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 PETROLIAM NASIONAL BERHAD (“PETRONAS”)

8 UNITED STATES DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
 9 OAKLAND DIVISION

11	PETROLIAM NASIONAL BERHAD	)	Case No.: C09-5939 PJH
	(“PETRONAS”)	)	
12	Plaintiff,	)	SUPPLEMENTARY MATERIAL IN
		)	OPPOSITION TO MOTION TO DIMISS
13	vs.	)	FIRST AMENDED COMPLAINT <sup>1</sup>
		)	
14	GO DADDY.COM, INC.,	)	Date: March 9, 2011
	Defendant.	)	Time: 9:00 a.m.
15		)	Courtroom 3
		))	Judge: Hon. Phyllis J. Hamilton

17 In addition to the reasons set forth in Plaintiff’s Opposition to GoDaddy’s motion to  
 18 dismiss, GoDaddy’s motion also should be denied because GoDaddy does not acknowledge—  
 19 much less dispute—that the Complaint pleads facts establishing GoDaddy’s “bad faith intent to  
 20 profit from [the] registration or maintenance of the domain name[s]” at issue in this case and, as  
 a result, the so-called safe harbor provision of the Anticybersquatting Protection Act (“ACPA”),  
 21 15 U.S.C. § 1114(2)(D)(iii), does not apply.

23 <sup>1</sup> This Supplementary Material is filed before Defendant has filed its reply and in compliance  
 24 with Civil L.R. 7-2(d) (“[O]nce a reply brief is filed, no additional memoranda, papers, or letters  
 may be filed without prior Court approval.”).

1 Specifically, GoDaddy moves to dismiss based on “the ACPA safe harbor” set forth in 15  
2 U.S.C. § 1114(2)(D)(iii):

3 A domain name registrar, a domain name registry, or other domain  
4 name registration authority shall not be liable for damages under  
5 this section for the registration or maintenance of a domain name  
6 for another **absent a showing of bad faith intent to profit from  
such domain name registration.**

6 (emphasis added).

7 Nowhere in its motion does GoDaddy mention, much less allege, that the Complaint fails  
8 to plead facts about GoDaddy’s actions and each domain name registration that are insufficient  
9 to establish such a “showing of bad faith intent to profit from such registration.” GoDaddy’s  
10 motion does allege—incorrectly—that Count I of the Complaint for direct cybersquatting against  
11 GoDaddy should be dismissed because the Complaint does not sufficiently plead facts regarding  
12 GoDaddy’s “bad faith intent to profit *from that mark*” pursuant to 15 U.S.C. § 1125(d)(2)(A)(i).  
13 Mtn. at 12-13 (emphasis added). But nowhere does GoDaddy’s motion make any suggestion  
14 that the Complaint fails to establish GoDaddy’s “bad faith intent to profit *from [the] domain  
15 name registration*” at issue in this case pursuant to 15 U.S.C. § 1114(2)(D)(iii) (emphasis added).  
16 Because the “safe harbor” in ACPA 15 U.S.C. § 1114(2)(D)(iii) would only apply “absent” such  
17 a showing of bad faith, and GoDaddy does not contend that the Complaint fails to sufficiently  
18 plead facts to make such a showing in the context of a Fed. R. Civ. P. 12(b)(6) motion,  
19 GoDaddy’s motion to dismiss should be denied to the extent it is based on 15 U.S.C. §  
20 1114(2)(D)(iii).

20 Dated: February 18, 2011

19 Respectfully Submitted,  
20 Law Offices of Perry R. Clark

21 /S/

22 \_\_\_\_\_  
23 Perry R. Clark  
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**TABLE OF CONTENTS**

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24

I. INTRODUCTION..... 1

II. ARGUMENT ..... 4

    A. GoDaddy’s Motion Essentially Ignores Plaintiff’s Claim for Contributory  
    Cybersquatting And Offers No Basis On Which To Dismiss That Claim .....6

        1. GoDaddy Controlled The Means Of The Registrant’s Cybersquatting..... 6

        2. GoDaddy Had Knowledge Of The Registrant’s Cybersquatting..... 10

    B. GoDaddy Is Directly Liable For Cybersquatting Based On Its Use Of The  
    Infringing Domain Name To Divert Consumers To The Infringing Website  
    With The Bad Faith Intent To Profit From Plaintiff’s Trademark..... 12

        1. GoDaddy Was At Least Impliedly Licensed To Use The Infringing  
        Domain Name ..... 12

        2. GoDaddy Used The Infringing Domain Name With A Bad Faith Intent To  
        Profit From The Mark..... 14

    C. Plaintiff’s Causes Of Action For Trademark Infringement And Dilution Are  
    Not Based On The Allegation That Defendant Merely Registered The  
    Infringing Domain Name ..... 16

    D. Plaintiff’s State Law Claims Should Not Be Dismissed Because The  
    Underlying Federal Claims Should Not Be Dismissed..... 18

    E. Plaintiff’s Motion For Attorneys’ Fees Is Baseless ..... 18

    F. Leave To Amend Should Be Granted As To Any Claim Dismissed As A  
    Result Of GoDaddy’s Motion..... 19

III. CONCLUSION..... 20

1 **TABLE OF CASES**

2 *Bell Atl. Corp. v. Twombly*, 550 U.S. 554, 570 (2007) .....3

3 *Fare Deals Ltd. v. World Choice Travel.Com, Inc.*, 180 F. Supp.2d 678, 689-90  
 4 (D. Md. 2001) .....7

5 *Ford Motor Co. v. Greatdomains.com, Inc.*, 177 F. Supp.2d 635, 646 (E.D. Mich. 2001) .....5

6 *Guichard v. Universal City Studios, L.L.L.P.*, No. C-06-06392 JSW, 2008 WL 2220434  
 7 (N.D. Cal. 2008).....16

8 *Hard Rock Café Licensing Corp. v. Concession Servs., Inc.*, 955 F.2d 1143, 1148  
 9 (7th Cir. 1992).....10

10 *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp.2d 958 (C.D. Cal. 1997) .....14

11 *Perfect 10 v. Visa Intern. Service Ass’n*, 494 F.3d 788, 807 (9th Cir. 2007).....5

12 *Solid Host NL v. Namecheap, Inc.*, 652 F. Supp.2d 1092, 1115-16 (C.D. Cal. 2009).....6

13 *Wang Labs, Inc. v. Mitsubishi Elecs. Am., Inc.*, 103 F.3d 1571, 1581 (Fed. Cir. 1997).....11

12 **STATUTES**

13 15 U.S.C. § 1125(d)(1)(B)(i)(V).....13

14 15 U.S.C. § 1125(d)(1)(D).....11

15 15 U.S.C. § 117(a)(3).....16

16 U.S.C. § 1125(d).....11

17 **RULES**

18 Fed. R. Civ. P. 15(a)(2).....17

19

20

21

22

23 **OPPOSITION TO MOTION FOR JUDGMENT**  
 24 **AND FOR FEES AND COSTS**  
 Case No.: C09-5939 PJH

1 **I. INTRODUCTION**

2 No Rule 8 regarding complaint—entire motion premised that no set of facts, including  
3 those identified in support of plaintiff’s opposition to the motion for judgment on the pleadings  
4 would support a finding in plaintiff’s favor. This is the basis for their contention no leave to  
5 amend should be granted because any amendment would be futile.

6 Safe harbor for registrars who perform the “act of registering”—if nothing else,  
7 defendant’s motion must fail because the question of what defendant **did** is a question of fact. Is  
8 it

9 Also, leg history shows that congress never intend the “registering and maintaining” to  
10 mean that Registrars should not work with trademark holders. To the contrary, intended that  
11 they would.

12 The statutory scheme also shows that registering and maintaining only to the narrow act  
13 of registering the domain name and the acts of keeping it registered (collecting fees).

14 GoDaddy itself refers to “domain name forwarding” as an “extra feature.

15 ICANN defines what registrar can charge for (defines registering?)

16 All cases and treatises and cases refer to act of registering – Lockheed, others, registering  
17 defined.

18 Website same – see chronology – if GoDaddy doing only act of registering when first  
19 transferred, it is disingenuous to argue that “domain name forwarding” started two weeks after  
20 registration was transferred is also just acting as a passive registrant.

21 BUST – no language in complaint show “GoDaddy not a passive registrar” – see  
22 complaint.

23 OPPOSITION TO MOTION FOR JUDGMENT  
24 AND FOR FEES AND COSTS  
Case No.: C09-5939 PJH

1 MAINTENANCE?? Means?—act of registering?

2 BUST on quote on page 3:12-16 to *Lockheed* with info from DC case technology

3 BUST – *Size, Inc. v. Network Solutions, Inc.*, 255 F. Supp. 2d 568, (E.D. Va. 2003)

4 (Plaintiff “has not alleged that alleged that it attempted to comply with NSI’s [defendant’s]  
5 established domain name dispute procedures.”) ALSO good stuff flea market and Lockheed.

6 Others:

7 **What is “registering”?**

8 “The registrar of Internet domain names, Network Solutions, Inc. (“NSI”), n1 maintains a  
9 database of registrations and translates entered domain-name combinations into Internet protocol  
10 addresses.” *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 872 (9th Cir. Cal. 1999).

11 **Licenses – Lockheed accepts:**

12 “In an attempt to fit under Fonovisa’s umbrella, Lockheed characterizes NSI’s service as a  
13 licensing arrangement with alleged third-party infringers. Although we accept Lockheed’s  
14 argument that NSI licenses its routing service to domain-name registrants, the routing service is  
15 just that - a service. In *Fonovisa* and *Hard Rock*, by contrast, the defendants licensed real estate,  
16 with the consequent direct control over the activity that the third-party alleged infringers engaged  
17 in on the premises. *Hard Rock*, 955 F.2d at 1149; see *Fonovisa*, 76 F.3d at 265.” *Lockheed*  
18 *Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 985 (9th Cir. Cal. 1999)