

ZOMBIE CINDERELLA AND THE UNDEAD PUBLIC DOMAIN

*Rebecca Schoff Curtin**

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ABSTRACT: 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 a trademark for “Zombie Cinderella” dolls, but was initially refused registration by the examining attorney because “Zombie Cinderella” dolls were found to be confusingly similar to “Walt Disney’s Cinderella” dolls. Such a 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 refusal to register was overturned on appeal, but the TTAB largely relied on doctrine that the “Cinderella” part of Disney’s trademark is 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 extending the doctrine of aesthetic functionality, which denies trademark protection to features of a product that confer a non-reputationally-related advantage on the trademark holder, to cultural elements in the public domain.

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* Associate Professor of Law, Suffolk University Law School. I wish to thank Birdie Curtin, Leah Chan Grinvald, Glynn Lunney, Mark McKenna, Betsy Rosenblatt, and Jessica Silbey for helpful discussions of this project at earlier stages, along with the participants of the 2016 IP Scholars Conference and the 2017 Works in Progress IP Conference. Thanks also to Evan Fleischer and Mollie Heintzelman for excellent research assistance.

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 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 a trademark for “Zombie Cinderella” for dolls, but was 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 on the right:¹

Application Serial No. 85/706,113	Cited Registration No. 3,057,988
ZOMBIE CINDERELLA	

¹ *In re United Trademark Holdings, Inc.*, Serial No. 85706113, 2014 WL 5463042 (T.T.A.B. Oct. 9, 2014). The picture is reproduced from the Applicant’s Response to Office Action of March 7, 2013, p. 2.

Such a 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-century China² and has been widely known in Western culture since at least its first print publications in the sixteenth and seventeenth centuries.³

The refusal to register was overturned on appeal, but the T.T.A.B. largely relied on doctrine that the “Cinderella” part of Disney’s trademark is 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 name 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.”⁴ This doctrine 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, similar reasoning was recently followed in a case involving attempted registration of the mark “Little Mermaid” for dolls.⁵ 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 is. This case involving one producer’s desire to reimagine Cinderella as a walking corpse, combining fairy tale characters with zombies, provides an

² R.D. Jameson, *Cinderella in China*, in THE CINDERELLA CASEBOOK 71 (Alan Dundes, ed., 1983).

³ Harriet Goldberg, *Cinderella*, in THE OXFORD COMPANION TO FAIRY TALES 95, 97 (Jack Zipes, ed., 1999) (describing the earliest known versions of the tale, its remarkable “stability” over time, and “hundreds if not thousands” of adaptations).

⁴ *Id.* at 9.

⁵ *In re United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d 1796 (T.T.A.B. June 13, 2017) (holding that word mark “LITTLE MERMAID when proposed for use in connection with dolls is merely descriptive”).

opportune set of facts for thinking about trademarks in the market for our shared cultural legacy. The issues raised are not only about overreaching trademark claims that might quash expressive uses of public domain characters, but also about the competitive needs of multiple producers to make reference to 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. Finally, it is important to 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. We need a trademark doctrine that will reanimate the living public domain by recognizing its vital role in both culture and commerce.

Introduction: Once Upon a Time . . . in the “Public Domain”

What is meant by the “public domain” in trademark doctrine is itself contested, often 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.⁶ 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

⁶ Laura 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, 569–573 (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).

modern copyright regimes (as in the case of Cinderella),⁷ because whatever copyright protection that once existed has expired (as in the case of the Little Mermaid),⁸ or because the relevant character is otherwise ineligible for copyright protection (as in the case of historical figures like Martha Washington).⁹ 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.¹⁰ 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.¹¹ 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.¹² As the Patent and

⁷ *In re United Trademark Holdings, Inc.*, 2014 WL 5463042 at 8 (describing the origins of Cinderella).

⁸ *In re United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d 1796 at 2–3 (describing the origins of the Little Mermaid).

⁹ *In re Carlson Dolls Co.*, 31 U.S.P.Q.2d 1319 (T.T.A.B. 1994).

¹⁰ See *infra* Section III, p. 54.

¹¹ For a recent example of a case, other than the Zombie Cinderella case, in which the T.T.A.B. applied this reasoning, see *In re United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d 1796 (T.T.A.B. June 13, 2017).

¹² See *infra* Section I, p. 25.

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.¹³ The case law arising out of claimed infringements of rights in toys that carry elements of characters is further confused by the amalgamation of elements from trademark and copyright law.¹⁴

This Article argues that a more coherent choice would be to extend the doctrine of aesthetic functionality to cultural 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 character elements. The Supreme Court has explained that "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."¹⁵ The Court 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."¹⁶ Applying that idea to the Zombie Cinderella case, 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

¹³ See *infra* Section I, p. 29.

¹⁴ 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 (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 (1992); Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429 (1986); Mark P. McKenna, *Dastar's Next Stand*, 19 J. INTELL. PROP. L. 357 (2011–2012); Viva Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, esp. 1506–09; Amanda Schreyer, *An Overview of Legal Protection for Fictional Characters: Balancing Public and Private Interests*, 6 CYBARIS AN INTELL. PROP. L. REV. 50 (2015).

¹⁵ Qualitex Co. v. Jacobson Products, 514 U.S. 159, 164 (1995).

¹⁶ *Id.* at 165.

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.)¹⁷ 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 an infringement action before the Ninth Circuit concerning merchandise that carried images of Betty Boop, *Fleischer Studios v. A.V.E.L.A., Inc.*.¹⁸ Though the opinion that employed aesthetic functionality in its reasoning was withdrawn and replaced by an opinion that made no reference to functionality,¹⁹ this abortive attempt to apply aesthetic functionality as a defense to a merchandising use of a character has revived attention to the doctrine, some positive²⁰ and some negative.²¹ The doctrine of aesthetic functionality has a complex history and remains controversial for some

¹⁷ IONA & PETER OPIE, *Snow White and the Seven Dwarfs*, in THE CLASSIC FAIRY TALES 175, 177 (1974).

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

¹⁹ Fleischer Studios, Inc., v. A.V.E.L.A., Inc., 654 F.3d. 958 (9th Cir. 2011).

²⁰ See, e.g., Irene Calboli, *Betty Boop and the Return of Aesthetic Functionality: A Bitter Medicine Against 'Mutant Copyrights'*? EUROPEAN INTELLECTUAL PROPERTY REVIEW, 2014 Forthcoming. Available at SSRN: <http://dx.doi.org/10.2139/ssrn.2375150>; Irene Calboli, *Overlapping Trademark and Copyright Protection: A Call for Concern and Action*, 2014 U. ILL. L. REV. SLIP OPINIONS 25, 32 (2014); Liu, *supra* note 6, at 1436.

²¹ See, e.g., Tom L. Casagrande, *Betty Boop—A Threat to Licensing Programs*, LAW 360, Mar. 14, 2011, avail. at <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 (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); Brief of Amicus Curiae International Trademark Association in Support of Rehearing or Rehearing En Banc, Fleischer Studios, Inc. v. A.V.E.L.A., Inc., No. 09-56317 (Mar. 21, 2011), reprinted in 101 TRADEMARK REP. 1390 (2011).

commentators and courts.²² The Ninth Circuit’s reasoning was reminiscent of a decades-old case before the T.T.A.B., *In re DC Comics*, in which that court argued that representations of the comic book characters cannot serve as trademarks for dolls of the characters because the character’s features “are commercially functional.”²³ That case was also controversial and was overturned on appeal.²⁴ Some scholars have noted difficulties in the application of aesthetic functionality doctrine to characters.²⁵ 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.²⁶ 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.²⁷

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

²² Robert G. Bone, *Trademark Functionality Reexamined*, 7 J. LEGAL ANALYSIS 183, 238–240; (2015); 1 J. THOMAS McCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §7.8 (5th Ed.); Mark McKenna, (*Dys*)Functionality, 48 HOUSTON L. REV. 823, 843–858 (2011–2012). See also, Trademark Manual of Examining Procedure (Oct. 2017), §1202.02(a)(vi).

²³ *In re DC Comics, Inc.*, 211 U.S.P.Q. (BNA) 834 (T.T.A.B. 1981), *rev’d*, 689 F.2d 1042 (C.C.P.A. 1982).

²⁴ *In re DC Comics, Inc.*, 689 F.2d 1042 (C.C.P.A. 1982).

²⁵ Justin Hughes, *Cognitive and Aesthetic Functionality*, 36 CARDOZO L. REV. 1227, 1263–64 (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”); Leslie Kurtz, *Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 504 (1986) (arguing that aesthetic functionality doctrine is not apposite to a case involving a toy car based on a car from a TV show because “the car’s features were valued not for their intrinsic attractiveness but because of the associations created by the plaintiff”); Rosenblatt, *supra* note 6, at 39 n. 313 (arguing that though “the 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 “‘signaling’ is an odd type of ‘function’ to characterize as functional, since all valid trademarks function as signals of something”).

²⁶ Liu, *supra* note 6, at 1436.

²⁷ *Id.* at 1435; see also Leslie Kurtz, *The Methuselah Factor: When Characters Outlive Their Copyrights*, 11 U. MIAMI ENT. AND SPORTS L. REV. 437, 446 (1993–1994) (arguing that “[i]n 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[lic] domain.”).

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 revisit. 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.²⁸ 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 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 on 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

²⁸ *Qualitex*, 514 U.S. at 164–65, 169–70; *TraffFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33 (2001).

ones.”²⁹ 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.”³⁰ 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 1998.³¹ 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 I 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 II of the Article turns to the 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 III will deal with criticisms that have been raised in

²⁹ ORLY LOBEL, YOU DON’T OWN ME xvi (2018).

³⁰ Jeet Heer, *The Disney Deal is a Disaster for Superhero Movies*, THE ATLANTIC, Dec. 15, 2017, avail. at <https://newrepublic.com/article/146312/disney-deal-disaster-superhero-movies>.

³¹ Liu, *supra* note 6, 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” (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.*)

response to previous applications of the aesthetic functionality doctrine. Part IV 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.

I. Enter “Zombie Cinderella”

On August 21, 2012, United Trademark Holdings, Inc. filed an application to register the word mark “Zombie Cinderella.”³² 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” when both marks are applied to dolls that it was likely to cause confusion.³³ 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. In the final office action, the examining attorney argued that “here. . . the marks are similar in sound and meaning because of the shared use of the term CINDERELLA in relation to toys and dolls.”³⁴

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 highly suggestive in connection with dolls and other related toy goods. In this context, the word “CINDERELLA”

³² U.S. Trademark Application Serial No. 85706113.

³³ U.S. Trademark Application No. 85706113, Examining Attorney’s Appeal Brief, 3/21/2014, at 1.

³⁴ U.S. Trademark Application No. 85706113, Final Office Action, 4/25/2013, at 1.

refers to the character Cinderella from the public domain folk tale first published by Charles Perrault in *Histoires ou contes du temps passé* in 1697.³⁵

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.’”³⁶ 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.”³⁷

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.”³⁸ None of the cited marks was for dolls or toys.³⁹ 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.⁴⁰ The examining attorney’s response to the argument about the conceptual weakness of CINDERELLA due to the public domain fairy tale was more concerning:

³⁵ U.S. Trademark Application No. 85706113, Applicant’s Response to Office Action, 3/7/2013, at 2.

³⁶ *Id.* at 3.

³⁷ *Id.* at 5.

³⁸ Examining’s Attorney’s Appeal Brief, *supra* note 33, at 5.

³⁹ *Id.*

⁴⁰ *In re United Trademark Holdings, Inc.*, Serial No. 85706113, 2014 WL 5463042 (T.T.A.B. Oct. 9, 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.**⁴¹

The examining attorney offered no evidence for his perception that Disney is to be credited for the prominence of the Cinderella tale.⁴² 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 attorney doing the analysis thought exclusively about Disney’s contributions to Cinderella. He was not being asked what Cinderella’s contributions to Disney were. 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 Joyeux Devis* in 1558. Following that publication, it appeared in multiple well-known collections of tales, including

⁴¹ Examining’s Attorney’s Appeal Brief, supra note 33, at 5 (citations omitted, emphasis added).

⁴² 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 7). 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.*

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 1815.⁴³ Scholars now believe the tale circulated in Indo-European culture prior to these publications⁴⁴ and its earliest analogue is a Chinese folktale with origins as early as the ninth century.⁴⁵ Versions of the tale are also known in Japan, Australia, India, and Africa.⁴⁶ 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 1729.⁴⁷ Harriet Goldberg 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."⁴⁸ 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."⁴⁹ 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.⁵⁰

It is difficult to overestimate the pervasive influence of the Cinderella tale. Iona and Peter Opie argue that "the 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

⁴³ Goldberg, *supra* note 3, at 95.

⁴⁴ *Id.*

⁴⁵ 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").

⁴⁶ Goldberg, *supra* note 3, at 97.

⁴⁷ IONA & PETER OPIE, *Cinderella*, in THE CLASSIC FAIRY TALES 117, 121 (1974).

⁴⁸ Goldberg, *supra* note 3, at 97.

⁴⁹ Jane Yolen, *America's Cinderella*, in THE CINDERELLA CASEBOOK 294, 296 (Alan Dundes, ed., 1983).

⁵⁰ Jack Zipes, *Introduction: Towards a Definition of the Literary Fairy Tale*, in THE OXFORD COMPANION TO FAIRY TALES xv, xxviii (Jack Zipes, ed., 1999).

years.”⁵¹ Harriet Goldberg asserts that there have been “hundreds if not thousands of literary, dramatic, musical, poetic, and cinematic versions.”⁵² 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.”⁵³ 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.”⁵⁴

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 1899.⁵⁵ It was released in the United States on Christmas Day that year.⁵⁶ Méliès was an innovator in cinematic techniques,⁵⁷ who was at the highest point of his fame during this period,⁵⁸ when American filmmakers regularly pirated Méliès ’s work.⁵⁹ As an indication of the stability of the elements of the Cinderella tale, below is

⁵¹ OPIE, *supra* note 47 at 117.

⁵² Goldberg, *supra* note 3, at 97.

⁵³ “Cinde’rella, n.”. OED Online. June 2017. Oxford University Press.
<http://proxy.bostonathenaeum.org:2053/view/Entry/33072?redirectedFrom=cinderella&> (accessed August 19, 2017). Some scholars have noted, however, that this definition of “Cinderella story” is somewhat of a misnomer, given that “‘Cinderella’ is not a story of rages 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 enduing but shrewd and practical girl persevering and winning a share of the power.” Yolen, *supra* note 49, at 296.

⁵⁴ Goldberg, *supra* note 3, at 97.

⁵⁵ Terry Staples, ‘Cinderella’, *Film Versions*, in THE OXFORD COMPANION TO FAIRY TALES 98 (Jack Zipes, ed., 1999).

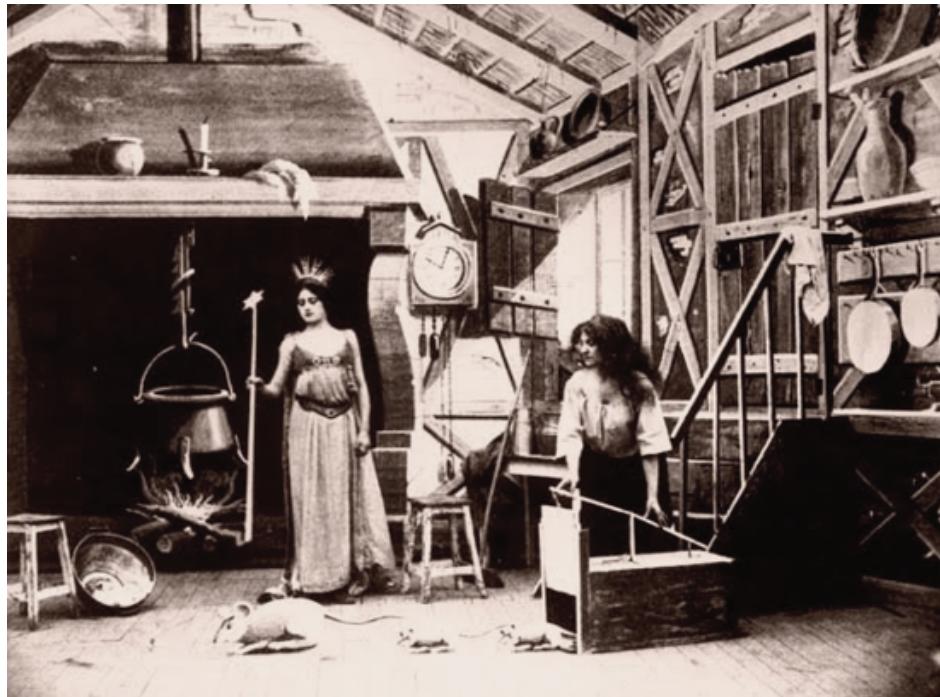
⁵⁶ *Cinderella Release Info*, INTERNET MOVIE DATABASE,
http://www.imdb.com/title/tt0000230/releaseinfo?ref_=tt_dt_dt.

⁵⁷ J.B. Kaufman, *Silent Cinderella*, CUTTING ROOM FLOOR, <http://www.jbkaufman.com/cutting-room-floor/silent-cinderella>.

⁵⁸ Ian Wojcik-Andrews, *Méliès , Georges*, in THE OXFORD COMPANION TO FAIRY TALES 315 (Jack Zipes, ed., 1999).

⁵⁹ PETER DECHERNEY, HOLLYWOOD’S COPYRIGHT WARS 20, 28 (2012).

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 footmen:⁶⁰



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.⁶¹ 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.

⁶⁰ *Cinderella (Film)*, FIRST VERSIONS, <http://www.firstversions.com/2017/07/cinderella-film.html> (includes several still photos and a link the full film).

⁶¹ Staples, *supra* note 55, at 98. Disney completely edited out Perrault's rat as raw material for the coachman, substituting a horse. Perrault also used lizards to be turned into coachmen, while Disney used a dog. *Id.*

Méliès's first version of Cinderella was followed by releases of at least fifteen different movie adaptations between 1900 and 1940 of varying length and style.⁶² 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 1939.⁶³ The Deanna Durbin vehicle, *First Love*, was successful enough to be nominated for three Oscars.⁶⁴ 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*.⁶⁵ The first animated film adaptations of Cinderella came in 1927, by the groundbreaking silhouette filmmaker Lotte Reiniger in Germany⁶⁶ and by Walt Disney himself for Laugh-O-Gram in the United States.⁶⁷

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, the advertising emphasized the association with the public domain character in ways that had changed relatively little over the long remarkable history of Cinderella

⁶² 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 57. 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 55 at 98.

⁶³ Staples, *supra* note 55 at 98.

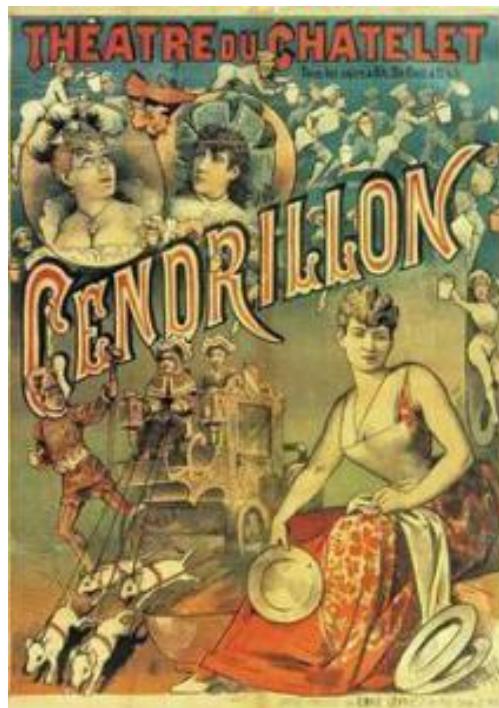
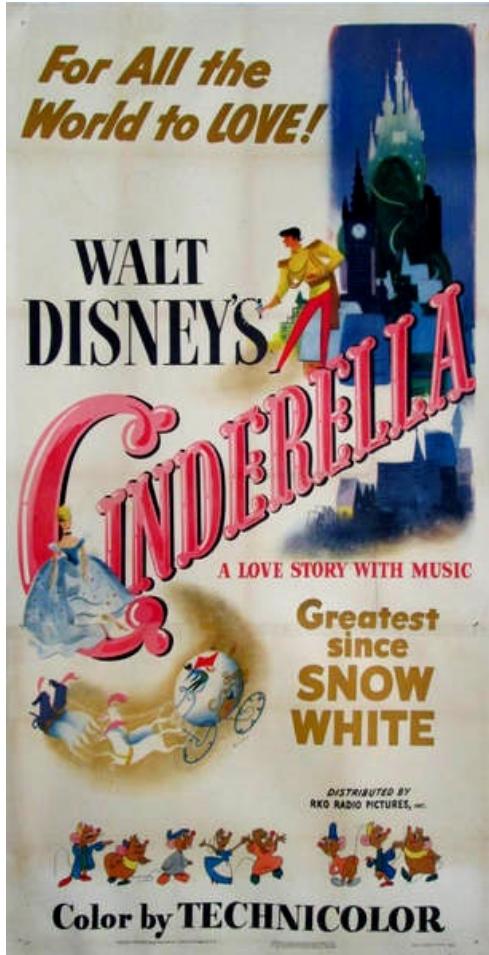
⁶⁴ These were for Best Cinematography, Black-and-White; Best Art Direction; and Best Music, Scoring. *First Love* (1939): Awards, INTERNET MOVIE DATABASE, <http://www.imdb.com/title/tt0031311/awards>.

⁶⁵ Staples, *supra* note 55 at 98.

⁶⁶ *Id.* For more on Lotte Reiniger, see Terry Staples, *Reiniger, Lotte*, in THE OXFORD COMPANION TO FAIRY TALES 419 (Jack Zipes, ed., 1999). She directed the world's first animated feature film. *Id.*

⁶⁷ Kaufman, *supra* note 57.

adaptations. Consider the two posters shown below. On the left is one of the original movie posters for Disney's *Cinderella* in 1950.⁶⁸ On the right is a poster for a stage production of *Cendrillon* by the Theatre du Chatelet in France nearly one hundred years before:⁶⁹



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,

⁶⁸ *Cinderella* (1950), INTERNET MOVIE DATABASE, <http://www.imdb.com/title/tt0042332/>. There was also a variation of this poster without the mice, see *Cinderella Movie Poster (1950)*, <https://www.filmposters.com/pd/CINDERELLA-Movie-Poster-1950/19806>.

⁶⁹ Rafaelle Jolivet Pignon, *Les métamorphoses scéniques Cendrillon: de la féerie à l'inquiétante étrangeté*, in AGÔN: REVUE DES ARTS DE LA SCÈNE, <http://agon.ens-lyon.fr/index.php?id=3158>. The show ran between 1866 and 1888. *Id.*

Cinderella. The things that really sold Disney's film *ex ante* were many of the same salient elements of the tale used by the Theatre du Chatelet 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 aren't 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.⁷⁰

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.⁷¹

⁷⁰ *In re United Trademark Holdings, Inc.*, Serial No. 85706113, 2014 WL 5463042, at 8, 10 (T.T.A.B. Oct. 9, 2014).

⁷¹ *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.⁷² However, the Court 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.” As a result, the Court concluded, “it has limited power to function as a source indicator.”⁷³ Terms classified as “suggestive” are inherently distinctive, however, and may be registered without a showing of secondary meaning. In other words, the Court 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, 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.

The T.T.A.B. then moved on to consider the “commercial weakness” of the term “Cinderella” in Disney’s mark. Here, the court focused on third-party uses in connection

⁷² Rosenblatt, *supra* note 6 (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,” at 625-626). Jane C. Ginsburg, *Licensing Commercial Value: From Copyright to Trademarks and Back in THE LAW AND PRACTICE OF TRADEMARK TRANSACTIONS*, 54, 66 (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 “if 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” at 66, 68).

⁷³ *In re United Trademark Holdings, Inc.*, 2014 WL 5463042, at 9.

with identical goods (dolls). The Court 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—though 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 Court is the “Dolly Pockets Cinderella Doll,” pictured below on the left.⁷⁴



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 (and pictured above on the right)⁷⁵ is a more formal, traditional doll by Madame Alexander in a ball gown. Finally, the Court 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

⁷⁴ The picture is from the Amazon.com ad for the doll (<https://www.amazon.com/North-American-Bear-Company-Cinderella/dp/B00EAMHHTG>), the same picture as that offered as Exhibit L, applicant’s request for consideration of October 25, 2013 at 31.

⁷⁵ The picture is from the Amazon.com ad for the doll (https://www.amazon.com/Madame-Alexander-Dolls-Storyland-Collection/dp/B000O94RS8/ref=sr_1_1?s=toys-and-games&ie=UTF8&qid=1503636296&sr=1-1&keywords=madame+alexander+cinderella+8%22+storyland) the same picture as that offered as Exhibit K, applicant’s request for consideration of October 25, 2013 at 29.

as a teenaged high school student. The doll, pictured below, has white-blonde hair, wears a mini-skirt, striped leggings, and what appear to be glass high-heeled shoes:⁷⁶



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. 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 isn’t really predictive of how the doll will look, as each doll conceives of the fairy tale princess in a

⁷⁶ The picture is from the Amazon.com ad for the doll (https://www.amazon.com/Fairy-Tale-High-Cinderella-Fashion/dp/B00D5SDLCS/ref=sr_1_1?ie=UTF8&qid=1503636518&sr=1-1&keywords=Fairy+Tale+High+Cinderella+Fashion+doll), the same picture is offered as Exhibit J, Applicant’s request for reconsideration of October 25, 2013 at 27. At the time, United Trademark Holdings, Inc., held a registration for the mark “Fairy Tale High” for “dolls.” *In re United Trademark Holdings, Inc.*, 2014 WL 5463042, at 11. They have since successfully registered the mark “Teen Cinderella,” Reg. No. 4989621.

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. 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 and, indeed, in a typical example of Disney's own Cinderella dolls, which are pictured below:⁷⁷



⁷⁷ The pictures are taken from the Amazon.com ads for each doll, available at https://www.amazon.com/Once-Upon-Zombie-Im-Cinderella/dp/B00DHA9REA/ref=sr_1_1?s=toys-and-games&ie=UTF8&qid=1503672995&sr=1-1&keywords=zombie+cinderella and https://www.amazon.com/DISNEY-STORE-CINDERELLA-CLASSIC-DOLL/dp/B01IAAY21Y/ref=sr_1_5?s=toys-and-games&ie=UTF8&qid=1503674695&sr=1-5&keywords=disney+cinderella. 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. Reg. No. 3057988, Specimen of Use dated Jan. 25, 2016, available at <http://tsdr.uspto.gov/documentviewer?caseId=sn75543711&docId=SPE20031024160033#docIndex=2&page=8>

Note that the packaging for both dolls features images of the glass slipper. 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.

However, when considering the commercial weakness of the term “Cinderella,” the Court is 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. The analysis focuses 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.”⁷⁸ Curiously, the Court does reference 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.”⁷⁹ This evidence is used to support the idea that “zombie” is indeed “used as an adjective to describe dolls that depict zombies.”⁸⁰ The Court seems more inclined to view what it terms “the archetype of the ‘zombie’”⁸¹ as merely descriptive than it is to view the specific character, Cinderella, that way, given the language the Court uses calling Cinderella “highly suggestive.” 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 court.⁸²

⁷⁸ *In re United Trademark Holdings, Inc.*, 2014 WL 5463042, at 11–12.

⁷⁹ *In re United Trademark Holdings, Inc.*, 2014 WL 5463042, at 13.

⁸⁰ *Id.*

⁸¹ *Id.* at 12.

⁸² 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. On the entrance of the word into the English language and its meaning, see ROGER LOCKHURST, ZOMBIES: A CULTURAL HISTORY 17–41 (2015). On the pop culture relevance of the zombie, see James Parker, *Our Zombies, Ourselves*, THE ATLANTIC, April 2011, at 32.

In the final analysis, the Court agrees 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. The Board concluded:

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.⁸³

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 Court 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

⁸³ *Id.* at 16.

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 Mermaid⁸⁴ and the Snow Queen,⁸⁵ plus the Snow Maiden, the heroine of a nineteenth-century Russian tale and opera,⁸⁶ and Rapunzel, the heroine of a fairytale with a history as old as that of Cinderella.⁸⁷ 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 name⁸⁸ and *The Snow Queen* in the 2013 blockbuster, *Frozen*.⁸⁹ While the T.T.A.B. affirmed refusal of LITTLE MERMAID for dolls because of its descriptiveness,⁹⁰ registrations have issued for SNOW QUEEN⁹¹ and SNOW MAIDEN,⁹² both for dolls and toy figures. The application for RAPUNZEL for dolls and toy figures is still pending.⁹³

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

⁸⁴ HANS CHRISTIAN ANDERSEN, *The Little Mermaid* in THE ANNOTATED HANS CHRISTIAN ANDERSEN 119 (Maria Tatar, ed., 2008). The trademark application was Ser. No. 86836082.

⁸⁵ Joan G. Haahr, *Snow Queen*, *The* in THE OXFORD COMPANION TO FAIRY TALES 478 (Jack Zipes, ed., 1999). The application was Ser. No. 86886490.

⁸⁶ Richard Taruskin, *Snow Maiden*, *The [Snegoruchka]* in THE GROVE BOOK OF OPERA (2nd ed., 2008). The application was Ser. No. 86496765.

⁸⁷ Karen Seago, *Rapunzel* in THE OXFORD COMPANION TO FAIRY TALES 416 (Jack Zipes, ed., 1999). The application is 87690863.

⁸⁸ *In re United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d 1796 at 4; 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 tale alive,” 120).

⁸⁹ Samantha Langsdale, *Disney Classics and ‘Poisonous Pedagogy’: The fairytale roots of Frozen (2013)*, 4 ANIMATION PRACTICE, PROCESS & PRODUCTION 27 (2014).

⁹⁰ *In re United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d 1796 at 11.

⁹¹ Reg. No. 5079718 issued November 8, 2016.

⁹² Reg. No. 5064887 issued October 18, 2016.

⁹³ Ser. No. 87690863, filed November 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.

goods worldwide in fiscal year 2015.⁹⁴ The practice of licensing 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*.⁹⁵ 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.⁹⁶ It has been observed that “licensed characters offer an easily identifiable toy or story line,” among other benefits.⁹⁷ This is an important advantage because the toy industry, like the entertainment industry, is notoriously volatile.⁹⁸ Licensing characters out to toymakers and other merchandizers provides a vital revenue stream for content creators.⁹⁹ Content in the form of movies, television or other programming that features the character provides a form of advertising for the product.¹⁰⁰ 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.¹⁰¹ 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.¹⁰² With traditional

⁹⁴ *The Top 150 Global Licensees*, 19 LICENSE! GLOBAL T3 (May 1, 2016), avail. at <http://www.licensemag.com/license-global/top-150-global-licensees-2>

⁹⁵ NORMA ODOM PECORA, THE BUSINESS OF CHILDREN’S ENTERTAINMENT 21 (1998).

⁹⁶ *Id.* at 57.

⁹⁷ *Id.*

⁹⁸ *Id.* at 46.

⁹⁹ 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.

¹⁰⁰ *Id.* at 40.

¹⁰¹ *Id.* at 51.

¹⁰² *The Top 150 Global Licensees*, *supra* note 94, at T6.

royalty rates of 5 to 15% of wholesale cost,¹⁰³ 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 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,¹⁰⁴ 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!¹⁰⁵

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."¹⁰⁶ 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:

¹⁰³ PECORA, *supra* note 95 at 55.

¹⁰⁴ <http://www.thetoonstudio.com/Home.html>. 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*, <https://www.awn.com/news/disneytoon-studios-builds-slate-under-new-name-and-homes-needy> (June 16, 2003).

¹⁰⁵ *About Toon Studio*, <http://www.thetoonstudio.com/about.html>

¹⁰⁶ *Id.*

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 touch a child's soul, and we have so many assets we need to make use of. Building the bond will build our brand.¹⁰⁷

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."¹⁰⁸

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.¹⁰⁹

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.¹¹⁰ Not even the Grimm Brothers themselves claimed to control the characters that their collections of folk tales disseminated to the world.¹¹¹ 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.

¹⁰⁷ *The Toon Studio of Beverly Hills*, RETAIL MERCHANDISER MAGAZINE (Jan. 3, 2012) avail. at <http://www.retail-merchandiser.com/reports/licensing-reports/330-the-toon-studio-of-beverly-hills>.

¹⁰⁸ *Id.*

¹⁰⁹ *Id.*

¹¹⁰ 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." 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." 17 U.S.C. §103(b).

¹¹¹ Vladimar Hafstein, *Fairy Tales, copyright and the public domain* in THE CAMBRIDGE COMPANION TO FAIRY TALES (Maria Tatar, ed., 2015) 11, 13.

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.¹¹² 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." 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). (Emphasis added.)¹¹³

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." 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).

¹¹² *In re United Trademark Holdings, Inc.*, *supra* note 5 at 6.

¹¹³ *Id.* at 8.

In contrast to the analysis applied to the LITTLE MERMAID application, however, the SNOW QUEEN application was approved without a single office action.¹¹⁴ 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, 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.¹¹⁵ 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 the following form:¹¹⁶



Note that the mark incorporates both the house mark of The Toon Studio and the name of the author of the public domain tale, Hans Christian Andersen. The specimen of use that was ultimately submitted to the PTO apparently includes these elements, but the picture is too small

¹¹⁴ The prosecution history is available here:

http://tsdr.uspto.gov/#caseNumber=86886490&caseType=SERIAL_NO&searchType=statusSearch.

¹¹⁵ 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. See *History of Junior Elf*, <http://www.juniorelf.com/history.php>; see also this page, listing the Junior Elf logo as among those on offer from Toon Studio: <http://www.thetoonstudio.com/Home.html>. 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 <http://www.juniorelf.com/index.php>. 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.

¹¹⁶ <http://www.thetoonstudio.com/snow-queen.html>

to see anything other than the words “Snow Queen.”¹¹⁷ There is every 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.¹¹⁸

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.¹¹⁹ 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

¹¹⁷ 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=SOU20160831182739#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.

¹¹⁸ Hafstein, *supra* note 111 at 11.

¹¹⁹ 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 120 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 <https://www.skinnygirlcocktails.com/about-us>; see also Lizzie Widdicombe, *Perfect Pitching: Bethenny Frankel and the new breed of celebrity entrepreneur*, THE NEW YORKER (Sept. 21, 2015), avail. at <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?

domain characters should be classed as descriptive when consumers associate such references with the character embodied by the product, 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,¹²⁰ 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 *Abercombie* spectrum, the

¹²⁰ Toon Studio has publicized two of its Snow Queen licensing deals. See <http://www.thetoonstudio.com/news.html>. One is for the creation of a live-action show in Australia. 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., Registration No. 4094086, Disney's registration of the word mark RAPUNZEL for services including “entertainer services, namely, live appearances by a professional entertainer.” 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.” 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.*

primary test for determining the inherent distinctiveness of word marks.¹²¹ 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.” 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. 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.¹²² Consider the wide range of Cinderella dolls that were in evidence before the T.T.A.B. in the Zombie Cinderella case.¹²³ 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 Board 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.¹²⁴ 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

¹²¹ *Abercrombie & Fitch v. Hunting World*, 537 F.2d 4, 9 (2d Cir. 1976).

¹²² *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983).

¹²³ See *supra* note 74–76 and accompanying text.

¹²⁴ *Id.* at 791.

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 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.”¹²⁵

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.¹²⁶

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

¹²⁵ *Id.*

¹²⁶ 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 *Filipino Yellow Pages, Inc. v. Asian Journal Pubs., Inc.* 198 F.3d 1143 (9th Cir. 1999).

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.”¹²⁷ She explains that the doctrine “embodies the basic principle that trademark law does not protect generic terms, which are defined as the ‘common descriptive name’ for a type of product or service.”¹²⁸ 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.¹²⁹

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.¹³⁰

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

¹²⁷ Rosenblatt, *supra* note 6 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.

¹²⁸ *Id.*

¹²⁹ *Id.* at 626.

¹³⁰ *Id.*

Nonetheless, genericism doesn't 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.¹³¹ 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.¹³²

Another examining attorney made virtually the same argument in the final office action refusing United Trademark Holdngs, 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.'"¹³³ That is, the examining attorneys saw "stories" and "dolls" as such separate product categories that the meaning of the character in relation to the story wouldn't control its meaning in relation to dolls.¹³⁴ In this mindset, seeing the name of the character from the story as a generic term for the

¹³¹ *In re United Trademark Holdings, Inc.*, *supra* note 1 at 9.

¹³² U.S. Trademark Application No. 85706113, Final Office Action, 4/25/2013, at 2.

¹³³ U.S. Trademark Application No. 85706104, Final Office Action, 4/21/2013, at 2–3.

¹³⁴ 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: "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." TMEP §1202.10. So there is a

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.¹³⁵

The uneasiness of the fit between characters and the *Abercrombie* spectrum is only exacerbated in trade dress cases where we might be trying to judge whether a non-verbal element of packaging or product design that evokes Cinderella’s story is eligible for protection. Holders of IP rights in characters have in the past 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.¹³⁶ In the case of packaging involving

kind of presumption that character names don’t 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.

¹³⁵ 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.

¹³⁶ See, e.g., Ideal Toy Corp. v. Kenner Products, and Twentieth Century-Fox Licensing Corp., 443 F.Supp. 291 (S.D.N.Y. 1977) (in which Ideal Toy Corp. sought declaratory judgment that their “Star Team” toys did not infringe “Star Wars” film, and defendants moved for a preliminary injunction against Ideal’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 Communications, 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 is 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 is protected under Section 43(a) of the Lanham Act); Warner Bros. Inc. v. American Broadcasting Companies, Inc., 720 F.2d 231 (2d Cir 1983) (in which owners of the Superman character of comic book, movie, and television fame, attempt to enjoin the makers of *The Greatest American Hero* television series).

nonverbal design elements, the *Abercrombie* spectrum may be difficult to apply in a way that would recognize the significance of public domain material.¹³⁷ 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.¹³⁸ 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 are useful product features. These features should be kept available for all producers to use without fear of infringement liability. In the next section, I turn to the doctrine of aesthetic functionality, which I argue, gives courts (and examining attorneys) a better tool for perceiving and preserving the vital role that public domain character elements play in our material culture.

¹³⁷ 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, as it is focused primarily on whether the shape is unusual and commercially distinct in the field. *Seabrook Foods, Inc., v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977). If it is not, then the purported markholder may still attempt to show secondary meaning.

¹³⁸ *Wal-mart Stores, Inc., v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

II. 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. 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.”¹³⁹ 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.”¹⁴⁰ Crucially, Prof. Bone urges that we should understand functionality doctrine as balancing “trademark-related benefits of protecting source-identifying trade dress” on one side with “the costs of restricting access to and use of product features” on the other.¹⁴¹ 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,¹⁴² so I think there is hope that the doctrine is supple enough to deal with both images and names of characters in verbal and nonverbal marks.

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

¹³⁹ Bone, *supra* note 22, at 195.

¹⁴⁰ *Id.*, at 220.

¹⁴¹ *Id.* at 222.

¹⁴² 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 et al. v. Krause et al.*, 160 F. 270 (C.C.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”).

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."¹⁴³ 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."¹⁴⁴ The Court goes on to summarize the test for functionality in the following way: "[i]n general terms, a product feature is functional,' and cannot serve 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-

¹⁴³ McKenna, *supra* note 22, at 848.

¹⁴⁴ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

reputation-related disadvantage.”¹⁴⁵ 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.”¹⁴⁶ 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 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.”¹⁴⁷

Here, the ability to invoke 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

¹⁴⁵ *Id.* at 165 (citing *Inwood Laboratories, Inc.*, 456 U.S., at 850, n. 10).

¹⁴⁶ *Qualitex Co.*, 514 U.S. at 169.

¹⁴⁷ *TraFFix Devices, Inc.*, v. *Marketing Displays, Inc.*, 532 U.S. 23, 32 (2001).

necessary.”¹⁴⁸ 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?¹⁴⁹ In 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 it.¹⁵⁰

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,

¹⁴⁸ McKenna, *supra* note 22, at 846.

¹⁴⁹ See Bone, *supra* note 22, at 238 (noting that the “heterogeneity of aesthetic preference” makes it difficult to evaluate the relative competitiveness of alternative designs).

¹⁵⁰ Smith et al. v. Krause et al., 160 F. 270, 271 (C.C.S.D.N.Y 1908).

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*.

The effect of a reference to Cinderella might be classed as what Justin Hughes has termed “pre-existing cognitive, psychological or aesthetic responses among consumers” that can justify a finding of aesthetic functionality and “curb overbroad trademark claims to product features.”¹⁵¹ In part, I am merely arguing to add “cultural response” to that list when we’re thinking about public domain characters, with the important caveat that the reasoning promoted by Prof. Hughes could extend only to character elements that “trigge[r] a positive. . . response among a substantial composite of the relevant consumers and that response predates the trademark owner’s activities.”¹⁵² At the very least, trademark doctrine should recognize the fully animated role that widely known and pre-existing cultural elements are playing in the Disney 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.

Finally, 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

¹⁵¹ Hughes, *supra* note 25, at 1279.

¹⁵² *Id.* at 1230.

one interpreter would dampen the impact it could make.¹⁵³ We are better off with both Disney's Cinderella and Zombie Cinderella. Yet, the T.T.A.B. did 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*,¹⁵⁴ 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. 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"),¹⁵⁵ the court granted a preliminary injunction on the 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."¹⁵⁶ 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."¹⁵⁷ The court, however, responds by citing indices of the

¹⁵³ Compare, e.g., the critique by Samantha Langsdale of the Disney interpretation of "The Snow Queen" in the animated feature *Frozen* with the analysis by Pauline Greenhill of the interpretations made in live-action films by four women directors. Langsdale charges 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. Langsdale, *supra* note 89, at 27–28. Greenhill argues that the four films she analyzes, all based on "The Snow Queen," "offer a compelling example of how geographically and temporally dispersed adaptation can share perspectives beyond their common source material, ones which [she] argu[es] can be directly linked to what one director felicitously called a (feminist) 'misinterpretation' of the original." Pauline Greenhill, *Team Snow Queen: feminist cinematic 'misinterpretations' of a fairy tale*, 13 STUDIES IN EUROPEAN CINEMA 32 (2016).

¹⁵⁴ *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.*, 157 F.Supp. 621 (SDNY 1958).

¹⁵⁵ *Id.* at 623, 625.

¹⁵⁶ *Id.* at 624.

¹⁵⁷ *Id.* at 623.

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.”¹⁵⁸ The court concludes:

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 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. . . .¹⁵⁹

The analysis just doesn’t leave a lot of room for thinking about what advantage the television producers had in building on the existing “life and legend” of the historical Wyatt Earp, which, 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.¹⁶⁰ It has been observed that Wyatt Earp was “something of a celebrity” for much of his life.¹⁶¹ The myth-making began early, with Earp himself reinventing his own persona many times.¹⁶² 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.¹⁶³ He spent time in the 1890’s in California racing horses.¹⁶⁴ In city directories in San Francisco and San Diego, he described his occupation

¹⁵⁸ *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.*

¹⁵⁹ *Id.*

¹⁶⁰ ALLEN BARRA, INVENTING WYATT EARP: HIS LIFE AND MANY LEGENDS 330–31 (1998).

¹⁶¹ *Id.* at 11.

¹⁶² ANDREW C. ISENBURG, WYATT EARP: A VIGILANTE LIFE 202 (2013).

¹⁶³ BARRA, *supra* note 160 at 329.

¹⁶⁴ *Id.* at 321.

as “capitalist.”¹⁶⁵ In 1896, he was embroiled in a nationwide scandal as referee of a boxing match that was alleged to have been fixed.¹⁶⁶ 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.¹⁶⁷ 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.¹⁶⁸ Earp was portrayed on film for the first time in 1923, in a silent film starring his friend William Hart.¹⁶⁹ 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.¹⁷⁰ Earp passed away in 1929 and a best-selling biography followed shortly after his death.¹⁷¹ Tom Mix is said to have wept at his funeral.¹⁷²

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.¹⁷³

¹⁶⁵ *Id.*

¹⁶⁶ *Id.* at 322–28.

¹⁶⁷ MICHAEL F. BLAKE, HOLLYWOOD AND THE O.K. CORRAL: PORTRAYALS OF THE GUNFIGHT AND WYATT EARP 22 (2007); BARRA, *supra* note 160 at 341.

¹⁶⁸ BARRA, *supra* note 160 at 11, 336.

¹⁶⁹ *Id.* at 342.

¹⁷⁰ *Id.* at 12–13.

¹⁷¹ *Id.* at 10–11.

¹⁷² *Id.* at 340.

¹⁷³ *Id.* at 14.

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 1955.¹⁷⁴ The important factor to note, 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 Twenties and early 1930s saw Wyatt Earp through the lens of the 1920s crime wave.¹⁷⁵ 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."¹⁷⁶ 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."¹⁷⁷ 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

¹⁷⁴ 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 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.

¹⁷⁵ *Id.* at 343.

¹⁷⁶ BLAKE, *supra* note 167, at 59.

¹⁷⁷ *Id.* at 87.

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. So this seems like a case whose 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, 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,¹⁷⁸ here 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.¹⁷⁹

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

III. 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, *In re DC Comics*, the

¹⁷⁸ Bone, *supra* note 22 at 222.

¹⁷⁹ BARRA, *supra* note 160 at 405.

T.T.A.B. upheld an examiner'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."¹⁸⁰ 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.¹⁸¹

I appreciate the move the Board 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 Board concluded that the "designs are functional in a utilitarian sense and for that reason are not trademarks." This engendered three problems for the opinion on appeal. 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, finally, 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 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.¹⁸²

¹⁸⁰ *In re DC Comics, Inc.*, 211 U.S.P.Q. (BNA) 834, 3 (T.T.A.B. 1981), *rev'd*, 689 F.2d 1042 (C.C.P.A. 1982).

¹⁸¹ *Id.*

¹⁸² McKenna, *supra* note 22, at 854.

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, appellant’s drawings are unable to perform as trademarks for toy dolls” and arguing that the Board had “obscured the distinction between utilitarian and aesthetic functionality.”¹⁸³ 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.¹⁸⁴

The court treats 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.” 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 efforts.” 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 an argument by Gay Toys that the symbols identifying a toy car as the “General Lee,” driven in the television show “The Dukes of Hazzard,” were functional.¹⁸⁵ Gay Toys argued that the symbols

¹⁸³ In re DC Comics, 689 F.2d 1042 (C.C.P.A. 1982).

¹⁸⁴ *Id.* at 1044.

¹⁸⁵ Warner Bros., Inc. v. Gay Toys, Inc., 724 F.2d 327, 330 (2d Cir. 1983).

were “functional in the sense that they are essential to enable children to play ‘Dukes of Hazzard’ with the cars.”¹⁸⁶ 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.”¹⁸⁷ Once again, the Court assumes 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 “carried 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.”¹⁸⁸ 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.¹⁸⁹ 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 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

¹⁸⁶ *Id.*

¹⁸⁷ *Id.*

¹⁸⁸ *Id.*

¹⁸⁹ See *supra* notes 144–45 and accompanying text.

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.¹⁹⁰ On remand, the Central District court of California did turn again to aesthetic functionality, but the court’s reasoning relied heavily on the finding that the defendant’s uses of the words Betty Boop were ornamental, not trademark use. The court says “because, as noted above, Defendant’s 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.’”¹⁹¹

First, it is problematic to conflate aesthetically functional uses with merely ornamental uses because there is separate doctrine that squarely deals with ornamentation that has no source-identifying content.¹⁹² By contrast, 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,¹⁹³ heart-shaped boxes for candies,¹⁹⁴ and a “Merrie Christmas” message on gift wrap ribbon¹⁹⁵ are more than ornamental. In each case, the purported mark is enhancing the marketability of the product,

¹⁹⁰ *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115 (9th Cir. 2011), withdrawn and superceded by *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011).

¹⁹¹ *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 925 F.Supp.2d 1067 (C.D.Cal. 2012).

¹⁹² See TMEP 1202.03 (Refusal on Basis of Ornamentation). The TMEP explicitly directs examining attorneys not to use aesthetic functionality as a basis for refusal in such cases. *Id.* at 1202.02(a)(vi).

¹⁹³ *In re Florists’ Transworld Delivery Inc.*, 106 USPQ2d 1784 (TTAB 2013); cited in TMEP1202.02(a)(vi).

¹⁹⁴ RESTATEMENT OF TORTS, §742, comment a (1938), quoted in Bradford Duft, “Aesthetic” Functionality, 73 TRADEMARK REPORTER 151, 174 (1983).

¹⁹⁵ *Smith et al. v. Krause et al.*, 160 F. 270, 271 (C.C.S.D.N.Y 1908).

respectively, to communicate grief, to express love, and to 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 Book 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 Defendant's merchandise.¹⁹⁶

The Court sees 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 functions to connect the images to the fictional character, and on the t-shirts that feature movie posters, the character's name is central to the text on the poster. The Court also importantly acknowledged that, in its analysis, the character's name had a significance apart from the source of the goods: "In addition, because Defendant's use of the Betty Boop word mark is not source identifying and simply does not trade on the 'reputation' of any source, barring Defendant from using those words would 'impose a significant non-reputation-related competitive disadvantage.'"¹⁹⁷

The *Fleischer* court's reasoning, however, limits the application of the doctrine pretty significantly when it appears to require a showing that there is no trademark use of the relevant elements at all.¹⁹⁸ For instance, in the case of an infringement suit comparing Disney's

¹⁹⁶ *Fleischer Studios, Inc., v. A.V.E.L.A., Inc.*, 925 F.Supp.2d 1067, 1075 (C.D.Cal. 2012).

¹⁹⁷ *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 it 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, though 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 *supra* at note 185 and accompanying text.

¹⁹⁸ *Fleischer Studios, Inc., v. A.V.E.L.A., Inc.*, 925 F.Supp.2d 1067, 1074 (C.D.Cal. 2012) (stating that "the Court finds, as a matter of law, that Defendant's use of the Betty Boop word mark is not a trademark use").

Cinderella and Zombie Cinderella, under the *Fleischer* court 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.”¹⁹⁹ 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 the mark may be aesthetically functional when used in relation to one class of goods, but not for the others.²⁰⁰

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:

[i]f 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 effect 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.²⁰¹

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

¹⁹⁹ McKenna, *supra* note 22, at 857.

²⁰⁰ *Id.* at 855 (arguing that this problem of “dual significance” is common in aesthetic functionality case).

²⁰¹ Casagrande, *supra* note 21.

entity” 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.²⁰² Whatever competitive advantage the mark holder might receive in that scenario is most likely to derive from the mark holder’s reputation. However, when consumers buy a t-shirt because “they like the depicted character itself,” 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).

Of course not all trademark uses of the Cinderella name are aesthetically functional. Consider the trademarks pictured below (Cinderella for an eyebrows spa,²⁰³ Cinderella Soap Co. for soap and bath products,²⁰⁴ and Cinderella Maids Service for cleaning services²⁰⁵):

²⁰² 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).

²⁰³ Reg. No. 3916845. Photo taken from <https://www.flickr.com/photos/7978334@N03/6990110111>.

²⁰⁴ Reg. No. 3432137. Label taken from <https://www.etsy.com/shop/cinderellasoap>.

²⁰⁵ Reg. No. 3936315. Photo taken from <http://www.cinderellamaidsservice.com>.



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 doesn't prevent others from marketing and offering the same eyebrow-grooming services, or equally effective soap, or yet superior cleaning services. The marks in this case just 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.

This can be so without undermining the merchandising rights that markholders have become accustomed to controlling for marks. Consider the keychain on the left below, featuring the Volkswagen logo. On the right is a picture of a t-shirt bearing the image of Betty Boop—suspend for a moment the fractured copyright claim in her case²⁰⁶ and focus solely on the

²⁰⁶ Calboli, *supra* note 20, at 6.

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.²⁰⁷ 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:²⁰⁸



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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.²¹¹

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

²⁰⁷ *Au-tomotive Gold, Inc., v. Volkswagen of America, Inc.*, 457 F.3d. 1062 (9th Cir. 2006).

²⁰⁸ *Fleischer Studios, Inc., v. A.V.E.L.A., Inc.*, 925 F. Supp.2d 1067 (C.D.Cal. 2012).

²⁰⁹ Picture taken from the web catalog of Troika, <https://troikaus.com/collections/automotive/products/volkswagen-vw-logo-pendant-key-chain?variant=821064567>.

²¹⁰ Picture taken from https://www.teeshirtpalace.com/products/sexy-star-betty-boop-logo-t-shirt?gclid=EA1aIQobChM1x66k1-jg2QIVFq_ICh1ubwXEEAkYASABEgJ_FPD_BwE.

²¹¹ *Au-tomotive Gold, Inc.*, *supra* note 207, 1073–74.

brand--and thus it is *not* “nonreputational” in any significant way.²¹² 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 products that included the BETTY BOOP name. This is because the words Betty Boop serve to name the famous character depicted on those goods. . .²¹³

The Court cites to *Auto-motive 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 *Auto-motive Gold*.²¹⁴ The Court here recognized a distinction 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.

IV. Resurrecting the Public Domain

And that brings us to the hard cases. What about cases regarding the aesthetic or cultural functionality of characters who were born under copyright? (Or for that matter, what about so-

²¹² Calboli, *supra* note 20, at 5 (observing that the *Auto-motive Gold* court followed the *TraFFix* test); see also Hughes, *supra* note 25, 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,” 1277).

²¹³ Fleischer Studios, Inc., *supra* note 208, at 1075.

²¹⁴ *Id.* at 1074.

called “spokescharacters” who are born as trademark logos and then become protagonists of expressive works?)²¹⁵ 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. It seems to me that these are the strongest cases for a finding of aesthetic functionality because the “nonreputational” 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?

I admit, there may be better doctrines to draw clear, explicit lines between copyright and trademark,²¹⁶ 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. 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. However, as the expiration of 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

²¹⁵ On spokescharacters, *see, e.g.* Ginsburg, *supra* note 72, at 73–5.

²¹⁶ *See, e.g.*, Mark McKenna, DASTAR’s *Next Stand*, 19 J. INTELL. PROP. L. 357 (2011–12).

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.²¹⁷

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 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

²¹⁷ The effects of such movement over time are beyond the scope of this paper, 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 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 Reg. No. 2683060). 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.

not the heroines of famous fairy tales in their former lives. Walt Disney created Mickey Mouse using preexisting elements.”²¹⁸ 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.*²¹⁹ 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.”²²⁰ 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 paper, 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.²²¹

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.

²¹⁸ Jessica Litman, *Mickey Mouse Emeritus: Character Protection and the Public Domain*, 11 U. MIAMI ENT. & SPORTS L. REV. 429, 433 (1993–94).

²¹⁹ Jim Korkis, *More Secrets of Steamboat Willie*, in A MICKEY MOUSE READER 331 (2014).

²²⁰ *Id.* at 335.

²²¹ Walter Benjamin, *On Mickey Mouse*, in A MICKEY MOUSE READER 20 (2014).