

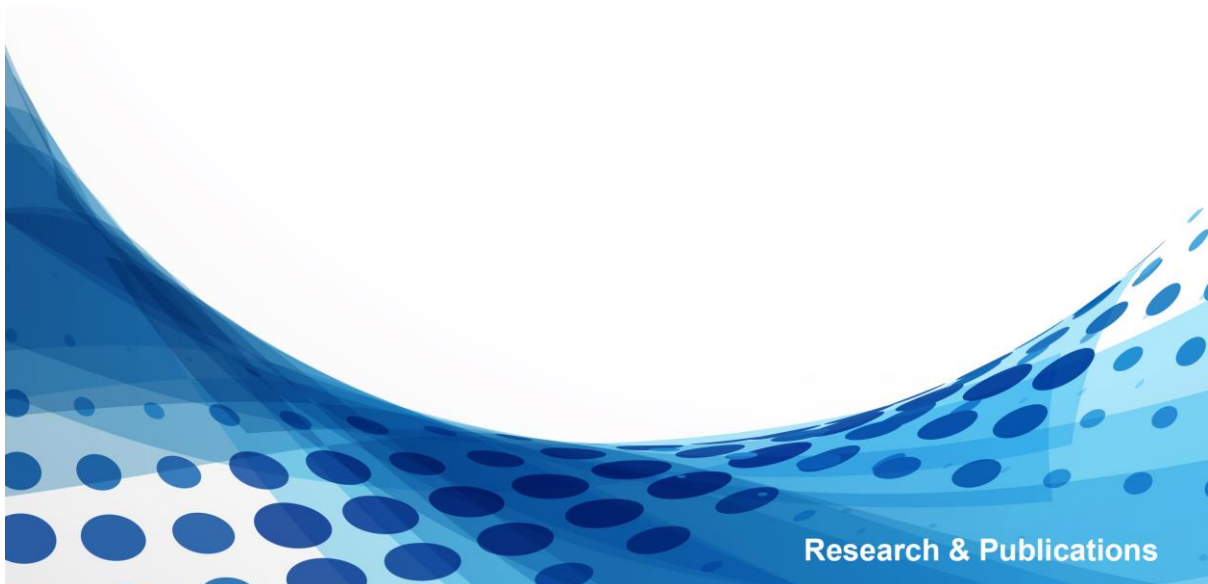


INDIAN INSTITUTE OF MANAGEMENT AHMEDABAD

**IIMA**  
Working Paper

## **Litigating Barbie: Trade Mark Infringement, Parody and Free Speech**

M. P. Ram Mohan  
Aditya Gupta



Research & Publications

# **Litigating Barbie: Trade Mark Infringement, Parody and Free Speech**

M. P. Ram Mohan  
Aditya Gupta

**July 2022**

The main objective of the working paper series of the IIMA is to help faculty members, research staff and doctoral students to speedily share their research findings with professional colleagues and test their research findings at the pre-publication stage. IIMA is committed to maintain academic freedom. The opinion(s), view(s) and conclusion(s) expressed in the working paper are those of the authors and not that of IIMA.

# **Litigating Barbie: Trade Mark Infringement, Parody and Free Speech**

M P Ram Mohan\* & Aditya Gupta<sup>‡</sup>

## **Abstract**

In the contemporary marketplace, trade marks are not mere monikers of origin. While often regarded as commercial symbols, trade marks 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 trade mark law and use of marks as part of expressive vocabulary has become increasingly controversial. One such trade mark 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 trade marks by employing Barbie as a case study. Comparatively analysing the treatment of the Barbie mark in India, the USA, and Canada, the authors underline an imperative need to adopt a legislative framework to protect the expressive and artistic secondary use of popular trade marks.

**Keywords:** Trade Mark, Barbie, Parody, Free Speech

---

\* Associate Professor, Strategy Area, Indian Institute of Management, Ahmedabad.

<sup>‡</sup> Research Associate, Strategy Area, Indian Institute of Management, Ahmedabad.

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

## Introduction

In 2022, the Barbie doll turned 63. Since her launch, she has dawned over 200 professions,<sup>1</sup> ranked as the world's #1 Toy Property<sup>2</sup> and featured as one of 2022's most trusted brands.<sup>3</sup> Since 2018, the Barbie mark has consistently accrued over a billion USD worth of gross billings.<sup>4</sup> With an annual sale of 58 million dolls, Barbie accounts for more than half of Mattel's overall sales turnovers.<sup>5</sup> Her success has made Barbie an indelible part of global popular discourse,<sup>6</sup> particularly within American feminine culture.<sup>7</sup> With her collectible magazines and a very loyal fanbase,<sup>8</sup> Barbie has been reported to receive more fan mail than Audrey Hepburn and Elizabeth Taylor combined.<sup>9</sup> She exemplifies *some set of values, beliefs and norms in the modern day society*<sup>10</sup> and has shaped the *world of play for over three generations*.<sup>11</sup>

Given her extraordinary recollection and recognition, the level of scrutiny, both positive and negative, accrued by Barbie is extraordinary.<sup>12</sup> 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*.<sup>13</sup> 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*.<sup>14</sup> The

---

<sup>1</sup> Melina Glusac, *Barbie turns 60 this year. Here are 25 of the coolest jobs she's had.*, INSIDER, 2019, <https://www.insider.com/barbies-coolest-jobs-2019-3> (last visited Jun 11, 2022).

<sup>2</sup> Business Wire, *Barbie Named 2020 Top Global Toy Property of the Year, Per NPD*, BUSINESS WIRE (2021), <https://www.businesswire.com/news/home/20210127005559/en/Barbie-Named-2020-Top-Global-Toy-Property-of-the-Year-Per-NPD> (last visited Jun 11, 2022).

<sup>3</sup> Nancy Cooper, *Most Trusted Brands in America*, 178 NEWSWEEK GLOBAL 44–48 (2022).

<sup>4</sup> At least since 2018, Rebecca C. Hains, *The Politics of Barbie's Curvy New Body: Marketing Mattel's Fashionistas Line*, in *THE MARKETING OF CHILDREN'S TOYS: CRITICAL PERSPECTIVES ON CHILDREN'S CONSUMER CULTURE* 265–283, 14.1 (Rebecca C. Hains & Nancy A. Jennings eds., 2021).

<sup>5</sup> Donna L. Roberts, *The Economics of Barbie: Marketing the Evolution of an Icon Through the Generations*, 22 *JOURNAL OF APPLIED BUSINESS & ECONOMICS* 83–88, 84 (2020).

<sup>6</sup> For example: Udo Wagner et al., *Possession Attachment toward Global Brands: How the "World of Barbie" is Shaping the Mindsets of Millennial Girls*, 33 *JOURNAL OF INTERNATIONAL CONSUMER MARKETING* 434–451 (2021).

<sup>7</sup> Roberts, *supra* note at 84.

<sup>8</sup> See: Marlys Pearson & Paul R Mullins, *Domesticating Barbie: An archaeology of Barbie material culture and domestic ideology*, 3 *INTERNATIONAL JOURNAL OF HISTORICAL ARCHAEOLOGY* 225–259 (1999).

<sup>9</sup> JERRY OPPENHEIMER, *TOY MONSTER: THE BIG, BAD WORLD OF MATTEL* 32 (2009); MARLENE WAGMAN-GELLER, *WOMEN WHO LAUNCH: WOMEN WHO SHATTERED GLASS CEILINGS* 6 (2018) Interesting to note, the two women have 3 Academy Awards between the two of them.

<sup>10</sup> M. G. LORD, *FOREVER BARBIE: THE UNAUTHORIZED BIOGRAPHY OF A REAL DOLL* 3–7 (2004); Susy Frankel, *From Barbie to Renoir: intellectual property and culture*, 41 *VICTORIA U. WELLINGTON L. REV.* 1 (2010).

<sup>11</sup> ORLY LOBEL, *YOU DON'T OWN ME – HOW MATTEL V. MGA ENTERTAINMENT EXPOSED BARBIE'S DARK SIDE: THE LANDMARK COURT BATTLES THAT EXPOSED BARBIE'S DARK SIDE* (1st edition ed. 2018).

<sup>12</sup> KRISTIN NOELLE WEISSMAN, *BARBIE: THE ICON, THE IMAGE, THE IDEAL: AN ANALYTICAL INTERPRETATION OF THE BARBIE DOLL IN POPULAR CULTURE* 9–11 (1999).

<sup>13</sup> Ann duCille, *Dyes and Dolls: Multicultural Barbie and the Merchandising of Difference*, in *THE BLACK STUDIES READER* 265, 268 (2004).

<sup>14</sup> Urla Jacqueline & Alan C Swedlund, *The Anthropometry of Barbie: Unsettling Ideals of the Feminine Body in Popular Culture.*, in *DEVIANT BODIES: CRITICAL PERSPECTIVES ON DIFFERENCE IN SCIENCE AND POPULAR CULTURE* 277, 282 (Jennifer Terry & Jacqueline L. Urla eds., Illustrated edition ed. 1995).

sexist and stereotypical approach of Mattel is also reflected in their versions of ethnic dolls. This approach has been particularly unsuccessful in India, where minimal aesthetic modifications to create an ‘*Indian Barbie*’ have largely remained unsuccessful.<sup>15</sup> In July 2022, the company realigned their Indian strategy and released a pant suit wearing dark-skinned version of the doll with *bigger eyes and bold brows* to appease the Indian audiences.<sup>16</sup> It remains to be seen if this new approach would enable Barbie to gain a favour from Indian critics and consumers. While Mattel has launched multiple attempts to realign the Barbie image, they have cited their intellectual property rights to condemn any such efforts which arise from outside the company.<sup>17</sup> The reimagination of the Barbie image by artists, critics and parodists has been repeatedly condemned before intellectual property courts.<sup>18</sup> 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.<sup>19</sup> However, this transcendence creates a unique problem for trade mark law. When trade marks become a part of language and serve as the foundation for evocative metaphors, the trade mark doctrine struggles to determine the legality of any secondary use of the mark.<sup>20</sup> Barbie has not only come to symbolise the idea of femininity<sup>21</sup> and descended into the popular discourse,<sup>22</sup> she has also served as ammunition for artistic,<sup>23</sup>

---

<sup>15</sup> Priti Nemani, *Globalization Versus Normative Policy: A Case Study on the Failure of the Barbie Doll in the Indian Market*, 11 ASIAN-PACIFIC LAW & POLICY JOURNAL 97 (2011).

<sup>16</sup> Rituparna Som, *The first Indian Barbie is about to change the world*, VOGUE INDIA, 2022, <https://www.vogue.in/beauty/content/the-first-indian-barbie-is-about-to-change-the-world> (last visited Jul 15, 2022).

<sup>17</sup> Dan Hunter & F. Gregory Lastowka, *Barbie*, 18 TULANE JOURNAL OF TECHNOLOGY & INTELLECTUAL PROPERTY 133, 135 (2015).

<sup>18</sup> See: Hunter and Lastowka, *supra* note 17; WEISSMAN, *supra* note 12.

<sup>19</sup> *Mattel, Inc. v. MCA Records Inc.*, 296 D. 3d 894 (9th Cir. 2002) 898; duCille, *supra* note 13 at 268; For an analysis of the meaning of cultural icons see: Steven M Cordero, *Cocaine-Cola, the Velvet Elvis, and Anti-Barbie: Defending the Trademark and Publicity Rights to Cultural Icons*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. LJ 599, 642–644 (1997).

<sup>20</sup> Rochelle Dreyfuss Cooper, *Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH , 262 (Graeme B Dinwoodie & Mark D Janis eds., 2008); Lemley, Mark A., *Fame, Parody, and Policing in Trademark Law*, MICHIGAN STATE LAW REVIEW, 2 (2019) Famous marks become a part of social conversation in a way ordinary marks don't. ; Frankel, *supra* note 10 at 13.

<sup>21</sup> See: Frankel, *supra* note 12; Jacqueline and Swedlund, *supra* note 14.

<sup>22</sup> Kiran Gore, *Trademark Battles in a Barbie-Cyber World: Trademark Protection of Website Domain Names and the Anticybersquatting Consumer Protection Act*, 31 HASTINGS COMMUNICATIONS AND ENTERTAINMENT LAW JOURNAL 193, 208–212 (2009).

<sup>23</sup> See for example: Tanya Grae, *To Come Undone, and: If Barbie Had a Brain*, 46 WSQ: WOMEN'S STUDIES QUARTERLY 259–261 (2018).

political and social discourse.<sup>24</sup> A shade of this cultural reappropriation can also be gleaned from the political debate surrounding abortion rights in the US.<sup>25</sup> In 2013, Senator Wendy Davis, an American senator from Fort Worth, Texas, gave a thirteen-hour filibuster<sup>26</sup> against a pro-life bill introduced in the American Congress.<sup>27</sup> Soon enough, in her criticism, the blonde-haired US lawmaker was given the title of *Abortion Barbie*.<sup>28</sup> 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.

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*.<sup>29</sup> 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.”*<sup>30</sup>

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*.<sup>31</sup> Dubbed an *intellectual property shark*,<sup>32</sup> Mattel's assaults have

---

<sup>24</sup> See: Roberts, *supra* note 5 at 85–87; Louise Collins et al., *We're Not Barbie Girls: Tweens Transform a Feminine Icon*, 24 FEMINIST FORMATIONS 102–126 (2012); Jacqueline and Swedlund, *supra* note 14.

<sup>25</sup> For a brief summary see Prof. Amar's article: Akhil Reed Amar, *The End of Roe v. Wade*, WSJ (2022), <https://www.wsj.com/articles/the-end-of-roe-v-wade-11652453609> (last visited Jul 13, 2022).

<sup>26</sup> A filibuster enables a minority of U.S. Senators to block action favoured by a majority of the Senate, the House of Representatives and the President. For details see: Catherine Fisk & Erwin Chemerinsky, *The Filibuster*, 49 STANFORD LAW REVIEW 181 (1997).

<sup>27</sup> Tom Dart, *Wendy Davis's remarkable filibuster to deny passage of abortion bill*, THE GUARDIAN, June 26, 2013, <https://www.theguardian.com/world/2013/jun/26/texas-senator-wendy-davis-abortion-bill-speech> (last visited Jul 13, 2022).

<sup>28</sup> Ann Bartow, *Barbie in Bondage: What Orly Lobel's Book You Don't Owe Me: How Mattel v. MGA Entertainment Exposed Barbie's Dark Side Tells Us about the Commoditization of the Female Body*, 29 FORDHAM INTELL. PROP. MEDIA & ENT. LJ 435, 450, 451 (2018); Mattel even responded to such a use of the Barbie mark by saying that “As a pop-culture icon, Barbie is often references as part of larger conversations occurring in culture.” Elizabeth Dias, *The Toy Barbie Responds to the Wendy Davis Barbie Wars*, TIME, 2013, <https://swampland.time.com/2013/08/20/the-toy-barbie-responds-to-the-wendy-davis-barbie-wars/> (last visited Jul 13, 2022).

<sup>29</sup> Gore, *supra* note 22 at 211.

<sup>30</sup> YOCHAI BENKLER, THE WEALTH OF NETWORKS – HOW SOCIAL PRODUCTION TRANSFORMS MARKETS AND FREEDOM 277 (9/23/07 edition ed. 2007).

<sup>31</sup> Hunter and Lastowka, *supra* note 17 at 135.

<sup>32</sup> LOBEL, *supra* note 9.

often relied on their trade mark rights.<sup>33</sup> By focussing on Barbie, we examine the degree of trade mark protection afforded to marks that have transcended their purposes as mere monikers of origin and have assumed prominence in contemporary language. To study this development, we identify four judicial decisions from three jurisdictions: the U.S.A., Canada and India. While Mattel has cited their IP rights in multiple disputes,<sup>34</sup> the authors restrict their study to cases where trade mark law intersects with constitutional safeguards of speech.

Part 1 traces the development of the Barbie doll and its descent as a cultural icon. Part 2 identifies the major legal opinions where the trade mark doctrine has been cited to control the expressive and commercial secondary uses of the mark Barbie in the U.S.A., Canada and India. Part 3 studies how an expressive secondary use qualifies itself for constitutional protection and the effect of such protection on trade mark liability. Part 4 studies the scope of trade mark liability within the confusion and dilution analysis.

## 1. Conceptualising and reinterpreting Barbie

Drawing inspiration from a German doll,<sup>35</sup> Ruth Handler gave life to Barbie in 1959.<sup>36</sup> 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*.<sup>37</sup> Lili was not a children's toy. She was a gag gift for bachelor parties, a dashboard ornament and often a gag gift for girlfriends and mistresses.<sup>38</sup> Making minor changes to Lilli, Mattel birthed Barbie.<sup>39</sup> Some historians note, "*Lilli and her new sister were barely distinguishable except to the new doll's creator.*"<sup>40</sup>

The criticism and scrutiny<sup>41</sup> accrued by Barbie can be expressed in terms of a feminist *double bind*.<sup>42</sup> A double bind *emerges in situations where one's options are narrowly defined, and*

---

<sup>33</sup> A HISTORY OF INTELLECTUAL PROPERTY IN 50 OBJECTS, 266, 267 (Claudy Op den Kamp & Dan Hunter eds., Illustrated edition ed. 2019).

<sup>34</sup> See for example: *Mattel, Inc. v. MGA Entm't, Inc.*, 616 F.3d 904, 2010 U.S. App. LEXIS 24150; *Mattel, Inc. v. Pitt*, 229 F. Supp. 2d 315 (S.D.N.Y. 2002); *Mattel, Inc. v. Jcom*, 48 U.S.P.Q.2d 1467 (S.D.N.Y. 1998); *Mattel, Inc. v. Internet Dimensions*, 2000 WL 973745 (S.D.N.Y. 2000).

<sup>35</sup> RUTH HANDLER & JACQUELINE SHANNON, *DREAM DOLL: THE RUTH HANDLER STORY* 1–3 (1995); LORD, *supra* note 10 at 29.

<sup>36</sup> While this is the most generally accepted story of the doll's conceptualisation, there is some controversy to these chain of events. See: OPPENHEIMER, *supra* note 9 at 1.

<sup>37</sup> SARAH HERMAN, *A MILLION LITTLE BRICKS: THE UNOFFICIAL ILLUSTRATED HISTORY OF THE LEGO PHENOMENON* 13–18 (2012).

<sup>38</sup> Hunter and Lastowka, *supra* note 17; ROBIN GERBER, *BARBIE AND RUTH: THE STORY OF THE WORLD'S MOST FAMOUS DOLL AND THE WOMAN WHO CREATED HER* 9–10 (Reprint edition ed. 2010).

<sup>39</sup> LORD, *supra* note 10 at 32.

<sup>40</sup> GERBER, *supra* note 38 at 13.

<sup>41</sup> See for example: Hains, *supra* note 4 at 268, 269.

<sup>42</sup> Bartow, *supra* note 28 at 446–448.

*detrimental consequences accompany all choices.*<sup>43</sup> For example, in the context of pregnancy, the fear is that employers will hire fewer women if women are given ‘special treatment.’ On the flip side, if women are not given ‘special treatment’ during their pregnancies, they will inevitably lose their jobs. Similarly, society will censor women who do not prioritise having children.<sup>44</sup> Concurrently, women actively engaging in parenting are parallelly deemed *occupied and distracted to take on demanding positions in politics or the workplace.*<sup>45</sup> Prof. Radin blames the very conceptualisation of gender for the existence of this double bind. She refers to it as *an artefact of the dominant social conception of meaning of gender.*<sup>46</sup>

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;*<sup>47</sup> “*Barbie is both perfect and perfectly paradoxical: she is every woman, yet she is no woman. She is unchangeable yet endlessly mutable. She is sexual yet sexless. She is white but of all races and ethnicities.*”<sup>48</sup> The adoption of Barbie from Lili meant the *Americanisation* of the doll. For Mattel, this meant shrinking Lili’s lips, removing her nipples and vagina while keeping her large breasts and widening her eyes.<sup>49</sup> These changes *rendered her sexy in clothes, but sexless outside them.*<sup>50</sup> 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.<sup>51</sup>

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.<sup>52</sup> In their attempt to reinvent the Barbie image, Mattel, in 1967, produced their first black doll named *Colored Francie.*<sup>53</sup> The doll received lukewarm market reception and was

---

<sup>43</sup> Lisa M. Corrigan & Skye de Saint Felix, *A New Doll in Texas: A Feminist Media Analysis of Senator Wendy Davis’s Rhetorical Framing as “Abortion Barbie,”* 0 FEMINIST MEDIA STUDIES 1–18, 13 (2021); MARILYN FRYE, *POLITICS OF REALITY: ESSAYS IN FEMINIST THEORY* (1983).

<sup>44</sup> Margaret Jane Radin, *The Pragmatist and the Feminist*, 63 SOUTHERN CALIFORNIA LAW REVIEW 1699, 1701 (1990); For another very interesting iteration of this double bind in the context of Barbie see: Corrigan and de Saint Felix, *supra* note 43.

<sup>45</sup> Bartow, *supra* note 28 at 448.

<sup>46</sup> Radin, *supra* note 44 at 1704.

<sup>47</sup> Tamar Buchakjian, *Mattel, Inc. v. MCA Records, Inc.: Let’s Party in Barbie’s World-Expanding the First Amendment Right to Musical Parody of Cultural Icons*, 36 LOY. LAL REV. 1321, 1323 (2002).

<sup>48</sup> LOBEL, *supra* note 13 at 7; Rebecca Tushnet, *Make me walk, make me talk, do whatever you please: Barbie and exceptions*, in *INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP* 405–426, 419 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2014).

<sup>49</sup> LOBEL, *supra* note 11.

<sup>50</sup> Bartow, *supra* note 28 at 447.

<sup>51</sup> *Id.* at 448–449.

<sup>52</sup> Jacqueline and Swedlund, *supra* note 14 at 282–284.

<sup>53</sup> duCille, *supra* note 13 at 268.



criticised for being *mere dye-dripped versions of the white Barbie*.<sup>54</sup> In 2014, Barbie was given a new profession, she was now a computer engineer.<sup>55</sup> However, she was portrayed only as a design enthusiast who could not write code and installed viruses on her colleagues computers.<sup>56</sup> Mattel could not help but feed the sexist stereotypical image of Barbie. The depiction received severe criticism was eventually withdrawn.<sup>57</sup>

Mattel made many attempts to protect and improve the Barbie image.<sup>58</sup> In 2016, Mattel addressed one of their biggest criticisms. Barbie was no longer a slim blonde with unrealistic body proportions,<sup>59</sup> she was now *body positive*.<sup>60</sup> Extensively advertising their newfound fulfilment and to persuade the Court of public opinion, Mattel courted Time Magazine to cover their new launch by offering the headline “*Now can we stop talking about my body?*”<sup>61</sup> Mattel attempted to establish that their new dolls differed *meaningfully from old offerings*.<sup>62</sup> 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.*”<sup>63</sup> Unfortunately for Mattel, the ‘curvy’ Barbie received similar political, social, satirical and comical scrutiny.<sup>64</sup> Writing for the National Review, Heather Wilhelm answered

---

<sup>54</sup> *Id.* at 269; Hains, *supra* note 4 at 267.

<sup>55</sup> Aisha Gani, *Barbie can be a computer engineer ... but only with help of a man*, THE GUARDIAN, November 19, 2014, <https://www.theguardian.com/lifeandstyle/2014/nov/19/-sp-barbie-can-be-a-computer-engineer-but-only-with-help-of-a-man> (last visited Jul 11, 2022).

<sup>56</sup> Pamie, *Barbie Fucks It Up Again*, PAMELA RIBON (2014), <https://pamie.com/2014/11/barbie-fucks-it-up-again/> (last visited Jul 11, 2022); Casey Fiesler, *Barbie Really Is a Computer Engineer*, SLATE, 2014, <https://slate.com/technology/2014/11/barbie-is-a-computer-engineer-the-terrible-book-gets-remixed.html> (last visited Jul 11, 2022).

<sup>57</sup> Alison Flood, *Barbie computer engineer story withdrawn after sexism row*, THE GUARDIAN, November 21, 2014, <https://www.theguardian.com/books/2014/nov/21/barbie-computer-engineer-story-withdrawn-sexist-mattel> (last visited Jul 11, 2022).

<sup>58</sup> See: Jacqueline and Swedlund, *supra* note 14 at 282–284.

<sup>59</sup> The criticism being that Barbie projects an unrealistic body image. See: K. D. Brownell & M. A. Napolitano, *Distorting reality for children: body size proportions of Barbie and Ken dolls*, 18 INT J EAT DISORD 295–298 (1995); Doeschka J. Anschutz & Rutger C. M. E. Engels, *The Effects of Playing with Thin Dolls on Body Image and Food Intake in Young Girls*, 63 SEX ROLES 621–630, 622 (2010); JEANNIE B. THOMAS, NAKED BARBIES, WARRIOR JOES, AND OTHER FORMS OF VISIBLE GENDER 6 (Illustrated edition ed. 2003).

<sup>60</sup> Eliana Dockterman, *Barbie’s Got a New Body*, TIME.COM (2016), <https://time.com/barbie-new-body-cover-story/> (last visited May 1, 2022); Claire Bates, *How does “Curvy Barbie” compare with an average woman?*, BBC NEWS, March 3, 2016, <https://www.bbc.com/news/magazine-35670446> (last visited May 8, 2022); Also see: Jennifer A. Harriger et al., *You can buy a child a curvy Barbie doll, but you can’t make her like it: Young girls’ beliefs about Barbie dolls with diverse shapes and sizes*, 30 BODY IMAGE 107–113 (2019).

<sup>61</sup> Eliana Dockterman, *Now Can we stop talking about my body? What Barbi’s new shape says about American beauty*, 187 TIME, 2016; See: Hains, *supra* note 4 at 273–275.

<sup>62</sup> Hains, *supra* note 4 at 272.

<sup>63</sup> Victoria Wand, *Barbie gets Curves*, THE DAILY TELEGRAPH, January 29, 2016, <https://www.pressreader.com/uk/the-daily-telegraph/20160129/282243779618507>.

<sup>64</sup> Hains, *supra* note 4 at 272–276; For examples see: Georgea Kovanis, *Curvy Barbie feels like money-making gimmick*, DETROIT FREE PRESS, February 2, 2016, <https://www.freep.com/story/life/shopping/georgea-kovanis/2016/02/02/new-curvy-barbie/79646364/> (last visited May 8, 2022); Samantha Cooney, *See all the cute*

Time's cover story's question, "Oh, and as for Time's innocent question- "Now can we stop talking about my body?" The answer is clear, decided no."<sup>65</sup>

What Barbie may or may not represent *has been and continues to be the subject of sociological and psychological study, of praise, the subject of criticism and the subject of parody.*<sup>66</sup> With a determined litigative appetite, Mattel has attempted to contain this discourse by citing their entitlements within intellectual property law.<sup>67</sup> However, Mattel's litigative appetite has reduced since the first decade of the 21<sup>st</sup> century and their attempts to control the associations of the Barbie mark have not seen many courtrooms in the last decade. In the next section, the authors discuss cases in the select countries where the Barbie mark has been cited to intercept secondary use.

## 2. Free speech actors and Mattel's Trade mark rights

Mattel has defended Barbie's trade mark with a *militant sense of protectionism.*<sup>68</sup> Mattel has not welcomed a reinterpretation of the 'brand image'<sup>69</sup> associated with Barbie and has chased multiple artists and parodists to trademark courts.<sup>70</sup> Mattel realised that to continue selling the doll, they had to ensure that *Barbie-ness* was retained and controlled by them.<sup>71</sup> From this point on, *the doll was no longer central, the important feature was the image and concept of Barbie.*<sup>72</sup>

Some scholars have gone as far as to allege that Mattel has used litigative strategies to counteract developing market realities.<sup>73</sup> Mattel adopted a *modus operandi* where it litigates

---

*body-positive dolls designed to be better than Barbie*, MASHABLE, January 30, 2016, <https://mashable.com/archive/body-positive-barbies> (last visited May 8, 2022).

<sup>65</sup> Heather Wilhelm, *Barbie Proliferates*, 68 NATIONAL REVIEW 23–24 (2016) The author is criticising this phenomenon where Barbie is criticised for the gentrification of women. However, this question is unquestionably correct.

<sup>66</sup> Frankel, *supra* note 10 at 9; For example see: David Firestone, *While Barbie Talks Tough, G. I. Joe Goes Shopping*, THE NEW YORK TIMES, December 31, 1993, <https://www.nytimes.com/1993/12/31/us/while-barbie-talks-tough-g-i-joe-goes-shopping.html> (last visited Jun 1, 2022).

<sup>67</sup> Gore, *supra* note 22 at 209 After nearly 50 makeovers, she is a public figure in a cultural icon. She's also controversial and very litigious.

<sup>68</sup> LOBEL, *supra* note 11 at 3; Also see: Gore, *supra* note 22; Tushnet, *supra* note 48; Julie Zando-Dennis, *Not Playing Around: The Chilling Power of the Federal Trademark Dilution Act of 1995 Note*, 11 CARDOZO WOMEN'S L.J. 599–630, 626–630 (2004).

<sup>69</sup> Dev S. Gangjee, *Property in brands: The commodification of conversation*, in CONCEPTS OF PROPERTY IN INTELLECTUAL PROPERTY LAW 29 (Helena Howe ed., 2013) 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."

<sup>70</sup> MARY F. ROGERS, BARBIE CULTURE 90–95 (1999).

<sup>71</sup> Hunter and Lastowka, *supra* note 17 at 142.

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

<sup>73</sup> 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.

every unauthorised secondary use in the hope of a global chilling effect from isolated single victories.<sup>74</sup> Alleged for being a *trademark bully*,<sup>75</sup> Mattel not only *abuses the legal system* but is also responsible for *causing harm to competition and speech interests*.<sup>76</sup>

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. The present study examines four judicial opinions spanning three jurisdictions and present interesting issues at the intersection of the scope of trade mark doctrine and constitutional safeguards of speech.

## 2.1. United States of America

### 2.1.1. *Mattel v. MCA Records Inc.*

In 1997, Aqua released a song titled '*Barbie Girl*.' Mocking the Barbie image, the song include 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 the allegedly *adult-oriented* lyrics.<sup>77</sup> 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. Barbie has been hailed as a role model and has been condemned as the cause of eating disorders*."<sup>78</sup>

The primary issue throughout the dispute, from trial to the appellate stage, was whether the song qualifies as a parody. A finding in favour 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

---

Mattel, Inc. v. Global China Networks, LLC, 2007 U.S. Dist. LEXIS 84946, 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 STREET JOURNAL, August 23, 2007, <https://www.wsj.com/articles/BL-LB-4330> (last visited May 8, 2022).

<sup>74</sup> 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, Mark A., *supra* note 17.

<sup>75</sup> U.S. DEPARTMENT OF COMMERCE, *Report to Congress: Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and prevent Counterfeiting*, (2011), <https://www.uspto.gov/sites/default/files/trademarks/notices/TrademarkLitigationStudy.pdf> The USPTO defines 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."

<sup>76</sup> See: Jessica M Kiser, *To Bully or Not to Bully: Understanding the Role of Uncertainty in Trademark Enforcement Decisions*, 37 COLUM. JL & ARTS 211, 211 (2013); Stacey Dogan, *Bullying and Opportunism in Trademark and Right-of-Publicity Law*, 96 BUL REV. 1293 (2016).

<sup>77</sup> *Mattel, Inc. v. MCA Records, Inc.* 7310, 1998 U.S. Dist. LEXIS 7310 (1998).

<sup>78</sup> *Id.* at 11, 12.

*shallow, plastic values she (Barbie) has come to represent in some circles.*<sup>79</sup> 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 and real and easily manipulable by others.*<sup>80</sup> The Court argued that the secondary use was attributive rather than commercial,<sup>81</sup> and the minimal possibility of consumer confusion was outweighed by free speech interests.<sup>82</sup> Dealing with dilution, the court ruled that the Aqua Girl song qualifies as a non-commercial use<sup>83</sup> and therefore cannot accrue any liability within the dilution framework.<sup>84</sup>

Subsequently, the parties approached the Court of Appeals against the decision of the District Court.<sup>85</sup> 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 trade mark doctrine to protect the public discourse surrounding the mark.<sup>86</sup> Given the expressive and referential nature of the defendants' use, the Court applied a nuanced likelihood of confusion analysis.<sup>87</sup> 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.<sup>88</sup>

Coming to the dilution claims, the Court viewed the secondary use by the defendants as dilutive but qualifying for the non-commercial speech defence.<sup>89</sup> If a secondary use qualifies as a non-commercial speech, it is exempted from liability within the dilution paradigm.<sup>90</sup> 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.*<sup>91</sup> Since the song did more than *merely propose a commercial transaction*, it was be protected within

---

<sup>79</sup> *Mattel, Inc. v. MCA Records, Inc.* 20943, 28 F. Supp. 2d 1120, 1998 U.S. Dist. LEXIS 20943 1139 (1998).

<sup>80</sup> *Id.* at 1138.

<sup>81</sup> *Id.* at 1142, 1143; Buchakjian, *supra* note 47 at 1322–1328.

<sup>82</sup> *MATTEL, INC. v. MCA RECORDS, INC.* 20943, *supra* note 79 at 1151–1154; Buchakjian, *supra* note 47 at 1327, 1328.

<sup>83</sup> Buchakjian, *supra* note 47 at 1328.

<sup>84</sup> 15 U.S.C. § 1125(3)(C) excludes any non-commercial use of the mark from trademark dilution liability; For details see: Lee Ann Lockridge, *When is a Use in Commerce a Noncommercial Use?*, 37 FLORIDA STATE UNIVERSITY LAW REVIEW 337, 352–284 (2010).

<sup>85</sup> *MATTEL, INC. v. MCA RECORDS, INC.* 20943, *supra* note 79 at 1159; Heather Wallack, *Mattel, Inc. v. MCA Record, Inc.*, 12 DEPAUL JOURNAL OF ART, TECHNOLOGY AND INTELLECTUAL PROPERTY LAW 477, 482 (2002).

<sup>86</sup> *MATTEL, INC. v. MCA RECORDS INC.*, *supra* note 19 at 900.

<sup>87</sup> *Id.* at 901 relying on; *Rogers v. Grimaldi*, 875 F.2d. 994, 1000 (2d Cir. 1989); Tushnet, *supra* note 48 at 414, 415.

<sup>88</sup> *MATTEL, INC. v. MCA RECORDS INC.*, *supra* note 19 at 992 referring to; *ROGERS v. GRIMALDI*, *supra* note 87.

<sup>89</sup> In coming to this conclusion, the court relied on precedents which dealt with the meaning of “commercial speech.” *Hoffman v. Capital Cities*, 255 F3d 1180 (9th Cir 2001); *Bolger v. Youngs Drug Prods Corp.*, 463 U.S. 60, 66, 77 L. Ed. 2d 469, 103 S. Ct. 2875 (1983).

<sup>90</sup> 15 U.S.C. § 1125(c)(3); Patrick D Curran, *Diluting the Commercial Speech Doctrine: "Noncommercial Use" and the Federal Trademark Dilution Act*, 71 THE UNIVERSITY OF CHICAGO LAW REVIEW 1077, 1081, 1082 (2004).

<sup>91</sup> *MATTEL, INC. v. MCA RECORDS INC.*, *supra* note 19 at 907.

the exception.<sup>92</sup> In July 2002, the Court of Appeals denied all the appeals and affirmed the findings of the District Court.<sup>93</sup>

In his judgement Judge Kozinski noted: *With fame comes unwanted attention.*<sup>94</sup> Barbie's fame, history, cultural resonance educated the analysis of the Court at every stage.<sup>95</sup> In its decision, the Court approved the recoding of intellectual property symbols to produce new meanings for the larger cultural discourse.<sup>96</sup> Mattel subsequently filed a writ of certiorari before the US Supreme Court, which was denied on January 27, 2003.<sup>97</sup>

### 2.1.2. *Mattel v. Walking Mountain Productions*

Another classic example of recoding intellectual property symbols was in *Mattel v. Walking Mountain Productions*.<sup>98</sup> In 1997, Thomas Forsythe published a series of 78 photographs titled *Food Chain Barbie*, portraying a nude Barbie in danger of being attacked by vintage household appliances.<sup>99</sup> Forsythe, through his works, had attempted to “deglamorize Barbie,” “skewer the Barbie myth,” and expose an “undercurrent of dissatisfaction with consumer culture.”<sup>100</sup> The series attempted to *critique the objectification of women associated with Barbie and to lambast the conventional beauty myth and the societal acceptance.*<sup>101</sup>

Forsythe used the mark Barbie in some of the titles of his photographs, which gave way to Mattel's infringement and dilution claims. Forsythe explained why he chose Barbie, “*Barbie is the most enduring of those products that feed on the insecurities of our beauty and perfection-obsessed culture.*”<sup>102</sup> While Forsythe's work was commercially unsuccessful and earned less than USD 4000,<sup>103</sup> Mattel tied Forsythe in a *three-year long, \$2 million legal marathon...Forsythe was able to afford the litigation only because of donated legal*

---

<sup>92</sup> *Id.* at 906.

<sup>93</sup> *MATTEL, INC. v. MCA RECORDS INC.*, *supra* note 19.

<sup>94</sup> *Id.* at 899.

<sup>95</sup> *Id.* at 900; Gore, *supra* note 22 at 209–213.

<sup>96</sup> For more information about how intellectual property symbols are recoded by public discourse, please see: Justin Hughes, *Recoding intellectual property and overlooked audience interests*, 77 *TEX. L. REV.* 923, 940, 941 (1998).

<sup>97</sup> *Mattel, Inc. v. MCA Records*, 537 U.S. 1171, 123 S. Ct. 993, 154 L. Ed. 2d 912, 2003 U.S. LEXIS 920.

<sup>98</sup> *Mattel, Inc. v. Walking Mt. Prods.* DC, 2001 U.S. App. LEXIS 2610; *Mattel Inc. v. Walking Mt. Prods.*, 353 F.3d 792 (2003); Yen-Shyang Tseng, *Protecting the First Amendment Rights of Video Games from Lanham Act and Right of Publicity Claims*, 48 *PEPPERDINE LAW REVIEW* 425–496, 436–438 (2021).

<sup>99</sup> For eg see: Hunter and Lastowka, *supra* note 17 at 270.

<sup>100</sup> *MATTEL INC. v. WALKING MT. PRODS.*, *supra* note 98 at 45–48; BARTON BEEBE, *TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK* 122 (8 ed. 2021).

<sup>101</sup> *MATTEL INC. v. WALKING MT. PRODS.*, *supra* note 98.

<sup>102</sup> *Id.* at 796.

<sup>103</sup> Tushnet, *supra* note 48 at 418.

assistance.<sup>104</sup> Interestingly, Forsythe's work benefited from the blatant disregard of the intellectual property doctrine by Mattel.<sup>105</sup> 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 called as the *Streisand effect*.<sup>106</sup>

Mattel contested the suit for copyright and trademark infringement.<sup>107</sup> The district court ruled,<sup>108</sup> and the Court of Appeals confirmed<sup>109</sup> that Forsythe's use of the copyrighted Barbie was fair-use and was therefore not actionable.<sup>110</sup> 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.<sup>111</sup> 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.<sup>112</sup>

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*.<sup>113</sup> Dealing with the nature of the secondary use, the Court opined that Forsythe's use of the trade dress amounted to *nominative fair use*.<sup>114</sup> 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.<sup>115</sup>

The Courts in the Mattel judgements effectively recognise that trade marks 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 without the hit and miss predictability of prior law*.<sup>116</sup> Further, the Court of Appeals for the Ninth Circuit

---

<sup>104</sup> Mark Sableman, *Artistic expression today: Can artists use the language of our culture*, 52 ST. LOUIS UNIVERSITY LAW JOURNAL 187, 202–205 (2007).

<sup>105</sup> See: Sandra Rierson, *The Myth and Reality of Dilution*, 11 DUKE LAW & TECHNOLOGY REVIEW 212–312, 278 (2012).

<sup>106</sup> See: Zubair Nabi, *Resistance-censorship is futile*, 19 FIRST MONDAY, 2 (2014).

<sup>107</sup> Since the paper is concentrated on studying the trademark doctrine, discussions surrounding Copyright infringement have been purposefully omitted. For discussions on copyright issues, please see: Dana Drexler, *Mattel Inc. v. Walking Mt. Prods.* 353 F. 3D 792 (9TH CIR. 2003), 15 DEPAUL JOURNAL OF ART, TECHNOLOGY & INTELLECTUAL PROPERTY LAW 433 (2005).

<sup>108</sup> MATTEL, INC. V. WALKING MT. PRODS. DC, *supra* note 98.

<sup>109</sup> MATTEL INC. V. WALKING MT. PRODS., *supra* note 98.

<sup>110</sup> Drexler, *supra* note 107 at 436–441.

<sup>111</sup> MATTEL INC. V. WALKING MT. PRODS., *supra* note 98 at 807.

<sup>112</sup> *Id.*

<sup>113</sup> *Id.* at 809.

<sup>114</sup> *Id.* at 47, 48; Tushnet, *supra* note 48 at 421–423.

<sup>115</sup> MATTEL INC. V. WALKING MT. PRODS., *supra* note 98 at 49.

<sup>116</sup> Sableman, *supra* note 104 at 205; Tushnet, *supra* note 48 at 424–426.

remanded the case to determine the attorney's fee and other damages in *Walking Mountain*. The Defendants were able to recover almost USD two million.<sup>117</sup> The grant of such an award serves as a necessary deterrent against frivolous litigation attempting to contain expressive speech.<sup>118</sup>

## **2.2. India: *Mattel v. Aman Bijal Mehta***

Identical to the *Mattel v. MCA* dispute, the Indian case concerning the Barbie trade mark also involved a song titled "*Barbie Girl*," as part of a cinematograph film.<sup>119</sup> 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 trade mark entitlements, claimed 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.*"<sup>120</sup> 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<sup>121</sup> has cleared a film, it shall be presumed that it is not defamatory to anyone.<sup>122</sup>

Citing the decisions from *Walking Mt. Prods.* and *MCA*, the Court noted, "*Barbie is seeking in India what has been denied to it in the Court of its origin.*"<sup>123</sup> 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.

However, what Mattel failed to achieve in America, it achieved in India. The interlocutory proceedings were *ex-parte* in nature,<sup>124</sup> and the Court issued notices and called upon the

---

<sup>117</sup> *Mattel, Inc. v. Walking Mt. Prods.*, 2004 U.S. Dist. LEXIS 12469.

<sup>118</sup> Tushnet, *supra* note 48 at 424, 426.

<sup>119</sup> *Mattel, Inc. & Anr. v. Aman Bijal Mehta*, 2017 SCC OnLine Del 11857 13 Justice Endlaw also highlighted the similarities between the two disputes.

<sup>120</sup> *Id.* at 22; The judgement of the court is only an obiter observation, which only has a persuasive authority and lacks any binding precedence, See: E. M. RAO, *INDUSTRIAL JURISPRUDENCE A CRITICAL COMMENTARY* 12.8.5 (First edition ed. 2015).

<sup>121</sup> Central Board of Film Certification is a statutory body under Ministry of Information And Broadcasting, regulating the public exhibition of film under the provisions of the Cinematograph Act 1952. Films can be publicly exhibited in India only after they have been certified by the Central Board of film certification.

<sup>122</sup> *MATTEL, INC. & ANR. V. AMAN BIJAL MEHTA*, *supra* note 119 at 23.

<sup>123</sup> *Id.* at 24.

<sup>124</sup> 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; See: *HALSBURY'S LAWS OF INDIA*, 65.335 (M. N. Venkatachaliah ed., Second edition ed. 2013).

Defendants to submit their written submissions before the Court.<sup>125</sup> Typical of the Indian IP litigation, the dispute did not survive the interlocutory stage.<sup>126</sup> The Defendants withdrew all references to *Barbie* and submitted an undertaking to this effect before the Court.<sup>127</sup> Thus, on account of premature withdrawal, the dispute failed to delineate the regulation of cultural icons within the Indian trade mark doctrine. 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 in favour of the *Indian Barbie Girl*.

### **2.3. Canada: *Mattel v. 3894207 Canada Inc.***

In 1992, *3894207 Canada Inc.* started using the mark *Barbie's* in reference to three restaurants in Montreal. Between 1992 and 1996, the restaurant generated considerable sales, totalling more than 20 million USD.<sup>128</sup> In 1993, the restaurant owner applied for registration of the mark *Barbie's* in stylised formats for use in association with *restaurant services, take-out restaurant services, catering and banquet services*.<sup>129</sup> Mattel objected to the Defendants' commercial exploitation of the subject mark by citing their 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<sup>130</sup> rejected Mattel's objection.<sup>131</sup> On appeal, the Federal Court also denied the existence of any likelihood of confusion.<sup>132</sup> On further appeal, the Canadian Federal Court of Appeals endorsed the lower courts' findings and argued that if fame could prevent all other uses of a mark, the fundamental concept of granting a trademark in association with certain goods would be meaningless.<sup>133</sup> Eventually, the issue was appealed to the Supreme Court of Canada.<sup>134</sup>

---

<sup>125</sup> MATTEL, INC. & ANR. v. AMAN BIJAL MEHTA, *supra* note 119.

<sup>126</sup> A disturbing reality of trade mark litigation in India is that many litigations are concluded at an interlocutory stage. The litigants do not take cases to trial, See: Dev Gangjee, *Chapter 12: India*, in INTERNATIONAL TRADEMARK DILUTION (Daniel R Bereskin ed., 2021).

<sup>127</sup> See: *Mattel, Inc. & Anr. v. Aman Bijal Mehta & Ors.* CS(COMM) 803/2017, see order dated November 30, 2017.

<sup>128</sup> For more details see: Paul D Blanchard, Lisa R Vatch & Andrea P Flewelling, *The Barbie Case: The Supreme Court of Canada Restates the Test for Trade-Mark Confusion*, 96 TRADEMARK REP. 1034, 1035 (2006).

<sup>129</sup> Application Nos. 736898, 736896. Canadian Trademark Office

<sup>130</sup> In Canada, the Trademark Opposition Board acts on behalf of the Registrar of Trademarks in adjudicating trademark opposition proceedings.

<sup>131</sup> *Mattel U.S.A., Inc. v. 3894207 Canada Inc.*, (2002), 23 C.P.R. (4th) 395 (T.M.O.B.).

<sup>132</sup> *Mattel, Inc. v. 3894207 Canada Inc. et al.*, 30 C.P.R. (4th) 456.

<sup>133</sup> *Mattel, Inc. v. 3894207 Canada Inc. et al.*, (2005), 38 C.P.R. (4th) 214.

<sup>134</sup> *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 SCR 772.



In the Canadian dispute, the secondary use was primarily commercial.<sup>135</sup> Therefore the Court relied on the traditional test for confusion<sup>136</sup> and did not adopt a novel test as was the case in the two American decisions.<sup>137</sup> Further, the Canadian Supreme Court held that fame associated with the *Barbie* mark is only a ‘*surrounding circumstance*’<sup>138</sup> and cannot deliver the proverbial knock-out blow in a confusion analysis.<sup>139</sup> According to Justice Binnie, trade marks are protected because they assure consistency of origin and quality.<sup>140</sup> The secondary use cannot be constrained without damage to either of these functions.<sup>141</sup>

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.<sup>142</sup> Further, the case before the Canadian Supreme Court arose in a trade mark opposition context. Since the Canadian Trademark law does not allow dilution and misappropriation as grounds for opposing trademark applications,<sup>143</sup> the Court was unarmed by concerns of misappropriation or denigration of goodwill.<sup>144</sup> 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.

---

<sup>135</sup> *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, <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. .

<sup>136</sup> Section 6(5) of the Canadian Trademarks Act, 1985 enlists certain factors for assessment of confusion. The *Mattel* case highlighted the relevance of fame as one of the factors for addressing confusion; Howell Robert G., *A Watershed Year for Well Known or Famous Marks*, in AN EMERGING INTELLECTUAL PROPERTY PARADIGM: PERSPECTIVES FROM CANADA 22, 25–28 (Ysolde Gendreau ed., 2008).

<sup>137</sup> Tushnet, *supra* note 48.

<sup>138</sup> *MATTEL, INC. V. 3894207 CANADA INC*, *supra* note 134 at 74, 87; International Trademark Association, *The Fourteenth Annual International Review of Trademark Jurisprudence*, 97 THE TRADEMARK REPORTER 311, 370–372 (2007); Blanchard, Vatch, and Flewelling, *supra* note 128 at 1053.

<sup>139</sup> Robert G., *supra* note 136 at 26, 27.

<sup>140</sup> *MATTEL, INC. V. 3894207 CANADA INC*, *supra* note 134 at 21 The Court in its judgement held that mark’s claim to monopoly rests on serving an important public interest in assuring consumer that they are buying from the source from whom they think they are buying and receiving the quality which they associate with the particular trade mark.

<sup>141</sup> *Id.* at 83–87; Blanchard, Vatch, and Flewelling, *supra* note 130.

<sup>142</sup> A prime example of this distinction is that while the Courts in *MCA* and *Walking Mt. Prods.* consider the reason why the Defendants’ use the *Barbie* mark. Alternatively, in Canada, the Court held that the intention before

<sup>143</sup> Stephanie Chong, *Chalk and Cheese: What’s the Connection?*, 24 CANADIAN INTELLECTUAL PROPERTY REVIEW 1, 7 (2006); JOHN S. MCKEOWN, CANADIAN INTELLECTUAL PROPERTY LAW AND STRATEGY: TRADEMARKS, COPYRIGHT, AND INDUSTRIAL DESIGNS 123–125 (2010); Robert G., *supra* note 136 at 22–27.

<sup>144</sup> Misappropriation of Goodwill is protected within Canadian Trademark Law by Section 22, Trademarks Act, 1985, See: Robert G., *supra* note 136 at 27–34.

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.

### 3. Barbie mark, parody and free speech

Parodies and expressive secondary uses 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 trade mark law,<sup>145</sup> a determination that the secondary use qualifies as parody activates the free speech doctrine and enables the defendant to counteract trade mark protections with constitutional safeguards.<sup>146</sup> This section explores how secondary use of the Barbie mark instigates its parodic reinterpretation.

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 idealised image created by the marks on her.”<sup>147</sup> A parody relies on a humorous and critical comment to produce the desired effect and distinguish itself from the original trademark.<sup>148</sup> One important element of a successful parody is it should be able to *conjure up the original*.<sup>149</sup> The public should be able to *recognise the underlying mark through the ciphers provided by the parodist*.<sup>150</sup> A parodist usually has no interest in creating consumer confusion<sup>151</sup> and therefore parodies are subjected to scrutiny within the trade mark 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

---

<sup>145</sup> See: Sandra L. Rierison, *US Anti-Dilution Law in Historical and Contemporary Context*, in THE CAMBRIDGE HANDBOOK OF INTERNATIONAL AND COMPARATIVE TRADEMARK LAW 483–498, 495–498 (Irene Calboli & Jane C. Ginsburg eds., 2020).

<sup>146</sup> *Id.* at 496; *Tommy Hilfiger Licensing, Inc. v. Nature Labs*, 221 F.Supp.2d 410 at 415, S.D.N.Y.; *MATTEL, INC. v. MCA RECORDS INC.*, *supra* note 21; *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 1997 U.S. App. LEXIS 5822 Parody has socially significant values as free speech under the first amendment. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 493 (2d Cir. 1989) Parody and satire a deserving of substantial freedom both as entertainment and as a form of social and literary criticism.

<sup>147</sup> *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC.*, 507 F.3d 252 (4th Cir. 2007).

<sup>148</sup> Rierison, *supra* note 145 at 496.

<sup>149</sup> Gary Myers, *Trademark Parody: Lessons from the Copyright Decision in Campbell v. Acuff-Rose Music, Inc.*, 59 LAW & CONTEMP. PROBS. 181, 185 (1996); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (1994) Explain that a successful parodist makes an original statement about something already popularly known.

<sup>150</sup> Sabine Jacques, *Parody Exception: Why trademark owners should get the joke*, 38 EUROPEAN INTELLECTUAL PROPERTY REVIEW 471 (2016).

<sup>151</sup> *LOUIS VUITTON MALLETIER S.A. v. HAUTE DIGGITY DOG, LLC.*, *supra* note 147 The Court reasoned that “an effective parody will actually diminish the likelihood of confusion” because it enables audiences “to perceive the target of the parody, while simultaneously allowing them to recognize the changes to the mark that make the parody funny or biting.”

for the fame of a mark.<sup>152</sup> 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 *Mattel v. MCA* noted that *parody inevitably offends others because it so often ridicules secrets, verities and prevailing mores.*<sup>153</sup> 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.*"<sup>154</sup> In *Mattel v. Walking Mt. Prod.* Barbie, Justice Pregerson relied on the social commentary and the cumulative context of Forsythe's work to argue that *Food Chain Barbie* constitutes a parodic reinterpretation.<sup>155</sup>

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.<sup>156</sup> The explicit reliance of the court 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 trade marks. For instance, in *Tata v. Greenpeace*, the defendant had reproduced a mark in a video game simulation.<sup>157</sup> Citing their trade mark rights, the plaintiff sought to muzzle the defendants' secondary use that was targeted at criticising an infrastructure project. Extensively relying on international jurisprudence,<sup>158</sup> the Court introduced the idea of the *Parody Paradox*. The Court emphasised that parody, while distinct from the original mark, relies substantially on the original mark to accomplish its goal.<sup>159</sup> Further, the Court noted that the more popular a mark, the more vulnerable it would be to a parodic reinterpretation.<sup>160</sup> In effect, the judiciary

---

<sup>152</sup> Lemley, Mark A., *supra* note 20 at 13.

<sup>153</sup> *MATTEL, INC. V. MCA RECORDS, INC.* 20943, *supra* note 79 at 1137; citing *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987).

<sup>154</sup> *MATTEL, INC. V. MCA RECORDS, INC.* 20943, *supra* note 79 at 1149.

<sup>155</sup> *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

<sup>156</sup> *MATTEL, INC. & ANR. V. AMAN BIJAL MEHTA*, *supra* note 119 at 22.

<sup>157</sup> *Tata Sons Ltd. v. Greenpeace International & Anr.*, 45 PTC 275 (2011).

<sup>158</sup> *Laugh It Off Promotions CC v. S. African Breweries Int'l (Fin.) BV t/a Sabmark Int'l & Another*, 2005 (8) BCLR 743 (CC); *Esso Francaise SA v. Association Greenpeace France*, 2003 ETMR 66.

<sup>159</sup> See: Tushnet, *supra* note 48.

<sup>160</sup> Lawrence Liang, *Fair Use of Cinematograph Films and Sound Recordings: Finding the Solution in the Amendment*, 5 NUJS LAW REVIEW 687, 697, 698 (2012).

has limited the ability of a trade mark owner to control the semiotic landscape by citing a mediation between the trade mark doctrine and constitutional safeguards.<sup>161</sup>

While the discussion in the Canadian Barbie case was limited to commercial infringement of the Barbie mark, the Canadian trade mark doctrine also protects parodies. In 1996, the Federal Court of Canada noted that “*the threshold of protecting expression is high.*”<sup>162</sup> The commercial nature of secondary use looms large in Canada’s protection of trade mark rights.<sup>163</sup> In *British Columbia Automobile Association v. OPEIU*, the court noted that, 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.*”<sup>164</sup> Further, The Canadian trade mark jurisprudence has heavily relied on the lack of an exception for parodic uses in trade mark law. In the case of *United Airlines v. Cooperstock*,<sup>165</sup> the Court relied on the fact that the secondary use was meant to evoke the original mark to protect the rights of the trade mark holder. While such recall is an essential element of every parody, the court enjoined the secondary use.<sup>166</sup>

Thus, while parody was not a question before the Canadian Supreme Court, in America 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 the secondary 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 USA. The next section studies how these constitutional safeguards educate the confusion analysis and dilution claims.

#### **4. Barbie mark and liability through secondary use**

The influence and relevance of a finding of parody within a trade mark infringement proceeding is best explained by Judge Byrne in *Mattel v. MCA*, “*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.*”<sup>167</sup>

---

<sup>161</sup> *Id.*

<sup>162</sup> *Michelin & Cie v. CAW*, 2 FC 306, 112 (1997).

<sup>163</sup> Sebastian D Beck-Watt, *Just Laugh It Off: Trademark Parody and the Expansion of User Rights*, 30 INTELLECTUAL PROPERTY JOURNAL 95–124 (2017) Consequently, the tension between the commercial protection of trademark law and the user is right to freedom of expression is admitted to the Canadian jurisprudence.

<sup>164</sup> *British Columbia Automobile Assn v OPEIU*, [2001] 4 WWR 95.

<sup>165</sup> *United Airlines, Inc. v. Cooperstock*, 2017 FC 616.

<sup>166</sup> Sabine Jacques, *First application of the Canadian parody exception*, 12 JOURNAL OF INTELLECTUAL PROPERTY LAW & PRACTICE 895–896 (2017).

<sup>167</sup> *MATTEL, INC. v. MCA RECORDS, INC.* 20943, *supra* note 79 at 1145.

This section examines how the cultural resonance of Barbie, and a finding of parody, determines the context of trademark infringement.

#### **4.1. 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.*”<sup>168</sup> Many forms of actionable confusion, such as sponsorship and post-sale, have assumed importance in judicial and academic discourse.<sup>169</sup> 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.

In United States, the Court of Appeals in *Mattel v. MCA* and *Mattel v. Walking Mt. Prods.* noted that when trade mark law potentially impinges on freedom of speech and expression, the traditional test of confusion<sup>170</sup> “*fails to account for the full weight of the public’s interest in free expression.*”<sup>171</sup> In order to accommodate the concerns of free speech and expression, the Courts in both the cases referred to *Rogers v. Grimaldi*. The *Rogers test* adopts a balancing test and maintains that judicial interference is warranted only *where the public interest in avoiding consumer confusion outweighs the public interest in free speech.*<sup>172</sup> In order to determine confusion in an artistic and expressive secondary use, the *Rogers test* posits a two-step analysis. 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.*<sup>173</sup>

In *Mattel v. MCA*, the defendants had used the Barbie mark in the title of their song, while in *Mattel v. Walking Mt. Prods.*, the use secondary was in the titles of individual photographs. According to the Court of Appeals in both American cases, “*Consumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the*

---

<sup>168</sup> DANIEL GERVAIS, THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS 330 (4th edition ed. 2012); Rasmus Dalgaard Laustsen, *Likelihood of Confusion: Legislative Harmonisation?*, in THE AVERAGE CONSUMER IN CONFUSION-BASED DISPUTES IN EUROPEAN TRADEMARK LAW AND SIMILAR FICTIONS 253, 260 (Rasmus Dalgaard Laustsen ed., 2020).

<sup>169</sup> See: Robert G Bone, *Taking the confusion out of likelihood of confusion: Toward a more sensible approach to trademark infringement*, 106 NW. UL REV. 1307, 1315, 1316 (2012).

<sup>170</sup> The Court in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979), developed eight specific factors for courts to use in evaluation likelihood of confusion in trademark cases. Ryan Baker, *Bidding on Trademarked Keywords in Search Engines: A Trademark Law Update*, 8 WASH. JL TECH. & ARTS 543, 542 (2012).

<sup>171</sup> *MATTEL, INC. v. MCA RECORDS INC.*, *supra* note 19 at 900; *MATTEL INC. v. WALKING MT. PRODS.*, *supra* note 98 at 1267.

<sup>172</sup> *ROGERS V. GRIMALDI*, *supra* note 87.

<sup>173</sup> *Id.* at 999.

*publisher or producer.*”<sup>174</sup> In both cases, 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*.<sup>175</sup> The Court of Appeals went as far as to suggest that if such use is held to be misleading, it will *render Rogers nullity*.<sup>176</sup> 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*.<sup>177</sup> 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.<sup>178</sup>

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, as brought forth by the use of the Barbie trade mark.<sup>179</sup> However, while dealing with trade dress concerns, the Court decided to conclude the analysis on a much narrower ground: the nominative fair use exception.<sup>180</sup> Explaining the contours of 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*.<sup>181</sup> While the Court of Appeals in *Mattel v. MCA* did not deem it necessary to address the nominative fair use analysis,<sup>182</sup> the District Court’s judgement on the issue followed identical reasoning as *Mattel v. Walking Mt. Prods.*<sup>183</sup>

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

---

<sup>174</sup> MATTEL, INC. V. MCA RECORDS INC., *supra* note 19; MATTEL INC. V. WALKING MT. PRODS., *supra* note 100 at 1267.

<sup>175</sup> MATTEL INC. V. WALKING MT. PRODS., *supra* note 98 at 1267 “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.”; MATTEL, INC. V. MCA RECORDS INC., *supra* note 19 “The use of Barbie in the song title clearly is relevant to the underlying work, namely, the song itself.”

<sup>176</sup> MATTEL, INC. V. MCA RECORDS INC., *supra* note 19 at 1720; MATTEL INC. V. WALKING MT. PRODS., *supra* note 98 at 1267.

<sup>177</sup> MATTEL INC. V. WALKING MOUNTAIN PRODS., *supra* note 155 at 807.

<sup>178</sup> For details see: Drexler, *supra* note 107; Wallack, *supra* note 85.

<sup>179</sup> MATTEL INC. V. WALKING MT. PRODS., *supra* note 98 at 1267, 1268.

<sup>180</sup> *Id.* at 808; Tushnet, *supra* note 48 at 421.

<sup>181</sup> MATTEL INC. V. WALKING MT. PRODS., *supra* note 98 at 810.

<sup>182</sup> The Court believed that its analysis through *Rogers v. Grimaldi* was dispositive of Mattel’s claims.

<sup>183</sup> MATTEL, INC. V. MCA RECORDS, INC. 20943, *supra* note 79 at 1141–1143.

and the fact that she has been the subject of continuous criticism.<sup>184</sup> 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 trade mark doctrine.

The importance of expressive and parodic uses is well-established in the 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.*<sup>185</sup>

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.

Unlike *Aman Bijal Mehta, MCA* and *Walking Mountain*, the dispute in the case of *Mattel v. 3894207 Canada Inc.* did not involve an expressive secondary use.<sup>186</sup> 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.<sup>187</sup> The Barbie mark was held to be 1) famous, 2) similar but not identical to the defendant's mark, and 3) there was a significant divergence in the ware and services in reference to which the two marks were applied.<sup>188</sup> 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*.'<sup>189</sup> Siding with the decisions from the lower courts, the Supreme Court of Canada allowed the registration of the Defendant's mark.

---

<sup>184</sup> MATTEL, INC. & ANR. V. AMAN BIJAL MEHTA, *supra* note 119 at 28.

<sup>185</sup> *Dr. Reddy's Laboratories Limited v. Eros International Media Limited*, 2021 SCC OnLine Del 1298 24; citing *TATA SONS LTD. V. GREENPEACE INTERNATIONAL & ANR.*, *supra* note 168; 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 a language suggests that infringement and dilution frameworks are concurrently studied by the Indian court. This results in doctrinal confusion and theoretical misunderstandings. For details 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).

<sup>186</sup> As explained in Part 2, the dispute before the Canadian Supreme Court singularly related to commercial use in reference to restaurants. See: Blanchard, Vatch, and Flewelling, *supra* note 136 at 1037.

<sup>187</sup> Robert G., *supra* note 136.

<sup>188</sup> *Id.*

<sup>189</sup> MATTEL, INC. V. 3894207 CANADA INC, *supra* note 134; Robert G., *supra* note 136.

## 4.2. Barbie mark and trademark dilution

The traditional underpinnings of trade mark law have focused on mitigating and controlling consumer confusion.<sup>190</sup> On the other hand, the dilution doctrine protects a trade mark's *selling power*,<sup>191</sup> rendering otiose any analysis of consumer confusion within the dilution framework.<sup>192</sup> 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.<sup>193</sup> The exception has been interpreted to be a *general exemption for constitutionally protected forms of expression and criticism*.<sup>194</sup> 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<sup>195</sup> and blurring.<sup>196</sup> 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.<sup>197</sup> 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.*"<sup>198</sup> 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 US 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.*<sup>199</sup> 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

---

<sup>190</sup> Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1035 (2006).

<sup>191</sup> See: Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARVARD LAW REVIEW 813 (1927).

<sup>192</sup> ITC v. Philip Morris, 42 PTC 572 (2010); Cipla Ltd. v. Cipla Industries Pvt. Ltd., AIR 2017 Bom 75 24 "Thus, for attracting sub-section (4), it is not necessary for the plaintiff to show possibility of confusion."; Dev Gangjee, *The Polymorphism of Trademark Dilution in India*, 17 TRANSNAT'L L. & CONTEMP. PROBS. 611 (2008); AKHILESHWAR PATHAK, *Changing context of trade mark protection in India: a review of the trade marks act, 1999*, (2004).

<sup>193</sup> 15 U.S.C. § 1125(c)(3)(C).

<sup>194</sup> Curran, *supra* note 90 at 1081–1082.

<sup>195</sup> 15 U.S.C. § 1125(c); Creating negative and damaging associations with the subject mark; See: AMIR FRIEDMAN, TRADEMARK DILUTION: THE PROTECTION OF REPUTED TRADEMARKS BEYOND LIKELIHOOD OF CONFUSION 3.2.6 (2022).

<sup>196</sup> Reducing the 'recallability' of the Barbie Mark, See: *Id.* at 3.2.5.

<sup>197</sup> MATTEL, INC. v. WALKING MT. PRODS. DC, *supra* note 98 at 812; MATTEL, INC. v. MCA RECORDS INC., *supra* note 19 at 906.

<sup>198</sup> MATTEL, INC. v. MCA RECORDS INC., *supra* note 19 at 906, 907; citing HOFFMAN v. CAPITAL CITIES, *supra* note 89.

<sup>199</sup> Curran, *supra* note 90 at 1089; This interpretation has been approved by the court in: American Family Life Insurance Co v Hagan, 266 F Supp 2d 682 (ND Ohio 2002).



deserve protection. What is important is how much of the secondary use is expressive and deserves constitutional protection. The mere existence of expressive use would qualify a Defendant's use for the non-commercial use defence.

In India, the Court in *Aman Bijal Mehta* did not consider the plaintiffs' dilution claim. While Justice Endlaw noted that Mattel claimed trade mark 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 is similar to the one within the American trade mark doctrine. A '*due cause*' limitation limits the dilution protection in India. A *justifiable or probable reason*<sup>200</sup> or a *tenable explanation*<sup>201</sup> for the secondary use would trigger the *due cause* limitation. Denominative<sup>202</sup> and non-trade mark use<sup>203</sup> 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,<sup>204</sup> which will further assist in a finding in favour of *due cause.*<sup>205</sup> 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-trade mark use, it would be protected from any liability within the Indian dilution doctrine.

As discussed, the Canadian trade mark law does not consider dilution as a ground of opposition;<sup>206</sup> 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.<sup>207</sup> Similar to the non-trademark use exception in India,<sup>208</sup> the Canadian dilution doctrine is limited to secondary use in association with wares

---

<sup>200</sup> Blue Hill Logistics Private Ltd. v. Ashok Leyland Limited, 48 PTC (DB) 564 (2011); Gangjee, *supra* note 126 at 322.

<sup>201</sup> Nestle India Ltd. v. Mood Hospitality India Pvt. Ltd., 42 PTC (Del.) 514 (2010); Gangjee, *supra* note 126 at 322, 323.

<sup>202</sup> 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 (2019).

<sup>203</sup> NESTLE INDIA LTD. V. MOOD HOSPITALITY INDIA PVT. LTD., *supra* note 201; Also see: AMANDA MICHAELS & ANDREW NORRIS, A PRACTICAL GUIDE TO TRADE MARK LAW 87,88 (Fifth edition ed. 2014).

<sup>204</sup> See for example: TATA SONS LTD. V. GREENPEACE INTERNATIONAL & ANR., *supra* note 157.

<sup>205</sup> Gangjee, *supra* note 126.

<sup>206</sup> See: MCKEOWN, *supra* note 143 at 123–125; BORDEN LADNER GERVAIS LLP, TRADE-MARK PRACTICE IN CANADA 99–101 (2011).

<sup>207</sup> FRIEDMAN, *supra* note 195 at 105.

<sup>208</sup> NESTLE INDIA LTD. V. MOOD HOSPITALITY INDIA PVT. LTD., *supra* note 201; Also see: MICHAELS AND NORRIS, *supra* note 203 at 87,88.

and goods.<sup>209</sup> This means that the Canadian dilution doctrine cannot be activated unless the secondary use designates good or services. In *Clairol Enterprises*, while the secondary use in packaging activated the dilution doctrine, the use on brochures did not.<sup>210</sup> Similarly, in *Michelin*, Court argued that using the plaintiff’s registered trade mark on pamphlets soliciting participation in union activities did not qualify as ‘*trade mark*’ use for the dilution doctrine.<sup>211</sup>

### Discussion

Barbie’s cultural resonance and history has loomed large in the Courts’ analysis of its trade mark rights. Whenever an expressive secondary use of the Barbie mark is concerned, the judicial discourse invariably turns to the doll’s social positioning. Extrapolating this analysis to other cultural icons, it can be argued that similar treatment should be afforded to expressive uses of reverent trade marks. However, in India, this conclusion is accompanied by two important caveats: 1) lack of judicial and academic discourse around expressive use of trade marks including parodies,<sup>212</sup> and 2) the lack of a proper distinction between actionable misuse and permitted secondary use.<sup>213</sup> The lack of clear legislative guidance and recurring reliance on multi-factor tests creates hyper-specialised instances where protection is afforded. This results in ambiguity in the legal doctrine.<sup>214</sup>

Apart from ambiguity, a volatile and unclear approach to intellectual property disputes can result in an incorrect interpretation of the law. For example, the Canadian Federal Court in 2017 enjoined a gripe site targeted at coalescing negative reviews against an airline company.<sup>215</sup> 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, Defendant’s website was enjoined under both the confusion and the dilution framework.<sup>216</sup>

Owing to the lack of any legislative guidelines, Courts often build unique standards for litigating the presented disputes. The lack of such a legislative tether results in omission of a

---

<sup>209</sup> MCKEOWN, *supra* note 143 at 123–128; Also see: *Veuve Clicquot Ponsardin v. Boutiques Cliquot*, [2006] 1 S.C.R. 824, 49 C.P.R. (4th) 401 (S.C.C.).

<sup>210</sup> *Clairol International Corp. v. Thomas Supply & Equipment Co.*, (1968), 55 C.P.R. 176 (Ex. Ct.); MCKEOWN, *supra* note 145 at 125; Daniel R Bereskin, *Trademark Use in Canada*, 87 TRADEMARK REP. 301, 312–316 (1997).

<sup>211</sup> *MICHELIN & CIE v. CAW*, *supra* note 162; Daniel R Bereskin QC, *United Airlines, Inc. v. Jeremy Cooperstock: A Critical Review*, 33 INTELLECTUAL PROPERTY JOURNAL 91, 99–100 (2020); Bereskin, *supra* note 210 at 316–318.

<sup>212</sup> Does it matter if the judge laughs?, *MANAGING INTELL. PROP.*, 2010, at 32.

<sup>213</sup> *Gangjee*, *supra* note 126 at 324.

<sup>214</sup> *Tushnet*, *supra* note 48.

<sup>215</sup> *UNITED AIRLINES, INC. v. COOPERSTOCK*, *supra* note 165.

<sup>216</sup> *QC*, *supra* note 211 at 111–113.

discussion on precedential standards. In 2020, the Delhi High Court enjoined 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.<sup>217</sup> In its decision, the Court did not refer to the discussion from *Tata v. Greenpeace*,<sup>218</sup> a case which set the standard for dealing with issues at the intersection of trade mark infringement and freedom of speech.

The resulting ambiguity creates an argument favouring entities like Mattel to flex their intellectual property rights.<sup>219</sup> The constitutional assurance of protecting freedom of speech and expression should be reflected in the legislative scheme of The 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.<sup>220</sup> 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.<sup>221</sup> 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 trade marks 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.

---

<sup>217</sup> *Anhueser Busch Llc v. Rishav Sharma*, 83 PTC (Del) 217 (2020); Mohan and Gupta, *supra* note 185.

<sup>218</sup> *TATA SONS LTD. V. GREENPEACE INTERNATIONAL & ANR.*, *supra* note 157.

<sup>219</sup> For a better understanding of the argument in favour of Mattel, see: Liz Somerstein, *Who Is Really Protecting Barbie: Goliath or the Silver Knight? A Defense of Mattel's Aggressive International Attempts to Protect Its Barbie Copyright and Trademark*, 39 THE UNIVERSITY OF MIAMI INTER-AMERICAN LAW REVIEW 559–585 (2008).

<sup>220</sup> USA: 17 U.S.C. § 107 Copyright Act of 1976; Canada: § 29, Copyright act of 1985; India: § 52, Copyright Act, 1957; MP Ram Mohan & Aditya Gupta, *Right to Research and Copyright Law: From Photocopying to Shadow Libraries*, IIM-AHMEDABAD WORKING PAPER SERIES, 3 (2021), [https://web.iima.ac.in/faculty-and-research/research-and-publication/working-papers.html&rnp\\_id=14662](https://web.iima.ac.in/faculty-and-research/research-and-publication/working-papers.html&rnp_id=14662) (last visited Apr 13, 2022); PAUL GOLDSTEIN & P. B. HUGENHOLTZ, *INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE* 11 (Fourth edition ed. 2019).

<sup>221</sup> Tushnet, *supra* note 48.