

## Cyberpiracy

By Richard H.W. Maloy with Kathleen Brown  
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Prior to 1999, the trademark aspect of intellectual property law in the United States had undergone little statutory development since the Lanham Act of 1946, which attempted to codify and harmonize existing federal trademark statutes.<sup>1</sup> With the rise of the internet in the early to mid-1990s and corresponding increases in trademark infringement suits, Congress sought to supplement the Lanham Act and address these issues in the Anticybersquatting Consumer Protection Act (ACPA) of 1999.<sup>2</sup> In his book *CYBERPIRACY*, Richard H.W. Maloy<sup>3</sup> first describes the ACPA and its administrative equivalent, the Uniform Domain Name Dispute Resolution Policy (UDRP). After furnishing this statutory foundation, Maloy proceeds to discuss in personam and in rem jurisdiction over violators, remedies for violation, individual cyberpiracy protection, and the phenomena of ‘typosquatting’ and ‘cybergripping.’

Maloy begins with a brief history of the evolution of trademark law in the United States. He notes the emphasis on the prevention of consumer confusion in commerce present in the traditional system and calls special attention to the fact that under the ACPA, one can even be in violation outside the commercial arena.<sup>4</sup> The second and third chapters outline the history and purpose of the UDRP and ACPA, respectively. Maloy does an exhaustive job of defining terms

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<sup>1</sup> RICHARD H.W. MALOY, *CYBERPIRACY* 3 (Vandepas Publishing 2008). The Lanham Act forms Title 15 of the United States Code.

<sup>2</sup> *Id.* at 5-6.

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<sup>4</sup> MALOY, *supra* note 1, at 7.

and explaining the processes of dispute resolution prior to litigation as well as litigation itself under the ACPA. Of particular note in these chapters are Maloy's explanation of cyberpiracy. Cyberpiracy occurs when a domain name identical or confusingly similar to an existing trademark is registered in an attempt to profit, and the various examples he uses to illustrate this conduct.<sup>5</sup>

The subject of in personam jurisdiction, used in this context to address who may be liable, who or what is protected, and who may sue under the ACPA, forms Maloy's next and longest chapter. His approach to this complex subject is similar to that of previous chapters; a combination of complete definition of terms with numerous footnote cases illustrating how courts have interpreted those terms. Maloy engages in a helpful discourse on the various degrees of trademarks and their levels of protection and indicates the importance in any cyberpiracy suit of a finding of a bad faith intent to profit from a domain name, whether or not that domain name is used in commerce.<sup>6</sup> He is careful to include a discussion of "fair use" defenses to cyberpiracy claims, in the interest of balancing what is forbidden with what is allowed under the ACPA.<sup>7</sup> Maloy concludes this chapter with an enlightening description of the different approach to personal jurisdiction concerns necessitated by the worldwide nature of the internet.<sup>8</sup>

Chapter V addresses the subject of in rem jurisdiction with respect to cyberpiracy suits. Maloy indicates that in rem actions are subject to different conditions than in personam actions. Although allowed by the ACPA, in rem actions are not nearly as widespread or favored, due mainly to requirements of proof of lack of personal jurisdiction over a defendant before

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<sup>5</sup> *Id.* at 24-25. Maloy wonderfully writes that "[s]ome of the accounts of cyberpiracy were they not factual would seem to be pure fantasmagoria."

<sup>6</sup> *Id.* at 40-48, 53.

<sup>7</sup> *Id.* at 63-64. Examples of "fair use" included here are using the mark only to refer to or describe the mark without indicating the mark is the source of the goods and the production of a licensing agreement.

<sup>8</sup> MALOY, *supra* note 1, at 102-116.

commencing an in rem action and to the relative lack of remedies available to the plaintiff in such an action.<sup>9</sup> The structure of this chapter helps illustrate this point. While Maloy retains his informative writing style, the footnotes and examples given here are strikingly bare-bones in contrast to the previous chapter, due in part to a greater proportion referring to statutes rather than to case law.

The following chapter, which outlines remedies for both types of actions, continues to accent the difference between them. Maloy discusses the gamut from legal damages and penalties to equitable forfeiture or cancellation of the domain name, showing that far more remedies are available to the victor in an in personam action. In an in rem action, the only available remedies are a forfeiture or cancellation of the domain name or the transfer of the domain name to the mark owner.<sup>10</sup> This contrasts sharply with the remedies available to the victor in an in personam action, which include, among others, penalties, damages, injunctions, and attorney fees.<sup>11</sup>

The final few chapters of CYBERPIRACY mark a stylistic departure from the earlier sections. Maloy shifts from the mechanical and explanatory prose that characterized the majority of the book to a more lively prose used to describe the phenomena of ‘typosquatting’ and ‘cybergripping.’<sup>12</sup> For example, Maloy’s incredulity at the actions of two ‘typosquatting’ defendants who “said that they were just hoping to pick up new customers by visitors to the Internet making a mistake as to the domain name of the companies they sought to contact” fairly

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<sup>9</sup> MALOY, *supra* note 1, at 117, 126.

<sup>10</sup> *Id.* at 157.

<sup>11</sup> *Id.* at 131-155.

<sup>12</sup> Maloy describes these terms in Chapters VII and IX, respectively. “Typosquatting” consists of creating a domain name off by a letter or two from a famous one with the intent to lure those who mistype, while “cybergripping” involves creation of a domain name for the purpose of venting, sometimes by combining a famous domain name with a disparaging term (Maloy favors ‘sucks’ in his illustration of the point).

leaps off the page.<sup>13</sup> In his discussion of ‘cybergripping,’ Maloy cogently articulates the boundaries of the ACPA, indicating that while the First Amendment protects critical speech, such speech may violate the ACPA if the domain name from which it emanates is identical to, or so similar to a mark owned by the recipient of the criticism that it creates confusion.<sup>14</sup> Maloy also emphasizes the point, reinforced with several examples, that as long as ‘cybergrippers’ use their registered domain names purely for editorial purposes, and do not in any way seek to profit from or induce confusion about the mark they are criticizing, they are likely to avoid running afoul of the ACPA.

The area of trademark law in the United States has undergone significant change in recent years, and *CYBERPIRACY* provides a valuably informative examination of that change. Maloy’s book provides a thorough and informative treatment of the issues, although his heavy reliance on footnotes to illustrate his points makes the reading slow going initially, particularly for the reader unfamiliar with trademark law. This mild criticism aside, the reader will be amply rewarded for the time spent navigating Maloy’s copious footnotes. Professor Maloy builds a foundation of knowledge that ultimately leads the reader to a better understanding of the entertaining yet complex issues facing internet and trademark regulation today. Reading *CYBERPIRACY* will benefit both the novice seeking a basic understanding of the evolution of United States trademark law and the trademark law specialist in search of more background and ideas about how trademark law may evolve.

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<sup>13</sup> MALOY, *supra* note 1, at 162.

<sup>14</sup> *Id.* at 173 (citing *Coca-Cola-Co. v. Purdy*, 382 F. 3d 774, 787 (8th Cir. 2004)).