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Make Me Walk, Make Me Talk, Do Whatever You Please: Barbie and Exceptions
Rebecca Tushnet¹

Barbie® is a symbol of America—down to the ®, representing Mattel’s claim of exclusivity. The Barbie brand is capacious, covering products of every kind. You and your Barbie can even wear matching jewelry. The doll represents an aspiration to an ideal and also a never-ending mutability. One basic body has been changed over time and reworked into multiple ethnicities, dressed in a seemingly infinite selection of outfits themselves representing a wide range of hobbies and careers (getting married might be one or the other), though almost always with feet arched to wear high heels, even for Army Medic Barbie.² Barbie is the perfect woman, and she is also grotesque, plasticized hyperreality, presenting a femininity exaggerated to the point of caricature.

Barbie’s marketplace success, combined with (and likely related to) her overlapping and contradictory meanings, also allow her to embody some key exceptions to copyright and trademark law. Though Mattel’s lawsuits were not responsible for the initial recognition of those exceptions, they illuminate key principles and contrasts in American law. Mattel attempted to use both copyright and trademark to control the meaning of Barbie, reflecting a trend towards such overlapping claims: creative material becomes a brand, and brands have so many creative elements that copyright’s low originality standard recognizes copyrightable subject matter therein. Trademark can thus be asserted as a means to provide copyright owners with potentially perpetual rights, and copyright can be asserted as a means for trademark owners to evade limits designed for commercial transactions.

In order to ensure that their combined scope is no greater than the sum of their parts, both trademark and copyright defenses ought to be considered together. The Barbie cases highlight the problem that overlaps between the two regimes can challenge the very idea of IP boundaries, unless robust defenses exist against overclaiming. More broadly, there is an international debate over whether U.S. copyright fair use, with its focus on transformativeness and flexibility in response to new situations, is a good model for other nations as they consider modernizing their own copyright exemptions and limitations. Fair use has been attacked as notoriously vague and unpredictable. On the other hand, America has produced a number of powerhouse industries, many of them (such as search engines) successfully reliant on fair use even in America’s notoriously litigious environment. International comparisons are fraught with danger, but perhaps something about the boundaries of IP can be learned from comparing two American versions of fair use, both of which have been employed to defend unauthorized uses of the famous Barbie doll.

American copyright law has a number of highly detailed and even baroque statutory limitations allowing particular types of uses and then a general fair use defense, which has often been decried for its uncertainty. American trademark law, by contrast, has historically been mostly judge-made, with the occasional statutory defense or limitation. Every circuit now uses a multifactor test to identify infringement, though some courts modify the test in certain circumstances, such as use of a trademark as a search keyword to trigger competitive advertising,

¹ Julie Cohen provided valuable feedback, as did participants at the roundtable organized around this volume.

² As a result, I can report, her flat-footed boots rarely stay on.

or in cases of ‘nominative fair use.’ While the initial ban on confusion was generally worded, more recent legislative changes to trademark law have been more likely to follow the same complex and reticulated model as copyright’s non-fair-use-based exclusions. The federal trademark dilution law and its subsequent revision added a number of multifactor tests and multistep exemptions, and anti-cybersquatting law is similar in this regard. This tendency of the law to become more complex over time has significant costs, especially for defendants who find their potential defenses turned into a confusing maze of overlapping but differently defined concepts.³

When contrasted to current trademark defenses, copyright’s vagueness starts to look a little better.⁴ Perhaps because of the four-factor fair use test codified in the 1976 Copyright Act, courts have been less likely to add new elements defendants must satisfy in order to qualify for fair use (though at the same time each individual factor can be weighed to accord with a judge’s view of the equities).

This chapter examines several Barbie cases—all involving defense wins on the part of a creative refashioner of Barbie’s image—that illustrate how courts have responded to attempts to suppress criticism, parody, and playfulness using existing works. I conclude that copyright’s flexible fair use defense is easier to understand and implement than the current set of overlapping and yet often rigid defenses courts have cobbled together in trademark cases. Trademark could benefit from clearer identification of nonactionable categories of use. The full set of protected uses might not be the same as the set of copyright fair uses, but at the very least a creative commentary should as clearly be beyond the trademark owner’s power to suppress as it is beyond a copyright owner’s reach.

I. Barbie

Barbie means many things to many people.⁵ Yochai Benkler used her as an example of the heterogeneity of meaning that, while it always existed, was exposed in new and more salient ways by the rise of the internet and, in particular, search engines. The top results from his

³ See W. McGeeveran, ‘Rethinking Trademark Fair Use,’ 94 *Iowa L. Rev.* 49 (2008).

⁴ A robust literature on predicting fair use has developed, and though it does differ in the details, the commentators suggest that fair use is not much worse in terms of predictability than any other concept in America’s highly litigious culture. See B. Beebe, ‘An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005,’ 156 *Penn. L. Rev.* 549 (2008); M. Sag, ‘Predicting Fair Use,’ 73 *Ohio St. L.J.* 47 (2012); P. Samuelson, ‘Unbundling Fair Uses,’ 77 *Fordham L. Rev.* 2537 (2009).

⁵ See, e.g., *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772, 2006 SCC 22 para. 79 (noting that Barbie’s meanings are not all positive and that “the association of the BARBIE doll with food might be taken as a warning of blandness”); J.B. Thomas, *Naked Barbies, Warrior Joes, and Other Forms of Visible Gender* (University of Illinois Press, 2003), 6 (“Barbie’s adult female body makes her appear as a sort of Everywoman, and because most women’s bodies do not look like Barbie’s, that quality often generates controversy. Currently, Barbie’s biggest public relations problem is her overly perfect physique. Balancing that is her greatest strength—the idiosyncratic uses people make of her . . .”); T. Kelly, ‘Sarah Haney, Photographer, Captures the Darker Side of Barbie,’ 19 March 2012, at 11:48 am, www.huffingtonpost.com/2012/03/19/sarah-haney-barbie-photos_n_1354425.html?ncid=edlinkusaolp00000003 (“‘I was able to expand it so much beyond the initial joke in large part because the doll herself embodies such a contradiction,’ Haney said in an email to The Huffington Post. ‘She’s marketed as this wholesome, all-American Madonna to little girls, but if you look at her as an adult, particularly at her body and clothes, she’s a pretty clear embodiment of the whore.’ Still, Haney said Barbie is the perfect icon to poke fun at.”).

Google search as reported in his 2006 book, in order, were: Mattel's official site; the official collectors' site; AdiosBarbie.com (a critical site); a Barbie-collectible magazine; a quiz, *If You Were a Barbie, Which Messed Up Version Would You Be?*; the Visible Barbie Project (discussed below); *Barbie: The Image of Us All* (an undergraduate paper on the cultural history of Barbie); a Barbie and Ken sex animation; a Barbie dressed as a suicide bomber; and Barbies dressed and painted as countercultural images.⁶ Benkler celebrates these juxtapositions, arguing that a search for 'Barbie' will now immediately foreground Barbie's culturally contested status because Google's algorithms prize individual, nonmarket judgments of relevance as well as dollars spent on advertising. 'It is easier for the little girl to see that the doll is not only a toy, not only a symbol of beauty and glamour, but also a symbol of how norms of female beauty in our society can be oppressive to women and girls. . . . [The search results show] that Barbie can have multiple meanings'⁷ (Notably, this is perhaps the only time that little girls are imagined in the scholarly discourse to be standard or normative internet searchers.)

Michael G. Cornelius articulates one aspect of Barbie's success, her role embodying the mass marketing of culture, displaying clothes and therefore suggesting identities:

Collectors will easily purchase dozens and dozens of the same doll—of the same form, the same plastic structure—in order to amass the paraphernalia associated with the particular look packaged onto the doll Barbie herself is not her physique, not her plastic curves and molded-over vagina; rather, she is the hair and clothing that cover these aspects of her personage. Her names suggest as much, since Barbie alters identity every time she switches wardrobe: differing personas like Ballerina Barbie, Western Barbie, and Pan Am Stewardess Barbie are differentiated only by raiment, hairstyle, and accoutrement. Her identity is designed to be discerned by how her form is both covered and represented by these accessories.⁸

As it turns out, reworkings of Barbie—like children's play with Barbie—often challenge this body/clothing dichotomy by focusing on the plastic, exaggerated body itself, stripping away the variations.⁹ The Visible Barbie Project,¹⁰ for example, represents a standard childhood Barbie torture, featuring pictures of Barbie in various stages of disembodiment.

Barbie's literal malleability allows her to stand in for a range of anxieties. Amy Richards and Jennifer Baumgartner wrote of their childhood experiences with the doll:

⁶ Y. Benkler, *The Wealth of Networks* (Yale University Press, 2006), 286 tbl.8.1. *But see* T. Slee, 'Googling Barbie Again,' whimsley.typepad.com/whimsley/2009/07/googling-barbie-again.html ("[T]he little girl who searches for Barbie on Google will now encounter a commodity toy. . . . [T]he remaining countercultural site from 2008 has now been pushed over the edge to page 2 of the search results, displaced by two Google-owned collections of links (News and Videos). . . . [T]he remaining link is to Wikipedia, now the only non-commercial site on the front page.").

⁷ Benkler, *supra* note 6, at 287.

⁸ M.G. Cornelius, 'Beefy Guys and Brawny Dolls: He-Man, the Masters of the Universe, and Gay Clone Culture' in M.G. Cornelius (ed.), *Of Muscles and Men: Essays on the Sword and Sandal Film* (Jefferson, NC: Mcfarland, 2011), pp. 154-55.

⁹ Thomas, *supra* note 5, at 6 (suggesting that adult responses to Barbie are often similar to children's transformative play, placing Barbie "into what both groups deem 'real-life' situations").

¹⁰ www.trygve.com/visible_barbie.html.

Barbie didn't so much influence us as she was a blank screen on which to project what was happening in our heads.... The traditional feminist distaste for Barbie has also kept many young women closeted about their dolly-loving past. They fear that loving Barbie will water down or jeopardize their feminism.¹¹

Richards and Baumgartner bring out a theme that often underlies the kinds of critiques that get challenged on trademark and copyright grounds: very few people bother to devote substantial attention to destroying, criticizing, or reenvisioning something to which they are indifferent. A strong critical response usually indicates emotional involvement, which can have significant elements of love as well as hate.¹² And the idea of the 'blank screen' also raises an issue with legal consequence: if the law favors critique, then it may be important to know what the meaning of an original work is. Can a 'blank screen' have a meaning to which a second-coming artist might oppose herself?

II. Barbie Girls

A. *Mattel v. Pitt*

Though the most well-known and doctrinally significant Barbie cases come from the Ninth Circuit, I begin with *Mattel v. Pitt*,¹³ a Barbie decision from the Southern District of New York. *Pitt* involved bullying, which may well have influenced the fair use outcome: pro se defendant Susanne Pitt, a resident of the United Kingdom, agreed to remove the challenged pictures from the internet, but Mattel pursued its case in the United States anyway. Given the lower tolerance for parody in many jurisdictions, being sued in the United States may well have ultimately worked in Pitt's favor once the case got to the point of a judicial resolution—but it is notable that Mattel still chose to sue in the United States, most likely because of the statutory damages provisions that allowed Mattel to *threaten* her with hundreds of thousands of dollars in alleged damages at the outset. Thus, *Pitt* introduces many of the relevant themes, from sexuality to the practical utility of defenses to small producers facing large corporations.

Pitt altered Barbies into 'Dungeon Dolls,' with added nipples and genitalia,¹⁴ and offered them for sale online. She also posted pictures of her creations, showing dolls sexually torturing and being tortured.¹⁵ Mattel sued for infringement of its copyright in SuperStar Barbie, a doll's head

¹¹ A. Richards & J. Baumgartner, *Manifesta: Young Women, Feminism, and the Future* 197 (New York, NY: Farrar, Straus and Giroux, 2000).

¹² 'A Conversation with Alice Randall,'

www.houghtonmifflinbooks.com/readers_guides/wind_done_gone/index2.shtml#conversation (explaining that Randall's love for *Gone with the Wind*, as much as her pain at the racist portrayals therein, drove her to create *The Wind Done Gone*, a rewriting of Margaret Mitchell's iconic work to introduce positive and heroic African-American characters and to reveal the racial and sexual stereotypes of the original).

¹³ *Mattel, Inc. v. Pitt*, 229 F. Supp. 2d 315 (SDNY 2002).

¹⁴ Or perhaps Pitt restored them. See Thomas, *supra* note 5, at 116 (Barbie's creator gave a Lilli doll, a German sex doll, to a Mattel engineer who had a prototype made in Japan, but the prototype had nipples, so the engineer filed them off). See 'Kidnapped, Page 1,' archived 18 October 2000, at web.archive.org/web/20001018155219/http://www.dungeondolls.com/page1.htm.

¹⁵ Again, this may have been reclamation of the cruelty that has always been a part of Barbie, as well as a reconstruction of the often sexualized tortures children have inflicted on Barbies for decades. See Thomas, *supra* note 5, at 123 ("The bitch-goddess identity has been with Barbie since her inception During the 1960s she was

sculpture. Pitt wrote to the court that her work constituted ‘legitimate freedom of artistic expression’ and that ‘Barbie’s origins can be traced to a German “adult” cartoon and doll called “Lilli” and that [her] website [was] offered free of charge, “as entertainment in the same free spirit as the original creator.”’

Construing her letters liberally—including their citation to the *Walking Mountain* district court opinion, to be discussed shortly—the court found them to raise a fair use defense.¹⁶ Section 107 of the Copyright Act provides that fair use is not an infringement of copyright. Though formulated in a way that it could be read as the plaintiff’s burden as part of its prima facie case to show that the defendant’s use is not fair, American courts have generally treated fair use as an affirmative defense, with the burden on the defendant. Congress provided four factors for courts to consider in determining fair use, along with a preamble listing several types of uses and permission to consider other relevant factors.¹⁷ The four factors, paraphrased, are (1) the character of the defendant’s use, including whether it is commercial (and, more recent caselaw emphasizes, whether it is transformative in the sense of giving new meaning or purpose to the original), (2) the nature of the plaintiff’s work (which includes whether it is factual or fictional and whether it is published or unpublished; the scope of fair use is theoretically narrower for the latter of each), (3) the amount of the work used by the defendant, and (4) the effect of the use on the market for the plaintiff.

The court found Pitt’s response sufficient to deny Mattel’s motion for summary judgment. Initially, the court found the Dungeon Dolls to be transformative, as evidenced both by ‘costume and anatomy,’ as well as context.¹⁸ The dolls’ bondage gear was ‘quite different from that typically appearing on Mattel’s products for children.’ The images of the doll on the website showed her—reworked into Lily the Diva Dominatrix—as ‘the protagonist in a tale of sexual slavery and torture, the victim of which was another reconfigured Barbie.’ The court distinguished this type of transformation from a mere substitution of one outfit for another—returning again to the interaction between the physical body of the doll and her clothing. Wryly, the court commented that, to its knowledge, ‘there is no Mattel line of “S & M” Barbie.’ (The court did not have the benefit of Mattel’s Catwoman Barbie, created later, which while lacking nipples and genitalia at least suggests a gesture towards non-vanilla sensibilities.)¹⁹

This transformation, the court concluded, sufficiently commented on Barbie herself rather than simply constituting general social criticism. This distinction is typical in fair use cases, even though there is no real historical or market-based justification for distinguishing ‘parody’ from ‘satire,’ and even though drawing such a line regularly forces courts into the ill-fitting position of

characterized as a ‘perfect bitch’ and criticized for having a ‘predatory’ nature. Men worried that she would turn little girls who played with her into a generation of ‘independent’ and ‘viperous’ women.”) (citations omitted).

¹⁶ 229 F. Supp. 2d at 319.

¹⁷ Courts have largely ignored the preamble and have certainly not treated its listed categories as presumptively fair, and they rarely consider factors other than the listed four, though those four are so capacious as to allow for almost any consideration a court deems relevant.

¹⁸ 229 F. Supp. 2d at 322.

¹⁹ See also Tattooed Barbie and pregnant teenage Midge (Barbie’s cousin), among other authorized versions: “‘Drag Queen’ Barbie and 9 other Controversial Barbies,” theweek.com/article/slide/232280/drag-queen-barbie-and-9-other-controversial-barbies.

art critic.²⁰ Here, however, the court was readily persuaded that Barbie was at least in part the target of the transformation. Pitt wanted to resurrect the ‘original idea of the female figure she claims inspired Barbie,’ Lilli, who was a character of easy virtue and not a child’s toy. As a result of this origin, Pitt suggested, sex was inherent in the doll, and she was ‘simply revealing this sexual nature by placing Barbie in a “modern erotic context.”’

This explanation, not incidentally, reveals some of the inherent tensions in transformativeness analysis. In theory, a successful defendant should add meaning that ‘transforms’ the original with new meaning or purpose. Yet courts are more likely to find that the original work is, at least in part, the ‘target’ of the transformation if they can perceive the seeds of the transformation in the original; otherwise there seems to be no organic and justified connection between the original and the accused work.²¹ So transformation regularly means revealing or exaggerating what is already there, rather than adding something that wasn’t previously present, even though one might ordinarily expect the latter to count as ‘new meaning.’ Because the images offered an interpretation of Barbie, the court concluded that the accuracy of Pitt’s claims about Barbie’s genealogy were immaterial to whether the dolls constituted parody. As an attempted commentary on Barbie’s sexual nature, Pitt’s images were ‘patently transformative.’

After a finding of transformativeness, the other fair use factors favored Pitt, as is typical.²² The nature of Mattel’s work was creative, but this is generally true in transformative use cases and didn’t help Mattel much. Likewise, though Pitt used the entire work—the doll’s head—she changed it substantially by decorating it and the doll body. In transformative use cases, the amount of the work taken can be substantial where that furthers the purpose of creating a new message or meaning. Finally, there was ‘slim to no’ likelihood of market substitution. Mattel was only entitled to markets that creators would in general develop or license others to develop. Here, Dungeon Dolls posed no apparent danger of usurping demand for Barbie dolls, and Mattel was unlikely to develop or license ‘adult’ dolls. The court denied Mattel’s motion for summary judgment, and there the case ended.

*B. Mattel v. MCA*²³

In the next case, Mattel brought only trademark claims. The legal path of its challenge highlights the problem in trademark of complex and overlapping multifactor defenses. A defendant can have difficulty figuring out which is supposed to apply, and their proliferation may suggest to courts that they should screen out many cases by interpreting each one narrowly, leaving some uses that should be protected essentially homeless.²⁴

²⁰ See B.P. Keller & R. Tushnet, ‘Even More Parodic Than the Real Thing: Parody Lawsuits Revisited,’ 94 *Trademark Reporter* 979, 983, 987-88 (2004).

²¹ See, e.g., *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997).

²² See Beebe, *supra* note 4, at 605-06.

²³ 296 F. 3d 894 (9th Cir. 2002), *aff’d* 28 F. Supp. 2d 1120 (CD Cal. 1998).

²⁴ See, e.g., J. McCarthy, *McCarthy on Trademarks*, 4th edn (St. Paul, MN: West Group 1994), § 31.129 (“There is a problem that faces one who ... claims that she is merely using another’s trademark in a noninfringing manner to convey some social, artistic, entertainment or political expression protected by the First Amendment as free speech. The problem is that there is no easily articulated, clearly defined legal principle that can quickly resolve the conflict. There is no statutory or judge-created safe harbor or affirmative defense that easily resolves such conflicts. Rather,

In 1997, Aqua, a Danish band, released ‘Barbie Girl,’ which featured one singer ‘impersonating’ Barbie, ‘singing in a high-pitched, doll-like voice,’ while another singer took the role of Ken.²⁵ The song became a novelty hit, and Mattel sued for trademark infringement and dilution.

The district court conducted a lengthy confusion analysis, using the standard American multifactor test. Though different courts number and name the factors slightly differently, the test considers mainly the strength of the plaintiff’s mark; the similarity of the marks; the relatedness of the parties’ goods and services or their likely expansion into each other’s markets; the parties’ marketing channels; any evidence of actual confusion; the degree of care exercised by the relevant consumers; and the defendant’s intent. After working its way through all this, the district court concluded that no confusion was likely. The fact that the court felt the need to spend so much time coming to such an obvious conclusion, however, suggests the need for more robust defenses that would preserve courts’ and defendants’ resources. This is especially true given the expense of a full summary judgment motion, the typical stage at which litigated trademark cases are resolved. A defendant must be prepared to provide evidence on the nature of the parties’ markets, the relationship between their advertising channels, the defendant’s own intent, evidence of any confusion or lack thereof (with expensive survey evidence prized above anecdotes; in *MCA*, for example, Mattel submitted a 556-person survey in support of its confusion claim), and multiple other factors. For this reason, the threat of a trademark lawsuit is often enough to chill even completely legitimate behavior.

Alongside its confusion analysis, the district court also held that ‘Barbie Girl’ was a parody that neither diluted nor infringed Mattel’s rights, because it constituted ‘nominative fair use,’ a concept identified by the Ninth Circuit as a type of referential use of a mark that furthers freedom of speech and doesn’t implicate trademark’s source-identifying functions.

‘[N]ominative use of a mark—where the only word reasonably available to describe a particular thing is pressed into service—lies outside the strictures of trademark law.’²⁶ The test requires three elements: ‘First, the product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the use must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.’²⁷

‘Barbie Girl’ satisfied each element. In particular, the repetition of ‘Barbie’ and ‘Ken’ throughout the song were reasonably necessary to the purpose and form of the parody, converting the second factor into a flexible test rather than an ‘absolute minimum possible’ approach.²⁸ The song’s references to Barbie participated in a preexisting conversation about

there is a buffet of various legal approaches to choose from. Different courts will choose different approaches and some courts will use more than one.”).

²⁵ *MCA*, 296 F. 3d at 899.

²⁶ *New Kids on the Block v. News America Publishing*, 971 F.2d 302, 308 (9th Cir. 1992).

²⁷ *Id.*

²⁸ *Mattel*, 28 F. Supp. 2d at 1142.

Barbie’s meaning and value; this picks up on the copyright fair use question of transformation as criticism.²⁹

Mattel argued that the song flunked the third prong of the nominative fair use test because it provided survey evidence that consumers thought the song was endorsed by Mattel. Though there were serious problems with the survey questions, the district court addressed the issue more directly: in the Ninth Circuit, nominative fair use is ‘not a likelihood of confusion standard.’ If the elements of the test are satisfied, a court need not consider evidence of actual confusion (or any of the other standard confusion factors) because the use is not a violation of the Lanham Act as a matter of law.³⁰ Subsequent Ninth Circuit cases have refined this concept further, holding that nominative fair use is a substitute for the usual confusion test, not a separate defense that can be overcome with sufficient evidence of confusion.³¹

The court of appeals affirmed on slightly different grounds, again illustrating how U.S. trademark defenses can cause conceptual confusion and wasted litigation energy. Judge Kozinski described Barbie’s multiplicity and malleability, treating authorized and unauthorized revisionings as similar in import: ‘Barbie has been labeled both the ideal American woman and a bimbo. She has survived attacks both psychic (from feminists critical of her fictitious figure) and physical (more than 500 professional makeovers).’³²

The court of appeals posited that the ordinary ‘likely confusion’ test usually strikes a good balance between the trademark owner’s property rights and the public’s freedom of speech. ‘But when a trademark owner asserts a right to control how we express ourselves—when we’d find it difficult to describe the product any other way (as in the case of aspirin), or when the mark (like Rolls Royce) has taken on an expressive meaning apart from its source-identifying function—

²⁹ *Id.* at 1139 (“Plaintiff dismisses such criticism of its product as simply the view of a “few extremists,” but this argument only emphasizes the fact that individuals disagree about the meaning and values associated with the doll”); see also J.C. Ginsburg, ‘Of Mutant Copyrights, Mangled Trademarks, and Barbie’s Beneficence: The Influence of Copyright on Trademark Law,’ in G.B. Dinwoodie & M.D. Janis (eds.), *Trademark Law and Theory: A Handbook of Contemporary Research* (Northampton, MA: Edward Elgar Publishing, 2008), 481, available at lsr.nellco.org/columbia/plll/papers/07138 (arguing that trademark defenses can fruitfully borrow from copyright’s free speech-oriented concept of transformative use, as the *Walking Mountain* court did). Ginsburg suggests, and I agree, that a court that has found a use to be fair for copyright’s purposes is highly likely to find it fair for trademark’s purposes, but why this is remains somewhat underexplained—in other areas, it’s not uncommon for conduct that doesn’t violate one law to violate another, especially when the formal justifications for the laws (incentivizing expression and protecting consumers from deception, for example) are different. I suspect that courts may be incorporating concepts of misuse into their fairness analysis—often, cases of overlapping claims should have been brought, if at all, only as copyright claims or only as trademark claims, and a fairness finding on the “wrong” claim recognizes that.

³⁰ 28 F. Supp. 2d at 1143.

³¹ See *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171 (9th Cir. 2010).

³² *Mattel*, 296 F.3d at 898. The district court, too, referenced Barbie’s physicality and the assaults to which she is regularly subjected. *Mattel*, 28 F. Supp. 2d at 1138 (“In the [Barbie Girl] video, the pretend Ken pulls the pretend Barbie’s arm off; the singers, playing with a fake-looking arm, appear to be poking fun at the fact that Barbie, like all dolls, can be taken apart by her more adventuresome owners.”); *id.* at n. 20 (“Indeed, in a book copyrighted by Mattel about Barbie, the introduction states that ‘the first thing most children want to do to a doll is take off her clothes.’ It further notes that Barbie, a ‘buxom fashion queen[,] is often a creature tortured for effect. Her head pops off, fits back on, and does a 360-degree rotation.’”) (citation omitted).

applying the traditional test fails to account for the full weight of the public's interest in free expression.³³

Aqua's use was both expressive and referential. The title of the song described the song, rather than identifying its producer. The song poked fun at Barbie and the values Aqua thought she represented with lyrics such as 'Life in plastic, it's fantastic. You can brush my hair, undress me everywhere/Imagination, life is your creation.... I'm a blond bimbo girl, in a fantasy world/Dress me up, make it tight, I'm your dolly.' Distinguishing an earlier case finding that a book about the O.J. Simpson murder trial in the style of Dr. Seuss infringed Dr. Seuss's trademarks,³⁴ the court emphasized that Barbie herself was the target of the song, not the medium for criticizing some third thing. As a result, traditional confusion analysis was inappropriate, and free speech interests deserved more weight.

The *MCA* court thus adopted the Second Circuit's test from *Rogers v. Grimaldi*,³⁵ which provides that trademark law does not reach titles that are in any way artistically relevant to the underlying work and that do not explicitly mislead as to their source (for example, by a false claim to be an authorized or official biography). The court's reasoning was both normative—titles are expressively valuable—and empirical—positing that consumers generally don't expect that a title of a book, song, or other expressive work identifies the publisher or producer; instead, it signals something about the content, whether directly or through allusion. 'If we see a painting titled "Campbell's Chicken Noodle Soup," we're unlikely to believe that Campbell's has branched into the art business. Nor, upon hearing Janis Joplin croon "Oh Lord, won't you buy me a Mercedes-Benz?," would we suspect that she and the carmaker had entered into a joint venture.'³⁶

Notably, after Joplin's death, her stepsister did in fact authorize the use of the song in a Mercedes ad,³⁷ just as Aqua would later license its song to Mattel. Judge Kozinski's claims sound in empirics, but empirics alone are vulnerable to trademark owners' attempts to change consumers' expectations. The normative component of the test discourages them from doing so. Another point about these examples is that Judge Kozinski's quotation of song lyrics, not just titles, foreshadows the expansion of *Rogers*. Framed as a rule about titles, *Rogers* is easily expanded to content, which is good from the point of view of free speech but makes a tautology of the concept of 'artistic relevance,' since the subject of an expressive work will by definition be artistically relevant to that work. In the event, *Rogers* dictated summary judgment in Aqua's favor. The use of Barbie in the title was clearly relevant to the song itself, and didn't explicitly claim that the song was produced by Mattel.

Mattel also claimed dilution under the then-current federal trademark dilution statute. The dilution statute's definition of dilution was somewhat opaque: 'the lessening of the capacity of a famous mark to identify and distinguish goods or services' caused by another person's 'commercial use in commerce,' with some exceptions. The court's statutory analysis is now

³³ *Mattel*, 296 F.3d at 900.

³⁴ *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir.1997).

³⁵ 875 F.2d 994 (2d Cir. 1989).

³⁶ *Mattel*, 296 F.3d at 902.

³⁷ J. Doyle, 'Selling Janis Joplin, 1995,' 10 March 2008, www.pophistorydig.com/?tag=janis-joplin-mercedes-ad.

obsolete, but the basic contours of its reasoning were accepted by the later revision of federal dilution law: because the song was ‘noncommercial speech’—which meant ‘not advertising’—it was not a ‘commercial use in commerce’ and was therefore excluded from the scope of dilution law. Nonetheless, the court unequivocally held that use of the mark was (nonactionably) dilutive because, ‘while a reference to Barbie would previously have brought to mind only Mattel’s doll, after the song’s popular success, some consumers hearing Barbie’s name will think of both the doll and the song, or perhaps of the song only.’³⁸ This was a ‘classic blurring injury’ because the distinctiveness of the mark was diminished if the mark ‘no longer brings to mind the senior user alone.’³⁹

Whatever the actual likelihood of such changes in consumer reactions, the flexibility (or standardlessness) of dilution as a concept is apparent in the fact that the court saw no contradiction between this holding and its prior holding that the song was about Barbie. Other courts have doubted that a referential use can blur, rather than reinforce, a trademark.⁴⁰ The song might be able to change or add to the *meanings* of Barbie, but that is a far different thing than making people think that there is more than one *source* of Barbie (reducing the mark’s capacity to *identify and distinguish* Barbie from other products). This very flexibility is why dilution has seemed to need strong categorical defenses. When Congress revised the dilution statute a few years after the *MCA* case, however, it followed the now-common practice of creating a long and detailed exclusion designed to protect freedom of speech.⁴¹ Unfortunately, precisely because of its length and detail, trademark owners can still argue that some commentary is covered by dilution law.⁴²

C. *Mattel v. Walking Mountain*

In the final case, trademark and copyright claims went together. Mattel sued artist Thomas Forsythe for producing 78 ‘Food Chain Barbie’ photos portraying Barbie ‘in various absurd and often sexualized positions.’⁴³ For example, ‘Malted Barbie’ featured a nude Barbie placed on a malt machine, while ‘Barbie Enchiladas’ showed four Barbie dolls wrapped in tortillas and covered with salsa in a casserole dish in an oven. Mattel alleged copyright, trademark, and trade

³⁸ *Mattel*, 296 F.3d at 903-04.

³⁹ *Id.* at 904.

⁴⁰ See, e.g., *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 267 (4th Cir. 2007) (holding that successful parody is unlikely to dilute a famous mark because it simultaneously communicates that it is a satire of the mark); *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 625 F. Supp. 48, 55 (DNM 1985) (quoting with approval McCarthy’s conclusion that successful parodies reinforce an association with the trademark owner because the success of the joke depends on continued association of the mark and the owner).

⁴¹ 15 U.S.C. § 1125(c)(3) (excluding “[a]ny fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—(i) advertising or promotion that permits consumers to compare goods or services; or (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner,” “[a]ll forms of news reporting and news commentary,” and “[a]ny noncommercial use of a mark”).

⁴² See, e.g., *Louis Vuitton*, 507 F.3d at 266 (noting that parodic use as a mark for a parody product fell outside the statutory exemption); *Louis Vuitton Malletier, S.A. v. Hyundai Motor America*, 2012 WL 1022247 (SDNY) (finding that dilution law covered a satirical use of Louis Vuitton’s mark in an ad even though the defendant did not use the mark to refer to its own goods or services).

⁴³ *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

dress infringement, along with trademark dilution.

Forsythe stated that the photos were his attempt to critique ‘the objectification of women associated with [Barbie],’ and to attack ‘the conventional beauty myth and the societal acceptance of women as objects because this is what Barbie embodies.’ He chose Barbie as his target because ‘Barbie is the most enduring of those products that feed on the insecurities of our beauty and perfection-obsessed consumer culture.’ Despite Forsythe’s limited market success (he earned well under \$4000 from the series, though his works were displayed in various exhibitions), Mattel sued and thereafter engaged in aggressive litigation tactics, including an incredibly broad subpoena to a non-party museum that resulted in sanctions.



The courts, both at the district and appellate levels, went through the same fair use analysis as in *Pitt*. One notable difference was that Mattel offered a survey in which it had presented ordinary consumers with color copies of Forsythe’s photos and asked them what meaning they perceived. According to Mattel, a reasonable jury could, like many respondents in the survey, fail to perceive a parodic character in the works. The court of appeals easily dismissed the survey: for copyright fair use, parody is a question of law, not of ‘majority opinion.’ Instead, parody was ‘an objectively defined rhetorical device.’ As the Supreme Court had put it, the question was whether parody could ‘reasonably be perceived,’⁴⁴ an inquiry distinct from whether a majority of viewers would primarily perceive a parody. Moreover, parody has First Amendment value, and so even if there’s disagreement about the ‘success or extent’ of a parody, ‘parodic elements in a

⁴⁴ *Campbell v. Acuff-Rose Music, Inc.*, 510 US 569 (1994).

work will often justify fair use protection.’ The survey was irrelevant because majority vote couldn’t be allowed to suppress artistic creativity. The court then quoted Justice Holmes’ well-known statement that ‘it would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [a work],’⁴⁵ glossing over the way that Mattel’s survey purported to alleviate this danger by having the public judge the worth of a work instead.

Forsythe’s use could reasonably be perceived (by the court, implicitly) as a parody of Barbie, given the social context of his work and the actual content of the photos. Mattel had created an image of Barbie as the ideal American woman, associating her with beauty, wealth, and glamour. Forsythe reversed this image ‘by displaying carefully positioned, nude, and sometimes frazzled looking Barbies in often ridiculous and apparently dangerous situations.’ He offered ‘a different set of associations and a different context for this plastic figure.’ Barbie’s smiling obliviousness to the dangers to which the photos showed her exposed—dangers posed by ‘domestic life in the form of kitchen appliances’—created a ‘disturbing[]’ effect, and in some photos the doll was sexualized by ‘sexually suggestive contexts.’ The court concluded that ‘[i]t is not difficult to see the commentary that Forsythe intended or the harm that he perceived in Barbie’s influence on gender roles and the position of women in society.’ Though the commentary could be *seen*, it apparently couldn’t be *stated*. The court did not and probably could not translate Forsythe’s visual message cleanly into words.

This failure to elaborate was not necessarily a weakness. By situating Forsythe’s commentary within an existing cultural debate over Barbie’s meaning, the court recognized that Barbie was already not entirely under Mattel’s control. And this multiplicity of meaning has important implications for how courts should think about transformativeness. Even a defendant-favorable fair use case can fix one meaning to the plaintiff’s work, another meaning or purpose to the defendant’s work, and then declare them different enough that the defendant’s use is transformative and therefore fair. When the defendant loses, the court tends to determine that the meaning of the works is the same, taking a universalist perspective that denies that different observers might generate different meanings from the same work. A court that finds a work nontransformative because it judges that the original already contained the elements highlighted by the defendant’s work⁴⁶ is mistaking aspects of meaning for the whole.

Interpretation is the condition of expression. *Pitt* and *Walking Mountain* demonstrate that it is the contest among possible meanings of a work, some of which are given greater salience by a second-comer’s commentary, that produces the ‘transformativeness’ fair use doctrine seeks. Barbie is already sexual; Barbie is desexualized. Barbie is materialistic and shallow; Barbie encourages girls to run for president. Barbie already covers all the bases. But people still get to make unauthorized uses of her.

Moreover, though Forsythe could have made similar statements without using Barbie, Barbie ‘conveys these messages in a particular way that is ripe for social comment.’ The court of appeals was unwilling to accept a definition of parody that would require the parodist to show that his parody was impossible without using the copyrighted work. To do so would unacceptably dictate to artists what their subjects could be. Similarly, the court of appeals

⁴⁵ *Bleistein v. Donaldson Lithographing Co.*, 188 US 239, 251 (1903).

⁴⁶ *Salinger v. Colting*, 641 F. Supp. 2d 250, 258 (SDNY 2009), rev’d on other grounds, 607 F.3d 68 (2d Cir. 2010).

rejected Mattel’s argument that Forsythe had simply used too much of Barbie by using her entire body. Significantly for other fair uses, the court pointed out that fair use of a visual or sculptural work may be different than fair use of songs, video, or written works. The latter can be ‘naturally severable’ in that a transformative user can select portions of the original and then add to them. But given his subject (a doll) and his medium (photography, as opposed to, say, painting or prose), Forsythe needed to transform by recontextualizing the doll. Though his medium was different, his use was ultimately no different from that of a musical parodist who took a song’s ‘basic melody’ and transformed it with other elements. Barbie emerged from his photos ‘imbued with a different character.’ Given the transformation, Mattel’s argument that Forsythe could have used less of the doll was meritless. Again, artists are not required to use the ‘absolute minimum’ of works they are transforming. Finally, the court pointed out that Mattel was unlikely to license critical uses of Barbie, nor was it sound public policy to allow Mattel to control the market for interpreting Barbie.

Mattel’s trademark claims were equally unsuccessful. The court of appeals reiterated the free speech value of expression about a cultural icon, then applied the *Rogers* test to Forsythe’s use of the term ‘Barbie’ in the names of his pictures. The test was easily satisfied: the use of Barbie was relevant to the content of Forsythe’s work, and the titles didn’t explicitly mislead as to Mattel’s sponsorship of the photos. Given those two factors, the public interest in freedom of artistic expression decisively outweighed any interest Mattel asserted in avoiding potential consumer confusion. (Among other things, it’s hard to imagine that any consumer confusion would change consumer behavior in any material way. Barbie buyers are likely to keep buying Barbies after seeing Forsythe’s photos no matter whether they think the photos are authorized or not.)

The court used a different analysis when assessing Mattel’s trade dress claim based on the portrayal of Barbie in the photos. Of the possible tests—a standard multifactor likelihood of confusion test, a version of *Rogers* expanded to expressive content, and nominative fair use—the court of appeals chose the last, as a narrower ground for its holding,⁴⁷ even as it recognized that Barbie’s appearance (trade dress) played a similar role in American culture to the Barbie word mark. Indeed, they are indelibly linked: Barbie the word mark means what it does because Barbie looks how she looks.

Forsythe’s use was nominative. He used the trade dress to refer to or ‘conjure up’ Mattel’s product in order to create his own work, and this use was ‘reasonably necessary,’ indeed, virtually required, given his choice of medium.⁴⁸ Implicit was that Forsythe had every right to choose photography as his medium of commentary. Trademark law couldn’t be used to limit him to words, or even to drawing Barbie freehand. This conclusion also meant that Forsythe had not used more of the trade dress than reasonably necessary. The ‘necessary’ amount is a case-by-case question, so it too was affected by Forsythe’s choice of a visual medium: given that he

⁴⁷ Ultimately, the Ninth Circuit recognized that *Rogers*’ First Amendment-protective test could be applied to a work’s content, not just its title. *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008).

⁴⁸ As Jane Ginsburg has noted, the use of “conjure up” seems borrowed from fair use’s third factor, and likewise functions flexibly: a second-comer is allowed to use the amount of the mark (or work) appropriate to the purpose. *See* Ginsburg, *supra* note 29.

was creating photos, and given that his goal was to comment on ‘the social implications of Barbie, including issues of sexuality and body image,’ his uses were both reasonable and necessary. This conclusion is required to keep the nominative fair use test from discriminating against expressive uses in nontextual media. But it also represents an expansion of the original idea that nominative uses only involve word marks, even though the case that first named the defense expressly distinguished word marks from visual components, such as distinctive fonts.⁴⁹

The court’s analysis of the third prong of the nominative fair use test was particularly illuminating of the weaknesses of the test, despite its favorable result for Forsythe. The Ninth Circuit initially stated this prong as a negative one: ‘the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder,’⁵⁰ and restated it in those same negative words in *Walking Mountain*. As Forsythe didn’t do anything to suggest sponsorship, such as calling his series ‘Official Barbie Food Chain,’ that would seem to be the end of the matter. But the *Walking Mountain* court called this prong a ‘closer call’ than the other two, even though the court then stated that no explicit disclaimer was required in cases of nominative fair use and even though it’s the second prong—reasonable necessity—that seemed to call for the exercise of the most judgment. Indeed, courts applying *New Kids* have often read this third prong as justifying a quick-and-dirty confusion analysis, using much more intuition and much less evidence than the ordinary multifactor confusion test.⁵¹

While defendants often win when a court has already decided that nominative fair use is the appropriate frame for a particular situation, the half-acknowledged use of affirmative confusion analysis makes this ‘quick look’ potentially quite hazardous to predictable and speech-protective results, as critics have noted.⁵² Changing ‘the defendant must do nothing else to suggest affiliation other than use the plaintiff’s mark’ to ‘the defendant’s use must not suggest affiliation’ simply restates the dominant confusion test, leaving the point of the rest of nominative fair use somewhat unclear.

In *Walking Mountain*, the court concluded that Forsythe’s other materials—making clear his artistic stance towards Barbie—‘reduce the likelihood of any consumer confusion as to Mattel’s endorsement of Forsythe’s work. Any reasonable consumer would realize the critical nature of this work and its lack of affiliation with Mattel. Critical works are much less likely to have a perceived affiliation with the original work.’ But this is just an on-the-cheap confusion analysis. It has the virtue of avoiding reference to evidence of actual consumer confusion (which is important since surveys can often be constructed to find likely confusion), but it provides regrettably little guidance for the next expressive use case, especially if the next court finds a

⁴⁹ *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302 (9th Cir. 1992).

⁵⁰ *Id.* at 308.

⁵¹ As Professor McGeeveran has noted, “trademark fair use frequently devolves into a clumsy alternate means of asking the fundamental question of trademark law: whether a defendant’s use of a plaintiff’s mark is likely to confuse consumers.” See McGeeveran, *supra* note 3, at 51.

⁵² See generally *id.*; compare *Swarovski Aktiengesellschaft v. Building #19, Inc.*, No. 12-1659, --- F.3d ---, 2013 WL 85929 (1st Cir. 2013) (lifting preliminary injunction based on trial court’s holding that a defendant relying on nominative fair use used more of a mark than necessary because the trial court had failed to make an underlying finding that confusion was likely), with *Tabari*, 610 F.3d at 1181 (apparently holding that using “too much” of a mark in a referential context “might” cause confusion and was therefore enjoined, without further consideration of likely confusion).

plaintiff's survey compelling.

Nominative fair use *could* be more than this—it could be a genuine defense precluding inquiry into confusion, the way that the *Rogers* test is. In fact, arguably *Rogers* should completely replace *New Kids* in protecting uses of trademarks in traditional expressive works such as books, movies, and songs, leaving *New Kids* or other doctrines (such as the general American rule that comparative advertising is nonconfusing) to deal with advertising. Or *New Kids*' negative formulation of the third prong could be taken seriously: a defendant's referential use, when reasonably necessary to make the reference communicate the defendant's message, should be conclusively presumed nonconfusing unless the defendant takes some other affirmative step to indicate that its product comes from the plaintiff.

Regardless, having disposed of the infringement claim, the *Walking Mountain* court quickly rejected Mattel's dilution claim, since Forsythe's use as a parody was a noncommercial use explicitly excluded from the scope of federal dilution law. In addition, given how bad Mattel's arguments were, and how Mattel was apparently using its resources to intimidate an ordinary artist, the court of appeals remanded the case to the district court for reconsideration of whether to award fees under both the copyright and trademark statutes. Though American law doesn't ordinarily provide for fee-shifting, both statutes allow it under certain circumstances, including for abusive claims. The remand was a strong suggestion that Mattel ought to be paying Forsythe's fees, which ultimately cost Mattel nearly two million dollars.

III. Conclusions: Come On, Barbie, Let's Go Party

It's common for lawyers to point to a different field of law to look for a fix to problems in a field under criticism. Judges in trademark cases challenging expressive uses borrow concepts from copyright; reformers in fair dealing jurisdictions suggest learning from fair use's flexibility; reformers in the U.S. look for the greater certainty they hope can be found in narrower but more clearly defined exceptions. But law is fractal and the actual operation of a doctrine may differ from its appearance from the outside. Add to this the interaction between judicial and legislative rule-making, which in the U.S. has often meant the creation of new and sometimes baroque multi-step tests from both sources, and it can be extremely hard to figure out what's going on with copyright and trademark defenses.

Still, freedom of expression demands clear protection for certain expressive uses. It is therefore worth noting that every judge, district and appellate, engaged in essentially the same copyright analysis in *Pitt* and *Walking Mountain*. By contrast, *MCA* and *Walking Mountain* involved multiple trademark tests, spending a great deal of effort to reach the same simple conclusion—a concern Robin Jacob also raises in his chapter on UK law. More generally, copyright fair use, which has developed general categories that are in practice presumptively free from liability, seems more attractive in comparison to repeated judicial or legislative creation and alteration of multifactor tests hyperspecialized for particular situations. Both copyright fair use's notorious vagueness and the vaunted predictability of narrower exemptions may have been overstated.

Copyright's fair use defense has developed a number of prototypes and clusters that make it a good model for preserving freedom to criticize in an environment—such as the American legal

environment—in which intellectual property owners are willing to sue critics and artists.⁵³ As Joseph Singer has recently explained, standards can be both predictable (when they encounter standard cases) and flexible (when they encounter innovations, either in a defendant’s unexpected use or a plaintiff’s claim to control something that used to be free):

Standards are often more predictable than we may think because they are elaborated through the case law system in a way that produces generalizations that approach the form of rules. Both rules and standards operate through explicit or tacit *exemplars*; storytelling defines the contexts in which both rules and standards apply. Exemplars give standards a fair degree of predictability. Standards also often contain implicit *presumptions*. Such default outcomes function as ‘soft rules’ that often approach or exceed the predictability we typically associate with rigid rules. For these reasons, standards are often far more constraining and decision-guiding than the scholars may assume.⁵⁴

Not only does this realization help to rehabilitate copyright fair use against the many criticisms of its unpredictability, it provides some guidance for trademark law. Modern plaintiffs are increasingly likely to bring both copyright and trademark claims against expressive uses. They don’t care about the name of the doctrine as long as it suppresses a disfavored use, which is related to the fact that, instead of protecting a traditional trademark or a series of copyrighted works, IP owners now seek to protect a ‘brand.’⁵⁵ A working copyright fair use isn’t enough. We also need working defenses in trademark to protect the same uses: an internal harmonization of boundaries. Given the proliferation of tests, trademark’s current defenses lack the supposed benefits of rules (predictability, clarity) while rarely delivering the flexibility of standards.

Norm entrepreneurs like Peter Jaszi and Patricia Aufderheide have vigorously argued that Larry Lessig’s famous claim that copyright fair use is ‘the right to hire a lawyer’⁵⁶ is misguided and detrimental. Instead, they suggest, most fair use determinations—certainly most determinations of the kind that an individual creator or an educational institution is likely to be making—can be made by paying attention to context, norms of fair practice, and the statutory fair use factors (primarily the nature of the use).⁵⁷ Aufderheide and Jaszi caution that ‘Exaggerating or misrepresenting the acts of fair users, and their consequences, can unnecessarily deprive people of the agency to accomplish routine acts of cultural expression.... Fair use does not usually require courage. It should be something that elementary schoolchildren can do without drama.’⁵⁸ A flexible defense that, over time, develops protected categories of use can provide predictability for ordinary users without requiring resort to an increasingly dysfunctional legislative process every time conditions change.

⁵³ See, e.g., Beebe, *supra* note 4; Sag, *supra* note 4; Samuelson, *supra* note 4.

⁵⁴ J. Singer, ‘The Rule of Reason in Property Law,’ *U.C. Davis L. Rev.* (forthcoming 2013), manuscript at 17, papers.ssrn.com/sol3/papers.cfm?abstract_id=2128299 (footnote omitted).

⁵⁵ See generally D.R. Desai, ‘From Trademarks to Brands,’ *64 Fla. L. Rev.* 981 (2012).

⁵⁶ L. Lessig, *Free Culture: The Nature and Future of Creativity* (New York, NY: Penguin Books 2005), 187.

⁵⁷ P. Aufderheide & P. Jaszi, *Reclaiming Fair Use: How to Put Balance Back in Copyright* (University of Chicago Press, 2011); cf. Singer, *supra* note 54, at 11 (“Predictability in property law comes as much from deferring to possession, reliance, custom, and moral norms as it does from formal documents of title.”).

⁵⁸ Aufderheide & Jaszi, *supra* note 57, at 68.

Of course, making a fair use—even a fair use that reasonable people would with near unanimity agree is fair—is no guarantee that a fair use will go unchallenged. America lacks a threats action providing a general remedy for unfounded threats of copyright or trademark infringement,⁵⁹ and so there is little deterrent to an intellectual property owner sending a threat letter to shut up a critic, who will rarely be able to secure counsel. Even if an artist does find counsel, the slimmest possibility of statutory damages in copyright, or even the simple burden of litigation, may be enough to force her to capitulate. But at the same time, Mattel’s overreaching produced precedents to which creators can now appeal, and a quick search online for Barbie-related art shows that unauthorized creative reuses are flourishing.⁶⁰

A key question for limitations and exceptions to trademark and copyright, then, is how they will shape behavior on the ground. The early critical uses of Barbie, including *Dungeon Dolls*, often went offline, but they were quickly replaced. A fee award against Mattel (as in *Walking Mountain*) has some deterrent effect, but more significant might be the larger culture that empowers people to create responses to corporate productions, and then at least sometimes to resist threats when they materialize.

⁵⁹ See 17 U.S.C. § 512(f) (providing limited cause of action for abuse of the notice and takedown system for identifying copyright infringement to online service providers); *cf.* Trade Marks Act, 1994, c. 26, §21 (Eng. & Wales) (providing cause of action for groundless threat by trademark claimant); L.C. Grinvald, ‘Shaming Trademark Bullies,’ 2011 *Wisc. L. Rev.* 625 (canvassing national laws on groundless threats by trademark owners and proposing a similar remedy in the U.S.).

⁶⁰ See, e.g., ‘Altered Barbie,’ alteredbarbie.com/artwork/all_art (collecting various artists’ work); ‘Debbie Curtis Barbie Art,’ debbiecurtisart.com/home.html (showcasing work of painter who takes Barbie as her subject); ‘Margaux Lange,’ www.margauxlange.com/ (featuring jewelry made from Barbie parts).