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14 Attorneys for Defendant
 GODADDY.COM, INC.

16 UNITED STATES DISTRICT COURT
 17 NORTHERN DISTRICT OF CALIFORNIA

18	PETROLIAM NASIONAL BERHAD,)	CASE NO: 09-CV-5939 PJH
19	Plaintiff,)	
20	vs.)	JOINT CASE MANAGEMENT
21	GODADDY.COM, INC.,)	STATEMENT
22	Defendant.)	
23)	
24)	

25 Plaintiff Petroliam Nasional Berhad (“Plaintiff” or “Petronas”) and Defendant
 26 GoDaddy.com, Inc. (“Defendant” or “GoDaddy”), pursuant to the Northern District’s Standing
 27 Order and the Court’s December 29, 2009 Order Setting Case Management Conference, jointly
 28 submit this Case Management Statement.

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1 INTRODUCTION

2 Plaintiff Petronas (short for Petroliam Nasional Berhad) is the national oil and gas
3 company of Malaysia and the record owner of a federal trademark registration for the mark
4 PETRONAS. Defendant GoDaddy is the world’s largest registrar of Internet domain names,
5 maintaining over 40 million domain names for customers around the world. GoDaddy is based
6 in Arizona.

7 In 2003 an individual with a London, England address -- Heiko Schoenekess -- registered
8 with GoDaddy the Internet domain name <petronastower.net>. Since that time Mr. Schoenekess
9 has apparently posted pornography at this Internet address.

10 Plaintiff maintains that the <petronastower.net> domain name is infringing and that the
11 pornography posted at this online address is offensive. Plaintiff is suing GoDaddy, the domain
12 name registrar, alleging that GoDaddy has acted with bad faith by allowing and maintaining the
13 <petronastower.net> domain name registration since 2003.

14 Defendant maintains that, as a matter of law, it is not responsible for the alleged
15 trademark infringement of Mr. Schoenekess or for the content posted at the <petronastower.net>
16 address. Defendant further maintains that Plaintiff is suing the wrong party (by suing GoDaddy
17 rather than Mr. Schoenekess) and that Plaintiff, if its allegations concerning the domain name are
18 true, should have brought an expedited domain name arbitration proceeding years ago.
19 According to Defendant, domain name arbitrations last only about 60 days from start to finish.

20 Plaintiff moved this Court for a temporary restraining order against GoDaddy in the days
21 just before Christmas. On December 23, 2009 the Court denied the motion in its entirety.

22 On January 29, 2010 Plaintiff filed a related lawsuit in the Northern District, pursuant to
23 the “in rem” provisions of the Lanham Act, against the same disputed domain name
24 (<petronastower.net>) as a defendant. See Case No. C10-00 431 EMC. Plaintiff now maintains
25 that it intends to dismiss this action once it secures entry of judgment in the related “in rem”
26 action.

27 1. Jurisdiction and Service: Plaintiff alleges subject matter jurisdiction under 28
28 U.S.C. §§ 1131 and 1338(b) insofar as its federal claims arise under the Lanham Act. Defendant

1 has answered the complaint, and elected not to file a Rule 12 motion with respect to either
2 personal jurisdiction or venue. No parties remain to be served.

3 2. Facts: In the Complaint Plaintiff asserts claims against Defendant for
4 cybersquatting and contributory cybersquatting, trademark infringement and contributory
5 trademark infringement, false designation of origin, dilution, and state statutory and common-
6 law trademark infringement. Defendant has filed an Answer denying the substantive allegations
7 in the Complaint and asserting various affirmative defenses. Defendant argues, in particular, that
8 domain name registrars are shielded from liability for damages and injunctive relief, pursuant to
9 statutory defenses in the Lanham Act and well-established Ninth Circuit case law.

10 The principal factual issues in dispute are:

- 11 • How long Plaintiff has been aware of the disputed domain name and/or the
12 content posted at that address;
- 13 • Whether Plaintiff has been vigilant as a trademark owner about monitoring
14 third-party violations and enforcing its trademark rights;
- 15 • Whether there has been any actual confusion arising from the registration
16 or use of the disputed domain name;
- 17 • Whether Internet users who visit the website at <petronastower.net> are
18 likely to be confused about the source of goods or services or content
19 promoted there, or about any appearance of sponsorship or endorsement
20 by Plaintiff;
- 21 • Whether Plaintiff's representations to the U.S. Patent and Trademark
22 Office concerning its PETRONAS mark were accurate; and
- 23 • Whether Defendant GoDaddy has had notice that the disputed domain
24 name is allegedly infringing, dilutive or otherwise illegal.

25 3. Legal Issues: The disputed points of law in this matter are:

- 26 • Whether and to what extent Plaintiff's federal trademark registration is
27 enforceable in the United States;

- 1 • Whether the disputed domain name is infringing or dilutive;
- 2 • Whether Defendant has acted with a bad faith intent to profit from
- 3 Plaintiff's trademark;
- 4 • Whether a domain name registrar is responsible for the infringement,
- 5 dilution or unfair competition of its registrant customers (See, e.g., 15
- 6 U.S.C. § 1114(2)(D); Lockheed Martin Corp. v. Network Solutions, Inc.,
- 7 194 F.3d 980 (9th Cir. 1999));
- 8 • Whether Plaintiff's claims are barred by the equitable doctrines of laches,
- 9 acquiescence, waiver and/or estoppel;
- 10 • Whether Plaintiff has suffered damage as a result of any act or omission
- 11 by Defendant;
- 12 • Whether Plaintiff is entitled to statutory damages;
- 13 • Whether this is an "exceptional case," pursuant to 15 U.S.C. § 1117(a),
- 14 entitling Defendant to an award of reasonable attorneys' fees; and
- 15 • Whether this is a frivolous action in violation of Fed. R. Civ. P. 11 and
- 16 entitling Defendant to an attorneys' fees award or other sanctions.

17 4. Motions: Plaintiff's motion for a temporary restraining order was denied on
18 December 23, 2009. Defendant is considering motions for judgment on the pleadings and for
19 sanctions pursuant to Rule 11, and, if necessary, will move at a later stage for summary
20 judgment.

21 5. Amendment of Pleadings: The parties propose that amendment of the pleadings,
22 if any, take place no later than April 25, 2010.

23 6. Evidence Preservation: Plaintiff has taken steps to preserve potentially relevant
24 evidence. Defendant has circulated an internal "litigation hold" memorandum concerning all
25 evidence related to this matter.

26 7. Disclosures: The parties have stipulated to exchange Initial Disclosures no later
27 than April 25, 2010.

1 8. Discovery: The parties have met and conferred concerning a proposed discovery
2 plan pursuant to Rule 26(f). There has been no discovery to date. The parties propose dates
3 below for key pretrial and trial deadlines. The parties do not propose any limitations or
4 modifications of the standard discovery rules.

5 9. Class Actions: This is not a class action.

6 10. Related Cases: Plaintiff's subsequent Northern District "in rem" Lanham Act
7 action (Case No. C10-00431 EMC) against the same disputed domain name is related to this
8 action. Plaintiff did not at the time of filing designate the "in rem" action as a "related case," and
9 accordingly the Court assigned the "in rem" action to Magistrate Judge Edward Chen. Plaintiff
10 has not filed any papers in the "in rem" action other than its January 29, 2010 complaint.

11 11. Relief: Plaintiff seeks statutory and other damages, an attorneys' fees award, and
12 injunctive relief, including an order mandating transfer of the disputed domain name to Plaintiff.
13 Defendant seeks dismissal of all claims in the Complaint as well as reimbursement for its
14 attorneys' fees, pursuant to the Lanham Act, Fed. R. Civ. P. 11 and 28 U.S.C. § 1927.

15 12. Settlement and ADR: Defendant has not been served with any orders or other
16 documents related to alternative dispute resolution (ADR) for this matter. Absent prompt
17 dismissal of this action, Defendant would consider participating in an early neutral evaluation
18 (ENE) process.

19 13. Consent to Magistrate Judge For All Purposes: The parties do not consent to
20 having a magistrate judge conduct all further proceedings.

21 14. Other References: The parties do not believe that this action is suitable for
22 reference to binding arbitration, a special master, or the Judicial Panel on Multidistrict Litigation.

23 15. Narrowing of Issues: The parties do not see a basis for narrowing issues by
24 agreement, motion or bifurcation.

25 16. Expedited Schedule: Insofar as Plaintiff is based in Malaysia, the registrant of the
26 disputed domain name is in England, and the alleged pornography appears to be originating in
27 Switzerland, there is likely to be considerable international discovery, and thus an expedited
28 schedule is unlikely to be appropriate for this action.

1 17. Scheduling: The parties’ proposed dates for designation of experts, discovery
2 cutoff, hearing of dispositive motions, pretrial conference and trial are set forth below:

3 Designation of experts: October 1, 2010

4 Discovery cutoff: November 15, 2010

5 Hearing of dispositive motions: January 31, 2011

6 Pretrial conference: March 31, 2011

7 Trial: April 11, 2011

8 18. Trial: This case will be tried to a jury, and the expected length of trial is four
9 days.

10 19. Disclosure of Non-party Interested Entities or Persons: The parties have each
11 filed a “Certification of Interested Entities or Persons” required by the Local Rules. Plaintiff
12 restates the content of its certification that the following persons, associations of persons, firms,
13 partnerships, corporations (including parent corporations), or other entities have either (i) a
14 financial interest in the subject matter in controversy or in a party to the proceeding; or (ii) any
15 other kind of interest that could be substantially affected by the outcome of the proceeding:

16 1. Petroliam Nasional Berhad (PETRONAS),

17 2. The Government of Malaysia.

18 Defendant restates the contents of its certification as follows:

19 “The following listed persons, associations of persons, firms, partnerships, corporations
20 (including parent corporations) or other entities (i) have a financial interest in the subject matter in
21 controversy or in a party to the proceeding, or (ii) have a non-financial interest in that subject
22 matter or in a party that could be substantially affected by the outcome of this proceeding: The Go
23 Daddy Group, Inc.”

1 Dated: March 18, 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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9 Dated: March 18, 2010

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

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By: /s/ John L. Slafsky.

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John L. Slafsky
David E. Kramer
Hollis Beth Hire

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Attorneys for Defendant
GODADDY.COM, INC.

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SIGNATURE ATTESTATION

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I, John L. Slafsky, hereby attest that all signatories to this document have consented to the e-filing of this document.

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Dated: March 18, 2010

By: /s/ John L. Slafsky
John L. Slafsky

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