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 5 PETROLIAM NASIONAL BERHAD (PETRONAS)

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UNITED STATES DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
 OAKLAND DIVISION

PETROLIAM NASIONAL BERHAD  
 (PETRONAS),  
 Plaintiff,  
 vs.  
 GODADDY.COM, INC.,  
 Defendant.

CASE NO: 09-CV-5939 PJH (MEJ)  
 Noticed Hearing Date: May, 16, 2012  
 Noticed Hearing Time: 9:00 a.m.

DECLARATION OF PERRY R. CLARK IN  
 SUPPORT OF PLAINTIFF'S REPLY  
 BRIEF ON ITS MOTION UNDER FED. R.  
 CIV. P. 54(D)(1) FOR THE COURT TO  
 REVIEW THE CLERK'S ACTION  
 TAXING COSTS

1 I, Perry Clark, declare:

2 1. I am an attorney admitted to practice law before this Court and the attorney for  
3 Plaintiff Petroliam Nasional Berhad (PETRONAS). I have personal knowledge of the  
4 facts set forth in this declaration.

5 2. Attached hereto as Exhibit 1 is a true and correct copy of an order from the United  
6 States Patent and Trademark Office Trademark Trial and Appeal Board dated June 7, 2011.

7 I declare under penalty of perjury that the foregoing is true and correct. Executed in Palo  
8 Alto, California on May 2, 2012.

9 By:           /s/ Perry Clark            
10 Perry Clark

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Ex. 1

(Order from the United States  
Patent and Trademark Office  
Trademark Trial and Appeal  
Board dated June 7, 2011)

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: June 7, 2011

Cancellation No. 92052714

GoDaddy.com, Inc.

v.

Petroliam Nasional Berhad

**George C. Pologeorgis,  
Interlocutory Attorney:**

By order dated May 25, 2011, the Board granted, in part, and denied, in part, petitioner's combined motion to compel discovery and test the sufficiency of responses to requests for admission filed on March 4, 2011. By the same order, the Board required the parties to submit copies of the pleadings in a civil action between the parties in the United States District Court for the Northern District of California, Oakland division.<sup>1</sup>

On May 26, 2011, petitioner filed copies of the pleadings in the civil action, as requested by the Board.

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<sup>1</sup> Case 4:09-cv-05939, styled *Petroliam Nasional Berhad v. GoDaddy.com, Inc.*, filed on or about September 29, 2010.

A review of the pleadings in the civil case indicates that a decision by the district court could be dispositive of, or have a bearing on, the issues in this proceeding.<sup>2</sup> Specifically, the Board notes that respondent (plaintiff in the civil action) has pleaded ownership of the subject registration herein and relies on its registration as a basis for its asserted claims. The Board additionally notes that petitioner (defendant in the civil action) has asserted an affirmative defense contesting the validity of respondent's pleaded registration. Accordingly, since the validity of respondent's subject registration is at issue in the civil action, a decision by the district court may have a bearing on the issues in this proceeding.<sup>3</sup>

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

Within **twenty days** after the final determination of the civil action, the interested party should notify the Board

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<sup>2</sup>Moreover, to the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court decision would be binding on the Board, whereas the Board decision is merely advisory to the district court. See *American Bakeries Co. v. Pan-O-Gold Baking 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).

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

Cancellation No. 92052714

so that this case may be called up for appropriate action. Upon resumption of these proceedings, if necessary and appropriate, the Board will set the time in which respondent must provide responses to the discovery requests compelled by the Board's May 25, 2011 order.

During the suspension period the Board should be notified of any address changes for the parties or their attorneys.