

I'M A BARBIE GIRL

By: Jim Astrachan

Judge Alex Kozinski's *Mattel v. Universal Music International* opinion ribs Mattel's attempt to prevent parodic use of its Barbie trademark holding, "If this were a sci-fi melodrama, it might be called Speech-zilla meets Trademark Kong." This case is a well reasoned opinion in which Judge Kozinski analyses a trademark owner's right to prevent use of its mark in an infringing manner and a third person's right to use the mark to lampoon the product associated with the mark.

A trademark is a word, phrase or symbol used to identify a manufacturer or sponsor of goods or a provider of service. Barbie is a registered mark used by Mattel to designate a doll that it manufactures and to identify Mattel as the source of the product. If any other doll manufacturer was to apply the Barbie mark to its doll product it is not hard to imagine that an appreciable number of consumers would believe Mattel was the source.

The principal purpose of trademark rights is to avoid this sort of confusion in the marketplace. When another's trademark is used in a way that is likely to cause confusion,

infringement results. Once infringement is shown irreparable harm is presumed and injunctive relief is appropriate.

But as Judge Kozinski points out, trademarks are used for more than product identification purposes. Some become part of our vocabulary and run the risk of becoming generic. He asks, "How else do you say something's the 'Rolls Royce' of its class?" We add trademarks to our vocabulary and we often use those marks to sound contemporary. And therein lies the clash. Can the mark's owner tell me I can't use its mark as part of my vocabulary? Should I be enjoined from saying "Put a Band-Aid on that problem?" Should I not be permitted to employ a trademark to make fun of the product it identifies or the company that produces the product? Can I not use a mark for social commentary?

Although these uses should be available, trademark owners often try to control the expressive, or descriptive, use of their marks. That control, however, should be allowed only in instances where a competitor labels its commercial goods or services with a confusingly similar mark; control should not be allowed where a person uses the mark to communicate ideas or express a point or view.

Considering that well known marks and the values they stand for are often targets of opportunity for parodists and social commentators, it is no surprise that a fair number of cases are brought by the owners of famous marks in an effort to stop the uses. Exacerbating this are the facts that the uses are seldom complimentary and are always without permission.

So when the band, Aqua, targeted Mattel's Barbie to poke fun at her and her values Mattel sued and lost hands down. The decision highlighted what the Supreme Court has considered the important distinction between parody, which targets the product represented by the mark, and satire, which uses the mark to target a third party. To be protected under the First Amendment there must be critical bearing on the substance or style of the product behind the mark. It is not generally permissible to use someone else's mark or copyrighted work merely as an attention getter as Penguin Books learned when it published commentary on O.J. Simpson in the trademark style of Dr. Seuss. That said, at least one court, however, has recognized "satire as deserving of substantial freedom - both as entertainment and a form of social and literary criticism."

Many people use another's mark in a way they think is protectible but fail to recognize the critical distinction between parody and satire. But even where they do recognize the distinction, they must make certain that the use has relevance to the product associated with the mark, which should follow where a parody is properly done. And they must assure that the use does not create a likelihood of confusion as to source or affiliation, for if it does, the use will not be protected.

Clearly, Aqua's use of Barbie did not misrepresent Mattel as the source of the song. Would anyone think that Mattel would slam its own product with *I'm a blonde bimbo girl, in a fantasy world?*

The lines, however, become less clear in cases dealing with parodies of well-known publications, such as L.L. Bean's catalogs, *Cliffs Notes* or the *Farmer's Almanac* where it is

critical to avoid any likelihood of confusion as to source. In each of these cases, the parodists were successful because the content of the product easily marked it as a parody of the original, or the author actually labeled it as such, although in the *Cliffs Notes* case the parodist mistakenly labeled the work a "satire." The court correctly saw the distinction despite the mislabeling.

Although commercial speech, which is speech with a predominant "buy me" message, is the stepchild of the First Amendment, and at once suspect, some advertisers have successfully parodied other's trademarks and copyrights. But advertisers' attempts at protected parody usually fail because their uses often imply endorsement, association or cause confusion as to source. Or the advertiser runs afoul of the federal anti-dilution laws pertaining to commercial speech.

Yet trademarks and copyrights remain fair game for the parodist. If you want to correctly employ parody expression and not commercial exploitation of another's trademark should be your primary intent and there must be a need to evoke the original work being parodied.

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