

5-1-2004

## Barbie's Life in Plastic: It's Fantastic for First Amendment Protection — or Is It? *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002)

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### Recommended Citation

Gallo, Bryan M. (2004) "Barbie's Life in Plastic: It's Fantastic for First Amendment Protection — or Is It? *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002)," *University of Dayton Law Review*. Vol. 29: No. 3, Article 2.

Available at: <https://ecommons.udayton.edu/udlr/vol29/iss3/2>

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**Cover Page Footnote**

The author wishes to thank his wife for her support and Professor Jeffrey Matsuura for his insight in the development of this note.

**BARBIE’S LIFE IN PLASTIC: IT’S FANTASTIC  
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IT? *MATTEL, INC. V. MCA RECORDS, INC.*, 296 F.3D  
894 (9TH CIR. 2002)**

*Bryan M. Gallo\**

I. INTRODUCTION

Trademarks<sup>1</sup> are the lifeblood of the modern commercial marketplace. They can be found in countless places, from highway billboards to the nearest pop-up internet ad, and are fiercely guarded by their owners. The sole purpose of a trademark is to serve an “identifying role.”<sup>2</sup> But what happens when a mark, rooted in the reputation and history of a company’s rise to success, begins to transcend its traditional “identifying role” and becomes a “cultural icon?” Such is the fate of Barbie.

For those who are seeking to use socially popular trademarks in an artistic setting, such as books, movies, and songs, the recent decision in *Mattel, Inc. v. MCA Records, Inc.* helped to clarify and expand upon what constitutes permissible fair use.<sup>3</sup> Unfortunately, for those seeking to guard their marks, this decision has provided no clear guidance as to the strength of the owner’s future rights.<sup>4</sup>

One of the core issues in *Mattel* is whether traditional trademark infringement analysis,<sup>5</sup> or the newer Second Circuit test, is applicable when

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<sup>1</sup> 15 U.S.C. §§ 1051-1129 (2000). A trademark is a word, phrase, or symbol that is used to identify a manufacturer or sponsor of a good or the provider of a service. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002). Trademarks inform consumers that trademarked goods come from the same source in an attempt to prevent others from duping consumers into buying similar products. *Id.*

<sup>2</sup> *New Kids on the Block v. News Am. Publg., Inc.*, 971 F.2d 302, 305 (9th Cir. 1992). That is, a trademark merely identifies the manufacturer or sponsor of a good or the provider of a service. *Id.*

<sup>3</sup> Fair use is a defense in a trademark action that forbids a trademark holder from claiming exclusive use over a descriptive term so as to prevent others from accurately describing a characteristic of their goods. *Id.* at 306. For example, although the name of the band, New Kids on the Block, is a registered trademark, a newspaper was permitted to print the name of the band alongside a poll asking its readers, “Who’s the best on the block?” *Id.* at 304.

<sup>4</sup> In holding that Aqua’s use of the word “Barbie” in the title of its song “Barbie Girl” was permissible, the court in *Mattel* failed to establish any boundaries regarding when a potential future use of the word “Barbie” in another artistic work would be impermissible. *Mattel*, 296 F.3d at 902.

<sup>5</sup> Traditional trademark analysis relies solely on a balancing of factors in an attempt to determine whether there is a likelihood of consumer confusion between two competing trademarks. *Parks v. Laface Records*, 329 F.3d 437, 448 (6th Cir. 2003) (citing *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979)). Under this approach, a defense asserted under the First Amendment is given no

a trademark has evolved into a cultural icon.<sup>6</sup> In *Mattel*, the Ninth Circuit Court of Appeals was confronted with reconciling a trademark infringement action between two vastly different products: Barbie dolls and pop music. Rather than applying the traditional trademark analysis, the court adopted a test from the Second Circuit, holding that where a trademark has taken on an expressive meaning in society apart from its source-identifying function, especially in the context of an artistic parody of a pop icon, the Lanham Act<sup>7</sup> should only apply to artistic works using that trademark where the public interest in avoiding consumer confusion outweighs the public interest in free expression.<sup>8</sup>

This Note will argue that, although the *Mattel* court correctly applied the Second Circuit test<sup>9</sup> with respect to the specific facts of the *Barbie Girl* song, its failure to provide detailed guidance on what factual circumstances trigger this test in place of traditional trademark analysis may have unknowingly opened a Pandora's Box of potential trademark issues.<sup>10</sup> Section II outlines the background of this case. Section III explores more fully the analysis used in *Mattel* and concludes that the court was correct in foregoing traditional trademark analysis in favor of the Second Circuit test under the specific facts of this case. However, the court's application of the Second Circuit's test appears to promote a limited right to the public use of a "cultural icon" trademark without ever defining the boundaries of such a right. Finally, the court may have failed to consider fully the damage that its application of the Second Circuit's standard may have on future trademark infringement claims against the Barbie mark.

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special attention. *Id.*

<sup>6</sup> 296 F.3d at 900.

<sup>7</sup> 15 U.S.C. §§ 1051-1129. The Lanham Act provides the basis for federal protection of trademarks, incorporating common-law trademark doctrine and enhancing it by providing a system for registering marks with the federal government. *Parks*, 329 F.3d at 445. Registration provides a number of benefits, such as protection throughout the geographic United States and a legal presumption of trademark validity. *Id.*

<sup>8</sup> *Mattel*, 296 F.3d at 902.

<sup>9</sup> The Second Circuit test only permits application of the Lanham Act to artistic works "where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Id.* at 901.

<sup>10</sup> *See supra* n. 5.

## II. BACKGROUND

### A. *The Facts of Mattel, Inc. v. MCA Records, Inc.*

Barbie was created in 1957, inspired by a German doll named Lilli, who was “a pornographic caricature that was a lascivious plaything for men.”<sup>11</sup> Mattel reformed the doll over time to represent purity and innocence, and turned it into a huge commercial success that clears over \$2 billion in annual profits from sales in 140 countries.<sup>12</sup> Since its inception, women have critiqued what Barbie, as a product and a social icon, says about how women should be.<sup>13</sup> “Barbie has been celebrated as the prototypical woman and simultaneously blamed for creating unrealistic expectations of women.”<sup>14</sup> She has been satirized by artist Paul Hansen through modified dolls named “Hooker Barbie,” “Carrie Barbie,” and “Big Dyke Barbie,”<sup>15</sup> while at the same time still being pervasive and popular enough in her natural state that somewhere in the world, Mattel sells two Barbie dolls every second.<sup>16</sup>

In 1997, Danish pop group Aqua released the song *Barbie Girl* on the album *Aquarium*.<sup>17</sup> In the song, one band member impersonates Barbie by singing in a high-pitched, doll-like voice about being “a Barbie girl, in [her] Barbie world.”<sup>18</sup> She sings to Ken (Barbie’s male counterpart), telling him “Life in plastic, it’s fantastic. You can brush my hair, undress me everywhere / Imagination, life is your creation.”<sup>19</sup> Similarly, one band

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<sup>11</sup> Steven M. Cordero, Student Author, *Cocaine-Cola, the Velvet Elvis, and Anti-Barbie: Defending Trademark and Publicity Rights to Cultural Icons*, 8 *Fordham Intell. Prop. Media & Ent. L.J.* 599, 636 (1998).

<sup>12</sup> *Id.* It is worth noting that Mattel’s efforts to reform the original Lilli doll into one that represents purity and innocence is only material to the trademark infringement claim insofar as it provides the baseline public perception of the Barbie doll from which to establish that Aqua’s “Barbie Girl” song represented a parody of it.

<sup>13</sup> Alyson Lewis, Student Author, *Playing Around with Barbie TM: Expanding Fair Use for Cultural Icons*, 1 *J. Intell. Prop.* 61, 72 (1999).

<sup>14</sup> Tamar Buchakjian, Student Author, *Mattel, Inc. v. MCA Records, Inc.: Let’s Party in Barbie’s World – Expanding the First Amendment Right to Musical Parody of Cultural Icons*, 36 *Loy. L.A. L. Rev.* 1321, 1323 (2003).

<sup>15</sup> Cordero, *supra* n. 11, at 638.

<sup>16</sup> Lewis, *supra* n. 13, at 73.

<sup>17</sup> *Mattel*, 296 F.3d at 899. The *Aquarium* album contained eleven tracks, including parodies of many other icons, including popular movies such as *Indiana Jones* and *The Candyman*.

<sup>18</sup> *Id.* at 901.

<sup>19</sup> *Id.*

member impersonates Ken, who tries to entice Barbie to “go party.”<sup>20</sup> *Barbie Girl* rose quickly in the music world, and, much to the chagrin of Mattel, the stinging parody eventually made its way to the Top 40 music charts, taking Aqua along with it.<sup>21</sup>

Mattel filed suit in the United States District Court for the Central District of California against MCA Records, Inc., the primary music company that produced, marketed, and sold the *Barbie Girl* song in the United States, along with a handful of other domestic and foreign music companies affiliated with MCA (collectively “MCA”) by cross-licensing agreements to distribute *Barbie Girl* worldwide.<sup>22</sup>

In its original complaint, Mattel alleged eleven causes of action,<sup>23</sup> including trademark infringement and trademark dilution.<sup>24</sup> On appeal, Mattel challenged the district court’s ruling that the *Barbie Girl* song was a parody of Barbie and a nominative fair use and that MCA’s use of the term Barbie is not likely to confuse consumers as to Mattel’s affiliation with the song.<sup>25</sup>

### B. *The Lower Court Opinion*

Mattel initially petitioned the court for a preliminary injunction on its claims for trademark infringement in early 1998 to enjoin MCA from

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<sup>20</sup> *Id.* at 899.

<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> The eleven claims included: (1) trademark and trade dress dilution (under state and federal law); (2) trademark infringement; (3) false designation of origin and false description; (4) statutory and common law unfair competition; (5) unfair competition under the Paris Convention; (6) wrongful use of a registered mark; (7) common law misappropriation; (8) common law passing-off and disparagement; (9) common law unjust enrichment; (10) contributory trademark and trade dress dilution (under state and federal law); and (11) contributory trademark and trade dress infringement. *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1126 (C.D. Cal. 1998).

<sup>24</sup> *Id.* Trademark infringement is codified in section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)) and creates a civil cause of action against any person who identifies his or her product in such a way as to create confusion among consumers as to the origin, sponsorship, or approval of a product by another person. *Parks*, 329 F.3d at 445. The language of section 43(a) is broad, and plaintiffs often invoke this section to protect trademarks of ordinary merchandise, as well as celebrity names and titles of artistic works. *Id.* Trademark dilution, codified in the Federal Trademark Dilution Act (15 U.S.C. § 1125), provides a private cause of action against anyone whose use of a trademark “[whittles] away at its value” or tarnishes the trademark with negative associations. *Mattel*, 296 F.3d at 903. Contrary to trademark infringement, the injury from dilution usually occurs when consumers are not confused about the source of the product, but rather seeks to prevent a third party from appropriating the substantial investment that the trademark owner has put into its mark. *Id.*

<sup>25</sup> *Id.* at 899. For a discussion on parody as it relates to trademark infringement claims see *infra* notes 70-74 and accompanying text.

manufacturing, producing, and distributing *Barbie Girl*, and to require the destruction of any product or packaging using Mattel's Barbie trademark.<sup>26</sup> The court denied the motion for a preliminary injunction, claiming that Mattel failed to show that it was likely to succeed on its infringement claim.<sup>27</sup>

After the denial of the preliminary injunction, MCA filed a motion for summary judgment to dismiss the case.<sup>28</sup> The district court granted the motion for summary judgment in favor of MCA.<sup>29</sup> At the outset, the court addressed the question of whether *Barbie Girl* constituted a parody,<sup>30</sup> noting that a parody has socially significant value as free speech under the First Amendment.<sup>31</sup> After examining Aqua's lyrics and music video, the court determined that the singers were poking fun at Barbie by spoofing the unrealness of Barbie and parodying a woman who is like Barbie, as "one who is plastic, unreal, and easily manipulable by others."<sup>32</sup> The court recognized that the album identifies on the CD case that the song "is a social comment and was not created or approved by the makers of the doll."<sup>33</sup> The court found the song *Barbie Girl* to be a parody and noted that, based on the song's fast tempo and the exaggerated performances of the singers, "the lyrics are not to be taken too seriously."<sup>34</sup>

Next, the court decided that *Barbie Girl* did not infringe on the Barbie trademark because the reference to Mattel's doll fell within the fair use of the term "Barbie."<sup>35</sup> To justify its position, the court applied not only the traditional trademark analysis, but also another test called the "New Kids"

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<sup>26</sup> *Mattel, Inc.*, 28 F. Supp. 2d at 1126. Ironically, Mattel did not sue Aqua directly, claiming that it was not attempting to "censor" the song. *Id.* Instead, Mattel requested that the court require MCA Records to "dispose or destroy any product or its packaging, which uses Mattel's Barbie trade name." *Id.*

<sup>27</sup> *Id.*

<sup>28</sup> *Id.*

<sup>29</sup> *Id.* at 1156.

<sup>30</sup> *Id.* at 1136. Parodies have socially significant value as free speech under the First Amendment because they play an important role in social and literary criticisms, even though they may discourage or discredit the original author. *Id.* As such, "a parodist whose expressive work aims its parodic commentary at a trademark is given considerable leeway, but a claimed parodic use that makes no comment on the mark is not a permitted trademark parody use." *Mattel*, 296 F.3d at 901.

<sup>31</sup> The First Amendment to the United States Constitution reads "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances." U.S. Const. amend. I.

<sup>32</sup> *Mattel, Inc.*, 28 F. Supp. 2d at 1138.

<sup>33</sup> *Id.* at 1142.

<sup>34</sup> *Id.* at 1138.

<sup>35</sup> *Id.* at 1141. "Fair use" is a defense that, in essence, forbids a trademark owner registrant from appropriating a descriptive term for his exclusive use so as to prevent others from accurately describing a characteristic of their goods. *New Kids on the Block*, 971 F.2d at 306.

standard.<sup>36</sup> The New Kids standard permits a nominative fair use defense by a user who does not attempt to capitalize on consumer confusion and whose use of a mark is required because it is “the only word reasonably available to describe a particular thing.”<sup>37</sup> The crux of this fair use test is whether the defendants attempted to capitalize on consumer confusion.<sup>38</sup> The court found sufficient evidence that MCA had taken steps to avoid consumer confusion and determined that MCA’s use of the Barbie mark was not an infringement.<sup>39</sup>

Alternatively, the court also applied the traditional trademark analysis standard to dismiss Mattel’s claims of trademark infringement.<sup>40</sup> This standard is comprised of eight factors:

- (1) the strength of the mark;
- (2) proximity of the goods;
- (3) similarity of the marks;
- (4) evidence of actual confusion;
- (5) marketing channels used;
- (6) type of goods and the degree of care likely to be exercised by the purchaser;
- (7) defendant’s intent in selecting the mark;
- and (8) likelihood of expansion of the product lines.<sup>41</sup>

It is designed to determine whether confusion between related goods is likely.<sup>42</sup> Applying the eight factors to the facts at hand, along with an additional factor that considered the First Amendment values at issue, the court determined that Mattel’s products (children’s dolls) were unrelated to MCA’s *Barbie Girl* song as a matter of law.<sup>43</sup>

### C. *Holding of the Ninth Circuit Court of Appeals*

On appeal to the Ninth Circuit, the court framed the issue somewhat differently than the lower court, approaching it from the position that “[w]ith fame comes unwanted attention.”<sup>44</sup> It sought to decide the question of how far trademark rights can extend before encroaching “upon the zone

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<sup>36</sup> *Mattel, Inc.*, 28 F. Supp. 2d at 1143. The “New Kids” standard provides a defense to a claim for trademark infringement based on the “nominative use” of a mark. That is, a trademark infringement claim will not lie “where the only word reasonably available to describe a particular thing is pressed into service.” *New Kids on the Block*, 971 F.2d at 308.

<sup>37</sup> *Mattel, Inc.*, 28 F. Supp. 2d at 1141.

<sup>38</sup> *Id.*

<sup>39</sup> *Id.* at 1143.

<sup>40</sup> *Id.* at 1144.

<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 1147.

<sup>44</sup> *Mattel*, 296 F.3d at 899.

of the First Amendment” when those same trademarks begin to “fill gaps in our vocabulary and add a contemporary flavor to our expressions.”<sup>45</sup>

In affirming the decision of the district court, the court stressed that Barbie is not simply a toy.<sup>46</sup> Rather, she has become an American cultural icon, and as such a “trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.”<sup>47</sup>

Dismissing the traditional trademark analysis, the court found that when a mark attains an “expressive meaning apart from its source-identifying function,” the application of the traditional test “fails to account for the full weight of the public’s interest in free expression.”<sup>48</sup> To better account for First Amendment considerations, the court abandoned both the “New Kids” and the traditional trademark tests, and instead adopted a different standard laid out by the Second Circuit in *Rogers v. Grimaldi*.<sup>49</sup> In *Rogers*, the Second Circuit held that “in general the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”<sup>50</sup>

The Second Circuit further distinguished between the title of artistic works and ordinary commercial products, observing that consumers expect a title to describe the underlying work and not to identify its origin.<sup>51</sup> It concluded that literary titles do not violate the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”<sup>52</sup>

Applying *Rogers*, the Ninth Circuit concluded that Aqua’s use of “Barbie” was not an infringement of Mattel’s trademark.<sup>53</sup> The court found that the use of “Barbie” in the song title was clearly artistically relevant

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<sup>45</sup> *Id.* at 900.

<sup>46</sup> *Id.*

<sup>47</sup> *Id.* (citing *Anti-Monopoly, Inc. v. Gen. Mills Fun Group*, 611 F.2d 296, 301 (9th Cir. 1979) (holding that “[i]t is the source-denoting function which trademark laws protect, and nothing more”).

<sup>48</sup> *Id.* See *supra* notes 40-41 and accompanying text for a listing of the eight factors of traditional trademark analysis. It is important to notice that traditional trademark analysis does not resolve this issue because any consideration of the public’s freedom of expression under the First Amendment is entirely absent.

<sup>49</sup> *Mattel*, 296 F.3d at 902 (citing to *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)). For discussion on the “New Kids” test, see *supra* note 36. For discussion on the traditional trademark test, see *supra* note 41 and accompanying text.

<sup>50</sup> 875 F.2d at 999.

<sup>51</sup> *Id.*

<sup>52</sup> *Id.*

<sup>53</sup> *Mattel*, 296 F.3d at 902.

because the song is about Barbie and the values Aqua claims she represents.<sup>54</sup> Further, the court found that the song title does not explicitly mislead as to the source of the work or otherwise suggest that Mattel produced it.<sup>55</sup> Indeed, the opinion concluded by stating that if a staunch prohibition against the mere use of Barbie in the title were enough to satisfy the *Rogers* test, it would render *Rogers* null and useless.<sup>56</sup> Thus, the court determined that Aqua's use of the word Barbie in the name of its song *Barbie Girl* did not infringe on Mattel's trademark.<sup>57</sup>

### III. ANALYSIS

This note will argue that the *Mattel* court correctly concluded that an artistic parody of a cultural icon deserves an increased level of protection under the First Amendment of the U.S. Constitution. Application of the Second Circuit test to trademarks that have permeated common language provides the best balance between the public's interest in avoiding consumer confusion with its interest in free expression.<sup>58</sup> The inquiry does not end here. The court must then consider whether the facts of the underlying case truly deserve application of the Second Circuit test. The court cannot blindly set forth a policy that the public deserves some limited right to critique a popular icon without addressing the extent to which this public right extends. Finally, the court must weigh the possible damage that application of this test may have in general on future trademark infringement actions as against the same mark.

#### A. *The Second Circuit Approach is Appropriate for Cultural Icons*

Mattel's claims of trademark infringement were successfully resolved without use of traditional trademark analysis, thereby affording adequate weight to Aqua's freedom of expression protected by the First Amendment.<sup>59</sup> The *Mattel* court correctly found this method to be the best balance between the public interest in avoiding consumer confusion and the public's interest in freedom of expression when an artistic parody pokes fun at a cultural icon.

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<sup>54</sup> *Id.*

<sup>55</sup> *Id.*

<sup>56</sup> *Id.*

<sup>57</sup> *Id.*

<sup>58</sup> *Parks*, 329 F.3d at 450.

<sup>59</sup> *Mattel*, 296 F.3d at 902.

The Second Circuit in *Rogers* was the first to recognize that songs, like movies, books and plays, deserve protection as unquestionable works of artistic expression.<sup>60</sup> The court also recognized that these works are also sold in the commercial marketplace and thus deserve some amount of government regulation, noting that “[t]he purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.”<sup>61</sup> Titles of artistic works, though, are a complex combination of both artistic and commercial elements.<sup>62</sup> As such, titles deserve more protection than ordinary commercial products because they encompass the additional element of the author’s freedom of expression.<sup>63</sup>

The Lanham Act, and the trademark protection it offers, deals solely with the source-identifying function of a “mark.”<sup>64</sup> The title of an artistic work, however, serves to describe the subject matter of the work and rarely offers any insight as to the source of the work.<sup>65</sup> As such, application of the Lanham Act to the titles of artistic works serves an overbearing purpose in light of the slight consumer interest in gleaning the source of the work through the title.<sup>66</sup> These considerations led to the Second Circuit test, wherein “a title with at least some artistic relevance to the work is not explicitly misleading as to the content of the work” will not draw application of the Lanham Act.<sup>67</sup>

Likewise, the concept of an artistic parody has always been particularly problematic in the context of trademark infringement.<sup>68</sup> A large portion of social dialogue would be practically impossible if its speakers were threatened by an infringement lawsuit every time they made reference to a person, product, or company by using its trademarks.<sup>69</sup> A parody must convey, at the same time, two contradictory messages: “that [the parody] is the original, but also that it is *not* the original and is instead a parody.”<sup>70</sup>

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<sup>60</sup> 875 F.2d at 997; see e.g. *Parks*, 329 F.3d at 450.

<sup>61</sup> *Rogers*, 875 F.2d at 997.

<sup>62</sup> *Id.* at 998.

<sup>63</sup> *Id.* The Sixth Circuit has recently echoed this proposition, stating that traditional “likelihood of confusion” trademark analysis “ignores the fact that the artistic work is *not* simply a commercial product but is also a means of communication.” *Parks*, 329 F.3d at 449 (emphasis in original).

<sup>64</sup> *Mattel*, 296 F.3d at 901.

<sup>65</sup> *Rogers*, 875 F.2d at 1000.

<sup>66</sup> *Id.*

<sup>67</sup> *Id.* It is important to note that, as presented *Rogers*, the analysis of a title that allegedly infringes a registered trademark is judged in the context of the underlying content of the work. *Id.* Thus, the Ninth Circuit judged the use of the word “Barbie” in the song title in the context of what the values that Aqua claims Barbie to represent. *Mattel*, 296 F.3d at 902.

<sup>68</sup> *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989).

<sup>69</sup> *New Kids on the Block*, 971 F.2d at 307.

<sup>70</sup> *Cliffs Notes*, 886 F.2d at 494 (emphasis in original).

The very targeting for ridicule of an original work justifies a parody's need to mimic the original.<sup>71</sup> The key to a parody is that it "must be able to 'conjure up' at least enough of [the] original to make the object of its critical wit recognizable."<sup>72</sup> This, in turn, makes the question of an explicitly misleading title especially troublesome because the very purpose of parody is imitation.<sup>73</sup> As such, the overall balancing and emphasis on First Amendment values of the Second Circuit approach makes it particularly suitable in deciding claims of trademark infringement as against parodies.<sup>74</sup>

It is important to discern what fact patterns may trigger a court to adopt this type of First Amendment analysis in lieu of traditional trademark analysis. This is an important distinction because while the Second Circuit approach carries the heavy burden of constitutional First Amendment scrutiny, a prospective plaintiff need only prove that the title has no artistic relevance to the underlying work, or alternatively that the title explicitly misleads as to the source of the work.<sup>75</sup> On the other hand, the traditional factors approach requires a prospective plaintiff to spend a considerable effort litigating at least eight separate factors to convince the court that a likelihood of consumer confusion exists.<sup>76</sup>

For example, a quick sampling of cases that chose to apply the Second Circuit approach reveals that they all involved a powerful cultural icon against one claiming freedom of artistic expression. Most recently, the Sixth Circuit chose to apply this test to a battle over the title of a rap song by the group OutKast entitled *Rosa Parks*.<sup>77</sup> In reversing summary judgment for the plaintiff and remanding the case, the Sixth Circuit noted that "Rosa Parks is a well-known public figure who has been recognized as an international symbol of freedom, humanity, dignity and strength."<sup>78</sup>

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<sup>71</sup> *Elvis Presley Enter., Inc. v. Capece*, 141 F.3d 188, 199 (5th Cir. 1998).

<sup>72</sup> *Id.*

<sup>73</sup> *Cliffs Notes*, 886 F.2d at 494.

<sup>74</sup> For example, in *Cliffs Notes*, the court applied the Second Circuit test to find that the defendant's publication of *Spy Notes*, a spoof on the popular *Cliffs Notes* summaries of traditional "great books" that mimicked the style and colors of the front cover of *Cliffs Notes*, was protected as a parody and therefore outside the reach of the Lanham Act. *Id.*

<sup>75</sup> *Parks*, 329 F.3d at 447.

<sup>76</sup> *Id.*

<sup>77</sup> *Id.* at 450. Rosa Parks is a historical figure who became a symbol of the civil rights movement in the United States during the 1950's and 1960's. She is best known for an incident in 1955 where, while riding in the front of a segregated bus in Montgomery, Alabama, she refused to give up her seat to a white passenger and move to the back of the bus as was required by the then-existing segregation laws. Her single act of defiance sparked organized boycotts and demonstrations across the South that brought civil and human rights causes to the forefront of American politics. *Id.* at 442.

<sup>78</sup> *Id.* at 453 (reversing the district court's summary judgment in favor of Parks and remanding the case for a factual determination of whether the title "*Rosa Parks*" has any artistic relevance to the

Other examples of application include *Cliffs Notes v. Bantam Doubleday*, a fight involving the publisher of Cliffs Notes, the study guides well-known to most college students, against a competitor's parody called Spy Notes,<sup>79</sup> and, of course, *Rogers v. Grimaldi*, the landmark Second Circuit case involving the silver screen mega-stars of times past: Ginger Rogers and Fred Astaire.<sup>80</sup>

A surprisingly similar case that appeared some fifteen years before the *Rogers* decision, and seven years before the debut of what is now considered the "traditional" trademark factors analysis, involved another cultural icon, Coca-Cola.<sup>81</sup> Indeed, the Eastern District of New York described Coca-Cola as "one of the three most-recognized trademarks in the world" and even went so far as to say that "one would have to be a visitor from another planet" not to immediately recognize the familiar stylized script and accompanying words, colors, and design of the Coca-Cola trademark.<sup>82</sup> The case involved a commercial printer that distributed and sold a poster that modified Coca-Cola's distinctive trademark to read "Enjoy Cocaine."<sup>83</sup> The court applied a more rudimentary balancing of factors analysis to determine that a likelihood of consumer confusion existed and decided the case in favor of Coca-Cola.<sup>84</sup>

However, had this case appeared on the docket today, or arguably anytime after the *Rogers* decision came down, it is possible that the facts of the case would have triggered the Second Circuit analysis. Again, this case involved an undisputable cultural icon, and an artist claiming freedom of expression.<sup>85</sup> The poster manufacturer would likely have fared better today under the Second Circuit analysis because, as First Amendment considerations are placed at the forefront of the inquiry, he would only be

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content of the song by OutKast because only if the title had no artistic relevance to the song would it constitute a violation of the Lanham Act).

<sup>79</sup> *Cliffs Notes*, 886 F.2d at 497 (reversing the district court's grant of a preliminary injunction against Bantam's "Spy Notes" publication because it found Spy Notes to be a parody of the famous Cliffs Notes, noting that "although it surely conjures up the original and goes to great lengths to use some of the identical colors and aspects of the cover design of Cliffs Notes, [it] raises only a slight risk of consumer confusion that is outweighed by the public interest in free expression").

<sup>80</sup> *Rogers*, 875 F.2d at 996 (granting summary judgment in favor of defendant filmmaker, who used the title "Ginger and Fred" for a fictional movie about two Italian cabaret performers who imitated Ginger Rogers and Fred Astaire because the risk that the title would mislead some consumers as to what the work is actually about is outweighed by the danger that suppressing an artistically relevant title would unjustifiably restrict expression).

<sup>81</sup> *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1186 (E.D.N.Y. 1972).

<sup>82</sup> *Id.* at 1187.

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* at 1191.

<sup>85</sup> *Id.* at 1187. The court aptly noted that "one would have to be a visitor from another planet" not to immediately recognize the familiar stylized script and accompanying words, colors and design of the Coca-Cola trademark. *Id.*

required to prove: (1) artistic relevance between usage of the Coca-Cola mark and the underlying “spoof” on the soft-drink giant; and (2) that the poster did not explicitly mislead consumers to believe that Coca-Cola had decided to capitalize on the drug market.<sup>86</sup> While this would be good news for the poster manufacturers of the world, it would be another example in a terrible pattern of cases weakening the legal protection afforded to the owners of trademarks that have become powerful cultural icons.

Aqua’s use of the Barbie mark in the title of the *Barbie Girl* song is clearly justified under the Second Circuit approach. Barbie is a steadfast “symbol of American girlhood.”<sup>87</sup> The court goes so far as to suggest that Barbie is ripe for parody and unrestricted commentary by calling her a public figure and steadfast symbol of American girlhood, while observing that unwanted attention necessarily follows fame.<sup>88</sup> The song relies solely on the Barbie mark to poke fun at Barbie herself and the values that she represents.<sup>89</sup> The song’s primary writer, Soren Rasted, stated that he wanted “to compose a humorous song about the ‘Barbie fantasy world’” and that the song was really commenting on Barbie’s status in popular culture, “like the royal family, which is not to be tampered with.”<sup>90</sup> Thus, the song title has a clear artistic relevance to the underlying work (i.e. the song itself). Further, the title does not explicitly mislead consumers into believing that Mattel produced the song merely because it includes the word Barbie as one half of *Barbie Girl*.<sup>91</sup> As noted in *Mattel*, if the single incantation of Barbie in the title were enough to satisfy the requirement of explicitly misleading as to the content, it would render the Second Circuit test a nullity because such a *per se* rule of trademark infringement would eliminate any need for the balancing provided by the test.<sup>92</sup> It seems clear that the Second Circuit test may be properly applied to the facts of the case at hand.

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<sup>86</sup> It is worth noting that even if the poster manufacturer could win on the trademark infringement claim, Coca-Cola had also alleged a number of other claims, including trademark dilution and unfair competition, on which it would likely prevail. Trademark dilution occurs when an infringing mark “whittles away” at the value of a trademark and tarnishes the mark. *Mattel*, 296 F.3d at 903.

<sup>87</sup> *Id.* at 899.

<sup>88</sup> *Id.*

<sup>89</sup> *Id.* at 901.

<sup>90</sup> *Mattel, Inc.*, 28 F. Supp. 2d at 1138, 1142.

<sup>91</sup> *Id.*

<sup>92</sup> *Mattel*, 296 F.3d at 902.

*B. The Ninth Circuit's Failure to Provide a Boundary on the Public's Right to Comment on Cultural Icons*

Mattel's loss in the Ninth Circuit served a deadly blow to its ability to restrict the public from freely commenting on the Barbie trademark in any given artistic form. Beginning the opinion from the premise that one who seeks fame must be ready to cope with any unwanted attention that necessarily follows, the court appeared to be more influenced by ideas of free expression than the protection of commercial namesakes.<sup>93</sup> It paid particular attention to the notion that a trademark cannot realize the popularity required to become a cultural icon without the direct participation of the public, and thus the public should enjoy the ability to comment on the trademark that it has helped to attain greatness.<sup>94</sup> Considering this public right in deciding that Aqua's use of the Barbie mark did not infringe Mattel's trademark, yet never explaining how future courts are to account for it in a trademark infringement action, the Ninth Circuit failed to provide adequate boundaries on the public's right to comment on cultural icons.

In the consumer-driven world in which we live, the most popular trademarks often enter the popular vernacular and become an integral part of society's language.<sup>95</sup> For example, the Ninth Circuit asks "[h]ow else do you say that something's 'the Rolls Royce of its class?'"<sup>96</sup> Marks that have become irretrievably embedded in our language by public use begin to take on a role apart from their natural source-identifying role, and thus the trademark holder must give some latitude to the public's First Amendment interest in free expression.<sup>97</sup> The Ninth Circuit advocates the "public right" to comment on these popular trademarks by stating that "the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function."<sup>98</sup> In the final decision, however, the court leaves open the question as to how much "right" the public actually has to comment on cultural icons in holding simply that the Barbie mark was not infringed by its use in the title of a musical parody.<sup>99</sup>

No trademark can become famous if left isolated, because fame is

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<sup>93</sup> *Id.* at 899.

<sup>94</sup> *Id.* at 900; *see infra* nn. 118-123.

<sup>95</sup> *Mattel*, 296 F.3d at 900.

<sup>96</sup> *Id.*

<sup>97</sup> *Id.*

<sup>98</sup> *Id.*

<sup>99</sup> *Id.* at 902.

inherently dependent on the public's participation.<sup>100</sup> A trademark owner's hard work and effort to achieve notoriety and a positive reputation in the marketplace is only half of the picture.<sup>101</sup> The ascension of a popular mark to the status of "cultural icon" requires the greatest public effort because one of the touchstones of an icon is that it means something to virtually everybody.<sup>102</sup> Thus, an argument that the public should not have a right to comment on a cultural icon must fail under the view that "one should not get something for nothing."<sup>103</sup>

This position is even stronger in the context of a parody, because not only is the parodist a member of the public that imbued the icon with its popularity, a parodist then invested additional time and resources to express its own opinion about the icon to the public.<sup>104</sup> Indeed, it has been noted that "the vibrancy of culture depends upon the existence of a right to draw ideas from the public domain, and the right to mock cultural icons for both commercial and entertainment purposes."<sup>105</sup>

How much expressive freedom, though, would subject the Barbie trademark to the plight of genericide? "Genericide" is a term of art used to describe the process by which a trademark declines from a unique product identifier to a term that instead refers only to a general class of products.<sup>106</sup> Given that the *Mattel* court appears willing to allow the public to comment freely about Barbie, it is only reasonable to assume that other artists and parodists will emerge in the future to weigh-in on their perception of the Barbie phenomenon.

An attempt to provide guidance from other cases involving cultural icons and expressive freedom provides little help. The trademark "cellophane" lost its trademark protection after nearly ten years of public use as the default name for any cellulose wrapping material.<sup>107</sup> Coca-Cola, however, successfully protected its mark against the distributor of the "Enjoy Cocaine" poster despite the fact that over 100,000 copies of the work had been sold across the United States in less than two years.<sup>108</sup> Elvis Presley, a name unquestionably known throughout America as "The King" and the subject of immeasurable commercial exploitation, both authorized

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<sup>100</sup> Greg Skoch, Student Author, *Commercial Trademark Parody: A Creative Device Worth Protecting*, 9 Kan. J.L. & Pub. Pol'y 357, 360 (1999).

<sup>101</sup> *Id.*

<sup>102</sup> Cordero, *supra* n. 11, at 643.

<sup>103</sup> Skoch, *supra* n. 100, at 360.

<sup>104</sup> *Id.*

<sup>105</sup> Cordero, *supra* n. 11, at 653.

<sup>106</sup> *Murphy Door Bed Co. v. Interior Sleep*, 874 F.2d 95, 95 (2d Cir. 1989).

<sup>107</sup> *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir. 1936).

<sup>108</sup> *Coca-Cola*, 346 F. Supp. at 1187.

and unauthorized, successfully protected the use of his name against a one-time use by the owner of a restaurant named "The Velvet Elvis."<sup>109</sup>

By advocating that the public has some limited right to comment on an icon that it has helped to create, and then remaining mute on the boundaries of this right, the Ninth Circuit has opened the floodgates for potential parodists to have their way with Barbie.<sup>110</sup> The district court recognized that *Barbie Girl* was not the first song to poke fun at Barbie, but was rather only one of among at least ten other such songs, most of which contain heavily disparaging or vulgar comments about Barbie and the values that she represents.<sup>111</sup>

The *Mattel* decision appears to give *carte blanche* permission to anyone seeking to comment about Barbie. How many more parodies will it take before Mattel will effectively lose any right, in a manner similar to that of genericide, to police the use of its mark in the artistic world? So long as future songs have at least some artistic relevance to Barbie and do not explicitly mislead consumers as to Mattel's affiliation with the work, it appears that Mattel's grip on the Barbie mark is set to slip just a bit more with the release of every new song questioning the steadfast symbol of American girlhood.

C. *The Ninth Circuit's Failure to Fully Consider Possible Future Implications to the Barbie Trademark*

MCA's victory in the Ninth Circuit may have been a clear victory for the champions of First Amendment rights, but it also may have marked the beginning of the end for the Barbie mark. The act of recognizing a property right in trademarks carries with it the cost of removing words from common, everyday language.<sup>112</sup> Thus, a trademark holder will be refused protection if the trademark becomes generic and ceases to exclusively relate to the trademark holder's product.<sup>113</sup> In taking into account Barbie's status as a cultural icon, ripe for parody, the Ninth Circuit may have unwittingly forced the Barbie mark towards the beginnings of genericide.<sup>114</sup>

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<sup>109</sup> *Elvis Presley*, 141 F.3d at 200.

<sup>110</sup> *Mattel*, 296 F.3d at 900.

<sup>111</sup> *Mattel, Inc.*, 28 F. Supp. 2d at 1139.

<sup>112</sup> *New Kids on the Block*, 971 F.2d at 306.

<sup>113</sup> *Id.* Although refusing protection to a trademark that has become generic through popular and widespread use in everyday language may appear to defeat the purposes of trademark law, it provides a necessary balance as the primary cost of recognizing a property right in trademarks is the removal of those words from our common language. *Id.*

<sup>114</sup> *Murphy Door Bed*, 874 F.2d at 95.

Denying a generic trademark protection serves the purpose of reducing the likelihood that trademark holders will deplete the stock of useful words from our language by claiming exclusive rights to control their use.<sup>115</sup> A court will hold, as a matter of law, that a mark is generic when it comes to describe a class of goods rather than identifying endorsement of an individual product by the trademark holder.<sup>116</sup> Examples of trademarks that became generic are aspirin and kleenex; rarely today will anyone ask for “acetyl salicylic acid” or “facial tissues” when they are in need of these products.<sup>117</sup>

Similarly, the pop icons of today are constantly being reshaped as our society attempts to invigorate our own images.<sup>118</sup> Ours is a consumer-driven era dominated by material symbols. Cultural icons are the signs of our time and occupy an integral part of the common culture, becoming “conventionalized, systematized and commercialized.”<sup>119</sup> A cultural icon is similar to a well-known and famous celebrity, and can be categorized as being “ultra-distinctive.”<sup>120</sup> The district court went so far as to claim that the word “Barbie” is a cultural icon, stating that it “invokes not only images of the doll itself but also cultural associations (e.g. the doll’s frivolous or unreal nature) that might apply to real people as well.”<sup>121</sup>

The problem with cultural icons as trademarks is that the qualities of a cultural icon (e.g. popular usage in everyday language and cultural associations) appear to parallel those of a generic trademark.<sup>122</sup> Unlike a commercially trademarked product, such as aspirin, a cultural icon does not seem to represent a single, definable object, feeling, or readily discernable concept.<sup>123</sup> Cultural icons represent a particular set of values to a broad

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<sup>115</sup> *New Kids on the Block*, 971 F.2d at 306.

<sup>116</sup> *Id.*

<sup>117</sup> *Id.* See *DuPont*, 85 F.2d at 82 (finding that Dupont’s trademark “cellophane” had become generic after years of common usage because it no longer made any difference to the common public what brand of thin, cellulose wrapping product they received whenever they requested “cellophane” from their local supplier).

<sup>118</sup> Cordero, *supra* n. 11, at 628.

<sup>119</sup> *Id.*

<sup>120</sup> *Id.* at 643-44.

<sup>121</sup> *Mattel, Inc.*, 28 F. Supp. 2d at 1145 n. 32.

<sup>122</sup> Cordero, *supra* n. 11, at 643.

<sup>123</sup> The term “cultural icon” has been employed in numerous judicial opinions to describe a myriad of products and people. See e.g. Tiger Woods, because he is “one of the world’s most famous professional golfers”; *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 918 (6th Cir. 2003); The M&M’s brand of chocolate candies, because it is the largest selling brand of candy in the United States. *Hershey Foods Corp. v. Homestead, Inc.*, 998 F. Supp. 500, 506 (M.D. Pa. 1998); A photograph of actress Demi Moore where she appeared eight months pregnant and nude in the photo, because the photograph appeared on the cover of Vanity Fair magazine and made that issue the best-selling issue of Vanity Fair to date. *Leibovitz v. Paramount Pictures Corp.*, 948 F. Supp. 1214, 1221 (S.D.N.Y. 1996); and Winnie-

group of people and may even represent different values to different individuals.<sup>124</sup> Barbie, for example, “has been seen as feminist and anti-feminist; as seductive and wholesome; as intelligent and as a ‘dumb blond.’” Barbie has been hailed as a role model and condemned as the cause of eating disorders.<sup>125</sup> Thus, outside the realm of children’s dolls, the term “Barbie” in today’s popular culture really describes a class of attributes referencing modern womanhood, just like the term “Band-Aid,” outside the realm of bandages, represents a quick fix.<sup>126</sup> By labeling Barbie as a cultural icon, the court appears to have potentially weakened Mattel’s trademark as against any future infringers who choose to utilize the Barbie mark outside the realm of plastic dolls by providing clear precedent that the Barbie mark, as a public icon, must stand the unwanted attention that comes with its fame.<sup>127</sup>

#### IV. CONCLUSION

The Ninth Circuit’s analysis of the issues surrounding Aqua’s right to use the Barbie name in the title of the *Barbie Girl* song adequately resolved the issue for the day, but provided a disappointing level of consideration of the future implications of its decision. Specifically, the court blindly set forth the policy that the public deserves some limited right to use the Barbie name in any artistic critique of her without addressing the extent to which this public right extends. Further, it provided no guidance as to what underlying facts of a case will trigger application of the Second Circuit test. Finally, the court failed to consider the possible damage that application of this test may have on future alleged infringement actions as against the Barbie mark. Barbie’s life in plastic may be fantastic for advocates of First Amendment protection, but the message it sends to any ultra-successful trademark holder is a disturbing reminder of the perils of being too famous.

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the-Pooh, because in the “seventy-odd years since their creation” the characters “are so recognizable they barely need introduction.” *Milne v. Stephen Slesinger, Inc.*, 2003 U.S. Dist. LEXIS 7942 at \*\*2-3 n.1 (C.D. Ca. May 8, 2003).

<sup>124</sup> Cordero, *supra* n. 11, at 628.

<sup>125</sup> *Mattel, Inc.*, 28 F. Supp. 2d at 1139.

<sup>126</sup> *Mattel*, 296 F.3d at 900.

<sup>127</sup> Presumably, however, the court’s decision would have little bearing on the strength of the Barbie mark as against a competitor who sought to commercialize children’s dolls under the name “Barbie” or any close derivative thereof because the alleged infringer would have little, if any, First Amendment protection and therefore the question would turn to the traditional trademark analysis.