



2021

Owning Frida Kahlo

Lario Albarrán

Follow this and additional works at: <https://scholarlycommons.law.emory.edu/eilr>



Part of the [International Law Commons](#)

Recommended Citation

Lario Albarrán, *Owning Frida Kahlo*, 35 Emory Int'l L. Rev. 627 (2021).

Available at: <https://scholarlycommons.law.emory.edu/eilr/vol35/iss4/3>

This Comment is brought to you for free and open access by the Journals at Emory Law Scholarly Commons. It has been accepted for inclusion in Emory International Law Review by an authorized editor of Emory Law Scholarly Commons. For more information, please contact law-scholarly-commons@emory.edu.

OWNING FRIDA KAHLO

INTRODUCTION

Her paintings demand—fiercely—that you look at her.

—Hayden Herrera¹

Frida Kahlo is undoubtedly one of the most recognizable names in art history.² Her work epitomizes Mexican national and indigenous traditions and is regarded as an uncompromising depiction of the female experience and form.³ But her fame goes beyond art galleries. Kahlo's face—brooding gaze, elaborate Mexican coiffures, and signature mono-brow—rivals the likes of Marilyn Monroe and Elvis Presley as one of the most recognizable faces in the world.⁴ Captivating artists, scholars, fashion designers, and more, Kahlo is celebrated, studied, and commodified.⁵ In 2001, the U.S. Postal Service placed her image on a 34-cent stamp.⁶ In 2003, the Academy of Motion Picture Arts and Sciences awarded the biopic *Frida* two Oscars.⁷ In 2010, Google adorned its website with a doodle of her face.⁸ She returned to the big screen in 2017 with a cameo in Disney-Pixar's *Coco*.⁹ In fact, one can find Kahlo on shoes, cosmetics, socks, tequila, and even Barbie dolls.¹⁰ In 2018, Barbie manufacturer, Mattel, Inc.

¹ Amy F. Collins, *Diary of a Mad Artist*, VANITY FAIR, Nov. 2015, at 90 (citations omitted).

² Jessica Stewart, *Mexican Sound Library Discovers First (and Possibly Only) Voice Recording of Frida Kahlo*, MY MODERN MET (June 17, 2019), <https://mymodernmet.com/frida-kahlo-voice-recording>.

³ Tony Palazzolo, *Women's History Wednesday: Spotlight- Frida Kahlo*, SAVING HALLOWED GROUND (Dec. 13, 2017), <https://www.savinghallowedground.org/single-post/2017/12/13/Womens-History-Wednesday-Spotlight—Frida-Kahlo>.

⁴ Lis Pankl & Kevin Blake, *Made in Her Image: Frida Kahlo as Material Culture*, 44 MATERIAL CULTURE (Vol. 2) 1, 3 (2012). Interestingly enough both Presley and Monroe have a history with trademark law and the courts. For specific examples of these trademark cases, see, e.g., *Milton H. Greene Archives, Inc. v. Marilyn Monroe LLC*, 692 F.3d 983, 1000 (9th Cir. 2012) (“I knew I belonged to the Public and to the world, not because I was talented or even beautiful but because I had never belonged to anything or anyone else”); *Elvis Presley Enterprises v. Elvisly Yours*, 936 F.2d 889 (6th Cir. 1991).

⁵ See Jenny Valentish, *The Commodification of Frida Kahlo: Are We Losing the Artist Under the Kitsch?*, GUARDIAN (Dec. 28, 2018), <https://www.theguardian.com/artanddesign/2018/dec/29/the-commodification-of-frida-kahlo-are-we-losing-the-artist-under-the-kitsch>.

⁶ Richard Carr, *Joint Issue with Mexico Honors Artist Kahlo*, SUN SENTINEL (July 1, 2001), <https://www.sun-sentinel.com/news/fl-xpm-2001-07-01-0106290717-story.html>.

⁷ See *The 75th Academy Awards*, ACADEMY OF MOTION PICTURE ARTS AND SCIENCES (Mar. 23, 2003), <https://www.oscars.org/oscars/ceremonies/2003>. For a stellar performance by Salma Hayek and a story that takes many creative liberties regarding Kahlo's life, see *FRIDA* (Lionsgate 2002).

⁸ See *Frida Kahlo's 103rd Birthday*, GOOGLE: DOODLE (July 6, 2010), <https://www.google.com/doodles/frida-kahlos-103rd-birthday>.

⁹ See *COCO* (Pixar 2017).

¹⁰ *Frida Kahlo: Vault Collection*, VANS, <https://www.vans.com/vault-main/frida-kahlo.html> (last visited Mar. 2, 2021); Kaleigh Fasanella, *Ulta Beauty Just Launches a Frida Kahlo Collection in Honor of Her Birthday*, ALLURE (July 5, 2019), <https://www.allure.com/story/frida-kahlo-ultra-beauty-makeup-collection>; *Frida Kahlo*

(Mattel) announced the Frida Kahlo doll on International Women's Day, and immediately caused an international uproar.¹¹

The controversy behind the manufacturing of the Frida Kahlo doll revolved around who was entitled to use and license Kahlo's name and image.¹² On one side, Mattel asserted it licensed Kahlo's name and likeness from the Frida Kahlo Corporation (FKC), the alleged owner of all rights related to Kahlo's name and identity in the United States.¹³ On the other side of the border, Kahlo's grandniece, Mara Romeo (Mara), claimed that Mattel did not have the proper authorization to use Kahlo's image.¹⁴ The controversy reached a crescendo when a judge of the Superior Court of Justice of Mexico City granted a temporary injunction and ordered Mattel and FKC to stop using the "brand, image and work of the illustrious painter Frida Kahlo" without permission from the owner of the rights—Mara.¹⁵ In return, FKC sued Mara, claiming that she undermined and defamed the company and had illegally used their Kahlo trademark.¹⁶ To complicate matters even more, two artists filed separate lawsuits challenging the FKC's alleged trademark registration of Kahlo's name and likeness the following year in 2019.¹⁷ Both artists decided to go to court after FKC lodged takedown orders against the e-commerce platforms hosting the artists' work that included Kahlo's name and image.¹⁸

Socks, SOCK SMITH, <https://www.socksmith.com/collections/frida-kahlo-socks>; *Frida Kahlo*, TEQUILA MATCHMAKER, <https://www.tequilamatchmaker.com/brands/471-frida-kahlo>; *Barbie Inspiring Women Series Frida Kahlo Doll*, BARBIE, <https://barbie.mattel.com/shop/en-us/ba/inspiring-women-series/barbie-inspiring-women-series-frida-kahlo-doll-fjh65>.

¹¹ Patrick J. McDonell, *Mattel Has a New Doll: Frida Kahlo Barbie. Descendants of the Artist Want It off the Shelves*, L.A. TIMES (Mar. 9, 2018), <https://www.latimes.com/world/mexico-americas/la-fg-mexico-frida-20180308-story.html>.

¹² *Id.*

¹³ *Id.*

¹⁴ Mara Romeo (@FridaKahlo), TWITTER (Mar. 7, 2018, 8:39 PM), <https://twitter.com/FridaKahlo/status/971576198185783299>.

¹⁵ Mara Romeo (@FridaKahlo), TWITTER (Apr. 18, 2018, 11:08 PM), <https://twitter.com/FridaKahlo/status/986803684569952256>.

¹⁶ See Jillian Steinhauer, *Fight over Frida Kahlo Trademark Takes a New Turn as Corporation Countersues Her Family*, ART NEWSPAPER (May 10, 2018), <https://www.theartnewspaper.com/news/fight-over-frida-kahlo-trademark-takes-a-new-turn-as-corporation-countersues-her-family>.

¹⁷ See Second Amended Declaratory Judgment Complaint at 2, *Shope v. Frida Kahlo Corp.*, No. 1:19-cv-01614-RBJ (Colo. Dist. Ct. Dec. 2, 2019) [hereinafter *Shope's Complaint*]; Second Amended Declaratory Judgment Complaint at 2, *Melo v. Frida Kahlo Corp.*, No. 3:19-cv-05449-CRB (N.D. Cal. Feb. 18, 2020) [hereinafter *Melo's Complaint*].

¹⁸ See *id.* For other commentary on the lawsuits, see also, e.g., *Artist Takes on Frida Kahlo Corporation in Copyright Spat*, BOODLE HATFIELD: ART LAW & MORE (June 10, 2019), <https://artlawandmore.com/2019/06/10/artist-takes-on-frida-kahlo-corporation-in-copyright-spat>; Araceli Cruz, *The Frida Kahlo Corporation is Being Sued by a California-Based Artist*, HIPLATINA (Jan. 28, 2020), <https://hiplatina.com/frida-kahlo-corporation-trademark-dispute>.

The back-and-forth between the parties raises numerous questions: When does using a historical figure's name become trademark infringement? What law governs the issue—U.S. law or Mexican law? Who is the rightful trademark owner—FKC or Mara? What issues of race and gender are uncovered in “owning” Kahlo? And more importantly, who *should* own the rights to Kahlo's name and likeness? To answer these questions, this Comment builds on two existing bodies of work. First, the extensive literature, across various academic disciplines, that centers Kahlo as a vehicle of study.¹⁹ Namely, it expands on Laurel Salisbury's research on the litigation and commodification of Kahlo's trademark.²⁰ Second, the work of legal scholars drawing on Critical Race Theory (CRT) to study racial investments and implications of intellectual property (IP).²¹ Positioned at the nexus of these two bodies of work, this Comment offers the first CRT examination of Kahlo's trademarks.

Part I offers a brief overview of Kahlo to contextualize the personal and financial significance underneath the legal disputes over possessing the rights to her name and likeness. With litigation on both sides of the U.S.-Mexico border, understanding the various parties and their respective suits sets the stage for the rest of this Comment. Part II presents a broad overview of the theory that undergirds trademark law. It then surveys domestic and international doctrines of trademark law. Doing so explains how international trademark treatises interact with a country's domestic trademark regime. Finally, Part III offers an introductory overview of CRT to problematize local and international trademark law.

¹⁹ For examples of the various academic disciplines centering Kahlo, see Valmantas Budrys, *Frida Kahlo's Neurological Deficits and Her Art*, in 203 PROGRESS IN BRAIN RESEARCH: THE FINE ARTS, NEUROLOGY, AND NEUROSCIENCE: NEURO-HISTORICAL DIMENSIONS 241 (Stanley Finger et al. eds., 2013) (neuroscience); Helene B. Bernstein & Charlene Villaseñor Black, *Frida Kahlo: Realistic Reproductive Images in the Early Twentieth Century*, 121 AM. J. MED. 1114 (2008) (obstetrics and gynecology); S.M.O Gradwohl & E.R. Turato, *From the Lack to the Sublimation: Psychodynamic Considerations About the Inability to Become Pregnant by the Way of Biographical Data About Frida Kahlo*, 26 EUR. PSYCHIATRY 1691 (2011) (psychiatry); Alba F. Aragón, *Uninhabited Dresses: Frida Kahlo, from Icon of Mexico to Fashion Muse*, 18 FASHION THEORY 517 (2014) (fashion); Barbara Nelson, *(De)Fusing the Bomb (Shell): Gender Issues, Popular Culture and Frida Kahlo*, 3 J. RES. GENDER STUD. 108 (2013) (gender studies); Nieves Limón Serrano, *Frida Kahlo's Photographic Posing: A Theoretical Approach to Visual Autobiographies*, 28 J. LATIN AM. CULTURAL STUD. (2019) (cultural studies).

²⁰ See Laurel Salisbury, *Rolling Over in Her Grave: Frida Kahlo's Trademarks and Commodified Legacy*, CTR. FOR ART LAW (Aug. 2, 2019), <https://itsartlaw.org/2019/08/02/rolling-over-in-her-grave-frida-kahlos-trademarks-and-commodified-legacy> (detailing the legal controversy surrounding Kahlo's trademark in the aftermath of the Kahlo Barbie) [hereinafter *Rolling Over in Her Grave*].

²¹ See generally Anjali Vats & Deidre A. Keller, *Critical Race IP*, 36 CARDOZO ARTS & ENT. L.J. 735, 740 (2018) (“[T]he interdisciplinary movement of scholars connected by their focus on the racial and colonial non-neutrality of the laws of copyright, patent, trademark, right of publicity, trade secret, and unfair competition using principles informed by CRT.”).

This Comment relies on the visionary insights of critical race theorists and is indebted to CRT, a strain of legal scholarship that challenges the ways in which race and racial power are constructed and represented in legal culture and, more generally, in society as a whole.²² CRT has not only challenged the substance of legal scholarship, it has also “contest[ed] the very language of mainstream legal and social analysis”²³ arguing that a preference for neutral, disengaged, unracial, and unsexed voices in legal scholarship reifies a baseline that is both white and male.²⁴ Challenging this preference, CRT embraces the notion of “grounding a scholarly voice in the material, aesthetic, emotional, and spiritual experiences of people of color.”²⁵ CRT also embraces storytelling as a way to interrogate the law and enrich the scholarly conversation.²⁶ This Comment does precisely that—storytelling and CRT, in practice. Accordingly, Part III ends with a critical race analysis of international trademark law and offers ideas to look towards the future as a starting point to inspire further inquiry. This Comment challenges the legal structures that exacerbated Kahlo’s commodification. Despite U.S., Mexican, and international doctrines of trademark and ownership, no party should hold exclusive rights of Kahlo’s trademarks. Instead, Kahlo’s name, likeness, and other trademarkable aspects should enter the public domain.

²² KIMBERLÉ W. CRENSHAW ET AL., *CRITICAL RACE THEORY: THE KEY WRITINGS THAT FORMED THE MOVEMENT* (Kimberlé W. Crenshaw et al. eds., 1995) [hereinafter CRENSHAW ET AL., *CRITICAL RACE THEORY*].

²³ *Id.* at 314.

²⁴ *Id.* at xiii (noting that CRT “rejects the prevailing orthodoxy that scholarship should be or could be ‘neutral’ and ‘objective’”).

²⁵ *Id.* at 314; see also John O. Calmore, *Critical Race Theory, Archie Shepp, and Fire Music: Securing an Authentic Intellectual Life in a Multicultural World*, 65 S. CAL. L. REV. 2129, 2147 (1992) (noting that CRT, “at its best, creates an art style that represents a fulfillment of culture” that includes “adding our own distinctly stylized dimensions to legal scholarship”).

²⁶ For examples of story-driven work in CRT, see Patricia J. Williams, *Alchemical Notes: Reconstructing Ideals from Deconstructed Rights*, 22 HARV. C.R.-C.L. L. REV. 401, 416 (1987); Derrick Bell, *The Space Traders*, in *FACES AT THE BOTTOM OF THE WELL: THE PERMANENCE OF RACISM* 158 (1992); Richard Delgado, *Storytelling for Oppositionists and Others: A Plea for Narrative*, 87 MICH. L. REV. 2411 (1989).

I. FROM *LA CASA AZUL* TO U.S. FEDERAL COURT: THE WOMAN BEHIND THE TRADEMARK

[He] does pretty well for a little boy, but it is I [] who am the big artist.
—Frida Kahlo²⁷

Kahlo's status as an icon goes beyond art history circles and expands into fashion, Latinx, feminist, and LGBTQ+ communities as well.²⁸ But that was not always the case. During her life, Kahlo and her work remained relatively niche outside of Mexico until the late 1970s.²⁹ Part I sets the stage for the rest of this Comment by detailing Kahlo's humble beginnings in *La Casa Azul* to the current controversy regarding her trademarks. The three sections within Part I detail Kahlo's life, the posthumous rise of Fridamania, and the litigation over Kahlo's trademark.

A. *Kahlo's Life: A Short History of the Mexican Anti-Capitalist Painter*

Magdalena Carmen Frieda Kahlo y Calderón was born on July 6, 1907 in the house of her parents, *La Casa Azul*, in Coyocoan, Mexico City, Mexico.³⁰ If asked, however, Kahlo always claimed to be born in 1910—the year the Mexican revolution began.³¹ Often announcing herself as a daughter of the revolution, Kahlo lived with a deep sense of independence and rebellion against ordinary social and moral habits. She was moved by passion and sensuality,

²⁷ Louis Aguilar, *Iconic Frida Kahlo Before She Was an Icon*, DETROIT NEWS (Feb. 2, 2017), <https://www.detroitnews.com/story/entertainment/arts/2017/02/02/frida-kahlo-iconic-artist-detroit-news/97386432> (citations omitted).

²⁸ For examples of the various works naming Kahlo as an icon, see *Looking at Frida Kahlo As A Global Icon*, GOOGLE ARTS & CULTURE, <https://artsandculture.google.com/theme/looking-at-frida-kahlo-as-a-global-icon/WALCrwz09w38KA?hl=en> (global icon); Lauren M. Freese, *Frida Kahlo and Chicana self-portraiture: Maya Gonzalez, Yreina D. Cervantez, and Cecilia Alvarez* (2013) (unpublished M.A. thesis, University of Iowa) (on file with author and University of Iowa Libraries) (art history); Hayden Herrera, *ART VIEW: Why Frida Kahlo Speaks to the 90's*, N.Y. TIMES (Oct. 28, 1990), <https://www.nytimes.com/1990/10/28/arts/art-view-why-frida-kahlo-speaks-to-the-90-s.html> (fashion); Amy Funderburk, *How Frida Kahlo's Sense of Self Created an Icon*, ART & OBJECT (Dec. 17, 2019), <https://www.artandobject.com/articles/how-frida-kahlos-sense-self-created-icon> (Latinx); Elisabeth Malkin, *Recalling Frida Kahlo, Myth and Reality*, N.Y. TIMES (July 9, 2007), <https://www.nytimes.com/2007/07/09/arts/09iht-kahlo.1.6560761.html> (feminism); Ellie Violet Bramley, *Frida Kahlo: Feminist, Selfie Queen, Queer Icon and Style Muse of 2017*, GUARDIAN (Oct. 28, 2017), <https://www.theguardian.com/fashion/2017/oct/29/frida-kahlo-style-muse-of-the-year> (LGBTQ+).

²⁹ Herrera, *supra* note 28.

³⁰ See, e.g., Karen Karbo, *The Inconvenient Spectacle of Frida Kahlo*, NAT'L GEOGRAPHIC (Jan. 4, 2019) <https://www.nationalgeographic.com/culture/2019/01/excerpt-frida-kahlo-artist-praise-difficult-women/#close> (explaining that Kahlo dropped the "e" in 1922.); MUSEO FRIDA KAHLO, <https://www.museofridakahlo.org.mx/en/the-blue-house> (informing visitors of the history of Kahlo's home).

³¹ See Judy Cox, *Frida Kahlo: Artist and Revolutionary* (Aug. 16, 2018), <https://www.counterfire.org/articles/opinion/19792-frida-kahlo-artist-and-revolutionary>.

proud of her *Mexicanidad* and cultural tradition—all mixed with a particular sense of humor.³² Unfortunately, her life was marked by physical and psychological suffering.³³

Kahlo lived with chronic pain and other ills throughout her life, which were often incorporated in her paintings.³⁴ She contracted polio when she was six, which crippled her right leg leaving it shorter, smaller, and with a limp for the rest of her life.³⁵ In 1925, Kahlo, only eighteen at the time, was riding a bus when it was hit by a car.³⁶ An iron handrail pierced her stomach through her vagina breaking both her back and pelvis and causing other severe injuries to her body.³⁷ Given the limited medical technology of the time, even the treatments tortured her body including the need to wear steel orthopedic corsets and undergo more than thirty documented surgical operations.³⁸ Her pelvic injury served as a prelude for her traumatic infertility.³⁹ Kahlo had several abortions and miscarriages, one of which caused severe hemorrhaging.⁴⁰ In 1953, gangrene led to the amputation of her right leg.⁴¹ Kahlo spent the rest of her life in a wheelchair.⁴² Nonetheless, Kahlo's pain was not the only thing that inspired her paintings.

Kahlo explained she experienced two great accidents in her life: one being the terrible bus collision, and the other being Diego Rivera.⁴³ A subject of great fascination and speculation, Kahlo's marriage to Mexican muralist Rivera was

³² *Id.*; see Diana Vernon, *Fridamania: The Frida Kahlo Effect*, CULTURE TRIP (Dec. 18, 2016), <https://theculturetrip.com/north-america/mexico/articles/fridamania-the-frida-kahlo-effect>; *Honestly Frida*, PBS: THE LIFE AND TIMES OF FRIDA KAHLO, <https://www.pbs.org/weta/fridakahlo/life>.

³³ See Barbara Maranzani, *How a Horrific Bus Accident Changed Frida Kahlo's Life*, BIOGRAPHY (Jan. 25, 2019), <https://www.biography.com/news/frida-kahlo-bus-accident>.

³⁴ *Id.*

³⁵ *Id.*

³⁶ *Id.*; Collins, *supra* note 1.

³⁷ See *Frida Kahlo: The Palette, the Pain, and the Painter*, ARTFORUM INT'L (Mar. 1983), <https://www.artforum.com/print/198303/frida-kahlo-the-palette-the-pain-and-the-painter-35514>.

³⁸ See Javier Espinoza, *Frida Kahlo's Last Secret Finally Revealed*, GUARDIAN (Aug. 11, 2007), <https://www.theguardian.com/world/2007/aug/12/artnews.art>.

³⁹ Gabriela Munoz, *Understanding Frida Kahlo's Fertility Problems*, SCI. ILLUSTRATED (May 3, 2012), <https://scienceillustrated.com.au/blog/science/news/understanding-frida-kahlos-fertility-problems>.

⁴⁰ *Id.*; see also *Pregnancy Loss and Visual Expressions of Grief: An Examination of Frida Kahlo*, GOSHEN COLL.: UNDERGRADUATE ACADS. (July 28, 2010), <https://www.goshen.edu/academics/2010/07/28/pregnancy-loss-and-visual-expressions-of-grief-an-examination-of-frida-kahlo>.

⁴¹ See Maranzani, *supra* note 33; see also Brindille (@Brindille_), TWITTER (Jan. 18, 2018, 11:26 AM), https://twitter.com/brindille_/status/954042383225774087?lang=en.

⁴² *Timeline*, PBS: THE LIFE AND TIMES OF FRIDA KAHLO, <https://www.pbs.org/weta/fridakahlo/life>.

⁴³ Lisa W. Rogers, *Frida's First Bad Accident*, LISA'S HIST. ROOM (May 26, 2009), <https://lisawallrogers.com/2009/05/26/frida-kahlos-first-bad-accident>.

passionate, tumultuous, and intense.⁴⁴ Kahlo and Rivera, then the most famous modernist in the Americas, wed in 1929.⁴⁵ Despite their marriage, Kahlo and Rivera engaged in multiple extramarital love affairs with Rivera encouraging Kahlo's romantic relationships with women.⁴⁶ An unorthodox union, their marriage pushed through the jealousy and sadness despite Rivera's infidelities and Kahlo's affairs with women.⁴⁷ The marriage met a breaking point when Kahlo discovered Rivera's affair with Cristina—Kahlo's younger sister.⁴⁸ The pair divorced in 1939.⁴⁹ Even so, their mutual passion and admiration for each other kept bringing them back to one another, and they remarried the following year in 1940 until Kahlo's death in 1954, at the age of 47.⁵⁰

Primarily known for her many portraits and self-portraits, Kahlo channeled her physical and emotional personal experiences into her work which often centered symbolic portrayals of her physical and psychological wounds.⁵¹ Kahlo also found inspiration in the nature, artifacts, and politics of Mexico.⁵² Kahlo's artwork constantly touched upon social and cultural issues intermixed with her race and disability.⁵³ She took her fiercely, anti-capitalistic politics and activism and joined the Mexican Communist Party in 1927.⁵⁴ Later she would even harbor the Marxist revolutionary Leon Trotsky in her home.⁵⁵ The political and social meaning of Marxism and her anti-capitalistic beliefs are readily seen within Kahlo's 1954 *Marxism Will Give Health to the Ill*.⁵⁶ Kahlo's last public

⁴⁴ See *Frida Kahlo (Painter)*, AMAZING WOMEN ROCK, <https://amazingwomenrock.com/frida-kahlo-painter>.

⁴⁵ *Frida Kahlo*, BIOGRAPHY (Feb. 28, 2018), <https://www.biography.com/artist/frida-kahlo>.

⁴⁶ Sara Kettler, *Behind Frida Kahlo's Real and Rumored Affairs with Men and Women*, BIOGRAPHY (June 19, 2019), <https://www.biography.com/news/frida-kahlo-real-rumored-affairs-men-women>.

⁴⁷ See *id.*; *Frida Kahlo (Painter)*, *supra* note 44.

⁴⁸ Collins, *supra* note 1.

⁴⁹ Karbo, *supra* note 30.

⁵⁰ See Jonathan Jones, *Salma Hayek on Why Frida Kahlo Was a Great Artist*, GUARDIAN (Feb. 13, 2003), <https://www.theguardian.com/film/2003/feb/14/artsfeatures1>.

⁵¹ See William Grimes, In 'Frida Kahlo: Art, Garden, Life,' Nature Melds With the Artist Herself, N.Y. TIMES (May 21, 2015), <https://www.nytimes.com/2015/05/22/arts/design/in-frida-kahlo-art-garden-life-nature-melds-with-the-artist-herself.html>.

⁵² See *id.*

⁵³ See Lindsay Baker, *Unlocking the Hidden Life of Frida Kahlo*, BBC: DESIGNED (June 18, 2018), <https://www.bbc.com/culture/article/20180615-unlocking-the-hidden-life-of-frida-kahlo>.

⁵⁴ Alexxa Gotthardt, *How Frida Kahlo's Love Affair with a Communist Revolutionary Impacted Her Art*, ARTSY (Apr. 30, 2019), <https://www.artsy.net/article/artsy-editorial-frida-kahlos-love-affair-communist-revolutionary-impacted-art>.

⁵⁵ *Id.*

⁵⁶ *Marxism Will Give Health to the Ill*, GOOGLE ARTS & CULTURE, <https://artsandculture.google.com/asset/marxism-will-give-health-to-the-ill/HAEIppnYYlxEWA?hl=en> (depicting Karl Marx uplifting Kahlo in the center, her crutches discarded in this moment as a dove is pictured in the far-left corner, contrasted with a hand choking the neck of a bearded white man in a red, white, and blue hat, whose body is that of a chicken).

appearance before her death was spent participating in a protest against U.S. interventions in Guatemala.⁵⁷ Critics have noted Kahlo's marriage to Rivera eclipsed her work during her lifetime, while today her work is seen as autobiographical fact of her turbulent life rather than art.⁵⁸ Others point out how the public may recognize and love Kahlo's face—but do not understand her work.⁵⁹ A primary reason for that is *Fridamania*.⁶⁰

B. *The Fridamania Phenomenon*

Fridamania, or Fridolatry and Kahloism, generally refers to Kahlo's posthumous rise in popularity from cult-like status to celebrity icon.⁶¹ During her lifetime, Kahlo was primarily known as Rivera's exotic, colorful, and eccentric (read: Mexican) wife.⁶² She gradually gained more recognition in the late 1970s when feminist scholars began to question the exclusion of female and non-Western artists from the art historical canon and when the Chicano Movement lifted her as one of its icons.⁶³

Two events were instrumental to Fridamania and raising the general public's interest in Kahlo's life and art outside of Mexico. The first was a 1982 joint retrospective of her paintings and Tina Modotti's photographs at the Whitechapel Gallery in London.⁶⁴ The second was the publication of art historian Hayden Herrera's international bestseller, *Frida: A Biography of Frida Kahlo* in 1983.⁶⁵ By 1984, Kahlo's reputation as an artist had grown to such extent that Mexico declared her works part of the national cultural heritage, prohibiting their export from the country.⁶⁶ Fridamania raised the popularity of

⁵⁷ *Frida Kahlo's Art Through the Lens of Magical Realism*, 1000MUSEUMS (June 1, 2020), <https://www.1000museums.com/frida-kahlo-art-magical-realism>.

⁵⁸ See Jones, *supra* note 50.

⁵⁹ See Sebastian Smee, *You Might Think You Know Frida Kahlo, But You'll Never Understand Her Pain*, WASH. POST (Feb. 14, 2019), https://www.washingtonpost.com/entertainment/museums/you-might-think-you-know-frida-kahlo-but-youll-never-understand-her-pain/2019/02/14/1509f868-2e4e-11e9-813a-0ab2f17e305b_story.html.

⁶⁰ See Pankl & Blake, *supra* note 4, at 1; Vernon, *supra* note 32.

⁶¹ Pankl & Blake, *supra* note 4, at 1; Vernon, *supra* note 32.

⁶² See Emily Green, *As Mexico Capitalizes on Her Image, Has Frida Kahlo Become Over-Commercialized?*, NPR (June 2, 2018), <https://www.npr.org/2018/06/02/616129555/as-mexico-capitalizes-on-her-image-has-frida-kahlo-become-over-commercialized>; Gannit Ankori, *Frida Kahlo: Fashioning Her Self in San Francisco*, DE YOUNG MUSEUM (Feb. 25, 2020), <https://deyoung.famsf.org/fashioning-her-self>.

⁶³ Pankl & Blake, *supra* note 4, at 1.

⁶⁴ *Id.*

⁶⁵ *Id.*

⁶⁶ Decreto por el que se Declara Monumento Artístico toda la obra de la Artista Mexicana Frida Kahlo Calderón, Incluyendo la obra de Caballete, la obra Gráfica, los grabados y los documentos técnicos, sean Propiedad de la Nación o de Particulares, Diario Oficial de la Federación [DOF] 25-07-1984 (Mex.); see also

Kahlo's biography, work, and image through the 1980s and into the 1990s.⁶⁷ It has since taken a life of its own.

Fridamania slowly transformed Kahlo's image into a commodity, void of her life story, her politics, and her disability. A feminist, anti-capitalist, queer, disabled, gender fluid, revolutionary, Kahlo is routinely stripped down to a subdued, able-bodied, feminized, and whitened ideal of feminism for mass consumption that stands in direct opposition to both her life and artistic endeavors.⁶⁸ For example, Theresa May sported a Kahlo bracelet and confused onlookers considering May, the Conservative Prime Minister of the United Kingdom at the time, held drastically different views to Kahlo's fierce Marxist and later Stalinist beliefs.⁶⁹ Further erasing Kahlo's lived experience, Hollywood packaged Salma Hayek in a hypersexualized portrayal of Kahlo as a tango-dancing flirt, while *Coco* depicted Kahlo as a performance artist dotty about working with oversize fruits.⁷⁰ In fact, the issue Mara raised over the Kahlo Barbie centered on Mattel's erasure of Kahlo's race, disability, and androgynous features.⁷¹ Accordingly, parties are fighting for more than Kahlo's trademarks and licensing rights—they are fighting for her legacy.

C. *The Litigation over Kahlo's Trademark*

Kahlo died intestate in *La Casa Azul*, paving the way for the current legal dispute.⁷² According to Mexican Industrial Property law, Kahlo's niece, Isolda Pinedo Kahlo (Isolda), inherited Kahlo's IP rights in her capacity as the third

CCP Staff, *Mexico: Art in the Time of Restrictive Export Laws*, CULTURAL PROP. NEWS (July 4, 2018), <https://culturalpropertynews.org/mexico-art-in-the-time-of-restrictive-export-laws>.

⁶⁷ See Tess Thackara, *How Frida Kahlo Became a Global Brand*, ARTSY (Dec. 19, 2017), <https://www.artsy.net/article/artsy-editorial-frida-kahlo-global-brand>.

⁶⁸ A search engine query for "Frida Kahlo" reveals many examples. See, e.g., *Frida Kahlo Endure More Girls Ringer T-Shirt*, HOT TOPIC, <https://www.hottopic.com/product/frida-kahlo-endure-more-girls-ringer-t-shirt/10784606.html> ("Frida Kahlo Endure More Girls Ringer T-Shirt [] \$7.99"); *Frida Kahlo Graphic Tee*, FOREVER 21, <https://www.forever21.com:frida-kahlo-graphic-tee> (last visited Mar. 2, 2020) ("Frida Kahlo Graphic Tee [] \$8.00").

⁶⁹ See, e.g., Morwenna Ferrier, *Was Theresa May's Frida Kahlo Bracelet a Political Statement?*, GUARDIAN (Oct. 4, 2017), <https://www.theguardian.com/politics/2017/oct/04/was-theresa-mays-frida-kahlo-bracelet-a-political-statement> (questioning May's motives for the choice of bracelet); Hannah Jane Parkinson (@ladyhaja), TWITTER (Oct. 4, 2017, 8:34 AM), <https://twitter.com/ladyhaja/status/915570818876362752> (noting the irony of May's choice of bracelet). See generally Isabella Gomez Sarmiento, *Frida Kahlo: Radical Artist, Political Activist, Icon*, TEEN VOGUE (Jan. 26, 2018), <https://www.teenvogue.com/story/frida-kahlo-radical-artist-political-activist-icon> (detailing Kahlo's ideological perspectives).

⁷⁰ COCO (Pixar 2017).

⁷¹ See McDonell, *supra* note 11.

⁷² Complaint at 3, *Frida Kahlo Corp. v. Romeo Pinedo*, 1:18-cv-21826 (S.D. Fla. May 7, 2018) [hereinafter FKC's Complaint].

“degree” in the collateral line of succession.⁷³ In 2003, Isolda’s daughter, Mara, was granted power of attorney over Isolda’s legal affairs, including the Kahlo’s rights to publicity.⁷⁴ This right is especially important for someone like Kahlo whose recognition stems largely from her distinctive appearance, which served as the subject matter for much of her art.⁷⁵ This Section expands on FKC’s legal disputes with both Mara and the artists suing FKC. First, it presents a brief history of Mara’s relationship with FKC. Then it explains FKC’s lawsuits related to Mara before discussing the artists’ litigious responses to FKC’s takedown orders.

1. *How Mara Met FKC*

Kahlo’s right of publicity expired in 2004, the same year FKC formed.⁷⁶ Isolda and Mara entered a working relationship with businessman Carlos Dorado, owner of FKC.⁷⁷ Dorado learned of Frida Kahlo when one of his employees wore a flannel shirt with, what Dorado described as, “a very ugly woman, with eyebrows joined[.]”⁷⁸ After asking about the “ugly woman,” his employee explained that it was the face of Kahlo and mentioned Salma Hayek’s *Frida*.⁷⁹ Dorado and his wife went to see the film and he claimed the film made a huge impression upon him.⁸⁰ Dorado then visited *La Casa Azul* where he met Isolda and convinced the family to let him commercialize Kahlo.⁸¹ Mara and her family offer a different story. According to Mara, any transfer of rights to FKC was not a complete transfer.⁸² Rather, FKC and the family were supposed to work together to mutually approve of any products bearing Frida Kahlo’s name

⁷³ Mexico uses the term *Industrial Property* to categorize laws protecting patents, utility models, industrial designs, and trademarks but it is not the legal equivalent of U.S. Intellectual Property law. See Reglamento de la Ley de la Propiedad Industrial [RLPI] sec. XII, art. 90, Diario Oficial de la Federación [DOF] 25-06-1991, últimas reformas DOF 28-06-2010 (Mex.) [hereinafter Mexican Industrial Property Law].

⁷⁴ FKC’s Complaint, *supra* note 72, at 4.

⁷⁵ See Rebecca Kleinman, *Frida Kahlo Was a Painter, a Brand Builder, a Survivor. And So Much More.*, N.Y. TIMES (Jan. 31, 2019), <https://www.nytimes.com/2019/01/31/arts/design/frida-kahlo-booklyn-museum.html> (emphasizing how Kahlo’s art centered the subject she knew best—herself).

⁷⁶ See Shope’s Complaint, *supra* note 17, at 5.

⁷⁷ See Mariana Garcia, *Frida Kahlo Corporation*, GLOB. OPINIONS (Jan. 1, 2017), <https://archive.fo/i3yNF#selection-1853.1-1853.24>.

⁷⁸ *Id.*

⁷⁹ *Id.*

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² See Sonia Sierra, *Legal Battle over Frida Kahlo Brand*, EL UNIVERSAL (Sept. 6, 2017), <http://archive.is/bUtTP#selection-1989.0-1989.35>.

and image.⁸³ FKC would provide the resources and the know-how, and Mara would provide the name.⁸⁴ Mara claims she never sold any rights to FKC.⁸⁵

The United States Patent and Trademark Office (USPTO) has records of registration belonging to Isolda of the “Frida Kahlo” name for use in a wide variety of commercial circumstances.⁸⁶ Representing her mother, Mara legally transferred the existing U.S. trademark registrations to FKC.⁸⁷ As such, FKC registered all subsequent U.S. registrations of Frida’s name, signature, initials, and slogans.⁸⁸ Meanwhile, the Mexican Institute of Industrial Property (IMPI), Mexico’s trademark office, has most of Frida’s trademarks registered to FKC but many registrations are also held in Mara’s name.⁸⁹ At some point in 2011, the working relationship between FKC and Mara began deteriorating.⁹⁰

2. *FKC Sues the Kahlo Family*

Four years later, Mattel’s Kahlo Barbie publicly pit FKC and Mara against one another.⁹¹ Despite Mara’s outcry, Mattel maintained that they worked closely with FKC to develop an authentic representation of Kahlo.⁹² As noted earlier, Mara pursued her grievance in Mexico claiming FKC exceeded their rights in licensing the use of Kahlo’s name without the family’s approval.⁹³ The Superior Court of Justice of Mexico City agreed and issued a temporary injunction to stop Mattel’s sales of the doll in Mexico.⁹⁴ Controlling the social media accounts under Kahlo’s name, Mara posted a letter addressed to the public, written in Spanish and English, stating that a decree was issued against FKC requiring them to refrain from using Kahlo’s brand, image, and work in any commercialization of products without the family’s consent.⁹⁵ In response,

⁸³ *Id.*

⁸⁴ *Id.*

⁸⁵ *Id.*

⁸⁶ *Rolling Over in Her Grave*, *supra* note 20. *See generally* Notice of Opposition at 51–62, Frida Kahlo Corp. v. Romeo Pinedo, No. 91254969 (T.T.A.B. 2020).

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ *See* Frida Kahlo Trademarks in Mexico, MARCARIA: TRADEMARK SEARCH, <https://trademark-search.marcaria.com/en> (press the “Mexico” box; then search for “Frida Kahlo”).

⁹⁰ *Rolling Over in Her Grave*, *supra* note 20. *See generally* FKC’s Complaint, *supra* note 71, at 5.

⁹¹ *Id.*

⁹² McDonell, *supra* note 11.

⁹³ *Id.*

⁹⁴ *See* Agencies in Mexico City, *Mexican Court Blocks Sales of Frida Kahlo Barbie Doll*, GUARDIAN (Apr. 20, 2018), <https://www.theguardian.com/artanddesign/2018/apr/20/frida-kahlo-barbie-doll-mexico-injunction>.

⁹⁵ *Id.* Sales in the United States were unaffected. *Rolling Over in Her Grave*, *supra* note 20.

⁹⁵ Mara Romeo (@FridaKahlo), TWITTER (Mar. 7, 2018, 8:39 PM), <https://twitter.com/FridaKahlo/status/971576198185783299>.

FKC brought suit against Mara.⁹⁶ FKC asserted a number of claims under the Lanham Act and commercial defamation.⁹⁷

During the litigation mentioned above, FKC initiated another lawsuit, this time against a Mexican corporation: VersaLicensing.⁹⁸ On July 16, 2019, VersaLicensing responded by filing a motion to dismiss the case.⁹⁹ In its motion, VersaLicensing stated that it received Mara's authorization to license the brand in Mexico, where Mara possess trademark registrations separate from FKC.¹⁰⁰ On January 17, 2020, both parties filed a stipulation of dismissal and the court dismissed the case three days later.¹⁰¹ Nonetheless, there is ongoing litigation between FKC and Mara in Mexico on the matter of who rightfully owns the trademarks there.¹⁰²

⁹⁶ See *Rolling Over in Her Grave*, *supra* note 20. See generally FKC's Complaint, *supra* note 72, at 1.

⁹⁷ See *Rolling Over in Her Grave*, *supra* note 20

(The Corporation asserted a number of claims including trademark infringement and unfair competition under the Lanham Act and commercial defamation. FKC claims it is the absolute owner of all trademark rights to the Frida Kahlo name in the U.S., EU, and Mexico . . . FKC maintains that the trademarks are valid because they are "distinctive" and "famous," and claims that Mara's use of the trademarks on the Frida Kahlo social media pages and website constitute infringement. FKC also claims Mara's public notices against FKC are slanderous and harmful to the brand, and constituted tortious interference with a business relationship, primarily FKC's relationship with Mattel.)

⁹⁸ *Rolling Over in Her Grave*, *supra* note 20

(The suit alleged contributory trademark infringement, false designation of origin, false advertisement, and unfair competition under the Lanham Act and common law. In this complaint, FKC alleges that Mara and Romeo, have together and under their company, "Familia Kahlo," "embarked on a campaign to misappropriate the rights" owned by FKC. As a part of that "campaign," FKC alleges, the Family 'engaged [VersaLicensing] to further their plan of undermining the legitimacy and validity of the FKC Trademarks.' FKC claims VersaLicensing, on its website and through promotional materials, purported to represent the trademark of Frida Kahlo's signed initials, 'FK,' a trademark which is registered to FKC in the U.S. The 'FK' brand has since been removed from VersaLicensing's website. As for relief, FKC again seeks compensatory damages in an amount greater than \$75,000, a declaration that FKC is the proper trademark holder, and injunctions against VersaLicensing's continued use of, or association with, the Frida Kahlo name and brand.)

(citations omitted). See generally Complaint, *Frida Kahlo Corp. v. VersaLicensing*, 1:19-cv-22258-MGC (S.D. Fla. Aug. 13, 2019).

⁹⁹ *Rolling Over in Her Grave*, *supra* note 20. Motion to Dismiss at 1, *Frida Kahlo Corp. v. VersaLicensing*, 1:19-cv-22258-MGC (S.D. Fla. Aug. 13, 2019).

¹⁰⁰ *Id.*

¹⁰¹ Stipulation of Dismissal at 1, *Frida Kahlo Corp. v. VersaLicensing*, 1:19-cv-22258-MGC (S.D. Fla. Aug. 13, 2019); Order of Dismissal at 1, *Frida Kahlo Corp. v. VersaLicensing*, 1:19-cv-22258-MGC (S.D. Fla. Aug. 13, 2019).

¹⁰² *Rolling Over in Her Grave*, *supra* note 20. See generally Motion to Dismiss, *supra* note 99, at 2.

3. *Artists Sue FKC*

The remaining cases involve two artists filing separate lawsuits against FKC. On June 5, 2019, folk-artist Nina Shope sued FKC.¹⁰³ Shope filed her suit after FKC sent a takedown notice of intellectual property infringement to Etsy, an online arts and crafts retailer, where Shope sells her artwork.¹⁰⁴ Shope handmakes a variety of embroideries and dolls, many of which represent Kahlo and are sold using Kahlo's name.¹⁰⁵ FKC submitted the notice against several of Shope's dolls, which resulted in automatic removal of her Kahlo listings.¹⁰⁶ Shope asserted that her creations did not constitute trademark infringement because her use of Kahlo's name was merely descriptive of the subject matter of her creations.¹⁰⁷ Furthermore, she argued the use of the name, Kahlo, in conjunction with the doll is not source-identifying.¹⁰⁸ In other words, because she used the name to identify a historical figure, consumers would not assume the dolls were associated with FKC. On March 5, 2020, Shope and FKC filed a joint motion to stay and vacate scheduling order to attempt to settle.¹⁰⁹ On April 1, 2020, Shope requested a dismissal of her complaint, which the court granted the next day.¹¹⁰ While FKC settled the case with Shope, the company currently faces similar legal challenges from another artist in court.

After FKC continually demanded takedown of her art on eBay, Etsy, Zazzle, and Redbubble, artist Cristine Melo sued FKC on August 29, 2019.¹¹¹ Melo has supported herself by selling her artwork on eBay since 2001, on Etsy since 2005, Zazzle since 2009, and Redbubble since 2015.¹¹² Melo claimed she had painted portraits of Kahlo years before FKC's formation and long before "Frida Kahlo" was trademarked.¹¹³ Seeking almost identical relief to Shope, Melo additionally sought an injunction, which she filed on February 18, 2020.¹¹⁴ As of April 5, 2021, the parties are attempting to work out the language of a settlement.¹¹⁵

¹⁰³ Shope's Complaint, *supra* note 17, at 1.

¹⁰⁴ *Rolling Over in Her Grave*, *supra* note 20. *See generally* Shope's Complaint, *supra* note 17, at 9.

¹⁰⁵ Shope's Complaint, *supra* note 17, at 5, 6.

¹⁰⁶ *Id.* at 9, 10.

¹⁰⁷ *Id.* at 11.

¹⁰⁸ *Id.* at 10, 11.

¹⁰⁹ *See* Shope v. Frida Kahlo Corporation, No. 1:19-cv-01614 (Colo. Dist. Ct. June 5, 2019) (LEXIS).

¹¹⁰ *See id.*; Rule 41 Dismissal at 1, Shope v. Frida Kahlo Corp., No. 1:19-cv-01614 -RBJ (Colo. Dist. Ct. Apr. 1, 2020). *See generally* Fed. R. Civ. P. 41.

¹¹¹ *See id.* at 3; Melo v. Frida Kahlo Corporation et al., No. 3:19-cv-05449 (N.D. Cal. Aug. 29, 2019) (LEXIS).

¹¹² Melo's Complaint, *supra* note 17, at 5.

¹¹³ Melo's Complaint, *supra* note 17, at 4.

¹¹⁴ *Compare* Melo's Complaint, *supra* note 17, at 41, *with* Shope's Complaint, *supra* note 17.

¹¹⁵ *See* Melo v. Frida Kahlo Corporation et al., No. 3:19-cv-05449 (N.D. Cal. Aug. 29, 2019) (LEXIS).

With an understanding of Kahlo's biography, her significance, and the resulting litigation, Part II introduces varying doctrines of local and international trademark law to examine what law impacts FKC, Mara, the artists, and Kahlo's trademarks.

II. A COMPARATIVE ANALYSIS OF TRADEMARK LAW

Of my face I like the eyebrows and eyes.

—Frida Kahlo¹¹⁶

Trademarks have existed in various capacities over the past millennia.¹¹⁷ For a deeper understanding of the arguments revolving Kahlo's trademarks, it is crucial to first understand what a trademark is. In its simplest form, a trademark is an "arbitrary or representative device attached to or sold with merchandise" with the purpose to help consumers identify the source of a product to distinguish similar and competing products.¹¹⁸ The Trade-Related Aspects of Intellectual Property Rights (TRIPS) defines a trademark as "any sign, or any combination of signs, capable of distinguishing goods or services of one undertaking from those of other undertakings[.]"¹¹⁹ Under the U.S. Lanham Act, a trademark is "any word, name, symbol, or device, or any combination[.]" used to identify and distinguish goods from those manufactured or sold by others.¹²⁰ Today, nearly anything capable of carrying meaning can serve as a trademark.¹²¹ In return, trademark law protects trademarks and their holders from unfair competition.¹²²

Part II undertakes Tanya Hernandez's¹²³ call to push CRT to focus on comparative law and contribute to the existing corpus of work that incorporates

¹¹⁶ Collins, *supra* note 1 (citations omitted).

¹¹⁷ See Gerald Ruston, *On the Origin of Trademarks*, 45 TRADEMARK REP. 127, 127 (1955) (tracing the historical origin of trademarks starting in 5000 B.C. through the 18th century). For an insightful history of trademarks, see Sidney A. Diamond, *The Historical Development of Trademarks*, 65 TRADEMARK REP. 265 (1975).

¹¹⁸ See *Davis v. Davis*, 27 F. 490, 491–92 (C.C.D. Mass. 1886). *But see* Case C-206/01, *Arsenal Football Club plc v. Reed*, 2002 E.T.M.R. 82 (Colomer, R.) (holding that the function of trademarks should not be limited to the indication of origin).

¹¹⁹ Agreement on Trade-Related Aspects of Intellectual Property Rights art. 15(1), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299 (1994) [hereinafter TRIPS Agreement].

¹²⁰ See 15 U.S.C. §§ 1051, 1127

¹²¹ See *Qualitex v. Jacobsen*, 514 U.S. 159, 162 (1998); TRIPS Agreement, *supra* note 119 (mandating protection for all types of signs provided they are capable of distinguishing).

¹²² See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 97 TRADEMARK REP. 1839, 1840 (2007).

¹²³ Professor Hernandez is the Archibald R. Murray Professor of Law at Fordham University School of

a comparative law component into CRT and the associated endeavor of applying CRT to non-U.S. legal jurisdictions.¹²⁴ In doing so, Part II offers an introductory survey of the harmonization between local and international trademark law. Section A addresses the difference between trademarks and other forms of intellectual property. Section A also explains the theoretical justifications behind trademarks and examples of attempts to harmonize trademark law amidst a global economy. With that foundation, Section B presents the trademark doctrines of the European Union, United States, and Mexico.

A. *Trademark Law's General Themes*

Although trademark law is often considered the broader intellectual property scheme, like patent and copyright law, trademark law is inherently different.¹²⁵ Generally, patent and copyright law are both incentive-based systems.¹²⁶ For example, an individual uses ingenuity to create a patentable or copyrightable item that benefits the rest of society and in return society rewards the individual a limited-duration monopoly to monetize that item.¹²⁷ In theory, the reward incentivizes the individual's ingenuity to create.¹²⁸ Therefore, patent and copyright laws encourage innovation as a whole.¹²⁹ Conversely, trademark law is not based on an incentive principle between society and an individual.¹³⁰ Rather, trademark law improves the quality of information in the marketplace, thereby reducing consumer search costs and ensuring competitors do not take producers' marks.¹³¹ Despite differences in trademark law jurisprudence, this

Law and the co-director of the Center on Race, Law & Justice where she is the head of global and comparative law programs and initiatives. See MULTIRACIALS AND CIVIL RIGHTS: MIXED RACE STORIES OF DISCRIMINATION, <https://multiracialsandcivilrights.wordpress.com/about>.

¹²⁴ Tanya K. Hernandez, *The Value of Intersectional Comparative Analysis to the Post-Racial Future of Critical Race Theory: A Brazil-U.S. Comparative Case Study*, 43 CONN. L. REV. 1407, 1410 (2011). For other work situated at the intersection of CRT and comparative law, see generally Francisco Valdes, *Foreword: Latino Ethnicities, Critical Race Theory, and Post-Identity Politics in Postmodern Legal Culture: From Practices to Possibilities*, 9 LA RAZA L.J. 1, 1–11 (1996); Enrique R. Carrasco, *Critical Race Theory and Development*, 91 AM. SOC'Y INT'L L. PROC. 427 (1997); Ruth Gordon, *Critical Race Theory and International Law: Convergence and Divergence: Racing American Foreign Policy*, 94 AM. SOC'Y INT' L. PROC. 260 (2000); Tanya K. Hernandez, *Comparative Judging of Civil Rights: A Transnational Critical Race Theory Approach*, 63 LA. L. REV. 875, 881–86 (2003).

¹²⁵ See Jeanne C. Fromer, *The Role of Creativity in Trademark Law*, 86 NOTRE DAME L. REV. 1885, 1886–87 (2011).

¹²⁶ *Id.* at 1893.

¹²⁷ *Id.* at 1894–95.

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ *But see id.* at 1887 (arguing that trademark law can encourage creativity without an incentive system).

¹³¹ *Id.*

purpose is generally shared around the world.¹³² This is not to say that all countries hold these definitions and their applicability to practice to the same degree.¹³³ There are two overarching common themes: territoriality and market protections.

Trademark protection is territorial, acquired and protected on a country-by-country basis.¹³⁴ Local trademark instruments and international trademark agreements recognize the territoriality of trademark law.¹³⁵ In fact, intellectual property regimes, in general, focus on rewarding local creators at the expense of foreigners.¹³⁶ The 1709 Statute of Anne—the first British copyright law—provides a great example of this bias considering the British parliament enacted the Statute of Anne for the benefit of domestic publishers.¹³⁷ Although countries have amended or drafted new laws over time, the guiding principle remains the territorial application of intellectual property rights.¹³⁸ Naturally, these principles also emerged in trademark law.

Despite all this, trademarks in modern legal regimes transcend their territoriality and have acquired a degree of internationalism.¹³⁹ As a result, the territorial nature of contemporary trademark law no longer confines a state to a specific territorial jurisdiction.¹⁴⁰ Recent examples include the trademark rights recognized under a pair of 2015 E.U. laws, which brought substantial changes to harmonize the national trademark systems of E.U. member states.¹⁴¹ These developments expanded the territorial nature of trademark law into an intricate mix of contemporary legal and universal characteristics, blurring the lines

¹³² See L.M. VanHoozer, *International Trademark Law*, 42 MISS. L.J. 178, 178 (1971) (stating the general functions of trademarks in an international arena).

¹³³ See Burkhardt Goebel, *Trademarks as Fundamental Rights - Europe*, 99 TRADEMARK REP. 931, 954 (2009) (tracing the concept of a trademark as a fundamental right, which is not the case in many countries).

¹³⁴ Graeme B. Dinwoodie, *Territorial Overlaps in Trademark Law: The Evolving European Model*, 92 NOTRE DAME L. REV. 1669, 1673–74 (2017).

¹³⁵ See *id.* at 1674 (“[TRIPS] . . . has not interfered with the purity of territoriality as a legal proposition.”)

¹³⁶ Marshall A. Leaffer, *The New World of International Trademark Law*, 2 MARQ. INTELL. PROP. L. REV. 1, 8 (1998).

¹³⁷ *Id.* See generally 8 Anne. C. 19 (1710).

¹³⁸ Dinwoodie, *supra* note 134, at 1673–74.

¹³⁹ Cf. P. Sean Morris, *From Territorial to Universal—The Extraterritoriality of Trademark Law and the Privatizing of International Law*, 37 CARDOZO ARTS & ENT. L.J. 33, 35 (2019) (“Intellectual property rights used to be territorial in nature, but in modern legal regimes, they have transcended their territoriality and appeared to have acquired internationalism.”).

¹⁴⁰ *Id.*

¹⁴¹ See Directive 2015/2436, of the European Parliament and of the Council of Dec. 16, 2015 to Approximate the Laws of the Member States Relating to Trade Marks, O.J. (L 336/1); Council Regulation 207/2009 of Feb. 22, 2009 on the Community Trade Mark, O.J. (L 78/1), as amended by Regulation (EU) 2015/2424, O.J. (L 341/21) (2015).

between private and public international law—for better and for worse.¹⁴² Because of their global scope, trademarks move with the goods they are affixed to, allowing them to cross borders into different localities.¹⁴³ Some have called this the globalization of trademark law.¹⁴⁴ Fueled by globalization and recent trademark law developments, some envisioned an inevitable progression toward a centralized, harmonized, unification of a “new world” of international trademark law.¹⁴⁵ Despite the harmonization of some jurisdictions like the European Union, the territorial nature of trademark law remains.¹⁴⁶ It is this territorial nature that prevented Mattel from selling the Kahlo Barbie in Mexico.

Generally, trademark law protects and benefits both producers and consumers in the market.¹⁴⁷ Historically, trademarks became legitimized through two historical uses.¹⁴⁸ First, merchants would affix marks on their goods so that they would be able to identify and retrieve their own goods after shipping.¹⁴⁹ Second, guilds would often require a regulatory production mark to be placed upon certain goods so that defective goods could be traced to their originator and such individuals could be punished.¹⁵⁰ Despite its history, trademark law has generally become more preoccupied with protecting producers’ investment in a mark to stimulate and enhance commercial activity and fair dealing.¹⁵¹ Trademarks may have developed to serve consumers by reducing search costs and allowing buyers to make rational purchasing decisions but now trademarks do even more.¹⁵² The products consumers buy are embedded with increasing intangible information that consumers largely do see—but feel.¹⁵³ In commercial environments, trademarks operate as a convenient symbolic “shorthand” that provides information or influences consumers in the

¹⁴² Morris, *supra* note 139, at 35. *But see* *McBee v. Delica Co., Ltd.*, 417 F.3d 107 (1st Cir. 2005), at 118–19 (“[T]he domestic effect of the international activities may be of lesser importance . . . [T]here is a risk that absent a certain degree of extraterritorial enforcement, violators will either take advantage of international coordination problems or hide in countries without efficacious antitrust or trademark laws . . .”).

¹⁴³ Morris, *supra* note 139, at 36.

¹⁴⁴ See Leaffer, *supra* note 136, at 2.

¹⁴⁵ *Id.*

¹⁴⁶ Dinwoodie, *supra* note 134, at 1674.

¹⁴⁷ Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2100 (2004).

¹⁴⁸ See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 814 (1927).

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

¹⁵¹ See McKenna, *supra* note 122, at 1849–50; see also Shahar J. Dilbary, *Famous Trademarks and the Rational Basis for Protecting “Irrational Beliefs”*, 14 GEO. MASON L. REV. 605, 605 (2007).

¹⁵² See William Landes & Richard Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269–70 (1987).

¹⁵³ *Id.*

most efficient manner.¹⁵⁴ For example, a Kate Spade satchel will convey a different affect on consumers compared to a near identical satchel from Chico's.¹⁵⁵ Likewise, Kahlo refrigerator magnets convey a different affect on consumers compared to fruit refrigerator magnets. The same applies to the countless items with Kahlo's name and face. These intangible and unobservable features account for even greater value in products.¹⁵⁶

Many scholars agree that trademarks have long transcended their basic role of identifying the source of products and have been transformed into an economic asset in their own right.¹⁵⁷ While a trademark's function was originally limited to guaranteeing its origin and ensuring the quality of products bearing the mark, over the years trademarks have transformed into tools of advertising and marketing.¹⁵⁸ This shift has continued with trademark law moving away from protecting consumer interests and toward protecting producers' property interests.¹⁵⁹ Similarly, trademark law has shifted to treat trademarks as property.¹⁶⁰ For example, many famous marks have acquired an independent commercial status that is distinct from the respective goods or services that they cover.¹⁶¹ Accordingly, producers need speed, certainty, and efficiency in seeking and maintaining their rights across international jurisdictions. The push for these safeguards became the motivating factor behind international attempts to harmonize jurisdictions with international solutions.¹⁶² For example, the Paris Convention puts geographical indicators in the context of protecting unfair

¹⁵⁴ *Id.* at 269.

¹⁵⁵ *Compare Margaux Large Satchel*, KATE SPADE, <https://www.katespade.com/products/margaux-large-satchel/098687313230.html?cgid=ks-handbags-view-all> (last visited Mar. 2, 2021), with *Black Aurora Satchel*, CHICO'S, <https://www.chicos.com/store/product/pixie+mood+black+aurora+satchel/570292936?color=001&catId=cat40029> (last visited Mar. 2, 2021).

¹⁵⁶ See Landes & Posner, *supra* note 152, at 266. How Latinx and other racialized consumers maneuver their social values and ideologies through purchasing Kahlo products lies outside of this comment's legal inquiry. Cf. RACHEL V. GONZÁLEZ, QUINCEAÑERA STYLE: SOCIAL BELONGING AND LATINX CONSUMER IDENTITIES 4 (2019) (examining this through Quinceañeras).

¹⁵⁷ McKenna, *supra* note 122, at 1906 ("These types of cases treat a trademark itself as the exclusive property of a mark owner.").

¹⁵⁸ See Mark Bartholomew, *Advertising and the Transformation of Trademark Law*, 38 N.M. L. REV. 1 (2008) (detailing the transformation of trademark law).

¹⁵⁹ Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1693–94 (1999); see Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 371–72 (1999); see also McKenna, *supra* note 122, at 1873–74.

¹⁶⁰ See generally Adam Mossoff, *Trademark as a Property Right*, 107 KY. L.J. 1 (2018) (explaining that trademarks have moved away from their origin and now resemble independent property rights like a fee simple in land or title in a patent).

¹⁶¹ See Steven M. Cordero, *Cocaine-Cola, the Velvet Elvis, and Anti-Barbie: Defending the Trademark and Publicity Rights to Cultural Icons*, 8 FORDHAM INTEL. PROP. MEDIA & ENT. L.J. 599 (1998).

¹⁶² See Katherine Beckman & Christa Pletcher, *Expanding Global Trademark Regulation*, 10 WAKE FOREST INTEL. PROP. L.J. 215 (2010).

competition among marks, and it implies that it will not recognize a geographical indication if it creates the likelihood of deception or confusion.¹⁶³

A U.S. case offers a stark reminder about the limits of international law even when countries are party to international conventions, such as the Paris Convention.¹⁶⁴ In *Vanity Fair Mills v. T. Eaton Co.*, the court explained that the Paris Convention protected a U.S. trademark owner, the plaintiff, against unfair competition and trademark infringement in Canada under Canadian law and in the United States under U.S. law.¹⁶⁵ The Paris Convention did not create a private right under local law for acts of unfair competition occurring in foreign countries.¹⁶⁶ There are other circumstances in which a nation has the power to handle issues that can be international in nature, but the national courts are often the main port of call at which state treaty obligations are interpreted through the use of domestic legislation.¹⁶⁷

Despite this lack of harmonization, the formation of the World Trade Organization (WTO) and TRIPS in 1994 expanded trademark regulation.¹⁶⁸ TRIPS serves as a guideline for trademark use and recognition by the 164 current WTO members.¹⁶⁹ To date, this is considered the most comprehensive and sweeping regulation of trademarks, reaching all corners of the globe.¹⁷⁰ TRIPS establishes a set of rules that Member States must transpose into their domestic intellectual property law systems.¹⁷¹ The TRIPS agreement was administered and created to set basic standards for various parts of intellectual property regulations.¹⁷² Essentially, the WTO deals with rules of trade between Member States at a global or *near-global* level.¹⁷³ It helps trade flow as freely as possible,

¹⁶³ Deborah J. Kemp & Lynn M. Forsythe, *Trademarks and Geographical Indications: A Case of California Champagne*, 10 CHAP. L. REV. 272, 273 (2006).

¹⁶⁴ *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633 (2d Cir. 1956).

¹⁶⁵ *Id.* at 640–41.

¹⁶⁶ *Id.* at 640.

¹⁶⁷ See Antonios Tzanakopoulos, *Domestic Courts in International Law: The International Judicial Function of National Courts*, 34 LOY. L.A. INT'L & COMP. L. REV. 133, 151 (2011). See generally ANDRE NOLLKAEMPER, NATIONAL COURTS AND THE INTERNATIONAL RULE OF LAW (2011) (exploring how domestic courts contribute to the maintenance of the rule of international law by providing judicial control over the exercises of public powers that may conflict with international law).

¹⁶⁸ See TRIPS Agreement, *supra* note 119.

¹⁶⁹ *Members and Observers*, WORLD TRADE ORGANIZATION: UNDERSTANDING THE WTO, https://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm.

¹⁷⁰ Beckman & Pletcher, *supra* note 162.

¹⁷¹ See TRIPS Agreement, *supra* note 119.

¹⁷² *Enforcement and Protection*, WORLD TRADE ORGANIZATION: UNDERSTANDING THE WTO, https://www.wto.org/english/thewto_e/whatis_e/tif_e/agrm7_e.htm.

¹⁷³ *What is the World Trade Organization?*, WORLD TRADE ORGANIZATION: UNDERSTANDING THE WTO, https://www.wto.org/english/thewto_e/whatis_e/tif_e/fact1_e.htm.

which is vital for a nation's economic development and well-being.¹⁷⁴ Accordingly, the WTO is obligated to “remov[e] obstacles” and “ensur[e] that individuals, companies and governments know what the trade rules are around the world, and giv[e] them the confidence that there will be no sudden changes of policy.”¹⁷⁵ The purpose of the TRIPS agreement is to limit the number of hindrances and confusion regarding international trade while promoting proper protection to trademarks and intellectual property rights as a whole.¹⁷⁶ Additionally, TRIPS serves to recognize and acknowledge underlying public policy objectives of various national systems for the purposes of intellectual property protection.¹⁷⁷

Despite the harmonization of trademark law's policy objectives, global trade—especially the online marketplace—has highlighted the growing gap between the market's global reach and trademark law's restricted national scope.¹⁷⁸ While trademark law's de facto territorial nature has not hindered developments of international harmonization and cohesion, gaps remain.¹⁷⁹ Kahlo's trademarks reside in these gaps between local law and international commerce. Despite their inherent limitations, these international doctrines highlight a general consensus to accept patterns of consistency in trademark law. A fitting example highlighting the harmonization of trademark law policies include the concepts of functionality and distinctiveness.

B. Functionality and Distinctiveness in the European Union, the United States, and Mexico

The concepts of functionality and distinctiveness are integral to trademark law and derive from the general shared themes of trademark law around the world. While there are numerous similarities and differences in the application of trademark laws in the European Union, United States, and Mexico, the focus on functionality and distinctiveness is purposeful. Trademark law in these jurisdictions all recognize functionality and distinctiveness as either refusals for a mark's registration or challenges to a mark's validity, and utilize these concepts in determining whether to cancel a mark. Understanding these concepts is crucial to examine one example of what trademark examiners are tasked with

¹⁷⁴ *See id.*

¹⁷⁵ *Id.*

¹⁷⁶ *See* TRIPS Agreement, *supra* note 119.

¹⁷⁷ *Id.*

¹⁷⁸ *See* Morris, *supra* note 139, at 53.

¹⁷⁹ *Id.*

in their roles as gatekeepers.¹⁸⁰ Accordingly, this Section briefly discusses the respective trademark jurisprudence of the European Union, United States, and Mexico.

1. *European Union Trademark Law*¹⁸¹

In the member states of the European Union, national trademark law and E.U. trademark law co-exist.¹⁸² Each E.U. member state has its own national trademark law, such as the German Trademarks Act, *Markengesetz* (MarkenG), the U.K. Trade Marks Act 1994, or France's *Code de la Propriété Intellectuelle* (CPI).¹⁸³ The 2015 legislative changes to E.U.'s trademark law harmonized the European Union by approximating, supplementing, or replacing the domestic trademark law of each individual E.U. member state regarding secondary liability for trademark infringement.¹⁸⁴ In order to ensure a uniform application of the Directive, and in accordance with Article 267 of the Treaty on the Functioning of the European Union, any domestic court of an E.U. member state that needs to interpret a provision in national trademark law that is based on the new legislation may request the European Union's Court of Justice (E.C.J.) to give a ruling.¹⁸⁵ Nevertheless, even with a legal framework primed for harmonization, limitations still arise.¹⁸⁶

¹⁸⁰ *Infra* Part III.B.

¹⁸¹ For an in-depth examination of the meaning and policies underlying the settled E.U. approach to analyzing inherent distinctiveness claims for product trade dress marks, see Dr. César J Ramírez-Montes, *The Elusive Distinctiveness of Trade Dress in EU Trademark Law*, 34 EMORY INT'L L. REV. 277 (2020).

¹⁸² *Internal Market, Industry, Entrepreneurship and SMEs*, EUROPEAN COMMISSION: TRADE MARK PROTECTION IN THE EU, https://ec.europa.eu/growth/industry/policy/intellectual-property/trade-mark-protection_en.

¹⁸³ *See* Gesetz über den Schutz von Marken und sonstigen Kennzeichen [Markengesetz] [German Trade Mark Act], Oct. 25, 1994, BUNDESGESETZBLATT, Teil I [BGBl I] at 3082 (Ger.), <http://www.gesetze-im-internet.de/markeng/>; Trade Marks Act, 1994, c. 26 (U.K.); CODE DE LA PROPRIÉTÉ INTELLECTUELLE [C. PRO. INTELL.] art. L711-17, R712-18 (Fr.), <http://www.legifrance.gouv.fr/affichCode.do?cidTexte=LEGITEXT000006069414&dateTexte=20100814>.

¹⁸⁴ Council Regulation 2017/1001, arts. 4, 7(1) O.J. (L 154) 1 [hereinafter EUTMR] (defining E.U. trademark and absolute grounds for refusal); Council Directive 2015/2436, arts. 3, 4(1) O.J. (L 336) 1 [hereinafter TMD].

¹⁸⁵ *See* Consolidated Version of the Treaty on the Functioning of the European Union art. 288, May 9, 2008, 2008 O.J. (C 115) 47 [hereinafter TFEU].

¹⁸⁶ For example, some of the E.U. eBay court decisions refer to both national and Community Trade Marks, others to national trademarks only ignoring the E.U. legislation. *See, e.g.*, Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 19, 2007, 172 ENTSCHIEDUNGEN DES BUNDESGERICHTSHOFES IN ZIVILSACHEN [BGHZ] 119 (Ger.) (Internet-Versteigerung II); L'Oréal SA v. eBay Int'l AG, [2009] EWHC 1094 (Ch) (Eng.); Tribunal de grande instance [TGI] [Ordinary Court of Original Jurisdiction] Troyes, ch. civ., June 4, 2008, no. 06/02604 (Fr.); Cour d'appel [CA] [Regional Court of Appeal] Reims, ch. civ., July 20, 2010, no. 08/01519 (Fr.).

The legislative changes did not have any direct effect; rather, they needed members to transpose the changes into their respective national law by the legislature of each individual E.U. member state.¹⁸⁷ Therefore, trademark law in E.U. member states is not identical, but based on a uniform minimum standard as set down by the 2015 legislation.¹⁸⁸ Nevertheless, the E.C.J. decisions in *Leur-Bloem v. Inspecteur* and *Giloy v. Hauptzollamt* held that national trademark laws must be interpreted in accordance with the Trade Marks Directive and the economic and political goals it sets forth.¹⁸⁹ A mark's registration is valid under E.U. law if it can enable consumers to distinguish branded goods from others of different origin, in other words distinctiveness, and is nonfunctional.¹⁹⁰ These criteria support the general policies that undergird trademarks.

2. *United States Trademark Law*

Unlike U.S. patent and copyright law, trademark law does not have a specific constitutional basis for protection in the United States.¹⁹¹ The Constitution grants Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries[.]”¹⁹² In the seminal *Trade-Mark Cases*, the U.S. Supreme Court held that trademarks do not fall under this clause's umbrella.¹⁹³ Instead, trademarks derive their status as protectable intellectual property from common law and the Lanham Act.¹⁹⁴ The Supreme Court explicitly distinguished trademarks from patents and copyrights explaining that trademarks have no necessary relation to invention or discovery and instead a trademark generally adopts “something already in existence as the distinctive symbol of the party using it.”¹⁹⁵ Since then, trademarks held a different status than other intellectual property by becoming useful and valuable aids or instruments of commerce.¹⁹⁶

¹⁸⁷ See TFEU, *supra* note 185.

¹⁸⁸ See Verena von Bomhard & Artur Geier, *Unregistered Trademarks in EU Trademark Law*, 107 TRADEMARK REP. 677, 679–80 (2017). See generally Annette Kur, *The EU Trademark Reform Package—(Too) Bold a Step Ahead or Back to Status Quo*, 19 MARQ. INTELL. PROP. L. REV. 15 (2015) (detailing the 2015 trademark legislation).

¹⁸⁹ Case C-28/95, *A. Leur-Bloem v Inspecteur der Belastingdienst/Ondernemingen Amsterdam 2*, 1997 E.C.R. I-4161; 96 Case C-130/95, *Bernd Giloy v Hauptzollamt Frankfurt am Main-Ost*, 1997 E.C.R. I-4291.

¹⁹⁰ See EUTMR, *supra* note 184; TMD, *supra* note 184.

¹⁹¹ See *In re Trade-Mark Cases*, 100 U.S. 82, 93–94 (1879).

¹⁹² U.S. CONST. art. I, § 8, cl. 8.

¹⁹³ See *In re Trade-Mark Cases*, 100 U.S. at 93–94.

¹⁹⁴ 15 U.S.C. § 1051 (2013).

¹⁹⁵ *In re Trade-Mark Cases*, 100 U.S. at 94.

¹⁹⁶ *Id.* at 95.

U.S. trademark law is vast with a robust doctrine of both judicial and administrative decisions. However, distinctiveness and functionality are two grounds which a U.S. court or the Trademark Trial and Appeal Board (TTAB) may decide to cancel FKC's Kahlo's marks. Indeed, a trademark may be cancelled if it becomes the generic name for less than all of the goods or services, or a portion thereof, for which it is registered.¹⁹⁷ What this means in practice is that whether a trademark is generic is determined by a spectrum of distinctiveness based on the relationship between the mark and the goods or services in connection with which the mark used.¹⁹⁸ As a result, a trademark is considered generic if it describes a quality or characteristic of the good or service or it is the common name of the good or service.

Furthermore, 15 U.S.C. § 1064(3) provides that a trademark may be cancelled at any time if it is functional.¹⁹⁹ The specifics of what makes a trademark functional varies. Courts recognize two types of functionality as grounds for denying trade dress protection to product design features: traditional or utilitarian functionality, and aesthetic functionality.²⁰⁰ First, a product feature is considered to be "functional" in a utilitarian sense if it is either essential to the use or purpose of the article, or if it affects the cost or quality of the article.²⁰¹ Conversely, when the aesthetic design of a product is itself the mark for which protection is sought, courts will deem the mark aesthetically functional, and therefore ineligible for protection under the Lanham Act—if protection of the mark significantly undermines competitors' ability to compete in the relevant market.²⁰²

3. *Mexican Trademark Law*

After years of using the TRIPS agreements' trademark definition, currently, Mexican industrial property law defines a trademark as any sign that is perceptible to the senses and which can be displayed in a manner that clearly and precisely allows the protected subject matter to be identified and distinguishes products or services from others of the same type or category in

¹⁹⁷ 15 U.S.C. § 1064(3).

¹⁹⁸ *See generally* Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9–11 (2d Cir. 1976) (describing the famous spectrum of marks as arbitrary/fanciful, suggestive, descriptive with secondary meaning, descriptive, and generic).

¹⁹⁹ *See* Qualitex Co. v. Jacobson Prod. Co., 514 U.S. 159, 165 (1995) (explaining that aspects of a product that are functional generally cannot serve as a trademark).

²⁰⁰ Christian Louboutin v. Yves Saint Laurent America, 696 F.3d 206, 219 (2012).

²⁰¹ Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 850 n.10 (1982).

²⁰² Christian Louboutin, 696 F.3d, at 219–20, 222.

the market.²⁰³ Considering Mexico's largest trade partner is the United States, Mexico has harmonized its laws to parallel its next-door neighbor. Unlike the United States, however, where different legal doctrines developed to address different forms of intellectual property, Mexican industrial property law governs all intellectual property, including trademarks.²⁰⁴ Accordingly, the development of Mexican trademark law directly derives from Mexico's patent law.²⁰⁵

The first law to govern intellectual property in Mexico was a decree issued by the Spanish Courts on October 2, 1820, to ensure the right of ownership to parties who invent, perfect, or introduce any branch of industry.²⁰⁶ In 1991 Mexico enacted the Mexican industrial property law that still governs today increasing the duration to ten years.²⁰⁷ Since then, Mexican trademark law has seen major developments, first driven by the enactment of the North American Free Trade Agreement in 1994 and then the pressure to harmonize its laws with its major trade partners, namely the United States.²⁰⁸ The most notable development was the establishment of Mexico's first formal trademark opposition system in 2015.²⁰⁹

Under Mexican industrial property law, determination regarding a mark's functionality and distinctiveness are among the grounds to refuse a mark's registration or subsequently cancel a mark.²¹⁰ Accordingly, an examiner will reject a mark if it is the technical or commonly used name of a product or services or if the word has turned into the usual or generic designation of said products or services in everyday language or business practice.²¹¹ Likewise, descriptive or indicative words that serve to identify the kind, quality, quantity, composition, purpose, value, or place of origin of the products or the time of their production are also unregistrable.²¹²

The concepts of distinctiveness and functionality in the European Union, United States, and Mexico exemplify the harmonization of international trademark law through the general acceptance of underlying policies behind trademarks. Based on the U.S. lawsuits, the potential arguments regarding the

²⁰³ Mexican Industrial Property Law, *supra* note 73, art. 88.

²⁰⁴ *See generally id.*

²⁰⁵ *See generally id.*

²⁰⁶ MARÍA NARVÁEZ TIJERINA, EL SISTEMA MEXICANO DE PROPIEDAD INDUSTRIAL 21 (2010).

²⁰⁷ Mexican Industrial Property Law, *supra* note 73, art. 95.

²⁰⁸ TIJERINA, *supra* note 207, at 35; John M. Murphy, *The New Trademark Opposition System in Mexico*, 107 TRADEMARK REP. 746, 749 (2017).

²⁰⁹ *See generally* Murphy, *supra* note 209, at 747.

²¹⁰ *See* Mexican Industrial Property Law, *supra* note 73, art. 90.

²¹¹ *Id.*

²¹² Mexican Industrial Property Law, *supra* note 73, art. 90.

functionality and distinctiveness of Kahlo's trademarks are obvious. Challengers will argue that the Kahlo trademarks are functional and generic in seeking their cancellation.²¹³ Conversely, FKC will argue that the Kahlo trademarks are nonfunctional and distinctive.²¹⁴ The brief survey of the trademark jurisdictions above is to emphasize that the trademark framework that disadvantages marginalized populations is not unique to the United States. While U.S. courts have not decided one way or another, the focus of inquiry for this Comment is not whether subsequent litigation in other jurisdictions could result in the cancellation of Kahlo's trademark. Instead, this analysis proceeds by utilizing CRT to challenge the normative and dominant understanding of the function of law governing Kahlo's trademarks.

III. FREEING KAHLO: APPLYING CRITICAL RACE INTELLECTUAL PROPERTY TO KAHLO'S TRADEMARKS

Freeing yourself was one thing; claiming ownership of that freed self was another.

—Toni Morrison²¹⁵

Before evaluating the racial landscape of trademark law around the world, it is important to first position trademark law historically and to supply a framework of its critique. Section A explores the blatant racism trademark law permitted and exacerbated globally. Section B then provides the central tenets and queries of a CRT and Critical Race IP analysis, while Section C explains the practical function of said analysis. Finally, Section D offers a Critical Race IP analysis of Kahlo's trademarks to examine aspects of local and international trademark law.

A. *The Racist History of Trademarks around the World*

Trademark law has essentially legalized and promulgated the use of racist representations of Black people and other marginalized racial and ethnic minorities.²¹⁶ Consequently, trademarks have a long history of stigmatizing people of color, especially Black people, and reinforcing racist tropes around the globe due to globalization.²¹⁷ For example, in the United States, notable

²¹³ The artists made this argument. See Shope's Complaint, *supra* note 17, at 12–13.

²¹⁴ FKC made this argument. See FKC's Complaint, *supra* note 72.

²¹⁵ TONI MORRISON, BELOVED 111–12 (1987).

²¹⁶ See K.J. Greene, *Intellectual Property at the Intersection of Race and Gender: Lady Sings the Blues*, 16 J. GENDER, SOC. POL'Y & L. 365, 375 (2008) [hereinafter Greene, *Lady Sings the Blues*].

²¹⁷ *Id.*

racist trademarks include Uncle Ben, Aunt Jemima, and countless indigenous symbols.²¹⁸ In fact, U.S. trademarks are notably full of “slave-rooted” images of Black people.²¹⁹ But the United States is not alone—trademarks are racist everywhere. *Sarotti*, a German chocolate brand, used variations of tray-carrying Black people until 2004.²²⁰ Similarly, Mexican food conglomerate Grupo Bimbo spent decades using racist caricatures of Black people as the trademark of its chocolate pastry, *Negrito*.²²¹ Grupo Bimbo eventually replaced the Black caricature on its products with a new trademark depicting a racially ambiguous boy with a massive afro haircut.²²² *Negrito* commercials showed a boy eating the pastry as it transformed his hair into a large afro.²²³ While Grupo Bimbo finally renamed the pastry *Nito* in 2013, it kept the afro haircut trademark.²²⁴ Similarly, *Banania*, a popular breakfast brand in France, still uses a smiling Senegalese man wearing a fez as its trademark.²²⁵ While the trademark moved away from its 1915 drawing of a realistic person, now depicting a colorful cartoon, it unmistakably remains a caricature of a Black man.²²⁶ As globalization increases, the impact of these trademarks are not bound by a country’s borders.

Marketing and advertising severely affect consumers by making trademarks a predominant source of information in the market which ultimately pours over to inform consumers’ general perceptions and understandings of the world.²²⁷ For example, Grupo Bimbo sold *Negritos* and its racist trademark in supermarkets across North and South America.²²⁸ Anti-Black racism existed in North American and South American countries long before *Negritos* decked supermarket shelves.²²⁹ While *Banania* may not share the same popularity in

²¹⁸ See MALTE HINRICHSEN, RACIST TRADEMARKS 82 (2012); see also *Lady Sings the Blues*, *supra* note 217, at 375.

²¹⁹ Greene, *Lady Sings the Blues*, *supra* note 216, at 376.

²²⁰ HINRICHSEN, *supra* note 218, at 83.

²²¹ SirNoodlehe, *Up Until 2013, Negrito Was a Popular Snack in Mexico*, REDDIT: ACCIDENTAL RACISM (2018), https://www.reddit.com/r/AccidentalRacism/comments/690llt/up_until_2013_negrito_was_a_popular_snack_in.

²²² See *Snack I Saw in Mexico a While Ago. Negrito by Bimbo!*, IMGUR (May 22, 2015), <https://imgur.com/NaYDkn7>.

²²³ *Id.*; see also *BIMBO Nito ‘Trasforma cualquier momento’ (2018)*, YOUTUBE (Sept. 8, 2018) <https://www.youtube.com/watch?v=Ji4U9LvZHgk>; *BIMBO NEGRITO.mp4*, YOUTUBE (June 23, 2010), <https://www.youtube.com/watch?v=0ukeXj062xc>.

²²⁴ SirNoodlehe, *supra* note 221; see *BIMBO Nito ‘Trasforma cualquier momento’*, *supra* note 223; *BIMBO NEGRITO.mp4*, *supra* note 223.

²²⁵ HINRICHSEN, *supra* note 218, at 83–85.

²²⁶ *Id.*

²²⁷ Greene, *Lady Sings the Blues*, *supra* note 216, at 374–75.

²²⁸ GRUPO BIMBO: OUR HISTORY, <https://www.grupobimbo.com/en/ourhistory>.

²²⁹ See generally, e.g., Tanya K. Hernandez, *Colorism and the Law in Latin America - Global Perspectives on Colorism Conference Remarks*, 14 WASH. UNIV. GLOB. STUD. L. REV. 683 (2015) (describing the racism in

major supermarkets outside of France, it remains an Amazon order away from any consumer with internet access.²³⁰ As such, trademarks with caricatures of Black people dehumanize Black bodies and do little to expand perceptions of Black people in localities with limited representations of Black people.²³¹ As a result, trademark laws do more than protect consumers and producers—they directly impact that enters the public’s consciousness.

Despite its underlying purpose to help and protect consumers, trademark law around the world resembles tenets of property law more than intellectual property because of the ability to maintain a trademark permanently.²³² As such, FKC’s ownership and use of Kahlo trademarks jeopardizes her legacy, life, and work as another marketable caricature. Owing to its expressive and economic dimension, the Kahlo trademark embodies trademarks’ ability to inhabit a multiplicity of meanings. As a result, Kahlo’s trademark operates a device of owned property, expression, and culture.²³³ The tension between these facets produces a nearly irreconcilable incompatibility between the marketplaces of goods and of ideas. Taking a look at the Aunt Jemima trademark offers insight into the implications of local and international trademark law.

The invention of the “Aunt Jemima” trademark cemented a growing trend in advertising to trademark depictions of racial and ethnic minorities to sell goods and services.²³⁴ Trademarks based on Black people perceived racial minorities not as consumers or citizens to be marketed to, but as a set of images and tools in a company’s brand.²³⁵ As a result, trademark law around the world transformed people of color from a racial subject, a person, to a racial object, a trademark—a piece of intellectual property.²³⁶ Like Aunt Jemima, trademark law is dominated by a profound conflict between economic value and social meaning.²³⁷ The AUNT JEMIMA trademark highlights how trademarks are

Latin America).

²³⁰ See *Banania Chocolate Powder from France 400 grams*, AMAZON, <https://www.amazon.com/Banania-Chocolate-Breakfast-France-14-1oz/dp/B0041Y4XE0> (last visited Mar. 2, 2021).

²³¹ See Greene, *Lady Sings the Blues*, *supra* note 216, at 376–77.

²³² Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601, 1612 (2010). See generally, e.g., Lemley, *supra* note 159, at 1688 (explaining that courts protect marks “as things valuable in and of themselves, rather than for the product goodwill they embody”); Lunney, Jr., *supra* note 159, at 371 (“[T]he expansion [of trademark law since the mid-1950s] has focused on a trademark’s value not merely as a device for conveying otherwise indiscernible information concerning a product (‘deception-based trademark’), but as a valuable product in itself (‘property-based trademark’).”).

²³³ See Katyal, *supra* note 232, at 1606.

²³⁴ *Id.* at 1610.

²³⁵ *Id.* at 1610–11.

²³⁶ See *id.*

²³⁷ *Id.* at 1611.

commodities in one sense and expressions in another to both the mark holder that owns them and to the public that perceives them.²³⁸ As such, the law inherits the responsibility of navigating a trademark's potential contradiction between its status as corporate property and as cultural icon.²³⁹ Because trademark law focuses only on how marks communicate information about a certain product or corporation within the marketplace of goods, it largely underestimates the more complex role that trademarks play within society.²⁴⁰ Assuming trademark law is colorblind only exacerbates the problem further.

Colorblind optics suggests that the long history of racist trademarks has more to do with the zeitgeist and little to do with trademark law. After all, unlike other areas of law that blatantly disadvantage marginalized communities, trademark law does not come to mind as an area of law ripe for reform. However, applying CRT, and Critical Race IP more specifically, to trademark law reveals something different: trademark systems around the world cultivate inequity. Kahlo, an anti-capitalist, queer, Mexican woman, is trademark law's next casualty.

B. An Overview of CRT and an Introduction to Critical Race Intellectual Property

Developed in the 1980s and heavily influenced by Black women, CRT has primarily dedicated itself to anti-racist and anti-sexist struggles.²⁴¹ CRT was the result of scholars of color who wanted to critique and to explore the relationships between law, race, racism, and social power in ways that existing fields, such as Critical Legal Studies or the liberal civil rights tradition, could not or had not.²⁴² Since then, CRT scholars continuously expound core tenets of CRT: that race is a social construction and a performative identity; that racism is endemic and institutionalized in society; that social and historical context is very important in any particular analysis of racial issues, and; to develop potential solutions to the societal problems it creates.²⁴³ Of course, any one-sentence description of the origins of a movement as complex and as diverse as CRT is necessarily incomplete.²⁴⁴

²³⁸ *Id.* at 1612.

²³⁹ *Id.*

²⁴⁰ *Id.*

²⁴¹ See CRITICAL RACE THEORY, *supra* note 22, at xi, xiii, xvi; see also DOROTHY A. BROWN, CRITICAL RACE THEORY: CASES, MATERIALS, AND PROBLEMS (2003) (examining first-year case law through CRT).

²⁴² CRITICAL RACE THEORY, *supra* note 22, at xi, xiii.

²⁴³ See Devon W. Carbado, *Critical What What?*, 43 CONN. L. REV. 1593, 1607–15 (2011) (giving an overview of these ideas and how they play an important role in defining the “whatness” of CRT scholarship).

²⁴⁴ See, e.g., Kimberlé W. Crenshaw, *Twenty Years of Critical Race Theory: Looking Back to Move Forward*, 43 CONN. L. REV. 1253 (2011).

Consequently, there is no single answer for what CRT is. In fact, most CRT scholars eschew the notion of a fully unified school of thought.²⁴⁵ In doing so, general tenets of CRT are built on addressing how race is socially constructed and how law itself constructs race and produces racial meaning.²⁴⁶ CRT challenges the substance of legal scholarship by recognizing that racism is engrained in the fabric and system of existing power structures.²⁴⁷ CRT is committed to confronting “the historical centrality and complicity of law in upholding white supremacy (and concomitant hierarchies of gender, class, and sexual orientation)” and transforming the relationship between law and white supremacy to reshape U.S. jurisprudence in a project of racial emancipation and anti-subordination.²⁴⁸ In doing so, CRT demonstrates a commitment to radical critique of the law and radical emancipation by the law.²⁴⁹ Aiming to develop a jurisprudence that accounts for the role of racism in the law, CRT works toward the elimination of racism as part of a larger goal of eliminating all forms of subordination.²⁵⁰

To think about how law itself constructs race, CRT acknowledges the way legal systems, despite their ideal notional neutrality, are structurally designed to keep insiders in power—a design that typically works to disadvantage outsiders such as people of color, women, sexual minorities, and the poor.²⁵¹ What this means is that even “color-blind” laws often serve to further insider privileges along the lines of race, gender, and class while marginalizing and obscuring social, political, and economic inequality.²⁵² CRT insists on “the need to account for multiple grounds of identity when considering how the social world is constructed”—especially when law is involved.²⁵³ Accordingly, because racial

²⁴⁵ See CRITICAL RACE THEORY, *supra* note 22, at xiii (“[T]here is no canonical set of doctrines or methodologies to which [CRT scholars] all subscribe.”).

²⁴⁶ See Calmore, *supra* note 25, at 2160 (“[CRT] begins with a recognition that ‘race’ is not a fixed term. Instead, ‘race’ is a fluctuating, decentered complex of social meanings that are formed and transformed under the constant pressures of political struggle.”).

²⁴⁷ CRITICAL RACE THEORY, *supra* note 22, at 314.

²⁴⁸ *Id.* at xi, xiii (observing that the goal of CRT is “not merely to understand the vexed bond between law and racial power but to *change* it[.]”).

²⁴⁹ Derrick A. Bell, *Who’s Afraid of Critical Race Theory?*, 1995 UNIV. ILL. L. REV. 893, 899.

²⁵⁰ Mari J. Matsuda, *Voices of America: Accent, Antidiscrimination Law, and Jurisprudence for the Last Reconstruction*, 100 YALE L.J. 1329, 1331 n.7 (1991).

²⁵¹ See Alan D. Freeman, *Legitimizing Racial Discrimination Through Antidiscrimination Law: A Critical Review of Supreme Court Doctrine*, 62 MINN. L. REV. 1049, 1054, 1069, 1105 (1978) (demonstrating how the Court’s privileging of the perpetrator perspective at the expense of the victim perspective entrenches inequality); see also Mario L. Barnes, “*The More Things Change . . .*”: *New Moves for Legitimizing Racial Discrimination in a “Post-Race” World*, 100 MINN. L. REV. 2043, 2067 (2016) (extending Freeman’s analysis to argue that the Court is now in an “Era of Incredulity” when it comes to claims from outsiders challenging insiders).

²⁵² See generally CRITICAL RACE THEORY, *supra* note 22.

²⁵³ Kimberlé W. Crenshaw, *Mapping the Margins: Intersectionality, Identity Politics, and Violence*

privilege and racial subordination are often elided in the law, much of CRT involves making race visible with an analysis that is critical and particularly attuned to the frequencies and registers of race.²⁵⁴

Beyond these broad concerns, a review of the CRT's key writings reveals several recurring themes. First, CRT is committed to the development of counter-accounts of social reality by subversive and subaltern elements of the reigning order.²⁵⁵ To this end, CRT contests the very language of traditional legal and social analysis by rejecting the preference for neutral, disengaged, unraced, and unsexed voices in legal scholarship.²⁵⁶ Instead, CRT supports the incorporation of personal narrative, or what is often referred to as *legal storytelling*, to critique and assess law's master narratives.²⁵⁷ This embrace of outsider voices and narrative is so fundamental that CRT has been called "voice scholarship."²⁵⁸ Second, CRT maintains that true change is possible only through radical interventions.²⁵⁹ This perspective also considers a popular idea that legal reforms that ostensibly benefit minorities only occur when the reforms also advance the interests of the white majority.²⁶⁰

Against Women of Color, 43 STAN. L. REV. 1241, 1245 (1991); see also Regina Austin, "The Black Community," *Its Lawbreakers, and a Politics of Identification*, 65 S. CAL. L. REV. 1769, 1817 (1992) (emphasizing differences in racial identity along gender, class, and geographic lines); Darren L. Hutchinson, *Out Yet Unseen: A Racial Critique of Gay and Lesbian Legal Theory and Political Discourse*, 29 CONN. L. REV. 561, 640-41 (1997) (offering multidimensionality to describe the very inseparability of identity categories); Dorothy E. Roberts, *Punishing Drug Addicts Who Have Babies: Women of Color, Equality, and the Right of Privacy*, 104 HARV. L. REV. 1419 (1991) (arguing that punishing drug addicts who choose to carry their pregnancies to term violates their constitutional rights considering that Black women experience several forms of oppression simultaneously).

²⁵⁴ See I. Bennett Capers, *Reading Back, Reading Black*, 35 HOFSTRA L. REV. 9, 12 (2006).

²⁵⁵ CRITICAL RACE THEORY, *supra* note 22, at xiii.

²⁵⁶ *Id.* (noting that CRT "rejects the prevailing orthodoxy that scholarship should be or could be 'neutral' and 'objective[.]'").

²⁵⁷ For examples of legal scholarship doing this work, see, e.g., Cheryl I. Harris, *Whiteness as Property*, 106 HARV. L. REV. 1707 (1993); Margaret E. Montoya, *Máscaras, Trenzas, y Greñas: Un/Masking the Self While Un/Braiding Latina Stories and Legal Discourse*, 17 HARV. WOMEN'S L.J. 185 (1994); Russell K. Robinson, *Perceptual Segregation*, 108 COLUM. L. REV. 1093 (2008); Gerald Torres & Kathryn Milun, *Translating Yonnonidio by Precedent and Evidence: The Mashpee Indian Case*, 1990 DUKE L.J. 625; Williams, *supra* note 26.

²⁵⁸ Monica Bell, *The Obligation Thesis: Understanding the Persistent "Black Voice" in Modern Legal Scholarship*, 68 UNIV. PITT. L. REV. 643, 646 (2007) (citation omitted).

²⁵⁹ Crenshaw et al., CRITICAL RACE THEORY, *supra* note 22.

²⁶⁰ Derrick A. Bell, Jr., Comment, *Brown v. Board of Education and the Interest-Convergence Dilemma*, 93 HARV. L. REV. 518, 523 (1980) (explaining that "[t]he interest of blacks in achieving racial equality will be accommodated only when it converges with the interests of whites[]" by analyzing *Brown v. Board of Education*, 347 U.S. 483 (1954), to demonstrate that civil rights advances for blacks only occurred because they coincided with the self-interest of white elites, who were concerned with promoting a humanitarian image of the U.S. vis-a-vis their foreign relations with the Soviet Union). *But see* Justin Driver, *Rethinking the Interest-Convergence Thesis*, 105 NW. UNIV. L. REV. 149 (2011) (offering many theoretical criticisms of the interest-convergence

Building on the tenets of CRT, in *Critical Race IP*, Anjali Vats and Deidre A. Keller expound the themes, hopes, and endeavors of a theoretical framework for an interdisciplinary movement they dub “Critical Race Intellectual Property” (Critical Race IP).²⁶¹ Vats and Keller emphasize the urgency to examine racial investments and implications of intellectual property to, among other things, untangle the cultural implications of intellectual properties and intellectual property law.²⁶² Critical Race IP offers an area of study describing the scholarship concerned with the intersections of race and intellectual property law—a fitting home for Kahlo’s trademarks.²⁶³ With this understanding in hand, examining the varying trademark doctrines becomes more than a scholarly exercise, but rather a direct call to challenge and question legal structures. In the case of Kahlo, Critical Race IP and comparative law work together to critique local and international trademark jurisprudence.

C. *The Function of a Critical Race Intellectual Property Analysis*

The function of a Critical Race IP analysis of trademark law is twofold. First, application of CRT to issues in trademark law sheds light on overlooked racial inequalities and subordination not only of trademark law, but also of the trademark registration process. Second, a trademark analysis of racial inequalities reveals racial disparities in parties’ relative ability to challenge or protect trademarks. Thus, a Critical Race IP analysis does not stop with the application of CRT principles to varying doctrines of trademark law and the registration process. Rather, a Critical Race IP analysis also applies a trademark analysis to the racial justice problem itself. In doing so, it explores how conventional treatments of trademark issues pose both racial justice and trademark concerns. This often exposes trademark law that supports white privilege and dominance or reflects that white norms are treated more favorably than those which reflect minority perspectives. Lawmakers did not craft trademark laws with a racially discriminatory purpose or inherently discriminatory, but their unequal or incomplete application produces a racially subordinating effect.

To make this framework more concrete, a Critical Race IP example might be helpful. One example is the way copyright law disadvantaged black cultural production—namely jazz.²⁶⁴ A Critical Race IP analysis can highlight how

thesis).

²⁶¹ Vats & Keller, *supra* note 21, at 736.

²⁶² *See id.* at 737–43.

²⁶³ *See generally id.*

²⁶⁴ *See* K.J. Greene, *Copyright, Culture & Black Music: A Legacy of Unequal Protection*, 21 HASTINGS

copyright law developed within social structures that historically did not serve the interests of black cultural production. The structure of copyright law, built and applied upon broad and pervasive social discrimination, resulted in the widespread denial of copyright protection to Black music artists.²⁶⁵ One of the copyright structures that disadvantaged Black cultural production is the idea-expression dichotomy. The idea-expression dichotomy is a fundamental tenet of copyright law mandating that copyright law should not protect raw ideas but only the expression of ideas.²⁶⁶ Part of the justification for the dichotomy is that if the first person to articulate a theory, divulge a principle, or lay out a plot line could prevent all others from using it for several decades, progress in creative works would be stymied rather than promoted.²⁶⁷ A second structure is that copyright law requires authors to fix musical works in a tangible form, such as sheet music or a recording, for copyright protection as musical composition.²⁶⁸ The rationale for this requirement arose from interpretation that the U.S. Constitution authorizes Congress to protect “Writings” and writing in a fixed form.²⁶⁹

These de jure race-neutral aspects of copyright law promote economic theory or uphold the Constitution, respectively, but a Critical Race IP examination reveals that in practice the idea-expression dichotomy of copyright and the tangible requirement disparately impacted Black innovators. For example, Black composers’ ground-breaking work in jazz and blues was imitated and appropriated widely.²⁷⁰ Tracing its development as far back as slavery, Black cultural production reproduced itself out of an oral predicate and non-Western norms.²⁷¹ This tradition is fundamental in jazz. Copyright law’s tangible requirement left many Black jazz artists who could not functionally read or write unable to create tangible compositions of their creations because they faced educational deprivation and the inherent difficulty of jazz rhythm using Western musical notation.²⁷² Like its application to copyright law, a Critical Race IP analysis of trademark law attempts to expose the unbalanced playing

COMM. & ENT. L.J. 339, 356 (1999) [hereinafter Greene, *Copyright, Culture & Black Music*].

²⁶⁵ *Id.* at 368.

²⁶⁶ See 17 U.S.C. § 102(b).

²⁶⁷ K.J. Greene, “Copynorms,” *Black Cultural Production, and the Debate over African-American Reparations*, 25 CARDOZO ARTS & ENT. L.J. 1179, 1200 (2008) [hereinafter Greene, *Copynorms*].

²⁶⁸ 17 U.S.C. § 102(a) (2007).

²⁶⁹ U.S. CONST. art. I, § 8, cl. 8.

²⁷⁰ See generally Greene, *Copyright, Culture & Black Music*, *supra* note 264, at 368.

²⁷¹ Greene, *Copynorms*, *supra* note 267, at 1201. See generally PETER TOWNSEND, *JAZZ IN AMERICAN CULTURE* 21 (2000) (remarking that the “earliest Europeans attempting to write down African-American music found it formidably difficult”).

²⁷² Greene, *Copyright, Culture & Black Music*, *supra* note 264, at 378.

field of challenging and protecting trademarks—an aspect exacerbated on the international stage. Recognizing that the deck is stacked against marginalized populations, namely people of color, in a multitude of inconspicuous ways, is a necessary first step to prompt mitigation of implicit and structural racial bias surrounding trademark registration and subsequent challenges and protections for trademarks.

D. A Critical Race Intellectual Property Analysis of Kahlo's Trademarks

This Section turns to a Critical Race IP analysis of Kahlo's trademarks to examine aspects of trademark law in the United States and the European Union. There are two key purposes of a Critical Race IP analysis and a comparative law approach. First, application of Critical Race IP to local and international problems uncovers overlooked racial inequalities under general trademark law.²⁷³ Second, comparative law adjusts the perspective by which one perceives the law, due to its ability to challenge entrenched categorizations and fundamental assumptions in one's own and others' legal cultures.²⁷⁴ Kahlo's trademark registration highlights the unbalanced power dynamics involved in the registration process. Regardless of jurisdiction, the processes to register trademarks are riddled with components of how trademark law serves to protect and preserve existing power structures that ensure "insiders" remain in power and benefit from the subordination of "outsiders." Accordingly, this Section will focus on one aspect and look at the power dynamics involved in deciding whether to refuse a trademark registration because the mark is descriptive and therefore generic.²⁷⁵ In applying CRT to local and international trademark law,

²⁷³ Vivian Grosswald Curran, *Dealing in Difference: Comparative Law's Potential for Broadening Legal Perspectives*, 46 AM. J. COMP. L. 657, 658 (1998).

²⁷⁴ *Id.*

²⁷⁵ See 15 U.S.C. § 1052(e)(1); Regulation 2017/1001, art. 7(1), 2017 O.J. (L 154) 1 (EU). In the United States and European Union, an applicant can overcome this rejection by proving the mark acquired distinctiveness through use. Regulation 2017/1001, art. 111(2)(k), 2017 O.J. (L 154) 1 (EU); *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 133, 173 USPQ 820, 823 (S.D.N.Y. 1972). Proving acquired distinctiveness in the European Union is unclear. Some courts merely require a showing that consumers recognize the product. See, e.g., *Mondelez UK Holdings & Services Ltd. v. Société des Produits Nestlé S.A.*, EUIPO, Joined Cases C-84/17 P, C-85-17 P, & C-95-17 P, EU:C:2018:266 (Apr. 19, 2018) (finding that consumer recognition of the mark is enough); EUIPO, Case T-112/13, EU:T:2016:735, paras. 95–107 (GC, Dec. 15, 2016) (finding that consumer recognition of the mark is enough). Others require more than consumer recognition or association for the mark to become legally distinctive. See *Société des Produits Nestlé S.A. v. Cadbury UK Ltd.*, [2017] EWCA (Civ) 358, paras. 76–84 (May 17, 2017) (finding that mere recognition or association falls short of the standard). In the United States, to show a mark acquired distinctiveness, also known as "secondary meaning," an applicant must prove that the mark has become distinctive as applied to the applicant's goods or services in commerce. *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 133 (S.D.N.Y. 1972).

this Section is guided by a primary inquiry: how does the legal doctrine, practice, and custom of trademark law subordinate interests of marginalized communities? Accordingly, this Section scrutinizes what appears neutral on its face or in its application.

It is crucial to understand the power of the trademark gatekeepers: the attorney examiners that analyze applications for trademarks. In the USPTO, officials who examine trademark applications are attorneys, while in the European Union Intellectual Property Office (EUIPO) officials with degrees or post-graduate degrees in law are preferred, but it is not a requirement per se. Examiners for the USPTO and the EUIPO hold great power and discretion in determining whether a mark is merely descriptive of goods or services.²⁷⁶ Generally, a mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services.²⁷⁷ While this is only one example of the power of USPTO and EUIPO examiners to gatekeep, it emphasizes the limitations of assumed neutrality in the trademark registration process. If the examining attorney deems the mark merely descriptive, then the mark is not registrable, unless the applicant shows that consumers associate the mark with a secondary meaning—as an indication of source—rather than just the term’s primary, descriptive meaning.²⁷⁸ The following cases highlight how the examiner’s power comes into play.

Useful examples of how the examiner’s power comes into play in refusing registration of a mark because it is merely descriptive are the cases of marks “MARTHA WASHINGTON” and “LITTLE MERMAID” for use in dolls. Martha Washington was the wife of George Washington and is considered the most famous U.S. Revolutionary War woman.²⁷⁹ After appealing the refusal of MARTHA WASHINGTON as a trademark for dolls, the TTAB upheld the examiner’s decision that a MARTHA WASHINGTON mark covering dolls was merely descriptive of a doll intended to represent the historical figure Martha Washington.²⁸⁰ The TTAB reasoned that consumers would not necessarily link Martha Washington’s name or image to a particular commercial entity and

²⁷⁶ See 15 U.S.C. §1052(e)(1).

²⁷⁷ See *In re TriVita, Inc.*, 783 F.3d 872, 874 (Fed. Cir. 2015).

²⁷⁸ See, e.g., 15 U.S.C. §1052(f); *Ralston Purina*, 341 F. Supp. at 133; *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300 (Fed. Cir. 2012).

²⁷⁹ AMERICAN REVOLUTIONARY WAR FACTS: MARTHA WASHINGTON FACTS, <https://www.american-revolutionary-war-facts.com/American-Revolutionary-War-Women-Facts/Martha-Washington-Facts.html>.

²⁸⁰ *In re Carlson Dolls Co.*, 31 U.S.P.Q.2d 1319, 1320 (T.T.A.B. 1994).

instead link the doll to the fictional historical figure.²⁸¹ Because prospective consumers expect dolls that depict characters to have labels of the character's name, the same reasoning applies to fictional public-domain characters, like the Little Mermaid.²⁸² As such, a LITTLE MERMAID mark for dolls is merely descriptive because it refers to the fictional public domain character and does not serve as a source identifier. This allows toy makers interested in marketing a Little Mermaid doll to use "Little Mermaid" to describe that the doll depicts the Little Mermaid.²⁸³ The determination of whether a mark comprising the name of a historical figure or a fictional character serves as a source identifier or is merely descriptive turns on whether the USPTO or EUIPO examining attorney believes consumers link the mark to a particular commercial entity or whether others have a competitive need to use the name to describe their products.²⁸⁴

The registration of the FRIDA KAHLO mark for Class 28 goods and services shows the potential unintended outcomes of tasking USPTO or EUIPO examining attorneys with determining the links consumers make. Before closing her case, Shope pointed to the refusals for the MARTHA WASHINGTON mark for Class 28 goods to argue the examining attorney erroneously issued the mark.²⁸⁵ One theory as to why the examiner did not find the mark, FRIDA KAHLO, as merely descriptive of the person, Frida Kahlo, was because the examiner did not know who Kahlo was, or failed to recognize her.²⁸⁶ Unsurprisingly, among the relief Shope sought was the cancellation of FKC's U.S. trademark registration over the use of the mark "FRIDA KAHLO" for Class 28 goods because it is generic, purely functional, and merely descriptive.²⁸⁷

Not knowing, or failing to recognize, Kahlo is a plausible theory explaining the mark's registration in Class 28 goods. Despite the rise of Fridamania elevating Kahlo's popularity into new heights through the 1980s and 1990s or the Hollywood major motion picture in 2002, it is still possible that an examiner did not know or recognize Kahlo in 2005 when Isolda and Mara filed the specific trademark application.²⁸⁸ Women of color continually experience indifference

²⁸¹ *Id.*

²⁸² *In re United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d 1796, 1798–99 (T.T.A.B. 2017).

²⁸³ *See id.*

²⁸⁴ *See In re United Trademark Holdings*, 122 U.S.P.Q.2d at 1799–1800; *In re Carlson Dolls*, 31 U.S.P.Q.2d at 1319–20.

²⁸⁵ Shope's Complaint, *supra* note 17, at 10.

²⁸⁶ Amanda Pampuro, *Denver Doll Maker to Corporation: You Don't Own Frida Kahlo*, WESTWORD (June 12, 2019), <https://www.westword.com/content/printView/11374186>.

²⁸⁷ Shope's Complaint, *supra* note 17, at 12–13.

²⁸⁸ *See supra* Part II.B.

from legal systems and society and the possibility that an USPTO examiner's failed to recognize Kahlo's name offers another example of the problem.²⁸⁹ While the theory is not farfetched, it is crucial to look at other aspects of the trademark registration process and not focus solely on one examiner's decision.

To reject an application on genericness grounds, a USPTO examiner must meet the heightened burden of showing clear and convincing evidence that the applied-for designation is generic.²⁹⁰ Conversely, in both federal court and TTAB proceedings a challenger must prove the mark is generic by a preponderance of the evidence.²⁹¹ Precedence might suggest that a "Frida Kahlo" mark for dolls is nothing more than descriptive of dolls that depict Kahlo, and therefore generic, but that may nonetheless fall short of for an examiner. Consequently, the evidentiary burden pigeonholes examiners to avoid determining genericness, even in situations like Kahlo's. And that might be the point of the process. The heightened threshold allows examiners to make cautionary decisions and removes a highly factual and often complicated question from the examiner's judgment. This highlights the problem of a legal process designed to streamline the entrance of goods into the market. The trademark registration system will invariably facilitate processes that prioritize and promote consumption while other considerations—like the racial implications of a trademark—are placed on the back burner.

Unlike the USPTO, the EUIPO does not give its examiners an evidentiary burden to meet to reject a mark due to descriptiveness.²⁹² Examiners, however, do rely on extensively detailed EUIPO guidelines for their examinations of marks.²⁹³ The guideline that includes the most recent EU trademark reforms is 1,610 pages long and details numerous EU cases and hypothetical examples to help examiners make decisions including, but not limited to, grounds to refuse a mark for descriptiveness.²⁹⁴ Notably, the guidelines go on to explain how the examiners' use of the "reference base," or the ordinary understanding of the relevant public of the word in question, can be corroborated by dictionary entries, examples of the use of the term in a descriptive manner found on internet

²⁸⁹ See generally, e.g., Crenshaw, *supra* note 253, (arguing the need to account for multiple grounds of identity when considering how the social world is constructed); Paulette M. Caldwell, *A Hair Piece: Perspectives on the Intersection of Race and Gender*, 1991 DUKE L.J. 365, 371–71 (1991) (analyzing a case of employment termination due to someone's hair, exemplifying intersectional race and gender discrimination).

²⁹⁰ See TMEP § 1209.01(c)(i); *In re Cordua Rests., Inc.*, 823 F.3d 594, 600–01 (Fed. Cir. 2016).

²⁹¹ 15 U.S.C. § 1115(a); see also *Colt Defense LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 705–06 (1st Cir. 2007).

²⁹² EUIPO, GUIDELINES FOR EXAMINATION 428 (2021).

²⁹³ See generally *id.*

²⁹⁴ *Id.*

websites, or it may clearly follow from the ordinary understanding of the term.²⁹⁵ Like the USPTO, however, the EUIPO's approach ultimately leads to powerful gatekeepers in control. The heightened burden of the USPTO and the wide discretion for the EUIPO seem to highlight opposite approaches but may ultimately serve the same purpose of prioritizing the market of goods over other considerations.

An example of the EUIPO's guidelines in action is a 2015 decision regarding a JANIS JOPLIN trademark application for Class 9 goods and services.²⁹⁶ The EUIPO examiner reasoned that the mark is descriptive and devoid of distinctive character, arguing that Janis Joplin is known as a U.S. rock and blues singer of the sixties.²⁹⁷ According to the examiner, the relevant consumer would immediately relate the goods and services applied for as somehow related to the famous singer.²⁹⁸ For example, CDs featuring music in Class 9 may feature songs or covers of songs sung or written by Janis Joplin. Electronic game software may feature Janis Joplin as the main character of the game.²⁹⁹ As such, to the examiner, the mark conveyed clear information regarding the subject matter of the goods and services in question and rejected the application.³⁰⁰

The applicant appealed and requested the Boards of Appeal of the Office for Harmonization in the Internal Market (OHIM Board) to annul the contested decision and allow the application for registration by arguing that the mark JANIS JOPLIN had no descriptive meaning in respect of the goods and services subject to the application nor lacked distinctive character.³⁰¹ According to the applicant, consumers would not consider the mark JANIS JOPLIN as an indication of the content or subject matter of the goods and services because the mark did not designate a quality or any characteristic of the goods and services.³⁰² Rather the JANIS JOPLIN mark indicated the commercial origin of the goods and services considering the applicant, much like FKC, was a company who owned the rights to Janis Joplin.³⁰³ For support, the applicant referred to previous registrations of the names of famous singers and bands.³⁰⁴

²⁹⁵ *Id.* at 428.

²⁹⁶ *See* In Case R 2292/2014-4 DECISION of the Fourth Board of Appeal of 24 March 2015.

²⁹⁷ *Id.* at 2.

²⁹⁸ *Id.*

²⁹⁹ *Id.*

³⁰⁰ *Id.*

³⁰¹ *Id.* at 3–4.

³⁰² *Id.*

³⁰³ *Id.*; JANIS JOPLIN, <https://janisjoplin.com> (“JANIS® and JANIS JOPLIN® are registered trademarks of Fantality Corp”).

³⁰⁴ These examples included famous names such as RIHANNA, JUSTIN BIEBER, BEYONCÉ, THE

Contrary to what the examiner found, the OHIM Board elaborated how the JANIS JOPLIN mark fulfilled a trademark's function as an indicator of origin.³⁰⁵ As such, the OHIM Board explained that the fact that JANIS JOPLIN may constitute the name of a famous singer did not exclude it as an origin-indicating mark.³⁰⁶ According to the OHIM Board, the mark JANIS JOPLIN was not capable of describing a particular category of CDs or DVDs that could be the subject-matter of these goods and services, like rock or blues.³⁰⁷ Therefore, it was unlikely that the relevant customers would perceive the mark as an indication of the subject matter of the goods and services for which registration was sought.³⁰⁸ The OHIM Board explained that the relevant public would not perceive the mark as descriptive in relation to the goods and services applied-for.³⁰⁹ In the OHIM Board's opinion, there were no indications that the public would not perceive the JANIS JOPLIN mark as a commercial indication of origin and annulled the examiner's rejection.³¹⁰

Notably absent in the OHIM Board's decision is any reference to how it reached its consumer behavior conclusions or what the OHIM Board utilized to reach its conclusion. Therein lies the problem, one that is not novel to any country in the world—the United States included. Judges, examiners, USPTO and EUIPO Boards, all presume an understanding of the average, or reasonable, person. What it means to be a reasonable consumer, or a reasonable person, is framed and constructed without full understanding of many marginalized populations.³¹¹ This case exemplifies the power in the process placed on EUIPO examiners. How decisionmakers' personal knowledge impacts the process speaks volumes to the power of decisionmakers in determining what is and is not famous, or well-known, and how consumers behave. In this case, neither the examiner, the applicant, nor the OHIM Board required a certain standard and

DOORS, AEROSMITH, LADY GAGA, ONE DIRECTION, or BEATLES. *See* In Case R 2292/2014-4 at 3.

³⁰⁵ *Id.* at 4.

³⁰⁶ *Id.*

³⁰⁷ *Id.* at 4–5.

³⁰⁸ *Id.*

³⁰⁹ *Id.*

³¹⁰ *Id.*

³¹¹ The liberal legal subject, “is a highly accountable, independent, and socially de-contextualised agent that also seems to stay clear of any major influences relations to attributes.” Taina Cooke, *Seeing Past The Liberal Legal Subject: Cultural Defence, Agency And Women*, 42 SUOMEN ANTROPOLOGI 23, 23 (2017). For scholarship critiquing the liberal legal subject, see, e.g., Laura A. Heymann, *The Reasonable Person in Trademark Law*, 52 ST. LOUIS UNIV. L.J. 781, 782 (2008); Graham Cronogue, *Race and the Fourth Amendment: Why the Reasonable Person Analysis Should Include Race as a Factor*, 20 TEX. J. C.L. & C.R. 55 (2014). *See generally* Laura Cohen, “*The Reasonable Black Child*”—Youth, Race, and the Fourth Amendment, 33 CRIM. JUST. 37 (2018); Donald Braman, *Cultural Cognition and the Reasonable Person*, 14 LEWIS & CLARK L. REV. 1455 (2010); Lydia J. Carlsgaard, *Reasonable Person and I*, 27 HASTINGS WOMEN'S L.J. 165 (2016).

solely relied on their experience and personal knowledge. Without a clearer framework that identifies how race and ethnicity cannot be divorced from consumers, trademark law will continue to jeopardize marginalized applicants that are impacted by these decisions.

In the United States, challengers of registered trademarks must prove the mark is generic by a preponderance of the evidence.³¹² When analyzing whether a designation is generic, courts consider the relevant good or service; the relevant consuming public; and the primary significance of the designation to these consumers. Generally, genericness determinations are based on the perception of the actual and potential purchasers of the goods or services in issue.³¹³ In cases involving ordinary consumer goods, the relevant consumer group is the general public while the relevant consumer group may differ when the goods or services are marketed to non-consumers.³¹⁴ Nonetheless, the court determines how the majority of the relevant consuming public views the alleged mark.³¹⁵ Because a mark may have significance both as a trademark and as a generic term, the question for the USPTO and the courts is to determine the primary significance of the designation.³¹⁶ Accordingly, all genericness cases must ultimately determine whether consumers perceive the designation as identifying a class or type of product or service (in which case it is generic) or the producer of the product or service (in which case it is not generic).³¹⁷

Because consumer perception is the central issue in genericness cases, parties often offer survey evidence, but courts also rely on evidence of how the media, the public, and the parties have used the term.³¹⁸ Surveys are not essential if other evidence strongly supports a party's position, but some courts state a preference for survey evidence over other forms of evidence in genericness cases.³¹⁹ Meanwhile, other courts and the TTAB have held that surveys are only

³¹² 15 U.S.C. § 1115(a); *see also* *Colt Defense LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 705–06 (1st Cir. 2007).

³¹³ *See Loglan Inst., Inc. v. Logical Language Grp., Inc.*, 962 F.2d 1038, 1041 (Fed. Cir. 1992).

³¹⁴ *See Horizon Mills Corp. v. QVC, Inc.*, 161 F. Supp. 2d 208, 217 (S.D.N.Y. 2001) (finding that the general public's perception, not the perception of trade professionals and fashion experts, is relevant to whether SLINKY is generic for certain fabric and wearing apparel).

³¹⁵ *See Moroccanoil, Inc. v. Marc Anthony Cosmetics, Inc.*, 57 F. Supp. 3d 1203, 1214 (C.D. Cal. 2014).

³¹⁶ *See Genesee Brewing Co., Inc. v. Stroh Brewing Co.*, 124 F.3d 137, 144 (2d Cir. 1997).

³¹⁷ *See generally* *Am. Thermos Prods. Co. v. Aladdin Indus., Inc.*, 207 F. Supp. 9 (D. Conn. 1962); *E. I. Dupont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975).

³¹⁸ *See Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 641 (Fed. Cir. 1991) (listing purchaser testimony, consumer surveys, dictionary definitions, trade journals, newspapers, and other publications).

³¹⁹ *See generally, e.g., Nartron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397, 406–07 (6th Cir. 2002); *Booking.com B.V. v. U.S. Patent & Trademark Office*, 915 F.3d 171, 183 (4th Cir. 2019); *Berner Int'l Corp. v. Mars Sales Co.*, 987 F.2d 975, 982–83 (3d Cir. 1993).

valid when assessing whether a coined or arbitrary trademark has become a generic term through popular usage, and not when assessing genericness of an ordinary term or a composite of ordinary terms.³²⁰

Comparatively, in the European Union, specifically the United Kingdom, surveys are inadmissible without the prior approval of a judge. In *Interflora v. Marks and Spencer*, plaintiff Interflora conducted a survey and proposed calling survey respondents as witnesses.³²¹ The High Court allowed the evidence, but the Court of Appeal overturned this decision.³²² The Court of Appeals in *Interflora* decided that: (1) a party may conduct a pilot survey without permission, but at its own risk as to costs; (2) no further survey may be adduced without the court's permission and disclosure of the pilot survey; and (3) no party may adduce evidence from survey respondents without the court's permission.³²³

Conducting surveys poses an entirely new problem regarding who is surveyed and how to conduct those surveys. First and foremost, conducting a survey for these purposes is expensive.³²⁴ While there is a general understanding that the price of litigation is immense, trademark litigation makes matters even worse, exacerbating the financial gap between potential litigants.³²⁵ As such, it is unsurprising that the artists facing off FKC in litigation did not use surveys to challenge FKC's Kahlo trademarks by proving that consumers do not associate Kahlo's image as a origin indicator pointing to FKC.³²⁶ Not only would it be

³²⁰ See generally, e.g., *Schwan's IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 976 (8th Cir. 2006); *Booking.com*, 915 F.3d at 183.

³²¹ See Nick Aires, *After Interflora*, CHARTERED INST. TRADE MARK ATT'YS (2013), <https://www.twobirds.com/~media/pdfs/news/articles/2013/after-interflora.pdf?la=en>; Michael Gardner, *UK: Interflora v M&S—The Saga Continues*, MONDAQ (Nov. 14, 2013), <https://www.mondaq.com/uk/trademark/354104/interflora-v-ms-the-saga-continues>.

³²² *Id.*

³²³ Aires, *supra* note 321.

³²⁴ See *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 224 (2d Cir. 1999) (noting the monetary and time investment in consumer surveys); Dan Sarel & Howard Marmorstein, *The Effect of Consumer Surveys and Actual Confusion Evidence in Trademark Litigation: An Empirical Assessment*, 99 TRADEMARK REP. 1416, 1416 (2009) ("Obtaining any data from consumers, particularly when a properly conducted survey is entailed, is a complex, time-consuming, and expensive process."); Robert C. Bird, *The Impact of the Moseley Decision on Trademark Dilution Law*, 26 J. PUB. POL'Y & MKTG. 102, 104 (2007) (stating that surveys can cost between \$50,000 and \$100,000); Rebecca Tushnet, *Running the Gamut From A to B: Federal Trademark and False Advertising Law*, 159 UNIV. PA. L. REV. 1305, 1339 (2011) (noting that consumer surveys are prohibitively expensive for smaller businesses).

³²⁵ See Glynn S. Lunney Jr., *Two-Tiered Trademarks*, 56 HOUS. L. REV. 295, 295 (2018) ("Today, we have a two-tiered trademark system. In the upper tier, both parties can afford to litigate. In the lower tier, only one party can.")

³²⁶ See generally E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of Species*, 99 TRADEMARK REP. 1118 (2009).

expensive but there would be no guarantee of success. This problem reaches new heights when considered in an international context. Obviously, populations around the world do not hold a monolithic perspective shared across cultures regarding what Kahlo's image represents. For that reason, FKC's ownership of the Kahlo trademark streamlines who and what Kahlo represents. In other words, as Shope and other artists learned, FKC is the gatekeeper to Kahlo's image and in doing so crafts Kahlo to whatever it wants—like a white-skinned able-bodied woman. That is what trademark law has evolved to in today's globalized economy. It allows gatekeepers, in the name of market capitalization and anti-completive principles, to manage marks with little concern to the immense implications that those marks may have. The racist history of trademarks around the world is not a consequence of antiquated views but a direct result of a jurisprudence that assumes race-neutrality.

CONCLUSION

Do not forget me, my love.

—Frida Kahlo³²⁷

Frida Kahlo trademarks should not exist, and Frida Kahlo should be in the public domain. This Comment has demonstrated that the litigation over the Frida Kahlo trademark is nothing more than a squabble premised in the fragmentation of local and international trademark law regimes that commodify and objectify marginalized people of color. At the same time, this perspective also raises new questions ripe for further inquiry. Primarily, what about other peoples' trademarks? For example, what about Rosa Parks; should a Rosa Parks trademark exist?³²⁸ Then there is Selena Quintanilla, whose shocking death in 1995 lead her father to create a fledgling empire on Selena's image and likeness and now utilizes the same tactics as FKC.³²⁹ This Comment does not argue that all cultural icons with trademarks to their name or image should enter the public domain. Additionally, this Comment does not overlook how trademark or property law can—and has—protected indigenous cultures and heritages across the globe.³³⁰ The law can, and should, be utilized as a tool by communities to

³²⁷ Michelle da Silva Richmond, *Long After Her Death, Mexico's Fiery Artist Still Hot*, HARTFORD COURANT (Sept. 1, 2002), <https://www.courant.com/hc-fridafever.artsep01-story.html> (quoting Frida Kahlo).

³²⁸ See Stephanie D. Zimdahl, *A Celebrity Balancing Act: An Analysis of Trademark Protection Under the Lanham Act and the First Amendment Artistic Expression Defense*, 99 NW. UNIV. L. REV. 1817 (2005).

³²⁹ See generally Jesse Katz, *What Would Selena Want?: As Netflix Series Begins, The Battle Over Her Estate Wages On*, BILLBOARD (Dec. 1, 2020), <https://www.billboard.com/articles/columns/latin/9491686/selena-estate-legal-battle-netflix-series>.

³³⁰ See, e.g., Sari Sharoni, *The Mark of a Culture: The Efficacy and Propriety of Using Trademark Law to Deter Cultural Appropriation*, 26 FED. CIR. BAR J. 407 (2017); Kristen A. Carpenter, Sonia K. Katyal & Angela

protect and defend their culture. The difference between Rosa Parks, Selena Quintanilla, and Kahlo is who holds the agency, autonomy, and power to make those decisions. What complicates matters with Kahlo's trademark are the numerous competing interests, primarily, what it means to protect Kahlo.

In analyzing Kahlo's trademarks, this Comment offers another perspective to the ongoing work in CRT that seeks to reimagine new directions for future scholarship regarding Critical Race IP and trademark law.³³¹ Let us not forget that even the treatment of colors—literally colors, like the pinkest pink—under trademark law is a vivid reminder of how skin color itself can serve as a form of bankable property.³³² Ultimately, trademark law around the globe will remain focused on the market and securing the investments that applicants make on their trademarks. As such, marginalized populations will continue to experience disadvantages time and time again operating within an overtly legal scheme inherently that rewards entities with familiarity and power, even forcing marginalized parties to pursue extralegal avenues of relief.³³³

This Comment furthered the position that Kahlo belongs to the public.³³⁴ The ambition of this Comment has been to uncover the inherent racism in local and international trademark law by examining Kahlo's trademarks. Nonetheless, other questions linger: what would have Kahlo wanted? And should that matter? Looking ahead, it is a given that artists will be better educated, more able to secure legal representation, and be better informed on how to protect their rights—in life and in death. Yet, if we are steadily moving toward a situation in which relatively few global conglomerates are in possession of the vast majority

R. Riley, *In Defense of Property*, 118 YALE L.J. 1022 (2009). See generally SUSAN SCAFIDI, WHO OWNS CULTURE?: APPROPRIATION AND AUTHENTICITY IN AMERICAN LAW 151 (2005) (proposing trademark-like protection for culture identities in commodified public spaces).

³³¹ See David D. Troutt, *A Portrait of the Trademark as a Black Man: Intellectual Property, Commodification, and Redescription*, 38 U.C. DAVIS L. REV. 1141, 1149–51 (2005) (providing an example of how a human person can become commodified through intellectual property law through an allegorical business plan).

³³² See Harris, *supra* note 257, at 1720–21, 1768 (demonstrating how skin color is a marketable and commodifiable asset and how “protection of the property interest in whiteness is achieved by embracing the norm of colorblindness”); Deborah R. Gerhardt & Jon M. Lee, *Owning Colors*, 40 CARDOZO L. REV. 2483 (2019) (discussing color trademarks). Gerhardt and Lee's article inspired this Comment's title.

³³³ See, e.g., Stephanie B. Turner, *The Case of the Zia: Looking beyond Trademark Law to Protect Sacred Symbols*, 11 CHI.-KENT J. INTEL. PROP. 116 (2012) (detailing the shortcoming of the legal system to protect Zia culture). But see Nicky Woolf, *Urban Outfitters settles with Navajo Nation after illegally using tribe's name*, GUARDIAN (Nov. 18, 2016), <https://www.theguardian.com/us-news/2016/nov/18/urban-outfitters-navajo-nation-settlement> (explaining how Navajo country successfully used the legal system to protect its name).

³³⁴ Cf. Milton H. Greene Archives, Inc. v. Marilyn Monroe LLC, 692 F.3d 983, 1000 (“I knew I belonged to the Public and to the world[.]”).

of the intellectual property resources,³³⁵ then there is no question that we are also moving toward the further marginalization of those who are currently situated at the edges of the intellectual property system.

LARIO ALBARRÁN*

³³⁵ PETER DRAHOS & JOHN BRAITHWAITE, INFORMATION FEUDALISM: WHO OWNS THE KNOWLEDGE ECONOMY? 3 (2007)

(These hands belong to media conglomerates and integrated life sciences corporations rather than individual scientists and authors. The effect of this, we argue, is to raise levels of private monopolistic power to dangerous global heights, at a time when states, which have been weakened by the forces of globalization, have less capacity to protect their citizens from the consequences of the exercise of this power.).

* Executive Special Content Editor, *Emory International Law Review*, Vol. 35; J.D. 2021, Emory University School of Law; M.A. 2018, B.A. 2016, University of Texas. The author extends his sincerest appreciation and thanks to Professor Dorothy A. Brown, for her support and advice. To Brandon Sinnott, Stephanie Saran Rudolph, and Mellie Ligon, for their thoughtful reviews. To Marlaina Wright, Alizé Mitchell, and the *EILR* staff, for its focus, effort, and dedication in editing this Comment. Finalmente, el autor agradece a su padre y madre que arriesgaron todo para que su hermano y él tuvieran una vida mejor.