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 PETROLIAM NASIONAL BERHAD (“PETRONAS”)
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8 UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 9 OAKLAND DIVISION
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11	PETROLIAM NASIONAL BERHAD)	Case No.: C09-5939 PJH (JCS)
	(“PETRONAS”))	
12	Plaintiff,)	FIRST AMENDED COMPLAINT
)	
13	vs.)	JURY TRIAL DEMANDED
)	
14	GO DADDY.COM, INC.,)	
	Defendant.)	
15)	
)	
16)	

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 FIRST AMENDED COMPLAINT
 Case No.: C09-5939 PJH (JCS)

1 Plaintiff Petroliam Nasional Berhad (“Petronas” or “plaintiff”) for its first amended
2 complaint alleges as follows against defendant GoDaddy.com, Inc. (“GoDaddy”):

3 **THE PARTIES**

4 1. Plaintiff Petronas is a corporation duly organized under the laws of Malaysia
5 with a principal place of business located at Tower 1, Petronas Twin Towers, Kuala Lumpur
6 City Center, 50088 Kuala Lumpur, Malaysia.

7 2. Upon information and belief, defendant GoDaddy is an Arizona corporation with
8 a principal place of business at 14455 N. Hayden Rd., Suite 219, Scottsdale, Arizona, 85260.

9 **JURISDICTION AND VENUE**

10 3. This case arises under the Lanham Act, 15 U.S.C. §§ 1051, *et seq.* There is also
11 diversity of citizenship between the parties and there is at least \$75,000 in controversy. As
12 such, the Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§
13 1331, 1332, and 1338(a) and (b) as well as under the principles of pendant jurisdiction. The
14 Court also has supplemental jurisdiction under 28 U.S.C. § 1367.

15 4. Venue is proper in this Court pursuant to 28 U.S.C. § 1391 (b) and (c).

16 5. This Court has jurisdiction over GoDaddy because of, at least, GoDaddy’s
17 contacts with this forum as well as its appearance and participation in this action.

18 **INTRADISTRICT ASSIGNMENT**

19 6. Although this is an intellectual property case and, as a result, there is no basis for
20 assignment to any particular division pursuant to Civil L.R. 3-2(c), this case has been assigned
21 to Hon. Phyllis J. Hamilton.

22 **FACTUAL ALLEGATIONS**

23 7. Plaintiff is a fully-integrated oil and gas corporation and was ranked in 2008
24 among Fortune’s Global 500 largest corporations in the world. Plaintiff’s business, and the

1 businesses of companies within its group, includes the full spectrum of oil and gas operations in
2 the areas of upstream oil and gas exploration and production, downstream oil refining,
3 marketing and distribution of petroleum products and fertilizer, trading, gas processing and
4 liquefaction, gas transmission pipeline network operations, marketing of liquefied natural gas,
5 petrochemical manufacturing and marketing, shipping, and property investment.

6 8. Plaintiff has operations in more than thirty-three (33) countries worldwide and
7 employs approximately 16,000 people.

8 9. The Petronas Twin Towers house plaintiff's headquarters and are one of the most
9 well-known landmarks in Asia. The Petronas Twin Towers are extremely closely identified
10 with plaintiff. The Petronas Twin Towers attract visitors from Malaysia and the rest of the
11 world for commercial, cultural, and other purposes.

12 10. Plaintiff's sole and official website is "www.petronas.com.my." Plaintiff also
13 owns "www.petronastwintowers.com.my," "www.petronas.com," "www.petronas.org,"
14 "www.petronas.my," and "www.petronastwintowers.com."

15 11. Plaintiff's official website "www.petronas.com.my" is a widely viewed
16 manifestation of plaintiff's brand and corporate identity. Among other things, plaintiff uses its
17 official website to project a corporate image that reflects the values of the employees,
18 management, and shareholders of plaintiff, including the people of Malaysia who, through the
19 Government of Malaysia, own a stake in the company. Plaintiff also uses its official website to
20 provide news and information about its business, to communicate with customers, potential
21 customers, and employees, to recruit and hire employees for its locations around the world, to
22 advertise its products, and to promote its brand.

23 12. Plaintiff uses the "petronastwintowers.com.my" domain name for the official
24 website of the Petronas Twin Towers and uses "petronastwintowers.com" to redirect to

1 “petronastwintowers.com.my.” The “petronastwintowers.com.my” website is intended to
2 provide information to as many people as possible about the Petronas Twin Towers.

3 13. Plaintiff owns all right, title, and interest in U.S. Trademark No. 2969707 for
4 “PETRONAS.”

5 14. Plaintiff has never authorized the use of the PETRONAS mark in connection
6 with the “petronastower.net” or “petronastowers.net” domain names or the pornographic
7 websites to which GoDaddy used those domain names to direct Internet users.

8 **TECHNICAL OVERVIEW OF THE DOMAIN NAME SYSTEM**

9 15. The Internet Corporation for Assigned Names and Numbers (“ICANN”) is a
10 non-profit corporation involved in the administration of the “Domain Name System.” The
11 Domain Name System relates to the use of domain names, such as “www.cand.uscourts.gov,” to
12 allow computers to interact over the internet.

13 16. ICANN has entered into a “Registry Agreement” with VeriSign, Inc. to promote
14 and facilitate the security and stability of the Internet and the Domain Name System. Under the
15 Registry Agreement, VeriSign is the sole “Registry Operator” for domain names ending in
16 “.com.” VeriSign and ICANN entered into a similar agreement for domain names ending in
17 “.net.”

18 17. As a Registry Operator, VeriSign maintains a database of registered domain
19 names that end in “.net” and the Internet Protocol addresses for the specific Name Servers that
20 correspond to each domain name. VeriSign constantly propagates information from this
21 database to thousands of computers connected to the internet around the world. When an
22 internet user types a “.net” domain name into an Internet browser, the browser submits a query
23 over the Internet that ultimately reaches a computer containing the record from the VeriSign
24 database that contains the Internet Protocol addresses for the Name Server corresponding to the

1 domain name. Using the Name Server's Internet Protocol address, the Internet browser can
2 connect to the Name Server. The Name Server can provide the Internet browser with access to
3 the data, files, information, services, or applications that the operator of the Name Server has
4 designated as corresponding to the domain name. These can include files needed for the
5 Internet browser to display a Web page, connections to an email service for the exchange of
6 email, or applications for credit card processing, bank transactions, or internet telephony.
7 (*VeriSign Registry Glossary*, www.verisign.com/domain-name-services/domain-information;
8 *The Domain Name Industry Brief*, VeriSign, Inc., 2008).

9 18. VeriSign receives data identifying registered domain names and the Internet
10 Protocol addresses of the corresponding Name Servers from Registrars. Registrars must enter
11 into a "Registrar Accreditation Agreement" with ICANN in order to submit data identifying
12 registered domain names and the Internet Protocol addresses of the corresponding "Name
13 Servers" to a Registry Operator.

14 **GODADDY'S SERVICES**

15 19. On information and belief, GoDaddy entered into a "Registrar Accreditation
16 Agreement."

17 20. Under the "Registrar Accreditation Agreement," GoDaddy is required to perform
18 "Registrar Services" which are defined as "contracting with Registered Name Holders,
19 collecting registration information about the Registered Name Holders, and submitting
20 registration information for entry in the registry database." Registered Name Holders (or
21 "registrants") are the owners of registered domain names and are the entities that may authorize
22 changes to the domain name information in the registry database, including the Internet Protocol
23 address of the Name Servers corresponding to a registered domain name.

1 21. Section 3 of the “Registrar Accreditation Agreement” sets forth the “Registrar
2 Obligations” under the agreement. Section 3.1 requires GoDaddy to act as a registrar as
3 required under the agreement.

4 22. Section 3.2 requires GoDaddy to submit to the Registry Operator the registered
5 domain name, the Internet Protocol address of two Name Servers corresponding to the domain
6 name, and the names of the corresponding “Name Servers.”

7 23. Section 3.3 requires GoDaddy to allow public access to the domain name
8 information it has submitted to the Registry Operator through a “Whois” service available over
9 the Internet.

10 24. Sections 3.4 and 3.5 require GoDaddy to retain domain name information under
11 certain conditions.

12 25. Section 3.7 requires that GoDaddy abide by applicable laws and governmental
13 regulations as a Registrar. GoDaddy also must enter into an agreement with each registrant that
14 allows GoDaddy to suspend, cancel, or transfer any domain name for the resolution of disputes
15 concerning the domain name.

16 26. Nothing in GoDaddy’s agreement with ICANN requires that GoDaddy provide a
17 Name Server to its domain name registrants or provide domain name forwarding services.

18 27. Usually, when a registrant registers a domain name with GoDaddy, GoDaddy
19 identifies its “parked nameservers” as the corresponding Name Servers for the domain name
20 and submits this information to the Registry Operator. These servers display a temporary page
21 in response to queries from Internet browsers. When a registrant determines that it wants to use
22 a specific web hosting provider, GoDaddy instructs the registrant to direct GoDaddy to change
23 the domain name’s Name Servers to the web hosting provider’s Name Servers. “Setting
24

1 Nameservers for Your Domain Names,” <http://help.godaddy.com/article/664>; “How Do
2 Domain Names Work?,” http://help.godaddy.com/article/327?prog_id=GoDaddy.

3 28. In addition to registration services, GoDaddy allows users to purchase a “hosting
4 account” which allows users who registered their domain name with GoDaddy or another
5 company to use GoDaddy’s domain name servers and to list GoDaddy’s name servers as the
6 Name Servers corresponding to a domain name. “Setting Nameservers for Your Domain
7 Names,” <http://help.godaddy.com/article/664>; “How Do Domain Names Work?,”
8 http://help.godaddy.com/article/327?prog_id=GoDaddy.

9 29. GoDaddy allows registrants who use its Name Servers for their domain names to
10 use GoDaddy’s “Domain Name Forwarding” service. This services allows GoDaddy customers
11 to “automatically direct their domain name’s visitor to a different website.” GoDaddy
12 customers may also use “Masking,” which “prevents visitors from seeing your domain name
13 forwarding by keeping your domain name in the Web browser’s address bar.” GoDaddy only
14 requires that “to forward or mask your domain name, you must use our name servers.”
15 “Forwarding or Masking Your Domain Name,
16 http://help.godaddy.com/article/422?prog_id=godaddy; “Updating Your Domain Name’s IP
17 Address for Forwarding,” <http://help.godaddy.com/article/5289>; “What Is DNS?,”
18 <http://help.godaddy.com/topic/833/article/655>; “Glossary of Technical Terms,”
19 <http://help.godaddy.com/article/4498>; “Registering Your Own Nameservers/Hosts,”
20 <http://help.godaddy.com/topic/833/article/668>.

21 30. On information and belief, GoDaddy provides its “domain name forwarding”
22 service to registrants who registered their domain names with registrars other than GoDaddy.
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1 31. On information and belief, GoDaddy entered into a “Domain Name Registration
2 Agreement” with the registrant of the “petronastower.net” and “petronastowers.net” domain
3 names.

4 32. The “Domain Name Registration Agreement” is between GoDaddy and the
5 registrant and binds GoDaddy and the registrant to GoDaddy’s “Dispute Policy” and the
6 “ICANN Transfer Dispute Resolution Policy.” The “Domain Name Registration Agreement”
7 allows GoDaddy to subject a registrant’s domain name to “suspension, cancellation or transfer .
8 . . pursuant to any GoDaddy policy . . . for the resolution of disputes concerning any domain
9 name.”

10 33. Under GoDaddy’s “ICANN Transfer Dispute Resolution Policy,” GoDaddy may
11 “cancel, transfer, or otherwise make changes to a domain name registration in accordance with
12 the terms of your registration agreement.”

13 34. GoDaddy also has promulgated a “Trademark and/or Copyright Infringement
14 Policy” which has been in effect at all relevant times. According to this policy, “GoDaddy.com,
15 Inc. supports the protection of intellectual property. Whether you are the holder of a trademark,
16 service mark, or copyright, GoDaddy is committed to helping you protect your legal rights.
17 Therefore, we have established the following policies for considering trademark and/or
18 copyright claims.” This policy sets forth a specific procedure “to notify GoDaddy that there has
19 been a copyright or trademark violation,” which includes submitting a “notification of
20 trademark violation” containing specific information identified by GoDaddy to a specific email
21 address. According to the policy, “upon receipt of the appropriate identification [identified in
22 the policy], for trademark claims, GoDaddy will institute an investigation. While GoDaddy is
23 investigating the claim, GoDaddy, in its sole discretion and with no legal obligation to do so,
24 may temporarily remove the challenged material from the GoDaddy Marketplace or from

1 GoDaddy Auctions, notify the posting party it will lock down the posting party's domain
2 name(s), redirect the posting party's DNS, and/or if it is solely stored on a GoDaddy server,
3 temporarily remove or deny access to the challenged material." The policy also allows
4 GoDaddy to make the foregoing actions permanent. The policy also provides for a "counter
5 notification" whereby a GoDaddy customer who receives a trademark infringement notice may
6 have the foregoing restrictions lifted.

7 **THE ANTICYBERSQUATTING CONSUMER PROTECTION ACT ("ACPA")**

8 35. The Anticybersquatting Consumer Protection Act ("ACPA") of 1999 amended
9 the Trademark Act of 1946 (15 U.S.C. § 1125(d)) and provides civil liability against any person
10 who with "bad faith" "registers, traffics in, or uses a domain name" that is a protected
11 trademark, is "confusingly similar" to distinctive mark, or is "confusingly similar to or dilutive"
12 of a famous mark. The ACPA also allows the owner of mark to file an *in rem* action against a
13 domain name that infringes its trademark rights under the ACPA if the registrant cannot be
14 located despite the due diligence of the trademark owner. (15 U.S.C. § 112(d)(2)).

15 36. Congress passed the ACPA to "protect consumers from fraud, protect the value
16 of countless trademarks, and encourage continued growth in our electronics industry." (Cong.
17 Record 106th Cong., Senate – June 21, 1999)). Congress also intended that the ACPA would
18 stop "people [from] extorting companies by registering company names, misdirecting internet
19 users to inappropriate sites, or otherwise attempting to damage a trademark that a business has
20 spent decades building into a recognizable brand." The ACPA was also intended to stop
21 "cybersquatters [who] often register well-known marks to prey on consumer confusion by
22 misusing the domain name to divert customers from the mark owner's site to the cybersquatter's
23 own site, many of which are pornography sites that derive advertising revenue based on the
24

1 number of visits, or ‘hits,’ the site receives.” (Committee Reports, 106th Cong., Senate Reports
2 106-140)).

3 37. In addition to the direct harms of cybersquatting, the ACPA was intended to
4 address the problem that “trademark holders are battling thousands of cases of cybersquatting
5 each year, the vast majority of which cannot be resolved through the dispute resolution policy
6 set up by Internet domain name registries.” (Committee Reports, 106th Cong., Senate Reports
7 106-140). Congress recognized the “ongoing efforts of the WIPO [World Intellectual Property
8 Association] and ICANN to build a consensus global mechanism for resolving online trademark
9 disputes” and intended that the ACPA would “build upon this progress and provide constructive
10 guidance to trademark holders, domain name registrars and registries, and Internet users
11 registering domain names.” (Cong. Rec., 106th Cong., Senate-August 05, 1999).

12 38. Congress intended the ACPA to “encourage domain name registrars and
13 registries to work with trademark owners to prevent cybersquatting by providing a limited
14 exemption from monetary damages for domain name registrars and registries that suspend,
15 cancel, or transfer domain names pursuant to a court order or in the implementation of a
16 reasonable policy prohibiting the registration of infringing domain names.” (Committee
17 Reports, 106th Cong., Senate Reports 106-140).

18 39. The ACPA was also intended to “promote the continued ease and efficiency
19 users of the current registration system enjoy by codifying current case law limiting the
20 secondary liability of domain name registrars and registries for the act of registration of a
21 domain name.” (Committee Reports, 106th Cong., Senate Reports 106-140). Congress
22 identified the “current case law” as “*Panavision Int’l. v. Toeppen*, 1316, 1319 (9th Cir. 1998)
23 (holding that NSI is not responsible for making ‘a determination about registrant’s right to use a
24 domain name.’); *Lockheed Martin Corporation v. Network Solutions, Inc.*, 985 F. Supp. 949

1 (C.D. Cal. 1997) (holding registrar not liable); *Academy of Motion Picture Arts and Science v.*
2 *Network Solutions, Inc.*, 989 F. Supp. 1276 (C.D. Cal. 1997) (holding that holder of registered
3 trademarks could not obtain a preliminary injunction against domain name registrar).”

4 40. Congress included a “savings clause” in the ACPA providing that “the civil
5 action established under paragraph (1) and the *in rem* action established under paragraph (2),
6 and any remedy available under either such action, shall be in addition to any other civil action
7 or remedy otherwise applicable.” (15 U.S.C.A § 1125(d)(3)).

8
9 **CYBERSQUATTING ON “PETRONASTOWER.NET” AND**
“PETRONASTOWERS.NET”

10 41. On or about November 26, 2009, plaintiff learned that a person or persons
11 unknown to plaintiff had registered the domain name “petronastower.net” without plaintiff’s
12 consent. The website affiliated with the “petronastower.net” domain name, found at
13 “petronastower.net” contained highly offensive, obscene, and pornographic material.

14 42. On or about November 26, 209, plaintiff learned that the domain name
15 “petronastower.net” was registered with Defendant, GoDaddy.

16 43. The “petronastower.net” domain name was transferred by the registrant to
17 GoDaddy from another registrar on or about April 1, 2007. As such GoDaddy was listed as the
18 registrar for the “petronastower.net” domain name beginning on or about April 1, 2007.

19 44. Two years later, on May 2, 2009, the registrant used GoDaddy’s online
20 “dashboard” to instruct GoDaddy to use its Name Servers to provide its “domain name
21 forwarding” service to direct anyone clicking on “petronastower.net” to be forwarded to a
22 website containing highly offensive, obscene pornography. In order to implement GoDaddy’s
23 “domain name forwarding” service, the registrant was required to use GoDaddy’s Name Servers

1 and to instruct GoDaddy to associate GoDaddy's Name Servers with the "petronastower.net"
2 domain name in the VeriSign domain name registry.

3 45. Beginning on or about November 26, 2009, plaintiff contacted GoDaddy
4 repeatedly to inform it of the unauthorized use of the PETRONAS mark in connection with the
5 "petronastower.net" domain name and to inform it that highly offensive, obscene, and
6 pornographic material was being displayed on the website associated with the
7 "petronastower.net" domain name. Plaintiff also requested that GoDaddy investigate and take
8 action against the website associated with the "petronastower.net" domain name.

9 46. On or about December 1, 2009, GoDaddy's "Spam and Abuse Department"
10 responded to plaintiff stating that "GoDaddy does not allow illegal content on our customer's
11 websites. However, as a hosting provider, it is not our place to determine if the site you have
12 mentioned is actually engaging in illegal activities." GoDaddy also stated that "any dispute
13 over the wording or ownership of the domain name itself will need to be sent to either the
14 registrant, through an arbitration forum such as <http://wipo.int/> [the World Intellectual Property
15 Organization] or the local court system. Per ICANN regulations, domain registrars are
16 prohibited from becoming involved in domain name ownership disputes." As such, GoDaddy
17 refused to take any action with respect to the "petronastower.net" domain name or the
18 associated website that was accessible through GoDaddy's Name Servers.

19 47. On December 14, 2009 plaintiff contacted GoDaddy via telephone to inform it
20 that the "petronastower.net" domain name and the associated website remained active, and
21 requested that the "petronastower.net" domain name and website be disabled. GoDaddy stated
22 that it did not respond to allegations of trademark infringement unless they were submitted in
23 writing according to GoDaddy's "Trademark and/or Copyright Infringement Policy."
24

1 48. On December 16, 2009, plaintiff again contacted GoDaddy and provided the
2 formal, written “Notice of Trademark Infringement” on the form required by GoDaddy’s
3 “Trademark and/or Copyright Infringement Policy” and to again request that the
4 “petronastower.net” website be disabled.

5 49. On December 16, 2009 GoDaddy responded to plaintiff indicating that it would
6 not take any action regarding “petronastower.net.” GoDaddy stated that “any issues regarding
7 the content of the website will need to be addressed to the owner of the site either directly, or to
8 the hosting provider.” GoDaddy further stated that “we can only process claims of trademark
9 infringement against the content of websites that we host. ICANN, the managing body of
10 internet, domain name registrars, specifically prohibits domain registrars from getting involved
11 in disputes over domain ownership in the Uniform Domain Name Dispute Resolution Policy.
12 Any disputes over the ownership or wording of the domain name itself will need to be sent to
13 either the registrant, through an arbitration forum, or the local court system.”

14 50. On December 16, 2009, plaintiff sent an email to the registrant of
15 “petronastower.net” at the email listed for the registrant in GoDaddy’s records and requested
16 that it cease and desist using the “petronastower.net” domain name. Plaintiff also attempted to
17 contact the registrant at the telephone number listed in GoDaddy’s records but the listed number
18 only connected to an automated and incoherent message.

19 51. On December 18, 2009, plaintiff moved for a temporary restraining order
20 requiring GoDaddy to remove from registration, remove from its servers, and otherwise disable
21 public access to, the website “petronastower.net.” The motion was supported by declarations of
22 plaintiff’s counsel and one of plaintiff’s employees as well as a memorandum in support.
23 GoDaddy opposed the motion and filed a declaration from its counsel as well as one of its
24 employees in addition to its memorandum in opposition. The motion was heard and denied on

1 December 23, 2009. All of the moving and responding papers, declarations in support, oral
2 argument, and orders of the court regarding plaintiff's motion for temporary restraining order
3 are incorporated as if set forth fully herein. Plaintiff sent all of the temporary restraining order
4 papers to registrant by Federal Express.

5 52. On January 29, 2010, plaintiff filed an *In Rem* Complaint for Violation of 15
6 U.S.C. § 1125(d) (Cyberpiracy) against "petronastower.net." The case was assigned case
7 number C10-00431. On February 8, 2010, GoDaddy received written notification of a filed,
8 stamped copy of the complaint in case number C10-00431. On March 25, 2010, plaintiff made
9 a motion for an order transferring to it the "petronastower.net" domain name and included in
10 support of the motion the registrar certificate supplied by GoDaddy. On May 13, 2010, the
11 Court granted the motion after the time for filing an opposition had passed and issued an order
12 directing GoDaddy to transfer the "petronastower.net" domain name within ten days. All of the
13 moving papers, declarations in support, and orders of the court regarding plaintiff's motion to
14 transfer the domain name in case number C10-00431 are incorporated as if set forth fully
15 herein. Plaintiff sent all of the *In Rem* papers to registrant by Federal Express.

16 53. In addition to the "petronastower.net" domain name, plaintiff learned that
17 GoDaddy was the registrar for the domain name "petronastowers.net." The
18 "petronastowers.net" domain name provided access to the same pornographic website as the
19 "petronastower.net" domain name. According to GoDaddy's records, GoDaddy was the
20 registrar of the "petronastowers.net" domain name and the "petronastowers.net" domain name
21 was registered by same the registrant as the "petronastower.net" domain name.

22 54. On July 7, 2010, plaintiff submitted a "Request for Trademark Claims" pursuant
23 to GoDaddy's policies. On July 8, 2010, GoDaddy responded that "although the domain
24 PETRONASTOWERS.NET is registered through our company, the domain is forwarding to a

1 website (camfunchat.com) that is hosted elsewhere. Any issues regarding the content of the
2 website will need to be addressed to the owner of the site either directly, or to the hosting
3 provider. We can only process claims of trademark infringement against the content of
4 websites that we host. ICANN, the managing body of internet, domain name registrars,
5 specifically prohibits domain registrars from becoming involved in disputes over domain
6 ownership in their Uniform Domain Name Dispute Resolution Policy. Any disputes over the
7 ownership or wording of the domain name itself will need to be sent either to the owner, or
8 through an arbitration forum, or the local court system.”

9 55. On July 12, 2010, plaintiff filed an *In Rem* Complaint for Violation of 15 U.S.C.
10 § 1125(d) (Cyberpiracy) against “petronastowers.net,” case number C10-3052. On July 14,
11 2010, GoDaddy provided the required “Registrar Certificate.” On August 27, 2010, the Court
12 issued an order directing GoDaddy to transfer the “petronastowers.net” domain name to
13 plaintiff after the registrant failed to oppose plaintiff’s motion for an order transferring the
14 domain name. All of the moving papers, declarations in support, and orders of the court
15 regarding plaintiff’s motion to transfer the domain name in case number C10-03052 are
16 incorporated as if set forth fully herein. Plaintiff sent all of the second *In Rem* action papers to
17 registrant by Federal Express.

18 56. GoDaddy transferred the “petronastower.net” domain name to plaintiff on May
19 18, 2010 and the “petronastowers.net” domain name on August 30, 2010.

20 57. GoDaddy does not occupy the neutral position of a registrar and is not working
21 with trademark owners to prevent cyber-squatting.

22 58. As of the filing of the Original Complaint in this action, GoDaddy had not taken
23 any steps to remove or otherwise disable the connection and affiliation between the
24 “petronastower.net” and “petronastowers.net” domain names and the pornographic website.

1 **COUNT ONE**

2 **CYBERSQUATTING—15 U.S.C. § 1125(D)**

3 59. Plaintiff realleges and incorporates by reference each of the allegations contained
4 in Paragraphs 1 through 58 of this Complaint as though fully set forth herein.

5 60. Plaintiff is the owner of and has full right, title, and interest in U.S. Trademark
6 No. 2969707 for “PETRONAS.”

7 61. Plaintiff has used the “PETRONAS” mark continually since at least 2005.

8 62. The “PETRONAS” mark was distinctive, famous, and federally registered at all
9 relevant times.

10 63. The registrant of the “petronastower.net” and “petronastowers.net” domain
11 names licensed, impliedly or otherwise, GoDaddy’s use of the “petronastower.net” and
12 “petronastowers.net” domain names, including GoDaddy’s use of the “petronastower.net” and
13 “petronastowers.net” domain names in conjunction with its Name Servers to forward, direct,
14 and/or connect Internet users to a pornographic website.

15 64. Upon information and belief, beginning on or before December 18, 2009,
16 GoDaddy used the “petronastower.net” and “petronastowers.net” domain names as described
17 above with knowledge of plaintiff’s rights in the PETRONAS mark and with knowledge of
18 plaintiff’s use of the PETRONAS mark as an integral part of its internet presence and its
19 associated domain names.

20 65. By continuing to use the “petronastower.net” and “petronastowers.net” domain
21 names with knowledge of the forgoing, GoDaddy, upon information and belief, intended to
22 divert consumers to a pornographic website that could and did harm the goodwill represented by
23 plaintiff’s PETRONAS mark by, at least, confusing consumers as to whether plaintiff was the
24 source of or affiliated with the site.

1 66. As part of GoDaddy’s agreement with the registrant of “petronastower.net” and
2 “petronastowers.net” as well as its “Trademark and/or Copyright Infringement Policy” and
3 other policies and agreements (including those referenced herein), GoDaddy could have ceased
4 the foregoing use of the “petronastower.net” and “petronastowers.net” domain names at its
5 discretion and without breaching any agreement or policy or incurring any liability to the
6 registrant or any other party.

7 67. Under the ICANN agreements and policies, GoDaddy was permitted to
8 unilaterally and in its sole discretion cease the foregoing use of the “petronastower.net” and
9 “petronastowers.net” domain names without breaching those agreements or incurring any
10 liability to the registrant or any other party.

11 68. GoDaddy would have fallen within the ACPA’s “safe harbor” (15 U.S.C. §
12 1114(d)) for registrars and would have been shielded from liability under the ACPA if it had
13 removed from registration, transferred to plaintiff, temporarily disabled, or permanently
14 cancelled the “petronastower.net” and “petronastowers.net” domain names at plaintiff’s request
15 and pursuant to GoDaddy’s “Trademark and/or Copyright Infringement Policy.”

16 69. Upon information and belief, GoDaddy did not charge the registrant a fee for its
17 domain name forwarding service or for GoDaddy’s use of the “petronastower.net” and
18 “petronastowers.net” domain names in addition to or separately from its standard domain name
19 registration fee.

20 70. Upon information and belief, the amount of consideration GoDaddy received
21 from the registrant in connection with GoDaddy’s use of the “petronastower.net” and
22 “petronastowers.net” domain names did not depend on the domain names use of or similarity to
23 the PETRONAS mark, or their relationship to the plaintiff’s trademark rights.

1 71. Upon information and belief, GoDaddy’s ability to use plaintiff’s mark as
2 described above is important, “crucial,” “central,” and/or “core” to its business because, among
3 other things, it receives thousands of notices every year from trademark owners informing
4 GoDaddy that its use of their marks in a manner similar to GoDaddy’s use of plaintiff’s mark
5 infringes their trademark rights.

6 72. Upon information and belief, GoDaddy continued to use plaintiff’s PETRONAS
7 mark as described above because it believed that if it stopped such use without being compelled
8 to do so by a Court order or by an order from an ICANN-affiliated tribunal or other tribunal,
9 GoDaddy might be compelled to work with trademark owners to process, investigate, and
10 resolve trademark owners’ claims that GoDaddy’s services and actions infringe their trademark
11 rights and to possibly discontinue those services and actions.

12 73. Upon information and belief, GoDaddy believed the foregoing would decrease
13 its revenue and/or profit or cause it to lose customers or potential customers.

14 74. Upon information and belief, GoDaddy’s use of the “petronastower.net” and
15 “petronastowers.net” domain names as described above was committed with an intent to profit
16 from the PETRONAS mark by allowing GoDaddy to set a “precedent” on which it could rely to
17 avoid the expense of investigating trademark owner’s complaints associated with GoDaddy’s
18 use of their marks in the manner similar to its use of plaintiff’s mark as described above.

19 75. By reason of the acts alleged herein, plaintiff is entitled to recover GoDaddy’s
20 profits, actual damages, and costs of the action, and/or statutory damages under 15 U.S.C. §
21 1117, on election by plaintiff, in an amount of one hundred thousand dollars (\$100,000) per
22 domain name infringed.

23 76. This is an exceptional case making plaintiff eligible for an award of attorney's
24 fees under 15 U.S.C. § 1117.

1 **COUNT TWO**

2 **CONTRIBUTORY LIABILITY FOR CYBERSQUATTING**

3 77. Plaintiff realleges and incorporates by reference each of the allegations contained
4 in Paragraphs 1 through 76 of this Complaint as though fully set forth herein.

5 78. The registrant of the “peteronastower.net” and “petronastowers.net” domain
6 names committed cybersquatting trademark infringement beginning at least on May 2, 2009.

7 79. GoDaddy used its Name Servers to provide its domain name forwarding service
8 in connection with the “peteronastower.net” domain name and, and upon information and
9 belief, the “petronastowers.net” domain name.

10 80. Upon information and belief, GoDaddy used hardware, software, and other
11 instrumentalities separately or in conjunction with its Name Servers to provide its domain name
12 forwarding service in connection with the “peteronastower.net” domain name and, and upon
13 information and belief, the “petronastowers.net” domain name.

14 81. The above-mentioned domain name forwarding service that GoDaddy provided
15 to registrant pointed, linked, connected, associated, affiliated, or otherwise related the
16 “peteronastower.net” and “petronastowers.net” domain names to a pornographic website so that
17 internet users searching for or utilizing those domain names would see and be given access to a
18 pornographic website.

19 82. Upon information and belief, GoDaddy pointed, linked, connected, associated,
20 affiliated, or otherwise related the “peteronastower.net” and “petronastowers.net” domain
21 names to a pornographic website by utilizing and/or providing a service or application in
22 addition to or in conjunction with the domain name forwarding service identified above.

23 83. Beginning no later than November 2009, GoDaddy knew, or should have known,
24 that its services and actions in connection with the “peteronastower.net” and

1 “petronastowers.net” domain names were being used by the registrant to infringe on plaintiff’s
2 trademark rights and to commit cybersquatting.

3 84. GoDaddy was, in any event, willfully blind to the registrant’s cybersquatting and
4 the fact that GoDaddy’s above-described actions were allowing, enabling, facilitating, and
5 making possible the registrant’s cybersquatting

6 85. GoDaddy maintained and implemented a policy of refusing to “process,”
7 investigate, or meaningfully respond to claims of trademark infringement, including claims of
8 trademark infringement submitted according to its own policy such as those submitted by
9 plaintiff.

10 86. GoDaddy did in fact refuse to “process,” investigate, or meaningfully respond to
11 plaintiff’s claims of cybersquatting trademark infringement.

12 87. GoDaddy committed contributory cybersquatting by continuing to provide its
13 above described services and activities related to the “peteronastower.net” and
14 “petronastowers.net” domain names after it knew, or should have known, of the registrant’s
15 cybersquatting trademark infringement and knew, or should have known, that its services were
16 necessary to and enabled the registrant’s cybersquatting trademark infringement.

17 88. GoDaddy committed contributory cybersquatting by failing and refusing to
18 remove from registration, transfer to plaintiff, temporarily disable, or permanently cancel the
19 “peteronastower.net” and “petronastowers.net” domain names until ordered to do so by the
20 Court.

21 89. GoDaddy committed contributory cybersquatting by refusing to investigate
22 plaintiff’s trademark claims regarding the “peteronastower.net” and “petronastowers.net”
23 domain names or take any action that would no longer permit, enable, or allow the
24

1 “peteronastower.net” and “petronastowers.net” domain names or the PETRONAS mark to be
2 associated with the pornographic websites to which they were associated.

3 90. Upon information and belief, GoDaddy provided its domain name forwarding
4 service and the other above-described services and actions with same intent to profit from
5 plaintiff’s PETRONAS mark that GoDaddy had when it used the “peteronastower.net” and
6 “petronastowers.net” domain names as set forth in Count One above.

7 91. Upon information and belief, GoDaddy intended to profit from the registration of
8 the “peteronastower.net” and “petronastowers.net” domain names and the maintenance of the
9 registration of those domain names in the same way it intended to profit from using the
10 “peteronastower.net” and “petronastowers.net” domain names as set forth in Count One above
11 by providing its domain name forwarding service and the other above-described services and
12 actions to the registrant.

13 92. GoDaddy acted in bad faith and with a bad faith intent to profit from the
14 goodwill Plaintiff established in its PETRONAS mark, including by refusing to discontinue its
15 domain name forwarding services and other above described services at any time prior to an
16 order from the Court that it do so and/or by refusing to take any action in response to plaintiff’s
17 notices of trademark infringement.

18 93. GoDaddy does not have any intellectual property rights or any other rights in the
19 PETRONAS mark.

20 94. On information and belief, the “peteronastower.net” and “petronastowers.net”
21 domain names do not consist of the legal name of the registrant, host, or registrar, including
22 GoDaddy, nor a name that is otherwise commonly used to identify any of these individuals or
23 entities.

1 not adequate to compensate it for its injuries. Accordingly, Plaintiff is entitled to relief pursuant
2 to California Business and Professions Code § 17203.

3 101. On information and belief, Defendant's conduct has been intentional and willful
4 and in conscious disregard of plaintiff's rights and, therefore, plaintiff is entitled to its attorney's
5 fees.

6 **RELIEF REQUESTED**

7 Therefore, plaintiff respectfully requests judgment against GoDaddy as follows:

8 102. GoDaddy has infringed plaintiff's rights in the "PETRONAS" mark in violation
9 of 15 U.S.C. § 1125(d);

10 103. GoDaddy has infringed plaintiff's rights in the "PETRONAS" mark in violation
11 of 15 U.S.C. § 1114(1);

12 104. GoDaddy has violated plaintiff's rights in the "PETRONAS" mark in violation
13 of 15 U.S.C. § 1125(a);

14 105. GoDaddy has violated plaintiff's rights in the "PETRONAS" mark in violation
15 of 15 U.S.C. § 1125(c);

16 106. GoDaddy has infringed plaintiff's rights in the "PETRONAS" mark in violation
17 of California Business and Professions Code § 17200 and the common law;

18 107. That this case be declared exceptional under 15 U.S.C. § 1117 and any other
19 applicable statute;

20 108. GoDaddy's conduct was willful, entitling plaintiff to enhanced and increased
21 damages;

22 109. GoDaddy pay plaintiff actual damages as provided under the Lanham Act and
23 that those damages be trebled;

