

5-1-1999

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Recommended Citation

Alyson Lewis, *Playing Around with Barbie: Expanding Fair Use for Cultural Icons*, 1 Chi. -Kent J. Intell. Prop. 61 (1999).

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PLAYING AROUND WITH BARBIE®

Expanding Fair Use for Cultural Icons

Alyson Lewis¹

Introduction

Freedom to speak and write about public questions is as important to the life of our government as is the heart to the human body. In fact, this privilege is the heart of our government. If that heart be weakened, the result is debilitation; if it be stilled, the result is death.
Hugo Black²

At the hands of postmodernity, our society has suffered dramatic changes in how it creates and disseminates cultural meaning.³ The media decides what we hear and how we see. This postmodern condition has caused a restructuring of capitalism, consolidating mass communications in corporate conglomerates and penetrating society with electronic media and information technologies.⁴ This condition fuels consumption, while consumption is managed by fewer and fewer mass media voices.⁵ “[O]ur modern media images, if they fascinate us so much it is not because they are

¹ J.D. 1999, University of California, Hastings College of the Law. The author would like to thank Professors Margreth Barrett and Ashutosh Bhagwat for their instruction and guidance.

² *Drivers v. Meadowmore Dairies*, 312 U.S. 287, 301-02 (1942)(Black, J. dissenting).

³ See Rosemary Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853, 1853-61 (1991); see generally David Harvey, *The Condition of Postmodernism: An Enquiry into the Origins of Cultural Change* (1990); Pierre Schlag, *Normative and Nowhere to Go*, 43 STAN. L. REV. 167 (1990).

⁴ See Coombe, *supra*, n.2 at 1862.

⁵ See Keith Aoki, *How the World Dreams Itself to be American: Reflections on the Relationship Between the Expanding Scope of Trademark Protection and Free Speech*, 17 LOY. L.A. ENT. L.J. 523, 523 n.3 (1997); see also Ben Bagdikian, *THE MEDIA MONOPOLY* 4 (2d ed. 1987).

sites of the production of meaning and representation . . . it is on the contrary because they are sites of the disappearance of meaning and representation”⁶

This consolidation of power has reeked havoc on how our culture creates and disseminates meaning.⁷ The mass media’s pervasiveness spreads this imagery and information into every home and highway to ensure production and demand.⁸ “Goods are increasingly sold by harnessing symbols, and the proliferation of mass media imagery means that we increasingly occupy the ‘cultural’ world of signs and signifiers that have no traditional meanings within social communities or organic traditions.”⁹ We associate a swooshed check mark with a product by Nike®, a purple dinosaur with Barney®, and a pink bunny with Energizer®.

In recent decades, several scholars have noted that the present state of trademark and copyright law ineffectively deals with this cultural condition.¹⁰ “[T]he law has moved more and more of our culture’s basic semiotic and symbolic resources out of the public domain and into private hands.”¹¹ Judge Kozinski for the Ninth Circuit Court of Appeals echoed these concerns:

⁶ See Aoki, *supra*, n.5 at 523.

⁷ *Id.*

⁸ See Coombe, *supra*, n.3 at 1862.

⁹ See Coombe, *supra*, n.3 at 1863.

¹⁰ See Michael Madow, Private Ownership of Public Image: Popular Culture and Publicity Rights, 81 CAL. L. REV. 125, 142 (1993)(citing David Lange, Recognizing the Public Domain, 44 LAW & CONTEMP. PROBS. 147, 171 (1981)(expressing concern that contemporary intellectual property law is choking off access to the “public domain”); Jane M. Gaines, CONTESTED CULTURE: THE IMAGE, THE VOICE, AND THE LAW 232-39 (1991)(arguing that current intellectual property law may be curtailing popular cultural production); Coombe, *supra*, n.3 at 1855 (arguing that in the current climate “intellectual property laws stifle dialogic practices -- preventing us from using the most powerful, prevalent, and accessible cultural forms to express identity, community, and difference”); Wendy J. Gordon, On Owning Information: Intellectual Property and the Restitutionary Impulse, 78 VA. L. REV. 149, 156-57 (1992)(observing that the recent judicial trend toward recognizing new intellectual property rights “sometimes may interfere impermissibly with the autonomy of others and with efforts by individuals to achieve cultural self-determination”)).

¹¹ Madow, *supra*, n.10 at 142.

Something very dangerous is going on here. Private property, including intellectual property, is essential to our way of life. It provides an incentive for investment and innovation; it stimulates the flourishing of our culture; it protects the moral entitlements of people to the fruits of their labors . . . reducing too much to private property can be bad medicine.¹²

Instead of expanding protections for private property,¹³ intellectual property law should retreat, leaving the cultural essence of symbolic speech in the public domain. “The law can strengthen the already potent grip of the culture industries over the production and circulation of meaning, or it can facilitate popular participation . . . in the processes by which meaning is made and communicated.”¹⁴ The social critiques of pop culture should be encouraged, even in commercial speech. To achieve this goal, the law should pull tighter reins on the doctrine of dilution of trademark. At the same time, under copyright law, courts should expand their interpretations of the doctrine of fair use to allow commercial uses when the use acts as a social critique.¹⁵

This Note will argue that the commercial use of social icons, or symbols, should be allowed as a means by which our culture necessarily communicates. First, I will discuss the underlying policies behind copyright¹⁶ and trademark¹⁷ protection, the recent trends in their development, and proposed solutions. Second, I will apply this new framework to toy maker Mattel’s most famous product, Barbie.¹⁸ Finally, this

¹² *White v. Samsung*, 989 F.2d 1512, 1513 (9th Cir. 1993)(Kozinski, J. dissenting). While Judge Kozinski was speaking of the majority’s grant of publicity right to Vanna White without a parody exception, his reasoning applies equally as well in the contexts of copyright and trademark protection.

¹³ *See* Jessica Litman, *Mickey Mouse Emeritus: Character Protection and the Public Domain*, 11 U. MIAMI ENT. & SPORTS L. REV. 429, 429 (1994)(arguing that the “intellectual property epidemic of the current era is the call to give increased legal protection to something because it is valuable”).

¹⁴ Madow, *supra*, n.10 at 141-42.

¹⁵ The term “social critique”, refers to criticism in the broadest sense, broader than the word parody implies.

¹⁶ *See* discussion *infra* Part II.

¹⁷ *See* discussion *infra* Part III.

¹⁸ *See* discussion *infra* Part V. For a description of the intellectual property battles of G.I. Joe, *See* Jack Guggenheim, *The Legal Battles of G.I. Joe : The*

Note will conclude with a discussion of how the law should change to accommodate the changing nature of intellectual property while fulfilling the original policy objectives of trademark and copyright protection.¹⁹

II. Copyright

Copyright is the Cinderella of the law. Her rich older sisters, Franchises and Patents, long crowded her into the chimney-corner. Suddenly the fairy godmother, Invention, endowed her with mechanical and electrical devices as magical as the pumpkin coach and the mice footmen. Now she whirls through mad mazes of a glamorous ball.

Zechariah Chafee²⁰

A. *The Origins of Copyright Law*

Copyright law stems from Congress' express power under Article I, section 8 of the Constitution, which authorizes Congress to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."²¹ The Supreme Court has allowed Congress broad power to grant and decline copyrights noting that the "primary objective of copyright is *not* to reward the labor of authors," but to fulfill this constitutional aim of promoting "the Progress of Science and useful Arts."²² Thus, the policy driving copyright legislation is to "foster growth of learning and culture for the public welfare, and the grant of exclusive rights to authors for a limited time as a means to that end."²³ The goal is to spur creative genius so the public can prosper "after the

Jurisprudence of Distinctive Fingernails, Action Figures, Ninja's, and Distinguished Marines, 80 J PAT. & TRADEMARK OFF. SOC'Y 831 (1998).

¹⁹ See discussion *infra* Part VI.

²⁰ Zechariah Chafee, Jr., Reflections on the Law of Copyright, 45 COLUM. L. REV. 503, 503 (1945).

²¹ U.S. CONST. art. I, § 8.

²² Feist Publications, Inc. v. Rural Tel. Co., Inc., 499 U.S. 340, 349 (1991)(emphasis added)(citing U.S. CONST. art. I, § 8).

²³ Margreth Barrett, *Intellectual Property*, 352 (West 1995); see also, Feist,

limited period of exclusive control has expired.”²⁴ The Supreme Court has also reminded us that we should always keep the goals of copyright law in mind when applying a particular fact pattern to the law.²⁵

There are always two competing interests at stake in copyright law: the interest of the author of the creative work and the interest of the public in benefiting from the work.²⁶ Because of the strong public interest, a copyright holder’s rights are not unlimited.²⁷ For example, the Copyright Act protects the expression of an idea, but not the idea itself.²⁸ Facts are also excluded from copyright protection.²⁹ Both facts and ideas remain in the public domain.

B. The Fair Use Doctrine

An additional limitation of copyright is the judicially created fair use doctrine.³⁰ Congress codified the fair use doctrine in section 107 of the Copyright Act stating that “the fair use of a copyrighted work . . . for purposes such as criticism [and] comment . . . is not an infringement of copyright.”³¹ The fair use doctrine seeks to strike a balance between the competing interests of the author(s) and the public during

499 U.S. at 350.

²⁴ *Sony Corp. of Am. v. Universal Studios, Inc.*, 464 U.S. 417, 429 (1984).

²⁵ *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994).

²⁶ *See Barrett, supra*, n.23 at 350-54.

²⁷ *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547 (1985)(copyright owner’s rights exclude facts, ideas, and fair use); *see also Acuff-Rose*, 510 U.S. at 575 n.5.

²⁸ *See Copyright Act of 1976*, 17 U.S.C.A. §§ 101-1010 (West 1997)(as amended)[hereinafter “Copyright Act”].

²⁹ *Feist*, 499 U.S. at 359 (“Facts contained in existing works may be freely copied”).

³⁰ *See Acuff-Rose*, 510 U.S. at 575; *see also* W. Patry, *The Fair Use Privilege in Copyright Law* 6-17 (1985); Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990); 17 U.S.C.A. § 107.

³¹ *Limitation on Exclusive Rights: Fair Use*, 17 U.S.C.A. § 107.

the limited period in which the copyright holder has exclusive control over her work.³²

However, this permissive use is not as broad as the literal reading would suggest. Congress set out four factors to help determine whether the use of a particular work qualifies as a fair use: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes, (2) the nature of the copyrighted work, (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole, and (4) the effect of the use upon the potential market for or value of the copyrighted work.³³ The first two factors focus on the alleged infringement and the copyrighted material respectfully, while the second two factors add degree of use and its effect respectively.

In applying these four factors courts have repeatedly found that parody is a fair use, but have had difficulty defining a parody.³⁴ In *Acuff-Rose*, the Supreme Court attempted to define a parody but because the inquiry is necessarily a case-by-case analysis, the courts are still split on how to apply the fair use defense.³⁵ The Court's definition of a parody leaves much room for courts to interpret a particular work either way.³⁶

For the purposes of copyright law, the nub of the definitions, and the heart of any parodist's claim to quote from existing material, is the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish), and other factors, like

³² See Brian R. Landy, Comment: The Two Strands of the Fair Use Web: A Theory for Resolving the Dilemma of Music Parody, 54 OHIO ST. L.J. 227, 230 (1993).

³³ See 17 U.S.C. § 107.

³⁴ *Acuff-Rose*, 510 U.S. at 569.

³⁵ *Id.*; see also *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400-01 (9th Cir. 1997).

³⁶ The Courts definition of parody resonates of Potter Stewart's famous definition of pornography: "I know it when I see it." *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964).

the extent of its commerciality, loom larger.³⁷

The Ninth Circuit Court of Appeals, using this definition of parody, held that a commercial use of Dr. Seuss' infamous "Cat in the Hat" children's book poking fun at the OJ Simpson double murder trial, was not a parody and hence not a fair use.³⁸ The court, reasoned that the "copied work must be, at least in part, an object of the parody, otherwise there would be no need to conjure up the original work."³⁹ The stated policy behind this requirement is that the audience needs to be aware "that underlying the parody there is an original and separate expression, attributable to a different artist."⁴⁰ The court concluded that "[b]ecause there is no effort to create a transformative work with 'new expression, meaning, or message,' the infringing work's commercial use further cuts against the fair use defense."⁴¹

The courts are also divided on how much weight to give the first factor in determining whether a for-profit commercial use of a copyrighted work can be a fair use. This confusion has been blamed on the Court's decision *Sony*.⁴² *Sony* has been interpreted as creating a "presumption of 'unfairness' where a use is commercial."⁴³ Even though the Court attempted to clarify this standard, courts are still giving a disproportionate amount of weight to this factor.⁴⁴

C. A Proposed Solution

It is this author's contention that this basic interpretation of parody robs the public domain of the essentials needed to achieve the objectives of protecting the

³⁷ *Acuff-Rose*, 510 U.S. at 580 (citations omitted).

³⁸ See *Dr. Seuss*, 109 F.3d at 1400-01.

³⁹ *Id.* at 1401 (citing *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992)).

⁴⁰ *Id.*

⁴¹ *Id.* at 1401 (citing *Acuff-Rose*, 509 U.S. at 578).

⁴² 464 U.S. 417 (1984).

⁴³ See Manal Z. Khalil, Note, The Applicability of the Fair Use Defense to Commercial Advertising: Eliminating Unfounded Limitations, 61 *FORDHAM L. REV.* 661, 663 (1992); see also *Sony*, 464 U.S. at 451.

⁴⁴ See *Acuff-Rose*, 509 U.S. at 579.

copyright owner. The first reason a person chooses to use a particular copyrighted work for parody is because it is so well known to the public as another's work that the public could only see the objective if they already had knowledge of the prior work.⁴⁵ If it is not obvious what the underlying work is, then it is probably not a parody.

Professor Koenig argues that “[c]riticism which does not use a protected icon is weak and ineffectual when compared to the use of the icon itself for critical purposes.”⁴⁶ Borrowing from the postmodernist, I would go even one step farther. The reason criticism of protected icons is necessary in our culture is because mass media has created symbols that have bled into our popular culture. Society cannot discuss the meaning of its popular culture images without infringing on some copyrighted work.

Admittedly, people could discuss these symbolic images coffee-house style or in academia instead of in the media. However, most of our cultural dialogues are portrayed in the commercial culture that drives these meanings.⁴⁷ In order for the criticism to get as much air time as the symbols themselves, they should be allowed to flourish from the source without courts questioning whether the parody is of the symbol itself or completely unrelated to the symbol.

Drawing a line between whether the parody is of the original work or a social comment unnecessarily restricts the creative works. While the copyright owner has an interest in preserving this distinction, once a mark has become so famous as to make it's way into society's symbolic culture, the public interest outweighs the copyright owner's interest.

Second, as a practical matter, copyright owners would never license a parody if they did not like the way it portrayed their prior work.⁴⁸ In effect, intellectual

⁴⁵ Cf. *supra* n.12 and accompanying text.

⁴⁶ Dorean M. Koenig, *Joe Camel and the First Amendment: The Dark Side of Copyrighted and Trademark Protected Icons*, 11 T.M. COOLEY L. REV. 803, 803-04 (1994)(arguing that the idea/expression distinction allows the marketer to be the gatekeeper of what society can and cannot say about its icons). For an example of how one defendant tried to conjure up images of the Velvet Elvis, see *Elvis Presley Enterprises v. Capece*, 141 F.3d 188 (5th Cir. 1998).

⁴⁷ See *supra* nn.3-11 and accompanying text.

⁴⁸ This is precisely what happened in *Acuff-Rose*. 2 Live Crew informed Acuff-Rose, Rick Dees and Roy Orbison that they had written a parody of “Oh, Pretty Woman.” They stated that they would afford all credit for ownership and authorship of the original to the copyright owner, and that they were willing to pay a fee for their use. Nonetheless, the copyright owner, Acuff-Rose refused permission. *Acuff-Rose*, 509 U.S. at 572-73.

property law “discourages, even forbids, criticism that uses protected icons.”⁴⁹ This raises fundamental First Amendment issues.⁵⁰

While there may be valid policy reasons for protecting another’s commercial use of a copyrighted work, in the case of commercial parodies, the balancing scales should tilt towards the public. In an enlightened dissent for a petition for rehearing en banc, Judge Kozinski of the Ninth Circuit Court of Appeals summarized the problem: “Intellectual property rights aren’t free: They’re imposed at the expense of future creators and of the public at large.”⁵¹

III. Trademark Law

A. *Historical analysis*

Trademark law stems from the common law doctrine of unfair competition and has since been codified by Congress.⁵² Trademark dilution was a state cause of action, but with the addition a dilution cause of action to the Lanham Act, now it is also a federal cause of action.⁵³ The basic test for both common law, state and federal statutory trademark infringement is whether the use causes a “likelihood of confusion.”⁵⁴ Factors considered by the courts include:

(1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; defendant’s intent in selecting the mark; (8) likelihood

⁴⁹ Koenig, *supra*, n.46 at 803.

⁵⁰ See generally Khalil, *supra* n.43; Koenig, *supra*, n.46.

⁵¹ *White*, 989 F.2d at 1516 (Kozinski, J., dissenting).

⁵² See Trademark Act of 1946, The Lanham Act, 15 U.S.C.A. §§ 1051-1127 (West 1997).

⁵³ See *id.*

⁵⁴ See Thomas McCarthy, MCCARTHY ON TRADEMARK AND UNFAIR COMPETITION, § 23.01[1] (rev. ed., Clark Boardman Callaghan 1994).

of expansion of the product lines.⁵⁵

In trademark law, there is no separate parody defense.⁵⁶ However, courts can apply the same reasoning in analyzing whether consumers are “likely to be confused as to the source, sponsorship, or approval,” of the parodied use.⁵⁷

B. The Problem

Again Judge Kozinski recognized societies need to use, criticize, and comment on the commercial symbols that we all recognize:

Trademarks are often reflected in the mirror of our popular culture. See Truman Capote, *Breakfast at Tiffany's* (1958); Kurt Vonnegut, Jr., *Breakfast of Champions* (1973); Tom Wolfe, *The Electric Kool-Aid Acid Test* (1968); . . . Looking for *Mr. Goodbar* (1977); *The Coca-Cola Kid* (1985)(using Coca-Cola as a metaphor for American commercialism); . . . Hear Janis Joplin, *Mercedes Benz*, on Pearl (CBS 1971); . . . Prince, *Little Red Corvette*, on 1999 (Warner 1982). Dance to Talking Heads, *Popular Favorites 1976-92: Sand in the Vaseline* (Sire 1992); Talking Heads, *Popsicle*, on [(Sire 1992)]. Admire Andy Warhol, *Campbell's Soup Can* . . . The creators of some of these works might have gotten permission from trademark owners, though it is unlikely *Kool-Aid* relished being connected with LSD, *Hershey* with homicidal maniacs, *Disney* with armed robbers, or Coca-Cola with cultural imperialism. Certainly no free society can demand that artists get such permission.⁵⁸

Under the interpretation of the majority of courts, all of these examples would dilute the owner's respective trademarks or cause consumer confusion. In several

⁵⁵ *Dr. Seuss*, 109 F.3d at 1404.

⁵⁶ *See id.* at 1405.

⁵⁷ *Id.*

⁵⁸ *White*, 989 F.2d at 1512-13 (Kozinski, J. dissenting)(emphasis added).

cases, “the courts have held, in effect, that poking fun at a trademark is no joke.”⁵⁹

However, a more reasonable conclusion is that these symbols are so intrinsic to the way we understand culture and meaning that there is no better way to communicate than using the common language given to consumers by mass media.

IV. The problem with Barbie

This is about the sacred cows of western culture. The golden idols. Not symbols of religious power, they are symbols of buying power, profit and revenue streams. These are secular idols known in the corporate world simply as “cash cows.”

One such cow is called “Barbie.” ***

Pick any icon. Barbie is a perfect subject for an inquiry into symbols. She is nearly ubiquitous, crosses international and religious borders. She is available to children and so is a part of their education and growth, and she is a product of the contemporary commercial image making industry⁶⁰

A. Background

In 1952, a cartoonist in Germany created a comic character by the name of

⁵⁹ *Dr. Seuss*, 109 F.3d at 1405. The court cites examples of Gucci (*Gucci Shops, Inc. v. R.H. Macy & Co.*, 446 F. Supp 838 (S.D.N.Y. 1977)), A.1 Steak sauce (*Nabisco Brands, Inc. v. Kaye*, 760 F. Supp. 25 (D.Conn. 1991)), and the Hard Rock Café (*Hard Rock Café Licensing Corp. v. Pacific Graphics, Inc.*, 776 F. Supp 1454, 1462 (W.D.Wash. 1991)); *see generally* Jonathon Roy Celniker, *Trademark Parody Unplugged*, 14 SPG ENT. & SPORTS LAW. 1 (1996).

⁶⁰ Mark Napier, *The Distorted Barbie* <http://www.users.interport.net/~napier/barbie/barbie.html> (visited February 27, 1998). Copy on file with author.

Lilli.⁶¹ A few years later, Lilli was transformed into an eleven and a half-inch pornographic doll designed for men and a symbol for illicit sex.⁶² In 1957, after purchasing this doll in Europe, Ruth Handler came up with the “idea” to make a doll that represented purity and innocence named after her daughter.⁶³ Barbie was introduced in the United States in 1959.⁶⁴

Shortly after Barbie’s introduction, women started to critique what Barbie, as a product, was saying about how women should be.⁶⁵ Naomi Wolff, a prominent feminist noted:

It used to be that girls watched their mothers and learned how to be women that way. But by 1968, it seemed that our mothers were suddenly watching someone else--- the media equivalent of Barbie . . . and learning to be women all over again in a new way. We too were watching Barbie’s and learning what womanhood meant. This upended the natural progression of the generations and, at a critical moment in our development, would give us--- those who would look more like Barbie’s than our mothers could-- more power than they had.

Barbie was the first toy that taught us what was expected of us sexually. The fact that some of the moms were trying to become hip young Barbie’s made it that much more important for us to understand. The twelve - inch dolls held the key to it all. That is why girls, now as well as then, are obsessed with them.⁶⁶

⁶¹ *Barbie: Maureen Turner Visits a Real Life Dreamhouse*, <http://metalab.unc.edu/stayfree/11/barbie.html> (visited February 28, 1999).

⁶² *See id.*

⁶³ *See id.*

⁶⁴ *See Hacker Barbe Dream Basement Apartment* [sic], <http://www.catalog/mrm/barbe/barbe.html> (visited on February 27, 1997). On file with the author.

⁶⁵ *See* Elizabeth Bettendorf, *If Barbie Were Real . . . Book Takes Light-Hearted Look at Our Obsession*, THE STATE JOURNAL-REGISTER (Springfield, IL), p. 29, Dec. 21, 1997)(available on LEXIS)(ellipses in original)(author describes how her feminist mother would not let her play with Barbie’s as early as the 1960’s); *see generally* Sarah Strohmeyer, *BARBIE UNBOUND: A PARODY ON THE BARBIE OBSESSION* (1997).

⁶⁶ Naomi Wolf, *PROMISCUITIES: THE SECRET STRUGGLE FOR WOMANHOOD* 13 (Random House 1997).

Just how pervasive is Barbie? If one were to spell-check this document one would find that her name is in the computer's dictionary. "Barbie is a \$1.2-billion-per-year business. Every second, somewhere in the world, two Barbies are sold."⁶⁷ In the United States, girls from 3 to 11 years old own an average of 10 Barbie dolls, compared to seven in Italy and five in France and Germany.⁶⁸ Barbie's worldwide market constitutes more than 140 countries.⁶⁹ It is no wonder everyone knows who she is.

B. The Problem

In September of 1997, this author received an e-mail as a member of an alumni list-serve, informing members of the list that Mattel had filed two lawsuits within one week claiming trademark and copyright infringement.⁷⁰ The response from the list-serve was unanimous: doesn't Mattel have anything better to do? The gut reaction of the community, comprised of predominately non-lawyers, was an overwhelming sense that this just wasn't right. No one could articulate precisely what was wrong with this picture, but those who commented on the issue felt like Mattel was taking something away from us, something we dearly wanted to hold on to.

The first suit was against MCA records for distributing the top of the charts hit "I'm a Barbie girl" by Dutch band Aqua.⁷¹ Mattel claimed that the song infringed on

⁶⁷ Leslie Earnest, Good Old Barbie; Collectibles: Entrepreneur Moves Thriving Vintage-Doll Business to Laguna Beach. She's Already Making a Pretty Penny, LOS ANGELES TIMES (Orange County Edition), May 1, 1997 (available on LEXIS)(quoting Barbie collector Kitty Stuart).

⁶⁸ *Id.*

⁶⁹ *Id.*

⁷⁰ Since this article was drafted, the opinion of the California district court has been published. *See Mattel v. MCA*, 28 F. Supp. 2d 1120. Publication deadlines prevented a re-write of this section, however, it is worth noting that the district court concluded that the song "Barbie Girl" was a protected parody. *See id.* at 1136-59. At the same time, an unpublished decision of a New York district court concluded that a Web site which used the Barbie name in connection with adult entertainment was not a fair use. *See Mealey's Litigation Reports*, "Use of 'Barbie' Mark Violates Anti-Dilution Act," 7 NO. 3 MEALEY'S LITIG. REP.: INTELL. PROP. 9 (Nov. 2, 1998).

⁷¹ Lisa Bannon, Mattel is Suing MCA Records, Saying Hit Tune Infringes On

its copyright and its “most valuable trademark.”⁷² Mattel stated that they were “unhappy with the lyrics because they are damaging” to Barbie’s pure image.⁷³ The back of the album contains a disclaimer saying that the song “is a social comment and was not created or approved by the makers of the doll.”⁷⁴

The second suit, filed seven days later, was against Nissan for a commercial that was produced with plastic figures resembling Mattel products, including Barbie. In the commercial a “Nick” doll, which allegedly resembles Mattel’s G.I. Joe doll, escapes “from the mouth of a dinosaur, which bears a striking resemblance to Mattel’s ‘Jurassic Park’ line of dinosaurs. Nick then gets into a toy Nissan sports car and drives to a dollhouse, which borrows elements from various Mattel Barbie dollhouses.”⁷⁵ Later, the Nick doll “picks up a Roxanne doll that looks like Barbie.”⁷⁶ In this suit, Mattel claimed injury to Mattel’s name, business reputation and goodwill.⁷⁷

A month later this author was walking through the mall and saw a fifteen-foot poster hanging from a display window in The Body Shop, a national chain that sells skin and hair care products.⁷⁸ The poster is significant because it was a flesh-tone nude plastic doll posed on a classic Victorian green couch. The striking part of this picture was that the doll was visibly overweight. She had plump thighs, a double chin, and a roll around her mid-section. Admittedly, in the eyes, she resembled Barbie. However, she also had open-jointed knees, arms, and legs (which the modern Barbie does not have), and strawberry blond hair.

In a large font, the caption above the doll read “There are 3 billion women who don’t look like supermodels and only 8 who do.” A banner ran across the bottom of the ad identifying The Body Shop with an additional slogan, “love your body.” A week later, the advertisement disappeared from the window. Mattel successfully convinced

Its Doll’s Trademark, *THE WALL STREET JOURNAL*, Sept. 12, 1997 (1997 WL-WSJ 14165991).

⁷² *Id.* (quoting Michele McShane, Mattel’s senior attorney).

⁷³ *Id.* (quoting Jean McKenzie, general manager and executive vice president of the company’s Barbie Worldwide division).

⁷⁴ *Id.*

⁷⁵ *Id.* (quoting the court filings).

⁷⁶ *Id.*

⁷⁷ Reuters, *Mattel Sues Nissan Over TV Ad*, *LOS ANGELES TIMES*, Sept. 19, 1997, at D2 (1997 WL 13981733).

⁷⁸ A magazine size sample of this ad is on file with the author.

The Body Shop to stop its new campaign with the threat of a lawsuit.⁷⁹

The suits filed by Mattel have been criticized as trying to “stifle social commentary, satire and critical review.”⁸⁰ One reporter noted, “Barbie is many things to many people. But above all, she’s a \$2 billion-a-year trademarked product of Mattel, which wants to keep it that way.”⁸¹ The problem is that all three of these alleged infringements involved some larger message. However, because of the current state of trademark and copyright law, these commercial uses are not clearly protected.⁸²

There is no question, Mattel is vigorously attempting to protect what it perceives as its “intellectual property.”⁸³ However, it is my position that while Mattel may own the direct for-profit use of Barbie, the rest belongs in the public domain.

C. *Working Towards a Solution*

In this postmodern era,⁸⁴ the social significance of Barbie cannot be underestimated. Just saying that one word “Barbie” conjures up an instant image that cannot be adequately described by words. Once a trademark has become famous (every marketer’s dream) it is “often reflected in the mirror of our popular culture.”⁸⁵

⁷⁹ Lisa Bannon, staff reporter of THE WALL STREET JOURNAL, WSJ Interactive Edition, January 6, 1998. Downloaded from Pointcast™ on January 6, 1998. On file with the author.

⁸⁰ Aline McKenzie, Mattel Presents Barbie In Trademark-Battle Dress; Company’s Lawsuits Raise Rights Issues, THE ARIZONA REPUBLIC, Nov. 12, 1997, pg C2.

⁸¹ *See id.*

⁸² *See Acuff-Rose*, 509 U.S. at 580; *see also* discussion *supra* Part II.B.

⁸³ Lisa Bannon, staff reporter of THE WALL STREET JOURNAL, WSJ Interactive Edition, January 6, 1998. Downloaded from Pointcast™ on January 6, 1998. On file with the author. In this article, Michele McShane, the company’s Senior Counsel is quoted claiming that Mattel has “an intellectual property, not a doll. We vigorously look for and pursue any and all infringements.”

⁸⁴ *See* discussion *supra* Part I, n.3-11 and accompanying text.

⁸⁵ *White*, 989 F.2d at 1513 n.6 (Kozinski, J. dissenting).

Barbie taught us a lot -- sometimes more than we wanted to know . . . If there is any doubt that Barbie is designed to appeal to girl's fascination with what *the culture considers* to be appropriate female sexuality, think of the doll that came out when we were children that actually grew breasts when you twisted her arm.⁸⁶

Brand names are frequently the subject of trademark protection because a company spends so much time and money investing in making their products a household name. In the legal world, we generally ask who owns the right to profit from the image of Barbie? If the issue is framed this way, the answer has to be Mattel. However, this author believes the issue is who gets to decide what Barbie means to society?⁸⁷

The law's premise is that other producers should not be able to reap the benefits they did not sow. However, the problem is that Barbie is not just a product of Mattel's labor. While Mattel's marketing of its product probably did play a part in the product's successfulness, a larger part is more likely attributable to the meaning society attached to Barbie.

This is not about money. It is about who owns the inferences that people draw from product association. When people⁸⁸ see Barbie, some see an economic powerhouse marketed by Mattel, others see a social icon that programs young girl's into thinking that Barbie is the perfect woman.⁸⁹ Feminist and cultural scholars alike have critiqued Barbie for promulgating an impossible feminine mystique.⁹⁰ True, she is plastic. However, even Mattel admits that she is marketed more as a person than as a doll.⁹¹

The Body Shop is not trying to make money off of mocking Barbie so much as

⁸⁶ Wolf, *supra*, n.66 (emphasis added).

⁸⁷ For an in-depth discussion on this issue in the contexts of celebrity publicity rights see Madow, *supra* n.10 at 134. (For example, Madow asks the question, "Who owns Madonna?" He argues that by giving all the legal rights to Madonna, the law stifles the cultural process of deciding what meanings Madonna will have to society at large.) *Id.* at 134.

⁸⁸ "People" refers to adults capable of inferences and larger cultural understanding (not Mattel's target audience of little girls from ages 7-12).

⁸⁹ See Wolf, *supra* n.66 at 13 (1997).

⁹⁰ See *id.*

⁹¹ See Napier, *supra*, n.60.

they are trying to respond to a societal problem.⁹² Whether Mattel likes it or not, people see this 12” plastic doll as a reflection of society’s problem with body image. The headline on the advertisement lends further support to its target, the societal myth that the perfect woman is a plastic looking supermodel.⁹³

Similarly, the band Aqua was not trying to steal market share from Mattel when they wrote, “I’m a Barbie girl.” Rather, the band was making a social critique of a life in plastic.⁹⁴ This kind of criticism says far more about pop culture than it does about Mattel.

Today, the entertainment and commercial media control much of what is considered popular culture.⁹⁵ There is room for reasonable people to disagree about which one causes the other. Does media dictate pop culture or does pop culture define the media? In some respects, public critiques have helped to make Barbie a household name. Even people who have never before purchased a Barbie not only know what she looks like, but also what she supposedly stands for. Whichever side you agree with, one thing is clear: the two are so closely linked that the law cannot effectively say who owns pop culture.

Barbie has semiotic power. There is meaning beyond the product. The popular sitcom *Ally McBeal* has even latched onto the idea that there is more in the word Barbie than just denoting a particular product or brand name.⁹⁶ In one episode, the show clearly was trying to show that the biggest insult to a professional woman is being called a Barbie.⁹⁷ Not only does it denote a plastic looking woman, but its connotative meanings range from fluffy airhead to co-dependant woman. No one would argue that the producers of *Ally McBeal* should be liable for using Barbie’s name in vain.

⁹² The problem of course being society’s, as well as Mattel’s, promulgation of the ideal woman being built like a supermodel, a body the average person is not likely to achieve.

⁹³ The advertisement reads: “There are 3 billion women who don’t look like supermodels and only 8 who do.” In the bottom right hand corner of the ad, under the plastic image is an additional slogan, “love your body.”

⁹⁴ The songs includes lyrics like “Life in plastic, it’s fantastic.” Aqua, “I’m a Barbie girl” (MCA 1997).

⁹⁵ See discussion *supra* Part I, nn.6-9 and accompanying text.

⁹⁶ *Ally McBeal* is produced by FOX Broadcasting Co.

⁹⁷ See the episode where the support staff sues the firm for hostile work environment. The comment is directed at the character played by Courtney Thorne-Smith, who looks somewhat like a Barbie doll.

However, that's exactly what is happening in the commercial contexts. No matter how important the societal message, the law is allowing Mattel to quash the disparaging message solely because the message appeared in a commercial forum.

V. Conclusion

Overprotection stifles the very creative forces it's suppose to nurture.⁹⁸
Judge Kozinski

If we allow this type of social criticism to occur in the public forum of commercial media, products will respond. Mattel announced in December of 1997 that it would be releasing a new and improved Barbie with more lifelike features.⁹⁹ She will have more realistic proportions, less make-up, and light brown hair.¹⁰⁰ All of these changes seem to suggest that when the social critiques are spoken loud enough, manufacturers will hear and respond. Whether the impetus for this type of marketing is another product or other social forces is irrelevant. The overall benefit derived from this commercial speech outweighs the interest in preventing it.

The law should foster this dialogue by giving clear protection to commercial speech. The law must change to accommodate the changing nature of how our culture communicates while fulfilling the original policy objectives of trademark and copyright protection.

When Congress codified the fair use defense it viewed the four criteria as guidelines for "balancing the equities," not as "definitive or determinative" tests.¹⁰¹ Since Congress only intended to codify the existing fair use doctrine, Congress also granted courts the power to interpret these factors.¹⁰² Therefore, the courts are free to weigh these factors in a way that promotes the progression of science and the useful arts.¹⁰³ Courts should emphasize the high value of social critiques of pop culture, even

⁹⁸ *Samsung*, 989 F.2d at 1513 (Kozinski, J. dissenting).

⁹⁹ Lisa Bannon, *Top-Heavy Barbie Is Getting Body Work At Hands of Mattel*, THE WALL STREET JOURNAL, Nov. 17, 1997.

¹⁰⁰ *See id.*

¹⁰¹ H.R. REP. NO. 94-1476, 94th Congress, 2d Sess. at 65 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5679.

¹⁰² *See Acuff-Rose*, 509 U.S. at 577.

¹⁰³ *Id.*

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in commercial speech. To achieve this goal, the law should pull tighter reins on the doctrine of dilution of trademark. At the same time, under copyright law, courts should expand their interpretations of the doctrine of fair use, downplaying the commercial nature of the use.