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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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, particularly within American feminine culture.\(^7\) With her collectible magazines and loyal fanbase, Barbie has been reported "to receive more fan mail than Audrey Hepburn and Elizabeth Taylor combined."\(^8\) She exemplifies "some set of values, beliefs and norms in the modern day society[,]"\(^9\) and has "shaped the world of play for over three generations."\(^10\)

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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
3 Nancy Cooper, Most Trusted Brands in America, 178 NEWSWEEK GLOB. 44, 44 (2022).
8 See Roberts, supra note 6, at 84.
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).
Given her extraordinary recollection and recognition, the level of scrutiny, both positive and negative, accrued by Barbie is extraordinary. 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." 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." The sexist and stereotypical approach of Mattel is also reflected in their versions of ethnic dolls. By way of example, modifications to create an "Indian Barbie" have largely remained unsuccessful. 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. 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. The reimagination of the Barbie image by artists, critics, and parodists has been repeatedly condemned before intellectual property courts. 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. However,
this transcendence creates a unique problem for trademark law.\textsuperscript{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.\textsuperscript{23} Barbie has not only come to symbolize the idea of femininity\textsuperscript{24} and descended into the popular discourse,\textsuperscript{25} she has also served as ammunition for artistic,\textsuperscript{26} political and social discourse.\textsuperscript{27} A shade of this cultural reappropriation can also be gleaned from the political debate surrounding abortion rights in the United States.\textsuperscript{28} In 2013, Senator Wendy Davis, an American senator from Fort Worth, Texas, gave a thirteen-hour filibuster\textsuperscript{29} against a pro-life bill introduced in the American Congress.\textsuperscript{30} Soon enough, in her criticism, the blonde-haired U.S. lawmaker was given the title of "Abortion Barbie."\textsuperscript{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.

\begin{thebibliography}{99}
\bibitem{Frankel24} See Frankel, supra note 23; see also Urla & Swedlund, supra note 15.
\bibitem{Urla27} 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.
\end{thebibliography}
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." 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.

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." Dubbed an "intellectual property shark," Mattel's assaults have often relied on their trademark rights. 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, 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.
34 Hunter & Lastowka, supra note 19, at 135.
35 Lobel, supra note 12.
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,

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).
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.
48 Id.
Concurrently, women actively engaging in parenting are parallely deemed "occupied and distracted to take on demanding positions in politics or the workplace." \(^{30}\) 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-dipped versions of the white Barbie." \(^{61}\) In 2014, Barbie was given a new profession, as a computer

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

\(^{50}\) Bartow, \textsuperscript{supra} note 31, at 448.

\(^{51}\) Radin, \textsuperscript{supra} note 47, at 1704.

\(^{52}\) Radin, \textsuperscript{supra} note 47, at 1704.


\(^{54}\) \textit{Lobel}, \textsuperscript{supra} note 12, at 7; see also Rebecca Tushnet, \textit{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, \textsuperscript{supra} note 31, at 447.

\(^{56}\) Bartow, \textsuperscript{supra} note 31, at 447.

\(^{57}\) Bartow, \textsuperscript{supra} note 31, at 447.

\(^{58}\) Bartow, \textsuperscript{supra} note 31, at 447.

\(^{59}\) Urla & Swedlund, \textsuperscript{supra} note 15, at 282–84.

\(^{60}\) duCille, \textsuperscript{supra} note 14, at 268.

\(^{61}\) duCille, \textsuperscript{supra} note 14, at 269; Hains, \textsuperscript{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

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\(^{69}\) Hains, *supra* note 4, at 272.

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).

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

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

\textsuperscript{78} Hunter & Lastowka, supra note 19, at 142.
\textsuperscript{79} Hunter & Lastowka, supra note 19, at 142.
\textsuperscript{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).
\textsuperscript{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.
\textsuperscript{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/noticesTrademarkLitigationStudy.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").
\textsuperscript{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-Privacy 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." 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." Mattel claimed infringement, dilution, and unfair competition against MCA for the allegedly "adult-oriented" lyrics. MCA asserted that the song aimed at lampooning the values associated with Barbie. 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." MCA further submitted that "Barbie has been hailed as a role model and has been condemned as the cause of eating disorders." 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. 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." 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." The court argued that the secondary use was attributive rather than commercial, and the minimal possibility of consumer confusion was outweighed by free speech interests. Dealing with dilution, the court ruled that the Aqua Girl song

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85 Id.
86 Id. at 4.
87 Id. at 45.
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.
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

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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 INTELL. 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).
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. In its decision, the court approved the recoding of intellectual property symbols to produce new meanings for the larger cultural discourse. Mattel subsequently filed a writ of certiorari before the United States Supreme Court, which was denied on January 27, 2003.

2. Mattel v. Walking Mountain Productions

Another classic example of recoding intellectual property symbols was in Mattel v. Walking Mountain Productions ("Walking Mt. Prods."). 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." Forsythe, through his works, had attempted to "deglamourize Barbie," 'skewer the Barbie myth,' and expose an 'undercurrent of dissatisfaction with consumer culture.' The series attempted to "critique [] the objectification of women associated with [Barbie], and [to] lambast the conventional beauty myth and the societal acceptance."

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." While Forsythe's work was commercially unsuccessful and earned less than $4000, 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." Interestingly, Forsythe's work benefited from the blatant

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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).
111 See Hunter & Lastowka, supra note 19, at 270.
113 Walking Mt. Prods. I, 353 F.3d at 796.
114 Id.
115 Tushnet, supra note 54, at 418.
disregard of the intellectual property doctrine by Mattel. 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." Mattel contested the suit for copyright and trademark infringement. The district court ruled, and the court of appeals confirmed, that Forsythe's use of the copyrighted Barbie was fair-use and therefore inactionable. The court of appeals heavily relied on Mattel v. MCA when dealing with trademark infringement claims. 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. 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.

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." Dealing with the nature of the secondary use, the court opined that Forsythe's use of the trade dress amounted to "nominative fair use." 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.

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

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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. 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*. The defendants were able to recover almost two million dollars in legal fees. The grant of such an award serves as a necessary deterrent against frivolous litigation attempting to contain expressive speech.

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. Mattel's primary contention was that the lyrics were "suggestive of an adult woman who is sexually attractive and enticing." Arguing that such a song could be inappropriate for young children, Mattel used its trademark entitlements, claiming infringement and dilution along with defamation.

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." 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." If the Central Board of Film Certification has cleared a film, it shall be presumed that it is not defamatory to anyone.
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

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141 *Id.* at 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 (Delhi), 1–4.
147 *Id.*
148 *Id.*
150 *See id.*
services, take-out restaurant services, catering and banquet services.”

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 Board rejected Mattel's objection. On appeal, the Canadian Federal Court also denied the existence of any likelihood of confusion. On further appeal, the Canadian Federal Court of Appeals endorsed the lower courts' findings and argued that if fame could preclude all other uses of a mark, the fundamental concept of granting a trademark in association with certain goods would be meaningless. Eventually, the issue was appealed to the Supreme Court of Canada.

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

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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.
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.
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 unarmored 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.


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).


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. 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." A parody relies on a humorous and critical comment to produce the desired effect and distinguish itself from the original trademark. One important element of a successful parody is that it should be able to "conjure up the original." The public should be able to "recognize the underlying mark through the ciphers provided by the parodist." A parodist usually has no interest in creating consumer confusion 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. In fact, Professor Lemley suggests that parodies can be viewed as a signifier for the fame of a mark. 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."
Highlighting the intrinsic dilemma associated with Barbie, the court noted that many individuals "disagree about the meanings and values associated with the doll." In the court's opinion, "from 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." 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.

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

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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.
185 See Tushnet, supra note 54.
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 injuncted 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.
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.
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." 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." Many forms of actionable confusion, such as sponsorship and post-sale, have assumed importance in judicial and academic discourse. 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 confusion "fails to account for the full weight of the public's interest in free expression." 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. The Rogers balancing test maintains that judicial

194 MCA I, 28 F. Supp. 2d at 1140.
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." 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.

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." In both cases, the defendant's use identified the underlying nature and content of the work, and did not mislead as to the source. Therefore, in both cases, the secondary use survived the Rogers test. The court of appeals went as far as to suggest that if such use is held to be misleading, it will "render Rogers nullity." 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." 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.

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. However, while dealing with trade dress concerns, the court decided to conclude the analysis on a much narrower ground: the nominative fair use exception. Explaining the contours of

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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."

While the court of appeals in Mattel v. MCA did not deem it necessary to address the nominative fair use analysis, the district court's judgement on the issue followed identical reasoning as Mattel v. Walking Mt. Prods.

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. 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." 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.

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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 T 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

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\(^{215}\) 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.


expression and criticism. 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 tarnishment and blurring. Both decisions admitted that the secondary use was dilutive. However, in both cases, the defendants’ use did more than propose a commercial transaction and qualified as non-commercial use. 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." 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." 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. 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. 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

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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).
231 See id.
protection in India. A "justifiable or probable reason" or a tenable explanation for the secondary use would trigger the "due cause" limitation. Denominative and non-trademark use 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, which will further assist in a finding in favor of "due cause." 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; 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. Similar to the non-trademark use exception in India, the Canadian dilution doctrine is limited to secondary use in association with wares and goods. 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. Similarly, in Michelin, Court argued that using the plaintiff's registered

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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.
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.
trademark on pamphlets soliciting participation in union activities did not qualify as 'trademark use' for the dilution doctrine.\textsuperscript{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 \textit{MCA} and \textit{Walking Mt. Prods.}, Mattel seems to have withdrawn its relentless approach in containing the associations of the Barbie mark.\textsuperscript{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 \textit{Harajuku Barbie},\textsuperscript{246} but has also released multiple songs and music videos where the word Barbie is used in conjunction with sexually explicit lyrics.\textsuperscript{247} While the association of a mark with sexually explicit content has lead multiple intellectual property courts to return a finding of trademark tarnishment,\textsuperscript{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.


\textsuperscript{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/.

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


\textsuperscript{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, and 2) the lack of a proper distinction between actionable misuse and permitted secondary use. 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.

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 injunction a gripe site targeted at coalescing negative reviews against an airline company. 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 injunction under both the confusion and the dilution framework.

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 injunction the secondary use of the plaintiff's mark in a YouTube video. Without considering the applicability of any judicial safeguards, the Court held that the irreverent representation amounts to tarnishment and is therefore actionable. In its decision, the Court did not refer to the discussion from Tata v. Greenpeace, a case which set the standard for dealing with issues at the intersection of trademark infringement and freedom of speech.

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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. 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. The judicial counterbalancing approach should find some legislative guidance within the scheme of the Indian Trade Marks Act, 1999. Lessons can be taken from Copyright law, where protections for expressive uses are baked into copyright statutes through fair use and fair dealing provisions. 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. 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.


259 The Trade Marks Act, 1999 (India).


261 Tushnet, supra note 54.