

1 JOHN L. SLAFSKY, State Bar No. 195513
 2 DAVID L. LANSKY, State Bar No. 199952
 3 HOLLIS BETH HIRE, State Bar No. 203651
 4 WILSON SONSINI GOODRICH & ROSATI
 5 PROFESSIONAL CORPORATION
 6 650 Page Mill Road
 7 Palo Alto, CA 94304
 8 Telephone: (650) 493-9300
 9 Fax: (650) 493-6811
 10 jslafsky@wsgr.com
 11 dlansky@wsgr.com
 12 hhire@wsgr.com

13 Attorneys for Defendant / Counterclaimant
 14 GODADDY.COM, INC.

15 UNITED STATES DISTRICT COURT
 16 NORTHERN DISTRICT OF CALIFORNIA

17	PETROLIAM NASIONAL BERHAD,)	CASE NO.: 09-CV-5939 PJH
18)	
19	Plaintiff,)	
20)	ADMINISTRATIVE MOTION FOR
21	vs.)	ENTRY OF FINAL JUDGMENT ON
22)	PETRONAS'S CLAIMS AND
23	GODADDY.COM, INC.,)	VOLUNTARY DISMISSAL OF GO
24)	DADDY'S COUNTERCLAIM
25	Defendant.)	WITHOUT PREJUDICE
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17 _____)
 18) Honorable Phyllis J. Hamilton
 19 GODADDY.COM, INC.,)
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 21 Counterclaimant,)
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 23 vs.)
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 25 PETROLIAM NASIONAL BERHAD,)
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 27 Counterclaim Defendant.)
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1 Defendant and Counterclaimant GoDaddy.com, Inc. (“Go Daddy”) hereby moves for entry
2 of final judgment as to all claims asserted by Plaintiff and Counterclaim Defendant Petroliam
3 Nasional Berhad (“Petronas”) in the above-captioned litigation (“Petronas’s claims”), and for
4 voluntary dismissal without prejudice of Go Daddy’s counterclaim for cancellation of Petronas’s
5 PETRONAS AND DESIGN trademark registration, Reg. No. 2969707 (the “Trademark claim”).
6 As discussed with the Court at the January 19, 2012 Case Management Conference, Go Daddy
7 maintains that the Court should now allow for trial of the Trademark claim before the Trademark
8 Trial and Appeal Board (“TTAB”) of the U.S. Patent and Trademark Office. Go Daddy
9 previously asserted a substantially identical claim currently pending in an action before the TTAB
10 entitled *GoDaddy.com, Inc., v. Petroliam Nasional Berhad*, No. 92052741 (the “TTAB
11 proceeding”). See Exhibit A to the Declaration of David L. Lansky, filed concurrently herewith
12 (the “Lansky Decl.”). The TTAB proceeding is suspended in deference to this litigation. Lansky
13 Decl., Ex. B.

14 By way of background, on January 3, 2012, the Court granted Go Daddy’s motion for
15 summary judgment as to Petronas’s claims and denied Go Daddy’s motion for summary judgment
16 as to the Trademark claim. Accordingly, the only claim now pending in this lawsuit is the
17 Trademark claim.¹

18 At the January 19 Case Management Conference, the parties and the Court discussed
19 whether, in view of the dismissal of Petronas’s claims, it would now be most efficient to litigate
20 the remainder of the Trademark claim in the TTAB proceeding as opposed to in this Court. Go
21 Daddy indicated that it would be willing to go forward with a trial of the Trademark claim before
22 the TTAB based on the discovery to date. In particular, Go Daddy suggested that the parties could
23 now request that the TTAB lift the current suspension of the TTAB proceeding.² The Court
24

25 ¹ Petronas is reserving its right to appeal the Court’s dismissal of its claims, which are based,
26 in part, on its federal trademark registration. Accordingly, at this time, Go Daddy is not willing to
27 withdraw the Trademark claim with prejudice.

28 ² Go Daddy, or preferably the parties together, would file a motion with the TTAB to lift the
stay, making clear that the Court has no plans to try the Trademark claim and that the basis for the
stay is now moot.

1 indicated that it was open to such disposition of the Trademark claim and also stated that if the
2 TTAB for some reason declined to lift its suspension, the parties could report back to the Court
3 and seek to reschedule trial of the Trademark claim. On January 19, 2012 the Court issued a
4 minute order (Dkt. 162) directing the parties to “meet and confer and submit a proposed stipulated
5 judgment covering the summary judgment order and either a voluntary dismissal of the
6 counterclaim without prejudice or proposed order remanding the case back to the trial board[.]”
7 Go Daddy subsequently proposed a series of stipulations and orders, but Petronas has not agreed
8 to any them. Lansky Decl., ¶ 6.

9 In response to Go Daddy’s proposed stipulation following the Case Management
10 Conference, Petronas initially insisted on obtaining “final judgment” in its favor on the Trademark
11 claim. Contrary to the discussion at the Case Management Conference, Petronas no longer
12 acknowledges that it would be most efficient for the parties to litigate the Trademark claim in the
13 TTAB proceeding. Petronas is likewise unwilling to stipulate to Go Daddy’s reservation of the
14 right, as suggested by the Court at the Case Management Conference, to seek revival of the
15 Trademark claim in this Court in the unlikely event that the TTAB refuses to lift its suspension.

16 Under the circumstances of this lawsuit, with a single remaining trademark cancellation
17 claim, it clearly would not be efficient to proceed to trial before the Court. A TTAB trial, in
18 contrast, is based on submission of documentary evidence and transcripts of trial testimony
19 depositions (typically without an oral hearing) and thus can proceed much less expensively and,
20 relatively speaking, at the convenience of the parties. Certainly, the TTAB has considerable
21 substantive expertise as to claims such as the Trademark claim.

22 Under the doctrine of primary jurisdiction, the Court has discretion to remand the
23 Trademark claim now to the TTAB, either by dismissing the Trademark claim without prejudice
24 (for the purpose of continued prosecution before the TTAB) or staying the lawsuit pending
25 disposition of the TTAB proceeding. “If a district court action involves only the issue of whether
26 a mark is entitled to registration and if subject matter jurisdiction is available, the doctrine of
27 primary jurisdiction might well be applicable. ... In such a case the benefits of awaiting the
28 decision of the [TTAB] would rarely, if ever, be outweighed by the litigants’ need for prompt

1 adjudication.” *Goya Foods, Inc. v. Tropicana Products, Inc.*, 846 F. 2d. 848 (2nd Cir. 1988). Here
2 the Court should exercise its discretion to dismiss the Trademark claim without prejudice,
3 allowing Go Daddy to ask the TTAB to lift its suspension and to schedule a trial of the Trademark
4 claim. The Court should also allow -- as discussed specifically at the Case Management
5 Conference -- for the procedural safeguard of Go Daddy being able to return to this Court in the
6 unlikely event the TTAB declines to lift its stay. The alternative of burdening the parties and the
7 Court now with a District Court trial of the Trademark claim is inefficient and unnecessary.

8 Accordingly, Go Daddy respectfully submits the proposed order filed concurrently
9 herewith.

11 Dated: January 27, 2012

WILSON SONSINI GOODRICH & ROSATI
PROFESSIONAL CORPORATION

14 By: /s/ David L. Lansky
15 JOHN L. SLAFSKY
16 DAVID L. LANSKY
17 HOLLIS BETH HIRE
18 jslafsky@wsgr.com
19 dlansky@wsgr.com
20 hhire@wsgr.com

Attorneys for Defendant and Counterclaimant
GODADDY.COM, INC.