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M P Ram Mohan* & Aditya Gupta

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
Introduction

In 2022, the Barbie doll turned 63. Since her launch, she has dawned over 200 professions,1 ranked as the world’s #1 Toy Property2 and featured as one of 2022’s most trusted brands.3 Since 2018, the Barbie mark has consistently accrued over a billion USD worth of gross billings.4 With an annual sale of 58 million dolls, Barbie accounts for more than half of Mattel’s overall sales turnovers.5 Her success has made Barbie an indelible part of global popular discourse,6 particularly within American feminine culture.7 With her collectible magazines and a very loyal fanbase,8 Barbie has been reported to receive more fan mail than Audrey Hepburn and Elizabeth Taylor combined.8 She exemplifies some set of values, beliefs and norms in the modern day society10 and has shaped the world of play for over three generations.11

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

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3 Nancy Cooper, Most Trusted Brands in America, 178 NEWSWEEK GLOBAL 44–48 (2022).
7 Roberts, supra note at 84.
9 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.
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. 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. 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. The reimagination of the Barbie image by artists, critics and parodists has been repeatedly condemned before intellectual property courts. The present paper, studies the extent to which Mattel can control the secondary use of the Barbie mark.

Initially adopted to designate that the doll is associated with Mattel Inc., Barbie has now transcended the ethos of marketing and commercial practice, assuming the status of a quintessential cultural icon. However, this transcendence creates a unique problem for 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. Barbie has not only come to symbolise the idea of femininity and descended into the popular discourse, she has also served as ammunition for artistic, 

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18 See: Hunter and Lastowka, supra note 17; WEISSMAN, supra note 12.
19 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).
21 See: Frankel, supra note 12; Jacqueline and Swedlund, supra note 14.
political and social discourse. A shade of this cultural reappropriation can also be gleaned from the political debate surrounding abortion rights in the US. In 2013, Senator Wendy Davis, an American senator from Fort Worth, Texas, gave a thirteen-hour filibuster against a pro-life bill introduced in the American Congress. Soon enough, in her criticism, the blonde-haired US lawmaker was given the title of Abortion Barbie. 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. Prof. Benkler captures this paradox:

“A nine-year-old girl searching Google for Barbie will quite quickly find links to AdiosBarbie.com, to the Barbie Liberation Organization (BLO), and to other, similarly critical sites interspersed among those dedicated to selling and playing with the doll. The contested nature of the doll becomes publicly and everywhere apparent, liberated from the confines of feminist-criticism symposia and undergraduate courses.”

Mattel’s use of the intellectual property system to patrol and control access to Barbie has influenced the development of that system over the last part of the twentieth century and the early part of this century. Dubbed an intellectual property shark, Mattel’s assaults have

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24 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.


26 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).


29 Gore, supra note 22 at 211.


31 Hunter and Lastowka, supra note 17 at 135.

32 LOBEL, supra note 9.
often relied on their trade mark rights. 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, 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, Ruth Handler gave life to Barbie in 1959. 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.” 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. Making minor changes to Lilli, Mattel birthed Barbie. Some historians note, “Lilli and her new sister were barely distinguishable except to the new doll’s creator.”

The criticism and scrutiny accrued by Barbie can be expressed in terms of a feminist double bind. A double bind emerges in situations where one’s options are narrowly defined, and

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35 RUTH HANDLER & JACQUELINE SHANNON, DREAM DOLL: THE RUTH HANDLER STORY 1–3 (1995); LORD, supra note 10 at 29.
36 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.
39 LORD, supra note 10 at 32.
40 GERBER, supra note 38 at 13.
41 See for example: Hains, supra note 4 at 268, 269.
42 Bartow, supra note 28 at 446–448.
detrimental consequences accompany all choices. 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. Concurrently, women actively engaging in parenting are parallely deemed occupied and distracted to take on demanding positions in politics or the workplace. 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.

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; “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.” 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. These changes rendered her sexy in clothes, but sexless outside them. 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.

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. In their attempt to reinvent the Barbie image, Mattel, in 1967, produced their first black doll named Colored Francie. The doll received lukewarm market reception and was

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44 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.
45 Bartow, supra note 28 at 448.
46 Radin, supra note 44 at 1704.
48 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).
49 LOBEL, supra note 11.
50 Bartow, supra note 28 at 447.
51 Id. at 448–449.
52 Jacqueline and Swedlund, supra note 14 at 282–284.
53 duCille, supra note 13 at 268.
criticised for being mere dye-dripped versions of the white Barbie. In 2014, Barbie was given a new profession, she was now a computer engineer. However, she was portrayed only as a design enthusiast who could not write code and installed viruses on her colleagues computers. Mattel could not help but feed the sexist stereotypical image of Barbie. The depiction received severe criticism was eventually withdrawn.

Mattel made many attempts to protect and improve the Barbie image. In 2016, Mattel addressed one of their biggest criticisms. Barbie was no longer a slim blonde with unrealistic body proportions, she was now body positive. 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?” Mattel attempted to establish that their new dolls differed meaningfully from old offerings. 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.” Unfortunately for Mattel, the ‘curvy’ Barbie received similar political, social, satirical and comical scrutiny. Writing for the National Review, Heather Wilhelm answered

54 Id. at 269; Hains, supra note 4 at 267.
58 See: Jacqueline and Swedlund, supra note 14 at 282–284.
62 Hains, supra note 4 at 272.
64 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
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. With a determined litigative appetite, Mattel has attempted to contain this discourse by citing their entitlements within intellectual property law. However, Mattel’s litigative appetite has reduced since the first decade of the 21st 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. Mattel has not welcomed a reinterpretation of the ‘brand image’ associated with Barbie and has chased multiple artists and parodists to trademark courts. Mattel realised that to continue selling the doll, they had to ensure that Barbie-ness was retained and controlled by them. From this point on, the doll was no longer central, the important feature was the image and concept of Barbie.

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

headnote


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.


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.


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.”

MARY F. ROGERS, BARBIE CULTURE 90–95 (1999).

Hunter and Lastowka, supra note 17 at 142.

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. Alleged for being a trademark bully, Mattel not only abuses the legal system but is also responsible for causing harm to competition and speech interests.

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 trademark 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. 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.”

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


74 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.


76 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).


78 Id. at 11, 12.
shallow, plastic values she (Barbie) has come to represent in some circles.\textsuperscript{79} 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.\textsuperscript{80} The Court argued that the secondary use was attributive rather than commercial,\textsuperscript{81} and the minimal possibility of consumer confusion was outweighed by free speech interests.\textsuperscript{82} Dealing with dilution, the court ruled that the Aqua Girl song qualifies as a non-commercial use\textsuperscript{83} and therefore cannot accrue any liability within the dilution framework.\textsuperscript{84}

Subsequently, the parties approached the Court of Appeals against the decision of the District Court.\textsuperscript{85} 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.\textsuperscript{86} Given the expressive and referential nature of the defendants’ use, the Court applied a nuanced likelihood of confusion analysis.\textsuperscript{87} 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.\textsuperscript{88}

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

\textsuperscript{80} Id. at 1138.
\textsuperscript{81} Id. at 1142, 1143; Buchakjian, supra note 47 at 1322–1328.
\textsuperscript{82} MATTEL, INC. v. MCA RECORDS, INC. 20943, supra note 79 at 1151–1154; Buchakjian, supra note 47 at 1327, 1328.
\textsuperscript{83} Buchakjian, supra note 47 at 1328.
\textsuperscript{84} 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).
\textsuperscript{85} 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).
\textsuperscript{86} MATTEL, INC. v. MCA RECORDS INC., supra note 19 at 900.
\textsuperscript{87} Id. at 901 relying on; Rogers v. Grimaldi, 875 F.2d. 994, 1000 (2d Cir. 1989); Tushnet, supra note 48 at 414, 415.
\textsuperscript{88} MATTEL, INC. v. MCA RECORDS INC., supra note 19 at 992 referring to: ROGERS V. GRIMALDI, supra note 87.
\textsuperscript{89} 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).
\textsuperscript{91} MATTEL, INC. v. MCA RECORDS INC., supra note 19 at 907.
the exception. In July 2002, the Court of Appeals denied all the appeals and affirmed the findings of the District Court.

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

2.1.2. Mattel v. Walking Mountain Productions

Another classic example of recoding intellectual property symbols was in Mattel v. Walking Mountain Productions. 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. Forsythe, through his works, had attempted to “deglamorize Barbie,” “skewer the Barbie myth,” and expose an “undercurrent of dissatisfaction with consumer culture.” The series attempted to critique the objectification of women associated with Barbie and to lambast the conventional beauty myth and the societal acceptance.

Forsythe used the mark Barbie in some of the titles of his photographs, which gave way to Mattel’s infringement and dilution claims. 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.” While Forsythe’s work was commercially unsuccessful and earned less than USD 4000, Mattel tied Forsythe in a three-year long, $2 million legal marathon... Forsythe was able to afford the litigation only because of donated legal

92 Id. at 906.
93 MATTEL, INC. v. MCA RECORDS INC., supra note 19.
94 Id. at 899.
95 Id. at 900; Gore, supra note 22 at 209–213.
96 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).
99 For eg see: Hunter and Lastowka, supra note 17 at 270.
100 MATTEL INC. v. WALKING MT. PRODS., supra note 98 at 45–48; BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK 122 (8 ed. 2021).
101 MATTEL INC. v. WALKING MT. PRODS., supra note 98.
102 Id. at 796.
103 Tushnet, supra note 48 at 418.
assistance. Interestingly, Forsythe’s work benefited from the blatant disregard of the intellectual property doctrine by Mattel. If not for the lawsuit, his work would not have received as much publicity and attention as it did. This attraction of unintentional virality is called as the Streisand effect.

Mattel contested the suit for copyright and trademark infringement. The district court ruled, and the Court of Appeals confirmed that Forsythe’s use of the copyrighted Barbie was fair-use and was therefore not actionable. The Court of Appeals heavily relied on Mattel v. MCA when dealing with trademark infringement claims. The Court reiterated that for trade mark law to regulate artistic and commercial speech, the public interest in avoiding confusion should outweigh the public interest in free expression. Citing the cultural role assumed by the word Barbie, the Court held that the secondary use of the mark was relevant to Forsythe’s work and did not explicitly mislead the source of the artistic work.

Referring to the claims of trade dress infringement, the Court of Appeals referred that Barbie’s trade dress also embodies a cultural dimension: symbolisation of an unattainable ideal of femininity for some women. Dealing with the nature of the secondary use, the Court opined that Forsythe’s use of the trade dress amounted to nominative fair use. While dealing with the dilution claims, the Court concluded that the photographs constituted Forsythe’s social view and qualified for the non-commercial speech exception.

The Courts in the Mattel judgements effectively 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. Further, the Court of Appeals for the Ninth Circuit

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107 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).
108 MATTEL, INC. v. WALKING MT. PRODS. DC, supra note 98.
109 MATTEL, INC. v. WALKING MT. PRODS., supra note 98.
110 Drexler, supra note 108 at 436–441.
111 MATTEL, INC. v. WALKING MT. PRODS., supra note 98 at 807.
112 Id.
113 Id. at 809.
114 Id. at 47, 48; Tushnet, supra note 48 at 421–423.
115 MATTEL, INC. v. WALKING MT. PRODS., supra note 98 at 49.
116 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.\textsuperscript{117} The grant of such an award serves as a necessary deterrent against frivolous litigation attempting to contain expressive speech.\textsuperscript{118}

### 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.\textsuperscript{119} 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.*”\textsuperscript{120} 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\textsuperscript{121} has cleared a film, it shall be presumed that it is not defamatory to anyone.\textsuperscript{122}

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.*”\textsuperscript{123} 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,\textsuperscript{124} and the Court issued notices and called upon the

\textsuperscript{117} Mattel, Inc. v. Walking Mt. Prods., 2004 U.S. Dist. LEXIS 12469.

\textsuperscript{118} Tushnet, *supra* note 48 at 424, 426.

\textsuperscript{119} Mattel, Inc. & Anr. v. Aman Bijal Mehta, 2017 SCC OnLine Del 11857 13 Justice Endlaw also highlighted the similarities between the two disputes.

\textsuperscript{120} 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).

\textsuperscript{121} 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.

\textsuperscript{122} MATTEL, INC. & ANR. V. AMAN BIJAL MEHTA, *supra* note 119 at 23.

\textsuperscript{123} Id. at 24.

\textsuperscript{124} 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. Typical of the Indian IP litigation, the dispute did not survive the interlocutory stage. The Defendants withdrew all references to Barbie and submitted an undertaking to this effect before the Court. 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. 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. 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 rejected Mattel’s objection. On appeal, the Federal Court also denied the existence of any likelihood of confusion. On further appeal, the Canadian Federal Court of Appeals endorsed the lower courts’ findings and argued that if fame could preclude all other uses of a mark, the fundamental concept of granting a trademark in association with certain goods would be meaningless. Eventually, the issue was appealed to the Supreme Court of Canada.

125 MATTEL, INC. & ANR. V. AMAN BIJAL MEHTA, supra note 119.
126 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).
129 Application Nos. 736898, 736896. Canadian Trademark Office
130 In Canada, the Trademark Opposition Board acts on behalf of the Registrar of Trademarks in adjudicating trademark opposition proceedings.
132 Mattel, Inc. v. 3894207 Canada Inc. et al., 30 C.P.R. (4th) 456.
133 Mattel, Inc. v. 3894207 Canada Inc. et al., (2005), 38 C.P.R. (4th) 214.
134 Mattel, Inc. v. 3894207 Canada Inc, [2006] 1 SCR 772.
In the Canadian dispute, the secondary use was primarily commercial. Therefore the Court relied on the traditional test for confusion and did not adopt a novel test as was the case in the two American decisions. Further, the Canadian Supreme Court held that fame associated with the Barbie mark is only a ‘surrounding circumstance’ and cannot deliver the proverbial knock-out blow in a confusion analysis. According to Justice Binnie, trade marks are protected because they assure consistency of origin and quality. The secondary use cannot be constrained without damage to either of these functions.

The Canadian case is unique in the list of judicial opinions examined in this study. Unlike Forsythe and Aqua, whose secondary use was artistic and expressive, the secondary use before the Canadian Court was commercial. Further, the case before the Canadian Supreme Court arose in a trade mark opposition context. Since the Canadian Trademark law does not allow dilution and misappropriation as grounds for opposing trademark applications, the Court was unarmored by concerns of misappropriation or denigration of goodwill. 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.

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135 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. 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).

136 Tushnet, supra note 48.


138 Robert G., supra note 136 at 26, 27.

140 Id. at 83–87; Blanchard, Vatch, and Flewelling, supra note 130.

142 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

143 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.

144 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 trademark law, 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. 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.” A parody relies on a humorous and critical comment to produce the desired effect and distinguish itself from the original trademark. One important element of a successful parody is it should be able to conjure up the original. The public should be able to recognise the underlying mark through the ciphers provided by the parodist. A parodist usually has no interest in creating consumer confusion and therefore parodies are subjected to scrutiny within the 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

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146 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. CliffsNotes, Inc. v. Bantam Doubleday Dell Pub’g Grp., Inc., 886 F.2d 490, 493 (2d Cir. 1989) Parody and satire are deserving of substantial freedom both as entertainment and as a form of social and literary criticism.
147 Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC., supra note 145 at 496.
149 Sabine Jacques, Parody Exception: Why trademark owners should get the joke, 38 EUROPEAN INTELLECTUAL PROPERTY REVIEW 471 (2016).
150 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. 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.” Highlighting the intrinsic dilemma associated with Barbie, the Court noted that many individuals disagree about the meanings and values associated with the doll. In the Court’s opinion, “From the lyrics of the song and the various comments by the Aqua band members, it appears that song was intended to parody both the doll itself and the shallow, plastic values she has come to represent in some circles.” In 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.

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 Endllaw alluded to the importance of protecting free speech and confirmed that any proposed restraint on expressive and artistic speech would have to survive the scrutiny laid down by constitutional protections and safeguards. The 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. 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, 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. Further, the Court noted that the more popular a mark, the more vulnerable it would be to a parodic reinterpretation. In effect, the judiciary

152 Lemley, Mark A., supra note 20 at 13.
154 MATTEL, INC. V. MCA RECORDS, INC. 20943, supra note 79 at 1149.
155 Mattel Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003).
156 MATTEL, INC. & ANR. V. AMAN BIJAL MEHTA, supra note 119 at 22.
157 Tata Sons Ltd. v. Greenpeace International & Anr., 45 PTC 275 (2011).
159 See: Tushnet, supra note 48.
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.\textsuperscript{161}

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.”\textsuperscript{162} The commercial nature of secondary use looms large in Canada’s protection of trade mark rights.\textsuperscript{163} In \textit{British Columbia Automobile Association v. OPEIU}, the court noted that, in order to be actionable, the statute requires the offending use be a use “\textit{in association with wares and services and that contemplates an element of commercial use}.”\textsuperscript{164} 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 \textit{United Airlines v. Cooperstock},\textsuperscript{165} 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.\textsuperscript{166}

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 \textit{Mattel v. MCA}, “\textit{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}.”\textsuperscript{167}

\begin{itemize}
\item \textsuperscript{161} \textit{Id.}
\item \textsuperscript{162} Michelin & Cie v. CAW, 2 FC 306, 112 (1997).
\item \textsuperscript{163} Sebastian D Beck-Watt, \textit{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.
\item \textsuperscript{164} British Columbia Automobile Assn v OPEIU, [2001] 4 WWR 95.
\item \textsuperscript{165} United Airlines, Inc. v. Cooperstock, 2017 FC 616.
\item \textsuperscript{166} Sabine Jacques, \textit{First application of the Canadian parody exception}, 12 JOURNAL OF INTELLECTUAL PROPERTY LAW & PRACTICE 895–896 (2017).
\item \textsuperscript{167} MATTEL, INC. V. MCA RECORDS, INC. 20943, supra note 79 at 1145.
\end{itemize}
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.”\(^{168}\) Many forms of actionable confusion, such as sponsorship and post-sale, have assumed importance in judicial and academic discourse.\(^{169}\) 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\(^{170}\) “fails to account for the full weight of the public’s interest in free expression.”\(^{171}\) 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 in warranted only *where the public interest in avoiding consumer confusion outweighs the public interest in free speech.*\(^{172}\) 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.\(^{173}\)

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*

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169 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).
170 The Court in AMP 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).
171 Mattel, Inc. v. MCA Records Inc., *supra* note 19 at 900; Mattel, Inc. v. Walking Mt. Prods., *supra* note 98 at 1267.
173 Id. at 999.
publisher or producer.”174 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.175 The Court of Appeals went as far as to suggest that if such use is held to be misleading, it will render Rogers nullity.176 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.177 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.178

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

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

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174 Mattel, Inc. v. MCA Records Inc., supra note 19; Mattel Inc. v. Walking Mt. Prods., supra note 100 at 1267.
175 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.”
176 Mattel, Inc. v. MCA Records Inc., supra note 19 at 1720; Mattel Inc. v. Walking Mt. Prods., supra note 98 at 1267.
177 Mattel Inc. v. Walking Mountain Prods., supra note 155 at 807.
178 For details see: Drexler, supra note 107; Wallack, supra note 85.
179 Mattel Inc. v. Walking Mt. Prods., supra note 98 at 1267, 1268.
180 Id. at 808; Tushnet, supra note 48 at 421.
181 Mattel Inc. v. Walking Mt. Prods., supra note 98 at 810.
182 The Court believed that its analysis through Rogers v. Grimaldi was dispositive of Mattel’s claims.
183 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.\textsuperscript{184} 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 \textit{Dr. Reddy’s v. Eros}, held that \textit{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.}\textsuperscript{185}

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 \textit{Aman Bijal Mehta, MCA} and \textit{Walking Mountain}, the dispute in the case of \textit{Mattel v. 3894207 Canada Inc.} did not involve an expressive secondary use.\textsuperscript{186} 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.\textsuperscript{187} 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.\textsuperscript{188} While important, the fame of the Barbie mark could not act as a \textit{trump card}, and was only given the pedestal of a ‘\textit{surrounding circumstance}.’\textsuperscript{189} Siding with the decisions from the lower courts, the Supreme Court of Canada allowed the registration of the Defendant’s mark.

\textsuperscript{184} \textit{MATTEL, INC. & ANR. V. AMAN BIJAL MEHTA, supra} note 119 at 28.
\textsuperscript{185} \textit{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, \textit{Mutation of the trademark doctrine: Analysing actionable use to reconcile brand identities with constitutional safeguards}, IIM-AHMEDABAD WORKING PAPER SERIES (2022).
\textsuperscript{186} 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, \textit{supra} note 136 at 1037.
\textsuperscript{187} Robert G., \textit{supra} note 136.
\textsuperscript{188} \textit{Id.}
\textsuperscript{189} \textit{MATTEL, INC. V. 3894207 CANADA INC, supra} note 134; Robert G., \textit{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. On the other hand, the dilution doctrine protects a trade mark’s selling power, rendering otiose any analysis of consumer confusion within the dilution framework. 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. The exception has been interpreted to be a general exemption for constitutionally protected forms of expression and criticism. In both Mattel v. MCA and Mattel v. Walking Mt. Prods., Mattel had claimed that the use of the mark by the defendant amounted to dilution by tarnishment and blurring. Both decisions admitted that the secondary use was dilutive. However, in both cases, the Defendants’ use did more than propose a commercial transaction and qualified as non-commercial use. In determining the meaning of commercial use, Judge Kozinski stated in Mattel v. MCA, “if the speech is not ‘purely commercial,’….then it is entitled to full first amendment protection.” The Barbie Girl song lampooned Barbie’s image, and similarly Forsythe’s work represented his social view and interpretation of Barbie. Both works, therefore, do more than propose a commercial transaction. The Barbie decisions from the 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.

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194 Curran, *supra* note 90 at 1081–1082.
195 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).
196 Reducing the ‘recallability’ of the Barbie Mark, See: *Id*. at 3.2.5.
197 MATTEL, INC. v. WALKING MT. PRODS. DC, *supra* note 98 at 812; MATTEL, INC. v. MCA RECORDS INC., *supra* note 19 at 906.
198 MATTEL, INC. v. MCA RECORDS INC., *supra* note 19 at 906, 907; citing HOFFMAN V. CAPITAL CITIES, *supra* note 89.
199 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 or a tenable explanation would amount to ‘due cause.’ An expressive secondary use for criticism or comedy would easily qualify the due cause requirement and shield any secondary use from liability. While adjudging this limitation, a Court would also consider the concerns of free speech and expression, which will further assist in a finding in favour of due cause. Therefore, if a secondary, albeit commercial, use of the Barbie mark is adjudicated by an Indian court, as long as the secondary use is expressive and constitutes a comment or criticism or amounts to non-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; therefore, the dilution concerns were not discussed in 3894207 Canada Inc. However, the Canadian dilution doctrine swerves on the restrictive side, and a dilution claim is relatively difficult to establish in Canada. Similar to the non-trademark use exception in India, the Canadian dilution doctrine is limited to secondary use in association with wares

200 Blue Hill Logistics Private Ltd. v. Ashok Leyland Limited, 48 PTC (DB) 564 (2011); Gangjee, supra note 126 at 322.
201 Nestle India Ltd. v. Mood Hospitality India Pvt. Ltd., 42 PTC (Del.) 514 (2010); Gangjee, supra note 126 at 322, 323.
202 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).
203 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).
204 See for example: TATA SONS LTD. v. GREENPEACE INTERNATIONAL & ANR., supra note 157.
205 Gangjee, supra note 126.
207 FRIEDMAN, supra note 195 at 105.
208 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. 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. 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.

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, and 2) the lack of a proper distinction between actionable misuse and permitted secondary use. The lack of clear legislative guidance and recurring reliance on multi-factor tests creates hyper-specialised instances where protection is afforded. This results in ambiguity in the legal doctrine.

Apart from ambiguity, a volatile and unclear approach to intellectual property disputes can result in an incorrect interpretation of the law. For example, the Canadian Federal Court in 2017 injunction a gripe site targeted at coalescing negative reviews against an airline company. The Court failed to acknowledge the parodic and expressive nature of the secondary use and did not consider the constitutional safeguards protecting the Defendant’s use. Given the lack of the counterbalance afforded by constitutional safeguards, Defendant’s website was injunction under both the confusion and the dilution framework.

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

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212 Does it matter if the judge laughs?, MANAGING INTELL. PROP., 2010, at 32.
213 Gangjee, supra note 126 at 324.
214 Tushnet, supra note 48.
215 UNITED AIRLINES, INC. V. COOPERSTOCK, supra note 165.
216 QC, supra note 211 at 111–113.
discussion on precedential standards. In 2020, the Delhi High Court injunction the secondary use of the plaintiff’s mark in a YouTube video. Without considering the applicability of any judicial safeguards, the Court held that the irreverent representation amounts to tarnishment and is therefore actionable.\textsuperscript{217} In its decision, the Court did not refer to the discussion from \textit{Tata v. Greenpeace}, \textsuperscript{218} 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.\textsuperscript{219} 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.\textsuperscript{220} 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.\textsuperscript{221} 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.

\textsuperscript{217} Anhueser Busch Llc v. Rishav Sharma, 83 PTC (Del) 217 (2020); Mohan and Gupta, supra note 185.

\textsuperscript{218} TATA SONS LTD. v. GREENPEACE INTERNATIONAL & ANR., supra note 157.

\textsuperscript{219} For a better understanding of the argument in favour of Mattel, see: Liz Somerstein, \textit{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).


\textsuperscript{221} Tushnet, supra note 48.