricultural, horticultural,
25 and scientific applications; photographic chemicals; artificial and
26 synthetic resins for use in the manufacture of fibers, polymers and
27 coatings, and molding compounds; plastic molding compounds for
28 use in plastic extrusion operations plastic molding compounds for
use the manufacture of molded plastic articles and plastic sheets and
films; composts; manures; fertilizers for agricultural and domestic
use; glue for industrial purposes, adhesives for general industrial
use, contact cements; gases for heating, lighting, steam generating,
cooking, refrigeration, drying and ventilating for industrial use in
liquid and gaseous forms; oil dispersants; chemicals for separating
oils; hydraulic fluids for general use; chemical additives for use in
the manufacture of fuels, lubricants, gasoline and drilling lubricants;
drilling muds for use in oil well drilling, coolants for vehicle
engines, heat transfer fluids for industrial use, hydraulic fluids for
general use, acidulated water for recharging accumulators and
batteries; chemical additives for use with internal combustion

- 1 engines. chemical additives for fuel saving treatments, catalysts for
- 2 use in the oil processing industry, oil for preservation of masonry.
- 3 International Class: 004
- 4 Goods & Services: Transmission fluids, cutting oil for industrial metalworking, Crude
- 5 oil, natural gasoline, fuel oil and general purpose greases, all
- 6 purpose lubricants; gasoline; fuel gas; fuel oils; fuel alcohol; diesel
- 7 fuel; gas; gasoline as lubricant; kerosene, unleaded fuel; oil gas;
- 8 paraffin; petroleum; petroleum ether, fuels in liquid, gaseous and
- 9 solid form, dust lying and absorbing compositions for use on
- 10 unpaved roads; non-chemical additives for oils and fuels; petroleum
- 11 jelly for industrial purposes, tallow, automatic transmission fluids;
- 12 methanol petrochemicals for use in fuel, petroleum based dust
- 13 suppressing compositions for use in manufacture
- 14 International Class: 011
- 15 Goods & Services: Air conditioners, water distillation units, flares, gas and petrol
- 16 burners for industrial purposes; gas regulators, heat exchangers, heat
- 17 pumps, pasteurizers for use in food and beverage industry; electric
- 18 radiators not for motors or engines, solar collectors for heating solar
- 19 furnaces, water filters

20 8. On December 28 2001, Petronas filed an application for registration of the

21 PETRONAS & Design mark with the U.S. Patent and Trademark Office (the “Petronas

22 Application”). The Petronas Application eventually matured into the Petronas Registration. The

23 Petronas Application stated Petronas’ bona fide intent to use the PETRONAS & Design mark in

24 connection with each of the goods and services in the application.

25 9. On information and belief, Petronas did not, in fact, have a bona fide intent to use the

26 PETRONAS & Design mark in connection with each of the goods and services in the Petronas

27 Application.

28 10. On information and belief, Petronas has not used the PETRONAS & Design mark in

connection with all of the goods and services in the Petronas Registration.

11. On information and belief, Petronas has ceased use of the PETRONAS & Design

mark in connection with some or all of the goods and services in the Petronas Registration.

12. On information and belief, Petronas has no intent to resume use of the PETRONAS &

Design mark in connection with all of the goods and services in the Petronas Registration.

13. On information and belief, Petronas has abandoned the PETRONAS & Design mark,

in whole or in part.

1 14. The Petronas Application was made pursuant to Section 44 of the Lanham Act, 15
2 U.S.C. § 1126, claiming a registration for the PETRONAS & Design mark in Petronas' country of
3 origin.

4 15. Petronas was required to submit to the USPTO a registration or registrations for the
5 PETRONAS & Design mark in Petronas' country of origin, with the foreign registration(s)
6 covering all or substantially all of the goods and services in its U.S. trademark application.

7 16. Petronas submitted registrations for the PETRONAS & Design mark in Petronas'
8 country of origin to the USPTO.

9 17. The registrations submitted by Petronas to the USPTO are considerably more limited
10 and narrow than, and thus do not support, the Petronas Registration.

11 18. For the reasons above, the Petronas Registration was issued improperly and is invalid.

12 19. Go Daddy has been damaged and will likely continue to be damaged by the Petronas
13 Registration, as Petronas is relying on that registration as a basis for this action for cybersquatting
14 and other related claims.

15 20. Accordingly, Go Daddy is entitled to an order from this Court canceling the Petronas
16 Registration, in whole or in part.

17 **PRAYER FOR RELIEF**

18 WHEREFORE, Go Daddy prays for judgment in its favor as follows:

19 a. That the Court deny the Complaint in its entirety, with prejudice, and
20 specifically deny each and every prayer for relief contained therein;

21 b. That the Court award Go Daddy its reasonable costs, disbursements, and
22 attorneys' fees incurred in this action, to the extent permitted by law, including but not limited to
23 15 U.S.C. § 1117, 28 U.S.C. § 1927, and Fed. R. Civ. P. 11;

24 c. That the Court order the Director of the U.S. Patent and Trademark Office to
25 cancel Petronas' United States Trademark Registration No. 2,969,707 for PETRONAS & Design;
26 and

27 d. That the Court grant such other and further relief as the Court deems just and
28 equitable.

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Dated: June 30, 2011

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: /s/ John L. Slafsky .

John L. Slafsky
David H. Kramer
Hollis Beth Hire

Attorneys for Defendant
GoDaddy.com, Inc.

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DEMAND FOR JURY TRIAL

Defendant Go Daddy hereby demands a trial by jury of this action pursuant to Federal Rule of Civil Procedure 38 and Civil L.R. 3-6.

Dated: June 30, 2011

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: /s/ John L. Slafsky
John L. Slafsky
David H. Kramer
Hollis Beth Hire

Attorneys for Defendant
GoDaddy.com, Inc.