

◀ Return to Full

LexisNexis™ Academic

Copyright 2001 Gale Group, Inc.
Business and Management Practices
Mondaq Business Briefing - The Duboff Law Group, United States

August 3, 2001

RDS-ACC-NO: 03004954

LENGTH: 1523 words

HEADLINE: United States: Bad **Barbie** Dolls

BYLINE: DuBoff, Leonard

HIGHLIGHT:

Case involving first amendment protections versus copyright and trademark laws

BODY:

By Mr Leonard DuBoff

When Utah- based photographer Tom Forsythe used Barbie dolls to assist him in making controversial political statements regarding his observations on society, he was sued by Mattel. The toymaker, which owns all rights to the extraordinarily popular toy, filed suit against the artist alleging that, among other things, his depiction of Barbie infringed the toymaker's copyright, trademark and trade dress rights. The American Civil Liberties Union, which defended the photographer, disagreed.

The problem began some time ago when Forsythe determined that the Barbie doll image stood for many of the things he felt were wrong with our society. According to the artist, Barbie embodies materialism and gender oppression. By depicting the doll wrapped in a tortilla doing domestic chores and in a variety of sexual poses, the artist felt that he could convey the message he wished in the most vivid and dramatic form possible. The photographs were made into, among other things, postcards for purposes of sale and distribution.

Mattel, which is very protective of its intellectual property, attempted to prevent distribution of the offending postcards and asked the court to order that the photographer's negatives be destroyed. The trial court refused, and the United States Court of Appeals for the Ninth Circuit agreed with this position. The court implied that Mattel would likely not succeed on a trial of the merits of the case

since the photographer's defense of fair use and free speech rights were compelling.

This case presented the court with an interesting dilemma: When copyright and trademark rights collide head on with the protections afforded by the First Amendment of the United States Constitution and the fair-use exceptions to the copyright and trademark laws, which will prevail? In order to understand the problem, it is important to briefly examine the issues involved.

The trademark laws of the United States protect any name, symbol, logo or combination of these when used in connection with a product or service. Trademarks are used to identify the source (or origin) of goods or services.

Barbie is a protectable trademark owned by Mattel. Because this mark has been around so long and because the toy is so popular, the mark is strong. When one hears Barbie or Barbie doll, a mental image is sparked, and the vast majority of Americans know exactly what was being described.

In addition, the shape of the popular toy has become so popular and so commonplace today that one need only see that shape in order to realize that it is a Barbie doll. Thus, the look and feel of the popular toy has taken on a secondary meaning, and a survey would likely confirm that the vast majority of Americans identify the toy, as well as its name, with Mattel.

Trademark law is a form of consumer protection. That is to say, when a consumer purchases a product bearing a trademark, the consumer expects the product to have the quality and attributes customarily associated with the manufacturer's product bearing the identifying trademark. As a result, if there is an unauthorized use of that trademark by one who is not the actual owner of the mark and the quality of the unauthorized product differs from that of the item identified by the legitimate trademark, then the consumer is misled. The trademark owner is likely to be identified as the producer of the unauthorized item, and this passing off is likely to be the source of the wrong. Therefore, only uses of a trademark which are likely to cause market confusion are actionable.

Applying this rule to the *Mattel v. Forsythe* case leads to the inevitable conclusion that observers would not likely believe that the toymaker is responsible for the social comments conveyed by the use of the Barbie doll. In other words, satirical use of the toy or its name would likely be deemed a fair use of the Mattel trademark, as well as a fair use of the doll's distinctive look and feel or trade dress. Using the Barbie doll for purposes of social comment, satire or the like might also be deemed parody. The parody defense has been permitted in situations where no reasonable person would believe that the use was authorized. Indeed, the popular comic book *Mad Magazine* is replete with examples of parody. Those who are familiar with the television show *Saturday Night Live* experience parody on a regular basis. Is it likely that any observer of the photographs of

Barbie in a tortilla wrapper doing domestic chores or in sexual poses would believe that Mattel permitted the use? The photographer would likely have an excellent argument that his use of the popular toy was a permissible parody.

The Barbie doll is also protected by copyright. Under the statute, the exclusive right to reproduce the protected work and sell copies of the copyrighted item belongs to the copyright owner. Despite this fact, the copyright statute does attempt to balance the rights of copyright proprietors with the rights of others who might wish to use the copyrighted work for purposes deemed socially beneficial. The statute that deals with this balancing is the section of the copyright law covering fair use. The law states that a use which might otherwise be deemed an infringement might be deemed a fair use in some situations.

The statute requires the courts to evaluate at least four factors in order to determine whether the unauthorized reproduction will be defensible as a fair use. The judge must consider first the nature of the work. Some works are created for the express purpose of being copied- for example, a book of patterns or a book of quotable quotes. Other items may never legitimately be copied since, for example, any copying of a workbook would likely deprive the owner of a sale and the workbook is not intended to be copied.

Secondly, the nature of the use should also be considered. If the unauthorized use produces a new work, such as a book review or critical commentary which includes quotes from a copyrighted work, then the use is likely fair use. On the other hand, if the use is intended to replace the copyrighted work or provide a substitute for it, then it is unlikely to be considered a fair use.

Thirdly, evaluating the extent of copying is important in determining fair use. Thus, it is more likely to be considered a fair use if the copying is of only a minimum portion of a protected work rather than the entire work itself. Finally, the last factor to be considered in determining whether the use is a fair use is the effect that the use will have on the copyright owner's market. Some courts have considered this to be the most important factor since depriving the copyright owner of the sale is likely to be most damaging. In evaluating the Forsythe photograph using the fair use criteria, it appears that the Barbie dolls are being depicted only in two- dimensions as part of a larger layout. The entire toy is not being recast but rather photographed. It is unlikely that the sale of a Forsythe photograph or postcard will be deemed a substitute for the toy played with by children. Indeed, it might be argued that the expanded distribution resulting from Forsythe's social commentary might expand the popularity of the toy. The counterpoint of this argument is that the critical comment might chill sales in the future. On balance, therefore, it is likely that the court felt that the artist-photographer's satirical use was a fair use as that term is used in the copyright statute.

The First Amendment of the United States Constitution is intended to provide

Americans with the ability to make statements that might be unpopular and controversial. It would, therefore, likely be a significant blow to the First Amendment if the copyright and trademark laws could be used as a means of undermining a citizen's right to free speech. It is likely for this reason that the court felt compelled to deny Mattel the right to enjoin distribution of the questionable Barbie doll photographs.

The Mattel v. Forsythe case has not exhaustively explored all of the issues surrounding the collision which is inevitable when a popular image is used for purposes of making political or social comments and which use is such that copyright, trademark and trade dress rights of the exploited image are involved. It seems that the Forsythe case teaches us that free speech, the First Amendment, satire and parody appear to require intellectual property rights to yield when the only obvious sustainable injury shown is likely to be embarrassment. If sales were lost and if the public was confused, there might be a different result- and Barbie dolls would then only be depicted as wholesome icons of a noncontroversial society.

The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.

Mr Leonard DuBoff
The Duboff Law Group
6665 SW Hampton St.
Suite 200
Portland
97213
UNITED STATES
Tel: 503968 Extn: 8111
E-mail: cking@business-law.com

Copyright 2001 The Duboff Law Group

TYPE: Report; Fulltext

JOURNAL-CODE: MONDBUSB

LOAD-DATE: August 17, 2001