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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
	(“PETRONAS”))	
12	Plaintiff,)	OPPOSITION TO CORRECTED MOTION
)	TO DIMISS FIRST AMENDED
13	vs.)	COMPLAINT
)	
14	GO DADDY.COM, INC.,)	Date: March 9, 2011
	Defendant.)	Time: 9:00 a.m.
15)	Courtroom 3
)	Judge: Hon. Phyllis J. Hamilton
16)	

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OPPOSITION TO GODADDY’S MOTION
 TO DISMISS FIRST AMENDED COMPLAINT
 Case No.: C09-5939 PJH

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1 **INTRODUCTION**

2 GoDaddy’s motion to dismiss reveals that its reliance on the so-called safe harbor
3 defense in the America Cybersquatting Protection Act (“ACPA”), 15 U.S.C. § 1114(2)(D)(iii), is
4 based entirely on a misrepresentation of what is shielded from liability under the statute. In
5 particular, there is absolutely no legal support for GoDaddy’s contention that the ACPA safe
6 harbor shields registrars from damages not only for the “registration” of a domain name for a
7 registrant customer but also for “routing internet traffic to a website identified by the registrant.”
8 GoDaddy has based virtually its entire defense of this case on its assertion that the ACPA’s safe
9 harbor covers “routing” internet traffic but there can be no real dispute that GoDaddy’s argument
10 is, at best, overreaching.

11 GoDaddy’s argument related to Plaintiff’s claim for direct cybersquatting raises an issue
12 that is largely unsuitable for resolution on a motion to dismiss, namely, whether the Complaint
13 sufficiently alleges GoDaddy’s “bad faith intent.” Because GoDaddy almost completely ignores
14 the actual facts pled in Plaintiff’s Complaint and applies an improperly narrow legal standard for
15 what constitutes bad faith, GoDaddy’s motion offers nothing that would support a dismissal of
16 Plaintiff’s direct cybersquatting claim.

17 As for Plaintiff’s claim for contributory cybersquatting, GoDaddy’s arguments amount to
18 little more than several completely incorrect assertions that Plaintiff’s Complaint fails to allege
19 that GoDaddy’s conduct is any different than the conduct of the registrar that was found not to
20 support a finding of contributory trademark infringement in the *Lockheed* Case. Because these
21 allegations are demonstrably false, there is nothing in GoDaddy’s motion that would warrant
22 dismissing Plaintiff’s claim for contributory cybersquatting.

1 **ARGUMENT**

2 **I. Plaintiff’s Claims Are Not Barred By The ACPA’s Safe Harbor From Damages For**
3 **A Registrar’s “Registration” Of A Domain Name**

4 GoDaddy’s primary argument here is the same argument it made in its previous motion
5 for judgment on the pleadings, namely, that it cannot be liable under the ACPA because it acted
6 as nothing more than the registrar of the domain names and, as a result, it is shielded from
7 liability under the ACPA’s safe harbor. This argument fails, however, because it based on the
8 legally incorrect assertion that the ACPA safe harbor shields registrars from damages ***not only***
9 for the actual registration of a domain name for a registrant customer ***but also*** for “routing”
10 internet traffic to a website chosen by the registrant. Because GoDaddy’s motion to dismiss
11 based on the ACPA safe harbor depends entirely on construing the scope of the safe harbor to
12 include not only the “registration” of a domain name but also “routing” a domain name, and
13 there is absolutely no legal basis that would support such a construction, GoDaddy’s motion to
14 dismiss should be denied as to the ACPA safe harbor.

15 As an initial matter, GoDaddy’s argument that the term “registration” in the ACPA also
16 means “routing” internet traffic to a website chosen by the registrant” is utterly unsupported by
17 the plain language of the ACPA which states that “a domain name registrar . . . shall not be liable
18 for damages under [the ACPA] for the registration or maintenance of a domain name for
19 another.” 15 U.S.C. § 1114(2)(D)(iii). GoDaddy points to nothing in the actual language of the
20 ACPA—and there is nothing—that would suggest the term “registration” means anything other
21 than the actual registration of a domain name for a registrant customer—much less that the term
22 “registration” should be construed to mean “routing” internet traffic.

23 Rather than base its argument on the actual language of the ACPA, GoDaddy bases its
24 argument that “registration” includes “routing” by citing to a statement in a treatise that “the

1 ACPA effectively codifies the pre-2000 case law . . . which held that a registrar that reserved or
2 registered an allegedly infringing domain name was not responsible as a direct or contributory
3 infringer.” Mtn. at 6:6-8 (*citing* 4 McCarthy on Trademarks and Unfair Competition § 25:73.40
4 (4th ed. 2010)). GoDaddy then contends that “cases interpreting the ACPA safe harbor provision
5 have interpreted this language”—meaning the language from the treatise in the previous sentence
6 referring to “pre-2000 case law” and not a reference to the actual language in the ACPA—to
7 make the leap that the safe harbor also shields “passive” registrars “who merely register domain
8 names for registrant customers and route internet traffic to the website of registrant’s choice.”
9 Mtn. at 6. (emphasis added).

10 There is absolutely nothing in any of the three cases cited by GoDaddy that even comes
11 close to suggesting—as GoDaddy does—that the ACPA shields registrars “who merely register
12 domain names for registrant customers *and route internet traffic to the website of the registrant’s*
13 *choice.*” Mtn. at 6:9-21 (emphasis added). In fact, all three of the cases undermine GoDaddy’s
14 position by stating specifically that the safe harbor in the ACPA applies only to a registrar’s
15 actions of registering domain names. Thus, in *Verizon California, Inc. v. Onlineic, Inc.*, Judge
16 Fogel held that the defendant “did not qualify for protection under the ACPA safe harbor
17 provision, which exempts a registrar from liability resulting from its registration of domain
18 names for others where the registrar is acting in a purely passive capacity.” *Verizon California,*
19 *Inc. v. Onlineic, Inc.*, 647 F. Supp.2d 1110, 1125 (N.D. Cal. 2009). Similarly, in both of the
20 other two cases cited by GoDaddy, the Courts held the ACPA’s safe harbor only applied to a
21 registrar’s action that constituted the “registration” of a domain name, which the Courts defined
22 respectively as “accepting registrations for domain names from customers” and as “keeper of the

1 registry.” *Solid Host, NL v. Namecheap, Inc.*, 652 F. Supp.2d 1092, 1104 (C.D. Cal. 2009);
2 *Lockheed Martin Corp. v. Network Solutions, Inc.*, 141 F. Supp.2d 648, 655 (N.D. Tex. 2001).

3 GoDaddy’s final attempt to establish that the ACPA safe harbor shields registrars from
4 liability for the registration of a domain name and the “routing of internet traffic to a website
5 identified by the registrant” is based on the Ninth Circuit’s opinion in *Lockheed Martin Corp. v.*
6 *Network Sols., Inc.*, 194 F.3d 980, 984 (9th 1999) (the Ninth Circuit’s opinion did not discuss the
7 ACPA because it was enacted in 2000 and the case was decided in 1999). Contrary to
8 GoDaddy’s assertions, however, nothing in the Ninth Circuit’s opinion expands the ACPA safe
9 harbor to cover actions by a registrar to include “routing of [internet traffic] by IP address
10 alone.” Mtn. at 7:21-23. Instead, the Ninth Circuit in the *Lockheed* case simply affirmed the
11 District Court’s grant of a domain name registrar’s motion for summary judgment because “all
12 evidence in the record” established that the registrar was not liable for contributory infringement
13 as a matter of law. *Lockheed*, 194 F.3d at 984. Contrary to GoDaddy’s suggestion, the holding
14 in *Lockheed* cannot as a matter of law categorically expand the scope of the ACPA’s safe harbor
15 by altering the definition of the term “registration.” Instead, the Ninth Circuit’s holding that the
16 District Court correctly granted summary judgment based on “all evidence in the record” can
17 have no application to a registrar’s conduct other than what was established in the summary
18 judgment record.

19 And there is nothing in “all evidence in the record” on which the District Court granted
20 summary judgment that would suggest that the defendant registrar’s conduct could be described
21 as anything other than the actual registration of domain names for its registrant customers and
22 that it had nothing at all to do with the “routing” of internet traffic to websites chosen by its
23 registrant customers. In fact, the District Court’s opinion in the *Lockheed* case states clearly that

1 the defendant domain name registrar did not perform any “routing” and “was not a part of the
2 process of linking domain names with potentially infringing resources such as Web sites.”

3 *Lockheed v. Network Sols., Inc.*, 985 F. Supp. 949, 961 (C.D. Cal. 1997). In addition, the
4 *Lockheed* Court simply could not have been any more clear as to what the registrar’s functions
5 were and, perhaps more import, what those functions were not:

6 NSI performs two functions in the domain name system. First, it screens domain
7 name applications against its registry to prevent repeated registrations of the same
8 name. Second, it maintains a directory linking domain names with the IP
9 numbers of domain name servers. The domain name servers, *which are outside of*
10 *NSI’s control*, connect domain names with internet resources such as Web sites
11 and email systems.”

12
13 *Lockheed Corp.*, 985 F. Supp. at 953. In light of the District Court’s detailed and clear
14 description of the conduct of the registrar which can leave no doubt that the registrar did not
15 perform the function of “routing internet traffic” as GoDaddy contends it did, the *Lockheed* case
16 offers no support for GoDaddy’s position regarding the scope of the safe harbor.

17 Nonetheless, GoDaddy attempts to use *dicta* in the Ninth Circuit’s opinion in the
18 *Lockheed* case to create confusion as to whether the ACPA safe harbor covers not only a
19 registrar’s conduct in “registering” a domain name but also in “routing internet traffic to a
20 website using that domain name.” When analyzed in the entire context of the Ninth Circuit’s
21 holding, however, it is clear that the Ninth Circuit plainly did not intend to expand the ACPA
22 safe harbor to include “routing” of internet traffic.

23 The issue in the *Lockheed* case was whether the District Court correctly granted summary
24 judgment dismissing Lockheed’s claim against the defendant NSI, a domain name registrar, for
25 contributory trademark infringement arising out of NSI’s service to its customers of registering
26 domain names which allegedly infringed Lockheed’s marks. *Lockheed*, 194 F.3d at 984. In
27 particular, the Ninth Circuit had to decide whether NSI’s registration service was sufficient to

1 establish that it “supplied a product to third parties” and thus could be liable for contributory
2 trademark infringement. *Id.* The question of whether NSI’s registration service satisfied the
3 “supplied a product” test depended in turn on (1) whether it supplied the “means of
4 infringement” to the infringing third parties and (2) the extent to which NSI had the ability to
5 “directly control and monitor” the “means of infringement.” *Id.*

6 The *Lockheed* court held that the evidence in the summary judgment record was not
7 sufficient to establish that NSI “supplied the means of infringement.” The Court observed “that
8 NSI’s role differs little from that of the United States Postal service: when an internet user enters
9 a domain-name combination, NSI translates the domain name combination and routes the
10 information to the corresponding computer.” *Id.* The only reasonable interpretation of this use
11 of the word “routes” is that “the corresponding computer” is the computer into which the internet
12 user entered the domain name combination. Indeed, it would make no sense for the information
13 that resulted from the translation of the domain name combination to be sent to any computer
14 other than the computer of the internet user who entered it in the first place. And there is
15 certainly nothing to suggest that this means that NSI, the internet register, “routed” internet
16 traffic to a website selected by the registrant” as GoDaddy contends.

17 In the context of the same discussion, the Ninth Circuit’s opinion also states that
18 “although NSI’s routing service is only available to a registrant who has paid NSI’s fee, NSI
19 does not supply the domain name combination any more than the Postal Service supplies a street
20 address by performing the routine service of routing mail.” *Id.* This reference to “NSI’s routing
21 service” is plainly a reference to NSI’s service as a registrar of registering domain names for
22 domain name customers because this is the only service for which there is any indication that
23 NSI collects fees. *Id.* As such, there is nothing to suggest that this reference to “NSI’s routing

1 service” should be interpreted to refer to anything other than the “registration” of domain names
2 by a registrar. This is especially true in light of the Court’s conclusion that the evidence
3 regarding “NSI’s routing service” did not establish that NSI had the ability to directly control
4 and monitor its registrant customers’ means of infringement of Lockheed’s marks because:

5 As the district court correctly observed, ‘where domain names are used to
6 infringe, the infringement does not result from NSI’s publication of the domain
7 name list, but from the registrant’s use of the name on a web site or other internet
8 form of communication in connection with goods or services . . . NSI’s
9 involvement with the use of the domain names does not extend beyond
10 registration.’

11
12 *Id.* (emphasis added). Thus, when read in the full context of the Court’s discussion in the
13 *Lockheed* opinion, the reference to “NSI’s routing service” cannot support GoDaddy’s argument
14 that the holding of *Lockheed* somehow expands the scope of the safe harbor of the ACPA to
15 include “routing” as alleged by GoDaddy.

16 **II. Count I For Direct Cybersquatting Should Not Be Dismissed Because The**
17 **Complaint Adequately Pleads “Use” and “Bad Faith Intent to Profit”**

18 GoDaddy does not dispute that all but two of the elements required to state a claim
19 against it for direct cybersquatting are met by the facts pled in Plaintiff’s Complaint. Under the
20 ACPA, the elements required to establish liability for direct cybersquatting are “(1) that the
21 defendant registered, trafficked in, or used a domain name; (2) the domain name is identical or
22 confusingly similar to a protected mark owned by the plaintiff; and (3) the defendant acted ‘with
23 bad faith intent to profit from that mark.’” *DSPT International, Inc. v. Nahum*, 624 F.3d 1213,
24 1218-19 (9th Cir. 2010). Here, GoDaddy contends that the only elements that are not adequately
25 pled are (1) GoDaddy’s “use” of the domain names and (2) GoDaddy’s “bad faith intent to profit
26 from the mark.”

1 **A. The Complaint Alleges GoDaddy “Used” The Domain Names In Violation of**
2 **the ACPA**

3 In essence, and among other things, the Complaint alleges that GoDaddy used the domain
4 names to direct Internet users to a pornographic website. GoDaddy makes two unavailing
5 arguments as to why this does not constitute “use” of a domain name under the ACPA.

6 First, GoDaddy contends that any action it may have taken with respect to directing
7 internet users searching for the domain names to a pornographic website cannot constitute “use
8 of the domain name under the ACPA” because GoDaddy was “merely following the automated
9 instruction of the Registrant to point the Domain Names to a particular website.” Mtn. at 11.
10 Not surprisingly, GoDaddy offers no citation to any legal authority to support its assertion that
11 “use” of a domain name does not constitute “use” under the ACPA so long as it is done at the
12 instruction of a Domain Name registrant. Indeed, it is hard to imagine why Congress would have
13 intended to allow a domain name registrant to avoid liability simply by instructing someone else
14 to use the mark to commit cybersquatting.

15 GoDaddy’s second argument is that the Complaint fails to adequately plead that
16 GoDaddy acted “as registrant’s authorized licensee” when it used the marks. Because Plaintiff
17 does not contend that GoDaddy is the registrant, GoDaddy can only be liable under the ACPA
18 for “using” the domain names if it was the “registrant’s authorized licensee.” 15 §
19 1125(d)(1)(D). GoDaddy argues that the Complaint fails to adequately plead that it was the
20 registrant’s “authorized licensee” because “Plaintiff provides no basis for this allegation; there is
21 no contractual arrangement alleged to constitute a license, and no conduct is indicated that would
22 substantiate an implied license to ‘use’ the Domain Names.” Mtn. at 12. This argument fails,
23 however, because GoDaddy is simply incorrect that the Complaint “provides no basis for the
24 allegation” that GoDaddy acted as registrant’s “authorized licensee.” To the contrary, the

1 Complaint alleges that “on May 2009, the registrant used GoDaddy’s online ‘dashboard’ to
2 instruct GoDaddy to use its Name Servers to direct anyone clicking on ‘petronastower.net’ to be
3 forwarded to a website containing highly offensive, obscene pornography.” Compl. § 44. By
4 alleging that the registrant instructed GoDaddy to use the domain names, it provides a more than
5 reasonable basis on which to infer that the registrant granted a GoDaddy a “license” to use the
6 domain names and, thus, that GoDaddy was the registrant’s “authorized licensee.” In any event,
7 GoDaddy fails to allege—much less demonstrate—that the facts pled in the Complaint are
8 insufficient to establish that it is at least “plausible” that GoDaddy acted as the registrant’s
9 authorized licensee and, as a result, GoDaddy fails to demonstrate that dismissal under Fed. R.
10 Civ. P. 12(6) is appropriate. *Lynn v. Riverside Healthcare System, LP*, 534 F.3d 1116, 1121-22
11 (9th Cir. 2008).

12 **B. The Complaint Pleads Enough Facts To State A Claim Based On GoDaddy’s**
13 **“Bad Faith Intent To Profit From The Use Of Plaintiff’s Mark”**

14 Under the ACPA, an element necessary to establish direct cybersquatting is that the
15 defendant used the domain name with “a bad faith intent to profit from [the plaintiff’s] mark.”
16 15 U.S.C. § 1125(d)(1)(A)(i). GoDaddy makes two arguments regarding “bad faith intent,”
17 neither of which has any merit. First, GoDaddy alleges that the Complaint does not use the
18 words “bad faith” to describe GoDaddy’s intent and, thus, should be dismissed for failure to
19 identify a cognizable legal theory of GoDaddy’s liability because “bad faith” intent is a required
20 element of cybersquatting. Second, GoDaddy contends that even if the Complaint had properly
21 identified “bad faith intent” as a legal theory, the facts pled in the Complaint are insufficient to
22 establish that GoDaddy had a “bad faith intent” to profit *from the plaintiff’s mark* as opposed to
23 an intent to profit in general.

24 **1. The Complaint Adequately Pleads GoDaddy’s Bad Faith Intent**

1 GoDaddy’s first argument regarding “bad faith” is that the Complaint should be
2 dismissed because “plaintiff does not even allege ‘bad faith’ standing alone” and “Plaintiff
3 merely alleges that GoDaddy had an ‘intent to profit,’ without bad faith.” Mtn. at 1:24-13:8.

4 While it is true that the Complaint does not use the words “bad faith” to described
5 GoDaddy’s intent to profit, GoDaddy’s argument that this warrants dismissal under Rule
6 12(b)(6) is frivolous. It is well settled that “[a] party need not plead specific legal theories in the
7 complaint, so long as the other side receives notice as to what is at issue in the case.” *Sagana v.*
8 *Tenorio*, 384 F.3d 731, 737 (9th Cir. 2004) (“We long ago rejected the argument that a specific
9 statute must be named, describing it is an attempt to evoke wholly outmoded technical pleading
10 rules.”). In any event, there can be no dispute that GoDaddy is on notice that Plaintiff’s legal
11 theory is that GoDaddy acted with “bad faith” intent to profit from its mark because GoDaddy
12 argues—in the same section in its brief—that the facts alleged in the Complaint are insufficient
13 to show GoDaddy’s “bad faith” intent to profit from the mark.

14 **2. The Facts Pled Are Sufficient to Establish GoDaddy’s Intent to Profit**
15 **From The Mark**

16 GoDaddy’s main argument regarding “bad faith intent” is that the Complaint fails to
17 allege facts sufficient to show that GoDaddy intended to profit “from the mark” as opposed to
18 showing that GoDaddy intended to profit from some other aspect of its conduct, such as profiting
19 from its domain name registration services. This argument fails, however, because it relies on an
20 incorrect statement of the legal test for determining “bad faith intent,” it ignores what is actually
21 pled in the Complaint, and it misapplies the standard applicable to a motion to dismiss.

22 As an initial matter, GoDaddy tries to use an overly narrow legal standard when it argues
23 that the Complaint should be dismissed because it “does not establish an ‘intent to profit’ *from*
24 *the goodwill of the trademark.*” Mtn. at 13:9-10 (emphasis original). GoDaddy’s proposed legal

1 standard is not supported by the plain language of the ACPA, which states only that a defendant
2 must have “a bad faith intent to profit from the mark”—not the “goodwill of the trademark”—to
3 be liable for using a domain name that infringes a plaintiff’s rights in the mark. 15 U.S.C. §
4 1125(d)(1)(A)(i). In addition to the language of the statute, GoDaddy’s proposed standard runs
5 counter to recent Ninth Circuit precedent interpreting the ACPA broadly and specifically
6 rejecting the notion that “intent to profit from the mark” requires a showing of “intent to profit
7 from the goodwill associated with the trademark.” *DSPT Int’l.*, 624 F.3d at 1219 (9th Cir. 2010)
8 (rejecting the argument that “‘any intent to profit’ under the act must be an intent to profit from
9 the goodwill associated with the mark.”); *Microsoft Corp. v. Shah*, 2011 U.S. Dist. LEXIS 2995,
10 *8-9 (holding bad faith was established because “defendants sought to profit in bad faith by
11 teaching others how to trade off the widespread recognition of plaintiff’s mark in order to drive
12 traffic to a particular website.”). In particular, the Ninth Circuit had made clear that although “a
13 remark in a Senate Committee report mentioning the goodwill associated with someone else’s
14 trademark” may be part of the ACPA’s legislative history, “the statute, like so many, is written
15 more broadly than what may have been the political catalyst that got it passed.” *DSPT Int’l.*, 624
16 F.3d at 1219 (“As in *Bosley Medical Inst. v. Kremer*, we conclude that the words of the statute
17 are broader than the political stimulus that led to its enactment.”).

18 Here, it nonetheless matters little that GoDaddy fails to articulate the correct legal
19 standard because GoDaddy simply ignores the facts pled in the Complaint rather than try to show
20 they are legally insufficient to establish its bad faint intent under the ACPA. In determining
21 whether a person has a bad faith intent, the ACPA enumerates nine nonexclusive factors for
22 courts to consider and, although it is not necessary “to march through these nine factors *seriatim*
23 because the ACPA itself notes that the use of the listed criteria is permissive,” GoDaddy never

1 mentions any of them. *Lahoti v. Vericheck, Inc.*, 586 F.3d 1190, 1202 (9th Cir. 2009) (upholding
2 finding of bad faith intent where defendant “earned income when customers clicked on links
3 when visiting the Domain Names” used by defendant). And while the nine factors are not
4 exhaustive, GoDaddy also does not address “the most important grounds for finding bad faith
5 [namely] the unique circumstances of the case.” *Interstellar Starship Svcs., Ltd. v. Tchou*, 304
6 F.3d 936, 946 (9th Cir. 2002).

7 GoDaddy does not address—much less analyze—the facts pled in the Complaint
8 establishing that GoDaddy intended to profit from Plaintiff’s mark by using the domain names to
9 set a “precedent” that could be used to avoid the expense of cooperating with trademark owners
10 who provide notice to GoDaddy that their marks are being violated in the same manner that the
11 Complaint alleges Plaintiff’s marks were violated. Compl. ¶¶ 71-74. In particular, the
12 Complaint alleges that GoDaddy used the domain names “petronastower.net” and
13 “petronastowers.net” to divert internet users to a pornographic website and did so with full
14 knowledge of Plaintiff’s trademark rights. Compl. ¶¶ 64-65. The Complaint further alleges that
15 GoDaddy was not obligated to continue to use the domain names for this purpose under its
16 contract with the registrant or under its agreements with ICANN. Compl. ¶¶ 66-67. In addition,
17 the Complaint alleges that GoDaddy would have been shielded under the ACPA from any
18 liability if it had stopped using the domain names as alleged in the Complaint. Compl. Compl. ¶
19 68. The Complaint also alleged that GoDaddy did not charge a fee to the registrant for
20 GoDaddy’s use of the domain names and that its compensation from the registrant did not
21 depend on whether the domain names infringed Plaintiff’s marks. Compl. ¶¶ 69-70.

22 Moreover, the Complaint alleged that GoDaddy’s ability to use Plaintiff’s mark as
23 described in the Complaint was “crucial,” “central,” and/or “core” to its business because it

1 receives thousands of notice each year from trademark owners alleging that it is infringing their
2 marks by using them the same way it used Plaintiff's marks. Compl. ¶71. The Complaint
3 alleged further that GoDaddy refused to stop using the domain names as alleged in the
4 Complaint because it feared that if it did so, it could be compelled work with trademark owners
5 to protect their trademark rights and possibly discontinue its services. Compl. ¶72. The
6 Complaint also alleged that GoDaddy believed that it would decrease its revenues and/or profit if
7 it stopped its use of the domain names as described in the Complaint. Compl. ¶73. The
8 Complaint alleged that GoDaddy's use of the domain names was intended to profit from
9 Plaintiff's mark so that it could avoid the expense of dealing with other trademark owner's
10 Complaints about GoDaddy's use of their marks in manner similar to GoDaddy's use of
11 Plaintiff's mark. Compl. ¶74.

12 As noted above, GoDaddy fails to mention any of the nine factors listed in the ACPA as
13 factors a Court may consider in determining whether a defendant had a bad faith intent to profit.
14 But even if it had, the factors that are applicable weigh in favor of a finding that GoDaddy acted
15 with the requisite bad faith intent. The first four factors deal with any legitimate reasons
16 GoDaddy may have had to use the domain names *other than* to profit from Plaintiff's mark, such
17 as GoDaddy's own trademark or other intellectual property rights to the domain names. 15
18 U.S.C. §1125(d)(1)(b)(1). GoDaddy offers no explanation for its use of the domain names and,
19 as such, all four of these factors weigh in Plaintiff's favor.

20 The only other factor that would apply to this case is the fifth factor—which examines
21 the defendant's "intent to divert customers from the mark owner's online location to a site
22 accessible under the domain name that could harm the goodwill represented by the mark"—and
23 also supports the conclusion that GoDaddy acted with bad faith. 15 U.S.C. §1125(d)(1)(b)(1).

1 The Complaint alleges that GoDaddy knew Plaintiff used its mark as an integral part of its own
2 domain names. Compl. ¶ 64. The Complaint also alleges GoDaddy knew that it was using the
3 domain names to divert internet users to a pornographic website that could and did harm the
4 goodwill associated with Plaintiff's mark. Compl. ¶ 65. In addition, the Complaint alleges that
5 GoDaddy continued to use the "petronastowers.net" domain name despite the fact that the Court
6 already had issued an order transferring the "petronastower.net" domain name to Plaintiff
7 because it was being used to violate Plaintiff's trademark rights. Compl. ¶¶ 52-56.

8 Rather than address the actual allegations establishing bad faith in the Complaint, GoDaddy
9 relies on mischaracterizations of what is pled in the Complaint to argue that Plaintiff fails to
10 sufficiently plead GoDaddy's bad faith intent to profit. Specifically, GoDaddy tries to
11 characterize the facts pled in the Complaint related to GoDaddy's intent as being limited to
12 "GoDaddy's handling of Plaintiff's trademark Complaints" and "its communications with
13 GoDaddy prior to the filing of the Original Complaint." Mtn. at 13-14. Based on this
14 characterization, GoDaddy goes on to argue that the Complaint does not establish bad faith intent
15 because "GoDaddy's actions as described in the FAC were in accordance with the established
16 legal framework for domain name disputes" and "the appropriate limits of a registrar's
17 involvement with ownership or trademark disputes" Mtn. at 13-14. This argument must fail,
18 however, because it is simply wrong that Plaintiff's allegations of bad faith intent are as limited
19 and GoDaddy contends they are. And, in any event, GoDaddy fails to identify any legal
20 authority that would equate what it calls "the established legal framework" and "the appropriate
21 limits of a registrar's involvement" with a basis for establishing the absence of a bad faith intent
22 to profit from a plaintiff's mark.

1 Finally, GoDaddy’s arguments regarding “bad faith intent” must fail because they seek to
2 require the Complaint to plead more facts than are required to overcome a motion to dismiss
3 under Fed. R. Civ. P. 12(b)(6). Contrary to GoDaddy’s assertion in its motion that the
4 Complaint must be dismissed because it “does not establish an ‘intent to profit’” the Complaint
5 need only plead “enough facts to state a claim for relief that it plausible on its face.” *Lynn*, 534
6 F.3d at 1121-22. It is axiomatic that the determination of whether a claim for relief is plausible
7 must be made by “accepting that all facts alleged in the Complaint are true and drawing all
8 reasonable inferences in favor of plaintiff.” *Al-Kidd v. Ashcroft*, 580 F.3d 949, 956 (9th Cir.
9 2009). With respect to intent under the ACPA in particular, it is well settled that “because
10 whether [a defendant] acted with a bad faith intent to profit from [a plaintiff’s] mark is a factual
11 question, judgment on the pleadings is typically inappropriate.” *Webquewst.com, Inc. v.*
12 *Hayward Indus.*, 2010 U.S. Dist. LEXIS 118188, *6 (E.D. Cal. 2011) (denying motion for
13 judgment on the pleadings that party had committed cybersquatting). GoGaddy makes
14 absolutely no allegation that the facts pled in the Complaint are not enough to make it
15 “plausible” that GoDaddy acted with the required bad faith intent and, for this reason alone,
16 GoDaddy allegations regarding bad faith intent do not provide any basis on which to dismiss
17 plaintiff’s Complaint.

18 **III. Count II For Contributory Cybersquatting Should Not Be Dismissed Because The**
19 **Allegations In The Complaint Establish “Control and Monitoring” And**
20 **“Knowledge”**

21 GoDaddy arguments in support of its request that the Court dismiss Plaintiff’s claim for
22 contributory cybersquatting are extremely weak.

23 GoDaddy’s first argument—that the “allegations [in the Complaint] do not distinguish
24 GoDaddy’s function from the role of the defendant registrar in *Lockheed*, namely, providing a

1 mere automated domain name routing function to registrants”—is simply false. Mtn. at 16:14-
2 17. To begin with, this is not what the *Lockheed* Court said about the defendant registrar NSI.
3 Instead, rather than describing the role of the defendant registrar NSI—as GoDaddy claims it
4 does—as providing an “automated domain name routing function to registrants,” the *Lockheed*
5 case clearly stated that the contrary is true and that defendant registrant “NSI is not part of the
6 process of linking domain names with potentially infringing resources, such as websites.”
7 *Lockheed Corp.*, 985 F. Supp. at 952. Instead, “after the domain name is registered, NSI’s
8 involvement is over.” *Id.* “NSI is only involved in the registration of domain names, not in the
9 use of domain names in connection with goods and services on the internet.” *Id.* (*citing*
10 *Intermatic*, 947 F. Supp. at 1231-32 (noting that there is no technical connection between domain
11 name service and the content of Web sites or other internet resources). Rather than support
12 GoDaddy’s assertion that the defendant registrar NSI provided an “automated routing function,”
13 the *Lockheed* case establishes that NSI did not—and could not—e ven provide a connection to
14 the internet much less the ability to “route” internet traffic to a particular website:

15 NSI does not provide the other services needed to use the domain names in
16 association with a website or other means of communication on the internet. The
17 services necessary to maintain a Web site, such as an IP address, communications,
18 computer processing and storage are provided by Internet service providers
19 (“ISP”) who provide the host computers and connections needed for
20 communications on the internet.

21
22 *Id.*

23 GoDaddy also argues that the allegations in the Complaint which describe GoDaddy’s
24 use of its Name Servers to divert internet users attempting to access the domain names by routing
25 them to a pornographic website “does not distinguish GoDaddy’s function from the role of the
26 defendant registrar in *Lockheed*.” Mtn. at 16. The Court in *Lockheed*, however, stated explicitly
27 that not only did the defendant registrar not use any Name Servers in connection with its acts as a

1 domain name registrar, “the domain name servers, *which are outside of NSI’s control*, connect
2 domain names with internet resources such as Web sites and email systems.” *Lockheed Corp.*,
3 985 F. Supp. at 952. This not only distinguishes GoDaddy from the registrar in *Lockheed* but it
4 also shows that GoDaddy performs the precise function the *Lockheed* court found the registrar in
5 that case *did not perform*. *Lockheed Corp.*, 985 F. Supp. at 952. The Court in *Lockheed* simply
6 could not have been clearer in describing the function of the defendant registrar NSI:

7 NSI performs two functions in the domain name system. First, it screens domain
8 name applications against its registry to prevent repeated registrations of the same
9 name. Second, it maintains a directory linking domain names with the IP
10 numbers of domain name servers.

11
12 *Id.* There is nothing in either the District Court or the Ninth Circuit *Lockheed* opinions that
13 would suggest the defendant domain name registrar in that case performed any functions other
14 the two listed here.

15 GoDaddy’s next argument is that the Complaint fails to allege that GoDaddy’s conduct
16 was any different from the conduct of the registrar in *Lockheed* and, as such, the assertions in
17 Complaint fail to establish “knowledge of infringement” required to support a claim for
18 contributory cybersquatting. Mtn. at 17. This, again, is simply not true. For one thing, the
19 Complaint alleges that GoDaddy had knowledge that it was using its domain name forwarding
20 service to allow a customer to divert internet users from the domain name “petronastowers.net”
21 to a pornographic website despite written notice from plaintiff that doing so infringed Plaintiff’s
22 trademark rights and despite the fact that this Court had issued an order requiring GoDaddy to
23 transfer the domain name “petronatower.net” to Plaintiff because Plaintiff’s trademark was being
24 infringed by the same customer who was using GoDaddy’s domain name forwarding service in
25 precisely the manner to divert internet users to the same pornographic website. Compl. ¶ 52-54.

26 GoDaddy makes no attempt to show that this is somehow analogous to the knowledge the

1 *Lockheed* Court found was inadequate to establish contributory cybersquatting. In any event,
2 even if GoDaddy were correct that the Complaint alleged conduct that was arguably similar to
3 the registrar in the *Lockheed* case, GoDaddy fails to show how that what is plead is not sufficient
4 to avoid a motion to dismiss because it includes “enough facts to state a claim for relief that is
5 plausible on its face.” *All-Kidd*, 580 F.3d at 974.

6 Although GoDaddy makes no attempt to explain how its final argument would warrant
7 dismissal of Plaintiff’s Complaint, it contends nonetheless that “[i]mposing on domain name
8 registrar’s the affirmative duty to resolve trademark disputes would place an unmanageable
9 burden on the industry and violate the well-settled case law.” Mtn. at 17. GoDaddy identifies
10 the “well-settled case law” as a statement in the District Court’s opinion in the *Lockheed* case
11 that “NSI cannot reasonably be expected to monitor the internet.” *Lockheed*, 985 F. Supp at 962.
12 It is impossible to comprehend how GoDaddy could believe this quote has any relevance to the
13 present case. GoDaddy was not asked to “monitor the internet”—Plaintiff simply asked that it
14 stop providing its domain name forwarding service to one of its customers that was obviously
15 using it to exploit Plaintiff’s marks and to commit blatant cybersquatting. GoDaddy fails to
16 explain how complying with such a request “would place an unmanageable burden on the
17 industry.” And it is doubtful GoDaddy could if it tried, since most domain name registrars and
18 Internet service providers include compliance with such requests as part of their operating
19 policies. For example, the policy of the defendant registrar NSI is described in detail in the
20 *Lockheed* case and provides that “if a trademark holder presents NSI with a United States Patent
21 Office Registration of a trademark identical to a currently registered domain name, NSI will
22 require the domain name holder to prove that it had a preexisting right to use the name. If the
23 domain name holder fails to do so, NSI will cancel the name.” *Lockheed*, 985 F. Supp. at 949.

CONCLUSION

For the foregoing reasons, GoDaddy’s motion to dismiss should be denied.

Respectfully Submitted,

Dated: February 16, 2011

Law Offices of Perry R. Clark

/S/

Perry R. Clark