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### Don't Play With Barbie!

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by Sharon Ellis, J.D.  
Miami, Florida

Young children love the Barbie doll. Adults are divided. Barbie, with her long flowing blonde hair, blue eyes, smile and accessories, has often been the prototype for the ideal all-American girl. Conversely, she has been the subject of ridicule, being labeled a materialistic bimbo with an unrealistic figure. Nonetheless, the Barbie doll is not just a toy, but a symbol of American girlhood and a cultural icon.

While the Barbie doll may be quite popular among young girls and a huge profit-maker for the toy company Mattel, when it comes to keeping others from jumping on the bandwagon of success surrounding the doll and commenting on Barbie, the toy company seems to fall short. Mattel's message is clear – "Don't play with Barbie" - but when they took two of their cases to court, they lost both times.

#### Mattel v. MCA Records

In the first controversial case, pop music and pop culture battled it out. In 1997, the Danish band, Aqua, produced the song "Barbie Girl." In the song, one band member impersonated Barbie by singing in a high-pitched, doll-like voice while another band member, calling himself Ken, enticed Barbie to "go party." The song's popularity helped it make the Top 40 music charts. Some of the most "interesting" lyrics follow.

"Barbie Girl" by Aqua  
I'm a Barbie girl, in my Barbie world  
Life in plastic, it's fantastic  
You can brush my hair, undress me everywhere  
Imagination, life is your creation  
I'm a blonde bimbo girl, in a fantasy world  
Dress me up, make it tight, I'm your dolly  
Make me walk, make me talk, do whatever you please  
I can act like a star, I can beg on my knees

In this case, Mattel, sued music company MCA alleging trademark infringement and dilution. MCA counterclaimed for defamation. Lawyers for MCA claimed that Barbie Girl was a parody protected by the Constitution's guarantee of free speech and expression. Under fair use, one is allowed to use another's work in a parody as long as no more than necessary is used. A parody must conjure up the original work without taking too much of it.

Mattel claimed that Barbie Girl's lyrics "associate sexual and other unsavory themes with Mattel's Barbie products." Mattel's attorneys claimed children would be confused, believing the song was somehow linked to the actual Barbie doll. Mattel also alleged MCA marketed the song to children.

A federal district judge in California ruled for MCA, saying, "Even if the song were considered vulgar as Mattel purports, it is a parody of the 'party girl' image Barbie may already have among some members of the general public. Absent stronger evidence that the song actually tarnishes Barbie's image, plaintiff is unlikely to succeed on its trademark dilution claims." The judge granted summary judgment in favor of MCA on the trademark infringement and dilution claims and summary judgment in favor of Mattel on the defamation claim. Mattel, Inc. v. MCA Records, Inc., 28 F. Supp. 2d 1120 (C.D. Cal. 1998). Both sides appealed.

On appeal, the Ninth Circuit Court of Appeals held that MCA's use of Barbie did not infringe the Barbie trademark because the song's title was relevant to the underlying work and the song did not suggest that it was created by the toy company. The song was not purely commercial speech and was fully protected by the First Amendment. The use of the toy company's trademark in the song fell within the noncommercial use exemption to the Federal Trademark Dilution Act. 296 F.3d 894 (9thCir. 2002).

#### Mattel v. Forsythe

In another recent case, Mattel sued Tom Forsythe, an artist and photographer who produced photos of Barbie in various situations, for copyright and trademark infringement. Forsythe claimed he wanted to comment on consumerism and thought Barbie was the ideal subject since she comes in every possible role and has an accessory for each role. In his photographs Forsythe showed Barbie nude and posing provocatively in and around household appliances.

Forsythe's attorneys argued that his photographs were parody and were protected under the fair use provisions of the Copyright Act. Fair use is met so long as the parody was meant to criticize Barbie, the amount copied was necessary for the purpose, and that the photographs do not affect the market demand for Mattel's products or those of its licensees.

In August 2001, a judge from U.S. District Court in Los Angeles agreed with Forsythe, granting judgment in favor of Mr. Forsythe but not awarding him legal fees. Mattel and Forsythe both appealed, with the company seeking a different judgment and the artist seeking legal fees. In December 2003, a three-judge panel from the Ninth Circuit Court upheld the decision against Mattel and sent the matter of legal fees back to District Judge Ronald Lew, with instructions to reconsider the issue. Mattel, Inc. v. Walking Mountain Productions, 2003 U.S. App. LEXIS 26294 (9th Cir. Dec. 29, 2003).

On remand, Judge Lew ordered Mattel to pay Forsythe legal fees of more than \$1.8 million. He found that "Plaintiff had access to sophisticated counsel who could have determined that such a suit was objectively unreasonable and frivolous. Instead it appears plaintiff forced defendant into costly litigation to discourage him from using Barbie's image in his artwork." This is just the sort of situation in which this court should award attorneys fees to deter this type of litigation which contravenes the intent of the Copyright Act. Because the Copyright Act allows plaintiffs to sue for high statutory damages and attorney's fees for infringements, the risk of such awards may "chill" defendants even if they have a strong case. The judge also characterized Mattel's claim of trademark infringement as "groundless and unreasonable." Mattel, Inc. v. Walking Mountain Productions, (C.D. Cal. June 21, 2004).

Forsythe was ecstatic with the results and said, "This should set a new standard for the ability to critique brands that are pervasive in our culture." The message to Mattel is clear: Mattel says "Don't play with Barbie," but the courts say, if you are making fun of Barbie, then play all you want! .

Sharon Ellis graduated from the University of Florida Levin College of Law in 2004 and received her undergraduate degree from Cornell University. She lives in Miami and can be reached at sre5@cornell.edu.

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