The Costs of Trademarking Dolls

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Rebecca Curtin, *Zombie Cinderella and the Undead Public Domain*, **86 Tenn. L. Rev.** __ (forthcoming 2018), available at SSRN.

Professor Curtin's article, *Zombie Cinderella and the Undead Public Domain*, takes a recent case from the Trademark Trial and Appeal Board (TTAB) 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 doll manufacturer sought to register the term "Zombie Cinderella" for a doll that was zombie-ish and princess-like. The examiner refused registration because the term "Zombie Cinderella" for this kind of doll was confusingly similar to the mark for Walt Disney's Cinderella doll. Although the TTAB overturned the examiner's "refusal to register" determination, it did so because it said Disney's mark is a conceptually weak source indicator of "Disney" for dolls. This leaves open the possibility that Disney could build a stronger association between its mark and its dolls and eventually monopolize the term "Cinderella" as a mark for princess dolls. Professor Curtin's article argues that leaving this opportunity open would be bad policy and should be precluded under a proper application of trademark law.

There are several aspects of this article that make it worth reading. First, it is a deep dive into a single case at the PTO, teaching readers about trademark registration and appeals from adverse rulings. The article reads as a compact case history from beginning to end. It appropriately balances the technical aspects of trademark practice with conceptual dimensions of trademark theory, such as aesthetic functionality (a doctrine that bars trademark protection for design and word elements that confer a non-reputationally-related advantage on the trademark holder). Second, drawing from her scholarly expertise in literary history, Professor Curtin provides rich and appropriately expansive details about Cinderella's provenance as a character dating from 1558. The cultural history alone makes this article a joy to read, as Professor Curtin traces the Cinderella character forward to the 1899 Georges Melies' film *Cinderella* and backward to a ninth century Chinese folk tale. This sets up the issue of what Disney can properly claim to own of the character's name (as a trademark for its own princess doll toy) after the 1950 release of its film *Cinderella*.

The central problems this article addresses are "overreaching trademark claims that quash expressive uses of public domain characters" and "the competitive needs of multiple producers to make reference to public domain characters in the names and designs of their products." (P. 3.) Overreaching trademark claims undermine the law's goal of promoting competition through the use of distinctive marks that designate the source of those goods. Trademarks that monopolize valuable public domain elements and undermine the competitive advantage of other manufacturers to name and describe their goods injure both consumers and competition. The argument that underlies Curtin's description of this problem is that there are and should be allowed to be more than one "Cinderella doll." Disney may make such a doll and brand it as Disney's Cinderella doll, but other manufacturers may also have Cinderella dolls and call them, for example, Zombie Cinderella or Dolly Pockets Cinderella Doll.

Trademark law does not permit restriction of the making of the goods themselves. It restricts only the use of confusingly similar marks on goods. Indeed, trademark law intends to enable copying of goods – e.g., there are and should be many kinds of bottled waters with their negligibly perceptible differences in ingredients and taste. And yet on the shelves we can distinguish between Dasani, Poland Spring, and Fiji. Likewise, Curtin argues, there are and should be many kinds of Cinderella dolls. As with the bottled water where the product is the water whether or not purified the same way or containing any (or the same) additives, the product here is the doll with characteristics from the Cinderella fairy tale: rags to riches details, princess-like dress, fairy godmother, glass slippers, etc. But if Disney owns the mark "Disney Cinderella" for dolls that refer to and look like the fairy tale Cinderella, and other manufacturers can make

dolls that look like Cinderella but cannot call them Cinderella dolls because of the broad scope of Disney's trademark, competitors are inhibited from competing in the marketplace for Cinderella-like dolls.

This central problem of assessing the plausible scope of Disney's Cinderella mark for dolls leads to other challenges related to the technical aspects of trademark practice – e.g., how do you prove competitive need or injury to limit a trademark holder's claim? This is a question of evidence and proof at the registration (and appeal) stage of trademark practice and also informs the complex (and confused) federal case law on aesthetic functionality.[1] Professor Curtin criticizes the TTAB's guidance that the commercial weakness of Disney's Cinderella mark was all that stood in the way of successful opposition to Zombie Cinderella's registration because it "sends the message that it is possible to appropriate the public domain character like Cinderella, even for products like dolls, if only your marketing and enforcement strategies are aggressive enough." (P. 25.) Instead, the article urges movement in the other direction: application of the aesthetic functionality doctrine at the registration stage to limit the appropriation of public domain characters and features when their depiction is a useful product feature conferring a non-reputationally-related advantage (e.g., a non-trademark benefit) on the trademark holder. As Curtin writes, "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." (P. 43.)

There are other problems with allowing trademark holders to appropriate public domain characters other than restricting competition. Curtin's description is irresistible: "a trademark holder who is successful in altering the meaning of a character so its primary significance is source identification impoverishes the public domain of the character's living meaning, rendering it an inanimate 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." (P. 34.) Once appropriated, the public domain character dies because it is rendered inert by the trademark, whose meaning must remain constant for it to function as the predictable source identifier of the product.

Professor Curtin carefully stays within trademark doctrine for most of the article, mentioning the rule against generic trademarks as a cousin to aesthetic functionality that some have argued can be helpfully applied to characters to limit trademark scope.[2] In addition to aesthetic functionality, she might consider more forcefully arguing for disclaiming practice in trademark law which, as with marks that contain generic words, requires applicants to limit their mark to that which excludes the generic word or uses it only in a specific combination. But she might also draw helpful support from well-established copyright doctrines for the principle that the public domain must remain available to all comers. Scene à faires doctrine requires stock characters and plots (e.g., a wicked witch and star-crossed lovers) to stay in the public domain as critical building blocks of cultural expression. And the separability doctrine applied to useful articles requires separating the useful features of the copyrighted work from the expressive ones (e.g., the useful cut of a dress from the design elements applied to dress fabric) for the purposes of only protecting that which is expressive and not useful to the article's function.[3] As an Article about the difficulty of persuading courts of the commercial and cultural values of aesthetics, it seems worth emphasizing through comparative analysis that trademark law resembles other intellectual property regimes by relying on and therefore protecting as a resource the vibrancy of literary culture in the public domain. In other words, the doctrine of aesthetic functionality is more familiar, conventional, and fundamental than the scholarly and case-law debates over the doctrine would have us believe.

Recently, Professor Curtin has had the opportunity to test her analysis of aesthetic functionality as applied to literary characters in the public domain. For the sequel to *Zombie Cinderella and the Undead Public Domain*, see her opposition (filed along with legal clinic students at Suffolk University Law School) to United Trademark Holding's trademark application for Rapunzel for a line of dolls that depict the Rapunzel character.[4]

1. *See* Justin Hughes, *Cognitive and Aesthetic Functionality*, 36 **Cardozo L. Rev.** 1227 (2015); Robert Bone, *Trademark Functionality Reexamined*, 7 **J. Legal Analysis** 183 (2015); Mark McKenna, *(Dys)Functionality*, 48

Houston L. Rev. 823 (2011-2012).

2. Betsy Rosenblatt, *Adventure of the Shrinking Public Domain*, 86 **U. Colo. L. Rev.** 561 (2015).
3. *But see* *Star Athletica v. Varsity Brands*. As the debate between the majority and dissenting opinions explain, separability is not always a self-evident exercise. Compare *Id.*, slip op. at 13-14 with Breyer dissent, slip op. at 3-5, 10-12.
4. Maria Cramer, *Rapunzel, Rapunzel, Let Down Your Trademark Restrictions*, **Boston Globe** (June 05, 2018); Karen Katz, Loletta Darden & Rebecca Curtin, *Rescuing Rapunzel*, IPWAtchdog (June 16, 2018).

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