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

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 11 PETROLIAM NASIONAL BERHAD
 (PETRONAS),
 12 Plaintiff,
 13 vs.
 14 GODADDY.COM, INC.,
 15 Defendant.

CASE NO: 09-CV5939 PJH (MEJ)

**OPPOSITION TO ADMINISTRATIVE
 MOTION FOR ENTRY OF FINAL
 JUDGMENT ON PETRONAS’S
 CLAIMS AND VOLUNTARY
 DISMISSAL OF GODADDY’S
 COUNTERCLAIM WITHOUT
 PREJUDICE
 (DOC. NO. 166)**

17 Plaintiff and Counterclaim Defendant Petroliam Nasional Berhad (“Petronas”) hereby
 18 opposes Defendant and Counterclaimant GoDaddy.com, Inc.’s (“GoDaddy’s”) administrative
 19 motion for entry of final judgment as to all claims asserted by Petronas and for voluntary
 20 dismissal without prejudice of GoDaddy’s counterclaim for cancellation of Petronas’s
 21 PETRONAS AND DESIGN trademark registration, Reg. No. 2969707 (the “Trademark claim”).

22 Petronas does not oppose—and repeatedly agreed to stipulate to—GoDaddy’s request
 23 that, “[p]ursuant to Federal Rule of Civil Procedure 41(a)(2), the Court enter[] GoDaddy’s
 24 voluntary dismissal of the Trademark claim without prejudice.”

25 Petronas does, however, oppose GoDaddy’s request that, in addition to GoDaddy’s
 26 voluntary dismissal of the Trademark claim without prejudice, the Court order that “[s]hould the
 27 TTAB for any reason decline a request to lift the suspension of the TTAB proceeding, then
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1 GoDaddy may advise this Court within 30 days of such TTAB decision and seek rescheduling
2 of trial of the Trademark claim before this Court.”

3 Petronas opposes this request by GoDaddy because it asks that the Court, on the one
4 hand, “dismiss” GoDaddy’s Trademark claim while, on the other hand, essentially stay
5 GoDaddy’s Trademark claim “[s]hould the TTAB **for any reason** decline a request to lift the
6 suspension of the TTAB proceeding.” (emphasis added). GoDaddy’s request is inconsistent
7 with the TTAB’s June 7, 2011 order suspending the TTAB proceeding, which contemplates a
8 “final disposition of the civil action between the parties, including all appeals.” Specifically,
9 TTAB’s order states:

10 “these proceedings are **suspended** pending final disposition of the civil action
11 between the parties, including all appeals. . . . Within **twenty days** after the final
12 determination of the civil action, the interested party should notify the Board so
that this case may be called up for appropriate action.

13 Lansky Decl. Ex. B (Doc. No. 166-3) at 2-3 (TTAB Suspension Order, June 7, 2011) (emphasis
14 original).

15 Petronas also opposes GoDaddy’s motion because it is based on several mis-
16 characterizations of positions taken by Petronas—one of which needs to be addressed. Namely,
17 it is incorrect that “[c]ontrary to the discussion at the Case Management Conference, Petronas
18 no longer acknowledges that it would be most efficient for the parties to litigate the Trademark
19 claim in the TTAB proceeding.” Mtn. at 2:11-12. Petronas’s position has always been that if
20 GoDaddy chooses to dismiss its Trademark claim in the district court, Petronas would rather be
21 in the TTAB and seek dismissal of GoDaddy’s Trademark claim there. Petronas has never
22 agreed, however, that the TTAB proceeding would be more efficient—indeed, discovery in the
23 TTAB has not even closed. Nor has Petronas agreed that it would be more efficient to, in
24 essence, stay this district court case pending a decision by the TTAB refusing to proceed with
25 GoDaddy’s Trademark claim “for any reason,” including substantive reasons such as that
26 GoDaddy lacks standing to bring its Trademark claim or that it lacks any evidence to support its
27 claim.

1 Petronas also does not agree that the TTAB proceeding would be “more efficient” for the
2 reasons set forth in the TTAB’s order suspending those proceedings (and footnotes 2 and 3 in
3 particular):

4 A review of the pleadings in the civil case indicates
5 that a decision by the district court could be dispositive
6 of, or have a bearing on, the issues in this proceeding.²
7 Specifically, the Board notes that respondent (plaintiff in
8 the civil action) has pleaded ownership of the subject
9 registration herein and relies on its registration as a
10 basis for its asserted claims. The Board additionally notes
11 that petitioner (defendant in the civil action) has asserted
12 an affirmative defense contesting the validity of
13 respondent’s pleaded registration. Accordingly, since the
14 validity of respondent’s subject registration is at issue in
15 the civil action, a decision by the district court may have
16 a bearing on the issues in this proceeding.³

17 Accordingly, these proceedings are suspended pending
18 final disposition of the civil action between the parties,
19 including all appeals. Trademark Rule 2.117(a).

20 Within twenty days after the final determination of the
21 civil action, the interested party should notify the Board
22 so that this case may be called up for appropriate action.

23 ²Moreover, to the extent that a civil action in a Federal
24 district court involves issues in common with those in a Board
25 proceeding, the district court decision would be binding on the
26 Board, whereas the Board decision is merely advisory to the
27 district court. See *American Bakeries Co. v. Pan-O-Gold Baking*
28 *Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986). Further, Board decisions
are appealable to the district court. See Section 21 of the
Trademark Act, and *Goya Foods, Inc. v. Tropicana Products Inc.*,
846 F.2d 848, 6 USPQ2d 1950, at 1953 (2d Cir. 1988).

³The Board further notes that the decision by the district court
may also have a bearing on petitioner’s standing to bring this
action.

Lansky Decl. Ex. B (Doc. No. 166-3) at 2-3 (TTAB Suspension Order, June 7, 2011).

