

***MATTEL, INC. V. MCA RECORDS, INC.: LET'S
PARTY IN BARBIE'S WORLD—EXPANDING
THE FIRST AMENDMENT RIGHT TO
MUSICAL PARODY OF CULTURAL ICONS***

I. INTRODUCTION

On July 24, 2002, the Ninth Circuit Court of Appeals decided *Mattel, Inc. v. MCA Records, Inc.*¹—a case that may have a substantial impact on reaching a balance between the interests of trademark owners of cultural icons and the First Amendment rights of musical parodists of those cultural icons. By ruling in favor of the defendants, the Ninth Circuit held that the use of the “Barbie” trademark in a musical parody (1) was not an infringement of the toy manufacturer’s trademark associated with the Barbie doll because the song was not likely to confuse the consumer as to its source or sponsorship, and (2) was not actionable under the Federal Trademark Dilution Act (FTDA)² as diluting the Barbie trademark because the song fell within the noncommercial use exception.³

Congress enacted the FTDA in 1995 as an amendment to the Lanham Act,⁴ which provides trademarks with federal protection from unfair competition and infringement. The purpose of the FTDA is to provide additional protection against successive uses that tarnish, disparage, or blur the distinctive quality of the mark,⁵ and to create a consistent remedy to trademark owners who suffer such dilution.⁶ Because the federal dilution statutes are unclear on the

1. 296 F.3d 894 (9th Cir. 2002).

2. Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125(c) (1995).

3. *See Mattel*, 296 F.3d at 894.

4. Trademark Act of 1946, 15 U.S.C. §§ 1051–1127 (1994 & Supp. II 1996) (“Lanham Act”).

5. *See* H.R. REP. No. 104-374, at 2–3 (1995), *reprinted in* 1995 U.S.C.C.A.N. 1029, 1029–30.

6. *See* 15 U.S.C. § 1125(c)(1). The court may grant injunctive relief if the trademark owner demonstrates the existence of dilution. However, the mark’s

application of First Amendment defenses, courts have had to strike their own balance between free speech rights and trademark protection.⁷ The resulting inconsistent body of law has left “parodists and trademark owners wondering when a parody becomes actionable and when it serves as a defense.”⁸ Courts have had significant difficulty in addressing these concerns, especially when the subject of the trademark protection is a cultural icon.⁹

Barbie is an example of a popular American cultural icon. Over the years “artists and writers have exploited the ‘voluptuous clotheshorse’ as muse and metaphor, developing a rich body of images and texts that use the doll to comment on class inequality, racial stereotypes, and the dark evanescence of childhood sexuality.”¹⁰ In response to such observations and critique of its doll, Mattel, the maker of Barbie, has zealously attempted to protect Barbie’s wholesome image through legal measures.¹¹ Thus, after the Danish band Aqua released its risqué song titled *Barbie Girl*, Mattel

owner may be entitled to damages upon establishing the defendant’s willful intent to “trade on the owner’s reputation or to cause dilution of the famous mark.” *Id.* § 1125(c)(2).

7. See Keren Levy, *Trademark Parody: A Conflict Between Constitutional and Intellectual Property Interests*, 69 GEO. WASH. L. REV. 425, 435 (2001) (stating, “It is important to remember that a parody exception is not expressly stated in the defenses for dilution. As courts grapple with trademark dilution cases, however, freedom of expression is frequently raised as a defense because it is read into the ‘non-commercial’ use defense.”).

8. *Id.*; see also Edward E. Vassallo & Maryanne Dickey, *Protection in the United States for “Famous Marks”*: *The Federal Trademark Dilution Act Revisited*, 9 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 503, 506 (1999) (concluding that there are many uncertainties regarding the reach and impact of the Federal Dilution Act).

9. 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. L.J. 599, 607 (1998). Cordero argues that to preserve First Amendment principles of freedom of expression, a new standard should apply to the unauthorized use of cultural icons that allows use as long as no confusion exists as to source, sponsorship, or affiliation. *See id.*

10. *Id.* at 636 (citing Margaret Gray Lord, *The Question Is: What Would Ken Think?*, N.Y. TIMES, Dec. 1, 1995, at C1).

11. See, e.g., *Mattel, Inc. v. Goldberger Doll Mfg.*, 200 F. Supp. 517 (E.D.N.Y. 1961) (holding that the defendant, producers of “Miss Babette,” a doll of similar height, attire, and accessories as Barbie, did not infringe the Barbie trademark because Miss Babette was not so similar to Barbie as to confuse an ordinary purchaser).

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filed suit against MCA Records, as well as the distributors and makers of the song, to enjoin continued production and distribution of *Barbie Girl*.

This Comment first provides a background of the facts of *Mattel, Inc. v. MCA Records, Inc.* and the holding of the district court. Second, it provides a summary of the Ninth Circuit's decision and reasoning. Third, the Comment acknowledges that the Ninth Circuit's holding is the correct application of trademark law to musical parodies of cultural icons because it strikes an appropriate balance between protecting trademark interests and First Amendment rights of musical parodists. Finally, the Comment concludes that the Ninth Circuit's holding provides courts with some clarity in addressing the First Amendment rights of musical parodists of cultural icons.

II. FACTS AND HISTORY OF *MATTEL, INC. V. MCA RECORDS, INC.*

A. *Barbie and Barbie Girl*

Created in 1957, Barbie was "inspired by a German doll named Lilli, a pornographic caricature that was a lascivious plaything for men."¹² Over the years, Mattel developed the doll into a huge commercial success, selling the doll "in more than 140 countries at the rate of two dolls every second, netting Mattel \$2 billion in annual profits,"¹³ and making "Barbie" a household word. As a result of Barbie's overtly feminine figure, activists have criticized her as perpetuating sexual stereotypes¹⁴ and serving as a symbol of American sexism.¹⁵ Thus, Barbie has been celebrated as the prototypical woman and simultaneously blamed for creating unrealistic expectations of women.

The distribution of Aqua's *Barbie Girl*, with its sexual lyrics such as "you can brush my hair, undress me everywhere, . . . come on Barbie, let's go party,"¹⁶ sparked the controversy between Mattel

12. Cordero, *supra* note 9, at 636 (citations omitted).

13. *Id.* (citations omitted).

14. *See Id.*

15. *See* MARGARET GRAY LORD, *FOREVER BARBIE: THE UNAUTHORIZED BIOGRAPHY OF A REAL DOLL* 26-29 (1994).

16. Aqua, *Barbie Girl*, on *AQUARIUM* (MCA Records 1997).

and MCA. The song portrayed Barbie and her playmate, Ken, singing “‘I’m a blond bimbo girl’ and ‘Kiss me here, touch me there, hanky-panky’.”¹⁷ To Mattel’s shock, the innovative pop tune became widely popular and broke into the top 40 music charts.¹⁸ Thus, to defend Barbie’s honor and hefty worldwide sales,¹⁹ on September 11, 1997, Mattel filed suit against MCA for trademark infringement.

B. Mattel’s Motion for a Preliminary Injunction

In February of 1998, Mattel moved for a preliminary injunction on its claims for trademark infringement and dilution, asking the court to enjoin the defendants’ manufacturing, production, and distribution of *Barbie Girl*, and to require the destruction of any product or packaging using Mattel’s Barbie trademark.²⁰ The court denied the motion for a preliminary injunction because it found that the plaintiff failed either to show that it was likely to succeed on its infringement and dilution claims, or to demonstrate that the balance of hardships tipped sharply in its favor.²¹

C. Defendants’ Motion for Summary Judgment

After the district court’s denial of the preliminary injunction, defendants filed a motion for summary judgment to dismiss the case.²² The court granted defendants’ motion, finding that the use of Barbie fell within the noncommercial use exception to the FTDA.²³

1. The district court held *Barbie Girl* is a parody

Initially, the court addressed the question of whether *Barbie Girl* constitutes a parody, a finding of which would guarantee the song

17. David Horrigan, *MCA Records Wins Battle of the Barbies*, NAT’L L.J., Aug. 5, 2002, at A4.

18. See Horrigan, *supra* note 17, at A4.

19. See Bob Egelko, ‘*Barbie Girl*’ Pop Song Free Speech, Court Rules, SAN FRAN. CHRON., July 25, 2002, at A2.

20. See *Mattel, Inc. v. MCA Records, Inc.*, 1998 U.S. Dist. LEXIS 7310, at *4 (C.D. Cal. 1998) (citing Pl.’s Proposed Order at 3).

21. See *id.* at *53.

22. See *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1126 (C.D. Cal. 1998).

23. See *id.* at 1156.

First Amendment protection.²⁴ After reviewing Aqua's lyrics and music video, the court determined that the singers were primarily aimed at ridiculing the artificiality of the doll and targeting women, who like Barbie, are "plastic, unreal, and easily manipulable by others."²⁵ Considering "[t]he song's fast tempo and the singers' exaggerated performances of their respective characters," the court found that "the lyrics are not to be taken too seriously," and only present a humorous parody on Barbie's fantasy world and the "shallow plastic values" she represents.²⁶

The court stated that "the fact [that] a parody makes a profit does not strip it of protection under the First Amendment."²⁷ Additionally, the court distinguished this case from *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*,²⁸ where the Ninth Circuit held that appropriation of a work only "to get attention" or to satirize something different than the work does not receive First Amendment protection.²⁹ The *Mattel* court stated that the song does not have to be about only the doll to warrant First Amendment rights.³⁰ Using this broader application of potential First Amendment protections, the court ruled that *Barbie Girl* is a parody warranting consideration of First Amendment rights.³¹

2. *Barbie Girl* does not infringe the Barbie trademark

In deciding that *Barbie Girl*'s reference to the doll fell within the fair use of the term "Barbie," and thus did not infringe on Mattel's trademark,³² the court relied on the *New Kids on the Block*

24. *See id.* at 1136.

25. *Id.* at 1138.

26. *Id.* at 1138–39.

27. *Id.* at 1136 (citing *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748, 761 (1976) (holding that speech is protected by the First Amendment even if it is in a form sold for profit, or involves a solicitation)).

28. 109 F.3d 1394 (9th Cir. 1997) (affirming the district court's granting of a preliminary injunction prohibiting the publication and distribution of the infringing work).

29. *See id.* at 1406.

30. *See Mattel*, 28 F. Supp. 2d at 1140.

31. *See id.*

32. *See id.* at 1141.

standard³³ and the Ninth Circuit *likelihood of confusion* standard.³⁴ Focusing on whether the appropriator “‘capitalize[s] on consumer confusion,’”³⁵ the *New Kids on the Block* standard allows a nominative fair use defense to a commercial user when (1) the use of the trademark is necessary to identify the product in question, (2) only the part of the mark that is “‘reasonably necessary to identify the product’” is used, and (3) the use does not suggest that it was endorsed or sponsored by the mark’s owner.³⁶

The court determined that the defendants met each of these elements. First, the court found that it would be impossible to successfully parody Barbie without declaring her name.³⁷ The court determined that the repeated use of the word “Barbie” was only used for parodying the doll, noting that the singers did not adopt the doll’s likeness on their CD or in their video.³⁸ Finally, the court was also persuaded that the disclaimer on the defendants’ CD which stated that the song “is a social comment and was not created or approved by the makers of the doll,” was a sufficient attempt to illustrate that Mattel did not endorse their song.³⁹ Because the focus of the *New Kids on the Block* fair use test is whether the defendants “‘capitalize[d] on consumer confusion” or appropriated a protected mark for a different one, and it appears that the defendants took steps to avoid confusion of mistaken sponsorship by Mattel, MCA’s use of “Barbie” was not an infringement.⁴⁰

Alternatively, the court dismissed the existence of trademark infringement under the traditional *likelihood of confusion* test.⁴¹ The *likelihood of confusion* test, known as the *Sleekcraft* test, takes into

33. See *New Kids on the Block v. New Am. Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

34. See *Mattel*, 28 F. Supp. at 1143–44 (citing *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d at 341, 348–49 (9th Cir. 1979)).

35. See *id.* at 1143 (quoting *New Kids on the Block*, 971 F.2d at 308).

36. See *id.* at 1142 (citing *New Kids on the Block*, 971 F.2d at 308).

37. See *id.*

38. See *id.* In fact the lead singer, unlike the typical Barbie doll, had dark hair and a tattoo on her arm. Similarly, the male singer, unlike Ken, was bald with blue marks drawn on his head. See *id.* Additionally, MCA did not adopt Mattel’s Barbie logo on any of its products. See *id.*

39. *Id.* at 1142–43.

40. *Id.*

41. See *id.* at 1144 (citing *AMF, Inc.*, 599 F.2d at 348–49).

account the following factors: (1) strength of the mark, (2) proximity or relatedness of the goods, (3) similarity of the marks, (4) evidence of actual confusion, (5) marketing channels used, (6) degree of care of the purchasers, (7) defendant's intent, (8) expansion of product lines, and (9) defendant's First Amendment interests.⁴² First, by noting the strength of the "Barbie" mark, the court found that since the lyrics refer to Barbie as a "blond bimbo," as opposed to the "wholesome image" Mattel has created for its doll, consumers "would be more likely to recognize *Barbie Girl* as a parody."⁴³ Second, looking at the lack of proximity or relatedness between the plaintiff's Barbie product and defendants' pre-recorded music, the court determined that "Mattel's products (including its purported music products) . . . [were] unrelated to defendants' *Barbie Girl* CDs as a matter of law."⁴⁴

Third, in measuring the similarity of the marks, the court stated that marks are not similar simply because they contain the same word.⁴⁵ The court determined that there was no sufficient similarity between the products because the defendants used different lettering, styles, colors, and packaging on their album and music single.⁴⁶ The court also took note that Aqua did not use the image of the doll, and the words "Aqua" in big blue lettering were on all of its CD covers, thereby eliminating the potential for any confusion.⁴⁷

Fourth, notwithstanding the plaintiff's evidence that some people associated the two products with each other, the court noted that because some confusion is unavoidable where a few fail to see that one product is making fun of the other, such instances are not proof of actual confusion.⁴⁸ Fifth, in taking into account the marketing channels used, the court found that even if the parties inevitably marketed their products through the same means (such as radio, print, television and Internet), Mattel's products were

42. *See id.* at 1143–44.

43. *Id.* at 1145 (quoting Pl.'s Opp'n at 7).

44. *Id.* at 1147.

45. *See id.* at 1147 (quoting *Mejia & Assoc. v. IBM Corp.*, 920 F. Supp. 540, 547 (S.D.N.Y. 1996)).

46. *See id.* at 1148.

47. *See id.*

48. *See id.*

primarily toys, whereas defendants' products were music.⁴⁹ Sixth, looking at the degree of care of the purchasers, the court noted that the average purchaser of MCA's product was a teenager, whereas Mattel's "primary purchasers [were] young children and adults—two groups distinct from teenagers."⁵⁰ Seventh, taking into account the defendants' intent, the court stated that the weight of this factor was weakened since all parodists intentionally choose the product to comment on.⁵¹ Mattel's intent or preparation to expand its product line to include musical products bearing the Barbie mark, "unless known by [the] prospective purchasers, [did] not affect the likelihood of confusion."⁵² Finally, noting that censorship of parodies, including those that generate a profit, presents serious impairments to free speech rights, the court found that the First Amendment interests outweighed the risk of some consumer confusion as to the source of the song.⁵³

3. *Barbie Girl* is a noncommercial use under the FTDA

The court stated that "[e]ven if the song did tarnish or dilute the Barbie mark, defendants' speech [fell] within the 'noncommercial use of a mark' exception"⁵⁴ to the FTDA. Noting that the Supreme Court defined commercial speech as "speech which does no more than propose a commercial transaction,"⁵⁵ the court stressed that *Barbie Girl* is not pure commercial speech even though it sells for a profit.⁵⁶

49. *See id.* at 1150. Additionally, the court recognized that the fact that Mattel promoted its dolls through advertisements, whereas MCA's product was promoted through "air play," demonstrated "how the products are unrelated." *Id.*

50. *Id.* at 1151 (citations omitted).

51. *See id.* at 1151 (citing *Cliff Notes Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490, 494 (2d Cir. 1989); *Hormel Foods Corp. v. Jim Henson Prods., Inc.* 1995 U.S. Dist., 36 U.S.P.Q.2D 1812, 1818 (S.D.N.Y. 1995) (stating that although Henson meant to invoke Hormel's trademark as a joke, it did not mean he intended to cause consumer confusion)).

52. *Id.* at 1152 (quoting *Lang v. Ret. Living Pub. Co., Inc.*, 949 F.2d 576, 582 (2d Cir. 1991) (emphasis in original)).

53. *See id.*

54. *Id.* at 1155.

55. *Id.* at 1154.

56. *Id.* at 1154–55 (quoting *Va. State Bd. of Pharmacy*, 425 U.S. at 762).

Mattel claimed that *Barbie Girl* tarnished Barbie's wholesome image through "sexual and denigrating lyrics,"⁵⁷ as well as inferences to "promiscuity, lewdness, and the stereotyping and denigration of young women."⁵⁸ However, the court found that Mattel had not demonstrated that Barbie was associated only with wholesomeness.⁵⁹ As in *L.L. Bean, Inc. v. Drake Publishers, Inc.*,⁶⁰ where the First Circuit held that a mere association with an "unwholesome or negative context [was not] enough to make a trademark dilution claim,"⁶¹ the *Mattel* court held that *Barbie Girl*'s "sexual but nonobscene speech"⁶² is entitled to the same protection afforded to other forms of expression "no matter how coarse, vulgar, or distasteful it may be to some."⁶³ The court explained both that as a result of fame, many marks become the "natural target of parodists,"⁶⁴ and that forbidding parodists the occasion to make fun of marks that are part of everyday life seriously impairs free speech.⁶⁵

Because the song constituted a parody, the court ruled that MCA's noncommercial use was not actionable as trademark dilution under the FTDA.⁶⁶ Thus, the district court granted MCA's motion for summary judgment on Mattel's trademark infringement and dilution claims.⁶⁷ In response, Mattel appealed to the Ninth Circuit.⁶⁸

III. THE NINTH CIRCUIT'S ANALYSIS AND DECISION

The Ninth Circuit's analysis in this case can be summed up in one sentence: "With fame often comes unwanted attention."⁶⁹ In affirming the district court's holding, the court emphasized that as a

57. *Id.* at 1155 (quoting Pl.'s Opp'n. at 7).

58. *Id.* (quoting Pl.'s Prelim. Inj. Mot. at 25).

59. *See id.*

60. 811 F.2d 26 (1st Cir. 1987).

61. *Mattel*, 28 F. Supp. 2d at 1156 (quoting *L.L. Bean*, 811 F.2d at 31).

62. *Id.*

63. *Id.* (citing *L.L. Bean*, 811 F.2d at 34).

64. *Id.*

65. *See id.*

66. *See id.*

67. *See id.*

68. *See Mattel*, 296 F.3d at 899.

69. *Id.*

result of Barbie's huge impact on American society, the doll is not only a toy but also an American cultural icon.⁷⁰

Addressing Mattel's trademark infringement claims, the court noted that when a mark acquires an "expressive meaning apart from its source-identifying function," the traditional *likelihood of confusion* test applied by the district court does not take into consideration the public's interest in free speech and expression.⁷¹ In order to more accurately take into account the First Amendment implications, the Ninth Circuit favored the standard articulated in *Rogers v. Grimaldi*⁷², instead of applying the *New Kids on the Block* standard or the *likelihood of confusion* test. In *Rogers*, the Second Circuit held that "in general the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression."⁷³

Applying *Rogers*, the court concluded that 1) *Barbie Girl* was not an infringement because use of the mark in the song title was relevant to the song itself since it was about Barbie and the values MCA claimed she represented, and 2) the title did not "explicitly mislead as to the source of the work."⁷⁴

The Ninth Circuit affirmed the district court's holding that Aqua's use of the Barbie mark was protected under the FTDA's noncommercial use exception.⁷⁵ Although *Barbie Girl* was dilutive, the song was entitled to First Amendment protection because it was a noncommercial use.⁷⁶ Following the Supreme Court, the Ninth Circuit stated that commercial speech is limited to speech that only

70. *See id.* at 898. The court stated that Barbie has been held as both the "ideal American woman and a bimbo, . . . [has] survived attacks both psychic . . . and physical. . . [and yet] remains a symbol of American girlhood, a public figure." *Id.*

71. *Id.* at 900.

72. 875 F.2d 994 (2d Cir. 1989). *Rogers* concluded that literary titles violate the Lanham Act only if "the title has no artistic relevance to the underlying work whatsoever, or . . . the title explicitly misleads as to the source or the content of the work." *Id.* at 999.

73. *Id.*

74. *Mattel*, 296 F.3d at 902.

75. *See id.* at 907.

76. *See id.* at 903-04.

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proposes a commercial transaction.⁷⁷ “If speech is not ‘purely commercial’—that is if it does more than propose a commercial transaction—then it is entitled to full First Amendment protection.⁷⁸ Because MCA not only used the Barbie name in its song to sell its music, but also to mock Barbie’s image and the values that she represented, it was “not purely commercial speech,” and thus fully protected by the First Amendment.⁷⁹

IV. ANALYSIS OF THE COURT’S DECISION

The Ninth Circuit’s decision in *Mattel, Inc. v. MCA Records, Inc.*, was a major step in clarifying the applicability of trademark law and First Amendment protection to musical parodies of cultural icons. Because cultural icons represent what society values at a particular time, the court correctly held that parodies of such symbols deserve First Amendment protection from trademark infringement and dilution claims brought by trademark owners who seek to restrain criticism and adaptation of these icons.

Cultural icons “are elements of American popular culture” that “are part of our everyday language.”⁸⁰ They exist in many forms such as images, pictures, and representations, and they remain “an external expression of a society’s internal convictions.”⁸¹ Most importantly, “icons are created through a partnership of purveyor and populace, whereby the purveyor of a commodity supplies the product, and the consumer—through an active creative practice—appropriates it by investing the product with new meaning.”⁸² These new meanings “better serve [consumers’] particular needs and

77. *See id.* at 906 (citing *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001) (quoting *Bolger v. Youngs Drug Prod’s Corp.*, 463 U.S. 60, 66 (1983))).

78. *Id.* (citations omitted).

79. *Id.* at 906–07.

80. Cordero, *supra* note 9, at 601 (citing Nicholas J. Jollymore, *Expiration of the Right of Publicity—When Symbolic Names and Images Pass Into the Public Domain*, 84 TRADEMARK REP. 125, 130 (1994) (arguing that celebrities lose control over their image upon achieving symbolic significance)).

81. *Id.* at 602 (citing MARSHALL W. FISHWICK, SEVEN PILLARS OF POPULAR CULTURE 131 (1985)).

82. *Id.* (citing Michael Madow, *Private Ownership of the Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 139–40 (1993) (analyzing the publicity rights and the popular culture debate)).

interests,”⁸³ and establish the presence and identity of cultural icons such as Barbie.⁸⁴ Though trademarks are created by their owners, “society elevates them to symbols, celebrities, and ultimately icons.”⁸⁵ Because the public plays an active role in giving meaning to and creating cultural icons, the public should be free to comment and criticize such icons according to First Amendment protections.

A. The Court Correctly Held Barbie Girl Did Not Infringe the Barbie Mark.

In acknowledging MCA’s right to use and comment on the Barbie mark in its song, the court correctly applied the *Rogers* test instead of the *New Kids on the Block* standard or the traditional *likelihood of confusion* test. The *Rogers* test more accurately takes into account the vital First Amendment interests at stake when dealing with trademarks elevated to cultural icons. First, although the *New Kids on the Block* test leads to the same result, it does not take into consideration the First Amendment rights of parodists. Also, the *likelihood of confusion* test does not entirely account for the public’s interest in free expression when dealing with cultural icons that have “taken on an expressive meaning apart from its source-identifying function,” especially where it would be difficult to describe the mark in any other way.⁸⁶ In adopting the *Rogers* standard, the Ninth Circuit correctly expanded First Amendment rights to parodies of cultural icons by indicating that the Lanham Act should not apply where the interests of free expression outweigh consumer confusion. In adopting the *Rogers* test, the court correctly placed greater emphasis on First Amendment rights of parodists than it placed on consumer confusion. Rather than considering First Amendment rights as one of eight or nine factors under the *likelihood of confusion* test, the *Rogers* balancing test brings First Amendment interests to the forefront, weighing such interests against those of avoiding consumer confusion.

83. *Id.* at 603 (citing ROBERT OWEN, *GEN X TV: THE BRADY BUNCH TO MELROSE PLACE* (1997)).

84. *See id.* at 603–04.

85. *Id.* at 653.

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

The court correctly identified that just as in *Rogers*, where the risk that the defendant's movie title would mislead some as to its subject and source was outweighed by the danger of "suppressing an artistically relevant though ambiguous" work,⁸⁷ MCA's interest in free expression clearly outweighed Mattel's interest in avoiding some consumer confusion. In *Rogers*, the Second Circuit acknowledged that though some consumers anticipate a product to be what its name says it is, most people know "that they cannot judge a book solely by its title any more than by its cover."⁸⁸ The *Rogers* court held that where the film title, "Ginger and Fred," contained no explicit language that the plaintiff endorsed or produced the movie, the risk of some misunderstanding was "outweighed by the interests in artistic expression as to preclude application of the Lanham Act."⁸⁹

Similarly, in *Mattel*, the Ninth Circuit correctly found that the risk that some listeners of Aqua's music might be confused was outweighed by MCA's interest in musical expression via parody. Through the use of Mattel's mark, MCA primarily intended to parody Barbie and the values associated with her.⁹⁰ As in *Rogers*, the court correctly noted that most "expect a title to describe the underlying work, not to identify the producer."⁹¹ The risk of confusion in *Mattel* was even less than in *Rogers*, since *Barbie Girl* obviously "pokes fun"⁹² at Barbie and the values that she supposedly represents. As in *Rogers*, the primary use of the mark was for purposes of artistic expression, thus precluding application of the Lanham Act.

Even if MCA used the Barbie mark to "poke fun at another subject"⁹³ such as "plastic" women like Barbie, under the *Rogers* test that use would still be characterized as "ambiguous" but "artistically relevant" speech. Such artistically relevant speech would outweigh the small risk of consumer confusion and again preclude application of the Lanham Act. This "ambiguous" dual use of Barbie for

87. *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d. Cir. 1989).

88. *Id.* at 1000.

89. *Id.* at 1001.

90. *See Mattel*, 296 F.3d at 901.

91. *Id.*

92. *Id.*

93. *Id.*

purposes of parodying the doll itself and women like her, would still qualify as “artistically relevant” because use of the mark is necessary in transmitting the message of the song. Though “get[ting] attention”⁹⁴ may be one purpose of *Barbie Girl*, the song mostly serves as a musical parody about the cultural icon and women like her. Thus, although the court does not address whether First Amendment considerations apply when a mark is used for purposes other than to parody the actual mark itself, its adoption and application of *Rogers* suggests that it would also apply to protect such alternate uses. Such an implicit reading of the court’s holding correctly expands First Amendment considerations to cases where dual uses are actually intended.

In addition, the court’s holding that MCA’s use of the Barbie mark was not an infringement was correct, especially in the case of Barbie. “[N]o party has the right to bar the use of a common English word.”⁹⁵ Because Barbie, as a cultural icon, has taken on a meaning beyond its initial role as a doll and has become a common household word, the general public, including parodists, should be able to refer to it without violating the trademark owner’s rights.

B. The Court Correctly Held Barbie Girl Did Not Dilute the Barbie Mark

The court accurately determined that MCA’s use of the Barbie mark was not actionable under the FTDA. Emphasizing the importance of the noncommercial use exception in providing First Amendment protection to dilutive speech, the court clarified that although speech may dilute a mark, it may still be protected, “especially where the mark has assumed an expressive function beyond mere identification of a product or service.”⁹⁶ Since Barbie has transcended its status as a toy and has become a symbol for so much more in American culture, negative speech about it expressed

94. *Id.*

95. Patrick J. Mackey, *Playboy Enterprises, Inc. v. Netscape Communications Corp.: The Legal World’s First Step in Determining Trademark Infringement and Dilution in Banner Advertising on the Internet*, 11 DEPAUL-LCA J. ART. & ENT. L. 157, 184 (2001).

96. *Mattel*, 296 F.3d at 904.

through a song, which is also sold for a profit, must still be protected as free expression about people and values of society.

The court correctly determined that its holding in *Hoffman v. Capital Cities/ABC, Inc.*,⁹⁷ controlled. In *Hoffman*, where the defendant's magazine featured an article portraying the plaintiff, Dustin Hoffman, in women's designer spring fashions, the court ruled that the commercial purpose of selling copies was "inextricably entwined with" its noncommercial purpose of making a humorous "visual and verbal editorial comment on classic films and famous actors."⁹⁸ Because the commercial aspects could not be separated from the "fully protected whole," the court held that both the article and the related photographs were fully protected by the First Amendment.⁹⁹ The court emphasized that the article "did not fall outside the protection of the First Amendment [simply] because it may help to sell copies [of its magazine]."¹⁰⁰

Similarly, although MCA may have used the Barbie mark to sell its CD's, it also simultaneously used the mark to comically parody Barbie in its song. In *Dworkin v. Hustler Magazine, Inc.*,¹⁰¹ the court found that although a magazine uses articles to draw attention and thus profits, those articles are not entirely commercial or for advertisement.¹⁰² Thus, consistent with *Dworkin* and *Hoffman*, the court correctly determined that MCA's use was protected by the First Amendment, even though its use of Mattel's mark may have helped it sell copies of the *Barbie Girl* CD.

The First Amendment right to free speech guarantees the right to freedom of expression. Different people use different mediums of expression, such as direct speech; music; writing; dancing or other forms of art, to convey their thoughts and ideas. Simply because these forms may also be sold for a profit does not mean they should go unprotected. Thus, in *Mattel*, where MCA's musical parody of Mattel's cultural icon was also sold for a profit, the court correctly

97. 255 F.3d 1180 (9th Cir. 2001).

98. *Id.* at 1185–86.

99. *Id.*

100. *Id.* at 1186.

101. 867 F.2d 1188 (9th Cir. 1989).

102. *See id.* at 1197–98.

provided the necessary First Amendment protections to the entire work.

V. IMPACT

The Ninth Circuit's decision in *Mattel*, strikes the appropriate balance between the rights of owners of cultural trademarks, and the First Amendment rights of those who parody those marks via music. By ruling that *Barbie Girl* did not infringe upon or dilute Mattel's trademark, the court established precedent for future courts to follow when assessing the First Amendment rights of musical parodists and the trademark rights of the cultural icons that such parodists target. But because Barbie is the ultimate cultural icon, the Ninth Circuit's expansive protection to the musical parody may open the door for many trademark owners to be denied protection for their trademarks. This may in turn provide creators with a disincentive to create new marks for fear that parodists may freely profit through various adaptations of the mark.

However, while providing First Amendment protection to musical parodies of cultural icons, the decision also stands consistent with the Lanham Act's main purposes of preventing consumer confusion and unfair competition. Because the court protects parodying of cultural marks, rather than the mere commercial use of those protected marks, it ensures that most of the audience of these parodies will understand by the mere nature of the parody that it is not associated or endorsed by the owner. By ensuring the general absence of consumer confusion, the Ninth Circuit protects the rights of the trademark owners and does not inhibit the creation of new marks. In fact, by protecting the work of parodists who create new works by commenting on previous material, the court encourages the kind of creative thought and free expression crucial to development of these new works.

VI. CONCLUSION

In holding that MCA's use of Barbie in its song was not an infringement or an actionable dilution of Mattel's mark, the Ninth Circuit in *Mattel, Inc. v. MCA Records, Inc.* correctly provided First Amendment rights to musical parodists of cultural icons. Though trademark owners have a legitimate interest in protecting their

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property, owners of marks that reach the status of cultural icon should not be able to inhibit the expression of those who comment about or parody such icons. Such forms of expression must constitute protected free speech to encourage the creation of new cultural icons and symbols in society. Ironically, a similar German doll¹⁰³ was the model for Barbie which, as a result of public acceptance and criticism over the years, developed into a cultural icon. By upholding MCA's First Amendment right to parody Barbie in its song, the court encourages the beneficial commentary of famous marks in society and the creation of new cultural icons through musical expression.

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103. See Cordero, *supra* note 9, at 636.

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