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INTELLECTUAL PROPERTY LAW

**Barbie™ v. "Barbie Girl":
Rock Song does not dilute registered trademark**

by Brian E. Banner

On January 27, 2003 the U.S. Supreme Court denied a petition for writ of certiorari from the Ninth Circuit's holding in *Mattel Inc. v. MCA Records Inc.* (US Case 02-633) that use of "Barbie Girl" as the title and subject of a rock song did not infringe or dilute the registered "Barbie" trademark for fashion dolls.

Five years ago the toy giant Mattel sued the record giant MCA for trademark infringement and dilution under the Lanham Act and Federal Trademark Dilution Act (FTDA) after MCA released Aqua's recording of "Barbie Girl" in the United States. The "Barbie Girl" song contains the juvenile lyrics including, "I'm a Barbie girl, in my Barbie world, Life in plastic it's fantastic, I'm a blond bimbo girl, in a fantasy world." In the record, one band member impersonates Barbie, singing in a high-pitched, doll-like voice while another impersonates Barbie's significant other, Ken (also a Mattel doll), who entices Barbie to "go party." The song lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents. A commercial success, the song made it onto Top 40 music charts to the angst and dismay of Mattel.

On the issue of trademark infringement, the lower court said that the likelihood-of-confusion test generally strikes a balance between trademark owner's property rights—avoiding confusion in the marketplace—and the public's expressive interests when the trademark enters our public discourse and becomes an integral part of our vocabulary. Does the average U.S. consumer for example know to ask for "aspirin" as "acetyl salicylic acid"? Probably not. Brands that transcend their identifying purpose often fill in gaps in our vocabulary, add a contemporary flavor to our expressions and assume a role outside the bounds of trademark law according to the appellate court. While Mattel's

survey evidence shows that substantial actual confusion among consumers exists, the courts conclude that the likelihood-of-confusion test sometimes does not give adequate protection to free expression. MCA's use of "Barbie" in the song title "Barbie Girl" is not a trademark infringement since it is clearly relevant to the song about Barbie and the values Aqua claims she represents. The title does not explicitly mislead anyone about the source or sponsorship of the song in the lower court's view.

Unlike infringement, dilution usually occurs when consumers aren't confused about the product's source or sponsorship. Dilution (either tarnishment or blurring) protects owners from an appropriation of or free riding on the substantial investment that they have made in their marks. The court said, "With Barbie, Mattel created not just a doll, but a culture icon." The court found that "Barbie" is both a distinctive trademark and famous under the FTDA in view of the doll's fifty year commercial success. Dilutive uses are prohibited under the FTDA unless they fall within one of three statutory exemptions namely, comparative advertising, news reporting and commentary and noncommercial use. The evidence shows that MCA's use is dilutive but does not tarnish "Barbie's" image since the lyrics are non-obscene, though possibly offensive. However, the district and appellate courts conclude that Aqua's use is a parody and a "noncommercial use" within this exception. The courts concluded that "Barbie Girl" is not purely commercial speech, and is fully protected by the FTDA exemption.

Because of these and other thorny issues raised by the parties, the Ninth Circuit's opinion written by Judge Kozinski ends with the sentence, "The parties are advised to chill." By denying the petition for writ of certiorari the Supreme Court tacitly appears to agree with this admonition.

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Brian E. Banner is a partner in the Washington, DC office of Banner & Witcoff, Ltd. The opinions express in this article are the authors and should not be taken as legal advice. For further information please contact Brian Banner at (202) 824-3000 or BBanner@bannerwitcoff.com.