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ZOMBIE CINDERELLA AND THE UNDEAD PUBLIC DOMAIN

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ZOMBIE CINDERELLA AND THE UNDEAD PUBLIC DOMAIN

REBECCA SCHOFF CURTIN*

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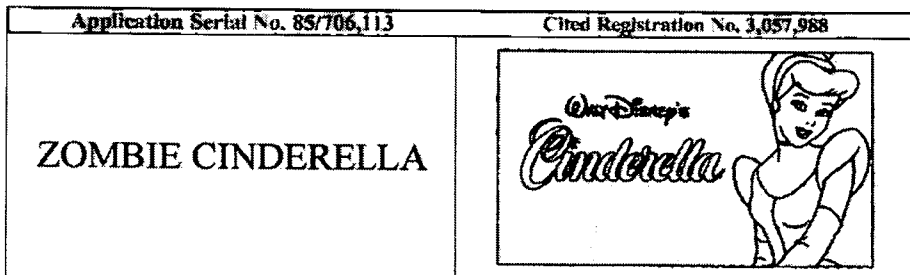
This Article takes a recent case from the Trademark Trial and Appeal Board as the basis for an argument that trademark doctrine needs stronger protection against the exclusive commercial appropriation of characters that are in the public domain. In that case, a new doll company sought to register the mark “Zombie Cinderella” for dolls. The examining attorney initially refused registration because “Zombie Cinderella” dolls were found to be confusingly similar to “Walt Disney’s Cinderella” dolls. This ruling would have implied that Disney had the exclusive right to market dolls using the “Cinderella” name, a name that carries with it the long legacy of a canonical fairy tale, beloved since at least its first print publication in the seventeenth century. The T.T.A.B. overturned the refusal to register on appeal, but it largely relied on doctrine that characterized the “Cinderella” part of Disney’s trademark as a “conceptually weak” indicator of Disney as the source of the dolls, in part because of other participants in the doll market using the word “Cinderella” to describe their dolls. This doctrine on some level denies Disney exclusive rights to the word “Cinderella” merely because the company’s commercial appropriation of the character has not been complete enough. I argue that we need a doctrine that would deny even the first market entrant the ability to appropriate such a public domain character. I argue in favor of

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extending the doctrine of aesthetic functionality, which denies trademark protection to features of a product that confer a non-reputation-related advantage on the trademark holder, to cultural elements in the public domain.

INTRODUCTION

Can anyone “own” Cinderella? Is it possible for one doll maker to use the name of an ancient fairy tale princess in a mark for dolls and then prevent all others from doing so? Can one moviemaker pluck a beloved and well-known character out of the public domain and then leverage trademark rights to control merchandizing of that character for dolls, costumes, and other toys, in perpetuity? The answer under current trademark doctrine is theoretically yes, but that cannot be the right result. This Article takes a recent case from the Trademark Trial and Appeal Board (T.T.A.B.) as the basis for an argument that trademark doctrine needs stronger protection against the exclusive commercial appropriation of characters that are in the public domain. In that case, a new doll company sought to register the mark “Zombie Cinderella” for dolls. The examining attorney initially refused registration by the examining attorney because he found the applicant’s mark (pictured below on the left) to be confusingly similar to a design and word mark including the words, “Walt Disney’s Cinderella” for dolls (pictured below on the right).¹



This result would have implied that Disney, having used and registered “Walt Disney’s Cinderella,” had the exclusive right to market dolls using the “Cinderella” name, a name that carries with it the long legacy of a canonical fairy tale, which originated in ninth-

1. *In re* United Trademark Holdings, Inc., No. 85706113, 2014 WL 5463042, at *1 (T.T.A.B. 2014). The picture is reproduced from the Applicant’s Response to Office Action at 2, ZOMBIE CINDERELLA, Registration No. 4,822,434.

century China² and has been widely known in Western culture since at least its first print publications in the sixteenth and seventeenth centuries.³ It would have been an egregious example of the kind of trademark protection in absence of any confusion as to the source of the goods that Jessica Litman has described as “arrogat[ing] to the producer the entire value of cultural icons that we should more appropriately treat as collectively owned.”⁴

The T.T.A.B. overturned the refusal to register on appeal, but it largely relied on doctrine that characterized the “Cinderella” part of Disney’s trademark as a “conceptually weak” indicator of “Disney” as the source of the dolls, in part because other participants in the doll market used the word “Cinderella” in naming their dolls and in part because “the term ‘Cinderella’ is, at a minimum, highly suggestive of the doll in that it names the fairytale character depicted.”⁵ With this doctrine as the expressed basis for reversal, the ruling on some level denies Disney exclusive rights to the word “Cinderella” merely because Disney’s commercial appropriation of the character has not been complete enough. The reasoning gives short shrift to the substantive contributions the public domain character makes to the trademark and to the product in question. Though the opinion was not precedential, the T.T.A.B. recently followed similar reasoning in a case involving attempted registration of the mark “Little Mermaid” for dolls.⁶

I argue in favor of a doctrine that would deny even the first entrant to the doll market exclusive trademark rights to the fairy tale character’s name and therefore deny to any one trademark holder the exclusive ability to market dolls that engage with a character as culturally resonant as Cinderella. This case involving one producer’s desire to reimagine Cinderella as a walking corpse, combining fairy tale characters with zombies, provides an opportune set of facts for thinking about trademarks in the market for our shared cultural

2. R.D. Jameson, *Cinderella in China*, in *CINDERELLA: A CASEBOOK* 71, 71 (Alan Dundes ed., 1982).

3. Harriet Goldberg, *Cinderella*, in *THE OXFORD COMPANION TO FAIRY TALES* 95, 97 (Jack Zipes ed., 2000) (describing the earliest known versions of the tale, its remarkable “stability” over time, and “hundreds if not thousands” of adaptations).

4. Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 *YALE L.J.* 1717, 1718 (1999).

5. *United Trademark Holdings, Inc.*, 2014 WL 5463042, at *4–5.

6. *In re United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d (BNA) 1796, 1800 (T.T.A.B. 2017) (holding that word mark “LITTLE MERMAID when proposed for use in connection with dolls is merely descriptive”).

legacy. The issues raised are not only about overreaching trademark claims that might quash expressive uses of public domain characters,⁷ but also about the competitive needs of multiple producers to reference public domain characters in the names and designs of their products. I say “names and designs” because this issue applies to word marks, like a character’s name, as well as to other elements of a character’s appearance or story line that might be appropriated through trade dress protection. We need a trademark doctrine that will reanimate the living public domain by recognizing its vital role in both culture and commerce.

I. ONCE UPON A TIME. . . IN THE “PUBLIC DOMAIN”

What is meant by the “public domain” in trademark doctrine is itself contested. Often, it is defined with reference to the public domain(s) delineated by the limits of copyright or patent protection, and that issue is only made more complex with reference to literary characters.⁸ When this Article refers to characters in the “public domain,” it means characters that are outside the scope of copyright protection at the time of the attempt to establish trademark rights in the relevant character elements, because the character elements were developed before the rise of modern copyright regimes (as in the case of Cinderella),⁹ because whatever copyright protection that once

7. Note that the circumstances of this particular case do not arise from aggressive enforcement on Disney’s part. The specter of a likelihood of confusion between the marks was raised by an examining attorney’s response to the application for the *Zombie Cinderella* mark, following current trademark doctrine. See Office Action at 3, *ZOMBIE CINDERELLA*, Registration No. 4,822,434 (rejecting the application due to likelihood of confusion).

8. Laura A. Heymann, *The Trademark/Copyright Divide*, 60 SMU L. REV. 55, 83–88 (2007); Elizabeth L. Rosenblatt, *The Adventure of the Shrinking Public Domain*, 86 U. COLO. L. REV. 561, 569–73 (2015) (addressing the “formal contours of the public domain in literary characters,” reviewing a range of proposed definitions, and arguing that creator perception should be a factor in defining the public domain); see also Joseph P. Liu, *The New Public Domain*, 2013 U. ILL. L. REV. 1395, 1416–19 (2013) (describing the effect of the imminent expiration in 2019 of the most recent copyright term extension on the public domain and discussing the benefits of a robust public domain).

9. *United Trademark Holdings, Inc.*, 2014 WL 5463042, at *4, 8 (describing the origins of Cinderella).

existed has expired (as in the case of the Little Mermaid),¹⁰ or because the relevant character is otherwise ineligible for copyright protection (as in the case of historical figures like Martha Washington).¹¹ The development of trademark doctrine supported by this Article would help in defining some uses of such character elements as outside the scope of trademark protection. The ultimate goal would be to define an area of open access to character elements positively, as a matter of trademark law, rather than referring to a negative space defined by the absence of copyright protection. Of course, not all trademark uses of a public domain character's name or attributes are troubling.¹² This Article seeks a coherent doctrine that will exclude trademark protection only for uses of public domain character elements, the protection of which would prevent others from creating and marketing products that substantively engage with the same public domain character.

Current trademark doctrine's reliance on the distinctiveness spectrum in this area, classing public domain character names as descriptive (or "at best suggestive") of the toys that embody them, incentivizes toymakers to appropriate the elements of public domain characters by developing secondary meaning in them.¹³ Toymakers who have done so may then attempt to leverage their trademark rights to protect themselves from competition in the market for toys that embody such public domain characters. In fact, the company that once developed the "Zombie Cinderella" mash-up has since shifted tactics toward seeking to register trademarks for dolls that are merely the names of fairy tale characters in the public domain.¹⁴ As the Patent and Trademark Office's responses to these applications demonstrates, reliance on the distinctiveness spectrum to police trademark rights to public domain character elements has resulted in inconsistent practice at the Patent and Trademark Office.¹⁵ The case law arising out of claimed infringements of rights in toys that carry

10. *United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d at 1797–98 (describing the origins of the Little Mermaid).

11. *In re Carlson Dolls Co.*, 31 U.S.P.Q.2d (BNA) 1319, 1320 (T.T.A.B. 1994).

12. *See infra* Part IV.

13. For a recent example of a case, other than the *Zombie Cinderella* case, in which the T.T.A.B. applied this reasoning, see *United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d at 1800.

14. *See infra* Part II.

15. *See infra* Part II.

elements of characters is further confused by the amalgamation of elements from trademark and copyright law.¹⁶

This Article argues that a more coherent choice would be to extend the doctrine of aesthetic functionality to character elements in the public domain, thereby giving trademark doctrine its own internal rationale for limiting the ability to block others from making certain uses of the names and traits of public domain characters. The Supreme Court has explained that “[t]he functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”¹⁷ The Court has further explained that a product feature “cannot serve as a trademark . . . if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.”¹⁸

The idea that this framework could apply to features of a product that have cultural meaning has already received significant support. In a detailed analysis of the origin and evolution of aesthetic functionality doctrine, Justin Hughes has argued that “what we have called ‘aesthetic’ functionality can be better understood as functionality arising from how consumers process and respond to sensory inputs, based either on evolution or deeply rooted acculturation that may or may not be ‘aesthetic.’”¹⁹ Therefore, he asserts that “aesthetic functionality, properly construed, should arise

16. Many scholars have commented on the overlap of copyright and trademark protections for characters. See, e.g., Irene Calboli, *Overlapping Trademark and Copyright Protection: A Call for Concern and Action*, 2014 U. ILL. L. REV. SLIP OPINIONS 25, 32 (2014); Kathryn M. Foley, Note, *Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide*, 41 CONN. L. REV. 921, 955, 960 (2009); Michael Todd Helfand, Note, *When Mickey Mouse Is As Strong As Superman: The Convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters*, 44 STAN. L. REV. 623, 646–47 (1992); Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 437 (1986); Mark P. McKenna, *Dastar’s Next Stand*, 19 J. INTELL. PROP. L. 357, 381–82 (2012); Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1506–09; Amanda Schreyer, *An Overview of Legal Protection for Fictional Characters: Balancing Public and Private Interests*, 6 CYBARIS INTELL. PROP. L. REV. 50, 65 (2015).

17. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

18. *Id.* at 165.

19. Justin Hughes, *Cognitive and Aesthetic Functionality in Trademark Law*, 36 CARDOZO L. REV. 1227, 1248 (2015).

only when a design or feature triggers a positive response from a substantial number of consumers based on widely shared cognitive, psychological, or aesthetic propensities of the consumer that existed *before* the design or trade dress was first created or used by the party claiming trademark rights.”²⁰ Although Prof. Hughes cautions that “there are important reasons why aesthetic functionality should not patrol the trademark/copyright frontier with the same rigor that utilitarian functionality patrols the trademark/utility patent frontier,”²¹ I will ultimately argue that consumer responses to the name and traits of a fairy tale character like Cinderella are consistent with this more sharply tailored understanding of aesthetic functionality, as well as the broader contours of the doctrine’s policy.

In the wake of an abortive attempt by the Ninth Circuit to apply aesthetic functionality doctrine to a character merchandizing case in *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*,²² other scholars have been willing to go further in embracing the application of aesthetic functionality to trademark uses of characters that have fallen out of copyright protection. Irene Calboli has asserted that, “courts could resort to the doctrine to set creative works free in the public domain after the expiration of the copyright term or when copyright protection does not apply, regardless of the additional layer of protection that these works have acquired as trademarks,” even if “the doctrine of aesthetic functionality remains an unclear doctrine.”²³ Joseph Liu has argued that “[a]lthough trademark law’s aesthetic functionality

20. *Id.* at 1231.

21. *Id.*; *see id.* at 1265–67 (exploring the complexities of the trademark/copyright divide and posing the question, “why would we bar a party developing trademark rights over a small piece of original expression that was copyrighted and then fell into the copyright public domain when we definitely allow the same party to develop and perfect trademark rights over material in the copyright public domain that was never protected by copyright (such as a hieroglyphic or a well-known ancient statue) . . . ?”). The dilemma posed by the analysis of public domain characters here is the conclusion that, in fact, we should not always allow a party to develop and perfect trademark rights over material that was never protected by copyright, at least not unlimited rights. Then there follows a similar question: if we do restrict rights in characters born in the copyright public domain, might there be good policy reasons to restrict trademark rights in characters that later enter the copyright public domain? At least, the same dilemma with respect to a substantive policy basis on which to distinguish the two groups of characters presents itself again.

22. 636 F.3d 1115, 1123–25 (9th Cir. 2011), *withdrawn*, *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d. 958 (9th Cir. 2011).

23. Irene Calboli, *Betty Boop and the Return of Aesthetic Functionality: A Bitter Medicine Against “Mutant Copyrights”?*, 2014 EUR. INTELL. PROP. REV. 80, 87 (2014).

doctrine has not always been warmly received by the courts, the initial *Fleischer* opinion indicates that this doctrine can play a useful and more prominent role in the future, policing the boundary between copyright and trademark."²⁴ This Article attempts to bring clarity to the application of the aesthetic functionality doctrine to certain trademark uses of characters by stepping away from the complexities of the trademark/copyright divide, in search of the "easy cases" which may make good law, in the converse of the proverbial hard cases. After fully exploring application of the doctrine to public domain characters, as defined here, I will briefly take up the challenge presented by the hard cases, characters born under copyright and developed as trademarks prior to copyright expiration.

Applying aesthetic functionality doctrine to the *Zombie Cinderella* case, then, we might say that the public domain character's name, "Cinderella," when used in connection with a class of goods like dolls, functions to connect those dolls with the fairy tale, amplifying the relevance of the toy and multiplying the possibilities for play through association with the public domain material. The same would be true not only of the doll's name, but also of a doll's design features that referenced elements of the fairy tale. (Imagine a Snow White doll with cheeks as red as blood, hair as dark as ebony, and skin as white as snow, as the character is described in the first English translation of the Brothers Grimm version of that tale.)²⁵ In this sense the character name and other character elements incorporated into the doll's design are a "useful product feature." A trademark holder's exclusive ability to associate its toy with the public domain material would confer a significant non-reputation-related disadvantage on competitors of the trademark holder—thus triggering a finding of aesthetic functionality for those elements of the doll's design or the word mark used in conjunction with the doll.

Aesthetic functionality was recently applied in a similar way in *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*,²⁶ an infringement action before the Ninth Circuit concerning merchandise that carried images of Betty Boop. Although the opinion that employed aesthetic functionality in its reasoning was withdrawn and replaced by an

24. Liu, *supra* note 8, at 1438.

25. IONA & PETER OPIE, *Snow White and the Seven Dwarfs*, in *THE CLASSIC FAIRY TALES* 175, 177 (1974).

26. 636 F.3d at 1124.

opinion that made no reference to functionality,²⁷ this abortive attempt to apply aesthetic functionality as a defense to a merchandising use of a character has revived attention to the doctrine—some positive²⁸ and some negative.²⁹ The doctrine of aesthetic functionality has a complex history and remains controversial for some commentators and courts.³⁰ The Ninth Circuit's reasoning was reminiscent of a decades-old case before the T.T.A.B., *In re DC Comics*. In that case, the court held that representations of the comic book characters cannot serve as trademarks for dolls of the characters because the character's features "are commercially functional."³¹ That decision was also controversial and was overturned on appeal.³² Some scholars have noted difficulties in the application of aesthetic functionality doctrine to characters.³³

27. *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011).

28. *See, e.g.*, Calboli, *supra* note 23, at 87; Calboli, *supra* note 16, at 32; Liu, *supra* note 8, at 1436.

29. *See, e.g.*, Thomas L. Casagrande, *Betty Boop—A Threat to Licensing Programs*, LAW360 (Mar. 14, 2011), <https://www.law360.com/articles/228375/betty-boop-a-threat-to-licensing-programs>; Anthony Fletcher, *Defensive Aesthetic Functionality: Deconstructing the Zombie*, 101 TRADEMARK REP. 1687, 1687 (2011) (drawing a metaphor between the aesthetic functionality doctrine and a zombie, as a dead body (of law) revived "for some evil purpose" in the Betty Boop case); Amicus Brief of the International Trademark Association, *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115 (9th Cir. 2011) (No. 09-56317), *reprinted in* 101 TRADEMARK REP. 1390, 1401–02 (2011).

30. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7.80 (5th ed. 2017), Westlaw (database updated September 2018); Robert G. Bone, *Trademark Functionality Reexamined*, 7 J. LEGAL ANALYSIS 183, 238–40 (2015); Mark McKenna, *(Dys)Functionality*, 48 HOUS. L. REV. 823, 843–58 (2011); *see also* U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.02(a)(vi) (2017).

31. *In re DC Comics, Inc.*, 211 U.S.P.Q. (BNA) 834, 837 (T.T.A.B. 1981), *rev'd*, 689 F.2d 1042, 1043 (C.C.P.A. 1982).

32. *In re DC Comics, Inc.*, 689 F.2d 1042, 1043 (C.C.P.A. 1982).

33. Hughes, *supra* note 19, at 1264 (suggesting that the form of aesthetic functionality applied in *Fleischer I* was "poised to wipe out trademark rights in visual characters, a set of intangibles particularly valuable in and of themselves"); Kurtz, *supra* note 16, at 505 (arguing that aesthetic functionality doctrine is not apposite to a case involving a toy car based on a car from a TV show because "[t]he car's features were valued not for their intrinsic attractiveness but because of the associations created by the plaintiff"); Rosenblatt, *supra* note 8, at 628 n.313 (arguing that although "[t]he parallel doctrine of trademark functionality would accomplish the same objective [as genericity] of rendering secondary meaning irrelevant to protectability and may in fact be a good match for the situation," genericity is a "better fit" because

Nonetheless, the resurgence of the doctrine in the initial *Fleischer* decision has been recognized as a viable model for limiting the scope of trademark protection in characters, particularly in merchandizing contexts in which the product at issue incorporates the image or embodiment of the character.³⁴ This context is one in which it has been argued that the interests of a trademark holder in source-identification are diminished in relation to the expressive or communicative interest in the use of the character.³⁵

The challenge in applying aesthetic functionality in this area is at least twofold. First, it is necessary to articulate the “function” of the character elements in the mark, or, in the parlance of the *Qualitex* court, what “non-reputational advantage” that exclusive use of the character elements would confer on the trademark holder. Second, it would go a long way toward defusing the controversy around applying aesthetic functionality to some trademark uses of characters if we could differentiate aesthetically functional uses of characters from (1) the trademark uses of characters that do not confer troubling “non-reputational advantages” (think of a registration for the word mark “Cinderella Soap Company” for soap and other cleaning products) and (2) the merchandizing uses of ordinary marks that trademark holders have become accustomed to controlling (think of a t-shirt with a company’s logo on it). This Article addresses each of these difficulties.

There are a number of reasons why the issue is ripe for revisitation. Since the *In re DC Comics* case in 1981, the doctrine of aesthetic functionality has developed significantly, including some guidance from the United States Supreme Court.³⁶ Both the Betty Boop case and the DC Comics case also involved characters who were born under copyright and parties who at least alleged active copyright

“signaling’ is an odd type of ‘function’ to characterize as functional, since all valid trademarks function as signals of something”).

34. Liu, *supra* note 8, at 1436.

35. *Id.* at 1435; see also Leslie Kurtz, *The Methuselah Factor: When Characters Outlive Their Copyrights*, 11 U. MIAMI ENT. & SPORTS L. REV. 437, 446 (1994) (“In any event, if a character testifies only, in general terms, to its sponsorship or authorization [of licensed merchandise], the policy underlying trademark protection, while present, is weaker than if it provides a guarantee of the quality of the product on which it appears. This is an important factor when the trademark goal of avoiding public confusion comes into conflict with the policy of allowing free use of what is in the pub[li]c domain.”).

36. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 1255, 1261 (2001); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–65, 169–70. (1995).

interests in them. The *Zombie Cinderella* case offers an opportunity to step back from the relatively fraught questions raised by cases involving characters that are under copyright protection and examine the advantages that a concept of aesthetic or “cultural” functionality might have in dealing with classes of goods that embody or engage with character elements in the public domain.

The dilemma raised by trademark protection of characters in the public domain is more pressing now than ever. Orly Lobel, in a recent book exploring the Barbie/Braatz doll wars, has observed that, “as increasingly is the case among leading brands across all industries, the fights in the toy industry are now focused on controlling existing ideas rather than creating new ones.”³⁷ At the same time, consolidations of corporate entities in the entertainment industry have recently put the rights to ever-larger numbers of characters into an ever-smaller number of hands, with some critics concerned that such centralized control will have the effect of “further stifling diversity and creativity in Hollywood films.”³⁸ The imminent expiration of copyright in January, 2019, for works published in the United States in 1923 promises to begin releasing elements of characters from copyright protection for the first time since Congress last extended copyright duration in 1998.³⁹ The possibility that trademark rights might be leveraged to prevent certain uses of such newly-released characters in perpetuity raises hard questions about how much control trademark doctrine should give, even to creators of “new” characters, beyond the scope of copyright protection.

This Article begins with an analysis of the T.T.A.B.’s opinion in the *Zombie Cinderella* case and the policy values at stake. Part II of the Article explores the shortcomings of the reasoning used in the opinion, including an adverse incentive to appropriate public domain characters exclusively, a vulnerability to inconsistent application, and a poor fit with trade dress cases. Part III of the Article turns to the

37. ORLY LOBEL, *YOU DON’T OWN ME* xvi (2018).

38. Jeet Heer, *The Disney Deal Is a Disaster for Superhero Movies*, NEW REPUBLIC (Dec. 15, 2017), <https://newrepublic.com/article/146312/disney-deal-disaster-superhero-movies>.

39. Liu, *supra* note 8, at 1396–97. Prof. Liu notes that “the increase in mass and visual media post-1920 led to the creation and broad dissemination of visual characters such as Mickey Mouse, who have been the subject of aggressive marketing techniques and who have achieved iconic status.” *Id.* at 1408. Liu points out that, in addition to Mickey Mouse, other characters due to begin passing into the copyright public domain include Minnie Mouse, Donald Duck, Pluto, Winnie the Pooh, and Superman. *Id.*

aesthetic functionality doctrine and how it might make a favorable impact on cases like the *Zombie Cinderella* case. To illustrate how aesthetic functionality might not only change the reasoning in such cases but also the results, I will examine a case involving trademark rights to the name of Wyatt Earp, known as the historical hero of the shootout at the OK Corral. Part IV will deal with criticisms that have been raised in response to previous applications of the aesthetic functionality doctrine. Part V turns briefly to the difficult cases, those of characters born under copyright, whose authors or assignees have developed trademark rights in the elements of the character prior to the expiration of copyright. The interests at play in these difficult cases must be weighed against the interests at play in breathing new life into the idea of the public domain in trademark law.

II. ENTER “ZOMBIE CINDERELLA”

On August 17, 2012, United Trademark Holdings, Inc. filed an application to register the word mark “Zombie Cinderella.”⁴⁰ The examining attorney issued a refusal to register under Section 2(d) of the Lanham Act, arguing that “Zombie Cinderella” was so similar to “Walt Disney’s Cinderella” that it was likely to cause confusion when both marks were applied to dolls.⁴¹ The application was filed on the basis of the intent to use the mark, so the examining attorney did not have a specimen of use to analyze at the time and the analysis focused on the interplay between the character name and the class of goods in general. In the final office action, the examining attorney argued that “[h]ere . . . the marks are similar in sound and meaning because of the shared use of the term CINDERELLA in relation to toys and dolls.”⁴²

United Trademark Holdings responded to the examining attorney’s focus on the term CINDERELLA in relevant part by alleging both conceptual and commercial weakness of this portion of the marks. With respect to conceptual weakness, their response to the office action argued that:

The term shared between the marks, “CINDERELLA,” has little or no source identifying significance because it is very

40. ZOMBIE CINDERELLA, Registration No. 4,822,434.

41. Examining Attorney’s Appeal Brief at Part I, ZOMBIE CINDERELLA, Registration No. 4,822,434.

42. Office Action, ZOMBIE CINDERELLA, Registration No. 4,822,434.

highly suggestive in connection with dolls and other related toy goods. In this context, the word “CINDERELLA” refers to the character Cinderella from the public domain folk tale first published by Charles Perrault in *Histoires ou contes du temps passé* in 1697.⁴³

Note that the categorization of the element of the mark as “suggestive” does not preclude inherent distinctiveness, so the applicant is not offering to disclaim protection for that particular element of the mark, but the argument does at least acknowledge the antecedent referent in the form of the fairy tale. With respect to commercial weakness, the response noted that Disney’s mark was initially refused registration because of “fifteen other marks containing the term ‘CINDERELLA.’”⁴⁴ United Trademark Holdings pointed out that Disney at that time successfully argued in a Request for Reconsideration that multiple third-party uses indicated that “the cited marks are comparatively weak and entitled to a correspondingly limited scope of trademark protection.”⁴⁵

None of these arguments were persuasive to the examining attorney. The applicant’s argument with respect to third-party registrations gained little traction with the examining attorney, because “[a]s a general rule, the weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services.”⁴⁶ None of the cited marks was for dolls or toys.⁴⁷ As we will see, the evidentiary record before the T.T.A.B on appeal included “evidence of marketplace use of CINDERELLA in connection with dolls” that carried more weight.⁴⁸ The examining attorney’s response to the argument about the conceptual weakness of CINDERELLA due to the public domain fairy tale was more concerning:

43. Applicant’s Response to Office Action, ZOMBIE CINDERELLA, Registration No. 4,822,434.

44. *Id.*

45. *Id.*

46. Examining Attorney’s Appeal Brief at Part IV.B, ZOMBIE CINDERELLA, Registration No. 4,822,434 (citations omitted).

47. *Id.*

48. *In re* United Trademark Holdings, Inc., No. 85706113, 2014 WL 5463042, at *6 (T.T.A.B. 2014).

Applicant provided dictionary and encyclopedia evidence to support the claim that consumers would immediately associate the name with the character in the original public domain story. While the validity of this evidence is not in dispute, the examiner disagrees that this evidence supports the contention that consumers would immediately associate the name Cinderella with that of the public domain story or the dictionary definition of the name. *In fact, it is likely that Cinderella is "the most widely known of all fairy tales" as a result of [Disney's] efforts and actions.*⁴⁹

The examining attorney offered no evidence for his perception that Disney is to be credited for the prominence of the Cinderella tale.⁵⁰ But then, the question being asked by the doctrine is cabined to the distinctiveness of the marks at the contemporary moment, after Disney's appropriation of the name—that is, what do consumers think when they look at this mark now? It is unsurprising that the examining attorney thought exclusively about Disney's contributions to Cinderella. He was not being asked what Cinderella's contributions to Disney were, and he was given scant evidence of what was in the "public domain" when Disney borrowed from it.

Before continuing to the analysis applied by the T.T.A.B. to overturn the examining attorney's refusal to register, it makes sense to pause now and consider the evidence not before the examining attorney that might have helped to clarify what the stakes are in access to the Cinderella name. By the time Disney released its film version of Cinderella in 1950, the tale had long been among the best-known fairy tales in Western culture. It emerged in European literature in Bonaventure des Périers' *Les Nouvelle Recreations et*

49. Examining Attorney's Appeal Brief at Part IV.B, ZOMBIE CINDERELLA, Registration No. 4,822,434 (emphasis added) (internal citations omitted).

50. Later in the brief, citing the Wikipedia article on the Disney film version of Cinderella, he did note that the Cinderella film produced by Disney was so successful that the profits allowed the company to finance other productions including projects in television, to start a distribution company, and to start building the company's first theme park, Disneyland. *Id.* at Part IV.C. But the conclusion he draws from this evidence is not about the boost the public domain tale gave to Disney but rather the strength of the association of the "Cinderella" name with Disney: "It can certainly be said that Disney's CINDERELLA mark is the cornerstone of the Disney enterprise." *Id.*

Joyeux Devis in 1558.⁵¹ Following that publication, it appeared in multiple well-known collections of tales, including Giambattista Basile's *Il pentamerone* in the 1630s, Charles Perrault's *Histoires ou contes du temps passé* in 1697, and Wilhelm and Jacob Grimm's *Kinder- und Hausmärchen* between 1812 and 1815.⁵² Scholars now believe the tale circulated in Indo-European culture prior to these publications⁵³ and its earliest analogue is a Chinese folktale with origins as early as the ninth century.⁵⁴ Versions of the tale are also known in Japan, Australia, India, and Africa.⁵⁵ Charles Perrault's version of the tale, which was the one used as a basis for the Disney film, was first translated into English by Robert Samber in 1729.⁵⁶ Harriet Golberg has suggested that the "universal appeal of a 'rags to riches' story with emphasis on sensitive family issues explains its successful diffusion through time and space."⁵⁷ Jane Yolen has argued that the Cinderella tale has been a favorite in the "American folktale pantheon" because the "rags-to-riches formula" is part of the "American creed," having been "immortalized in American children's fiction by the Horatio Alger stories of the 1860s and by the Pluck and Luck nickel novels of the 1920s."⁵⁸ The fairy tale genre was institutionalized at the formation of children's literature itself and Cinderella's place in what has been called the "canon of 'classical' fairy tales" was secure by the start of the twentieth century.⁵⁹

It is difficult to overestimate the pervasive influence of the Cinderella tale. Iona and Peter Opie argue that "[t]he story of Cinderella is undoubtedly the best-known fairy story in the world, and it is a tale whose strangeness has apparently been a wonder to man for a thousand years."⁶⁰ Harriet Goldberg asserts that there have been

51. Goldberg, *supra* note 3, at 95.

52. *Id.*

53. *Id.*

54. Jameson, *supra* note 2, at 71. *But see* Armando Maggi, *The Creation of Cinderella*, in *THE CAMBRIDGE COMPANION TO FAIRY TALES* 150, 160–61 (2015) (noting distinctions between the Chinese tale the "Perrault-Grimm-Disney outline").

55. Goldberg, *supra* note 3, at 97.

56. IONA & PETER OPIE, *Cinderella*, in *THE CLASSIC FAIRY TALES* 117, 121 (1974).

57. Goldberg, *supra* note 3, at 97.

58. Jane Yolen, *America's Cinderella*, in *THE CINDERELLA CASEBOOK* 294, 296 (Alan Dundes ed., 1982).

59. Jack Zipes, *Introduction: Towards a Definition of the Literary Fairy Tale*, in *THE OXFORD COMPANION TO FAIRY TALES* xv, xxviii (Jack Zipes ed., 2000).

60. OPIE, *supra* note 56, at 117.

“hundreds if not thousands of literary, dramatic, musical, poetic, and cinematic versions.”⁶¹ The tale is so well-known that references to it have entered the English language. “Cinderella story,” meaning “an event . . . involving a sudden rise from poverty, adversity, or obscurity to a position of wealth, success, or recognition” has been in use since the mid-nineteenth century, as has the term “Cinderella,” meaning “a neglected or despised member, partner or the like.”⁶² Indicating the continued usefulness of the tale in grappling with cultural and societal evolution, Goldberg points out that “since the 1970s . . . the term ‘Cinderella complex’ has come to stand for a troubled woman who cannot determine her own destiny.”⁶³

As one example of Cinderella’s currency prior to Disney’s use of the character, consider just the film adaptations that were made of the tale. The first film version of Cinderella was produced by the famed Georges Méliès in 1899.⁶⁴ It was released in the United States on Christmas Day that year.⁶⁵ Méliès was an innovator in cinematic techniques,⁶⁶ who was at the highest point of his fame during this period,⁶⁷ when American filmmakers regularly pirated Méliès’ work.⁶⁸

61. Goldberg, *supra* note 3, at 97.

62. *Cinderella*, OXFORD ENGLISH DICTIONARY ONLINE, <http://www.oed.com> (last visited Nov. 5, 2018). Some scholars have noted, however, that this definition of “Cinderella story” is somewhat of a misnomer, given that “‘Cinderella’ is not a story of rags to riches, but rather riches recovered; not poor girl into princess but rather rich girl (or princess) rescued from improper or wicked enslavement; not suffering Griselda enduring but shrewd and practical girl persevering and winning a share of the power.” Yolen, *supra* note 58, at 296.

63. Goldberg, *supra* note 3, at 97.

64. Terry Staples, *Cinderella, Film Versions*, in THE OXFORD COMPANION TO FAIRY TALES 98, 98 (Jack Zipes ed., 2000).

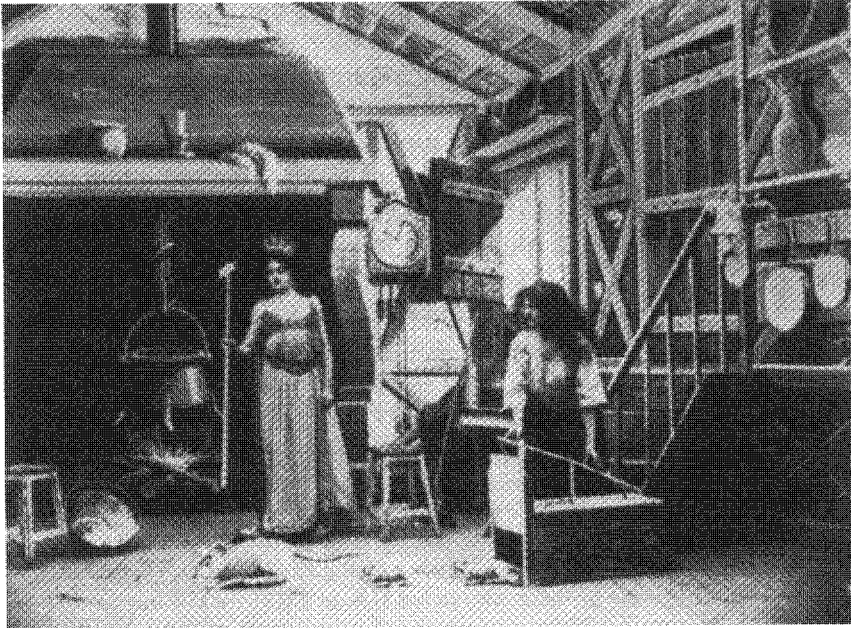
65. *Cinderella: Release Info*, INTERNET MOVIE DATABASE, http://www.imdb.com/title/tt0000230/releaseinfo?ref_=tt_dt_dt (last visited Nov. 5, 2018).

66. J.B. Kaufman, *Silent Cinderella*, CUTTING ROOM FLOOR, <http://www.jbkaufman.com/cutting-room-floor/silent-cinderella>.

67. See Ian Wojcik-Andrews, *Méliès, Georges*, in THE OXFORD COMPANION TO FAIRY TALES 315, 315 (Jack Zipes ed., 2000).

68. PETER DECHERNEY, HOLLYWOOD’S COPYRIGHT WARS 20, 28 (2012).

As an indication of the stability of the elements of the Cinderella tale, below is a still photo from an early scene in the film, showing the Fairy Godmother looking on as Cinderella releases a rat who will magically become a coachman and the mice who will become footmen⁶⁹:



The girl in rags by the hearth, the mice, and the fairy godmother are all readily familiar elements of the tale from Charles Perrault's version, except that in Perrault's version, as in Disney's, the mice turn into horses to pull the carriage, not footmen.⁷⁰ Méliès also used stop-camera substitutions to transform a pumpkin into a carriage and Cinderella's rags into a fine dress, bringing more elements of Perrault's tale to life through new technology.

Méliès's first version of Cinderella was followed by releases of at least fifteen different movie adaptations between 1900 and 1940 of

69. *Cinderella (Film)*, FIRST VERSIONS, <http://www.firstversions.com/2017/07/cinderella-film.html> (last visited Nov. 5, 2018) (includes several still photos and a link to the full film).

70. Staples, *supra* note 64, at 98. Disney completely edited out Perrault's rat as raw material for the coachman, substituting a horse. *Id.* Perrault also used lizards to be turned into coachmen, while Disney used a dog. *Id.*

varying length and style.⁷¹ These included a number of productions featuring actresses who were major stars in the title role, including Mary Pickford in 1914 and Deanna Durbin in 1939.⁷² The Deanna Durbin vehicle, *First Love*, was successful enough to be nominated for three Oscars.⁷³ There had been modernizations that adapted the tale to new settings in time and place, including one set in London during World War I by J.M. Barrie, the author of *Peter Pan*.⁷⁴ The first animated film adaptations of Cinderella came in 1927, by the groundbreaking silhouette filmmaker Lotte Reiniger in Germany⁷⁵ and by Walt Disney himself for Laugh-O-Gram in the United States.⁷⁶

By the time Walt Disney returned to the Cinderella material for Walt Disney Company in 1950, the tale was already a beloved subject for the screen, bringing along with it a massive amount of goodwill, built up over decades of ingenious treatments on the screen alone. The American appetite for film adaptations of Cinderella was tried and true. When Disney set out to market its new film, its advertising emphasized the association with the public domain character in ways that had changed relatively little over the long remarkable history of

71. Kaufman lists the following twelve productions, released in the United States where noted: *Cendrillon ou la pantoufle merveilleuse*, by Pathé productions (released in the U.S. as *Cinderella* in 1907 or 1908); *Cinderella* by Thanhouser (in the U.S. in 1911), *Cinderella* by Selig (also in the U.S. in 1911); *Cendrillon ou la pantoufle merveilleuse*, remade by Pathé productions in partnership with Georges Méliès (in 1912); *Cinderella* by Famous Players in a partnership with Paramount (in the U.S. in 1914); *Aschenputtel* by Lotte Reiniger (in 1922); *Cinderella* by Walt Disney for Laugh-O-Gram (in the U.S. in 1922); *Cinderella/Der Verlorene Schuh* by Decla-Biscop (in 1923 and in the U.S. in 1927); *Cinderella Meets Fella* by Tex Avery for Warner Bros. (in the U.S. in 1938); and then three films Kaufman classes as modernizations of Cinderella: *Cinderella Up-to-Date* by Georges Méliès (in 1909), *A Modern Cinderella* by Vitagraph (in the U.S. in 1910), *A Modern Cinderella* by Edison (in the U.S. in 1911). Kaufman, *supra* note 66. In addition, Staples lists three more film adaptations prior to 1940: *A Kiss for Cinderella* in 1926, based on a play by J.M. Barrie, the author of *Peter Pan*; *Ella Cinders* in 1927, updating the setting to contemporary Hollywood; and *First Love* in 1939, starring Deanna Durbin. Staples, *supra* note 64, at 98.

72. Staples, *supra* note 64, at 98.

73. These were for Best Cinematography, Black-and-White; Best Art Direction; and Best Music, Scoring. *First Love (1939): Awards*, INTERNET MOVIE DATABASE, <http://www.imdb.com/title/tt0031311/awards> (last visited Nov. 5, 2018).

74. Staples, *supra* note 64, at 98.

75. *Id.* For more on Lotte Reiniger, see Terry Staples, *Reiniger, Lotte*, in THE OXFORD COMPANION TO FAIRY TALES 419, 419 (Jack Zipes ed., 2000). She directed the world's first animated feature film. *Id.*

76. Kaufman, *supra* note 66.

Cinderella adaptations. Consider the two posters shown on the following page.

Below on the left is one of the original movie posters for Disney's *Cinderella* in 1950.⁷⁷ Below on the right is a poster for a stage production of *Cendrillon* by the Théâtre du Châtelet in France nearly one hundred years before.⁷⁸



77. The picture is reproduced from Exhibit A in Applicant's Response to Office Action, ZOMBIE CINDERELLA, Registration No. 4,822,434. See also *Cinderella* (1950), INTERNET MOVIE DATABASE, <https://www.imdb.com/title/tt0042332/mediaviewer/rm47988736> (last visited Nov. 5, 2018); *Cinderella Movie Poster (1950)*, FILMPOSTERS.COM, <https://www.filmposters.com/pd/CINDERELLA-Movie-Poster-1950/19806> (last visited Nov. 5, 2018) (displaying a variation of this poster without the mice).

78. Rafaëlle Jolivet Pignon, *Les Métamorphoses Scéniques de Cendrillon: De la Féerie à l'Inquiétante Étrangeté*, AGÛN: REVUE DES ARTS DE LA SCÈNE, <http://agon.ens-lyon.fr/index.php?id=3158> (last visited Nov. 5, 2018). The show ran between 1866 and 1888. *Id.*

The references to the content of the tale in each poster pull out many of the same details: the girl, her dress, the shoe, the carriage, the mice, and in the center of it all, that emblematic name, Cinderella. The things that really sold Disney's film *ex ante* were many of the same salient elements of the tale used by the Théâtre du Châtelet poster, not Disney's particular twist on the tale. In fact, with the exception of the mice, the characters as they appear on the Disney movie poster are not represented how they are distinctively rendered in the film (and, so many years later, in Disney's word and design mark). They are instead stylized abstractions that allude primarily to the public domain tale.

In that context, it seems clear that the public domain tale provided a significant boost to Disney's efforts in creating and promoting the *Cinderella* film of 1950. The tale donated both raw material and reputational goodwill to Disney's film and, by extension, to the dolls marketed under the "Walt Disney's Cinderella" mark. But, under current trademark law, none of that evidence was relevant to the question of whether the existence of the "Cinderella" portion of Disney's mark should have the effect of preventing United Trademark Holdings from accessing the same advantage by also making use of "Cinderella" in their mark. The heart of the likelihood of confusion factors applied by the T.T.A.B., the similarity or dissimilarity of the marks, was dominated by consideration of the conceptual and commercial weakness of the "Cinderella" element in Disney's mark.⁷⁹

The T.T.A.B.'s opinion does touch on the existence of the public domain story, but it moves quickly on to consider the number of dolls already on the market. In the section considering the conceptual weakness of the term, the court remarks:

The evidence shows that the fairytale character Cinderella is an established part of our cultural fabric and enjoys extremely widespread public recognition. The record also shows, as we discuss further below, that this cultural figure has had an impact in the commercial field of dolls, and that many dolls that depict the character Cinderella have been offered in the market by unrelated business.⁸⁰

79. *In re* United Trademark Holdings, Inc., No. 85706113, 2014 WL 5463042, at *8, 10 (T.T.A.B. 2014).

80. *Id.* at *9.

Given the prevalence of the tale and the third-party dolls noted here, it is perhaps surprising that the T.T.A.B. does not think of the term “Cinderella” as at least descriptive of the relevant products (Cinderella dolls), if not a generic term for those products. At least two prominent scholars have argued that characters whose copyright has expired should be treated like generic terms in connection with expressive uses of the character.⁸¹ The T.T.A.B., however, merely said that “for a doll that depicts the fairytale character Cinderella, the term ‘Cinderella’ is, at a minimum, highly suggestive of the doll in that it names the fairytale character depicted.”⁸² As a result, the T.T.A.B. concluded, “it has limited power to function as a source indicator.”⁸³ Terms classified as “suggestive” are inherently distinctive, however, and may be registered without a showing of secondary meaning.⁸⁴ In other words, the T.T.A.B. stopped short even of considering “Cinderella” to be descriptive of the dolls, much less a generic term for such goods. It also bears noting that descriptive terms may be registered upon a showing of secondary meaning,⁸⁵ so even a finding that Cinderella was descriptive of the dolls would not have absolutely prevented the establishment of exclusive rights to the name as identifying a single source for “Cinderella” dolls.

81. Jane C. Ginsburg, *Licensing Commercial Value: From Copyright to Trademarks and Back*, in *THE LAW AND PRACTICE OF TRADEMARK TRANSACTIONS* 54, 66, 68 (Irene Calboli & Jacques de Werra eds., 2016) (arguing that the name and image of a character that has fallen out of copyright protection should be treated as generic terms, “since the name and image are the name and the necessary representation of a thing (the character),” provided that “[i]f the trademark owner can build up goodwill in goods or services unrelated to literary, artistic, and audiovisual uses, the case for trademark coverage becomes more convincing”); Rosenblatt, *supra* note 8 (arguing that “the existing doctrine of genericity should eliminate the ability to claim trademark rights [for expressive goods and services] in literary characters and character names that have entered the public domain,” because “characters and their names signal a type of goods (that is, expressive goods concerning that character) rather than a source of goods”); cf. Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 *NOTRE DAME L. REV.* 397, 399 (1990) (developing a defense of “expressive genericity” for expressive uses of word marks).

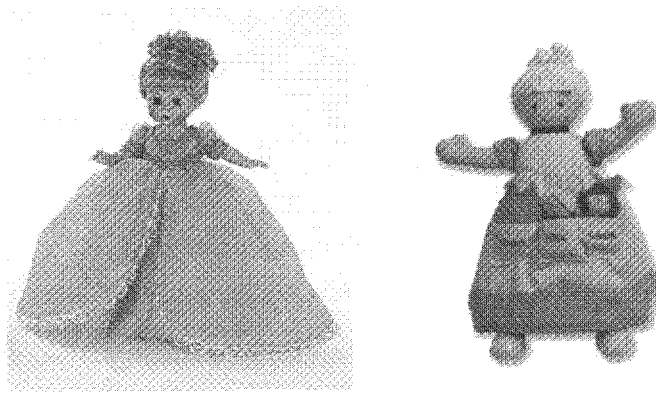
82. *United Trademark Holdings, Inc.*, 2014 WL 5463042, at *5.

83. *Id.*

84. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976).

85. *United Trademark Holdings, Inc.*, 2014 WL 5463042, at *8 (citing *In re Christian Dior, S.A.*, 225 U.S.P.Q. (BNA) 533, 534 (T.T.A.B. 1985)).

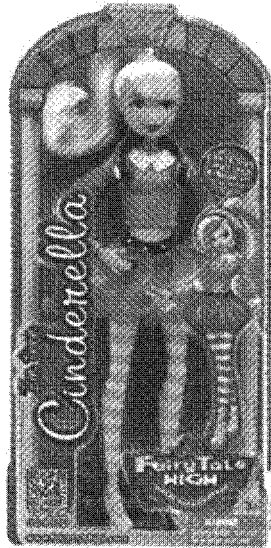
The T.T.A.B. then moved on to consider the “commercial weakness” of the term “Cinderella” in Disney’s mark. Here, the T.T.A.B. focused on third-party uses in connection with identical goods (dolls). It noted that it had evidence of nine dolls depicting Cinderella before it and mentioned three products by name. The diversity of the dolls is interesting. Although each of the dolls engages with the public domain fairytale in some way, they are so different as to be unlikely to be confused with each other. The first third-party doll noted by the T.T.A.B. is the “Dolly Pockets Cinderella Doll” (pictured below on the right).⁸⁶



It is a soft cloth doll in silvery shoes that comes with finger puppets, representing a pumpkin, a prince, and the fairy godmother, tucked into the pockets of its dress. The next doll noted by the court (pictured above on the left)⁸⁷ is a more formal, traditional doll by Madame Alexander in a ball gown.

86. The picture is from the Amazon.com ad for the doll. *North American Bear Company Dolly Pockets Cinderella Doll*, AMAZON, <https://www.amazon.com/North-American-Bear-Company-Cinderella/dp/B00EAMHHTG> (last visited Nov. 5, 2018). The same picture was offered as Exhibit L in Applicant’s Response for Consideration After Final Office Action, ZOMBIE CINDERELLA, Registration No. 4,822,434.

87. The picture is from the Amazon.com ad for the doll. *Madame Alexander Dolls 8” Storyland Collection—Cinderella*, AMAZON, https://www.amazon.com/Madame-Alexander-Dolls-StorylandCollection/dp/B000O94RS8/ref=sr_1_1?s=toys-andgames&ie=UTF8&qid=1503636296&sr=11&keywords=madame+alexander+cinderella+8%22+storyland (last visited Nov. 5, 2018). The same picture was offered as Exhibit K in Applicant’s Request for Reconsideration After Final Office Action, ZOMBIE CINDERELLA, Registration No. 4,822,434.



Finally, the T.T.A.B. notes another of the products made by the producers of the Zombie Cinderella doll, a “Fairy Tale High Cinderella Fashion Doll” that re-imagines Cinderella as a teenaged high school student. The doll (pictured above) has white-blonde hair and wears a mini-skirt, striped leggings, and what appear to be glass high-heeled shoes.⁸⁸

Each of these dolls depends on consumer awareness of elements of the Cinderella tale to understand the doll in a different way. In each case, however, the name “Cinderella” does not *describe* the product’s qualities so much as *inscribe* the product with the qualities of the public domain character, opening up a world of possibilities for play

88. The picture is from the Amazon.com ad for the doll. *Fairy Tale High Cinderella Fashion Doll*, AMAZON, https://www.amazon.com/Fairy-Tale-High-Cinderella-Fashion-Doll/dp/B00D5SDLCS/ref=sr_1_1?s=toys-andgames&ie=UTF8&qid=1503636518&sr=1-1&keywords=Fairy+Tale+High+Cinderella+Fashion+doll (last visited Nov. 5, 2018). The same picture was offered as Exhibit J in Applicant’s Request for Reconsideration After Final Office Action, ZOMBIE CINDERELLA, Registration No. 4,822,434. At the time, United Trademark Holdings, Inc. held a registration for the mark “Fairy Tale High” for “dolls.” *United Trademark Holdings, Inc.*, 2014 WL 5463042, at *6 n.11 (citing Request for Reconsideration Denied, ZOMBIE CINDERELLA, Registration No. 4,822,434). They have since successfully registered the mark “Teen Cinderella.” TEEN CINDERELLA, Registration No. 4,989,621.

with the toy.⁸⁹ The semantic relationship between the public domain character and the doll is not merely descriptive. That is, the name of the character does not merely convey information about what consumers can expect to see in the product. For instance, the name Cinderella is not really predictive of how the doll will look, as each doll conceives of the fairy tale princess in a different way. Use of the Cinderella name gives a backstory to what would otherwise be a very ordinary formal doll from Madame Alexander. Similarly, the teen fashion doll is given an extra dimension by her mash-up with the fairytale. Without the connective tissue of the reference to Cinderella, the finger puppets that accompany the Dolly Pockets doll would be nonsensical. The word “Cinderella” organizes the relationship of the doll with the fairy tale canon. A similar dynamic between the character name and the doll product can be observed in the product that was ultimately marketed under the Zombie Cinderella name

89. As has been suggested to me in comments made on the draft by both Barton Beebe and Justin Hughes, this idea could profit from more formal theorization with the application of speech-act theory. While a complete exploration of the theory is beyond what I can do in this Article, I note that Alexandra Roberts has applied speech-act theory to determinations of distinctiveness by articulating the difference between word marks that are “source-constative” (that is, representing the source of the product, distinctive as a matter of trademark law, and therefore legally performative, resulting in trademark protection) and word marks that are “goods-constative” (merely descriptive and therefore not legally performative). Alexandra Roberts, *How to Do Things with Word Marks: A Speech-Act Theory of Distinctiveness*, 65 ALA. L. REV. 1035, 1041–45 (2014). Adopting this framework, we might think of the use of the “Cinderella” name by consumers and toymakers as, yes, goods-constative in the sense that it does convey some information about the doll, but also culturally performative in some sense, because it creates the back story for the doll in articulating the connection between it and the fairy tale canon. This seems consistent with Roberts’s note that “[p]erformatives are ‘acts of language that bring things into being, organizing the world rather than simply representing what is.’” *Id.* at 1041 (citing JONATHAN CULLER, *LITERARY THEORY: A VERY SHORT INTRODUCTION* 101–02 (2011)). In this context, it might also be helpful to think in terms of group speech acts in the marketplace, to the extent that we see the consuming public’s use of the word “Cinderella” in play with the toys as performative in this way or perhaps if we think of multiple toymakers using the literary reference in trademarks as creating the full functionality of the toy. For an exploration of the nature of group speech acts, see generally Justin Hughes, *Group Speech Acts*, 7 LINGUISTICS & PHIL. 379 (1984). For a sophisticated linguistic analysis of trademarks, see generally Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621 (2004).

(pictured below on the left) and, indeed, in a typical example of Disney's own Cinderella dolls (pictured below on the right).⁹⁰



Note that the packaging for both dolls features images of the glass slipper.⁹¹ Other than that reference, the *Zombie Cinderella* doll is fully dependent on the presence of the term “Cinderella” to mark the doll with a “back story” in the public domain fairy tale. The dolls are more interesting, more valuable, and more “functional” because we know that they represent Cinderella.

90. The pictures are taken from the Amazon.com ads for each doll. *Once Upon Zombie – I’m Zombie Cinderella*, AMAZON, [hereinafter *Zombie Cinderella Doll*], https://www.amazon.com/Once-Upon-Zombie-Im-Cinderella/dp/B00DHA9REA/ref=sr_1_1?s=toysandgames&ie=UTF8&qid=1503672995&sr=11&keywords=zombie+Cinderella (last visited Nov. 5, 2018) (on the left); *Disney Interactive Studios Disney Store 12” Cinderella Classic Doll with Gus Gus*, AMAZON, [hereinafter *Disney Cinderella Doll*], https://www.amazon.com/DISNEY-STORE-CINDERELLA-CLASSIC-DOLL/dp/B011AAY21Y/ref=sr_1_5?s=toys-and-games&ie=UTF8&qid=1503674695&sr=1-5&keywords=disney+cinderella (last visited Nov. 5, 2018) (on the right). The specimen of use for the Disney word and design mark was merely the mark on what appears to be a label for a shipping carton, as opposed to a retail box for a single doll. Specimen of Use – LABEL, WALT DISNEY’S CINDERELLA, Registration No. 3,057,988.

91. *Zombie Cinderella Doll*, *supra* note 90; *Disney Cinderella Doll*, *supra* note 90.

However, when considering the commercial weakness of the term “Cinderella,” the T.T.A.B. was uninterested in the variety of roles that references to the fairytale character are playing in the marks, the packaging, or the design of the products.⁹² The analysis focused only on the number of market entrants, concluding: “We agree that this evidence demonstrates that the designation CINDERELLA has diminished source-indicating power for dolls that depict the character Cinderella.”⁹³ Curiously, the T.T.A.B. referenced evidence put forward by the examining attorney regarding the many forms of zombie dolls: “Although such dolls take many forms, they are characterized almost universally by eyes having a blank or unnerving stare. Other common characteristics are a blood-stained mouth and signs of bodily decomposition.”⁹⁴ This evidence formed the basis for the T.T.A.B.’s conclusion that “zombie” is indeed “used as an adjective to describe dolls that depict zombies.”⁹⁵ The T.T.A.B. seemed more inclined to view what it termed “the archetype of the ‘zombie’”⁹⁶ as merely descriptive than it is to view the specific character, Cinderella, that way, given its characterization of Cinderella as “highly suggestive.”⁹⁷ Perhaps this is because Cinderella is a well-developed character of the kind we might think of as “recognizable” or “distinct” under copyright doctrine analysis, while a “zombie” is more of an “archetype,” in the language of the T.T.A.B.⁹⁸

In the final analysis, the T.T.A.B. agreed that the mash-up of “zombie” and “Cinderella” gives a “distinct commercial impression” that is different enough from “Walt Disney’s Cinderella” to prevent any consumer confusion.⁹⁹ It concluded:

92. *United Trademark Holdings, Inc.*, 2014 WL 5463042, at *5–6.

93. *Id.* at *6.

94. *Id.* at *7.

95. *Id.*

96. *Id.*

97. *Id.* at *5–6, 8.

98. *Id.* at *4, 7–8. There is good reason to think of “zombie” as also aesthetically functional here, as it is a word with a cultural freight as rich as that of any fairy tale princess, and a current relevance in American pop culture that is difficult to rival. See ROGER LUCKHURST, *ZOMBIES: A CULTURAL HISTORY* 17–41 (2015) (discussing the entrance of the word into the English language and its meaning); James Parker, *Our Zombies, Ourselves*, ATLANTIC, Apr. 2011, at 32 (discussing the pop culture relevance of the zombie).

99. *United Trademark Holdings, Inc.*, 2014 WL 5463042, at *8.

We are persuaded by Applicant's contention that the mark ZOMBIE CINDERELLA creates a 'cognitive dissonance,' involving an uneasy mixture of innocence and horror. By contrast, the registered mark creates an impression of prettiness and goodness. Even if such marks were used on identical goods, these distinct commercial impressions would be distinguishable.¹⁰⁰

This is undoubtedly the right result in this case. The doll market is richer with both interpretations of Cinderella embodied in these very different dolls and the risk of consumer confusion as to source seems negligible. It is ultimately beneficial that both marks are allowed to incorporate the "Cinderella" name. Both toys can take advantage of the reference to the public domain fairy tale in the marks that identify their source for consumers. Meanwhile, consumer confusion between the two marks remains remote as the other elements in each mark, respectively "zombie" and "Walt Disney's," keep the two marks distinct from each other. The reasoning followed by the T.T.A.B. to reach this result, however, is problematic in a number of ways.

First, the emphasis on conceptual weakness along the distinctiveness spectrum sends the message that it is possible to appropriate the name of a public domain character like Cinderella, even for products like dolls, if only your marketing and enforcement strategies are aggressive enough to establish secondary meaning. The result is to incentivize companies to attempt appropriation of public domain characters via trademark rights. Indeed, in the wake of their successful application for ZOMBIE CINDERELLA, the applicants for the ZOMBIE CINDERELLA mark have since shifted tactics and attempted to register multiple names of public domain characters for dolls. For instance, in the months following the T.T.A.B.'s ruling regarding ZOMBIE CINDERELLA, United Trademark Holdings, Inc. filed applications for word marks for dolls in the names of several public domain characters, including two characters from tales written in the nineteenth century by Hans Christian Andersen: the Little

100. *Id.*

Mermaid¹⁰¹ and the Snow Queen,¹⁰² plus the Snow Maiden, the heroine of a nineteenth-century Russian tale and opera,¹⁰³ and Rapunzel, the heroine of a fairytale with a history as old as that of Cinderella.¹⁰⁴ Both of the Hans Christian Andersen tales have been adapted by the Walt Disney Company for animated films, *The Little Mermaid* in the 1989 film of the same name¹⁰⁵ and *The Snow Queen* in the 2013 blockbuster, *Frozen*.¹⁰⁶ While the T.T.A.B. affirmed refusal of LITTLE MERMAID for dolls because of its descriptiveness,¹⁰⁷ registrations have issued for SNOW QUEEN¹⁰⁸ and SNOW MAIDEN,¹⁰⁹ both for dolls and toy figures. The application for RAPUNZEL for dolls and toy figures is still pending.¹¹⁰

The commercial realities of the market for licensed toys and merchandise make it attractive for companies to attempt to establish these rights. The market in licensed goods is enormous, with the top 150 licensors alone reporting \$262.9 billion in retail sales of licensed goods worldwide in fiscal year 2015.¹¹¹ The practice of licensing

101. U.S. Trademark Application Serial No. 86/836,082 (filed Dec. 1, 2015); see also HANS CHRISTIAN ANDERSEN, *The Little Mermaid*, in THE ANNOTATED HANS CHRISTIAN ANDERSEN 119, 119–55 (Maria Tatar ed., 2008).

102. U.S. Trademark Application Serial No. 86/886,490 (filed Jan. 26, 2016); see also Joan G. Haahr, *Snow Queen, The*, in THE OXFORD COMPANION TO FAIRY TALES 478, 478 (Jack Zipes ed., 1999).

103. U.S. Trademark Application Serial No. 86/496,765 (filed Jan. 26, 2016); see also Richard Taruskin, *Snow Maiden, The*, in THE GROVE BOOK OF OPERAS 573, 573–75 (Stanley Sadie ed., 2d ed. 2008).

104. U.S. Trademark Application Serial No. 87/690,863 (filed Nov. 20, 2017); see also Karen Seago, *Rapunzel*, in THE OXFORD COMPANION TO FAIRY TALES 415, 416 (Jack Zipes ed., 1999).

105. *In re United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d (BNA) 1796, 1798 (T.T.A.B. 2017); see also Maria Tatar, *Notes to The Little Mermaid*, in THE ANNOTATED HANS CHRISTIAN ANDERSEN 119, 120 (2008) (noting that “the animated Disney version of ‘The Little Mermaid’ (1989) deviates sharply from the tale that inspired it[,] . . . but [as in Andersen’s tale,] female desire dominates the film . . . [and] the Disney version has in many ways kept Andersen’s story alive . . .”).

106. See generally Samantha Langsdale, *Disney Classics and ‘Poisonous Pedagogy’: The Fairytale Roots of Frozen (2013)*, 4 ANIMATION PRACTICE, PROCESS & PRODUCTION 27 (2014).

107. *United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d at 1800.

108. THE SNOW QUEEN, Registration No. 5,079,718.

109. SNOW MAIDEN, Registration No. 5,064,887.

110. U.S. Trademark Application Serial No. 87/690,863 (filed Nov. 20, 2017). As of May 2017, the mark was published without so much as a single office action, and I have filed a notice of opposition.

111. Tony Lisanti, *The Top 150 Global Licensors*, LICENSE! GLOBAL, May 2016, at T3, <http://www.licensemag.com/license-global/top-150-global-licensors-2>.

characters for toys and other merchandise is longstanding, with roots going back at least to the 1930s with product tie-ins to Shirley Temple films and radio programs like *Little Orphan Annie*.¹¹² It was not until the years between 1977 and 1990, however, that the sale of licensed products took off, increasing more than tenfold in that decade as the toy industry and the entertainment industry increasingly came together to capitalize on the benefits of a relationship between a toy and a character that is known to consumers.¹¹³ It has been observed that “licensed characters offer an easily identifiable toy or story line,” among other benefits.¹¹⁴ This is an important advantage because the toy industry, like the entertainment industry, is notoriously volatile.¹¹⁵ Licensing characters out to toymakers and other merchandizers provides a vital revenue stream for content creators.¹¹⁶ Content in the form of movies, television, or other programming that features the character provides a form of advertising for the product.¹¹⁷ When toymakers license a known character in, they reduce the risk in marketing a new product and, depending on how evergreen the popularity of the character is, they potentially increase the “shelf life” of the new product line based on that character.¹¹⁸ Today, the licensor with the highest revenue in sale of licensed products is The Walt Disney Co., with \$52.5 billion in retail sales for the 2015 fiscal year.¹¹⁹ With traditional royalty rates of 5 to 15% of wholesale cost,¹²⁰ Disney’s profit from those sales is probably significant.

The business model is yet more advantageous when the “known” characters embodied in the licensed products are taken freely from the public domain, with perpetual name recognition and a centuries-long track record of approval from generations of parents and

112. NORMA ODOM PECORA, *THE BUSINESS OF CHILDREN’S ENTERTAINMENT* 21 (1998).

113. *Id.* at 56–57.

114. *Id.* at 57.

115. *Id.* at 46.

116. Of course, some characters begin life as toys and are licensed out to or co-produced with partners in the entertainment industry for the creation of programming centering around the toy. Famous examples include the Smurfs and He-Man. *Id.* at 60–61. The same commercial principles should apply regardless of where the cycle of product development and programming begins.

117. *Id.* at 40.

118. *Id.* at 51.

119. Lisanti, *supra* note 111, at T6.

120. PECORA, *supra* note 112 at 55.

children. One can hardly blame United Trademark Holdings, Inc. for pursuing the potential profits in purporting to secure exclusive trademark rights to such characters. Doing business as The Toon Studio,¹²¹ United Trademark Holdings, Inc. maintains a website offering to license its characters:

Toon Studio Licensing offers the most iconic and evergreen characters and brands in the world. From our priceless library of original vintage art to our updated renditions of the celebrated and beloved Fairy Tale Characters including Snow White, Cinderella, Peter Pan, Tinker Bell, Sleeping Beauty and hundreds more, we can elevate and super charge your consumer products!¹²²

The statement walks a fine line, describing the company as one that “controls one of the largest Fairy Tale children’s book collection [sic] and 78 RPM record album archives.”¹²³ That statement strongly implies to potential licensees that the Toon Studio exclusively “controls” the IP rights in its “Fairy Tale children’s book collection,” right down to exclusive control of the characters themselves.

This indeed is the impression given by coverage of Toon Studio in the merchandizing trade press. In an interview given to *Retail Merchandiser Magazine* in 2012, the CEO of Toon Studio made the following remarks:

We acquired the book and record properties for the purpose of licensing the evergreen, iconic characters of the licensing world. We intend to become fairy tale headquarters by bonding with consumers There is nothing like music and books to

121. *Home*, TOON STUDIO, <http://www.thetoonstudio.com/Home.html> (last visited Nov. 5, 2018). The Toon Studio sounds like a generic version of Disneytoon Studios, which was the name given to the division of the Walt Disney Co. that produces direct-to-DVD films in a reorganization of the company in 2003. Sarah Baisley, *Disneytoon Studio Builds Slate Under New Name and Homes for Needy*, ANIMATION WORLD NETWORK (June 16, 2003, 12:00 AM), <https://www.awn.com/news/disneytoon-studios-builds-slate-under-new-name-and-homes-needy>.

122. *About Toon Studio*, TOON STUDIO, <http://www.thetoonstudio.com/about.html> (last visited Nov. 4, 2018).

123. *Id.*

touch a child's soul, and we have so many assets we need to make use of. Building the bond will build our brand.¹²⁴

The article observes that “trying to create a lasting connection with consumers is a daunting task” because “fads fade away, but some properties have value that can't easily be duplicated.”¹²⁵ The writer then reports:

This is why The Toon Studio of Beverly Hills is confident about the future after acquiring the worldwide exclusive rights to a stable of iconic children's books and records, representing evergreen characters that include Snow White, Cinderella, Peter Pan, Tinker Bell, Alice in Wonderland, Aladdin, the Little Mermaid, and the Wizard of Oz.¹²⁶

Under copyright doctrine, it is relatively easy to establish that the claim to have acquired “worldwide exclusive rights” to such “evergreen characters” from public domain works is nonsense.¹²⁷ Not even the Grimm Brothers themselves claimed to control the characters that their collections of folk tales disseminated to the world.¹²⁸ But trademark doctrine's reliance on the distinctiveness spectrum to identify references to public domain characters as descriptive of the products that embody the characters has left just enough of a door open to incentivize such overreaching claims.

124. *The Toon Studio of Beverly Hills*, RETAIL MERCHANDISER MAG. (Jan. 3, 2012), <http://www.retail-merchandiser.com/reports/licensing-reports/330-the-toon-studio-of-beverly-hills>.

125. *Id.*

126. *Id.*

127. Section 103(b) of the copyright statute states that “[t]he copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.” 17 U.S.C. § 103(b) (2006). The multiple translations and adaptations of fairy tales published over the years are derivative works that employ pre-existing material in the public domain. Thus, Toon Studio has copyright, at most, only in the new contributions, if any, made by the particular adaptation whose copyright they have acquired. The statute goes on to clarify that “[t]he copyright in such [compilation or derivative] work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.” *Id.*

128. Vladimar Hafstein, *Fairy Tales, Copyright, and the Public Domain*, in THE CAMBRIDGE COMPANION TO FAIRY TALES 11, 13 (Maria Tatar ed., 2015).

To make matters worse, trademark doctrine's approach to this issue has resulted in inconsistent application of the doctrine by the Patent and Trademark Office. For instance, both the Snow Queen and the Little Mermaid are characters from the short stories of Hans Christian Andersen. United Trademark Holdings, Inc. applied for word marks consisting only of the character's name for dolls. The application for the Little Mermaid was rejected as descriptive of the product. Undoubtedly the construction of the name, an adjective, "little," plus an ordinary noun, "mermaid," aided the examining attorney in conceptualizing the name as descriptive.¹²⁹ The applicant actually argued in response that the phrase could not be merely descriptive because it referenced "a particular fictional character in the public domain."¹³⁰ The T.T.A.B.'s opinion on this point is instructive:

[A] fictional public domain character like the Little Mermaid of Hans Christian Anderson [sic] fairy tale is *not necessarily* linked to a specific commercial entity and may be presented in various embodiments because prospective purchasers expect dolls labeled as LITTLE MERMAID to represent the fairy tale character and, thus, describes the purpose or function of the goods (i.e., to represent the Little Mermaid of the fairy tale).¹³¹

The T.T.A.B. is careful here to leave open the possibility that a public domain character *could be* but is "*not necessarily*" linked in the minds of consumers with a specific commercial entity, though the doctrine would appear to instruct a finding of descriptiveness any time that "purchasers expect dolls labeled as LITTLE MERMAID to represent the fairy tale character."¹³² So, any time that the reference to the tale functions at all, it should be found descriptive and the applicant should be forced to at least demonstrate the establishment of secondary meaning (that is, to demonstrate that consumers think primarily not of the character but of the source of the goods).

In contrast to the analysis applied to the LITTLE MERMAID application, however, the SNOW QUEEN application was approved

129. *In re* United Trademark Holdings, Inc., 122 U.S.P.Q.2d (BNA) 1796, 1797 (T.T.A.B. 2017).

130. *Id.*

131. *Id.* at 1799 (emphasis added).

132. *Id.*

without a single office action.¹³³ There is no policy by which we can distinguish these two cases. At the time of the application, which was an intent-to-use application,¹³⁴ there was no reason for consumers to associate Toon Studio with the Snow Queen any more than they would associate Toon Studio with the Little Mermaid.¹³⁵ Yet there remains a significant advantage in appropriating the reputation, the tradition, the legacy of the known character, as is demonstrated by Toon Studio's own strategy. Today, Toon Studio is licensing their SNOW QUEEN word mark in a form that features the words SNOW QUEEN over a field of ice crystals that also incorporates both the house mark of Toon Studio and the name of the author of the public domain tale, Hans Christian Andersen.¹³⁶ The specimen of use that was ultimately submitted to the United States Patent and Trademark Office apparently includes these elements, but the picture is too small to see anything other than the words "Snow Queen."¹³⁷ There is every

133. See THE SNOW QUEEN, Registration No. 5,079,718, (prosecution history available at http://tsdr.uspto.gov/#caseNumber=86886490&caseType=SERIAL_NO&searchType=statusSearch).

134. *In re United Trademark Holdings, Inc.*, No. 85706113, 2014 WL 5463042, at *1 n.1 (T.T.A.B. 2014).

135. The potential claim to copyright in any one of the many modern published versions of such nineteenth-century stories would not change that general principle, but in any case, it appears to be irrelevant for Snow Queen and Little Mermaid. The "exclusive rights to a stable of iconic children's books" claimed by Toon Studio's CEO in the interview quoted above are apparently based on the acquisition of the copyright in Rand McNally's Junior Elf series of children's books. *The Toon Studio of Beverly Hills*, *supra* note 124; *History of Junior Elf*, JUNIOR ELF, <http://www.juniorelf.com/history.php> (last visited Nov. 4, 2018); see also *Home*, TOON STUDIO, <http://www.thetoonstudio.com/Home.html> (last visited Nov. 4, 2018) (listing the Junior Elf logo as among those on offer from Toon Studio). There is not a stand-alone edition of Andersen's tales listed on the Junior Elf site, and, if any of Andersen's tales are otherwise incorporated into the handful of compilations on the list (e.g., "Twilight Tales," or "Bedtime Stories"), it is not apparent from any of the titles. See *Index*, JUNIOR ELF, <http://www.juniorelf.com/index.php> (last visited Nov. 4, 2018). The Hans Christian Andersen Centre of Syddansk University maintains an index of editions of Andersen's work at http://andersen.sdu.dk/liv/index_e.html. It also does not list a Rand McNally/Junior Elf edition of the tales.

136. *Snow Queen*, TOON STUDIO, <http://www.thetoonstudio.com/snow-queen.html> (last visited Nov. 4, 2018).

137. Specimen, THE SNOW QUEEN, Registration No. 5,079,718. The specimen, which is on the boxes for relatively generic blonde dolls, each also labelled with a character name (respectively Snow Maiden and Snow Queen), can be found here: <http://tsdr.uspto.gov/documentviewer?caseId=sn86886490&docId=SOU20160831182>

indication, then, that Toon Studio is attempting to bootstrap a registration for SNOW QUEEN for dolls into an exclusive right to merchandise Hans Christian Andersen's character. The deep irony of this is that Andersen himself sometimes struggled during his life to defend his claims of authorship because of the nature of his work's close relationship with folk tales, understood to be common to all.¹³⁸

The SNOW QUEEN result cannot be the right result under any of the policies that undergird trademark law, including those invoked by the T.T.A.B.'s LITTLE MERMAID opinion. If we are concerned about preventing consumer confusion and lowering consumer search costs, the implications of the Snow Queen/Hans Christian Andersen/Toon Studio mark are to create a false association between the author's character and Toon Studio, one of exclusive ownership.¹³⁹ If we are concerned about the competitive need to use descriptive words and thus about reserving trademark rights only for source-identifying words or symbols, then the T.T.A.B. was clear in the LITTLE MERMAID opinion. Under current doctrine, references to public domain characters should be classed as descriptive when consumers associate such references with the character embodied by the product,

739#docIndex=5&page=1. Note that the names of the dolls are doing significant work here to distinguish them from each other. The only other differences appear to be the color of their dresses and the color of their eye shadow. *Id.*

138. Hafstein, *supra* note 128, at 11.

139. One might argue in response that the implication is not of exclusive ownership in general, but only in connection with the goods and services that Toon Studio offers in commerce with the mark attached. But that is not how the merchandising business model is working for them—see *infra* note 140 and accompanying text. Rather, this is a model in which trademark rights are projected into new categories of goods and services via licensing agreements with product developers, while the trademark holder collects fees (and, at least in theory, exercises quality control). This “project-and-collect” model is not always problematic—think, for instance, of the now-common expansions of “lifestyle” brands, like Skinnygirl, which began as a brand for cocktail mixers and now labels a wide variety of products. See *A Lady Knows About Skinny Girl Cocktails*, SKINNY GIRL COCKTAILS, <https://www.skinnygirlcocktails.com/about-us> (last visited Nov. 5, 2018); see also Lizzie Widdicombe, *Perfect Pitching: Bethenny Frankel and the New Breed of Celebrity Entrepreneur*, NEW YORKER (Sept. 21, 2015), <https://www.newyorker.com/magazine/2015/09/21/perfect-pitching>. “Project-and-collect” business models are problematic in the context of marks that invoke public domain characters because there is a public interest in the cultural meaning of the character apart from the trademark owner's goodwill. Why should one trademark owner, particularly one that had nothing to do with the creation of the character, exclusively control the projection of those character elements into theoretically unlimited categories of merchandise?

not with the commercial entity that is the source of the product. To the extent that Toon Studio is pursuing licensing fees for use of the word mark in association with products or services that embody Andersen's character,¹⁴⁰ they are also increasing the costs of creating such products and raising barriers to competition in the form of other products or services that embody Andersen's character. This is inconsistent with trademark policy that seeks to promote fair competition.

The inconsistent application of the doctrine in these cases is at least partly a function of the uneasy fit between character elements and the distinctiveness spectrum. Approaching this as a distinctiveness problem focuses on the linguistic relationship between the name and the goods as a matter of how the language works, as opposed to the broader cultural value of the name in relation to the goods. This framework tends to elide what we might think of as the cultural work that the purported mark is doing, whether the mark is a word that invokes the character or a product design that embodies elements of the character. Depending on the kind of mark at issue (word mark or trade dress) and the type of goods, the "cultural work" that the mark is doing may not fit into one of the four categories that have been placed on the *Abercrombie* spectrum, the primary test for

140. Toon Studio has publicized two of its Snow Queen licensing deals. See *Licensing News: Snow Queen Live Shows in Australia*, TOON STUDIO, <http://www.thetoonstudio.com/news.html> (last visited Nov. 5, 2018). One is for the creation of a live-action show in Australia. *Id.* To the extent that the show is a dramatic enactment of Hans Christian Andersen's tale, a license to do that in general should not be necessary. Perhaps payment of a fee is commercially reasonable if it is for (and set at the value of) using the particular artwork developed by Toon Studio to embody the characters? That would be fairly unproblematic if understood to be a copyright license for the derivative work created by Toon Studio, their version of the Snow Queen character. The danger here, of course, is that their live-action entertainment partner might leverage exclusive trademark rights in the word mark to prevent other entertainers from offering similarly-named "services" within their territory. Registrations of character names for entertainment services is not unheard of. See, e.g., RAPUNZEL, Registration No. 4,094,086. Disney's registration of the word mark RAPUNZEL for services including "entertainer services, namely, live appearances by a professional entertainer." *Id.* Toon Studio's other publicized deal is for the use of "Snow Queen, the Ice Princess Collection" for "shampoo, bath gels, perfume and other beauty related products." *Licensing News: Snow Queen Live Shows in Australia*, *supra* note 140. Again, if understood to be a copyright license to use Toon Studio's particular artwork depicting the Snow Queen on the shampoo label, it seems unproblematic, but Toon Studio's press release implies that the license is for use of Hans Christian Andersen's character: "The Snow Queen is the original Hans Christian Andersen tale beloved by children all over the world." *Id.*

determining the inherent distinctiveness of word marks.¹⁴¹ For instance, the T.T.A.B. in the *Zombie Cinderella* case struggled to see the Cinderella name as merely descriptive, referring to it as “at best suggestive.”¹⁴² I think this is because the relationship between the Cinderella character and the Cinderella dolls isn’t only adjectival. The *Abercrombie* spectrum distinguishes between “suggestive” marks and marks that are “merely descriptive” with the imagination test.¹⁴³ That is, if it “requires the consumer to exercise the imagination in order to draw a conclusion as to the nature of the goods and services,” then the mark is suggestive and may be protected without a showing of secondary meaning.¹⁴⁴ Consider the wide range of Cinderella dolls that were in evidence before the T.T.A.B. in the *Zombie Cinderella* case.¹⁴⁵ In some sense, it does require imagination to draw a conclusion as to how each of those products interacts with the Cinderella character or how the product might interpret the character. Understanding the relationship between the character and the doll does engage the imagination—this is the whole point of making the reference. In that sense, I can understand why the T.T.A.B. hedged the issue by thinking in terms of suggestiveness rather than descriptiveness. Yet that result dictates a finding of inherent source distinctiveness, which thoroughly discounts the significance of the character reference in the mark.

Even when a court finds that a character element in a mark is descriptive of, say, a doll, that finding merely folds the problem back onto whether the trademark applicant can establish secondary meaning.¹⁴⁶ A focus on secondary meaning seems equally problematic in connection with products that depict or otherwise closely engage with character elements in the public domain. The factors we look at to establish secondary meaning answer a very different question from whether there is a separate cultural resonance that makes the purported mark meaningful for reasons completely unrelated to the source identification of the goods. These would include “factors such as amount and manner of advertising, volume of sales, and length and

141. See *Abercrombie & Fitch Co. v. Hunting World*, 537 F.2d 4, 9 (2d Cir. 1976).

142. *In re United Trademark Holdings, Inc.*, No. 85706113, 2014 WL 5463042, at *9 (T.T.A.B. 2014).

143. *Abercrombie & Fitch Co.*, 537 F.2d at 11.

144. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983).

145. See *supra* note 86–90 and accompanying text.

146. *Zatarains, Inc.*, 698 F.2d at 791.

manner of use," remembering that "the question is not the extent of the promotional efforts, but their effectiveness in altering the meaning of [the term] to the consuming public."¹⁴⁷

The factors for establishing secondary meaning are a prescription for aggressive promotion of marks that appropriate public domain characters, with the explicit goal of draining the character of whatever meaning it once had and replacing it with source identification. At the very least, that goal is counter-productive to the trademark holder, who of course intends to use the character's familiarity and ready-made narrative to give the goods additional value, at least when the goods are expressive of the character. A trademark holder who is successful in altering the meaning of a character so that its primary significance is source identification impoverishes the public domain of the character's living meaning, rendering it an animated corpse. No one, not even the potential trademark holder, really wants to fully replace the cultural meaning in a public domain character with the reputational meaning or source identification of the trademark holder. Trademark holders want to use the character's cultural meaning to their advantage in communicating with consumers. They should be allowed to do so, just as we allow trademarks to contain generic terms, just not exclusively and not without some other component in the mark that can make the whole combination source-identifying.¹⁴⁸

There is considerable support for dealing with this problem at least in part by using the last applicable category on the *Abercrombie* spectrum, genericism. Elizabeth Rosenblatt has argued that "the existing doctrine of genericity should eliminate the ability to claim trademark rights in literary characters and character names that have entered the copyright public domain."¹⁴⁹ She explains that the doctrine "embodies the basic principle that trademark law does not

147. *Id.* at 795 (citing *Aloe Cream Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 850 (5th Cir. 1970)).

148. For a discussion of doctrine allowing the possibility of trademark rights in a mark that combines generic elements into a distinctive, trademark-able whole, see generally *Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns, Inc.*, 198 F.3d 1143 (9th Cir. 1999).

149. Rosenblatt, *supra* note 8, at 625. Prof. Rosenblatt cabins the argument in that particular article to literary characters and names, noting: "I steer clear of visual or hybrid characters here . . . not because I believe the proposal might not apply to them, but because questions of genericism and secondary meaning may be slightly more complicated for them." *Id.* at 625 n.301.

protect generic terms, which are defined as the ‘common descriptive name’ for a type of product or service.”¹⁵⁰ Applying the doctrine to literary characters and names, Prof. Rosenblatt asserts that:

Just as the term “apple juice” is the generic term for the juice of apples, the term “Sherlock Holmes” is the generic term for the detective Sherlock Holmes. Just as a bottle of apple juice can be marked with the term “apple juice” without fear of infringement, an adaptor should be able to use the term “Sherlock Holmes” to identify the contents of expressive work featuring the character Sherlock Holmes without trademark repercussions.¹⁵¹

The doctrine of genericity could be made to distinguish between trademark rights in character names that are unproblematic and those that should not be allowed by asking whether the mark is for “expressive goods and services,” so that:

[C]haracters’ names would still be amenable to protection as marks for other goods and services—Sherlock Holmes pipe tobacco, Beowulf Pet Day Care But for *expressive* goods and services, when characters enter the copyright public domain, they and their names should be treated as generic for the fiction they represent.¹⁵²

I agree that this approach would achieve the right result and that it should be workable for some combinations of character elements and goods.

However, I think we need not decide on a single doctrine. Rochelle Cooper Dreyfuss, when developing what she termed “expressive genericity” as a defense for expressive uses of word marks, asserted that:

Because trademark law differs from ordinary first amendment jurisprudence precisely in the greater attention that it has paid to the significance of words . . . its other facets may also be useful templates upon which to build safeguards for speech. Thus, attention should be paid to defenses such as fair use,

150. *Id.* at 625.

151. *Id.* at 626.

152. *Id.*

functionality, abandonment, laches and continuous prior use. Further elaboration of these doctrines would flesh out the buffer between public and private rights in words.¹⁵³

A similar assertion is possible with respect to trademark doctrine's engagement with characters as marks. Multiple doctrines may make productive contributions to resolving the issues.

Nonetheless, genericism does not feel as if it can be a complete solution to the problem. Because of the mechanical way in which the existing doctrine applies analysis of the relationship between the mark and the goods, for instance, the T.T.A.B. and examining attorneys have at times struggled to see character elements as even descriptive of such expressive goods. Note, again, that here the Board actually thought of the "Cinderella" name as "at best suggestive" of the doll's qualities.¹⁵⁴ The examining attorney's final office action refusing registration for ZOMBIE CINDERELLA disposed of the evidence relating to the public domain fairy tale by making the following distinction:

Applicant further argues that the marks are not similar because the term 'CINDERELLA' is conceptually weak for dolls and therefore highly suggestive. However, applicant's evidence of public domain use of the term 'CINDERELLA' relates to use of the term in connection with stories and movies, not dolls.¹⁵⁵

Another examining attorney made virtually the same argument in the final office action refusing United Trademark Holdings, Inc.'s application for ZOMBIE SLEEPING BEAUTY, on the theory that it was likely to be confused with WALT DISNEY'S SLEEPING BEAUTY: "[A]pplicant's evidence of public domain use of the term 'sleeping beauty' relates to use of the term in connection with stories. . . . In this case, the goods at issue are 'dolls.'"¹⁵⁶ That is, the examining attorneys saw "stories" and "dolls" as such separate product categories that the meaning of the character in relation to the

153. Dreyfuss, *supra* note 81, at 423.

154. *In re* United Trademark Holdings, Inc., No. 85706113, 2014 WL 5463042, at *9 (T.T.A.B. 2014).

155. Office Action, ZOMBIE CINDERELLA, Registration No. 4,822,434.

156. Office Action, ZOMBIE SLEEPING BEAUTY, Registration No. 4,752,257.

story wouldn't control its meaning in relation to dolls.¹⁵⁷ In this mindset, seeing the name of the character from the story as a generic term for the dolls would be a further stretch. One can imagine an examining attorney arguing that the goods are "dolls," not "Cinderellas." What about other toys or games or costumes invoking the character through the character name or through references to the character's story? While it might be possible to conceive of calling the product a "Cinderella" when you are looking for a Cinderella doll, is the same true of a social media app in which users meet with Cinderella in her castle? The semantic equivalence between the class of the goods and the name of the character is less complete in the case of the app, but the app is no less expressive of the public domain material.¹⁵⁸

The uneasiness of the fit between characters and the *Abercrombie* spectrum is only exacerbated in the context of trade dress. In a trade dress case, for example, the issue presented may be whether a non-verbal element of packaging or product design that evokes Cinderella's story is eligible for protection. In the past, holders of IP rights in characters have raised claims, sometimes in troubling ways, based on nonverbal elements of character design to prevent competition from the makers of toys (or even other expressive works) similar to their characters.¹⁵⁹ In the case of packaging involving

157. This mindset, of course, vastly underappreciates the power of the fairy tale to create meaning that can be ported across genres and media. It is, however, probably a mindset that is encouraged by the *Trademark Manual of Examining Procedure*, which instructs that "marks that merely identify a character in a creative work" are not registrable as marks for the creative work without a showing that the mark functions as a trademark. U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.10 (2017). "For example, the applicant may submit evidence showing use of the character name as a mark on the spine of the book, or on displays associated with the goods, in a manner that would be perceived as a mark." *Id.* So there is a kind of presumption that character names do not function as marks for the stories in which they appear, but it is overcome by evidence that the character name is used as a mark. This implies that trademark use of a character in connection with even the creative work in which the character appears will replace the significance of the character with source identification.

158. For these same reasons, trademark fair use doctrine is unlikely to alleviate all of the problems caused by exclusive trademark rights in public domain characters for products that embody or otherwise engage with the character. Trademark fair use doctrine requires that the defendant asserting the defense make a showing that the defendant is using the mark descriptively and not as a trademark.

159. See, e.g., *Ideal Toy Corp. v. Kenner Prods.*, 443 F. Supp. 291 (S.D.N.Y. 1977) (in which *Ideal Toy* sought declaratory judgment that their "Star Team" toys did not infringe "Star Wars" film, and defendants moved for a preliminary injunction against

nonverbal design elements, the *Abercrombie* spectrum may be difficult to apply in a way that would recognize the significance of public domain material.¹⁶⁰ Imagine a box for a line of Cinderella character dolls in the shape of a pumpkin carriage or a box for a Snow White doll that looks like a glass coffin. Such packaging elements would not literally depict or describe the doll inside, but they would embody elements of the character's story that, I argue, should not be exclusive to any one producer of dolls. In the case of elements of product design that embody a character or otherwise call out aspects of a character's story, such as the pumpkin, the prince, and the fairy godmother incorporated into the design of the Dolly Pockets Cinderella doll, the rule in *Wal-Mart v. Samara Brothers* dictates that such marks cannot be inherently distinctive.¹⁶¹ Thus, the focus would inevitably be on whether the purported trademark holder had established secondary meaning in those aspects of the design, with all of the concerns inherent in that analysis described above.

The very benefit involved in exclusively appropriating public domain characters demonstrates the reason it should be impossible to do so under trademark doctrine. In the parlance of aesthetic functionality, references to public domain characters in the names or designs of products that embody such characters are useful product features. These features should be kept available for all producers to

Ideal Toy's distribution of its own toys, in part on the grounds of an unfair competition claim due to "visual similarities between the toys themselves and the [Star Wars] movie characters"); *Processed Plastic Co. v. Warner Commc'ns, Inc.*, 675 F.2d 852 (2d Cir. 1982) (in which a preliminary injunction against a toymaker distributing cars that look similar to the "General Lee" car from the *Dukes of Hazzard* television show was affirmed in part on grounds that the appearance of the car has acquired secondary meaning); *Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76 (2d Cir. 1981) (in which the appearance of the "General Lee" car from the *Dukes of Hazzard* television show was protected under Section 43(a) of the Lanham Act); *Warner Bros. Inc. v. Am. Broad. Cos.*, 720 F.2d 231 (2d Cir 1983) (in which owners of the Superman character of comic book, movie, and television fame attempted to enjoin the makers of *The Greatest American Hero* television series).

160. The *Seabrook* test, developed to analyze the inherent distinctiveness of non-verbal marks, is not any more likely to help a court or examining attorney detect and understand public domain character elements. *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977). It is focused primarily on whether the shape is unusual and commercially distinct in the field. *Id.* If the shape is not inherently distinctive, then the purported markholder may still attempt to show secondary meaning. *Id.* at 1345-46.

161. 529 U.S. 205, 212 (2000).

use without fear of infringement liability. In the next section, I turn to the doctrine of aesthetic functionality, which I argue, gives courts (and decisionmakers at the PTO) a better tool for perceiving and preserving the vital role that public domain character elements play in our material culture.

III. A HAPP(IER) ENDING WITH AESTHETIC FUNCTIONALITY?

This section of the Article explores how aesthetic functionality could apply in public domain character cases, beginning with how it would have changed the reasoning in the *Zombie Cinderella* case. I argue that the application of aesthetic functionality to certain uses of public domain character names and traits is consistent with both the broader contours of the doctrine and the more tailored understanding of aesthetic functionality doctrine advanced by Justin Hughes.¹⁶² Robert Bone has observed that functionality doctrine in general first grew out of nineteenth-century case law in which judges “struggled to reconcile the right to copy [absent patent or copyright protection] with liability for passing off.”¹⁶³ Since that time, he argues, the idea of a natural right to copy in the case law has evolved into something more like a recognition that “the Lanham Act’s policy in favor of preventing consumer confusion must be coordinated with the public domain policies embodied in the Patent and Copyright Acts.”¹⁶⁴ Crucially, Prof. Bone urges that we should understand functionality doctrine as balancing “trademark-related benefits of protecting source-identifying trade dress” with “the costs of restricting access to and use of product features.”¹⁶⁵ Though both utilitarian and aesthetic functionality are most often applied in cases involving trade dress (product packaging or design), it may be helpful to note that courts have applied the concept to verbal marks as well.¹⁶⁶ So I think there

162. See generally Hughes, *supra* note 19.

163. Bone, *supra* note 30, at 195.

164. *Id.* at 220.

165. *Id.* at 222.

166. See, e.g., *Damn I’m Good, Inc. v. Sakowitz, Inc.*, 514 F.Supp. 1357, 1362 (S.D.N.Y. 1981) (holding that an inscription on a bracelet reading “Damn I’m Good” is “a crucial ingredient in the commercial success of plaintiff’s product, independent of any source-identifying function it might serve and thus is a functional feature”); *Smith v. Krause*, 160 F. 270, 271 (S.D.N.Y. 1908) (holding that the words “Merrie Christmas” woven into gift wrap ribbon are not a trademark because “the words, when put on the ribbon . . . are an integral part of the ribbon, adding to its value”).

is hope that the doctrine is supple enough to deal with both images and names of characters in verbal and nonverbal marks.¹⁶⁷

Following from those observations, as a threshold matter, applying aesthetic functionality to public domain characters would require that we understand the cost of restricting access to public domain characters to be high in certain contexts, outweighing whatever source-identifying benefits there might be. In the case of public domain characters, particularly those appropriated by producers who had no hand in the origin of the character, those source-identifying benefits are dubious in the first place, if we allow that some part of the character's meaning will always indicate something other than the source of the product. So, given that the source-identifying benefit is likely to be low, in which contexts are the costs of trademark protection for a character too high? Mark McKenna has observed that "every court that recognizes aesthetic functionality views that doctrine solely through the lens of competitive need."¹⁶⁸ That is, courts that apply aesthetic functionality to deny trademark protection do so on the basis of a need to access the claimed feature in order to compete with the purported trademark holder's goods. As a result, the doctrine will have the best fit with character marks for goods that are expressive of the character, either embodying the character in design, depicting its image, or otherwise engaging with the character's story, such that exclusive rights in the mark would raise barriers to a competitor marketing a product with the same attractions.

This approach is consistent with the Supreme Court's most recent guidance on functionality doctrine in *Qualitex* and *TrafFix*. As the *Qualitex* court explained, "The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature."¹⁶⁹ The Court goes on to summarize the test for functionality in the following way: "In general terms, a product feature is functional,' and cannot serve

167. Like genericity doctrine, I think aesthetic functionality doctrine is also supple enough to distinguish between uses that are aesthetically functional and those that are not. Just as a word can be generic when used in some contexts but not others, a character name or trait may be aesthetically functional in relation to some goods but not others. So a finding of aesthetic functionality need not destroy all trademark rights in a character. Cf. Dreyfuss, *supra* note 81, at 418 & n.119.

168. McKenna, *supra* note 30, at 848.

169. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,' that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage."¹⁷⁰ The Court further elaborated, "The functionality doctrine thus protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely, their inability reasonably to replicate important non-reputation-related product features."¹⁷¹ In *Traffix*, the Court subsequently clarified that the competitive necessity test should be reached only in cases of aesthetic functionality: "It is proper to inquire into a 'significant non-reputation-related disadvantage' in cases of [a]esthetic functionality, the question involved in *Qualitex*. Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature."¹⁷²

The invocation of the Cinderella name via the mark is a useful product feature of the doll. Engagement with the long and already beloved legacy of the fairy tale gives Disney a "leg up" in developing (and marketing) their product. With the "Cinderella" name affixed, the doll comes pre-packaged with the narrative of the fairy tale as her "backstory," not to mention the vast interpretive tradition of play with the character. These are qualities of the "Cinderella" component of the mark that are not related to the recognition or reputation of Disney, and are relatively easy to identify because, in this case, they existed prior to Disney's appropriation of the character. I do not think it is a stretch, then, to conceive of using the "Cinderella" name in connection with a doll as a non-reputational advantage.

The more difficult step is identifying the competitive necessity to use it. Mark McKenna has noted that "what is no doubt preventing courts from recognizing any right to copy aesthetic features is the near uniform sense that aesthetic features generally are not competitively necessary."¹⁷³ That is, if one aesthetic design is appealing, why couldn't another design be equally competitive in the market, especially since aesthetic preferences among consumers differ?¹⁷⁴ In

170. *Id.* at 165 (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).

171. *Qualitex Co.*, 514 U.S. at 169.

172. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001).

173. McKenna, *supra* note 30, at 846.

174. See Bone, *supra* note 30, at 239 (noting that the "heterogeneity of aesthetic preference" makes it difficult to evaluate the relative competitiveness of alternative designs).

the context of characters, this issue is resolved where the individual, recognizable characters are not fungible. One fairy tale princess, for instance, is not a reasonable substitute for another. Cinderella's name functions in a particular way in the doll market in part because of the long history of that tale within the pantheon of fairy tales that proved so formative of children's literature.

The competitive necessity to use Cinderella's name (or other elements of the character in the doll's design) can be analogized to the competitive necessity identified in classic aesthetic functionality cases. Consider *Smith v. Krause*, in which the court considered whether the words "Merrie Christmas" woven into ribbon for gift wrapping can serve as a mark for the ribbon. The court decided that the words could not serve as a mark, in part because:

The evident object of putting upon the market a ribbon having the words 'Merrie Christmas' on it was to enable persons desiring to send a Christmas gift to tie the package with a ribbon having a Christmas greeting upon it. . . . To the purchaser of such a ribbon, the fact that it has 'Merrie Christmas' inscribed upon it adds a value to it over the value of a plain ribbon, for the purpose for which the purchaser wishes to use it¹⁷⁵

Similarly, a doll called "Cinderella" is better than a generic doll because the possibilities for play are inscribed on it, even if the name itself is not actually etched into the doll. The "evident object" of putting the name on the doll is to make the doll suitable for play that engages with the public domain fairy tale. The case is yet better for design elements of a doll that reference the character's story, such as glass slippers, a beautiful ball gown, or a pumpkin carriage. In such trade dress cases, the purported mark referencing the character would be incorporated into the product, as were the words on the ribbon in *Smith v. Krause*.

Turning back now to the more precise formulation of the doctrine articulated by Justin Hughes, we must identify the "preexisting cognitive, psychological, or aesthetic responses"¹⁷⁶ among consumers in this case that can justify a finding of aesthetic functionality and

175. *Smith v. Krause*, 160 F. 270, 271 (S.D.N.Y. 1908).

176. Hughes, *supra* note 19, at 1279.

“curb . . . overbroad trademark claims to product features.”¹⁷⁷ Here, the consumer response to the reference to Cinderella, a desire to engage in play with the already well-known character, is consistent with the kind of acculturated responses Hughes describes, with the important caveats that the character elements must “trigger[] a positive . . . response among a substantial composite of the relevant consumers and that response [must] predate[] the trademark owner’s activities.”¹⁷⁸ So, this form of the doctrine could really only apply to public domain characters as defined here, that is, those outside the scope of copyright protection at the time of the attempt to establish trademark rights in the relevant character elements. Additionally, of course, under this reasoning, any character elements developed and added to a public domain character by the trademark holder could not be found aesthetically functional because no consumer response to those particular elements could pre-date the trademark holder’s activities.

Under Hughes’s reasoning, would it be problematic if not all consumers share the same interpretation of the fairy tale—and thus have different “responses” to what is meant by “Cinderella?” Not necessarily. Hughes asserts that “[i]n principle, cognitive biases that result from acculturation may be subject to more heterogeneity on the edges or across populations, but they can still have enough consistency in consumer responses for a sound aesthetic functionality claim.”¹⁷⁹ As an example, he analyzes the 2013 T.T.A.B. case *In re Florists’ Transworld Delivery, Inc.*,¹⁸⁰ in which the color black was found to be aesthetically functional for the packaging of flower arrangements because of the color’s diverse associations with grief, condolence, formal events, or Halloween.¹⁸¹ Hughes notes that “any one of these acculturated, widespread responses in consumers would have been enough for the T.T.A.B. to uphold the Trademark Examiner’s conclusion that ‘there is a competitive need for others in the industry to use the color black in connection with floral arrangements and flowers.’”¹⁸² In that case, the color black in the packaging functions to make the association between the flowers

177. *Id.*

178. *Id.* at 1230.

179. *Id.* at 1253.

180. 106 U.S.P.Q.2d (BNA) 1784 (T.T.A.B. 2013).

181. Hughes, *supra* note 19, at 1253–54 (citing *id.* at 1789).

182. *Id.* at 1254 (quoting *Florists’ Transworld Delivery, Inc.*, 106 U.S.P.Q.2d at 1791).

inside and the possibilities for their use. Because of the cultural meaning carried by the color, possibilities are created in the minds of consumers for the flowers inside the package—now they offer condolences or go with a black-tie affair. While other colors are available, they are not fungible—I would not wish to send a grieving friend a bouquet wrapped in pink.

The creation of a cultural association by the color is analogous to the kind of association created by a reference to a public domain character, and therefore the competitive need to access the character should seem equally apparent. My associations with Cinderella, though they may vary a bit from the associations that other readers would make, are nonetheless specific to the character. I would not wish to get my daughter a Snow White doll when she wants to play with Cinderella. At the very least, trademark doctrine should recognize the fully animated role that widely known and pre-existing cultural elements are playing in Disney's Cinderella doll and therefore leave the field open to more than one doll maker to engage in play with that particular public domain character. If a doll can't be called "Cinderella" or incorporate a glass slipper into its packaging, it can't compete effectively with Disney's Cinderella dolls, because resonance with that fairy tale is a source of the attraction to the product, a source that Disney was free to exploit and that second- (or third- or fourth-) comers should be equally free to exploit.

Ultimately, the cost of protecting "Cinderella" for dolls is high because dolls are a kind of expressive medium and trademark protection for the character name would raise barriers to the character receiving new interpretations in this medium. It would be a poorer world if there were only one kind of Cinderella doll, or if the decision as to what kinds of Cinderella dolls we could get were reserved to Disney alone. It is demonstrable that leaving a fairy tale in the hands of any one interpreter would dampen the impact it could make.¹⁸³ We are better off with both Disney's Cinderella and Zombie

183. Compare Langsdale, *supra* note 106, at 27–28 (arguing that despite the changes in plot, Disney's film re-encodes its fairy tale with an authoritarian model followed by the classic Grimm's fairy tales), with Pauline Greenhill, *Team Snow Queen: Feminist Cinematic Misinterpretations' of a Fairy Tale*, 13 *STUD. EUR. CINEMA* 32, 45 (2016) (arguing that the four films she analyzes, all based on "The Snow Queen," "offer a compelling example of how geographically and temporally dispersed adaptations can share perspectives beyond their common source material, ones which [she] argue[s] can be directly linked to what [one director] felicitously called a (feminist) 'misinterpretation' of the original").

Cinderella. Yet, the T.T.A.B. ultimately did reach that result. Is it possible that the existing doctrine is adequate to reach the right result, given the barriers to establishing secondary meaning in a public domain character?

In order to demonstrate that an aesthetic functionality-like doctrine is needed, I will now turn to a case in which not only the reasoning but also the result of the case would be changed by application of the doctrine. In *Wyatt Earp Enterprises v. Sackman*,¹⁸⁴ the producer of an ABC television show starring Hugh O'Brian as the famous and actual historical lawman, Wyatt Earp, sued to enjoin a former licensee from selling costumes labelled as "Wyatt Earp" costumes.¹⁸⁵ Though the former licensee had removed all reference to Hugh O'Brian and ABC-TV (except for an ill-considered lingering use of the word "official"),¹⁸⁶ the court granted a preliminary injunction, reasoning that "the name Wyatt Earp has been battered in to the public consciousness by the television program to an extent far beyond any fame or notoriety ever previously attached to the marshal's name."¹⁸⁷ Sackman, the former costume licensee, "denie[d] the possibility of secondary meaning attaching to the name, arguing that it belonged to a living person out of the nation's history, and hence has become a part of the public domain not subject to commercial monopolization."¹⁸⁸ The court, however, responded by citing indices of the establishment of secondary meaning, like the investment in producing the television program, the extent to which the plaintiffs have been making exclusive use of the name, and the "enormous publicity [that] has been generated in other media of mass communication."¹⁸⁹ The court concluded:

It has been asserted without denial or other comment that goods and merchandise marketed under the name of "Wyatt Earp" were unheard of prior to the first telecast of the show. The finding is nearly inescapable that the commercial value

184. 157 F. Supp. 621 (S.D.N.Y. 1958).

185. *Id.* at 623.

186. *Id.* at 625.

187. *Id.* at 624.

188. *Id.* at 623.

189. *Id.* at 624. The court includes the figures that "\$3,000,000 has been spent by the plaintiff in producing the films, and more than \$3,500,000 has been received by the television network for its time and facility charges during the two year period commencing in September of 1955," and that the show has been "viewed weekly on millions of television receivers by additional millions of persons." *Id.*

now enjoyed by the name is attributable almost entirely to the program. The plaintiff, as a result, has entered into the business of licensing merchandise rights in connection with the program.¹⁹⁰

The analysis does not leave much room for thinking about what advantage the television producers had in building on the existing “life and legend” of the historical Wyatt Earp. An advantage that, I think it can be demonstrated, was given short shrift by the court’s opinion.

In the years following the shoot-out at the OK corral in 1881, Wyatt Earp was a public personality, periodically appearing in national newspaper coverage.¹⁹¹ It has been observed that Wyatt Earp was “something of a celebrity” for much of his life.¹⁹² The myth-making began early, with Earp reinventing his own persona many times.¹⁹³ Following the stint as a federal lawman in Tombstone, Arizona, for which he is now primarily known, Earp roamed the West, gambling, running saloons, and prospecting.¹⁹⁴ He spent time in the 1890s in California racing horses.¹⁹⁵ In city directories in San Francisco and San Diego, he described his occupation as “capitalist.”¹⁹⁶ In 1896, he was embroiled in a nationwide scandal as referee of a boxing match that was alleged to have been fixed.¹⁹⁷ After the turn of the century, he spent his summers in Los Angeles, where he struck up friendships with big names in the Western movie industry, including the actors Tom Mix and William Hart and the director John Ford.¹⁹⁸ A well-known magazine article lionizing Earp appeared in 1907, written by Bat Masterson, a friend of Earp’s who had been a Western lawman in his own right, turned sportswriter after the West was won.¹⁹⁹ Earp was portrayed on film for the first

190. *Id.*

191. ALLEN BARRA, INVENTING WYATT EARP: HIS LIFE AND MANY LEGENDS 330–31 (1998).

192. *Id.* at 11.

193. ANDREW C. ISENBERG, WYATT EARP: A VIGILANTE LIFE 202 (2013).

194. BARRA, *supra* note 191, at 329.

195. *Id.* at 321.

196. *Id.*

197. *Id.* at 322–28.

198. BARRA, *supra* note 191, at 341; MICHAEL F. BLAKE, HOLLYWOOD AND THE O.K. CORRAL: PORTRAYALS OF THE GUNFIGHT AND WYATT EARP 22 (2007).

199. BARRA, *supra* note 191, at 11, 336.

time in 1923, in a silent film starring his friend William Hart.²⁰⁰ He was the subject of multiple books in the late 1920s and early 1930s, some casting him as a hero of law and order, the “Lion of Tombstone,” others as a vigilante murderer, abusing federal power for his own ends.²⁰¹ Earp passed away in 1929, and a best-selling biography followed shortly after his death.²⁰² Tom Mix is said to have wept at his funeral.²⁰³

At that point, Wyatt Earp’s place in the pantheon of legends from the Wild West was assured. The facts of Earp’s life are in some sense less important to understanding his legacy than the facts of his legend. As Allen Barra has asserted:

[S]urely history is more than a study of social and economic factors. And if history isn’t more than the study of such things, legend certainly is. Was King Arthur important? Was a deer poacher named Robin Hood? As *Tombstone* screenwriter Kevin Jarre has suggested, Wyatt Earp’s life might be the last chance we have to see the folk process by which fact is turned into legend and legend into myth. And Wyatt Earp’s importance as a symbol of the Old West cannot be exaggerated.²⁰⁴

As we did with Cinderella, focusing solely on the films that featured the character prior to the plaintiff’s commercial appropriation is a workable proxy for getting a sense of this mythmaking in action. In the years between Earp’s death in 1929 and 1955, the year in which the ABC-TV series debuted, Wyatt Earp, or recognizable elements of his story, were portrayed in at least ten more films, notably including: *My Darling Clementine* in 1946, starring Henry Fonda as Wyatt and directed by the academy-award-winning master of Westerns, John Ford, and *Wichita*, starring Joel McCrea, which was a “moderate hit” in 1955.²⁰⁵ The important factor to note,

200. *Id.* at 342.

201. *Id.* at 12–13.

202. *Id.* at 10.

203. *Id.* at 340.

204. *Id.* at 14.

205. The films were: *Law and Order* (1932) starring Walter Huston with script by a young John Huston, *Frontier Marshal* starring George O’Brien in 1934 (both based on Wyatt’s biography, but not using his name out of sensitivity to his widow), *The Arizonian* starring Richard Dix in 1935, *Law for Tombstone* (1937) starring Buck Jones, *In Early Arizona* (1938) starring Bill Elliot, *Frontier Marshal* with Randolph

is that each of the many interpretations of Wyatt Earp featured in expressive works prior to the ABC-TV show differed from each other. The portrayals of the late 1920s and early 1930s saw Wyatt Earp through the lens of the 1920s crime wave.²⁰⁶ It has been argued that the audiences of *Tombstone—The Town too Tough to Die*, released in 1942, saw “the violence in *Tombstone* as reflecting the horrors occurring on the battlefields of Europe and in the Pacific.”²⁰⁷ In a subtle shift, critics have observed that *My Darling Clementine* (1946) portrayed Wyatt Earp as “the reluctant hero,” perhaps reflecting “the mindset of those returning from World War II service, who wanted only to avoid any further conflict in their lives.”²⁰⁸ Each generation found his story useful in different ways and molded his character in their own likeness.

The producers of the ABC-TV show, calling themselves Wyatt Earp Enterprises, Inc., hardly plucked Wyatt Earp’s name from obscurity. There is surely an identifiable advantage they had over other makers (or licensors) of western-themed play costumes that was not merely a function of the reputation of the TV show, but rather related to the cultural resonance of Wyatt Earp, the historical figure, or, at least, of his larger-than-life legend. This seems like a case in which the outcome would clearly be changed, and, I think, changed for the better, by application of a functionality-like doctrine. Giving exclusive rights to the producers of the ABC-TV show to use the name “Wyatt Earp” in connection with costumes would put other costume purveyors at a non-reputational disadvantage, because the Wyatt Earp name is useful in amplifying an otherwise generic Western costume with an identity and a narrative that is already familiar to children (and, *ex ante*, had nothing to do with the TV producers). A child who wants to “be” Wyatt Earp will not be equally satisfied with a costume labelled “Federal Marshal” or, for that matter, “Bat Masterson.” As long as the costume purveyors who are not associated with the TV show are careful to reference only the Wyatt Earp of history and not, say, Hugh O’Brian or any other indicia specific to the TV show, they would be doing no more than Wyatt Earp Enterprises,

Scott (1939), a re-make of *Law and Order* with Johnny Mack Brown (1940), *Tombstone—The Town too Tough to Die* (1942), *My Darling Clementine* (1946) starring Henry Fonda and directed by John Ford, another re-make of *Law and Order* starring Ronald Reagan (1953), and *Wichita* starring Joel McCrea in 1955. *Id.* at 342, 344–50.

206. *Id.* at 343.

207. BLAKE, *supra* note 198, at 59.

208. *Id.* at 87.

Inc., had initially done to “supercharge” their product, in the parlance of merchandisers, by making use of the public’s existing understanding of Wyatt Earp. Meanwhile, Wyatt Earp Enterprises is still free to leverage the superb success of their television show by using house marks in the form of “ABC-TV” or other references to the television show in combination with Wyatt’s name. Registrations for such marks might clarify the scope of protection by disclaiming “Wyatt Earp.” Fans of the show would be likely to seek out the “authentic” merchandise, and, if it is true that the commercial value lies with ABC-TV’s Wyatt Earp in particular, then consumers will pay a premium to buy that costume over others.

Returning to Robert Bone’s balancing test,²⁰⁹ we could say that the source-identifying benefits of exclusive rights in the “Wyatt Earp” name are relatively low, while the costs of restricting access to the name for costumes is high. The character of Wyatt Earp has been too meaningful, too “useful” in interpreting the Wild West to put the power to costume children in his likeness into the hands of just one producer. As Allen Barra has asserted:

History and Hollywood have had plenty of time to seek other symbols of America’s frontier past to mold into icons, to debunk, to read their ideological assumptions into: They keep coming back to Wyatt Earp. He rides on the eternally unsettled territory of our national consciousness When another eruption of violence fuels our ongoing debate over law and order, he will be back, reinvented in exactly what way, as enforcer of the law or avenger, we cannot now say. But he will be back.²¹⁰

The cultural value of Wyatt Earp depends on history and Hollywood having free access to remake and make over his legend. While it might be argued that the limits of trademark rights should prevent them from quashing any of the expressive uses to which history and Hollywood might put him, the Wyatt Earp Enterprises case points up the extent to which the cultural value created by expressive uses is entwined with the commercial value of certain kinds of consumer products. There is a clear public interest in allowing literary and historical culture to be freely expressed through material culture. This means recognizing that there is a cost to

209. Bone, *supra* note 30, at 222.

210. BARRA, *supra* note 191, at 405.

restricting even just trademark use of public domain characters and thus allowing only one producer to make such uses.

IV. BREAKING THE SPELL OF PAST PRECEDENT

That being said, actual application of aesthetic functionality to character trademarks has not been easy. In an abortive early attempt to apply the doctrine in 1982, the T.T.A.B., in *In re DC Comics*, upheld an examining attorney's refusal to register drawings of Superman, Batman, and Joker as trademarks for dolls portraying each character, reasoning that "the designs of the three dolls . . . [were] quintessentially utilitarian."²¹¹ The T.T.A.B. opined that:

A child who wants to playact with dolls an adventure involving the character "Superman" or the character "Batman" or the character "Joker" would simply not be satisfied with any doll that was not a replica of the appropriate character. The customary dress, accoutrements and facial expression of the character are indispensable elements of the commercial appeal of the product. Thus, these features are commercially functional.²¹²

I appreciate the move the T.T.A.B. made in conceptualizing how the claimed design elements interacted with the goods to which they were affixed in order to add value. I also appreciate the sense that the characters are not fungible. However, the T.T.A.B. concluded that the "designs are functional in a utilitarian sense and for that reason are not trademarks."²¹³ This engendered three problems for the opinion on appeal.²¹⁴ One was the confusing application of utilitarian functionality to design elements that could more readily be labeled as aesthetic, another was the focus on whether the marks could function as trademarks, and the third was the harshness of the remedy, which seemed to result in the drawings of the dolls being incapable of trademark protection in combination with any goods—that they were

211. *In re DC Comics, Inc.*, 211 U.S.P.Q. (BNA) 834, 837 (T.T.A.B. 1981), *rev'd*, 689 F.2d 1042, 1045 (C.C.P.A. 1982).

212. *Id.*

213. *Id.*

214. *DC Comics*, 689 F.2d at 1048 (Rich, J., concurring).

simply not trademark subject matter. Mark McKenna has observed the last as an enduring issue for aesthetic functionality:

One explanation for courts' greater reticence about aesthetic functionality is that the consequences of a functionality finding seem too harsh in the context of many aesthetic functionality cases. In the mechanical or utilitarian functionality setting, functionality goes to the existence of the plaintiff's rights in the claimed features. Hence if a court finds the claimed features functional, it has declared those features unprotectable—free for all to use.²¹⁵

On appeal, the C.C.P.A. rejected the T.T.A.B.'s view unequivocally, finding “no merit in the argument that, by virtue of the aesthetic features identified by the board, the appellant's drawings are unable to perform as trademarks for toy dolls” and arguing that the T.T.A.B. had “obscure[d] the distinction between utilitarian and aesthetic functionality.”²¹⁶ The Court was, however, also notably moved by the sense that these characters, born under and still covered by copyright, owed their existence to DC Comics:

Whatever information a drawing of Superman or Batman or Joker might convey to the average prospective purchaser regarding a doll resembling one of the related fictional characters is wholly dependent on appellant's efforts to associate each character in the public's awareness with numerous attributes, including a single source of sponsorship.²¹⁷

The court treated the characters as if there is no, and indeed can be no, attribute of the character that is not tied to the “single source of sponsorship.”²¹⁸ As noted above, the same is not true of public domain characters like Cinderella, Rapunzel, Little Mermaid, Snow Queen, and Wyatt Earp. In some cases, it should be possible to identify “information” that is not “wholly dependent on the appellant's

215. McKenna, *supra* note 30, at 854 (citing *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 26 (2001)).

216. *DC Comics*, 689 F.2d at 1045.

217. *Id.* at 1044.

218. *Id.*

efforts.”²¹⁹ In those cases, it should also be possible to craft remedies that appropriately preserve access to whatever advantage the trademark holder derived from the public domain. Competitors will need access to such public domain character elements to compete, not by masquerading as the same source, but by marketing goods that compete on the basis of the same, non-reputational advantage.

Similarly, in *Warner Bros., Inc. v. Gay Toys, Inc.*, the Second Circuit rejected Gay Toys’ argument that the symbols identifying a toy car as the “General Lee,” the car driven in the television show “The Dukes of Hazzard,” were functional.²²⁰ Gay Toys argued that the symbols were “functional in the sense that they are essential to enable children to play ‘Dukes of Hazzard’ with the cars.”²²¹ The Second Circuit, however, found that argument “paradoxical,” because “it is precisely the fact that the symbols provide identification that make them ‘functional’ in the sense urged on us by Gay Toys, while Warner’s exclusive right to use its own identifying symbols is exactly what it seeks to protect.”²²² Once again, the Court assumed that any “identification” made by the symbols fully folds back onto Warner as the originator of the television series, but this would clearly not be the case for all characters, especially public domain characters with life cycles similar to those discussed above.

Further, the Second Circuit complained that “[c]arried to a logical conclusion, Gay Toys’ argument would enlarge the functionality defense so as to eliminate any protection for any object, since presumably each feature of any object is designed to serve a particular ‘function’ in Gay Toys’ sense of the term.”²²³ But since this case was argued in 1983, the Supreme Court’s guidance has made clear that aesthetic functionality applies only to product features that put competitors at a significant *non-reputation-related* disadvantage.²²⁴ This puts the question squarely on whether there is a competitive disadvantage and, if so, whether the non-reputation-related component of the disadvantage, if any, is significant. Therefore, only “identifications” that are (1) meaningful beyond the reputation of the trademark holder and (2) so useful to the applicable goods as to confer

219. *Id.*

220. 724 F.2d 327, 330 (2d Cir. 1983).

221. *Id.*

222. *Id.*

223. *Id.*

224. See *supra* notes 169–72 and accompanying text.

a significant competitive disadvantage would trigger an aesthetic functionality defense. At any rate, the public domain characters discussed above at least illustrate how the associations created by elements of a character can refer back to more than the reputation of the trademark holder, even when, as in “Disney’s Cinderella,” the character element is being used as part of a source-identifying mark.

More recently, in *Fleischer I*, the Ninth Circuit initially applied aesthetic functionality to particular uses of Betty Boop’s name on posters, dolls, and clothing, but that opinion was withdrawn and superseded by an opinion without that reasoning.²²⁵ On remand, the district court again turned to aesthetic functionality, but its reasoning relied heavily on the finding that the defendants’ use of the words Betty Boop was ornamental and not trademark use.²²⁶ The court stated: “Because . . . Defendants’ use of the mark is a decorative feature of their merchandise and is not source-identifying, ‘protection of the feature as a trademark would impose a significant non-reputation-related competitive disadvantage’ on Defendants.”²²⁷

First, it is problematic to conflate aesthetically functional uses with merely ornamental uses, because there is a separate doctrine that squarely deals with ornamentation that has no source-identifying content.²²⁸ By contrast, the aesthetic functionality doctrine should address trademark subject matter that, regardless of its ability to indicate source, should not be protected because it provides the mark holder with a significant (non-reputational) competitive advantage. For instance, the “aesthetic” functions of black packaging for floral arrangements,²²⁹ heart-shaped boxes for candies,²³⁰ and a “Merrie Christmas” message on gift wrap ribbon²³¹

225. *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115, 1124 (9th Cir. 2011), *withdrawn and superseded by* *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011).

226. *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 925 F. Supp. 2d 1067, 1075 (C.D. Cal. 2012).

227. *Id.*

228. See U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.03 (2017). The TMEP explicitly directs examining attorneys not to use aesthetic functionality as a basis for refusal in such cases. *Id.* § 1202.02(a)(vi).

229. U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.02(a)(vi) (citing *In re Florists’ Transworld Delivery Inc.*, 106 U.S.P.Q.2d (BNA) 1784, 1789 (T.T.A.B. 2013)).

230. Bradford Duft, “Aesthetic” Functionality, 73 TRADEMARK REP. 151, 174 (1983) (quoting RESTATEMENT OF TORTS § 742 cmt. a (AM. LAW INST. 1938)).

231. *Smith v. Krause*, 160 F. 270, 271 (S.D.N.Y. 1908).

are more than ornamental. In each case, the purported mark is enhancing the marketability of the product, respectively, to communicate grief, express love, and offer holiday greetings, all dimensions of the appeal of the product that are unrelated to the reputation of the product's source. The *Fleischer* court was closer to this kind of rationale when it noted that:

Were Defendants to market their goods bearing the image of Betty Boop or Betty Boop movie posters without the words Betty Boop to identify the character, that would make their products less marketable than the same product that included the BETTY BOOP name. This is because the words Betty Boop serve to name the famous character depicted on those goods and are part and parcel of the movie posters printed on Defendants' merchandise.²³²

The court saw the reference to the character through her name as integral to the products. On the t-shirts that feature images of Betty Boop, the name functioned to connect the images to the fictional character, and on the t-shirts that feature movie posters, the character's name was central to the text on the poster. The court also importantly acknowledged that, in its analysis, the character's name had significance apart from the source of the goods: "In addition, because Defendants' use of the Betty Boop word mark is not source identifying and simply does not trade on the 'reputation' of any source, barring Defendants from using those words would 'impose a significant non-reputation-related competitive disadvantage.'"²³³

The *Fleischer* court's reasoning, however, limits the application of the doctrine pretty significantly when it appears to require a showing

232. *Fleischer Studios*, 925 F. Supp. 2d at 1075.

233. *Id.* It should be noted that the court does not spell out the source of its intuition that consumers think not of Fleischer Studios, but, separately, of Betty Boop when they see this use of her name. But the court does note that the character is "famous" and it may have been relevant that the Ninth Circuit had already ruled for the defendants on Fleischer's copyright claims, although it had found a triable issue in whether the "fractured ownership history" of the character precluded a finding of secondary meaning. *Id.* at 1070. By contrast, the *Gay Toys* court assumed that all aspects of the "General Lee" car were symbols identifying Warner Bros., presumably because Warner was the source of the *Dukes of Hazzard* television show in which the car appeared. See discussion at *supra* note 220 and accompanying text.

that there is no trademark use of the relevant elements at all.²³⁴ For instance, in the case of an infringement suit comparing Disney's Cinderella and Zombie Cinderella, under the *Fleischer* court's reasoning, functionality might well not be a defense for Zombie Cinderella because the defendant is using the character name as part of its own trademark and not merely ornamentally. But why not recognize the functionality of the word "Cinderella" in each mark in relation to the product class and require both parties to disclaim protection of that element, as we might with generic elements of a mark? This treatment would not preclude trademark protection of the mark as a whole. Mark McKenna has argued that "a court should be able to find a defendant's use to be functional even if the features at issue might also indicate something about source."²³⁵ This seems particularly true where the trademark holder uses the purportedly functional mark on more than one class of goods—or the trademark holder's use is on a different class of goods than an alleged infringer's use—and where the mark may be aesthetically functional when used in relation to one class of goods but not for the others.²³⁶

The primary objection to the application of aesthetic functionality in the Betty Boop case has been the idea that the reasoning would lead to the end of licensing merchandise for all kinds of trademarks. Thomas Casagrande voices this concern, arguing that:

If followed, the Betty Boop decision could threaten trademark licensing programs for logos[,] mascots, or even the names of professional sports teams and colleges. It could also affect entertainment companies (e.g., Walt Disney), which license characters on consumer items. As with Betty Boop t-shirts . . . people generally buy these items because they want to show their allegiance with an entity or because they like the depicted character itself.²³⁷

But this formulation of the problem glosses over a lot of subtle differences between these types of trademarks. I would argue that there is an important distinction between "allegiance with an entity"

234. *Fleischer Studios, Inc.*, 925 F. Supp. 2d at 1074 ("The Court finds, as a matter of law, that Defendants' use of the Betty Boop word mark is not a trademark use.").

235. McKenna, *supra* note 30, at 857.

236. *Id.* at 855 (arguing that this problem of "dual significance" is common in aesthetic functionality case).

237. Casagrande, *supra* note 29.

that is the trademark holder and “lik[ing] the depicted character itself.” Logos, mascots, and the names of sports teams and colleges all seem to function in a much more “reputational” way than characters in expressive works do, depending on the kind of character at issue. For logos and mascots, it seems reasonable that the motivation to buy is to show “allegiance to an entity” that is also the source (or sponsor) of the relevant goods or services.²³⁸ Whatever competitive advantage the mark holder might receive in that scenario is most likely to derive from the mark holder’s reputation. When consumers buy a t-shirt because “they like the depicted character itself,” however, there is at least a better chance that there is a significant non-reputational component to that advantage, depending on the character’s life cycle and how close the association between the mark holder and the character has been.

Therefore, it might go some way toward defusing the controversy around applying aesthetic functionality to some trademark uses of characters if we could differentiate aesthetically functional uses of characters from (1) the trademark uses of characters that do not confer troubling “non-reputational disadvantages” (think of a registration for the word mark “Cinderella Soap Company” for soap and other cleaning products) and (2) the merchandizing uses of ordinary marks that trademark holders have become accustomed to controlling (think of a keychain with a company’s logo on it).

238. This intuition was borne out by the jury finding in the damages phase of a copyright infringement trial, when the jury determined that profits derived by the Baltimore Ravens NFL team from the sale of products bearing the “Flying B” logo “was attributable completely to factors other than the art work of the Flying B logo.” *Bouchat v. Baltimore Ravens Football Club, Inc.*, 346 F.3d 514, 526 (4th Cir. 2003).

Of course not all trademark uses of the Cinderella name are aesthetically functional. Consider the trademarks pictured below (Cinderella for an eyebrows spa,²³⁹ Cinderella Soap Co. for soap and bath products,²⁴⁰ and Cinderella Maids Service for cleaning services²⁴¹):



Each of these marks takes something from the public domain. Each of them engages with elements of the Cinderella story—suggesting, respectively, how Cinderella is magically made beautiful or endlessly cleans up after her stepsisters. None of these uses, however, would be aesthetically functional, because exclusive rights in the name here would not put competitors at a non-reputation-related disadvantage. Protection for the mark does not prevent others from marketing and offering the same eyebrow-grooming services, or equally effective soap, or yet superior cleaning services. The marks in these cases are not useful features of the product itself. Depending on how much prestige these brands build with their clientele or consumers, the marks may amplify the value of the goods or services, but, if so, that value would be a function of the reputation of the brand. These examples illustrate how trademark rights, for instance, in the “Cinderella” name might persist in relation to some goods while being aesthetically functional in relation to goods that bear or embody the character itself.

239. CINDERELLA EYEBROWS SPA, Registration No. 3,916,845; George Hopkins, *FLICKR* (Oct. 8, 2011), <https://www.flickr.com/photos/7978334@N03/6990110111>.

240. CINDERELLA SOAP CO., Registration No. 3,432,137; Cinderella Soap Co., *ETSY*, <https://www.etsy.com/shop/cinderellasoap> (last visited Nov. 5, 2018).

241. CINDERELLA MAIDS SERVICE, Registration No. 3,936,315; CINDERELLA MAIDS SERVICE, <http://www.cinderellamaidsservice.com> (last visited Nov. 5, 2018).

This can be so without undermining the merchandising rights that mark holders have become accustomed to controlling. Consider the keychain below on the left, featuring the Volkswagen logo.²⁴² Below on the right is a picture of a t-shirt bearing the image of Betty Boop²⁴³—suspend for a moment the fractured copyright claim in her case²⁴⁴ and focus solely on the treatment of the design under trademark law.



Goods similar to the keychain were at issue in *Au-tomotive Gold, Inc. v. Volkswagen of America*, in which the Ninth Circuit ruled that Auto Gold’s use of the Volkswagen logos on key chains and license plate frames was not aesthetically functional.²⁴⁵ Goods similar to the t-shirt on the right were at issue in *Fleischer*, where the court found that the “Betty Boop” word mark was aesthetically functional when printed on t-shirts and movie posters.²⁴⁶

242. Volkswagen VW Logo Pendant Key Chain, TROIKA, <https://troikaus.com/collections/automotive/products/volkswagen-vw-logo-pendant-key-chain?variant=821064567> (last visited Nov. 5, 2018).

243. Sexy Star Betty Boop Logo T-Shirt, TEE SHIRT PALACE, https://www.teeshirtpalace.com/products/sexy-star-betty-boop-logo-t-shirt?gclid=EAlaIqobChMIx66k1-jg2QIVFq_ICh1ubwXEEAkYASABeGJ_FPD_BwE (last visited Nov. 5, 2018).

244. Calboli, *supra* note 23, at 83.

245. *Au-tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1064 (9th Cir. 2006).

246. *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 925 F. Supp.2d 1067, 1074–75 (C.D. Cal. 2012).

The *Au-tomotive Gold* court reasoned:

The present case illustrates the point well, as the use of Volkswagen and Audi's marks is neither aesthetic nor independent of source identification. That is to say, there is no evidence that consumers buy Auto Gold's products solely because of their "intrinsic" aesthetic appeal. Instead, the alleged aesthetic function is indistinguishable from and tied to the mark's source-identifying nature. . . . This consumer demand is difficult to quarantine from the source identification and reputation-enhancing value of the trademarks themselves.²⁴⁷

In the parlance of *Qualitex* and *TrafFix*, whatever advantage the pictured keychain has over others derives from the goodwill of Volkswagen—people buy it to associate themselves with the brand—and thus it is *not* "non-reputational" in any significant way.²⁴⁸ By contrast, let's look again at the rationale of the district court in *Fleischer* that is quoted above:

Were Defendants to market their goods bearing the image of Betty Boop . . . without the words Betty Boop to identify the character, that would make their products less marketable than the same product that included the BETTY BOOP name. This is because the words Betty Boop serve to name the famous character depicted on those goods.²⁴⁹

The court cites to *Au-tomotive Gold* in that analysis finding that the Betty Boop word mark on the t-shirt had a very different function on the front of the shirt, asserting that they are in fact following the reasoning in *Au-tomotive Gold*.²⁵⁰ The court recognized a distinction

247. *Au-tomotive Gold, Inc.*, 457 F.3d at 1073–74.

248. See *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28 (2001) (discussing reputational advantage); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) (discussing reputational advantage); Calboli, *supra* note 23, at 82 (observing that the *Au-tomotive Gold* court followed the *TrafFix* test); Hughes, *supra* note 19, at 1276–77 (noting the holding with approval because "a cognitive, psychological, or aesthetic response in consumers that is the result of the trademark holder's efforts is not the stuff of functionality, but rather the stuff of modern marketing").

249. *Fleischer Studios, Inc.*, 925 F. Supp. 2d at 1075.

250. *Id.* at 1074.

between these two merchandising uses based on the relationship between the mark, the goods, and the mark holder. Some significant component of the advantage conferred by marketing the shirt with the words BETTY BOOP on it had nothing to do with the reputation of the mark holder. Rather, the more immediate reference was to the Betty Boop character (again, setting aside the issue of a flawed ownership history that must have aided the court in thinking of the character as somehow independent) and there was a competitive necessity to use Betty Boop's name to identify her when the products were desirable because of their embodiment of the character.

V. RESURRECTING THE PUBLIC DOMAIN

And that brings us to the hard cases. What about cases regarding the aesthetic functionality of characters who were born under copyright? (Or for that matter, what about so-called "spokescharacters"²⁵¹ who are born as trademark logos and then become protagonists of expressive works?) In other words, if we reintroduce the fact that Betty Boop was born under copyright, how do we know that a reference to her name stands independent of the reputation of her creator? In analyzing the functionality of Cinderella for dolls or Wyatt Earp for Wild West costumes, I leaned pretty heavily on the history of each character prior to its appropriation by the trademark holder. The reasoning promoted by Justin Hughes to discipline the aesthetic functionality doctrine in fact requires that there be a consumer response to the cultural element prior to the activities of the trademark holder.²⁵² It does seem to me that these are the strongest cases for a finding of aesthetic functionality because the "non-reputational" component of whatever value the character-based mark may bring to the goods should be separable by the temporal line—we can see the value of the character prior to its appropriation by the trademark holder. If the character had no history prior to the trademark holder's claim, can we separate what part of the character's meaning or resonance or attractiveness is bound up with the reputation of the trademark holder and what part of it is not?

251. See, e.g., Ginsburg, *supra* note 81, at 73–75.

252. Hughes, *supra* note 19, at 1230, 1248.

I admit, there may be better doctrines to draw clear, explicit lines between copyright and trademark,²⁵³ but aesthetic functionality can at least pose the question as to whether exclusive rights in a character's name or other recognizable elements confer a significant non-reputational disadvantage on competitors, once competitors are free under copyright law to compete in goods that embody the character. The question posed by the *Qualitex* formulation of the doctrine is not whether the advantageous effect of the claimed feature existed before the feature was claimed as a trademark, but rather, whether the significant dis-advantageous effect of the claimed feature is *non-reputational*.²⁵⁴

We may find, as in the *Gay Toys* case, that courts will always conclude that the appeal of copyrighted characters is bound up with the reputation of their exclusive source as long as the distribution of the underlying work is controlled by a single entity.²⁵⁵ However, when the expiration of a copyright allows new entities to begin disseminating copies of the work and to prepare new derivative works employing the character, there should be room for that analysis to change over time when (and if) our culture takes up the character, just as genericide can erode trademark rights when the public takes up the meaning of a coined term and uses it to denote the genus of the goods. That is, references to the character should seem less bound to the reputation of the original copyright holder as the expiration of copyright operates to unmoor the work from its commercial control.

This independent, non-reputational significance of the character elements should be demonstrable with evidence such as third-party uses, including fair uses prior to copyright expiration, expressive uses in the language (e.g., the "Cinderella complex"), and perhaps survey evidence of consumer perceptions as to whether the character mark is appealing for reasons beyond the source of the goods—reasons that may have developed after the character was created, but which are not solely attributable to the reputation of the creator.²⁵⁶ It has long

253. See, e.g., McKenna, *supra* note 16, at 360 (describing cases that discuss the boundary between copyright and trademark law).

254. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 168 (1995).

255. Copyright protection should make the question moot for a minimum of seventy years in most of the merchandizing cases involving images of characters, because the sale of literal copies on say, t-shirts, would give rise to a claim of copyright infringement.

256. The effects of such movement over time are beyond the scope of this Article, but I do not think they would be devastating to the modern merchandising market. The entities most likely to have assets for which the analysis would be relevant would

been recognized that consumers contribute to the development of characters, even as valuable brands. In Jessica Litman's seminal account:

Of course, I paid for that tube of toothpaste with Bugs Bunny's picture on it. The value of the "Bugs Bunny" mark reflects my participation (and that of millions of other consumers) as well as Warner Brothers's. The building of a brand that becomes its own product is a collaborative undertaking; the investment of both dollars and imagination flows both ways. There is no particularly good reason to adopt a rule permitting the producers of the brands to arrogate all of that collaboratively created value to themselves.²⁵⁷

The aesthetic functionality doctrine as explored here would suggest a lowering of barriers to competition in uses that embody the character (and therefore a sharing of the value in the form of lowered cost to consumers)²⁵⁸ when the value of that use (the significant competitive advantage) does not derive from the reputation of the mark holder.

I acknowledge that application of the doctrine without a temporal line to distinguish the "reputational" components of value with "non-reputation-related" ones will be fact-specific, difficult, and result in case-by-case rulings that fail to produce consistent and predictable results. But I do, nonetheless, think that distinctions will be possible using the kinds of evidence listed above.

still be in a position after copyright expiration to continue to compete in the market for merchandise in the characters they created by exclusively exploiting house marks (e.g., Disney's Mickey Mouse) or particular stylized marks (e.g., the stylized rendering of the Harry Potter name with a lightning bolt on the shaft of the "P" that is currently used to denote clothing that has officially been licensed by Warner Brothers. See HARRY POTTER, Registration No. 2,683,060. In those cases, while the character name might become aesthetically functional for dolls or merchandise bearing the image of the character, the house mark or the stylized rendering of the name would still be protected. Consumers who do wish to associate themselves more with Disney in particular than with Mickey Mouse in general would be able to find the "official" merchandise and should be willing to pay a premium for it.

257. Litman, *supra* note 4, at 1734.

258. See Dreyfuss, *supra* note 81, at 407 (describing the effect of a lack of exclusive rights on consumers).

As a brief example, let's take two character marks used by Justin Hughes in his discussion of the trademark/copyright frontier,²⁵⁹ Tony the Tiger (the spokescharacter for frosted flakes) and Disney's version of Tinkerbell (whose image was created for Disney's version of *Peter Pan* but was later used as a mark by the Walt Disney Company). I agree that it does not help much to note their different origins, especially since it is not clear that copyright doctrine makes a distinction here. Both cartoon images are copyrightable subject matter from the moment of fixation. But, using the kind of evidence listed above, I do think it would be possible to distinguish between uses of the characters for the purposes of the aesthetic functionality analysis.

Consider for each of them an image of the character on a t-shirt. I would put such a merchandizing use of Tony the Tiger closer to the reputational end of the spectrum. I think it would be more like a Volkswagen keychain than a Betty Boop t-shirt. This is because my impression is that Tony the Tiger does not say much about anything other than Kellogg's Frosted Flakes ("they're grrrrreat!"), and barring some kind of parodic use, the straight image of Tony the Tiger just means Kellogg's to me.

By contrast, Tinkerbell comes out of a much richer narrative and there are more opportunities for associations that are not exclusively tied up with Disney—that is, I would not be surprised to find that consumers had done more with Tinkerbell, formed more non-Disney-related associations, because there is more to work with, even just in Disney's rendering of the character. She is closer to Betty Boop than she is to the Volkswagen icon. So, I would likely put a Tinkerbell t-shirt closer to the aesthetically functional end of the spectrum, though undoubtedly my impression is complicated by her origins in the play (and its novelization) upon which the movie is based.²⁶⁰

While it may be tempting, I think it is wrong to make a distinction here, to say that, for the purposes of aesthetic functionality doctrine, characters born under copyright are vacuum-sealed and inextricably

259. Hughes, *supra* note 19, at 1265–66.

260. It should be noted that I am assuming that the image on the t-shirt is not accompanied by any other Disney mark that would operate to associate Tinkerbell in that context with the company. See *supra* note 256 and accompanying text. I think it also important that a finding of aesthetic functionality of the use of the image on a t-shirt or in conjunction with dolls that depict the character should not affect the use of the character as a mark for say, Disney movies or merchandise not depicting Tinkerbell. See *supra* note 167 and accompanying text.

pervaded with the reputations of their authors. This would mean, for instance, that no part of Mickey Mouse would ever wave goodbye to the freight of Disney's corporate brand. That would be a fundamental misunderstanding of how living culture functions. First, the idea that Mickey Mouse was ever hermetically sealed off from the public domain is a myth of its own. As Jessica Litman has observed: "First, I mentioned that Disney's Snow White character is based on preexisting elements. That's also true of characters who were not the heroines of famous fairy tales in their former lives. Walt Disney created Mickey Mouse using preexisting elements."²⁶¹ The earliest incarnation of Mickey Mouse, in the short *Steamboat Willie*, was fashioned in part as a parody of Buster Keaton's silent film, *Steamboat Bill Jr.*²⁶² Disney was an inveterate recycler of gags, once commenting to a friend that a gag "got a laugh in 1923 and it will get a laugh today."²⁶³ Thus, some part of the most meaningful, iconic characters in our culture are reborn from the soil of our shared experience.

Aesthetic functionality doctrine, applied as described in this Article, at least asks the question as to what contributions cultural meaning might be making to the value of a mark and provides a framework for balancing the benefits of source identification against the costs of restricting access to characters. As the great critic Walter Benjamin observed:

All Mickey Mouse films are founded on the motif of leaving home in order to learn what fear is. So the explanation for the huge popularity of these films is not mechanization, their form; nor is it a misunderstanding. It is simply the fact that the public recognizes its own life in them.²⁶⁴

Trademark doctrine should be able to recognize a distinction between commercial appeal based on the reputation of source and the broader resonance of a cultural reference with a life of its own.

261. Jessica Litman, *Mickey Mouse Emeritus: Character Protection and the Public Domain*, 11 U. MIAMI ENT. & SPORTS L. REV. 429, 433 (1994).

262. Jim Korkis, *More Secrets of Steamboat Willie*, in A MICKEY MOUSE READER 331 (Garry Apgar ed., 2014).

263. *Id.* at 335.

264. Walter Benjamin, *On Mickey Mouse*, in A MICKEY MOUSE READER 20 (Garry Apgar ed., 2014).