



WELL, SLAP ME SILLY.

By: Jim Astrachan

Over the past fifty years Barbie has really cleaned up her act, going from a German doll resembling a streetwalker to a glamorous long-legged blonde. Some call her the ideal American Women; others call her a bimbo. After nearly 50 make-overs, she is a public figure and a cultural icon. She's also controversial and very litigious.

It should come as no surprise that Mattel, Barbie's owner, would go to great lengths to protect her virtue, including suing those folks who would desecrate the ideals for which she stands.

Two years ago Judge Alex Kozinsky, a scholar of IP and a Justice on the Ninth Circuit Court of Appeals, was so amused by a Barbie case brought by Mattel for trademark infringement against *Aqua's* record label over a spoof of Barbie's attributes, that he wrote, "If this were a sci-fi melodrama it might be called *Speech-Zilla meets Trademark Kong*." His sarcasm was well aimed because he saw Mattel's suit as frivolous, and *Aqua's* right to lampoon Barbie protected by the First Amendment; a sanctuary of speech that Mattel does not want to acknowledge.

To shorten a long story, the court ruled that *Aqua's* song, *Barbie Girl*" was entitled to full First Amendment protection because it was not commercial speech. *Aqua* used Barbie to create a parody of Barbie that was social commentary. What were the objectionable lyrics?

Hiya Barbie!
Hi Ken!
You wanna go for a ride?
XXX
I'm a Barbie girl, in my Barbie world
Life in plastic, it's fantastic
XXX
I'm a blonde bimbo girl, in a fantasy world
Dress me up, make it tight, I'm your dolly
XXX

What is so incredible about Mattel's subsequent suit against the artist Thomas Forsythe over use of Barbie in his art, was the reference in *Aqua* to a suit brought by Dustin Hoffman against an artist who altered images from famous films. In *Hoffman*, which was exceptionally similar to the Forsythe case, the court ruled that the artist enjoyed significant First Amendment protection.

Consider this. Mattel has now lost its first case on the grounds that the alleged infringement was protected parody. The basis for this ruling is a case whose facts are remarkably similar to the allegations of Forsythe's wrong doings. Mattel sued Forsythe in the same judicial circuit in which it lost its first case.

Did Mattel think it would win the Forsythe case? Likely not. Why then would Mattel, less than two years after being judicially slapped on the side of its silly head, sue artist Forsythe for engaging in what the court had already considered protected behavior? There's no good explanation unless Mattel decided to wage aggressive and costly legal battles in an effort to

develop a reputation as a litigious protector of its IP regardless of the merits. A slap suit, in other words. And sue Mattel did, alleging that Forsythe's photographs of a nude Barbie under attack by vintage appliance infringed Mattel's copyrights, trademarks and trade dress.

The court held that Forsythe's works contained social and political overtones. And while his work may not be your cup of tea, to some it is art. For example, "Fondue a la Barbie" depicts Barbie heads in a fondue pot; "Malted Barbie" features a nude Barbie placed on a Hamilton Beach malt machine. Forsythe claimed that these photos were an attempt to critique the objectification of women.

Mattel's attack was exceptionally vicious. It went after the San Francisco Museum of Modern Art where Forsythe's expert witness was employed, serving it with a 30(b)(6) notice of deposition and an oppressive request for documents, which the court quashed, awarding SFMOMA attorneys' fees and sanctioning Mattel.

Forsythe successfully moved for summary judgment on Mattel's underlying claims. The basis of the motion was that while admitting taking photos of Barbie, the photos were a fair use -- the same defense successfully asserted by Aqua. Forsythe appealed the district court's refusal to award him attorney's fees under the Copyright and Lanham Acts. Mattel appealed the dismissal of its claims.

In a well-written and informative decision the appellate court affirmed the trial court's grant of summary judgment on the grounds that the photos were a fair use. Mattel tried to convince the appellate court it was in error for the trial court not to have considered survey evidence on this issue of public perception of whether parody existed; the court held that "the

issue of whether a work is a parody is a question of law, not a matter of public majority opinion". Further it held that to be a parody the plaintiff's copyrighted work must be, at least in part, the target of defendant's satire. No doubt that it was.

The district court refused to award Forsythe \$1.6 Million in fees and expenses, holding that he had not established that Mattel's case was frivolous or objectively unreasonable or that the need to advance considerations of compensation and deterrence supports an award, nor, under the Lanham Act, had Forsythe demonstrated this was an "exceptional case."

The court's failure to provide the reasons for its decision was reversible error and fee issues under both Acts were remanded, with the appellate court ruling that there were sufficient grounds for the trial court to consider Mattel's suit groundless and unreasonable. On remand the district court awarded Forsythe fees and expenses of \$1.85 Million. The basis was that Forsythe's defense "furthered the purposes of the Copyright Act. Defendant's defense was meritorious; it demarcated more clearly the boundaries of copyright law; and it publicized Defendant's work, possibly leading to further creative pieces." The court took its own slap at Mattel, ruling that it "is a sophisticated entity with access to good legal representation. Plaintiff's claims were not in an unsettled area of law and had little likelihood of success. Plaintiff's copyright claims, therefore, were frivolous." The court saw Mattel's motives as merely an attempt to force Forsythe into costly litigation to discourage his use of Barbie.

\$1.85 Million. Those L.A. lawyers must have fast meters!

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