

LITIGATING BARBIE: TRADEMARK INFRINGEMENT, PARODY AND FREE SPEECH

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ABSTRACT

In the contemporary marketplace, trademarks are not mere monikers of origin. While often regarded as commercial symbols, trademarks sometimes become part of the commonplace vocabulary and are indelibly linked to expressing ideas and thoughts. In recent years, the dichotomy of expansive protection offered through the trademark law and use of marks as part of expressive vocabulary has become increasingly controversial. This brings the conception of corporate property at odds with the protections of speech and expressions promised by constitutional jurisprudence. One such trademark which has amassed immense communicative strength is Mattel, Inc.'s Barbie. The mark has assumed an enduring prominence in contemporary language and has assumed the status of a cultural icon. The present study examines the regulation of expressive secondary uses of trademarks by employing Barbie as a case study. Comparatively analyzing the treatment of the Barbie mark in India, the United States of America, and Canada, the authors underline an imperative need to adopt a legislative framework to protect the expressive and artistic secondary use of popular trademarks.

Keywords: Trademark, Barbie, Parody, Free Speech

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We are grateful to Prof. Rebecca Tushnet of Harvard Law for detailed comments on the earlier draft of the paper. Many thanks to Sai Muralidhar, Sriram Prasad and Praachi Misra for discussions and editors of the *Delaware Journal of Corporate Law* for their exceptional support. This project was supported by the Research and Publications Area of IIM Ahmedabad.

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I. INTRODUCTION

In 2022, the Barbie doll turned sixty-three years old. Since her launch, she has dawned over 200 professions,¹ ranked as the world's #1 Toy Property,² and featured as one of 2022's most trusted brands.³ Since 2018, the Barbie mark has consistently accrued over a billion USD worth of gross sales.⁴ With annual sales of fifty-eight million dolls,⁵ Barbie accounts for more than half of Mattel's overall sales.⁶ Barbie's success made her an indelible part of global popular discourse,⁷ particularly within American feminine culture.⁸ With her collectible magazines and loyal fanbase,⁹ Barbie has been reported "to receive more fan mail than Audrey Hepburn and Elizabeth Taylor combined."¹⁰ She exemplifies "some set of values, beliefs and norms in the modern day society[.]"¹¹ and has "shaped the world of play for over three generations."¹²

¹ Melina Glusac, *Barbie Turns 60 This Year. Here are 25 of the Coolest Jobs She's Had.*, INSIDER (Mar. 9, 2019, 11:12 AM), <https://www.insider.com/barbies-coolest-jobs-2019-3>

² *Barbie Named 2020 Top Global Toy Property of the Year, Per NPD*, BUSINESS WIRE (Jan. 27, 2021, 08:41 AM), <https://www.businesswire.com/news/home/20210127005559/en/Barbie-Named-2020-Top-Global-Toy-Property-of-the-Year-Per-NPD>.

³ Nancy Cooper, *Most Trusted Brands in America*, 178 NEWSWEEK GLOB. 44, 44 (2022).

⁴ Rebecca C. Hains, *The Politics of Barbie's Curvy New Body: Marketing Mattel's Fashionistas Line*, in *THE MARKETING OF CHILDREN'S TOYS: CRITICAL PERSPECTIVES ON CHILDREN'S CONSUMER CULTURE* 265, 270, 277 (Rebecca C. Hains & Nancy A. Jennings eds., 2021).

⁵ See Petra Shock, *Barbie dolls and body image*, COSMOS, <https://cosmosmagazine.com/cosmos-briefing/barbie-dolls-and-body-image/> (Oct. 30, 2022) (stating that Barbie dolls enjoy sales of 58 million dolls per year).

⁶ Donna L. Roberts, *The Economics of Barbie: Marketing the Evolution of an Icon Through the Generations*, 22 J. APPLIED BUS. & ECON. 83, 84 (2020).

⁷ See Udo Wagner et al., *Possession Attachment toward Global Brands: How the "World of Barbie" is Shaping the Mindsets of Millennial Girls*, 33 J. INT'L CONSUMER MKTG 434 (2021).

⁸ See Roberts, *supra* note 6, at 84.

⁹ See Marlys Pearson & Paul R. Mullins, *Domesticating Barbie: An Archaeology of Barbie Material Culture and Domestic Ideology*, 3 INT'L J. HIST. ARCHAEOLOGY 225, 227 (1999).

¹⁰ Interesting to note, the two women have three Academy Awards. MARLENE WAGMAN-GELLER, *WOMEN WHO LAUNCH: WOMEN WHO SHATTERED GLASS CEILINGS* 6 (2018). See also JERRY OPPENHEIMER, *TOY MONSTER: THE BIG, BAD WORLD OF MATTEL* 32 (2009).

¹¹ MARY F. ROGERS, *BARBIE CULTURE* 6 (1999).

¹² ORLY LOBEL, *YOU DON'T OWN ME – HOW MATTEL V. MGA ENTERTAINMENT EXPOSED BARBIE'S DARK SIDE: THE LANDMARK COURT BATTLES THAT EXPOSED BARBIE'S DARK SIDE* xx (2018).

Given her extraordinary recollection and recognition, the level of scrutiny, both positive and negative, accrued by Barbie is extraordinary.¹³ The doll has been blamed for being an object that does "the dirty work of patriarchy and capitalism in the most insidious way in the guise of child's play."¹⁴ She has been credited for being a training ground and an "introduction to the kinds of knowledge and social relations one can encounter in a Post-Fordist economy."¹⁵ The sexist and stereotypical approach of Mattel is also reflected in their versions of ethnic dolls.¹⁶ By way of example, modifications to create an "Indian Barbie" have largely remained unsuccessful.¹⁷ In July 2022, the company realigned their Indian strategy and released a pantsuit wearing, dark-skinned version of the doll with "bigger eyes and bold brows" to appease the Indian audiences.¹⁸ It remains to be seen if this new approach would enable Barbie to gain favor from Indian critics and consumers. While Mattel has launched multiple attempts to realign the Barbie image, they have cited their intellectual property ("IP") rights to condemn any such efforts which arise from outside the company.¹⁹ The reimagination of the Barbie image by artists, critics, and parodists has been repeatedly condemned before intellectual property courts.²⁰ The present paper studies the extent to which Mattel can control the secondary use of the Barbie mark.

Initially adopted to designate that the doll is associated with Mattel, Inc., "Barbie" has now transcended the ethos of marketing and commercial practice, assuming the status of a quintessential cultural icon.²¹ However,

¹³ KRISTIN NOELLE WEISSMAN, *BARBIE: THE ICON, THE IMAGE, THE IDEAL: AN ANALYTICAL INTERPRETATION OF THE BARBIE DOLL IN POPULAR CULTURE* 9–11 (1999).

¹⁴ Ann duCille, *Dyes and Dolls: Multicultural Barbie and the Merchandising of Difference*, in *THE BLACK STUDIES READER* 265, 268 (2004).

¹⁵ Jacqueline Urla & Alan C. Swedlund, *The Anthropometry of Barbie: Unsettling Ideals of the Feminine Body in Popular Culture.*, *DEVIANT BODIES: CRITICAL PERSPECTIVES ON DIFFERENCE IN SCIENCE AND POPULAR CULTURE* 277, 282 (Jennifer Terry & Jacqueline Urla eds., illustrated ed. 1995).

¹⁶ Priti Nemani, *Globalization Versus Normative Policy: A Case Study on the Failure of the Barbie Doll in the Indian Market*, 13 *ASIAN-PACIFIC L. & POL'Y J.* 97, 97 (2011).

¹⁷ *Id.*

¹⁸ Rituparna Som, *The First Indian Barbie is About to Change the World*, *VOGUE*, (Jul. 15, 2022), <https://www.vogue.in/beauty/content/the-first-indian-barbie-is-about-to-change-the-world>.

¹⁹ Dan Hunter & Gregory Lastowka, *Barbie*, 18 *TUL. J. TECH. & INTELL. PROP.* 133, 135 (2015).

²⁰ *See id.* at 147–50.

²¹ *Mattel, Inc. v. MCA Records Inc.*, 296 F.3d 894, 898 (9th Cir. 2002); *see also* Steven M Cordero, *Cocaine-Cola, the Velvet Elvis, and Anti-Barbie: Defending the Trademark and Publicity Rights to Cultural Icons*, 8 *FORDHAM INTELL. PROP. MEDIA & ENT. L. J.* 599, 642–44 (1997) (analyzing the meaning of cultural icons).

this transcendence creates a unique problem for trademark law.²² When trademarks become a part of language and serve as the foundation for evocative metaphors, the trademark doctrine struggles to determine the legality of any secondary use of the mark.²³ Barbie has not only come to symbolize the idea of femininity²⁴ and descended into the popular discourse,²⁵ she has also served as ammunition for artistic,²⁶ political and social discourse.²⁷ A shade of this cultural reappropriation can also be gleaned from the political debate surrounding abortion rights in the United States.²⁸ In 2013, Senator Wendy Davis, an American senator from Fort Worth, Texas, gave a thirteen-hour filibuster²⁹ against a pro-life bill introduced in the American Congress.³⁰ Soon enough, in her criticism, the blonde-haired U.S. lawmaker was given the title of "Abortion Barbie."³¹ The use of the Barbie mark as a slur in popular political discourse indicates the integral position the mark embodies in explaining and communicating the understanding of gendered notions.

²² Rochelle Cooper Dreyfuss, *Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity*, in 10 TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 261, 262 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008).

²³ *Id.*; see Mark A. Lemley, *Fame, Parody, and Policing in Trademark Law*, MICH. ST. L. REV. 1, 2 (2019) ("Famous marks become a part of social conversation in a way ordinary marks don't."); see also Susy Frankel, *From Barbie to Renoir: Intellectual Property and Culture*, 41 VICTORIA U. WELLINGTON L. REV. 1 (2010).

²⁴ See Frankel, *supra* note 23; see also Urla & Swedlund, *supra* note 15.

²⁵ Kiran Gore, *Trademark Battles in a Barbie-Cyber World: Trademark Protection of Website Domain Names and the Anticybersquatting Consumer Protection Act*, 31 HASTINGS COMM'NS AND ENT. L. J. 193, 208–12 (2009).

²⁶ See generally Tanya Grae, *To Come Undone*, 46 WOMEN'S STUD. Q. 259 (2018); Tanya Grae, *If Barbie Had a Brain*, 46 WOMEN'S STUD. Q. 261 (2018).

²⁷ See Roberts, *supra* note 6, at 85–87; Louise Collins et al., *We're Not Barbie Girls: Tweens Transform a Feminine Icon*, 24 FEMINIST FORMATIONS 102, 103–126 (2012); Urla & Swedlund, *supra* note 15.

²⁸ See Akhil Reed Amar, *The End of Roe v. Wade*, WALL ST. J. (May 14, 2022, 12:01 AM), <https://www.wsj.com/articles/the-end-of-roe-v-wade-11652453609>.

²⁹ See Catherine Fisk & Erwin Chemerinsky, *The Filibuster*, 49 STAN. L. REV. 181 (1997).

³⁰ Tom Dart, *Wendy Davis's Remarkable Filibuster to Deny Passage of Abortion Bill*, THE GUARDIAN (June 26, 2013, 4:37 PM), <https://www.theguardian.com/world/2013/jun/26/texas-senator-wendy-davis-abortion-bill-speech>.

³¹ Ann Bartow, *Barbie in Bondage: What Orly Lobel's Book "You Don't Owe Me: How Mattel v. MGA Entertainment Exposed Barbie's Dark Side" Tells Us about the Commoditization of the Female Body*, 29 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 435, 450–51 (2018); Elizabeth Dias, *The Toy Barbie Responds to the Wendy Davis Barbie Wars*, TIME (2013), <https://swampland.time.com/2013/08/20/the-toy-barbie-responds-to-the-wendy-davis-barbie-wars/> (last visited Jul 13, 2022) (Mattel even responded to such a use of the Barbie mark by saying that "As a pop-culture icon, Barbie is often references as part of larger conversations occurring in culture.").

There seems to be a "direct conflict between Mattel's interest in controlling usage of its Barbie doll product and the public interest in manipulating the Barbie image to produce new meanings for the larger cultural discourse."³² Prof. Benkler captures this paradox:

A nine-year-old girl searching Google for Barbie will quite quickly find links to AdiosBarbie.com, to the Barbie Liberation Organization (BLO), and to other, similarly critical sites interspersed among those dedicated to selling and playing with the doll. The contested nature of the doll becomes publicly and everywhere apparent, liberated from the confines of feminist-criticism symposia and undergraduate courses.³³

Mattel's use of the intellectual property system to "patrol and control access to Barbie has influenced the development of that system over the last part of the twentieth century and the early part of this century."³⁴ Dubbed an "intellectual property shark,"³⁵ Mattel's assaults have often relied on their trademark rights.³⁶ By focusing on Barbie, we examine the degree of trademark protection afforded to marks that have transcended their purposes as mere monikers of origin and have assumed prominence in contemporary language. Examining the protection afforded to Barbie, as a trademark, allows the authors to examine how constitutional protections intersect with the conception of corporate property within the intellectual property doctrine. To study this development, we identify four judicial decisions from three jurisdictions: the United States, Canada, and India. While Mattel has cited its IP rights in multiple disputes,³⁷ the authors restrict their study to cases where trademark law intersects with constitutional safeguards of speech.

Part II traces the development of the Barbie doll and its ascent as a cultural icon. Part III identifies the major legal opinions where the trademark doctrine has been cited to control the expressive and commercial secondary uses of the trademark Barbie in the United States,

³² Gore, *supra* note 25, at 211.

³³ YOCHAI BENKLER, *THE WEALTH OF NETWORKS – HOW SOCIAL PRODUCTION TRANSFORMS MARKETS AND FREEDOM* 277 (Yale Univ. Press, 2006).

³⁴ Hunter & Lastowka, *supra* note 19, at 135.

³⁵ LOBEL, *supra* note 12.

³⁶ See *A HISTORY OF INTELLECTUAL PROPERTY IN 50 OBJECTS*, 266-67 (Claudy Op den Kamp & Dan Hunter eds., 2019) (discussing the various Barbie trademarks owned by Mattel).

³⁷ See generally *Mattel, Inc. v. MGA Ent., Inc.*, 616 F.3d 904 (9th Cir. 2010); *Mattel, Inc. v. Pitt*, 229 F. Supp. 2d 315 (S.D.N.Y. 2002); *Mattel, Inc. v. Jcom, Inc.*, 48 U.S.P.Q.2d (BL) 1467 (S.D.N.Y. 1998); *Mattel, Inc. v. Internet Dimensions*, 2000 WL 973745 (S.D.N.Y. 2000).

Canada, and India. Part IV studies how an expressive secondary use qualifies itself for constitutional protection and the effect of such protection on trademark liability. Part V studies the scope of trademark liability within the confusion and dilution analysis.

II. CONCEPTUALIZING AND REINTERPRETING BARBIE

Drawing inspiration from German doll "Lilli,"³⁸ Ruth Handler gave life to Barbie in 1959.³⁹ The dichotomy of Barbie's image and cultural values can be traced back to her lineage. The German doll Lilli, was modelled as an underemployed secretary "hooking" to make ends meet.⁴⁰ Lilli was not a children's toy; she was a dashboard ornament or a gag gift for bachelor parties, girlfriends and mistresses.⁴¹ Making minor changes to Lilli, Mattel birthed Barbie.⁴² Some historians note, "Lilli and her new sister were barely distinguishable except to the new doll's creator."⁴³

The criticism and scrutiny⁴⁴ accrued by Barbie can be expressed in terms of a feminist "double bind."⁴⁵ A double bind "emerges in situations where one's options are narrowly defined, and detrimental consequences accompany all choices."⁴⁶ For example, in the context of pregnancy, the fear is that employers will hire fewer women if women are given "special treatment."⁴⁷ On the flip side, if women are not given 'special treatment' during their pregnancies, they will inevitably lose their jobs.⁴⁸ Similarly,

³⁸ See RUTH HANDLER & JACQUELINE SHANNON, *DREAM DOLL: THE RUTH HANDLER STORY* 1–3 (1995); L. G. LORD, *FOREVER BARBIE: THE UNAUTHORIZED BIOGRAPHY OF A REAL DOLL* 3–7 (2004) (explaining how Ruth Handler came across the German doll).

³⁹ See OPPENHEIMER, *supra* note 10, at 1 (While this is the most generally accepted story of the doll's conceptualization, there is some controversy to these chain of events.).

⁴⁰ Hunter & Lastowka, *supra* note 19, at 138 (explaining that Barbie was based off of the character Lilli who was an under-employed secretary who hooked on the side, or at least spent a great deal of time "socializing" with rich sugar daddies to supplement her income).

⁴¹ Hunter & Lastowka, *supra* note 19; ROBIN GERBER, *BARBIE AND RUTH: THE STORY OF THE WORLD'S MOST FAMOUS DOLL AND THE WOMAN WHO CREATED HER* 9–10 (1st Harper paperback ed. 2010).

⁴² See LORD, *supra* note 38, at 32 (explaining the differences between the design of the Lilli and Barbie dolls).

⁴³ GERBER, *supra* note 41, at 13.

⁴⁴ See, e.g., Hains, *supra* note 4, at 268–69.

⁴⁵ Bartow, *supra* note 31, at 446–48.

⁴⁶ Lisa M. Corrigan & Skye de Saint Felix, *A New Doll in Texas: A Feminist Media Analysis of Senator Wendy Davis's Rhetorical Framing as "Abortion Barbie,"* *FEMINIST MEDIA STUDIES* 13 (2021); MARILYN FRYE, *THE POLITICS OF REALITY: ESSAYS IN FEMINIST THEORY* (1983).

⁴⁷ Margaret Jane Radin, *The Pragmatist and the Feminist*, 63 *S. CAL. L. REV.* 1699, 1701 (1990).

⁴⁸ *Id.*

society will censor women who do not prioritize having children.⁴⁹ Concurrently, women actively engaging in parenting are parallelly deemed "occupied and distracted to take on demanding positions in politics or the workplace."⁵⁰ Professor Radin blames the very conceptualization of gender for the existence of this double bind.⁵¹ She refers to it as "an artifact of the dominant social conception of meaning of gender."⁵²

The Barbie doll perfectly embodies this double bind. She has been "celebrated as the prototypical woman and simultaneously blamed for creating unrealistic expectations of women."⁵³ "Barbie is both perfect and perfectly paradoxical: she is every woman, yet she is no woman . . . [s]he is unchangeable yet endlessly mutable . . . [s]he is sexual yet sexless . . . [s]he is white but of all races and ethnicities."⁵⁴ The adoption of Barbie from Lilli meant the "Americanization" of the doll.⁵⁵ For Mattel, this meant shrinking Lilli's lips, removing her nipples, and vagina, while keeping her large breasts and widening her eyes.⁵⁶ These changes "rendered her sexy in clothes, but sexless outside them."⁵⁷ While Mattel has maintained "sexual frisson" as an essential element of the Barbie image, it has been consciously contained, lest it hampers her "wholesome" image.⁵⁸

In the early 1970s, Mattel faced a serious problem: sales dropped as the social consciousness around sexist imagery of women forced parents to consider the effect of the doll on their daughters.⁵⁹ In their attempt to reinvent the Barbie image, Mattel, in 1967, produced its first black doll named "Colored Francie."⁶⁰ The doll received lukewarm market reception and was criticized for being "mere dye-dripped versions of the white Barbie."⁶¹ In 2014, Barbie was given a new profession, as a computer

⁴⁹ Bartow, *supra* note 31, at 448; *see also* Corrigan and de Saint Felix, *supra* note 43 (depicting another iteration of this double bind in the context of Barbie).

⁵⁰ Bartow, *supra* note 31, at 448.

⁵¹ Radin, *supra* note 47, at 1704.

⁵² Radin, *supra* note 47, at 1704.

⁵³ Tamar Buchakjian, *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 (2002).

⁵⁴ LOBEL, *supra* note 12, at 7; *see also* Rebecca Tushnet, *Make Me Walk, Make Me Talk, Do Whatever You Please: Barbie and Exceptions*, in *INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP* 405, 419 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2014).

⁵⁵ Bartow, *supra* note 31, at 447.

⁵⁶ Bartow, *supra* note 31, at 447.

⁵⁷ Bartow, *supra* note 31, at 447.

⁵⁸ Bartow, *supra* note 31, at 447.

⁵⁹ Urla & Swedlund, *supra* note 15, at 282–84.

⁶⁰ duCille, *supra* note 14, at 268.

⁶¹ duCille, *supra* note 14, at 269; Hains, *supra* note 4, at 267.

engineer.⁶² However, she was portrayed only as a design enthusiast who could not write code and installed viruses on her colleagues' computers.⁶³ Mattel could not help but feed the sexist stereotypical image of Barbie. The depiction received severe criticism and was eventually withdrawn.⁶⁴

Mattel has made many attempts to protect and improve the Barbie image.⁶⁵ In 2016, Mattel addressed one of its biggest criticisms; Barbie was no longer a slim blonde with unrealistic body proportions,⁶⁶ and she was now "body positive."⁶⁷ Extensively advertising their newfound fulfilment and to persuade the court of public opinion, Mattel courted Time Magazine to cover its new launch by offering the headline "*Now Can We Stop Talking About My Body?*"⁶⁸ Mattel attempted to establish that its new dolls differed "meaningfully from old offerings."⁶⁹ Barbie's vice president of design, Kim Culmone, said, "When you say 'Barbie' to someone, a very clear image of a blonde haired, blue eyed, slim doll comes to mind. In a few years that will no longer be the case."⁷⁰ Unfortunately for Mattel, the 'curvy' Barbie received similar political, social, satirical, and

⁶² Aisha Gani, *Barbie Can Be a Computer Engineer ... But Only With Help of a Man*, THE GUARDIAN (November 19, 2014, 9:00 PM), <https://www.theguardian.com/lifeandstyle/2014/nov/19/sp-barbie-can-be-a-computer-engineer-but-only-with-help-of-a-man>.

⁶³ Pamela Ribon, *Barbie Fucks it Up Again*, PAMIE (November 17, 2014), <https://pamie.com/2014/11/barbie-fucks-it-up-again/>; Casey Fiesler, *Barbie Really is a Computer Engineer*, SLATE (November 21, 2014, 4:06 PM), <https://slate.com/technology/2014/11/barbie-is-a-computer-engineer-the-terrible-book-gets-remixed.html>.

⁶⁴ Alison Flood, *Barbie Computer Engineer Story Withdrawn After Sexism Row*, THE GUARDIAN (November 21, 2014, 7:16 PM), <https://www.theguardian.com/books/2014/nov/21/barbie-computer-engineer-story-withdrawn-sexist-mattel>.

⁶⁵ See Urla & Swedlund, *supra* note 15, at 282–84.

⁶⁶ See K. D. Brownell & M. A. Napolitano, *Distorting Reality for Children: Body Size Proportions of Barbie and Ken Dolls*, 18 INT. J. EAT. DISORD. 295, 295 (1995) (criticising Barbie for projecting an unrealistic body image); Doeschka J. Anschutz & Rutger C. M. E. Engels, *The Effects of Playing with Thin Dolls on Body Image and Food Intake in Young Girls*, 63 SEX ROLES 621, 622 (2010); JEANNIE B. THOMAS, NAKED BARBIES, WARRIOR JOES, AND OTHER FORMS OF VISIBLE GENDER 6 (illustrated ed. 2003).

⁶⁷ Eliana Dockterman, *Barbie's Got a New Body*, TIME (2016), <https://time.com/barbie-new-body-cover-story/> (last visited May 1, 2022); Claire Bates, *How Does "Curvy Barbie" Compare With an Average Woman?*, BBC NEWS (March 3, 2016), <https://www.bbc.com/news/magazine-35670446>; see also Jennifer A. Harriger et al., *You Can Buy a Child a Curvy Barbie Doll, But You Can't Make Her Like It: Young Girls' Beliefs About Barbie Dolls With Diverse Shapes and Sizes*, 30 BODY IMAGE 107, 107 (2019).

⁶⁸ Eliana Dockterman, *Now Can We Stop Talking About My Body? What Barbie's New Shape Says About American Beauty*, TIME (2016), <https://time.com/barbie-new-body-cover-story/> (last visited May 1, 2022); see Hains, *supra* note 4, at 273–75.

⁶⁹ Hains, *supra* note 4, at 272.

⁷⁰ Victoria Wand, *Barbie Gets Curves*, THE DAILY TELEGRAPH (Jan. 29, 2016), <https://www.pressreader.com/uk/the-daily-telegraph/20160129/282243779618507>.

comical scrutiny.⁷¹ Writing for the National Review, Heather Wilhelm answered Time's cover story's question, "Oh, and as for Time's innocent question- "Now can we stop talking about my body?" The answer is clear, decided no."⁷²

What Barbie may or may not represent "has been and continues to be the subject of sociological and psychological study, of praise, the subject of criticism and the subject of parody."⁷³ With a determined litigative appetite, Mattel has attempted to contain this discourse by citing its entitlements within intellectual property law.⁷⁴ However, Mattel's litigative appetite has reduced since the first decade of the 21st century and their attempts to control the associations of the Barbie mark have not seen many courtrooms in the last decade. In the next section, the authors discuss cases in the select countries where the Barbie mark has been cited to intercept secondary use.

III. FREE SPEECH ACTORS AND MATTEL'S TRADEMARK RIGHTS

Mattel has defended Barbie's trademark with a "militant sense of protectionism."⁷⁵ Mattel has not welcomed a reinterpretation of the "brand image"⁷⁶ associated with Barbie and has chased multiple artists and parodists to trademark courts.⁷⁷ Mattel realized that to continue selling the doll, it had to ensure that *Barbie-ness* was retained and controlled by

⁷¹ Hains, *supra* note 4 at 272–76; *see, e.g.*, Georgea Kovanis, *Curvy Barbie Feels Like Money-Making Gimmick*, DETROIT FREE PRESS (Feb. 2, 2016), <https://www.freep.com/story/life/shopping/georgea-kovanis/2016/02/02/new-curved-barbie/79646364/>; Samantha Cooney, *See All The Cute Body-Positive Dolls Designed to Be Better Than Barbie*, MASHABLE (Jan. 30, 2016), <https://mashable.com/archive/body-positive-barbies>.

⁷² The author criticizes this phenomenon where Barbie is criticized for the gentrification of women. However, this question is unquestionably correct. Heather Wilhelm, *Barbie Proliferates*, 68 NAT'L REV. 23 (2016).

⁷³ Frankel, *supra* note 23, at 9; *see, e.g.*, David Firestone, *While Barbie Talks Tough, G. I. Joe Goes Shopping*, NEW YORK TIMES (Dec. 31, 1993), <https://www.nytimes.com/1993/12/31/us/while-barbie-talks-tough-g-i-joe-goes-shopping.html>.

⁷⁴ After fifty makeovers, Barbie is a public figure and a culture icon. She's also controversial and very litigious. Gore, *supra* note 25, at 209.

⁷⁵ LOBEL, *supra* note 12, at 3; *see also* Gore, *supra* note 25; Tushnet, *supra* note 54; Julie Zando-Dennis, *Not Playing Around: The Chilling Power of the Federal Trademark Dilution Act of 1995* Note, 11 CARDOZO WOMEN'S L. J. 599–630, 626–30 (2004).

⁷⁶ Dev S. Gangjee, *Property in Brands: The Commodification of Conversation*, in CONCEPTS OF PROPERTY IN INTELLECTUAL PROPERTY LAW 29 (Helena Howe ed., 2013) (stating brand image, in marketing literature, covers the construction of an image, containing a set of attributes and qualities, transmitted to passive customers, which it is hoped will "trigger predictable affective and cognitive effects.").

⁷⁷ MARY F. ROGERS, *BARBIE CULTURE* 90–95 (1999).

them.⁷⁸ From that point on, "the doll was no longer central, the important feature was the image and concept of Barbie."⁷⁹

Some scholars have gone so far as to allege that Mattel used litigative strategies to counteract developing market realities.⁸⁰ Mattel adopted a *modus operandi* where it litigated every unauthorized secondary use in the hope of a global chilling effect from isolated single victories.⁸¹ Alleged for being a "trademark bully,"⁸² Mattel not only "abuses the legal system but is also responsible for causing harm to competition and speech interests."⁸³

Given Barbie's descent into language and its popularity as a cultural icon, Mattel's attempts to contain the secondary use presents public interest and free speech concerns. This paper examines four judicial opinions spanning three jurisdictions and presents interesting issues at the intersection of the scope of trademark doctrine and constitutional safeguards of speech.

⁷⁸ Hunter & Lastowka, *supra* note 19, at 142.

⁷⁹ Hunter & Lastowka, *supra* note 19, at 142.

⁸⁰ For example, in 2007, Mattel instituted a case against "China Barbie." This litigation was conveniently instituted at a time when Mattel received considerable criticism owing to the recall of their dolls manufactured in China. Some scholars suggested that this was an attempt by Mattel to control what a Google search for "China Barbie" reveals. *Mattel, Inc. v. Global China Networks, LLC*, No. 07 Civ. 7418(SAS), 2007 WL 3332662 (2007); WILLIAM SPARROW, *RED-LIGHT NIGHTS, BANGKOK DAZE: CHRONICLES OF SEXUALITY ACROSS ASIA* 96 (2008); Lattman Peter, *Was Mattel v. China Barbie Spawned By a Google Search?*, WALL ST. J. (Aug. 23, 2007), <https://www.wsj.com/articles/BL-LB-4330> (last visited May 8, 2022).

⁸¹ The result is that even though trademark owners tend to lose most cases against political and social speech, they still end up shutting down quite a bit of socially valuable speech that the law is not intended to target. Lemley, *supra* note 23.

⁸² U.S. DEPARTMENT OF COMMERCE, *Report to Congress: Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and prevent Counterfeiting* (2011), <https://www.uspto.gov/sites/default/files/trademarks/notices/TrademarkLitigationStudy.pdf> (defining the term trademark bullies as: "a trademark owner that uses its trademark rights to harass and intimidate another business beyond what the law might be reasonably interpreted to allow").

⁸³ See Jessica M Kiser, *To Bully or Not to Bully: Understanding the Role of Uncertainty in Trademark Enforcement Decisions*, 37 COLUM. J. L. & ARTS 211, 211 (2014); see, e.g., Stacey Dogan, *Bullying and Opportunism in Trademark and Right-of-Publicity Law*, 96 B. U. L. REV. 1293 (2016).

*A. United States of America*1. *Mattel v. MCA Records Inc.*

In 1997, Aqua released a song titled "Barbie Girl."⁸⁴ Mocking the Barbie image, the song includes lyrics like: "I am a blond bimbo girl in a fantasy world . . . I can act like a star, I can beg on my knees," and "undress me everywhere."⁸⁵ Mattel claimed infringement, dilution, and unfair competition against MCA for the allegedly "adult-oriented" lyrics.⁸⁶ MCA asserted that the song aimed at lampooning the values associated with Barbie.⁸⁷ Claiming that the doll means different things to different people, MCA submitted that "the doll has been seen as a feminist and anti-feminist; as seductive and as wholesome; as intelligent and as a dumb blonde."⁸⁸ MCA further submitted that "Barbie has been hailed as a role model and has been condemned as the cause of eating disorders."⁸⁹

The primary issue throughout the dispute, from trial to the appellate stage, was whether the song qualifies as a parody. A finding in favor of parody would qualify the song for constitutional protections and safeguards.⁹⁰ Upon examining the lyrics, the band members' comments, and other contributing factors, the court suggested that the song comments on the "shallow, plastic values [Barbie] has come to represent in some circles."⁹¹ Further, the Court held that the lyrics "appear to target for parody a woman who is like Barbie, i.e. a Barbie Girl – one who is plastic, unreal, and easily manipulable by others."⁹² The court argued that the secondary use was attributive rather than commercial,⁹³ and the minimal possibility of consumer confusion was outweighed by free speech interests.⁹⁴ Dealing with dilution, the court ruled that the Aqua Girl song

⁸⁴ *Mattel, Inc. v. MCA Records, Inc.*, 1998 U.S. Dist. LEXIS 7310 at *2, *7–8 (C.D. Cal. 1998) (explaining the background of the case while denying plaintiff's motion for preliminary injunction).

⁸⁵ *Id.*

⁸⁶ *Id.* at 4.

⁸⁷ *Id.* at 45.

⁸⁸ *Mattel, Inc. v. MCA Records, Inc. (MCA I)*, 28 F. Supp. 2d 1120, 1139 (C.D. Cal. 1998).

⁸⁹ *Id.* at 1139.

⁹⁰ *Id.* at 1140.

⁹¹ *MCA I*, 28 F. Supp. 2d at 1139.

⁹² *Id.* at 1138.

⁹³ *Id.* at 1142, 1143; Buchakjian, *supra* note 53, at 1322–28.

⁹⁴ *MCA I*, 28 F. Supp. 2d at 1151–54; Buchakjian, *supra* note 53, at 1327–28.

qualifies as a non-commercial use⁹⁵ and therefore, cannot accrue any liability within the dilution framework.⁹⁶

Subsequently, the parties approached the court of appeals against the decision of the district court.⁹⁷ The court of appeals noted that whenever the public imbues the mark with a meaning beyond its source identifying function, the court cannot cite the trademark doctrine to protect the public discourse surrounding the mark.⁹⁸ Given the expressive and referential nature of the defendants' use, the court applied a nuanced likelihood of confusion analysis.⁹⁹ Since the secondary use was necessary to identify the underlying work and did not mislead the source of the song, no liability could be exacted on the defendants.¹⁰⁰

Coming to the dilution claims, the court viewed the secondary use by the defendants as dilutive but qualifying for the non-commercial speech defense.¹⁰¹ If a secondary use qualifies as a non-commercial speech, it is exempted from liability within the dilution paradigm.¹⁰² Dealing with the import and extent of the provision, the court noted "the song also lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents."¹⁰³ Since the song did more than "propose a commercial transaction," it was protected within the exception.¹⁰⁴ In July 2002, the court of appeals denied all the appeals and affirmed the findings of the District Court.¹⁰⁵

In his judgement, Judge Kozinski noted: "With fame often comes unwanted attention."¹⁰⁶ Barbie's fame, history, and cultural resonance

⁹⁵ Buchakjian, *supra* note 53, at 1328.

⁹⁶ Buchakjian, *supra* note 53, at 1328–30; 15 U.S.C. § 1125(c)(3)(C) (excluding any non-commercial use of the mark from trademark dilution liability); *see also* Lee Ann Lockridge, *When is a Use in Commerce a Noncommercial Use?*, 37 FLA. ST. UNIV. L. REV. 337, 368, 379 (2010).

⁹⁷ *MCA I*, 28 F. Supp. 2d at 1159; *see, e.g.*, Heather Wallack, *Mattel, Inc. v. MCA Record, Inc.*, 12 DEPAUL LCA J. ART, TECH., AND INTEL. PROP. L. 477, 482-83 (2002).

⁹⁸ *Mattel, Inc. v. MCA Records, Inc. (MCA II)*, 296 F.3d 894, 900 (9th Cir. 2002).

⁹⁹ *Id.* at 901 (relying on *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989); *Tushnet, supra* note 54, at 414–15).

¹⁰⁰ *MCA II*, 296 F.3d at 900; *see also* *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989) (explaining that when a title with some artistic relevance to the work is not misleading, it is not considered false advertising).

¹⁰¹ *MCA II*, 296 F.3d at 906–07; *see generally* *Hoffman v. Capital Cities*, 255 F.3d 1180, 1184 (9th Cir. 2001); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66 (1983) (explaining that commercial speech proposes a commercial transaction).

¹⁰² 15 U.S.C. § 1125(c)(3)(C); Patrick D. Curran, *Diluting the Commercial Speech Doctrine: "Noncommercial Use" and the Federal Trademark Dilution Act*, 71 U. CHI. L. REV. 1077, 1081–82 (2004).

¹⁰³ *MCA II*, 296 F.3d at 907.

¹⁰⁴ *Id.* at 906.

¹⁰⁵ *Id.*

¹⁰⁶ *Id.* at 899.

educated the analysis of the court at every stage.¹⁰⁷ In its decision, the court approved the recoding of intellectual property symbols to produce new meanings for the larger cultural discourse.¹⁰⁸ Mattel subsequently filed a writ of certiorari before the United States Supreme Court, which was denied on January 27, 2003.¹⁰⁹

2. Mattel v. Walking Mountain Productions

Another classic example of recoding intellectual property symbols was in *Mattel v. Walking Mountain Productions* ("*Walking Mt. Prods.*").¹¹⁰ In 1997, Thomas Forsythe published a series of seventy-eight photographs titled "Food Chain Barbie," portraying "[a nude Barbie] in danger of being attacked by vintage household appliances."¹¹¹ Forsythe, through his works, had attempted to "'deglamourize Barbie,' 'skewer the Barbie myth,' and expose an 'undercurrent of dissatisfaction with consumer culture.'"¹¹² The series attempted to "critique [] the objectification of women associated with [Barbie], and [to] lambast the conventional beauty myth and the societal acceptance."¹¹³

Forsythe used the mark Barbie in some of the titles of his photographs, which gave way to Mattel's infringement and dilution claims. In explaining why he chose Barbie, Forsythe explained, "Barbie is the most enduring of those products that feed on the insecurities of our beauty and perfection-obsessed culture."¹¹⁴ While Forsythe's work was commercially unsuccessful and earned less than \$4000,¹¹⁵ Mattel tied Forsythe in a "three-year long, \$2 million legal marathon . . . [where] Forsythe was able to afford the litigation only because of donated legal assistance."¹¹⁶ Interestingly, Forsythe's work benefited from the blatant

¹⁰⁷ *MCA II*, 296 F.3d at 899; Gore, *supra* note 25, at 209–13.

¹⁰⁸ For more information about how intellectual property symbols are recoded by public discourse, see generally Justin Hughes, *Recoding Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923, 940–41 (1998).

¹⁰⁹ *Mattel, Inc. v. MCA Records, Inc.*, 537 U.S. 1171 (2003).

¹¹⁰ *Mattel, Inc. v. Walking Mt. Prods. (Walking Mt. Prods.)*, 353 F.3d 792 (2003); Yen-Shyang Tseng, *Protecting the First Amendment Rights of Video Games from Lanham Act and Right of Publicity Claims*, 48 PEPPERDINE L. REV. 425, 436–38 (2021).

¹¹¹ See Hunter & Lastowka, *supra* note 19, at 270.

¹¹² *Walking Mt. Prods.*, 353 F.3d at 811; BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK 592 (8th ed. 2021).

¹¹³ *Walking Mt. Prods. I*, 353 F.3d at 796.

¹¹⁴ *Id.*

¹¹⁵ Tushnet, *supra* note 54, at 418.

¹¹⁶ Mark Sableman, *Artistic Expression Today: Can Artists Use the Language of our Culture*, 52 ST. LOUIS U. L. J. 187, 202–05 (2007).

disregard of the intellectual property doctrine by Mattel.¹¹⁷ If not for the lawsuit, his work would not have received as much publicity and attention as it did. This attraction of unintentional virality is referred to as the "Streisand Effect."¹¹⁸

Mattel contested the suit for copyright and trademark infringement.¹¹⁹ The district court ruled,¹²⁰ and the court of appeals confirmed,¹²¹ that Forsythe's use of the copyrighted Barbie was fair-use and therefore inactionable.¹²² The court of appeals heavily relied on *Mattel v. MCA* when dealing with trademark infringement claims.¹²³ The court reiterated that for trademark law to regulate artistic and commercial speech, the public interest in avoiding confusion should outweigh the public interest in free expression.¹²⁴ Citing the cultural role assumed by the word "Barbie," the court held that the secondary use of the mark was relevant to Forsythe's work and did not explicitly mislead the source of the artistic work.¹²⁵

Referring to the claims of trade dress infringement, the court of appeals referred that Barbie's trade dress also embodies a cultural dimension: "symbolisation of an unattainable ideal of femininity for some women."¹²⁶ Dealing with the nature of the secondary use, the court opined that Forsythe's use of the trade dress amounted to "nominative fair use."¹²⁷ While dealing with the dilution claims, the court concluded that the photographs constituted Forsythe's social view and qualified for the non-commercial speech exception.¹²⁸

The courts in the Mattel judgements effectively recognize that trademarks which are a part of cultural language can be subjected to reinterpretation.¹²⁹ These findings can, if followed, "permit artists, humanists, and commentators to use the symbols and maybe even do so

¹¹⁷ See Sandra Rierson, *The Myth and Reality of Dilution*, 11 DUKE L. & TECH. REV. 212, 278 (2012).

¹¹⁸ See Zubair Nabi, *Resistance Censorship is Futile*, 19 FIRST MONDAY, 2 (2014).

¹¹⁹ Since this paper is concentrated on studying the trademark doctrine, discussions surrounding copyright infringement have been purposefully omitted. For discussions on copyright issues, see generally Dana Drexler, *Mattel Inc. v. Walking Mt. Prods.* 353 F.3d 792 (9th Cir. 2003), 15 DEPAUL J. OF ART, TECH. & INTELL. PROP. L. 433 (2005).

¹²⁰ *Walking Mt. Prods.*, 353 F.3d at 796.

¹²¹ *Id.*

¹²² Drexler, *supra* note 119, at 436–41.

¹²³ See, e.g., *Walking Mt. Prods.*, 353 F.3d at 806–07.

¹²⁴ *Walking Mt. Prods.*, 353 F.3d at 807.

¹²⁵ *Id.*

¹²⁶ *Id.* at 809.

¹²⁷ *Id.* at 47–48; Tushnet, *supra* note 54, at 421–23.

¹²⁸ *Walking Mt. Prods.*, 353 F.3d at 811.

¹²⁹ Sableman, *supra* note 116, at 204.

without the hit and miss predictability of prior law."¹³⁰ Further, the United States Court of Appeals for the Ninth Circuit remanded the case to determine the attorney's fees and other damages in *Walking Mountain*.¹³¹ The defendants were able to recover almost two million dollars in legal fees.¹³² The grant of such an award serves as a necessary deterrent against frivolous litigation attempting to contain expressive speech.¹³³

B. India: *Mattel v. Aman Bijal Mehta*

Identical to the *Mattel v. MCA* dispute, the Indian case concerning the Barbie trademark also involved a song titled "Barbie Girl" as part of a cinematograph film.¹³⁴ Mattel's primary contention was that the lyrics were "suggestive of an adult woman who is sexually attractive and enticing."¹³⁵ Arguing that such a song could be inappropriate for young children, Mattel used its trademark entitlements, claiming infringement and dilution along with defamation.¹³⁶

Highlighting the importance of expressive and artistic speech, Justice Endlaw noted, "India has the benefit of one of the most modern and liberal Constitutions, one of the most cherished rights wherein is to speak one's mind and write what one thinks, no doubt, that is subject to reasonable restrictions, but then the ambit of what one can do is wide."¹³⁷ Considering the findings of the court of appeals in *Mattel v. MCA*, the Delhi High Court noted that the courts should not act as "super censor boards."¹³⁸ If the Central Board of Film Certification¹³⁹ has cleared a film, it shall be presumed that it is not defamatory to anyone.¹⁴⁰

¹³⁰ Sableman, *supra* note 116, at 204; *see* Tushnet, *supra* note 54, at 424–26.

¹³¹ *Walking Mt. Prods.*, 353 F.3d at 816.

¹³² *See* *Mattel, Inc. v. Walking Mt. Prods.*, CV 99-8543 RSWL (RZx), 2004 U.S. Dist. LEXIS 12469, at *11 (June 24, 2004).

¹³³ Tushnet, *supra* note 54, at 424–26.

¹³⁴ *Mattel, Inc. & Anr. v. Aman Bijal Mehta & Ors (Mehta I)*, 2017 SCC OnLine Del 11857 13 (highlighting the similarities between the two disputes).

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *Id.* at 22; *see* E. M. RAO, INDUSTRIAL JURISPRUDENCE A CRITICAL COMMENTARY ch. 10 (First ed. 2015) (ruling the judgement of the court is only an obiter observation, which only has a persuasive authority and lacks any binding precedence).

¹³⁸ *Mehta I*, 2017 SCC OnLine Del 11857 at 23.

¹³⁹ Central Board of Film Certification is a statutory body under Ministry of Information and Broadcasting, regulating the public exhibition of film under the provisions of the Cinematograph Act 1952. Films can be publicly exhibited in India only after they have been certified by the Central Board of film certification.

¹⁴⁰ *Mattel, Inc. & Anr. v. Aman Bijal Mehta & Ors (Mehta II)*, (Delhi) at 23 (Nov. 22, 2017).

Citing the decisions from *Walking Mt. Prods.* and *MCA II*, the court noted, "Barbie is seeking in India what has been denied to it in the Court of its origin."¹⁴¹ Denying the grant to interim relief, the court alluded to Barbie's heritage and cultural resonance, and the fact that the doll has been subjected to repeated criticism and comment.¹⁴²

However, what Mattel failed to achieve in America, it achieved in India. The interlocutory proceedings were *ex-parte* in nature,¹⁴³ and the court issued notices and called upon the defendants to submit their written submissions before the court.¹⁴⁴ Typical of Indian IP litigation, the dispute did not survive the interlocutory stage.¹⁴⁵ The defendants withdrew all references to Barbie and submitted an undertaking to this effect before the court.¹⁴⁶ Thus, on account of premature withdrawal, the dispute failed to delineate the regulation of cultural icons within the Indian trademark doctrine.¹⁴⁷ However, given the language employed by the court in its interlocutory opinion and their explicit allusion to Barbie's cultural resonance and the American legal decisions, the Indian court could have adopted a counterbalancing approach, which could have created a strong argument favoring the "Indian Barbie Girl."¹⁴⁸

C. Canada: *Mattel v. 3894207 Canada Inc.*

In 1992, 3894207 Canada Inc. started using the mark "Barbie's" in reference to three restaurants in Montreal.¹⁴⁹ Between 1992 and 1996, the restaurant generated considerable sales, totaling more than twenty million USD.¹⁵⁰ In 1993, the restaurant owner applied for registration of the mark "Barbie's" in stylized formats for use in association with "restaurant

¹⁴¹ *Id.* at 25.

¹⁴² *Mehta I*, 2017 SCC OnLine Del 11857 at 23–25.

¹⁴³ See HALSBURY'S LAWS OF INDIA, 65.335 (M. N. Venkatachaliah eds., second ed. 2013) (stating Order 39 Rule 3, Civil Procedure Code 1908 empowers a court to grant an *ex-parte* interim injunction if the Court believes that the object of the injunction would be defeated by reason of delay).

¹⁴⁴ *Mehta II*, (Delhi) at 33–34.

¹⁴⁵ A disturbing reality of trademark litigation in India is that many litigations are concluded at an interlocutory stage. The litigants do not take cases to trial. See, e.g., Dev S. Gangjee, *Chapter 12: India*, in INTERNATIONAL TRADEMARK DILUTION (Daniel R Bereskin eds., 2021).

¹⁴⁶ See *Mattel, Inc. & Anr. v. Aman Bijal Mehta & Ors. (Mehta III)*, Unreported Judgments, CS(COMM) 803/2017, Of 2017 decided on Nov. 30 (Dehli), 1–4.

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ Paul D Blanchard et al., *The Barbie Case: The Supreme Court of Canada Restates the Test for Trade-Mark Confusion*, 96 TRADEMARK REP. 1034, 1035 (2006).

¹⁵⁰ See *id.*

services, take-out restaurant services, catering and banquet services."¹⁵¹ Mattel objected to the Defendants' commercial exploitation of the subject mark by citing its right to the exclusive use of the Barbie mark.

Relying on the difference in the wares and services between Mattel's registration and restaurant services, the Trademark Opposition Board¹⁵² rejected Mattel's objection.¹⁵³ On appeal, the Canadian Federal Court also denied the existence of any likelihood of confusion.¹⁵⁴ On further appeal, the Canadian Federal Court of Appeals endorsed the lower courts' findings and argued that if fame could prevent all other uses of a mark, the fundamental concept of granting a trademark in association with certain goods would be meaningless.¹⁵⁵ Eventually, the issue was appealed to the Supreme Court of Canada.¹⁵⁶

In the Canadian dispute, the secondary use was primarily commercial.¹⁵⁷ Therefore, the court relied on the traditional test for confusion¹⁵⁸ and did not adopt a novel test as was the case in the two American decisions.¹⁵⁹ Further, the Canadian Supreme Court held that fame associated with the Barbie mark is only a "surrounding circumstance"¹⁶⁰ and cannot deliver the proverbial knockout blow in a confusion analysis.¹⁶¹ According to Justice Binnie, trademarks are protected because they assure consistency of origin and quality.¹⁶² The

¹⁵¹ Canadian Trademark Office, Application Nos. 736898, 736896.

¹⁵² In Canada, the Trademark Opposition Board acts on behalf of the Registrar of Trademarks in adjudicating trademark opposition proceedings.

¹⁵³ *Mattel, Inc. v. 3894207 Canada Inc.*, [2002] 21 C.P.R. (4th) 83.

¹⁵⁴ *Mattel, Inc. v. 3894207 Canada Inc. et al.*, [2004]30 C.P.R. (4th) 456.

¹⁵⁵ *Mattel, Inc. v. 3894207 Canada Inc.*, [2005] 38 C.P.R. (4th) 83.

¹⁵⁶ *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772 (Can).

¹⁵⁷ *Mattel, Inc. v. S.W. Fantasies, Inc.*, No. 91170977 (T.T.A.B. Sep. 26, 2012); Leason Ellis LLP, *Mattel Prevents Registration of BARBIE GRIFFIN For Adult Entertainment Services*, WORLD TRADEMARK REVIEW (Oct. 15, 2012), <https://www.worldtrademarkreview.com/article/mattel-prevents-registration-of-barbie-griffin-adult-entertainment-services>. In a non-precedential opinion, the Trademark Trial and Appeal Board denied registration of the mark BARBIE GRIFFIN for restaurant and entertainment services and adult entertainment services. The decision relied on the traditional consumer confusion test in arriving at the decision.

¹⁵⁸ The Canadian Trademarks Act of 1985 enlists certain factors for assessment of confusion. The Mattel case highlighted the relevance of fame as one of the factors for addressing confusion. Canadian Trademarks Act of 1985, § 6(5); Robert G. Howell, *A Watershed Year for Well Known or Famous Marks*, in AN EMERGING INTELL. PROP. PARADIGM: PERSPECTIVES FROM CANADA 22, 25–28 (Ysolde Gendreau eds., 2008).

¹⁵⁹ Tushnet, *supra* note 54, at 8–9.

¹⁶⁰ See *Mattel, Inc.*, [2006] 1 SCR 772, 813, 818; see also International Trademark Association, *The Fourteenth Annual International Review of Trademark Jurisprudence*, 97 THE TRADEMARK REPORTER 311, 370–72 (2007); Blanchard et al, *supra* note 149, at 1053.

¹⁶¹ See Howell, *supra* note 158, at 26–27.

¹⁶² See *Mattel, Inc. v. 389207 Canada Inc.*, [2006] 1 SCR 772, 788 (holding that a mark's claim to monopoly rests on serving an important public interest in assuring consumer that they

secondary use cannot be constrained without damage to either of these functions.¹⁶³

The Canadian case is unique in the list of judicial opinions examined in this study. Unlike Forsythe and Aqua, whose secondary use was artistic and expressive, the secondary use before the Canadian Court was commercial. Further, the case before the Canadian Supreme Court arose in a trademark opposition context. Since Canadian trademark law does not allow dilution and misappropriation as grounds for opposing trademark applications,¹⁶⁴ the court was unarmed by concerns of misappropriation or denigration of goodwill.¹⁶⁵ These unique characteristics of the Canadian dispute allow an examination of the intersection between the likelihood of confusion and free speech interests without the dilution paradigm muddying the analysis.

Based on the issues discussed in this section, the authors examine how constitutional and free speech concerns address the infringement and dilution analysis when the secondary use is expressive and artistic.

IV. BARBIE MARK, PARODY AND FREE SPEECH

Parodies and expressive secondary use of trademarks pose interesting questions when the subject marks form part of cultural representation and language. While a finding of parody is not dispositive of liability within trademark law,¹⁶⁶ a determination that the secondary use qualifies as parody activates the free speech doctrine and enables a defendant to counteract trademark protections with constitutional safeguards.¹⁶⁷ This section explores how secondary use of the Barbie mark instigates its parodic reinterpretation.

are buying from the source from whom they think they are buying and receiving the quality which they associate with the particular trademark).

¹⁶³ *Id.* at 817–18; Blanchard et al., *supra* note 149, at 1049.

¹⁶⁴ See Stephanie Chong, *Chalk and Cheese: What's the Connection?*, 24 CANADIAN INTELL. PROP. REV. 1, 7 (2006); JOHN S. MCKEOWN, CANADIAN INTELLECTUAL PROPERTY LAW AND STRATEGY: TRADEMARKS, COPYRIGHT, AND INDUSTRIAL DESIGNS 123–125 (Oxford U. Press, Inc., 2010); see also Howell, *supra* note 158, at 22–27.

¹⁶⁵ See Howell, *supra* note 158, at 27–34 (stating that misappropriation of goodwill is protected within Canadian Trademark Law by Section 22 of the Trademarks Act).

¹⁶⁶ See Sandra L. Rierson, *US Anti-Dilution Law in Historical and Contemporary Context*, in THE CAMBRIDGE HANDBOOK OF INTERNATIONAL AND COMPARATIVE TRADEMARK LAW 483, 495–98 (Irene Calboli & Jane C. Ginsburg eds., 2020).

¹⁶⁷ See *id.* at 495–96; see also *Tommy Hilfiger Licensing Inc. v. Nature Labs*, 221 F. Supp. 2d 410 at 415, (S.D.N.Y. 2002) (noting that parodies and related forms of expression are entitled to First Amendment protection); see also *MCA I*, 28 F. Supp. 3d at 1154–55 (identifying parody as non-commercial, protected speech); cf. *Dr. Seuss Enters v. Penguin Books, USA.*, 109 F.3d 1394, 1400 (9th Cir. 1997) (parody has socially significant values as free speech under the

A workable definition of parody has been the subject of persisting judicial enquiry.¹⁶⁸ The court of appeals in *Louis Vuitton v. Haute Diggity Dog* defines parody as "a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the trademark's owner."¹⁶⁹ A parody relies on a humorous and critical comment to produce the desired effect and distinguish itself from the original trademark.¹⁷⁰ One important element of a successful parody is that it should be able to "conjure up the original."¹⁷¹ The public should be able to "recogni[z]e the underlying mark through the ciphers provided by the parodist."¹⁷² A parodist usually has no interest in creating consumer confusion¹⁷³ and therefore parodies are subjected to scrutiny within the trademark dilution doctrine. While only famous marks are protected within dilution, parodies often rely on the fame of the mark to make their point.¹⁷⁴ In fact, Professor Lemley suggests that parodies can be viewed as a signifier for the fame of a mark.¹⁷⁵ Therefore, while the contours of parody remain continually tested, fame of the original mark is an important element in creating a successful parody.

Desiccating Mattel's claims of hurting Barbie's wholesome image, the district court in *MCA I* noted that "parody inevitably offends others because it so often ridicule[s] sacred verities and prevailing mores."¹⁷⁶

First Amendment); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 493 (2d Cir. 1989) (parody and satire deserving of substantial freedom both as entertainment and as a form of social and literary criticism).

¹⁶⁸ See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 581 (1994) (noting that courts must judge parody on a case-by-case basis).

¹⁶⁹ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC.*, 507 F.3d 252, 260 (4th Cir. 2007).

¹⁷⁰ *Rierson*, *supra* note 166, at 496.

¹⁷¹ Gary Myers, *Trademark Parody: Lessons from the Copyright Decision in Campbell v. Acuff-Rose Music, Inc.*, 59 LAW & CONTEMP. PROBS. 181, 185 (1996); accord *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 588 (1994) (explaining that a successful parodist makes an original statement about something already popularly known).

¹⁷² Sabine Jacques, *Parody Exception: Why Trademark Owners Should Get The Joke*, 38 EUROPEAN INTELL. PROP. REV. 471, 471 (2016).

¹⁷³ See *Louis Vuitton Malletier*, 507 F.3d at 261 (reasoning that "an effective parody will actually diminish the likelihood of confusion" because it enables audiences "to perceive the target of the parody, while simultaneously allowing them to recognize the changes to the mark that make the parody funny or biting.").

¹⁷⁴ See Lemley, *supra* note 23, at 13–14 ("Fame is likely to be particularly relevant in cases of parody and other forms of protected speech about trademarks. Parodies, satire[,] and criticism naturally target or employ well-known brands; making fun off a trademark no one has ever heard of seems a bootless enterprise, and a satire based on a meme no one understands won't be very effective.").

¹⁷⁵ Lemley, *supra* note 23, at 13.

¹⁷⁶ *MCA I*, 28 F. Supp. 3d at 1137 (quoting *L.L. Bean, Inc. v. Drake Publishers*, 811 F.2d 26, 28 (1st Cir. 1987)) (internal quotations omitted).

Highlighting the intrinsic dilemma associated with Barbie, the court noted that many individuals "disagree about the meanings and values associated with the doll."¹⁷⁷ In the court's opinion, "[f]rom the lyrics of the song and the various comments by the Aqua band members, it appears that song was intended to parody both the doll itself and the shallow, plastic values she has come to represent in some circles."¹⁷⁸ In his *Walking Mt. Prod.* opinion, Judge Pregerson relied on the social commentary and cumulative context of Forsythe's work to argue that "Food Chain Barbie" constitutes a parodic reinterpretation.¹⁷⁹

In India, given that the decision was published at an interim stage, the court did not comment on whether the defendants' secondary use qualified as a parodic reinterpretation. However, Justice Endlaw alluded to the importance of protecting free speech and confirmed that any proposed restraint on expressive and artistic speech would have to survive the scrutiny laid down by constitutional protections and safeguards.¹⁸⁰ The court's explicit reliance on *Mattel v. MCA* and *Mattel v. Walking Mt. Prod.* further buttressed this position.

The Indian judiciary has often highlighted the importance of expressive secondary use of trademarks.¹⁸¹ For instance, in *Tata v. Greenpeace*, the defendant reproduced a mark in a video game simulation.¹⁸² Citing its trademark rights, the plaintiff sought to muzzle the defendants' secondary use that was targeted at criticising an infrastructure project.¹⁸³ Relying extensively on international jurisprudence, the court introduced the idea of the "Parody Paradox."¹⁸⁴ The Court emphasized that parody, while distinct from the original mark, relies substantially on the original mark to accomplish its goal.¹⁸⁵ Further, the court noted that the more popular a mark, the more vulnerable it would be to a parodic reinterpretation.¹⁸⁶ In effect, the judiciary has limited the ability of a

¹⁷⁷ *MCA I*, 28 F. Supp. 3d at 1139.

¹⁷⁸ *Id.*

¹⁷⁹ *Walking Mt. Prods.*, 353 F.3d at 796.

¹⁸⁰ *Mehta II*, (Delhi) at 33–34.

¹⁸¹ *Id.*

¹⁸² *Tata Sons Ltd. v. Greenpeace Int'l & Anr.*, (2011) 178 DLT 705.

¹⁸³ *Id.*

¹⁸⁴ *See, e.g.*, *Laugh It Off Promotions CC v. S. African Breweries Int'l (Fin.) BV t/a Sabmark Int'l & Another*, 2005 (8) BCLR 743 (CC); *Esso Francaise SA v. Association Greenpeace France*, 2003 ETMR 66.

¹⁸⁵ *See* Tushnet, *supra* note 54.

¹⁸⁶ Lawrence Liang, *Fair Use of Cinematograph Films and Sound Recordings: Finding the Solution in the Amendment*, 5 WEST BENGAL NAT'L U. JUD. SCI. L. REV. 687, 697, 698 (2012).

trademark owner to control the semiotic landscape by citing a mediation between the trademark doctrine and constitutional safeguards.¹⁸⁷

While the discussion in the Canadian Barbie case was limited to commercial infringement of the Barbie mark, the Canadian trademark doctrine also protects parodies.¹⁸⁸ In 1996, the Federal Court of Canada noted that "the threshold of protecting expression is high."¹⁸⁹ The commercial nature of secondary use looms large in Canada's protection of trademark rights.¹⁹⁰ In *British Columbia Automobile Association v. OPEIU*, the court noted that, in order to be actionable, the statute requires offensive use "in association with wares and services and that contemplates an element of commercial use."¹⁹¹ Further, The Canadian trademark jurisprudence has heavily relied on the lack of an exception for parodic uses in its trademark disputes. In *United Airlines v. Cooperstock*,¹⁹² the court relied on the fact that the secondary use was meant to evoke the original mark to protect the rights of the trademark holder. While such recall is an essential element of every parody, the court enjoined the secondary use.¹⁹³

Thus, while parody was not a question before the Canadian Supreme Court, in both the United State and India, the court determined that the secondary use of Barbie qualifies as a parody. As a result, protections based in free speech and constitutional safeguards serve to protect such use. However, from the discussion in this section, it can be argued that qualification as a parody and gaining subsequent protection thereunder is relatively more difficult in Canada than it is in India or the United States. The next section studies how these constitutional safeguards educate the confusion analysis and dilution claims.

¹⁸⁷ *Id.* at 687.

¹⁸⁸ *Id.*

¹⁸⁹ *Michelin & Cie v. CAW*, [1997] 2 F.C. 306, 112 (Can. Van.).

¹⁹⁰ Sebastian D Beck-Watt, *Just Laugh It Off: Trademark Parody and the Expansion of User Rights*, 30 INTELL. PROP. J. 95 (2017) (noting the tension between the commercial protection of trademark law and the user is right to freedom of expression is admitted to the Canadian jurisprudence).

¹⁹¹ *British Columbia Auto. Assn. v. OPEIU*, [2001] 4 WWR 95 ("in order to be actionable, the statute requires the offending use be a use in association with wares and services and that contemplates an element of commercial use") (internal quotations omitted).

¹⁹² *United Airlines, Inc. v. Cooperstock*, 2017 FC 616.

¹⁹³ Sabine Jacques, *First Application of the Canadian Parody Exception*, 12 J. INTELL. PROP. L. & PRAC. 895 (2017).

V. BARBIE MARK AND LIABILITY THROUGH SECONDARY USE

The influence and relevance of a finding of parody within a trademark infringement proceeding are best explained by Judge Byrne in *Mattel v. MCA ("MCA I")*, when he proclaimed "because this court finds that the song Barbie girl is a parody, it will also consider defendants' first amendment interest in commenting on the popular brand name when evaluating plaintiff's infringement claims."¹⁹⁴ This section examines how the cultural resonance of Barbie, and a finding of parody, determines the context of trademark infringement.

A. Barbie mark and trademark infringement

The confusion analysis examines if "the average relevant consumer or buyer of the good or service in question may well be misled."¹⁹⁵ Many forms of actionable confusion, such as sponsorship and post-sale, have assumed importance in judicial and academic discourse.¹⁹⁶ We analyse the scope of actionable confusion when the subject trademarks amass cultural resonance and are integral parts of the language. While the Barbie judgements guide the analysis in this section, the authors refer to other judgements to supplant the confusion analysis.

The courts of appeals in both *Mattel v. MCA ("MCA II")* and *Walking Mt. Prods.* noted that when trademark law potentially impinges on freedom of speech and expression, the traditional test of confusion¹⁹⁷ "fails to account for the full weight of the public's interest in free expression."¹⁹⁸ In order to accommodate the concerns of free speech and expression, the Courts in both cases referred to the test articulated in *Rogers v. Grimaldi*.¹⁹⁹ The *Rogers* balancing test maintains that judicial

¹⁹⁴ *MCA I*, 28 F. Supp. 2d at 1140.

¹⁹⁵ DANIEL GERVAIS, *THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS* 330 (4th ed. 2012); RASMUS DALGAARD LAUSTSEN, *LIKELIHOOD OF CONFUSION: LEGISLATIVE HARMONISATION?*, in *THE AVERAGE CONSUMER IN CONFUSION-BASED DISPUTES IN EUROPEAN TRADEMARK LAW AND SIMILAR FICTIONS* 253, 260 (Rasmus Dalgaard Laustsen eds., 2020).

¹⁹⁶ See Robert G Bone, *Taking The Confusion Out of Likelihood Of Confusion: Toward a More Sensible Approach to Trademark Infringement*, 106 NORTHWESTERN U. L. REV. 1307, 1315–16 (2012).

¹⁹⁷ *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979) (developing eight specific factors for courts to use in evaluation likelihood of confusion in trademark cases); see also Ryan Baker, *Bidding on Trademarked Keywords in Search Engines: A Trademark Law Update*, 8 WASH. J. L. TECH. & ARTS 543, 543–52 (2013) (discussing the Ninth Circuit's development of the factors).

¹⁹⁸ *Walking Mt. Prods.*, 353 F.3d at 807; *MCA II*, 296 F.3d at 902 (9th Cir. 2002).

¹⁹⁹ *MCA II*, 296 F.3d at 902; *Walking Mt. Prods.*, 353 F.3d at 807.

interference is warranted "only where the public interest in avoiding consumer confusion outweighs the public interest in free speech."²⁰⁰ To determine confusion in an artistic and expressive secondary use, the *Rogers* test posits a two-step analysis providing that no liability can be established unless: "1) the title has no artistic relevance to the underlying work whatsoever or, 2) if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work."²⁰¹

In *MCA II*, the defendants had used the Barbie mark in the title of their song, while in *Walking Mt. Prods.*, the secondary use was in the titles of individual photographs. According to the court of appeals in both cases, "Consumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the publisher or producer."²⁰² In both cases, the defendant's use identified the underlying nature and content of the work, and did not mislead as to the source.²⁰³ Therefore, in both cases, the secondary use survived the *Rogers* test.²⁰⁴ The court of appeals went as far as to suggest that if such use is held to be misleading, it will "*render Rogers nullity*."²⁰⁵ Explaining the confusion analysis further, Judge Pregerson noted that "the public interest in free and artistic expression greatly outweighs its interest in potential consumer confusion about Mattel's sponsorship of Forsythe's works."²⁰⁶ The decisions of the court clarify that the interest in protecting free speech and expression outweighs any possibility of consumer confusion that results from the secondary use.²⁰⁷

Apart from the *Rogers* test, the court in *Mattel v. Walking Mountain* also addressed trade dress infringement claims. It was held that even Barbie's trade dress "plays a role in our culture," and its secondary use would engender similar First Amendment concerns brought forth by the use of the Barbie trademark.²⁰⁸ However, while dealing with trade dress concerns, the court decided to conclude the analysis on a much narrower ground: the nominative fair use exception.²⁰⁹ Explaining the contours of

²⁰⁰ *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

²⁰¹ *Id.*

²⁰² *MCA II*, 296 F.3d at 902; *Walking Mt. Prods.*, 353 F.3d at 802.

²⁰³ *MCA II*, 296 F.3d at 902; *Walking Mt. Prods.*, 353 F.3d at 807.

²⁰⁴ *Walking Mt. Prods.*, 353 F.3d at 802 ("The Barbie mark in the titles of Forsythe's work and on his website accurately describe the subject of the photographs, which in turn, depict Barbie and target the doll with Forsythe's parodic message."); *MCA II*, 296 F.3d at 902 (stating "the use of Barbie in the song title clearly is relevant to the underlying work, namely, the song itself.").

²⁰⁵ *MCA II*, 296 F.3d at 902; *Walking Mt. Prods.*, 353 F.3d at 807.

²⁰⁶ *Walking Mt. Prods.*, 353 F.3d at 807.

²⁰⁷ See Drexler, *supra* note 119; Wallack, *supra* note 97.

²⁰⁸ *Mehta II*, (Delhi) at 33-34 (quoting *Walking Mt. Prods.*, 353 F.3d at 802).

²⁰⁹ *Walking Mt. Prods.*, 353 F.3d at 807; Tushnet, *supra* note 54, at 421.

nominative fair use, the court noted, "where use of the trade dress or mark is grounded in the defendant's desire to refer to the plaintiff's product as a point of reference for the defendant's own work, such a use is nominative."²¹⁰ While the court of appeals in *Mattel v. MCA* did not deem it necessary to address the nominative fair use analysis,²¹¹ the district court's judgement on the issue followed identical reasoning as *Mattel v. Walking Mt. Prods.*²¹²

Turning to India, the court in *Aman Bijal Mehta* did not deal with the confusion analysis in detail. However, in denying the interim relief sought by Mattel, the court extracted the history of the Barbie doll, its association with the German doll, its resonance in contemporary culture, and the fact that she has been the subject of continuous criticism.²¹³ It is possible that if the case had gone to trial, the court would have examined constitutional justifications to counteract the property rights created by the trademark doctrine.

The importance of expressive and parodic uses is well-established in Indian trademark jurisprudence. The Delhi High Court in *Dr. Reddy's v. Eros*, held that "entertainment, literature and other art forms should not be critiqued on by Courts or pertinaciously restrained from its release to the masses...the discomfort generated by an artist's expression cannot be ground for silencing ideas at the altar of maintaining corporate's goodwill."²¹⁴ Therefore, while it is unclear if an expressive secondary use would warrant a novel confusion analysis in India, it is clear that within the court's analysis, constitutional concerns and safeguards will assume a significant role.

²¹⁰ *Walking Mt. Prods.*, 353 F.3d at 810.

²¹¹ The Court believed that its analysis through *Rogers v. Grimaldi* was dispositive of Mattel's claims.

²¹² *MCA I*, 28 F. Supp. 2d at 1141–43.

²¹³ *Mehta II*, (Delhi) at 33–34.

²¹⁴ *Dr. Reddy's Laboratories Limited v. Eros International Media Limited*, 2021 SCC OnLine Del 1298 24 (citing *Tata Sons Ltd. v. Greenpeace Int'l & Anr.*, 45 PTC 275 (2011)). While the court in *Eros* was dealing with an infringement analysis it cited a case which dealt with the dilution paradigm. The eventual language employed by the court is also indicative of dilution concerns. The use of such language suggests that infringement and dilution frameworks are concurrently studied by the Indian court. This results in doctrinal confusion and theoretical misunderstandings. For further reading, see MP Ram Mohan & Aditya Gupta, *Mutation of the trademark doctrine: Analysing actionable use to reconcile brand identities with constitutional safeguards*, IIM-AHMEDABAD WORKING PAPER SERIES (2022).

Unlike *Aman Bijal Mehta, MCA* and *Walking Mt. Prods.*, the dispute in *Mattel v. 3894207 Canada Inc.* did not involve an expressive secondary use.²¹⁵ Given the commercial nature of the secondary use, constitutional concerns did not loom large in the Canadian court's analysis. The court alluded to the traditional test of confusion and adopted a multi-factor analysis to arrive at its conclusion.²¹⁶ The Barbie mark was held to be 1) famous, 2) similar but not identical to the defendant's mark, and 3) with significant divergence in the ware and services in reference to which the two marks were applied.²¹⁷ While important, the fame of the Barbie mark could not act as a *trump card*, and was only given the pedestal of a "surrounding circumstance."²¹⁸ Siding with the decisions from the lower courts, the Supreme Court of Canada allowed the registration of the defendant's mark.

B. Barbie mark and trademark dilution

The traditional underpinnings of trademark law have focused on mitigating and controlling consumer confusion.²¹⁹ On the other hand, the dilution doctrine protects a trademark's *selling power*,²²⁰ rendering otiose any analysis of consumer confusion within the dilution framework.²²¹ The dilution paradigm's explicit dissociation from the traditional focus of trademark law has been counterbalanced with various statutory exceptions.

One important protection within the American dilution doctrine is the non-commercial secondary use.²²² The exception has been interpreted to be "a general exemption for constitutionally protected forms of

²¹⁵ See generally Blanchard, et al., *supra* note 149 (disputing before the Canadian Supreme Court singularly related to commercial use in reference to restaurants); Howell, *supra* note 158, at 1037.

²¹⁶ Howell, *supra* note 158.

²¹⁷ Howell, *supra* note 158.

²¹⁸ *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772 (Can.); see also Howell, *supra* note 158.

²¹⁹ Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1035 (2006).

²²⁰ See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927).

²²¹ *ITC v. Philip Morris*, (2010) ILR II. Del 455; see also *Cipla Ltd. v. Cipla Industries Pvt. Ltd.*, AIR 2017 Bom 75 ("Thus, for attracting sub-section (4), it is not necessary for the plaintiff to show possibility of confusion."); Dev Gangjee, *The Polymorphism of Trademark Dilution in India*, 17 TRANSNAT'L L. & CONTEMP. PROBS. 611 (2008); Akhileshwar Pathak, *Changing Context of Trademark Protection in India: A Review of the Trademarks Act, 1999* (2004).

²²² 15 U.S.C. § 1125(e)(3)(C).

expression and criticism."²²³ In both *Mattel v. MCA* and *Mattel v. Walking Mt. Prods.*, Mattel had claimed that the use of the mark by the defendant amounted to dilution by tarnishment²²⁴ and blurring.²²⁵ Both decisions admitted that the secondary use was dilutive.²²⁶ However, in both cases, the defendants' use did more than propose a commercial transaction and qualified as non-commercial use.²²⁷ In determining the meaning of "commercial use," Judge Kozinski stated in *Mattel v. MCA*, "if the speech is not 'purely commercial,' . . . then it is entitled to full first amendment protection."²²⁸ The Barbie Girl song lampooned Barbie's image, and similarly Forsythe's work represented his social view and interpretation of Barbie. Both works, therefore, do more than propose a commercial transaction. The Barbie decisions from the United States can be cited to conclude that "a broad range of mixed communication those that contain both commercial and non-commercial element be deemed entirely non-commercial."²²⁹ Therefore, whenever the secondary use of cultural icons is concerned, it is not important how much of the secondary use is commercial and does not deserve protection. What is important is how much of the secondary use is expressive and deserves constitutional protection. The existence of expressive use would qualify a defendant's use for the non-commercial use defense.

In India, the court in *Aman Bijal* did not consider the plaintiffs' dilution claim.²³⁰ While Justice Endlaw noted that Mattel claimed trademark dilution, the withdrawal of the case before trial did not allow the court to comment on dilution.²³¹ However, the legislative instruction and judicial guidance in India regarding dilution parallels that within the American trademark doctrine. A "due cause" limitation limits the dilution

²²³ Curran, *supra* note 102, at 1081–82.

²²⁴ 15 U.S.C. § 1125(c); *see* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902–04 (2002); *Mattel, Inc. v. Walking Mountain Prod.*, 353 F.3d 792, 812 (9th Cir. 2003); *see also* AMIR FRIEDMAN, TRADEMARK DILUTION: THE PROTECTION OF REPUTED TRADEMARKS BEYOND LIKELIHOOD OF CONFUSION 3.2.6 (2022) (postulating tarnishment creates negative and damaging associations with the subject mark).

²²⁵ *See supra* FRIEDMAN note 224, at 3.2.5 (reducing the "recallability of the Barbie mark.").

²²⁶ *See MCA II*, 296 F.3d at 903; *Walking Mt. Prods.*, 353 F.3d at 812.

²²⁷ *See MCA II*, 296 F.3d at 903; *Walking Mt. Prods.*, 353 F.3d at 812.

²²⁸ *MCA II*, 296 F.3d at 906–07 (citing *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185–86 (9th Cir. 2001)).

²²⁹ Curran, *supra* note 102, at 1089; *see also* *Am. Fam. Life Ins. Co. v. Hagan*, 266 F.Supp.2d 682, 696 (N.D. Ohio 2002) (affirming the premise that speech that is not purely commercial is not actionable).

²³⁰ *See Mehta I*, 2017 SCC OnLine Del 11857.

²³¹ *See id.*

protection in India.²³² A "justifiable or probable reason"²³³ or a tenable explanation"²³⁴ for the secondary use would trigger the "due cause" limitation. Denominative²³⁵ and non-trademark use,²³⁶ would amount to "due cause." An expressive secondary use for criticism or comedy would easily qualify the due cause requirement and shield any secondary use from liability. While adjudging this limitation, a court would also consider the concerns of free speech and expression,²³⁷ which will further assist in a finding in favor of "due cause."²³⁸ Therefore, if a secondary, albeit commercial, use of the Barbie mark is adjudicated by an Indian court, as long as the secondary use is expressive and constitutes a comment or criticism or amounts to non-trademark use, it would be protected from any liability within the Indian dilution doctrine.

As discussed, the Canadian trademark law does not consider dilution as a ground of opposition;²³⁹ therefore, the dilution concerns were not discussed in *3894207 Canada Inc.* However, the Canadian dilution doctrine swerves on the restrictive side, and a dilution claim is relatively difficult to establish in Canada.²⁴⁰ Similar to the non-trademark use exception in India,²⁴¹ the Canadian dilution doctrine is limited to secondary use in association with wares and goods.²⁴² This means that the Canadian dilution doctrine cannot be activated unless the secondary use designates goods or services. In *Clairol Enterprises*, while the secondary use in packaging activated the dilution doctrine, the use on brochures did not.²⁴³ Similarly, in *Michelin*, Court argued that using the plaintiff's registered

²³² See Gangjee, *supra* note 145, at §12:2.

²³³ *Blue Hill Logistics Private Ltd. v. Ashok Leyland Limited*, 48 PTC (DB) 564 (2011); Gangjee, *supra* note 145, at 322.

²³⁴ *Nestle India Ltd. v. Mood Hospitality India Pvt. Ltd.*, 42 PTC (Del.) 514 (2010); Gangjee, *supra* note 145, at 322–23.

²³⁵ See Renuka Medury, "Denominative" Use of Another's Trademark Can Constitute *Prima Facie* "Due Cause" Under Section 29(4) of the Indian Trade Marks Act, in ANNOTATED LEADING TRADEMARK CASES IN MAJOR ASIAN JURISDICTIONS 187, 192 (Kung-Chung Lio eds., 2019).

²³⁶ *Nestle India Ltd.*, (2010) 42 PTC (Del.); see also AMANDA MICHAELS & ANDREW NORRIS, A PRACTICAL GUIDE TO TRADE MARK LAW 87–88 (5th ed. 2014).

²³⁷ See, e.g., *Tata Sons Ltd.*, (2011) 45 PTC 275.

²³⁸ Gangjee, *supra* note 145, at 12:27.

²³⁹ See MCKEOWN, *supra* note 164, at 123–25; THERESEA M. CORNEAU ET AL., TRADE-MARK PRACTICE IN CANADA: A PRACTICAL GUIDE 99–101 (2011).

²⁴⁰ FRIEDMAN, *supra* note 224, at 105.

²⁴¹ *Nestle India Ltd.*, 42 PTC (Del.) 514 (2010); see also MICHAELS & NORRIS, *supra* note 236, at 87–88.

²⁴² MCKEOWN, *supra* note 164, at 123–28; see also *Veuve Clicquot Ponsardin v. Boutiques Cliquot*, [2006] 1 S.C.R. 824, 49 C.P.R. (4th) 401 (S.C.C.).

²⁴³ *Clairol Int'l Corp. v. Thomas Supply & Equip. Co.*, (1968), 2 Ex. C.R. 552 (Ex. Ct.); MCKEOWN, *supra* note 164, at 125; Daniel R. Bereskin, *Trademark Use in Canada*, 87 TRADEMARK REP. 301, 312–16 (1997).

trademark on pamphlets soliciting participation in union activities did not qualify as 'trademark use' for the dilution doctrine.²⁴⁴

VI. DISCUSSION

Barbie's cultural resonance and history have loomed large in courts' analyses of Mattel's trademark rights. Whenever an expressive secondary use of the Barbie mark is concerned, the judicial discourse invariably turns to the doll's social positioning. The judicial precedents have created important safeguards and deterrents against frivolous litigation concerning expressive uses of secondary marks. After the court of appeals' decisions in *MCA* and *Walking Mt. Prods.*, Mattel seems to have withdrawn its relentless approach in containing the associations of the Barbie mark.²⁴⁵ This is evidenced by the use of the Barbie mark by the American Hip-Hop artist, Nicki Minaj, who not only identifies herself as *Harajuku Barbie*,²⁴⁶ but has also released multiple songs and music videos where the word Barbie is used in conjunction with sexually explicit lyrics.²⁴⁷ While the association of a mark with sexually explicit content has lead multiple intellectual property courts to return a finding of trademark tarnishment,²⁴⁸ the lack of a litigious assault by Mattel can, at least in part, be accredited to the Court's clear enunciation of the social positioning of the Barbie mark.

²⁴⁴ *Michelin*, [1997] 2 F.C. 306 at 112. ; Daniel R. Bereskin QC, *United Airlines, Inc. v. Jeremy Cooperstock: A Critical Review*, 33 INTELL. PROP. J. 91, 99–100 (2020); Bereskin, *supra* note 243, at 316–18.

²⁴⁵ See *Mattel Inc. v. Rap Snacks Inc.*, Case No. 2:22-CV-5702, United States District Court for the Central District of Florida (2022) (Mattel has not proceeded against some very popular uses of the Barbie mark. However, Mattel is still filing litigations to control the commercial use of the mark); Blake Brittain, *Nicki Minaj "Barbie-Que" Chip Maker Hit With Mattel Trademark Lawsuit*, REUTERS (Aug. 12, 2022), <https://www.reuters.com/legal/litigation/nicki-minaj-barbie-que-chip-maker-hit-with-mattel-trademark-lawsuit-2022-08-12/>.

²⁴⁶ Jennifer Dawn Whitney, *Some Assembly Required: Black Barbie and the Fabrication of Nicki Minaj*, 5 GIRLHOOD STUDIES 141, 145 (2012).

²⁴⁷ Nicki Minaj, Mike WILL Made-It - Black Barbies, YOUTUBE (2016), <https://www.youtube.com/watch?v=cWFpjZkBbnU> (last visited Aug 18, 2022); Nicki Minaj - Barbie Tingz, YOUTUBE (2018), <https://www.youtube.com/watch?v=eppa0RXRU-I> (last visited Aug 18, 2022); Nicki Minaj - Barbie Dreams, YOUTUBE (2018), https://www.youtube.com/watch?v=_bvLphVWHpo (last visited Aug 18, 2022).

²⁴⁸ See, e.g., *Mattel, Inc. v. Internet Dimensions*, No. 99 Civ. 10066(HB), 2000 WL 973745 (S.D.N.Y. 2000); Suneal Bedi & David Reibstein, *Measuring Trademark Dilution by Tarnishment*, 95 INDIANA L. J. 683 (2020) (stating the most prevalent and often-argued form of tarnishment is sex tarnishment).

Extrapolating the findings from the Barbie case study to other cultural icons, it can be argued that similar treatment should be afforded to expressive uses of reverent trademarks. However, in India, this conclusion is accompanied by two important caveats: 1) lack of judicial and academic discourse around expressive use of trademarks including parodies,²⁴⁹ and 2) the lack of a proper distinction between actionable misuse and permitted secondary use.²⁵⁰ The lack of clear legislative guidance and recurring reliance on multi-factor tests creates hyper-specialized instances where protection is afforded. This results in ambiguity in the legal doctrine.²⁵¹

Apart from ambiguity, a volatile and unclear approach to intellectual property disputes can result in an incorrect interpretation of the law. For example, the Canadian Federal Court in 2017 enjoined a gripe site targeted at coalescing negative reviews against an airline company.²⁵² The court failed to acknowledge the parodic and expressive nature of the secondary use and did not consider the constitutional safeguards protecting the defendant's use. Given the lack of the counterbalance afforded by constitutional safeguards, the defendant's website was enjoined under both the confusion and the dilution framework.²⁵³

Owing to the lack of any legislative guidelines, courts often build unique standards for litigating the presented disputes. The lack of such a legislative anchor results in omission of a discussion on precedential standards. In 2020, the Delhi High Court enjoined the secondary use of the plaintiff's mark in a YouTube video.²⁵⁴ Without considering the applicability of any judicial safeguards, the Court held that the irreverent representation amounts to tarnishment and is therefore actionable.²⁵⁵ In its decision, the Court did not refer to the discussion from *Tata v. Greenpeace*,²⁵⁶ a case which set the standard for dealing with issues at the intersection of trademark infringement and freedom of speech.

²⁴⁹ Does It Matter If The Judge Laughs?, *MANAGING INTELL. PROP.*, 2010, at 32.

²⁵⁰ Gangjee, *supra* note 145, at 324.

²⁵¹ Tushnet, *supra* note 54.

²⁵² *United Airlines*, 2017 CF 616.

²⁵³ Bereskin, *supra* note 244, at 111–13.

²⁵⁴ *Anhueser Busch, LLC v. Rishav Sharma & Ors*, 83 PTC 217 (India 2020); see also Mohan & Gupta, *supra* note 214.

²⁵⁵ See *Anhueser Busch*, 83 PTC 217; see also Mohan & Gupta, *supra* note 214.

²⁵⁶ See *Tata Sons Ltd.*, (2011) 178 DLT 705.

The resulting ambiguity creates an argument favoring entities like Mattel to flex their intellectual property rights.²⁵⁷ The constitutional assurance of protecting freedom of speech have been confirmed in judicial discourse. It has been confirmed that at the intersection of corporate goodwill and freedom of expression, the discomfort generated by a parody, expressive or satirical speech cannot silence an artist's expression.²⁵⁸ The judicial counterbalancing approach should find some legislative guidance within the scheme of the Indian Trade Marks Act, 1999.²⁵⁹ Lessons can be taken from Copyright law, where protections for expressive uses are baked into copyright statutes through fair use and fair dealing provisions.²⁶⁰ The inclusion of these provisions within the statutes provide for a good model for protecting criticism and expressive secondary use in a legal environment where intellectual property owners are keen to chase artists to intellectual property courts.²⁶¹ While rigid rules may not provide the necessary flexibility to approach a complicated intellectual property dispute, codified legislative standards can provide consistent and predictable guidelines.

The trademark doctrine needs to be crafted in a manner that does not determine the conclusions of expressive use of trademarks through a game of luck. The doctrine has to be so designed that the hit and miss predictability which gives way to overzealous litigation can be avoided.

²⁵⁷ See, e.g., Liz Somerstein, *Who Is Really Protecting Barbie: Goliath or the Silver Knight? A Defense of Mattel's Aggressive International Attempts to Protect Its Barbie Copyright and Trademark*, 39 THE UNIV. OF MIAMI INTER-AMERICAN L. REV. 559, 568–69 (2008).

²⁵⁸ Dr. Reddy's Lab's Ltd. v. Eros Int'l Media Ltd., 2021 SCC OnLine Del 1298 24.

²⁵⁹ The Trade Marks Act, 1999 (India).

²⁶⁰ See USA: Copyright Act of 1976, 17 U.S.C. § 107; see also Canada Copyright Act of 1985 § 29; India Copyright Act of 1985 § 52; Aditya Gupta & Ram MP Mohan, *Right to Research and Copyright Law: From Photocopying to Shadow Libraries*, 11 NYU JOURNAL OF INTELLECTUAL PROPERTY & ENTERTAINMENT LAW (2022), <https://jipel.law.nyu.edu/right-to-research-and-copyright-law-from-photocopying-to-shadow-libraries/> (last visited Nov 8, 2022); PAUL GOLDSTEIN & P. B. HUGENHOLTZ, INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE 11 (Fourth edition ed. 2019).

²⁶¹ Tushnet, *supra* note 54.