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 GODADDY.COM, INC.

16 UNITED STATES DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
 17 OAKLAND DIVISION

18	PETROLIAM NASIONAL BERHAD,	)	CASE NO: 09-CV-5939 PJH
		)	
19	Plaintiff,	)	
		)	
20	vs.	)	<b>THIRD JOINT CASE</b>
		)	<b>MANAGEMENT STATEMENT</b>
		)	
21	GODADDY.COM, INC.,	)	<b>Date: May 26, 2011, 2:00 p.m.</b>
		)	
22	Defendant.	)	
		)	

1 On May 5, 2011, the Court denied Defendant GoDaddy.com, Inc.’s (“Defendant’s” or  
2 “Go Daddy’s”) motion to dismiss the amended complaint of Plaintiff Petroliam Nasional Berhad  
3 (“Plaintiff” or “Petronas”) and ordered that a case management conference be held on May 26,  
4 2011. Pursuant Civil L.R. 16-10(d), the parties jointly submit this Third Case Management  
5 Statement and (1) report on the progress of the case and changes since the Second Joint Case  
6 Management Statement was filed on July 14, 2010, (2) make certain proposals for the  
7 management of the remainder of the case, and (3) report their views about whether using some  
8 form of ADR would be appropriate. Copies of the parties two previous case management  
9 statements are attached hereto as Exhibits A and B.

10 **I. PROGRESS AND CHANGES SINCE JULY 14, 2010 STATEMENT**

11 **A. Summary of Proceedings Since Last Statement**

12 1. The parties exchanged initial disclosures on July 15, 2010.

13 2. On August 3, 2010, Defendant filed a motion for judgment on the pleadings and  
14 for an order finding plaintiff liable for attorneys’ fees. (Doc. No. 50).

15 3. On August 5, 2010, the Court conducted the second case management  
16 conference and issued civil minutes stating that “[t]he Court will set a pretrial schedule for this  
17 case after it rules on the pending motion to dismiss.” (Doc. No. 52).

18 4. On September 9, 2010, the Court issued an order granting the motion to dismiss  
19 with leave to file an amended complaint by September 29, 2010 and (1) “referring this matter for  
20 a mandatory settlement conference, to be held within the next 4 to 6 weeks, (2) ordering that  
21 “[t]he case is stayed pending the settlement conference (except for the filing of the amended  
22 complaint),” and (3) ordering that, “[i]n the event the parties fail to settle, GoDaddy’s answer or  
23 motion to dismiss shall be filed no later than 21 days after the conclusion of the settlement  
24 process.” (Doc. No. 67).

1           5.       On September 29, 2010, Plaintiff filed its amended complaint. (Doc. No. 69).

2           6.       On October 18, 2010, the Hon. Magistrate Judge Joseph C. Spero conducted a  
3 settlement conference with the parties. (Doc. No. 73).

4           7.       On December 9, 2010, Judge Spero conducted a further settlement conference  
5 with the parties. (Doc. No. 75). On December 10, 2010, Judge Spero issued a Civil Minute  
6 Order reporting that the “[c]ase did not settle.” (*Id.*).

7           8.       The parties stipulated to extend the time for Defendant to respond to the  
8 amended complaint to January 31, 2011 (Doc. 76) and on that date Defendant filed a motion to  
9 dismiss the complaint. (Doc. No. 77).

10          9.       On May 5, 2011, the Court denied Defendant’s motion to dismiss. (Doc. No.  
11 87).

12           **B.       Plaintiff’s View of Progress and Changes Since Last Statement**

13           Since the parties filed their second Case Management Statement on July 14, 2010, this  
14 case has changed in two significant respects. First, the number of causes of action asserted  
15 against GoDaddy has been reduced from eight to three: direct cybersquatting, contributory  
16 cybersquatting, and unfair competition under Californis Bus. and Prof. Code section 17200.  
17 Second, the Court’s May 5, 2011 Order denying Defendant’s second motion to dismiss based on  
18 the so-called “safe harbor” defense contains clear directions regarding the “developed record”  
19 that will be needed to resolve the main issues in this case. As a result, the scope of discovery  
20 should be tightly focused and allow for the completion of discovery in no more than three  
21 months.

22           **C.       Defendant’s View of Progress and Changes Since Last Statement**

23           Since July 14, 2010, the following events have occurred:

- 24           • On September 9, 2010, the second (and last) of Plaintiff’s *in rem* proceedings

1 against the disputed domain names terminated, resulting in transfer of both  
2 disputed domain names to Plaintiff.

- 3 • On August 3, 2010, Go Daddy filed a motion for judgment on the pleadings and  
4 for an award of attorneys' fees. The Court granted the motion with leave to  
5 amend on September 9, 2010.
- 6 • On September 29, 2010, Plaintiff filed the First Amended Complaint, dropping  
7 claims for trademark infringement, contributory trademark infringement,  
8 trademark dilution, and false designation of origin. The First Amended  
9 Complaint alleged only cybersquatting, contributory cybersquatting, and state law  
10 unfair competition claims, and prays only for declaratory relief and damages  
11 (injunctive relief is moot, as Plaintiff now controls both disputed domain names  
12 as a result of the *in rem* proceedings).
- 13 • In October and December, the parties attended settlement conferences with  
14 Magistrate Judge Spero. The case did not settle.
- 15 • On January 31, 2011, Go Daddy filed a motion to dismiss the first amended  
16 complaint.
- 17 • On May 5, 2011, the Court denied the motion, stating "the court requires a record  
18 clarifying the mechanics of what GoDaddy did or does with regard to the disputed  
19 domain names, and what 'forwarding' or 'routing' are and whether either or both  
20 can be considered part of domain name registration services generally or the  
21 services offered by GoDaddy." In this Order, the Court set a further case  
22 management conference for May 26, 2011.

1 **II. PROPOSALS FOR THE MANAGEMENT OF THE REMAINDER OF THE CASE**

2 The parties make the following proposals for the management of the remainder of the  
3 case:

4 **A. Plaintiff's Proposals**

5 The Plaintiff proposes that the Court enter a Case Management Order containing the  
6 following:

7 Last Day to Amend Pleadings and Join of Parties: June 10, 2011

8 Last Day to Designate Expert Witnesses: June 17, 2011

9 Civil L.R. 26-2 Discovery "Cut-Off": August 26, 2011.

10 Last Day for Hearing of Dispositive Motions: September 30, 2011

11 Pretrial Conference: October 28, 2011

12 Trial: November 13, 2011. This case will be tried to a jury a jury, and the expected  
13 length of the trial is four days.

14 Plaintiff was not able to agree to Defendant's proposal for "staged discovery" because it is  
15 unnecessary and will simply delay resolution of this case.

16 First, GoDaddy's proposal contemplates a "first stage of discovery" limited to the issue of  
17 whether "Go Daddy's activities and function with respect to the disputed domain names was  
18 protected activity" that would be followed by motions for summary judgment and, eventually, a  
19 "second stage of discovery" and more motions for summary judgment. According to the Court's  
20 Pretrial Instructions, however, "[o]nly **one** summary judgment motion may be filed by each side."  
21 (emphasis original). It would make no sense, and be grossly unfair, to require the Plaintiff to file  
22 its single motion for summary while discovery is stayed on all issues except GoDaddy's "safe  
23 harbor" defense and GoDaddy has not requested—much less identified any grounds that would  
24 support—leave of Court for the parties to file multiple motions for summary judgment.

1           Second, the information within the scope of GoDaddy’s “first stage”—namely,  
2 information regarding whether “Go Daddy’s activities and function with respect to the disputed  
3 domain names was protected activity”—is within GoDaddy’s control and possession and should  
4 already have been produced as part of its initial disclosures under Fed. R. Civ. P. 26(a)(1)(a)(ii).  
5 Even though it was not, there is no reason why the Court should issue what amounts to a  
6 protective order staying discovery on all issues but one so that GoDaddy can provide the discovery  
7 that it claims will support its “safe harbor” defense. There is simply no reason why discovery on  
8 all issues cannot be completed during a single “stage of discovery” and GoDaddy has not  
9 identified such a reason—much less shown the “good cause” that would be required for the Court  
10 to issue a protective order limiting discovery to the “stages” GoDaddy proposes.

11           Third, GoDaddy specifically excludes from its “first stage of discovery” the issue of  
12 “whether Go Daddy had a bad faith intent to profit from Plaintiff’s mark.” Because the so-called  
13 “safe harbor” for domain name registrars does not apply if the registrar acted in “bad faith,”  
14 summary judgment on the “safe harbor” would be inappropriate if discovery is limited to  
15 GoDaddy’s proposed “first stage.” As such, there is simply no reason to delay discovery into all  
16 relevant areas pending completion of GoDaddy’s proposed first stage.

17           Finally, with respect to GoDaddy’s observation that Plaintiff’s schedule “would require  
18 filing of dispositive motions before the close of discovery,” GoDaddy fails to show why this  
19 would warrant rejecting Plaintiff’s proposed schedule. There is no reason why any party should  
20 wait until the close of fact discovery to obtain discovery it may feel it needs for dispositive  
21 motions and GoDaddy fails to offer any reason why it feels it would be unable to complete the  
22 discovery it may need under the schedule proposed by Plaintiff.

23           **B. Defendant’s Proposals**

24           1. Schedule

1 Go Daddy notes that the schedule above would require filing of dispositive motions before  
2 the close of discovery. Go Daddy proposes the following schedule:

3 Expert designation: July 1, 2011

4 Limited Discovery cutoff: August 5, 2011

5 Dispositive motion filing: September 14, 2011

6 Hearing on dispositive motions: October 19, 2011

7 Go Daddy requests that, if the dispositive motion or motions are denied, the Court set  
8 another Case Management Conference to set dates for the next stage of discovery and trial.

9 2. Scope of limited discovery in the first stage

10 Go Daddy proposes staged discovery to allow for an early motion for summary judgment  
11 on the issue of whether Go Daddy's activities and function with respect to the disputed domain  
12 names was protected activity of a domain name registrar under the relevant statutory and case law.  
13 Discovery on this issue, in the form of one set of interrogatories, production of documents related  
14 to the disputed domain names, production of documents related to the services Go Daddy provided  
15 with respect to the disputed domain names, and one Rule 30(b)(6) deposition would be completed  
16 by August 5, 2011, in anticipation of filing a motion for summary judgment on the issue by  
17 September 14, 2011.

18 If the motion for summary judgment is denied, Go Daddy reserves the right to request  
19 discovery on additional topics, and there are numerous other issues that would be relevant at that  
20 point (i.e., whether Plaintiff has valid trademark rights in the PETRONAS mark, and whether Go  
21 Daddy had a bad faith intent to profit from Plaintiff's mark, among others).

22 **III. PARTIES VIEWS REGARDING ADR**

23 **A. Plaintiff's View**

24 Although the case did not settle, Judge Spero was very effective as a mediator and has  
become familiar with the case as a result of presiding over two mediation sessions with the parties.

1 As a result, the Plaintiff believes that a further settlement conference before Judge Spero would  
2 likely be productive.

3 **B. Defendant's View**

4 Go Daddy has participated in two settlement conferences to date. Go Daddy does not  
5 believe that further settlement conferences or ADR would be productive.

6 Dated: May 19, 2011

LAW OFFICES OF PERRY R. CLARK

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By: /s/ Perry R. Clark  
Perry R. Clark

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Attorney for Plaintiff  
PETROLIAM NASIONAL BERHAD  
(PETRONAS)

11 Dated: May 19, 2011

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation

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By: /s/ John L. Slafsky  
John L. Slafsky  
David E. Kramer  
Hollis Beth Hire

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Attorneys for Defendant  
GODADDY.COM, INC.

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**SIGNATURE ATTESTATION**

20 I, Perry Clark, hereby attest that all signatories to this document have consented to the e-  
21 filing of this document.

21

22 Dated: May 19, 2011

By: /s/ Perry Clark  
Perry Clark

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