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MATTEL INC. V. WALKING MOUNTAIN PRODUCTIONS*353 F.3d 792 (9th Cir. 2003)*

The Ninth Circuit held that the defendant's series of photographs featuring Mattel Barbie dolls in provocative settings were a fair use of copyrighted material and qualified as nominative fair use of trade dress.

Thomas Forsythe, an artist known for photographs with social and political overtones, created a series of photographs, "Food Chain Barbie," depicting Barbie in unusual and sometimes sexual poses. The pictures featured Barbie in dangerous situations involving kitchen appliances and food, and often included nude dolls. Following limited display of the work at two art festivals, on postcards and business cards, and on the web, Mattel filed suit, alleging that the series infringed its copyrights, trademarks, and trade dress.

The district court granted Forsythe summary judgment on the grounds that Forsythe's pictures were fair use. The Ninth Circuit affirmed, finding that the pictures were a fair use of copyrighted material, that the public interest in expression outweighed any consumer confusion from the use of the Barbie trademark, and that the use of trade dress was nominative fair use.

On the issue of copyright infringement, the court balanced the four fair use factors codified at 17 U.S.C. § 107—purpose and character of the use, nature of the copyrighted work, amount and substantiality of the portion used, and effect of the use upon the potential market—and for each factor found that the facts favored fair use. The purpose of the photographs could reasonably be perceived as parody, and this type of critique is protected by the First Amendment and supported by the Copyright Act. Forsythe's commercial interest in the photographs weighed only slightly against fair use. While Barbie's figure and face "can fairly be said to be a creative work," the nature of the copyrighted work is less important when the use is for parody. The amount copied was justifiable in light of the artist's parodic purpose and medium, and Mattel was unlikely to develop or license a market for similar "adult" uses of the Barbie image.

As to the trademark infringement claim, the court applied the *Rogers* test, which balances the public interest in free artistic expression with the potential for consumer confusion, and found that the use of the Barbie trademark had the requisite artistic relevance to Forsythe's work to trigger First Amendment protection. The court also found that Forsythe satisfied the three elements required for nominative fair use of trade dress: (1) The use of the Barbie figure and head were reasonably necessary to conjure up the idea of Barbie; (2) Forsythe only used as much trade dress as necessary; and (3) Forsythe did nothing by use of Barbie trade dress to suggest sponsorship or endorsement of the pictures by Mattel.