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 GODADDY.COM, INC.  
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16 UNITED STATES DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
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18	PETROLIAM NASIONAL BERHAD,	)	CASE NO: 09-CV-5939 PJH
19	Plaintiff,	)	
20	vs.	)	<b>SECOND JOINT CASE</b>
21	GODADDY.COM, INC.,	)	<b>MANAGEMENT STATEMENT</b>
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 June 15, 2010 Order, jointly submit this Second Case Management  
 28 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 AND DESIGN. Defendant GoDaddy is the world’s largest registrar of Internet  
5 domain names, maintaining over 40 million domain names for customers around the world.  
6 GoDaddy is based in Arizona.

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

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, so-called UDRP domain name arbitrations last only about 60 days from  
20 start to finish, with trademark owners winning the arbitrations approximately 85% of the time.

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

23 On January 29, 2010 Plaintiff filed a related lawsuit in the Northern District, pursuant to  
24 the “in rem” provisions of the Lanham Act, against the same disputed domain name  
25 (<petronastower.net>) as a defendant. See Case No. C10-00 431 EMC. As a result, the Court  
26 transferred ownership of the disputed domain name to Petronas on May 13, 2010.

27 The parties’ March 18, 2010 Joint Case Management Statement stated that “Plaintiff now  
28 maintains that it intends to dismiss this action once it secures entry of judgment in the related ‘in

1 rem' action." Plaintiff's counsel earlier stated that "Given GoDaddy's willingness to promptly  
2 provide the required certification and cooperate in the expeditious resolution of the [in rem  
3 action], we expect that the in rem action . . . will be resolved shortly, and if so, that the  
4 Petronas/GoDaddy case can be dismissed before [GoDaddy's Answer deadline]." Plaintiff has  
5 since changed its position in this regard. After the conclusion of the "in rem" action, Plaintiff  
6 discovered a site using the domain name "PETRONASTOWERS.NET" which mirrors the  
7 content of the site using the "PETRONASTOWER.NET" domain name prior to its transfer to  
8 Plaintiff. As it did with respect to the "PETRONASTOWER.NET" domain name, Plaintiff  
9 submitted a "Request for Trademark Claim" pursuant to Defendant's "Trademark and/or  
10 Copyright Infringement Policy" informing Defendant of Plaintiff's trademark rights with respect  
11 to the "PETRONASTOWERS.NET" domain name, requesting that the domain name be  
12 disabled, and providing all of the information required by Defendant's "Trademark and/or  
13 Copyright Infringement Policy." Defendant responded by stating that it "can only process claims  
14 of trademark infringement against the content of websites that we host" and that it does not host  
15 the website that uses the "PETRONASTOWERS.NET" domain name. Defendant indicated that  
16 it would not become involved in Plaintiff's request that the domain name be disabled and that  
17 "[a]ny disputes over the ownership or wording of the domain name itself will need to be sent  
18 either to the owner, or through an arbitration forum, or the local court system." On July 12,  
19 2010, Plaintiff filed an "in rem" action in the Northern District of California under the Lanham  
20 Act seeking to have the "PETRONASTOWERS.NET" domain name transferred to Plaintiff.

21 1. Jurisdiction and Service: Plaintiff alleges subject matter jurisdiction under 28  
22 U.S.C. §§ 1131 and 1338(b) insofar as its federal claims arise under the Lanham Act. Defendant  
23 has answered the complaint, and elected not to file a Rule 12 motion with respect to either  
24 personal jurisdiction or venue. No parties remain to be served.

25 2. Facts: In the Complaint Plaintiff asserts claims against Defendant for  
26 cybersquatting and contributory cybersquatting, trademark infringement and contributory  
27 trademark infringement, false designation of origin, dilution, and state statutory and common-  
28 law trademark infringement. Defendant has filed an Answer denying the substantive allegations

1 in the Complaint and asserting various affirmative defenses. Defendant argues, in particular, that  
2 domain name registrars are shielded from liability for damages and injunctive relief, pursuant to  
3 statutory defenses in the Lanham Act and well-established Ninth Circuit case law.

4 The principal factual issues in dispute are:

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

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

- 20 • Whether and to what extent Plaintiff's federal trademark registration is  
21 enforceable in the United States;
- 22 • Whether the disputed domain name is infringing or dilutive;
- 23 • Whether Defendant has acted with a bad faith intent to profit from  
24 Plaintiff's trademark;
- 25 • Whether a domain name registrar is responsible for the infringement,  
26 dilution or unfair competition of its registrant customers (See, e.g., 15  
27 U.S.C. § 1114(2)(D); Lockheed Martin Corp. v. Network Solutions, Inc.,  
28 194 F.3d 980 (9th Cir. 1999);

- 1 • Whether Plaintiff's claims are barred by the equitable doctrines of laches,  
2 acquiescence, waiver and/or estoppel;
- 3 • Whether Plaintiff has suffered damage as a result of any act or omission  
4 by Defendant;
- 5 • Whether Plaintiff is entitled to statutory damages;
- 6 • Whether this is an "exceptional case," pursuant to 15 U.S.C. § 1117(a),  
7 entitling Defendant or Plaintiff to an award of reasonable attorneys' fees;  
8 and
- 9 • Whether this is a frivolous action in violation of Fed. R. Civ. P. 11 and  
10 entitling Defendant to an attorneys' fees award or other sanctions.

11 4. Motions: Plaintiff's motion for a temporary restraining order was denied on  
12 December 23, 2009. Defendant intends to file a motion for judgment on the pleadings and to  
13 seek reimbursement for its attorney fees pursuant to, *inter alia*, 15 U.S.C. § 1117(a). Defendant  
14 is also considering a motion for sanctions pursuant to Rule 11. Defendant, if necessary, will  
15 move at a later stage for summary judgment.

16 Plaintiff intends to file a motion to dismiss and/or strike Defendant's Sixth Affirmative  
17 Defense of "misrepresentation of material facts."

18 5. Amendment of Pleadings: Defendant requests that the deadline for the parties to  
19 amend their pleadings be August 29, 2010. Plaintiff opposes this request on the grounds that the  
20 parties previously agreed that the deadline for the parties to amend their pleading be April 25,  
21 2010 and the parties jointly proposed this deadline to the Court in the March 18, 2010 Case  
22 Management Conference statement.

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 will exchange Initial Disclosures on July 15, 2010.

27 8. Discovery: The parties have met and conferred concerning a proposed discovery  
28 plan pursuant to Rule 26(f). There has been no discovery to date. The parties propose dates

1 below for key pretrial and trial deadlines. The parties do not propose any limitations or  
2 modifications of the standard discovery rules.

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

4 10. Related Cases: Plaintiff's Northern District "in rem" Lanham Act action (Case  
5 No. C10-00431 EMC) against the same disputed domain name is related to this action and has  
6 been consolidated herein. That action is completed. On July 12, 2010, Plaintiff filed an "in  
7 rem" action (10-CV-03052) against the domain name "PETRONASTOWERS.NET" and  
8 Plaintiff will move to have that action related to this action.

9 Defendant has petitioned the U.S. Patent and Trademark Office (USPTO) to cancel  
10 Plaintiff's trademark registration for PETRONAS AND DESIGN, alleging misrepresentations in  
11 the application as well as partial or complete abandonment of the registered trademark. The  
12 USPTO cancellation proceeding is pending.

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

17 12. Settlement and ADR: Defendant has not been served with any orders or other  
18 documents related to alternative dispute resolution (ADR) for this matter.

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: February 1, 2011

4                   Discovery cutoff: March 15, 2011

5                   Hearing of dispositive motions: May 25, 2011

6                   Pretrial conference: July 28, 2011

7                   Trial: August 8, 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.”

24           ///

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1 Dated: July 14, 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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7 Dated: July 14, 2010

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Professional Corporation

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By: /s/ John L. Slafsky.

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

21

22 Dated: July 14, 2010

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

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