Trademark Battles in a Barbie-Cyber World: Trademark Protection of Website Domain Names and the Anticybersquatting Consumer Protection Act

Kiran Nasir Gore

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Trademark Battles in a Barbie-Cyber World: Trademark Protection of Website Domain Names and the Anticybersquatting Consumer Protection Act†

by

KIRAN NASIR GORE*

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In August 2007, Mattel, Inc. ("Mattel") filed a lawsuit in United States District Court, claiming that adult entertainer Terri Gibson, under the moniker "China Barbie,"$ infringed upon Mattel’s Barbie doll trademark with her pornographic website maintained at the domain name "www.chinabarbie.com."$ Mattel claimed that China Barbie used the Barbie trademarks intending to trade on Mattel’s enormous goodwill to enhance the commercial value of her products and services.⁴ Mattel feared that her use of the domain name would cause irreparable damage and requested transference of the domain name to Mattel, treble damages or profits earned, and statutory damages under the Anticybersquatting Consumer Protection Act ("ACPA"),⁵ and punitive damages.⁶ Filing of the "China Barbie" complaint attracted significant attention in the legal community, where most perceived the lawsuit as frivolous and a reflection of Mattel’s over-litigiousness protection of its Barbie trademark.⁷

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2. In addition to "China Barbie," Terri Gibson’s other aliases include Tearabue S. Gibson and Terarie Sharail Gibson. Her company, China Global Networks, was also listed as a defendant in the complaint. Complaint at 1, Mattel, Inc. v. Global China Networks, LLC, No. 07 Civ. 7418 (S.D.N.Y. Oct. 23, 2007), 2007 WL 2509011.

3. Id. at 8-9.


6. Complaint, supra note 1, at 8, 13.

Nonetheless, China Barbie soon defaulted and the www.chinabarbie.com domain name was transferred to Mattel. China Barbie was further "enjoined from cybersquatting upon, infringing or diluting Mattel’s registered trademarks." This lawsuit turns on facts unique to the Internet age; however, it signals only the latest stage in Mattel’s fifty year history of vigorously protecting Barbie’s image as a wholesome children’s toy and American icon through marketing strategies, and when appropriate, legal action.

The Internet is essential to the success of businesses, both in the real and cyber worlds. E-commerce’s rapid expansion and exponential growth created a greater need than ever for strong systems to protect trademarks to ensure that development and cultivation of trademarks remains worthwhile for trademark owners. However, as trademark property rights expanded during the twentieth century, many legal commentators became concerned about the overprotection of trademarks at the expense of First Amendment principles. Recent enactment of
the Federal Trademark Dilution Act ("FTDA")\textsuperscript{14} and the ACPA\textsuperscript{15} have created new challenges for balancing trademark property rights and the public's free speech.\textsuperscript{16} This tension is exemplified by the current website domain name registration system, which is at the heart of Mattel's claims against China Barbie.\textsuperscript{17}

This Note will use Mattel's claim against China Barbie as a paradigm to argue that the balance between trademark owners' property interests and the public's free speech rights in the Internet domain name registration system should be reevaluated. First, this Note will discuss the non-trademark connotations of Barbie due to its incorporation into public discourse and societal vocabulary, which lends it a secondary public domain role that is beyond the reach and regulation of trademark law. As demonstrated by Mattel's excessive litigation,\textsuperscript{18} this Note will further argue that current trademark law, particularly the ACPA, excessively protects trademark owners and impedes the public's free speech. Finally, this Note will propose alternative methods to protect the goodwill of trademarks, without compromising the public's free speech.

Part I of this Note discusses trademark law's expansion from its "likelihood-of-confusion" origins to the more protective FTDA, and the ACPA. It also addresses conflicts between the First Amendment and the ACPA. Part II discusses Barbie's status as an American icon and Barbie's history of trademark litigation, and then specifically discusses litigation involving the ACPA. Finally, Part III argues that Barbie has become a cultural icon that holds value in public discourse that cannot be curtailed by trademark protection. Part III will also argue that the ACPA fails to strike the appropriate balance between trademark property rights and the public's First Amendment entitlements.

\section*{II. The Evolution of Trademark Law: From Likelihood of Confusion to the ACPA}

This section traces trademark law developments during the twentieth century, an evolution that reflects a paradigmatic shift from a focus on consumer protection to ensure that products are accurately represented to them, to a broader property than with tort. When consumer confusion ceases to be the touchstone, however, the accommodation between trademark law and the first amendment becomes more problematic." \textit{Id}.\textsuperscript{14}


16. As the scope of trademark property rights has expanded, trademark infringement claims now regularly arise in the context of social commentary, criticism, and artistic expression, which in turn implicate First Amendment issues. See Lipton, \textit{supra} note 12, at 1327, 1332 (noting the poor balance between free speech protection and commercial trademark interests in the context of Internet domain names of parody and gripe websites).


18. Lattman, \textit{Mattel Fires Back at China—China Barbie, supra} note 1; see also discussion \textit{supra} Part IIIB.
focus on trademark owners' rights, without any clear scope. This section concludes that trademark law's more recent focus poses a threat to the public's free speech rights due to its ambiguity. Part A of this section outlines the "likelihood of confusion" theory, the traditional form of relief available to trademark owners. Part B highlights the FTDA and the ACPA; and finally, Part C addresses the tension between modern trademark law and the First Amendment.

A. Basic Principles: Goals of Traditional Trademark Law and the Likelihood of Confusion Standard

Federal trademark law was codified in the Lanham Trademark Act in 1946, which defines a "trademark" as "any word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."19 Under this original paradigm, trademark law had two goals: (1) protecting consumers by ensuring that all purchases were fully informed; and (2) ensuring that trademark owners, who invest resources in the cultivation of their trademark's goodwill, are protected from misappropriation of that goodwill.20 Both reflect a common concern: prevention of unauthorized trademark use that causes public confusion.21 A use constitutes trademark infringement under the Lanham Act if it is:

likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or ... in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities.22

The likelihood of confusion standard protects a trademark from a variety of harms; however, its limitations are evident in its requirements—trademark holders must prove the likelihood of error or direct or indirect

21. Lipton, supra note 12, at 1335.
22. 15 U.S.C. 1125 (a)(1)(A) & (B). Courts have developed various likelihood-of-confusion tests that consider common elements, including: the alleged infringer’s intent; actual confusion; and market factors that consider the relationship between the goods and services at issue and the trade channels. Lipton, supra note 12, at 1335.
competition between its own goods and the unauthorized use by another.\textsuperscript{23} This leaves a trademark vulnerable to misappropriation beyond these limits; for example, unauthorized use that associates a trademark with goods that are not related to the business of the trademark holder.\textsuperscript{24} These shortcomings did not become prominent or relevant until the economic system behind trademark value became more sophisticated and called for trademark holders to be protected as "owners" with property rights.\textsuperscript{25}

B. Evolution of Trademark Law over the Course of the Twentieth Century

During the latter part of the twentieth century, trademark law evolved beyond traditional trademark infringement and broadened trademark owner's rights.\textsuperscript{26} This was a response to the perceived shortcomings of traditional likelihood of confusion trademark infringement and reflected an evolving understanding of the status of property rights, the role of trademarks in marketing, and their economic value.\textsuperscript{27} This section highlights the development of the trademark dilution doctrine and anticybersquatting law and policy, both of which provided the theoretical and statutory basis for Mattel's claims against China Barbie.\textsuperscript{28}

1. Enactment of the FTDA

In 1995, the FTDA was enacted to expand the Lanham Act.\textsuperscript{29} It introduced the theory of trademark dilution and provided additional remedies to trademark owners.\textsuperscript{30} The FTDA defines "dilution" as "the lessening of the

\begin{itemize}
\item \textsuperscript{24} "[T]he unique nature of a mark will be destroyed by companies who trade on the renown of the mark by selling unrelated goods, such as Kodak pianos or Buick aspirin." Mark A. Lemley, The Modern Lanham Act and the Death of Common Sense, 108 YALE L.J. 1687, 1698 (1999).
\item \textsuperscript{25} Id. at 1697. "[T]he economics of trademark law has grown more sophisticated over the last fifty years, but it has not abandoned its roots. The economic rationale for trademarks today is roughly the same as it was a half-century ago." Id. Professor Lemley argues that increasingly "propertizing" trademarks comes at societal costs because it creates "lost opportunities" by suppressing opportunities for "important political and social commentary." Id. at 1696. "Vesting trademarks with the mantle of property—and giving them some of the indicia of real property, such as free transferability—defeats the purpose of linking trademarks to goods in the first place." Id. at 1695-96.
\item \textsuperscript{26} Lemley, supra note 23, at 1695-96.
\item \textsuperscript{27} Id. at 1696-98.
\item \textsuperscript{28} Mattel asserted four causes of action against China Barbie: (1) a common claim for unfair competition; (2) trademark infringement (15 U.S.C. § 1114(a)); (3) trademark dilution under the FTDA (15 U.S.C. § 1125(c)); and (4) violation of the ACPA (15 U.S.C. § 1125(d)). Complaint, supra note 1, at 9-12.
\item \textsuperscript{29} 15 U.S.C. § 1125(c).
\item \textsuperscript{30} Cook, supra note 22, at 231.
\end{itemize}
capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake or deception.”

Trademark dilution can be manifested either through blurring or tarnishment. Dilution through blurring occurs when the public forms a mental connection between the mark and unauthorized use. Confusion regarding the sponsorship of the good or service is not necessary, mere mental connection that weakens the uniqueness of the trademark is sufficient. In contrast, dilution by tarnishment requires an unauthorized use to tarnish or degrade the quality of the mark.

Most notably, the FTDA does not impose a consumer confusion requirement for a claim. Under the FTDA, a trademark is protected from losing its distinctiveness, which effectively protects a trademark from completely unrelated, non-competing goods. Further, Congress did not proffer requirements for how trademark owners may prove dilution, which allows courts a great level of discretion in their decision-making.

Trademark dilution has been criticized as “an expansive notion because it recognizes damage to a trademark holder irrespective of consumer confusion” because of its undefined limits and opponents suggest that it “erodes the foundations of traditional trademark law, which is premised on protecting consumers from confusion as to the source of particular products or services.”

31. 15 U.S.C. § 1127. Trademark dilution theory stems from Frank Schechter’s 1927 article where he asserted a trademark’s value and power derives from its “uniqueness and singularity” and even non-confusing use would “gradually whittle away or disperse… [its] identity and hold upon the public mind of the [trade]mark.” Frank I. Schechter, The Rational Basis of Trademark Protection, 40 HARV. L. REV. 813, 825 (1927). “The more distinctive or unique the mark, the deeper is its impress on the public consciousness, and the greater its need for protection against vitiation of dissociation from the particular product in connection with which it has been used.” Id.


33. Id.

34. Id. at 13.

35. Id. at 12-13.


37. Id.


39. Lipton, supra note 12, at 1335.
2. The Rise of the Internet: The Website Domain Name Registration System and its Intersection with Trademark Law

In the late 1990s, the Internet became an important outlet that allowed businesses to better reach their consumers.\(^40\) A website presence on the Internet provided businesses with a new interactive advertising resource; they could provide detailed information about their goods and services and allow consumers to make purchases online, with decreased transaction costs.\(^41\) The commercial potential of this technology encouraged all businesses to set up their own websites.\(^42\) As businesses have increasingly established their presence on the Internet, the limited number of available domain names, each of which can only be occupied by one website on the Internet, has increased the importance and value of domain names containing trademarked terms.

Businesses aim to ensure that their consumers could reach them in the simplest way possible.\(^43\) Domain names often consist of the name of an individual, a company, or a trademark and function as unique identifiers, similar to a telephone number or street address.\(^44\) Obtaining a domain name is simple and inexpensive: an application must be filed with a domain name registrar; who ensures that the domain name has not been previously registered to another entity; and if the domain name is still available, it is issued—this is easily accomplished over the Internet.\(^45\) Registrars usually require applicants to represent that their registration and subsequent use of a domain name does

\(^{40}\) Donna L. Howard, Note and Comment, Trademarks and Service Marks and Internet Domain Names: Giving ICANN Deference, 33 ARIZ. ST. L.J. 637, 641 (2001).

\(^{41}\) Id. at 641.

\(^{42}\) Id. A review of the Mattel website on January 24, 2008, indicates Mattel's significant Internet presence, including a variety of websites devoted to their different children's products. Moreover, Google search results from the same date returned a number of websites related to Mattel's corporate entity. This presence indicates Mattel's interest in websites that contain their trademarked terms and websites that may be confused as one of their own.

\(^{43}\) Howard, supra note 39, at 641. If a user does not know the domain name of the website he intends to reach, he can use an Internet search engine and type in keywords that would yield hundreds of websites that match the words entered for the user to sort through. See also Panavision Int'l, L.P. v. Toeppen, 141 F.3d 1316, 1319 (9th Cir. 1998); Cook, supra note 22, at 257. "[C]ompanies strongly prefer that their domain name be comprised of the company or brand trademark and the suffix '.com.'" Howard, supra note 39, at 642.

\(^{44}\) See, e.g., Panavision, 141 F. 3d at 1318-19. All websites have domain names which Internet users can easily enter into their web browser to navigate to the website of an individual or company. Id. at 1318.

\(^{45}\) Howard, supra note 39 at 640-41. A domain name is an address that corresponds to only one webpage. Domain names consist of top-level and second-level domain names. Top-level domain names consist of a country code (such as "us" for the United States or "au." for Australia) or signify the type of enterprise the website is involved in, such as "edu" for educational, "org" for non-profit organizations, "gov" for government, "net" for networks, and "mil" for military. The "com" domain name is the most desirable and is used by commercial entities and also "serves as a catchall top-level domain." Second-level domain names are composed of alphanumeric terms or a series of terms. Id. at 639-40. See also supra note 42.
not infringe on a third party's rights and their use is not for unlawful purposes.\textsuperscript{46} However, the large number of applications makes it is impossible for registrars to confirm applicants' representations.\textsuperscript{47} 

As Internet usage by consumers expanded, the economic benefits of an Internet presence has been more broadly recognized.\textsuperscript{48} In turn, the "first-come, first-served"\textsuperscript{49} domain name registration process led to a rush of individuals registering domain names that contained trademarked terms, with the intention to profit through their resale.\textsuperscript{50} Potential buyers who were willing to pay above and beyond the basic registration fee\textsuperscript{51} included trademark owners who wanted domain names containing their trademarked terms, business competitors who aimed to disrupt competition by preventing their competitors from owning particular domain names, or those who aimed to use a particular domain name to confuse consumers and divert them to their own website.\textsuperscript{52} These individuals became known as "cyber pirates" or "cybersquatters."\textsuperscript{53} "Cybersquatting" involves "individuals seeking extortionate profits by reserving Internet domain names that are similar or identical to trademarked names with no intention of using the names in commerce themselves."\textsuperscript{54} 

Under trademark infringement and trademark dilution theories, the law does not provide structured redress to trademark owners for the registration of domain names that contained their trademarks by unauthorized users.\textsuperscript{55} Its reach was limited by how cybersquatters used the domain names; mere registration of a domain name was not a trademark use, which placed the typical cybersquatter outside the scope of the law.\textsuperscript{56} Many plaintiffs argued that registration of a domain name that contained a trademarked term was a new form of trademark dilution.\textsuperscript{57} Trademark dilution through

\begin{itemize}
\item \textsuperscript{46} Id. at 640-41.
\item \textsuperscript{47} Id.
\item \textsuperscript{48} See Marc Lorelli, Note, How Trademark Litigation Over Internet Domain Names Will Change After Section 43(D) of the Lanham Act, 78 U. DET. MERCY L. REV. 97, 102 (2000).
\item \textsuperscript{49} Id.
\item \textsuperscript{50} Howard, supra note 39, at 642; see also Lorelli, supra note 46, at 102.
\item \textsuperscript{51} The typical rate for registration was $100 in 1996. Intermatic, Inc. v. Toeppen, 947 F. Supp. 1227, 1231 (N.D. Ill. 1996).
\item \textsuperscript{52} Howard, supra note 38, at 642; see also Lorelli, supra note 47, at 102.
\item \textsuperscript{53} Id.
\item \textsuperscript{54} H.R REP NO. 106-412, at 6 (1999).
\item \textsuperscript{55} Lorelli, supra note 47, at 102; See also Lockheed v. NSI, 985 F. Supp. 949 (C.D. Cal. 1997), aff'd, 194 F.3d 980 (9th Cir. 1999).
\item \textsuperscript{56} Lorelli, supra note 47, at 102-03.
\item \textsuperscript{57} Cook, supra note 21, at 257. This rationale was premised on the idea that consumers often speculate that the website of a business is the business' proper name with the '.com' attached. If a consumer attempts to retrieve that website and no website appears, the consumer either assumes the business does not maintain an Internet presence or simply gives up trying to locate it. Id. at 257-58. "[T]his diminishes [for the consumers] 'the capacity of the marks to identify and distinguish the
cybersquatting was found in *Intermatic v. Toeppen* and again in *Panavision International, L.P. v. Toeppen*. Both suits involved defendant Dennis Toeppen, who registered two hundred domain names containing famous trademarks, whose use and ownership only blocked their use by others. His intent to profit through this scheme of registration and resale to trademark owners was undisputed. Legislators saw this type of behavior as a threat that "undermine[d] consumer confidence, discourage[d] consumer use of the Internet, and destroy[ed] the value of brand-names and trademarks of American businesses." 

3. The ACPA of 1999: Enactment and Background

In response to Toeppen-like cybersquatting behavior and the concerns of legislators, President Clinton signed into law the ACPA, a new section of the Lanham Act. For a remedy under the ACPA, the plaintiff must demonstrate: (1) that the plaintiff's trademark is distinctive or famous; (2) that the domain name is identical or confusingly similar to that of the trademark owner's; and (3) that the defendant had bad faith intentions when registering. Notably, the ACPA does not apply to "good faith, innocent, or negligent uses of a domain name that is identical or confusingly similar to another's mark or dilutive of a famous mark." This

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59. 141 F.3d at 1316 (9th Cir. 1998).
60. G. PETER ALBERT JR., WHITESEL LAFF & SARET LAFF, INTELLECTUAL PROPERTY LAW IN CYBERSPACE 165 (BNA Books 1999); see also *Intermatic*, 947 F. Supp. 1227, 1232-33; *Panavision*, 141 F.3d at 1319. An example of the unsubstantial websites Toeppen maintained at these domain names was his use of "www.panaflex.com," where the webpage simply displays the word "Hello."
61. "Toeppen's argument misstates his use of the Panavision mark. His use is not as benign as he suggests. Toeppen's 'business' is to register trademarks as domain names and then sell them to the rightful trademark owners. He 'act[s] as a 'spoiler,' preventing Panavision and others from doing business on the Internet under their trademarked names unless they pay his fee.' *Id.* at 621. This is a commercial use. See *Intermatic*, 947 F.Supp. at 1230 (stating that "[o]ne of Toeppen's business objectives is to profit by the resale or licensing of these domain names, presumably to the entities who conduct business under these names.")." *Panavision*, 141 F.3d at 1325. The Ninth Circuit held, "Toeppen traded on the value of Panavision's marks. So long as he held the Internet registrations, he curtailed Panavision's exploitation of the value of its trademarks on the Internet, a value which Toeppen then used when he attempted to sell the Panavision.com domain name to Panavision." *Id.*
reflects the ACPA's responsiveness to Toeppen-like cybersquatting, and it calls for a court to consider the intent of the defendant in his domain name registration, rather than the effect of mere registration. The ACPA also provides two additional "weapons" to trademark owners to protect their trademarks that were previously unavailable: jurisdiction and statutory damages. First, the ACPA provides for in rem jurisdiction against the domain name itself, which alleviates trademark owners' difficulties in locating the domain name's registrant, since many cybersquatters register domain names under aliases and use false information to avoid being identified. Second, in regards to remedies, the ACPA allows a court to award injunctive relief barring the defendant's further use of the domain name, cancellation or transference of the domain name to the plaintiff, actual damages and profits, attorneys' fees, and statutory damages in an amount between $1,000 and $100,000 per domain name. Additionally, the ACPA ensures that the actual bad faith registrants are held accountable for their registration through limited liability for domain name registrars.

Enactment of the ACPA addressed much of the bad faith cybersquatting trademark owners encountered on the Internet. Judge Guido Calabresi of the

Four factors look for the absence of bad faith: (1) the defendant's intellectual property rights in the domain name; (2) the domain name's similarity to the registrant's legal or otherwise identifying name; (3) the registrant's prior commercial use of the domain name; and (4) the registrant's attempts to create a legitimate website at the domain name. Five factors look for conduct that indicates circumstances of bad faith: (1) whether the registrant intended to divert customers away from the trademark owner's website; (2) whether the registrant's behavior imitates cybersquatters; (3) whether the registrant used false information or an alias during domain name registration; (4) whether the registrant's behavior reflects a pattern of acquiring multiple domain names that are similar to or dilutive of other trademarks; and (5) whether the domain name incorporates a mark that is distinctive or famous under the Lanham Act. Id. at 11.

65. Snow, supra note 31, at 3.
67. "A court's power to adjudicate the rights to a given piece of property, including the power to seize and hold it." BLACK'S LAW DICTIONARY 869 (8th ed. 2004).
69. 15 U.S.C. § 1125(d)(2)(D)(i). These remedies are valuable to trademark owners because they ensure the trademark owner receives some monetary reward. "The expense of litigation (and length of the process) made it more attractive for a trademark holder to simply pay up rather than fight as the best one could get at the end of the sometimes arduous litigation process was a transfer of the name. A cybersquatter had very little downside in waiting to wear the trademark holder down through the litigation process. Now, the trademark holder starts the battle armed with the threat of serious monetary damages (at least serious to the typically smaller company or individual who is holding the domain name) available if they litigate and win. The threat is sometimes enough to cause David to throw in the towel much earlier on in a domain name battle with Goliath than under the old rules." Sharton, supra note 62, at 11.
70. Melville, supra note 65, at 327. Registrars, as middle men, are generally immune from monetary damages and can only be subject to injunctive relief if they fail to cooperate with court orders. Id.
71. Barber, supra note 10, at 235.
Second Circuit stated, "the ACPA was passed to remedy the perceived shortcomings of applying the FTDA in cybersquatting cases." With the goal of protecting businesses and promoting the growth of online commerce, the ACPA broadened the scope of trademark property rights by allowing owners to prohibit bad-faith and abusive Internet domain name registration of their distinctive marks with the intent to profit from the goodwill associated with trademarks.

C. Modern Trademark Law and its Intersection with the First Amendment

Recent expansion of the scope of trademark law implicates free speech issues more than ever. This section traces that evolution to reveal a pattern of conflict that contextualizes Mattel’s claim against China Barbie and how it reflects broader curtailment of the public’s free speech rights.

1. First Amendment Rights and Trademark Dilution Theory

To reiterate, unlike a trademark infringement action, a trademark dilution action does not have a likelihood of consumer confusion requirement. Thus, even if use of a trademark is found to be protected by the First Amendment under traditional trademark infringement analysis, that same use may still violate a trademark if examined through a dilution analysis. Generally, under a dilution analysis, unauthorized use of a trademark is permitted as free speech only if one of two conditions is met: that the plaintiff’s trademark was not sufficiently famous to sustain a dilution action, or that the unauthorized use was found to be noncommercial. However, courts have carved out an exception to this rule through their nuanced treatment of unauthorized trademark invocation in the context of book, song, or movie titles.

72. Cook, supra note 22, at 260 (quoting Sporty’s Farm L.L.C. v. Sportsman’s Mkt., Inc., 202 F.3d 489, 496 (2d Cir. 2000)).
73. Cook, supra note 22, at 260.
74. In the traditional trademark infringement context, courts have developed their approach to First Amendment conflict primarily through the lens of conflict with trademark parodies. Generally, courts have taken one of three approaches: (1) adding a parody factor to their analysis under the traditional likelihood of confusion standard; (2) requiring a higher bar for the traditional likelihood of confusion factors when a trademark is invoked as part of some kind of artistic, social, or political message; and (3) applying the traditional likelihood of confusion test first, and then conducting a separate inquiry in the balance between the trademark owner’s rights and the free speech rights of the defendant. These frameworks share a common deference to the public’s First Amendment rights and simultaneously are considerate of trademark owners’ property rights. This reveals that an appropriate balance can be struck between these competing concerns without curtailment of either party’s rights. However, achieving this balance has become increasingly challenging under the FTDA and ACPA because the scope of trademark law has been significantly broadened under these statutes. See supra Part I.B.1.
75. See supra Part I.B.
76. Lipton, supra note 12, at 1338.
77. 15 U.S.C. §§ 1125(c), 1127.
79. Lipton, supra note 12, at 1340-41.
A vivid and relevant example is provided by Judge Alex Kozinski of the Ninth Circuit in his treatment of a trademark infringement and dilution action brought by Mattel against Aqua, a Danish pop music band, for their Top Forty music hit “Barbie Girl” in Mattel, Inc. v. MCA Records. The song consists of a Barbie impersonation in a high-pitched, doll-like voice and another band member, calling himself Ken, enticing Barbie to “go party.” Mattel claimed that the song’s worldwide success affected American foreign commerce and Mattel suffered monetary injury due to those sales. It is evident that Aqua’s song is not only named after Mattel’s Barbie product, but its subject matter is also meant to evoke the imagery of Barbie and her “lifestyle.” Judge Kozinski’s analysis in MCA Records is twofold and addresses both aspects of Aqua’s use of Barbie. First, he considers the use of the term “Barbie” in the title; and second; he considers Barbie’s status in American culture and public discourse.

In regards to the use of “Barbie” in the title of Aqua’s song, Judge Kozinski states,

There is no doubt that MCA uses Mattel’s mark: Barbie is one half of Barbie Girl. But Barbie Girl is the title of a song about Barbie and Ken, a reference that-at least today-can only be to Mattel’s famous couple. We expect a title to describe the underlying work, not to identify the producer, and Barbie Girl does just that.

This characterization and treatment of the title “Barbie Girl” reflects the unique treatment that titles receive in the context of the FTDA and may be relevant to formulate policy for domain names, which are similar to titles of original works: they are descriptive and identify an underlying work. Professor Jacqueline Lipton develops this analogy as follows:

In the case of song, book, and movie titles, the title can describe the underlying work in the sense that it gives some idea of what the title’s audience may expect the work to be about; for example, the “Barbie Girl” song is most likely some kind of commentary on the Barbie Girl doll and/or ideas she connotes within contemporary society. A title can also identify a work for future reference; for example, if you have heard the “Barbie Girl” song on the radio and you think that one of your friends might like to listen to it, you will most likely use the song title to identify the song to your friend. Domain names can also serve both of these functions . . . A domain name can describe an underlying website.

80. Mattel, Inc. v. MCA Records, 296 F.3d 894, 899 (9th Cir. 2002).
81. Id.
82. Id.
83. Id. at 901, 907.
84. Id. at 901.
85. Id. at 900; see also infra Part IIA.
86. MCA Records, 296 F.3d at 901.
87. Lipton, supra note 12, at 1339.
in the sense of giving some idea of what the user might expect to find on
the site . . . A domain name can also identify a relevant website in the
same sense that a book, song, or movie title can identify an underlying
work. This aspect of a domain name practice is unlikely to chance even
if search engines become more sophisticated.\footnote{Id.
at 1339-40.}

Judge Kozinski's analysis of Barbie imagery also suggests another
framework for the merits of Mattel's claims against China Barbie. Since
Barbie has entered "public discourse and become an integral part of our
vocabulary;" her status in American culture is greater than just Mattel's
trademark.\footnote{MCA Records, 296 F.3d at 900; see also infra Part II A.}
He concludes that "Barbie Girl" drew upon Mattel's Barbie as a
cultural icon and "lampoons the Barbie image and comments humorously on
the cultural values she represents. Use of the [trademark] fell within the
noncommercial use exemption to the FTDA, despite the revenue it generated
for Aqua."\footnote{MCA Records, 296 F.3d at 907.}
The court determined the song's value as a work of social
commentary within First Amendment expression outweighed its commercial
value.\footnote{"The commercial success of Barbie Girl establishes beyond dispute that the Barbie
mark" qualifies as a commercial use. \textit{Id.} at 903.}
This nuances the conversation about trademark owner's property
rights and free speech rights and renders the non-commercial use exception to
trademark dilution as flexible to judicial interpretation.\footnote{Lipton, supra note 12, at 1342. For example, see \textit{MCA Records}, 296 F.3d at 905-07.}

2. \textit{Freedom of Speech Under the ACPA}

Historically, conflict between trademark law and free speech has been
minimal because trademark law was developed with a narrow scope and
the limited goal of consumer confusion prevention regarding the sources of
goods and services.\footnote{Robert C. Denicola, supra note 12, at 165; see supra Part IA.}
However, commentators fear that the recent trajectory of trademark property rights, the ACPA included, has turned
trademark law into a much stronger property right than originally
contemplated, which causes tension with free speech.\footnote{This tension has been addressed by legislative discussion:

The [ACPA] is carefully and narrowly tailored, however, to extend only to
cases where the plaintiff can demonstrate that the defendant registered,
trafficked in, or used the offending domain name with bad-faith intent to
profit from the goodwill of a mark belonging to someone else. Thus, the
bill does not extend to innocent domain name registrations by those who are
unaware of another's use of the name, or even to someone who is aware of
the trademark status of the name but registers a domain name containing the
mark for any reason other than with bad faith intent to profit from the
goodwill associated with that mark. Paragraph (1)(B) of the new section
43(d) sets forth a number of nonexclusive, nonexhaustive factors to assist a}

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mark for any reason other than with bad faith intent to profit from the
goodwill associated with that mark. Paragraph (1)(B) of the new section
43(d) sets forth a number of nonexclusive, nonexhaustive factors to assist a}
that the ACPA “effects a complete appropriation” of a registrant’s domain name based solely on intent. They further claim that it “infringes free speech rights, overlooks small business and individual interests, and lacks international scope.”

In particular, the domain name registration system and the ACPA poorly protect First Amendment rights of free speech due to an inherent failure to balance speech and commercial trademark interests. Some of this conflict can be attributed to the ACPA’s relatively recent enactment and confusion regarding the appropriate scope of its reach and application of its principles. Namely, there has been confusion regarding precisely what is meant by “bad faith” domain name registration and ambiguity regarding whether a showing of commercial use of the trademark by the allegedly cybersquatting defendant is necessary.

Overzealous application of the ACPA in domain name regulation risks chilling Internet free speech. This concern has also been expressed judicially, Judge David Doty of the District Court of Minnesota comments that,

[w]hile the public interest clearly demands that the Internet be used responsibly and in conformance with intellectual property laws, the right of defendant[s] to openly express [their] viewpoint[s] should likewise not be curtailed absent clearer demonstration that the claims against [them] have merit . . . Public policy requires that the preliminary injunctions, especially those that stand to potentially chill a person’s right to free speech, no matter how disagreeable that speech may be, should only be granted in the most extraordinary of circumstances.


96. Snow, supra note 30, at 46 (noting the unconstitutionality of the ACPA’s appropriation of domain names under the takings clause); Lipton, supra note 12, at 1327 (discussing free speech and domain name policing).

97. Melville, supra note 65, at 327 (2000); see also id. at 327 n.40.

98. S. REP. NO. 106-140, at 8; see generally Lipton, supra note 12.

99. Lipton, supra note 12, at 1352.

100. Id. at 1349-50.

101. Id. at 1352.

This suggests that case by case application of the ACPA must be monitored in order to understand the requirements for a successful claim and monitor when the ACPA infringes upon First Amendment principles.

III. Mattel’s Barbie Doll: A Litigious Icon

It is important to understand the iconic status of Mattel’s Barbie doll product in order to place the China Barbie lawsuit within the context of Barbie doll’s litigious history. Part A will discuss Mattel’s Barbie doll as one of the most successful globally branded children’s products in history. Part B will then discuss how Mattel’s history of trademark claims has interacted with First Amendment principles. Finally, Part C will link this past pattern of trademark litigation to the context of the Internet and claims under the ACPA.

A. Barbie: A Global Icon Fifty Years in the Making

Mattel’s Barbie doll is more than just a trademarked toy produced for child consumption—Barbie has entered public discourse and become a cultural phenomenon. Her public image has been crafted, refined, and protected by Mattel’s marketing, development, and legal departments for nearly fifty years, with significant economic implications—Barbie is the best selling toy doll in the world. In 2003, the Ninth Circuit cited that Barbie has been referred to as "possibly the most famous toy in history and characterized the doll as "phenomenally successful from the moment of its

103. Highlighting the importance of such a phenomenon, Rogers argues:

In some people's minds and in some theoretical models, cultural icons like Barbie represent the lowest common denominators of mass culture. By now, though, researchers have documented the rich, multifaceted character of cultural icons. No icon represents only one dimension or axis of a culture. Instead, icons become such because of their versatility, thick folds of meaning, adaptability to diverse individuals' needs or interests, ultimate ambiguity, and open-ended nature. In a sense then, a cultural icon is paradoxical. At one and the same it evokes commonality and difference. It offers a shared point of reference for society's members while adapting itself to the cultural differences built up among them.

Mary F. Rogers, BARBIE CULTURE 2-3 (Sage Publications, 1999).

104. See generally supra note 9 for a historical overviews of the product's development, marketing, and litigation history.

105. Miss Am. Org. v. Mattel, Inc., 945 F.2d 536, 537 (2d Cir. 1991). In 1990, twenty-six million Barbie dolls were sold, earning gross revenues for Mattel of $740 million. Id. Ninety-six percent of American three to eleven year old girls own at least one Barbie doll. Id. As of 2003, Barbie was sold in one hundred fifty countries, with world-wide wholesale revenues in excess of over $2 billion each year. Mattel, Inc. v. Greiner and Hauser GmbH ("Greiner"), 354 F.3d 857, 858-60 (9th Cir. 2003). Worldwide, two Barbie dolls are sold each second. Steven C. Dublin, Who's that Girl? The World of Barbie Deconstructed, in THE BARBIE CHRONICLES: A LIVING DOLL TURNS FORTY, supra note 9, at 19.
introduction;"106 she is more than just a doll, Barbie has become a public figure and cultural icon. Mattel has "bec[o]me the world's largest toy maker, with Barbie as its flagship product line."107 Therefore, it is only appropriate for Mattel to protect Barbie's image from any attempts to besmirch her reputation, which could detract from Barbie's value as a children's product.

In addition to Barbie's epic status and economic value in the children's toy market, she has taken on additional meanings and status at a societal level.108 As Judge Kozinski so aptly wrote, "[w]ith fame often comes unwanted attention."109 She is "an icon and a fetish—to some angelic to others depraved" and she has inspired artists, writers, and academics from a variety of fields in a way that suggests she is more than just a child's toy.110 "Barbie has become an unmistakable reference point in our world,"111

[she] 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). She remains a symbol of American girlhood, a public figure who graces the aisles of toy stores throughout the country and beyond. With Barbie, Mattel created not just a toy but a cultural icon.112

B. The Clash Between Barbie and the First Amendment

As Barbie achieved iconic status, she also became a frequent visitor to American courtrooms as the subject of various intellectual property disputes.113 Many of these disputes invoked the unauthorized use of Barbie

106. Greiner, 354 F.3d at 860.
107. Id. at 861.
109. MCA Records, 296 F.3d at 899.
110. Introduction, THE BARBIE CHRONICLES: A LIVING DOLL TURNS FORTY, supra note 9, at 14. "Barbie, and all the associates she has acquired through Mattel's impressive marketing success, conveys... messages [about society, gender roles, sexuality, and perhaps even social class] in a particular way that is ripe for social comment." Mattel, Inc. v. Walking Mountain Productions ("Walking Mountain Productions"), 353 F.3d 792, 802 (9th Cir. 2003). Through Barbie imagery, artists and social commentators have explored gender, sexuality, race, and body image. See THE BARBIE CHRONICLES: A LIVING DOLL TURNS FORTY, supra note 9, 37-38, 53, 60, 131.
111. Dublin, supra note 104, at 36.
112. MCA Records, 296 F.3d at 898.
113. Greiner, 354 F.3d 857 at 859; "After nearly 50 makeovers, she is a public figure and a cultural icon. She's also controversial and very litigious." James B. Astrachan, Commentary: Court calls Mattel's copyright suit frivolous, DAILY RECORD (BALTIMORE), July 2, 2004, available at http://findarticles.com/p/articles/mi_qn4183/is_20040702/ai_n10062674/print; see generally Miss America Ofg., 945 F.2d at 538 (a new line of Miss America fashion dolls manufactured in China were ordered detained by Mattel because they allegedly copied Barbie doll's face. Miss America sued for an
and her imagery in social commentary, which implicated free speech. Traditionally, exclusive trademark rights are justified by a creator's investment in the exclusive right to these ideas. This controlled usage rationale stems from "tragedy of the commons" theory, which aims to create incentives for the efficient exploitation of ideas and prevention of their overuse. Professors William Landes and Richard Posner elaborate and suggest that consumers "desire uniformity in their cultural icons" and allowing an idea to enter the public domain in a variety of contexts, would reduce its consumer value.

If we permit portrayals of Mickey Mouse as a drug dealer, or Barbie as a porn star, or Scarlet O'Hara abusing her slaves, these countercultural works will somehow infect the wholesome nature of the icon, ruining it for everyone else... the creation of unauthorized works may have a demand-reducing effect on all works based on the original, overwhelming what ... is a positive economic effect from reducing price and expanding the potential market.

This debate involves not just who captures the economic value associated with an icon, but also who controls its meaning at a societal level. Judge Kozinski positions Barbie's crossover into epic and iconic status as follows:

[t]rademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions. Once imbued with such expressive value, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law... Were we to ignore the expressive value that

injunction to prevent Mattel from interfering with the importation and sale of these dolls in the United States;); Mattel, Inc v. Goldberger Doll Mfg., 200 F. Supp. 517 (E.D.N.Y. 1961) (claiming defendant's "Babette doll" was confusingly similar to its trademark Barbie); MCA Records, 296 F.3d at 894 (Mattel brought suit for trademark infringement and dilution against Danish band, Aqua, for their song "Barbie Girl."); Walking Mountain Productions, 353 F.3d at 796-97 (Mattel sued a photographer who creates artwork with social and political overtones for copyright, trademark, and trade dress infringement for his "Food Chain Barbie" series of photographs, which depicts Barbie in "various absurd and often sexualized positions.").

114. See supra note 111.
115. Lemley, supra note 11, at 129.
116. "The "tragedy of the commons" theory espouses that resources that are commonly owned and generally available will be overused, depleted and then exhausted. Observance of the social phenomenon, currently most often applied to evolutionary, developmental, and behavioral biology, can be traced to Aristotle, although Garret Hardin popularized the theory in 1968. Susanna Chenette, Maintaining the Constitutionality of the Patent System, 35 HASTINGS CONST. L.Q. 221, 253 n. 203 (2008). See Garret Hardin, The Tragedy of the Commons, 162 SCIENCE 1243 (1968)
117. Lemley, supra note 11, at 141-42.
118. Id. at 145 (citing William M. Landes & Richard A. Posner, Indefinitely Renewable Copyright, 70 U. CHI. L. REV. 471 (2003)).
119. Id.
some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment . . . Simply put, the trademark owner does not have the right to control public discourse whenever the public imbuces his mark with a meaning beyond its source-identifying function.\textsuperscript{211}

Direct conflict exists between Mattel’s interest in controlling usage of its Barbie doll product and the public’s interest in manipulating the Barbie image to produce new meanings for the larger cultural discourse.\textsuperscript{122} Professor Lemley suggests that courts have increasingly deferred to the property rights of trademark owners, without considering the broader social costs of such protection.\textsuperscript{123} However, courts have balanced Mattel’s trademark property rights and the public’s free speech rights in a way that protects the public’s freedom to comment on Barbie’s status in popular culture and invoke her iconic image; although the status of this freedom in the context of the Internet and the website domain name system remains to be clarified.\textsuperscript{124}

Judge Kozinski held in favor of Aqua’s use of the term “Barbie” in the title of their song “Barbie Girl,” as well as use of Barbie imagery in the song’s content because of Barbie’s status as a cultural icon.\textsuperscript{125} The Court recognized the importance of Barbie in public discourse, which was beyond the control of Mattel and its property rights over its Barbie doll trademark.\textsuperscript{126} If these conclusions were translated to the Internet context, the term “Barbie” would be available for use by domain name registrants to evoke Barbie imagery as part of a larger public discourse.

Similarly, in \emph{Mattel Inc. v. Walking Mountain Productions},\textsuperscript{127} the Court allowed artistic creativity and free speech that evoked Barbie to trump Mattel’s copyright and trademark violation claims.\textsuperscript{128} Thomas Forsythe, the defendant-photographer, developed a series of photographs entitled “Food Chain Barbie” depicting Barbie in various absurd and sexualized positions; the word “Barbie” was even used in some of the titles.\textsuperscript{129} Mattel brought copyright, trademark, and trademark infringement violation claims in response.\textsuperscript{130} Forsythe defended his use of Barbie as an attempt to use Barbie to critique the objectification of women and condemn the “conventional beauty myth” and “societal acceptance of

\begin{itemize}
\item $121. \textit{MCA Records}, 296 F.3d 894 at 900.$
\item $122. \textit{Justin Hughes, “Recoding” Intellectual Property and Overlooked Audience Interests, 77 TEX. L. REV. 923, 940-41 (1999).}$
\item $123. \textit{Lemley, supra note 23, at 1697.}$
\item $124. \textit{See discussion supra Part IIB.}$
\item $125. \textit{MCA Records}, 296 F.3d 894 at 898.$
\item $126. \textit{Id. at 900.}$
\item $127. 353 F.3d 792 (9th Cir. 2003).$
\item $128. \textit{Id. at 807.}$
\item $129. \textit{Id. at 796.}$
\item $130. \textit{Id.}$
\end{itemize}
women as objects." He described the role of Barbie in societal discourse: "Barbie is the most enduring of those products that feeds on the insecurities of our beauty and perfection-obsessed consumer culture." The Ninth Circuit concluded that Forsythe’s work was a parody and social commentary of Barbie and highly transformative—therefore, his use of Mattel’s Barbie doll did not violate Mattel’s property rights in the Barbie image. Application of these principles to the Internet context would suggest that as long as unauthorized use of Barbie diverged enough from the context of Mattel’s Barbie as a children’s toy, it would be protected under free speech.

In Mattel, Inc. v. Pitt, Mattel brought copyright and trademark infringement claims against Susanne Pitt, for her production and sale of “Dungeon Doll,” a product that was a repainted and re-costumed version of Barbie. Pitt also maintained an Internet website, which depicted Dungeon Doll in sexually explicit stories and offered sexual paraphernalia for sale. She claimed that she wanted to comment on the sexual nature of Barbie by using “customized Barbie figures in sadomasochistic costume and/or storylines” to “‘resurrect’ (sic) the original idea of the female figure she claims inspired Barbie: a German ‘adult cartoon’ character called ‘Lilli’ of ‘easy virtue...[d]efinitely not a childrens [sic] toy.’” She asserted that a sexualized nature was inherent to the doll, which she only highlighted through its placement in a “modern erotic context.” The Court refused to rule in Mattel’s favor at summary judgment because “[t]he sale or display of ‘adult’ dolls does not appear to be a use Mattel would likely develop or license others to develop.” This illustrates that unauthorized Barbie imagery that departs significantly from the Barbie image Mattel endeavors to maintain is possible without impinging on Mattel’s trademark property rights.

131. Id.
132. Id.
133. Id. at 804.
135. Id. at 318. She also used Mattel’s “Superstar Barbie” for the head of her dolls. Id.
136. Id.
137. Id. at 322. Ironically, Barbie’s origins lie in the German Bild Lilli doll, which has been described as “a lascivious plaything for adult men,” based on a postwar comic character who appeared in the Bild Zeitung, a downscale German newspaper similar to America’s National Enquirer.” “The doll, sold principally in tobacco shops, was marketed as a sort of three-dimensional pinup. In her cartoon incarnation, Lilli was not merely a doxie, she was a German doxie—an ice-blond, pixie-nosed specimen of an Aryan ideal—who may have known hardship during the war, but as long as there were men with checkbooks, was not going to suffer again.” M. G. Lord, FOREVER BARBIE: THE UNAUTHORIZED BIOGRAPHY OF A REAL DOLL 7; see also MCA Records, 296 F.3d at 898.
139. Id. at 324. No opinion on the further merits of this case was ever issued.
C. The Barbie Trademark on the Internet

Courts have given a great amount of deference to the public's free speech rights in the face of Mattel's repeated trademark infringement and dilution claims. More recently, Mattel has expanded the scope of its litigiousness to protecting Barbie from alleged trademark violators in cyberspace. The courts' historic trajectory of prioritizing free speech rights leads to the expectation that similar deference would exist in the Internet context, precisely what the legal community excepted when the China Barbie complaint was filed. However, courts have not been nearly as deferential in the context of websites and domain name registration.

Mattel's ACPA trademark claim against China Barbie's website domain name is only Mattel's most recent effort to control Barbie's public image, despite the disconnect between China Barbie's use of the term "Barbie" and the scope of Mattel's property rights.

In Mattel, Inc. v. Jcom, prior to enactment of the ACPA, Mattel brought a trademark dilution claim asserting that the Barbie trademark was diluted by the adult services website maintained by the defendant under the name "Barbie's Playhouse." The website was designed with a teleconferencing feature with a female model engaging in sexually explicit behavior that was available to customers for a per minute fee. Judge Sonia Sotomayor of the Second Circuit concluded that the model performing these services may not have intended to trade on the goodwill of Mattel's trademark. However, by the time the website was functional and available to consumers, the intent to evoke Mattel's trademarked product was present.

The font in which B[arbie] was set forth on the Web site is almost indiscernible from the font Mattel uses in connection with the sale of B[arbie] dolls. The differences can only be seen when one puts them side by side. The fonts are so similar that anyone looking at them would

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140. In addition to the domain name disputes highlighted below, Mattel has also brought actions against an online swimwear retailer for the domain names www.barbiesbeachwear.com and barbiesclothing.com. (Mattel, Inc. v. Adventure Apparel, 2001 WL 1035140 at *1 (S.D.N.Y. 2001)); against a series of fifty seven domain names that evoked a variety of Mattel's trademarked toys including www.barbie-club.com and www.princessbarbie.com (Mattel, Inc. v. Barbie-Club.com, 310 F.3d 293, 295 (2d Cir. 2002)); and the domain name www.barbieshop.com, which was the Internet presence of an adult retail store located in Canada, owned by Barbara Anderson a/k/a Barbie Walley (Mattel, Inc. v. Barbara Anderson, 2005 WL 1690528 at *1 (S.D.N.Y 2005).

141. See supra note 6.

142. See infra Part IIIC.


144. Id. at 1468. The exact website URL was http://www.jcomlive.com/barbie.htm. Id.

145. Id. at 1468-69.

146. Id. at 1469.
automatically think that defendants chose their font to copy Mattel’s B[arbie] trademark. The use of the word ‘playhouse’ with the word ‘Barbie’ could have only been linked in [the defendant’s] mind to Mattel’s product, despite his statements to the contrary.\textsuperscript{147}

Judge Sotomayor enjoined Jcom from further dilution of the Mattel Barbie trademark and use of the mark “Barbie’s Playhouse.”\textsuperscript{148} In \textit{Mattel, Inc. v. Jcom}, it seems that the Court’s decision turned on more than just the defendant’s use of the word “Barbie,” but rather on the website's look and feel, including use of Mattel’s trademarked signature Barbie font. In contrast, China Barbie only utilized the word “Barbie” in her domain name,\textsuperscript{149} which was identical to the stage name she continues to utilize.\textsuperscript{150}

In \textit{Mattel, Inc. v. Internet Dimensions},\textsuperscript{151} Mattel brought a similar suit against an adult entertainment website maintained at www.barbiesplaypen.com after ACPA enactment.\textsuperscript{152} The website’s front page featured the word “Barbie” in “approximately the same font” as Mattel’s signature Barbie font.\textsuperscript{153} Judge Harold Baer of the Southern District of New York awarded Mattel ownership of the domain name and ruled that the defendant intended to profit by associating its site name with the Mattel dolls.\textsuperscript{154} He wrote,

The Barbie dolls, with their long blond hair and anatomically improbable dimensions are ostensibly intended to portray wholesomeness to young girls. The ‘models’ on the barbiesplaypen.com site, although many have long hair and anatomically improbable dimensions, can in no way be described as engaging in ‘wholesome’ activities.”\textsuperscript{155}

He continued, “The obvious intent of the defendants is to cash in on the favorable public image of the Barbie doll, including the image of a particular kind of feminine appearance and character.”\textsuperscript{156}

Similar to \textit{Mattel, Inc. v. Jcom}, the defendant’s action in \textit{Mattel, Inc. v. Internet Dimensions} illustrated an intent to evoke more than just the idea of “Barbie.”\textsuperscript{157} The models were meant to appear as real life Barbie dolls and the look and feel of the website also evoked Mattel’s Barbie and the concept of

\textsuperscript{147} Id.
\textsuperscript{148} Id. at 1471.
\textsuperscript{150} See infra note 183 and accompanying text.
\textsuperscript{151} 2000 WL 973745 (S.D.N.Y. 2000).
\textsuperscript{152} Id. at *1.
\textsuperscript{153} Id. at *3.
\textsuperscript{154} Id. at *4-6.
\textsuperscript{155} Id. at *8.
\textsuperscript{156} Id.
\textsuperscript{157} Id. at *8.
In contrast, China Barbie did not aim to evoke the look and feel of Mattel's trademarks, nor does she attempt to evoke a real life Barbie doll. This suggests that Mattel's suit against China Barbie would not have been successful if tried on its merits. However, due to China Barbie's default, the suit was fairly uneventful. This history of domain name litigation against adult services websites, in addition to a more generalized history of Mattel's trademark litigation, puts China Barbie into perspective as a continuation of Mattel's litigious history aiming to ensure Barbie's value is not eroded as a child's toy.

IV. Barbie and the ACPA's Overprotection of Trademark Property Rights

The paradigm of Mattel's Barbie doll and litigation involving the Internet illustrates that trademark owners' property interests should not be given priority over the public's free speech rights. Part A will argue that "Barbie" actually evokes two distinct ideas: a trademarked product and a cultural icon in public discourse that is separate from Mattel's trademark. Then, Part B will evaluate how courts have applied the ACPA in cases involving Barbie, and will subsequently argue that the ACPA was enacted to apply to a much narrower scope of circumstances that does not include the types of claims that have been brought forth by Mattel. Part C will question the productivity of pursuing lawsuits like that against China Barbie. Finally, Part D will present a possible alternative framework for analyzing domain name disputes.

A. Barbie's Dual Status as a Trademarked Product and Cultural Icon

Barbie has become integral in American popular culture, suggesting that the trajectory of Mattel's trademark rights to Barbie should be considered distinct from the concept of Barbie in public discourse. This is best understood by separating the idea of Barbie into two distinct roles: It is a trademarked Mattel children's product and a cultural icon that has evolved through public discourse and manipulation. This is at the heart of the tension between trademark property rights and free speech regarding Barbie.

158. Id.
159. Accompanying the New York Post's article about Mattel's complaint against China Barbie the Post also published a chart that compares Barbie doll and China Barbie's measurements and statistics. See Gittens, supra note 149.
161. “Not only important legal issues but also high economic stakes are packaged in these petite plastic figures.” Miss Am. Org., 945 F.2d at 537.
Trademarks, like other words and symbols, aim to enter society’s “common vocabulary” to accumulate connotations and associations. However, if a trademark’s entry into common vocabulary goes too far, it leads to the “death” of the trademark and its original denotation, imposing significant costs on the trademark owner. In contrast, increased “propertizing” of trademarks, beyond advertising mechanisms to sell products, may impose significant social costs, including curtailment of free speech. Over-propertizing is exemplified by Mattel’s litigiousness with its Barbie trademark, as represented by the numerous trademark suits it has undertaken to prevent the use of Barbie in unauthorized contexts.

Professor Yochai Benkler describes Barbie’s “dual role” as it relates to her Internet presence in The Wealth of Networks: How Social Production Transforms Markets and Freedom, where he conducted a simple Internet search for “Barbie” using Google. His search returned results ranging from Mattel’s official website and the official collectors’ website, to AdiosBarbie.com (a website that is critical of Barbie), a Barbie and Ken sex animation, and Barbie dressed as a suicide bomber. Based on these results he reasons,

A nine-year-old girl searching Google for Barbie will quite quickly find links to AdiosBarbie.com, to the Barbie Liberation Organization (BLO), and to other, similarly critical sites interspersed among those dedicated to selling and playing with the doll. The contested nature of the doll becomes publicly and everywhere apparent, liberated from the confines of feminist-criticism symposia and undergraduate courses. This simple Web search represents both of the core contributions of the networked information economy. First, from the perspective of the searching girl, it represents a new transparency of cultural symbols. Second, from the perspective of the participants in AdiosBarbie or the BLO, the girl’s use of their site completes their own quest to participate in making the cultural meaning of Barbie.

Courts have also generally recognized this “dual role” and have flexibly applied trademark law to ensure that Barbie’s position in popular culture and its associated trajectory remains separate and distinct from Mattel’s property interest in its children’s product. One legal scholar notes, “modern expression frequently requires the use of trademarks in

163. Id.
164. Lemley, supra note 23, at 1593, 1697.
165. See supra Part IIB.
167. Benkler, supra note 170, at 277.
168. See supra Part IIB-C.
their role as social referents, whether or not the product itself is being discussed directly.\textsuperscript{169} This is precisely the idea Judge Kozinski struggled with in \textit{Mattel, Inc. v. MCA Records}:

\begin{quote}
Were we to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment. . . . \textit{[T]rademark owner[s] [do] not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source identifying function.}\textsuperscript{170}
\end{quote}

\textbf{B. Barbie's Dual Status Creates Tension in ACPA Enforcement}

While it seems that all the conflicting ideas residing within Professor Benkler's Google search results can coexist, their contradictory nature pose a number of complications when applied to domain name enforcement on the Internet. First Amendment commentators remain concerned that Internet regulation threatens freedom of speech, "[m]ore regulability means more constraints, which by definition, means less freedom, as freedom is reasonably constructed as an absence of constraint."\textsuperscript{171} Most Internet litigation that calls for the inclusion and consideration of trademark law involves domain name disputes under the ACPA,\textsuperscript{172} which makes it increasingly important to balance trademark protection in regards to domain names and First Amendment principles appropriately. Professor Lemley identifies the risks of failure to strike an appropriate balance by arguing that cybersquatting precedent provides a foundation to take domain names away from "legitimate users," including individuals who want to register their last names as their website domains and those who want to create a "gripe site" as a forum to discuss a product or business.\textsuperscript{173} Domain names are unique and cannot be simultaneously shared by multiple parties. Furthermore, businesses have an interest in ensuring easy and efficient access to their Internet presence.\textsuperscript{174} Therefore, an implicit policy decision is made that fails to accommodate free speech in enforcement of the Internet domain name system because higher priority is awarded to the protection of trademark owners from the threats of cybersquatters, as exemplified by Mattel's claim against China Barbie.

Mattel's litigation against domain names that include the term Barbie, particularly websites that provide adult entertainment services, is an especially troubling case for this discussion. Cultural critics note that

\begin{itemize}
\item \textsuperscript{169} Lemley, \textit{supra} note 23 at 1711.
\item \textsuperscript{170} \textit{MCA Records}, 296 F.3d at 900.
\item \textsuperscript{172} Lemley, \textit{supra} note 23, at 1703.
\item \textsuperscript{173} \textit{Id.}
\item \textsuperscript{174} See \textit{supra} Part IB2.
\end{itemize}
Barbie represents a perfectly plastic blonde with exaggerated female body proportions and has entered our public discourse as a sexual icon. Courts have discussed and recognized this iconic status generally in trademark litigation, but have been much more hesitant in the Internet context under the ACPA. Moreover, the use of a Barbie domain name for pornographic purposes raises even more complex issues, as it seems that this type of activity has been pre-condemned by the legislative bodies. The House of Representatives' Report on the Trademark Cyberpiracy Prevention Act of 1999 clearly states in the "Purpose and Summary" section that the posting of pornographic materials by cybersquatters is particularly egregious, as it effectively increases the likelihood that cybersquatters will collect ransom by damaging the integrity of the mark. However, this statement assumes that any posting of pornographic materials on a confusingly similar domain name was done with purposeful bad faith and the intent of cybersquatting.

Upon analysis of the ACPA and consideration of this conflict, it is clear that the statute has little practical applicability outside of the context of true cybersquatting, even though the statute has spawned many more general claims for domain name ownership. The ACPA was initially designed to make up for the "perceived shortcomings" of the FTDA in the cybersquatting context to provide additional protection for trademark owner's property and to eliminate cybersquatters from reserving domain names and preventing businesses from registering their own Internet presence and profiting from the trademark owner's "good will" and need to establish itself according to its true name through reselling the domain name to them. Therefore, though the legislative intent in enacting the ACPA was to limit its applicability to bad faith registration, the meaning of bad faith registration needs to be further clarified in order to prevent unnecessary taking of domain names from registrants who did not intend to infringe on the trademark owner's goodwill.

However, Mattel, Inc. v. Global China Networks indicates that some trademark owners have brought ACPA claims where no true cybersquatting occurred, but trademarked terms were merely included in the domain name.

175. Mattel has not been oblivious, retired Mattel toy designer Joe Cannizzaro has been quoted as saying, "I think if you look at the silhouette of the Playboy Bunny, it looks like a Barbie doll . . . So do men want to date a Barbie doll? Probably. But do men notice it? Only if shown. They wouldn't go looking for it." M. G. Lord, supra note 9, at 200.
176. See Pitt, 229 F. Supp.2d at 315; Greiner, 354 F.3d at 857; Walking Mountain Productions, 353 F.3d at 792.
177. See supra Part II.C.
179. Cook, supra note 22, at 257.
180. Kindel, supra note 18, at 2114.
This is problematic because it effectively deprives domain name owners of their free speech rights.181 Mattel’s goal was to ensure that no one else operated a website at this domain name, but Mattel never expressed intent to maintain a website of its own at the domain name. This is particularly troubling for the context of China Barbie’s use of the term “Barbie,” because the term has passed into “public discourse”182 and has many more connotations and layers of meaning that beyond Mattel’s trademark property rights.183

C. Was Mattel, Inc. v. Global China Networks Productive Litigation?

It is unclear what Mattel accomplished by bringing suit against China Barbie. Following her failure to answer the complaint and the default judgment, China Barbie’s domain name has been transferred to Mattel.184 However, she continues to call herself China Barbie, and has developed another moniker, “China B.”185 Her MySpace.com homepage is still registered under the pseudonym “China Barbie,” though she has transferred her website to www.brownandready.com.186 Ironically, as of December 2007, her Brown and Ready MySpace homepage continued to state the following in “About me” section, “I am China B(arbie).”187 Through the clever use of parentheses she continues to use her moniker, perhaps hopefully in an attempt to not turn up in a general Google search for the term.188

In effect, Mattel’s suit has not prevented her from continuing to use this pseudonym, but actually brought her services more attention, “[China] Barbie said that her site usually gets about 100 views a day, but [the day after this suit was filed] it received more than 100,000.”189 This suggests that even though Mattel had a legal victory through default in this case, the law did not actually serve its purpose. Filing this lawsuit did not eliminate the Internet presence of China Barbie; instead the

182. MCA Records, 296 F.3d at 900.
183. See supra Part II.A.
186. Id.
187. Id. (Screenshots of December 2007 page available from author upon request.) Though her MySpace no longer states this claim, as of September 2008, her MySpace page continue to state in various contexts that this was a “China B Studios” Production.
188. China Barbie’s MySpace Page was one of the top items that returned from a Google search using the terms “China Barbie” in December 2007 despite this effort. Other results consisted of material created by China Barbie hosted by other websites; references to this lawsuit; and news reports regarding Mattel’s defectively manufactured Chinese toys.
189. Gittens, supra note 6.
lawsuit increased her popularity. Moreover, the Court’s decision has not stopped her from going by the alias “China Barbie,” she just merely relocated her website to a new domain name. The ACPA did not only fail Mattel, the trademark owner in this case, but it generally fails to remedy trademark owners’ concerns. In its present form, the ACPA requires trademark owners to track down infringing domain names one-by-one. This piecemeal approach does not allow a trademark owner, or courts, to develop a broader comprehensive policy for this type of behavior. Therefore, not only do the ACPA and its enforcement threaten the public’s First Amendment principles, but it also fails to accomplish its stated purpose on behalf of trademark owners. Without clearer guidance from the legislature or courts, the ACPA will continue to remain ineffective.

D. An Alternative Framework for Analyzing Domain Name Property Rights

An alternative approach emerges if domain names were viewed as signifiers that identify the underlying work, much like a book, song, or movie titles conveys the content of the work. For example, in the context of parody and gripe websites, the inclusion of trademarked terms in domain names is perceived as a signifier of the content of the website contains for individuals who encounter it. The test courts have applied in the context of book, song, and movie titles, as exemplified by Judge Kozinski’s approach and discussed above, is probably the best example for how trademark owners’ property rights and the public’s free speech rights may be balanced more effectively in the domain name registration system. There is no dispute that the song’s use of the Barbie image was commercially successful, but Judge Kozinski looked to the legislative history of the trademark dilution act and concluded that constitutionally protected speech was an exception to its applicability. The “Barbie Girl” song title did not constitute a trademark infringement or dilution because the title signified that the song commented on Barbie’s image in society. The Court focuses in on the fact that it is unlikely that Aqua’s use of the term Barbie would confuse consumers as to the source of the product or dilute Mattel’s trademark because its use was for expressive purposes.

191. Id.
192. Lipton, supra note 12, at 1340.
193. Id.
194. Id.
195. MCA Records, 296 F.3d at 903, 905.
196. Lipton, supra note 12, at 1340-41.
197. MCA Records, 296 F.3d at 899-900.
Applying these principles to domain names containing the term Barbie, suggests that none of Mattel’s trademark property interests are violated. As determined in the Southern District of New York in the context of the “Dungeon Doll” product, invoking Barbie in a sexual context that is out of character from Mattel’s use is highly “transformative.”

Through hosting her adult entertainment website at www.chinabarbie.com, China Barbie’s use of the term “Barbie” plays on the popular imagery Barbie has come to evoke similar to many artists and writers in the past. As China Barbie clearly pointed out in an interview with the *New York Post*, “I’m not marketing myself to children, in any way shape or form.”

V. Conclusion

Barbie, both a successful children’s toy and cultural icon with many layers of meaning, creates a truly unique paradigm through which to analyze the appropriateness of the scope of newly developed trademark property rights and the public’s free speech rights. Courts have successfully balanced these interests under trademark dilution theory, but have not been nearly as successful in the context of the Internet. The Internet provides new frontiers for communication, consumerism, and the balancing act between intellectual property and the First Amendment. The Internet domain name system and the ACPA are not responsive its evolving and changing nature and should be revised with a deeper understanding of the First Amendment and the expressive nature of a domain name, much like a song, book, or movie title. Otherwise, smaller domain name owners will continue to lose their domain name rights to larger, monopolistic trademark owners.
