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# SCORE A TOUCHDOWN, KISS YOUR TATTOO, AND GET SUED FOR COPYRIGHT INFRINGEMENT?

DARREN A. HEITNER\* & ALAN WILMOT\*\*

## ABSTRACT

This article discusses the connection between copyright law and tattoos, an art form that has not commonly been thought of as a highly protected type of intellectual property under the Copyright Act of 1976 (Copyright Act). The issue of existence and control of tattoo intellectual property has started to make its appearance in multiple federal district courtrooms across the United States; however, thus far all cases have settled before proceeding to trial. As a result, legal precedent informing potential litigants about the merits of their cases has yet to be firmly established. This article attempts to fully explain the applicability of the Copyright Act to the tattoo industry by highlighting the claims and affirmative defenses that the respective parties may assert in litigation.

## I. INTRODUCTION

On July 12, 2013, *ESPN The Magazine* released its fifth annual Body Issue. This compilation featured fifty-four photos of twenty-one athletes posing in different (partially nude) positions in order to accentuate and show off their chiseled, hard-earned bodies.<sup>1</sup> Among the select few chosen to appear in the issue, nine were captured in positions that also showcased their body art. Most notably,

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1. See, e.g., *Bodies We Want*, ESPN PHOTO, [http://espn.go.com/espn/photos/gallery/\\_/id/9428872/image/1/courtney-force-2013-body-issue-bodies-want-espn-magazine](http://espn.go.com/espn/photos/gallery/_/id/9428872/image/1/courtney-force-2013-body-issue-bodies-want-espn-magazine) (last visited May 8, 2014).

four prominent sports figures – Washington Wizards Point Guard, John Wall; San Francisco 49ers Quarterback, Colin Kaepernick; United States Women’s National Soccer Team Forward, Sydney Leroux; and San Francisco 49ers Tight End Vernon Davis – were depicted with multiple tattoos covering various parts of their body, including the chest, arms, ribs, back, and shoulders.

*ESPN The Magazine’s* Body Issue indirectly highlights the prevalence of tattoos in sports. With the social stigma attached to tattoos declining, and the percentage of citizens getting inked up increasing, over the years, more athletes have taken to visiting their friendly, neighborhood tattoo parlor.<sup>2</sup> This increase has led to the rise of an issue that was never considered to be of great importance in the past: who owns the copyright in tattoos once they have been permanently placed upon the recipient’s body? The most noteworthy case highlighting this issue involved a dispute between a tattoo artist and Warner Bros. Entertainment for its use of the artist’s work in its motion picture, *The Hangover: Part II*. This case, like the few tattoo copyright infringement cases that came before it, settled outside of court, preventing any concrete legal precedent to be set that would shed light on how future litigation would play out in the courtroom. As a result, legal action involving the copyrightability of tattoos, the ownership of those rights, and the application of copyright law to tattoos still largely remain issues of first impression for courts.

This article will attempt to color in the empty spaces that arise when discussing copyrights and tattoos by highlighting and explaining the pertinent provisions that come into play when analyzing the issues contained herein. It will begin by examining the Copyright Act of 1976, the governing body of law that deals exclusively with all issues regarding copyright throughout the United States. Next, the article will dive into the interrelation between copyright law and

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2. See, e.g., NBA TATTOOS, <http://nbatattoos.tumblr.com/> (last visited Jan. 15, 2014) (detailing increase in percentage of NBA players tattoo from the 2010-11 season (53%) to the 2012-13 season (56%)); see also Samantha Braverman, *One in Five U.S. Adults Now Has a Tattoo*, HARRIS INTERACTIVE (Feb. 23, 2012), <http://www.harrisinteractive.com/NewsRoom/HarrisPolls/tabid/447/mid/1508/articleId/970/ctl/ReadCustom%20Default/Default.aspx> (finding that more than one in five adults (21%) have at least one tattoo, up from 16% and 14% of people who reported having at least one tattoo when this survey was conducted in 2003 and 2008, respectively). Based on a *Harris Poll* of 2,016 adults surveyed online between January 16 and 23, 2012. *Id.*; see also Kal Raustiala & Christopher Sprigman, *Whose Tattoo Is It Anyway?*, L.A. TIMES, Oct. 6, 2013, available at <http://www.latimes.com/opinion/commentary/la-oe-raustiala-tattoo-copyright-20131006,0,3026228.story#axzz2j4uD1o00> (“[M]ore than one-third of Americans younger than 40 now have [a tattoo].”).

tattoos as seen through past litigation. Thereafter, the article will present all applicable defenses that a tattoo recipient may assert to show that the artist should not be gifted an exclusive copyright in the tattoo. Following that, there will be a discussion, assuming *arguendo* that it is legally recognized that artists are vested with exclusive rights upon completion of the artwork on the athlete's body, about how said rights may be transferred or granted to the recipient. Finally, the article will showcase where the tattoo industry currently stands in the eyes of copyright law, and will conclude by presenting possible scenarios tattoo artists and their clients may partake in furtherance of alleviating the issues presented by this novel and interesting topic.

## II. THE COPYRIGHT ACT OF 1976

The Copyright Act of 1976 ("Copyright Act") is the chief doctrine that governs all issues concerning copyright law in the United States. Among other things, the Copyright Act defines the subject matter of copyright, grants basic and exclusive rights to copyright holders, details how to properly transfer ownership in a copyright from one party to another, and explains copyright infringement and its applicable remedies.<sup>3</sup>

Pursuant to the Copyright Act, copyright protection is applicable to "original works of authorship fixed in any tangible medium of expression."<sup>4</sup> The following categories define what items qualify as works of authorship: (1) literary works; (2) musical works; (3) dramatic works; (4) choreography and pantomimes; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audio-

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3. See generally Copyright Act of 1976, 17 U.S.C. §§ 101-1332 (2012) (generally discussing various aspects of Copyright Act including exclusive rights and limitations, ownership, transfer of rights, and penalties for violations of rights).

4. *Id.* § 101 ("A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phone record, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than a transitory duration."). "Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." *Id.* § 102(a); see also *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). While the Copyright Act does not explicitly define originality, for a work to be original, it must be "independently created by the author" and possess "at least some minimal degree of creativity." *Id.* Only a small amount of creativity is needed to satisfy this creativity requirement. *Id.*; see also *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 178 (1st Cir. 2013) (stating works that may contain unoriginal elements are still afforded copyright protection if they are sufficiently original to particular author).

visual works; (7) sound recordings; and (8) architectural works.<sup>5</sup> Once an author has asserted and obtained an exclusive right in the copyrighted work, the Copyright Act bestows upon the author exclusive rights to do or authorize the following: (1) reproduce the copyrighted work; (2) prepare derivative works based upon the copyrighted work; (3) distribute copies of the copyrighted work or transfer ownership of the copyright by rental, lease, or lending; and (4) display or perform the copyrighted work publicly.<sup>6</sup> An author who believes a third-party has violated one of his or her exclusive rights may file a claim in federal court for copyright infringement. In order to allege copyright infringement, a plaintiff must satisfy two requirements: (1) ownership of the allegedly infringed material; and (2) presentment of sufficient proof to support a belief that the alleged infringer violated at least one of the exclusive rights bestowed upon the copyright holder by 17 U.S.C. § 106.<sup>7</sup> Copyright in a work vests initially in the author at the moment of creation, automatically granting the author exclusive rights.<sup>8</sup> The owner may not bring a claim for copyright infringement in federal court, however, until a work is registered.<sup>9</sup>

Authors and artists have exclusive rights to dictate who may have access to their work, but these rights are limited.<sup>10</sup> There are numerous statutory restrictions placed upon an author's ability to make a claim for copyright infringement, and the most common defense an infringing party asserts is the fair use doctrine.<sup>11</sup> Reproduction of a copyrighted work is considered fair use when the work is the subject of, or being used for the purpose of, "criticism, com-

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5. 17 U.S.C. § 101 (describing various works encompassed in Copyright Act).

6. *Id.* § 106.

7. *See* A&M Records, Inc. v. Napster, Inc., 239 F.3d 1004, 1013 (9th Cir. 2001); *see also* 17 U.S.C. § 501(a) (infringement occurs when alleged infringer engages in activities listed in § 106).

8. *See* 17 U.S.C. § 201(a) ("Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are co-owners of copyright in the work.").

9. *See id.* § 411(a) ("[N]o action for infringement of the copyright in any United States work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title."); *see also* Precision Automation, Inc. v. Tech. Servs., Inc., 628 F. Supp. 2d 1244, 1247 (D. Or. 2008) ("[U]ntil a work is registered, federal courts lack subject matter jurisdiction over claims of copyright infringement.").

10. *See generally* 17 U.S.C. §§ 107-118 (listing circumstances where use of copyrighted work constitutes "fair use," not subject to copyright infringement claim).

11. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994) (alteration in original) (citation omitted). The fair use defense is extremely important in copyright law because it "permits [and requires] courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster." *Id.*

ment, news reporting, teaching, scholarship, or research.”<sup>12</sup> Additionally, courts look at four factors to determine whether a particular utilization of a work of authorship should be considered fair use: (1) the purpose and character of the use, including whether use is for commercial or nonprofit educational purposes; (2) the nature of the copyrighted work, i.e. is it a factual or fictional work; (3) the amount and substantiality of the portion of the work used in relation to the copyrighted work as a whole; and (4) the effect of the particular use on the potential market, or value of, the copyrighted work.<sup>13</sup>

Another defense to copyright infringement is the “work for hire” doctrine.<sup>14</sup> The Copyright Act defines work made for hire as either: (1) “a work prepared by an employee for an employer during the scope of his or her employment;” or (2) “a work specially ordered or commissioned for use – if the parties expressly agree to such in writing – as: (1) a collective work; (2) part of a motion picture or other audiovisual work; (3) a translation; (4) a supplementary work; (5) a compilation; (6) an instructional text; (7) a test; (8) answer or material for a test; or (9) an atlas.”<sup>15</sup> If the alleged infringer succeeds under a work made for hire argument, it is in fact the supposed infringing party, not the party claiming infringement, who holds the exclusive rights in the copyright granted by Section 106 of the Copyright Act.

If the defendant in a copyright infringement suit has no valid defense for his or her use of the author’s copyrighted work, copyright infringement liability is established, and the plaintiff may be entitled to one, or a combination, of several different remedies. One such remedy is injunctive relief. Preliminary injunctive relief is granted at the outset of litigation if the owner of the copyright can demonstrate the following: (1) likelihood of success on the merits of his or her copyright infringement claim; (2) possibility of irreparable harm because of the unavailability of an adequate remedy at law due to, for example, incalculable monetary damages; (3) the damage done to the author by the continued use of the copy-

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12. 17 U.S.C. § 107 (listing uses of copyrighted work that are “fair use” and not subject to claim for copyright infringement).

13. *Id.* (listing four factors considered by courts in determining whether use of copyrighted material protected by “fair use” doctrine); *see also* Religious Tech. Ctr. v. Netcom On-Line Comm’n Servs., Inc., 907 F. Supp. 1361, 1378-80 (N.D. Cal. 1995) (analyzing four factors set out by Congress in order to determine whether fair use defense applicable).

14. *See generally* 17 U.S.C. § 101 (2012) (defining “work for hire”).

15. 17 U.S.C. § 101.

righted work outweighs any benefit or harm that the infringing party may have due to its use of the work; and (4) the injunction is in the public interest.<sup>16</sup> A preliminary injunction may turn into a permanent injunction after the conclusion of the lawsuit if the court finds copyright infringement.<sup>17</sup>

Another remedy the author may seek is monetary damages. The Copyright Act allows for the infringed party to recover both “actual damages,” and “statutory damages.”<sup>18</sup> To recover actual damages, the copyright owner must present proof of the amount of money the infringer gained from infringing upon the copyright. The defendant may rebut this evidence by claiming that any revenue or profits gained were the result of other factors not related to its use of the copyrighted work.<sup>19</sup> The Copyright Act states that a plaintiff can be awarded statutory damages “in a sum not less than \$750 or more than \$30,000” for each infringement.<sup>20</sup> In cases of willful infringement, “the court in its discretion may increase the award of statutory damages to an award of not more than \$150,000.”<sup>21</sup> Willful infringement is proven when the author of the copyrighted work sufficiently shows that the defendant acted with knowledge that its conduct constituted copyright infringement.<sup>22</sup> Courts have found that specific intent to violate copyright protection does not need to be shown to establish the knowledge requirement.<sup>23</sup>

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16. See *Rovio Entm’t Ltd. v. Royal Plush Toys, Inc.*, 907 F. Supp. 2d 1086, 1092 (N.D. Cal. 2012) (citing *Winter v. Natural Res. Def. Council Inc.*, 555 U.S. 7, 20 (2008)).

17. David V. Radack, *Remedies for Copyright Infringement*, 50 JOM (ISSUE 5) 51 (1998), available at <http://www.tms.org/pubs/journals/JOM/matters/matters-9805.html>.

18. 17 U.S.C. § 504(b) (2012) (explaining that “actual damages” are “damages suffered by [the copyright owner] as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages.”); see also *id.* § 504(c)(1) (“[T]he copyright owner may elect, at any time before final judgment is rendered, to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in the action, with respect to any one work, for which one infringer is liable individually, or for which any two or more infringers are liable jointly and severally, in a sum of not less than \$750 or more than \$30,000 as the court considers just. For the purposes of this subsection, all the parts of a compilation or derivative work constitute one work.”).

19. See *id.* § 504(b).

20. *Id.* § 504(c)(1).

21. *Id.* § 504(c)(2).

22. See 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 14.04[B], at 14-40.2-3 (1989).

23. See *Broadcast Music, Inc. v. McDade & Sons, Inc.*, 928 F. Supp. 2d 1120, 1134 (D. Ariz. 2013) (holding that defendant’s statement that it was not its intent to infringe upon plaintiff’s copyright was insufficient to raise genuine issues of

Having examined the important provisions of the Copyright Act that play a significant role in this topic, it is now time to turn to how these provisions affect tattooists and their clientele.

### III. THE INTERRELATION BETWEEN TATTOOS AND COPYRIGHT LAW

The main issue presented by the *ESPN Magazine* Body Issue, and many other instances that involve marketing athletes and celebrities who have visible tattoos, is who owns the right to benefit from the use of the tattoo. However, in order to reach this question, it must first be established whether tattoos warrant copyright protection.

Applying the language of the Copyright Act, a tattoo artist would have to prove the following three elements for his or her work to be copyrighted: (1) that the tattoo constitutes a “work” under the Copyright Act; (2) that the tattoo is “original”; and (3) that the tattoo is “fixed in any tangible medium of expression.”<sup>24</sup> Section 101 of the Copyright Act defines “pictorial, graphic, and sculptural works” to include two-dimensional works of “fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.” Under this definition, tattoos would seem to qualify as a “work” due to their pictorial or graphic nature as two-dimensional works of applied art, or art reproduction. In this sense, tattoos are analogous to paintings, differing only in the aspect that the artist is using a body as his or her canvas. Furthermore, a tattoo is considered original if the artist is able to prove that the art was independently created and possesses a minimal degree of creativity.<sup>25</sup> As previously stated, the “minimal degree of creativity” standard is a fairly low threshold to reach. Therefore, if an alleged infringer attempts to claim that the artist’s work is too generic to be copyrighted, the artist may point to slight variations added to the artwork to show the tattoo is an independent creation. As for the third element, it is tough to argue against the fact that once the ink dries, the tattoo has now become a permanent fixture on the recipient, no matter how unfortunate the location of the art. Pursuant to these three factors, it is commonly accepted that tattoos

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material fact regarding willful infringement) (citing *Peer Int’l Corp. v. Pausa Records, Inc.*, 909 F.2d 1332, 1336 n.3 (9th Cir. 1990)).

24. David Lizerbram, *Can Tattoos be Copyrighted?*, DAVID LIZERBRAM & ASSOC. (Jan. 14, 2012), <http://lizerbramlaw.com/blog/2012/01/04/can-tattoos-be-copyrighted/>.

25. *See Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (providing “minimal degree of creativity standard”).



fall within the ambit of categories that qualify for copyright protection.<sup>26</sup>

Recently, there have been a string of cases sprouting up that involved copyright infringement as it relates to tattoos; unfortunately (or rather fortunately for some of the parties involved), all the cases settled before the courts could reach a final decision. As a result, there has never been an explicit court ruling that establishes the precedent needed for tattooists to explicitly claim that tattoos, in fact, do fall under copyright protection.

In February 2005, Matthew Reed, a tattoo artist from TigerLilly Tattoo and DesignWorks located in Portland, Oregon, filed a federal lawsuit against Nike, Inc., Rasheed Wallace, and Weiden & Kennedy alleging various forms of copyright infringement for the copying, reproduction, and public display in a commercial prominently featuring a tattoo he designed for Wallace.<sup>27</sup> According to the lawsuit, Wallace approached Reed in 1998 asking for “an Egyptian-themed family design with a king and queen and three children and a stylized sun in the background.”<sup>28</sup> Wallace only paid \$450, which Reed considered low, but agreed to because he believed his business would receive exposure and additional work from tattooing a NBA player. Reed conceded to the fact that he expected his work to be shown nationally without his consent due to Wallace’s constant presence on sports television, accepting this fact as a tattoo industry norm. However, when Reed discovered the tattoo highlighted in an advertisement campaign for Nike’s products in a commercial broadcast during the Detroit Pistons’ 2004 championship run, Reed saw this as much more than incidental use and instead as a misappropriation of his work for commercial benefit; a use not commonly discussed in the tattoo industry prior to

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26. See, e.g., *id.* (“At first glance, it would appear that tattoos should be subject to copyright law.”); see also Timothy Bradley, *The Copyright Implications of Tattoos: Why Getting Inked Can Get You into Court*, 29 ENTMT & SPORTS LAW. 1, 27 (2011) (“As works of art, tattoos fall within the realm of copyrights.”).

27. See Complaint, Reed v. Nike, Inc., 3:05-CV-00198, 2005 WL 1182840 (D. Or. Feb. 10, 2005). Count I alleged copyright infringement of Copyright Registration Number VA 1-265-074 against both Nike and Weiden & Kennedy. The Amended Complaint included an additional copyright infringement claim against both parties for Copyright Registration Number VA 1-236-392. Count II alleged contributory infringement against Wallace individually. See *Perfect 10, Inc. v. Visa Intern. Serv. Ass’n*, 494 F.3d 788, 794-95 (9th Cir. 2007) (“[A] defendant is a contributory infringer if it (1) has knowledge of a third party’s infringing activity, and (2) induces, causes, or materially contributes to the infringing conduct.”) (internal citations omitted).

28. *Artist Sues Wallace Over Use of Tattoo*, ESPN.COM (Feb. 16, 2005, 1:54 PM), <http://sports.espn.go.com/espn/sportsbusiness/news/story?id=1992812>.

that point-in-time. While the lawsuit settled outside of court for an undisclosed amount, it established the basis for other artists to begin initiating copyright claims against those whom they felt were wrongfully benefitting from their work.<sup>29</sup>

Two tattoo copyright infringement cases stemming from the use of the artwork in videogames made appearances in federal court in 2012. The first, which resulted in a dismissal at the request of the plaintiff, was Stephen Allen's – a tattoo artist and owner of Crybabies Tattoo in Shreveport, Louisiana – lawsuit against Electronic Arts (EA) Sports and Ricky Williams.<sup>30</sup> Allen alleged that EA infringed upon his copyrighted artwork when it placed Williams on the cover of its videogame, *NFL Street*, which was released in 2004.<sup>31</sup> The game cover showcases tattoo artwork that he inked on Williams' biceps in 2003.<sup>32</sup> The second case entails an ongoing lawsuit between Chris Escobedo, owner of Elite Tattoo based in Phoenix, Arizona, and THQ Inc. In his complaint<sup>33</sup>, Escobedo claims that he is the original creator of the "Lion Tattoo" that he inked onto the ribcage of professional mixed martial artist Carlos Condit<sup>34</sup>; that he is the lawful owner of a federal copyright in the tattoo<sup>35</sup>; and that THQ's videogame, *UFC Undisputed 3*, violated his exclusive rights under 17 U.S.C. section 106 by containing unauthorized reproductions of the Lion Tattoo on Condit's character.<sup>36</sup> Of note, Escobedo mentions that he impliedly licensed Condit to publicly display the Lion Tattoo on his body at UFC fights and sanctioned events<sup>37</sup>; however, he goes on to state that he did not authorize Condit, or any other party for that matter, to copy or recreate the artwork,<sup>38</sup> especially for commercial purposes. Currently, due to THQ's pending bankruptcy and Escobedo's failed attempts to recoup more

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29. See Stipulation of Dismissal with Prejudice, *Reed v. Nike, Inc.*, 3:05-CV-00198, 2005 WL 1182840 (D. Or. Oct. 19, 2005).

30. See Complaint, *Allen v. Elec. Arts Inc.*, No. 5:12-cv-03172-SMH-MLH (W.D. La. Dec. 31, 2012), ECF No. 1.

31. See Ross Dannenberg, *New Case: Allen v. EA (Tattoo Art)*, PATENT ARCADE (Jan. 8, 2013), <http://www.patentarcade.com/2013/01/new-case-allen-v-ea-tattoo-art.html>.

32. See *Ricky Williams and EA Getting Sued for NFL Street Tattoo*, OPERATION SPORTS (Jan. 11, 2013), <http://www.operationsports.com/news/599456/ricky-williams-and-ea-getting-sued-for-nfl-street-tattoo/> (providing image of videogame cover).

33. See Complaint, *Escobedo v. THQ Inc.*, No. 2:12-cv-02470-JAT (D. Ariz. Nov. 16, 2012).

34. *Id.* ¶¶ 12, 15.

35. *Id.* ¶ 16 (speaking of Copyright Registration No. VAu001094747).

36. *Id.* ¶¶ 41-58.

37. *Id.* ¶ 45.

38. *Id.* ¶ 46.

than just the payment THQ made to Condit for his image in *UFC Undisputed 3*, this case is on appeal in front of a bankruptcy appellate panel.<sup>39</sup>

The most prevalent case that has given tattoo artists reason to believe they are likely to prevail on their copyright infringement claims involved three rambunctious friends, two similarly tattooed faces, and a former heavyweight boxing champion known to keep tigers as his pets. Just a month before its 2011 Memorial Day Release, the tattoo artist who inked the infamous tattoo seen on Mike Tyson's face initiated a lawsuit against Warner Brothers Entertainment for its recreation of the tattoo in its film, *The Hangover: Part II*. In the film, character Stu Price—played by actor, Ed Helms—is shown waking up in the bathtub of a shady Thailand hotel with a tattoo on his face substantially similar to the one Tyson sports in his everyday life. As a result of this alleged unauthorized reproduction of his registered copyright<sup>40</sup>, S. Victor Whitmill sued Warner Bros. for monetary damages and injunctive relief to prevent the release of the film.<sup>41</sup> An important factor in this case not seen in the other infringement cases is that after completion of the tattoo, Tyson signed a release form stating “that all artwork, sketches and drawings related to [his] tattoo and any photographs of [his] tattoo are property of Paradox-Studio of Dermagraphics [Whitmill's tattoo parlor].”<sup>42</sup> Pursuant to this agreement, Tyson is allowed to make public appearances, such as star in the original *Hangover* movie, but he does not have the right to reproduce the tattoo in other forms or license the use of the tattoo to third parties.

Warner Brothers raised a number of affirmative defenses to Whitmill's copyright infringement claim, its strongest being the doctrine of fair use. Within its fair use defense, one of Warner Brothers' key arguments was that its reproduction of the tattoo was protected because the purpose of its use was to make fun of the Tyson tattoo, therefore serving as a parody or satire of the original

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39. See Eriq Gardner, *Tattoo Artist Looks to Show Value of Copyright Claim Against Videogame Publisher*, HOLLYWOOD REP. (Sept. 10, 2013, 2:22 PM), <http://www.hollywoodreporter.com/thr-esq/tattoo-artist-looks-show-value-625509>.

40. See Exhibit 5, HENDRICKS & LEWIS, <http://iplaw.hllaw.com/uploads/file/98082.pdf> (last visited May 8, 2014) (providing Certificate of Registration for “Tribal Tattoo,” No. VA 1-767-704).

41. See Complaint ¶ 1, Whitmill v. Warner Bros. Entm't, No. 4:11-cv-752, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011), ECF No. 1, available at <http://www.nytimes.com/interactive/2011/05/21/business/media/20110521tattoo-case.html>.

42. *Id.* ¶ 7.

artwork.<sup>43</sup> However, as previously mentioned, a key factor for the first element of fair use is whether the infringing party used the copyrighted work for “commercial nature” or “nonprofit educational purposes.” As evidenced by the fact that Warner Brothers featured Stu’s tattooed face in marketing and promotional advertisements for the movie, it is undeniable that Warner Brothers commercially gained from its use of Whitmill’s artwork. In order to hurdle the “commercialism” factor and strengthen its defense, Warner Brothers argued that its use of the tattoo in the film was a transformative parody because its use functioned as a “stark contrast between the ‘tough’ and ‘outrageous’ tattooed warrior (Tyson) and the meek Stu [thus serving as] an element of the commentary on the tattoo.”<sup>44</sup> As stated by the Supreme Court, when asserting a parody defense under the fair use doctrine, the main “enquiry focuses on whether the new work merely supersedes the objects of the original creation, or whether and to what extent it is ‘transformative,’ altering the original with new expression, meaning or message.”<sup>45</sup> The Court went on to further say the “more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.”<sup>46</sup>

Unfortunately (for those hoping to rely on precedent in this area), like the cases that came before and after, this lawsuit also settled outside of court before a ruling could be made on the merits of the tattoo artist’s claims. However, in her ruling rejecting Whitmill’s request for preliminary injunction, presiding Judge Catherine D. Perry gave future tattoo artists in likewise situations reason to believe that they may be compensated in the future for any infringement of their artwork. Judge Perry found that two key factors – the likelihood of Whitmill succeeding on the merits, and whether he would suffer irreparable harm – weighed in favor of Whitmill.<sup>47</sup> Discussing Warner Brothers’ fair use defense, the Judge

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43. See *Broadcast Music, Inc. v. McDade & Sons, Inc.*, 928 F. Supp. 2d 1120, 1130 (D. Ariz. 2013) (“Parody is a subset of fair use, and is evaluated under the criteria set forth in 17 U.S.C. § 107.”).

44. Warner Bros.’ Memorandum in Opposition to Plaintiff’s Motion for Preliminary Injunction, p. 21, *Whitmill v. Warner Bros. Entm’t*, No. 4:11-cv-752 (E.D. Mo. May 20, 2011) (hereinafter Warner Bros. Memorandum).

45. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 569 (1994) (describing scope of courts focus when examining parody in context of fair use).

46. *Id.* (examining how other factors may affect new work seeking fair use protection).

47. See Yvette Joy Liebesman, *Copyright and Tattoo: Hangover II Injunction Denied, But the Copyright Owner Got Some Good News Too – Whitmill v. Warner Bros.* (Guest Blog Post), *TECH. & MKTG. LAW BLOG* (May 24, 2011), <http://blog.ericgold>

stated that she found no parody or transformative use in Warner Brothers' use of the design because the entire tattoo was copied in its original form and Warner Brothers used the tattoo substantially in its marketing of the movie<sup>48</sup>; as a result, Whitmill's case could not be dismissed. The court also reasoned that Whitmill's loss of control over the dissemination of his design served as an adequate basis to support his claim of irreparable harm.<sup>49</sup> However, Judge Perry found that the remaining two elements for injunctive relief – the balance of equities of the opposing parties and the harm to the public if the injunction were to be approved – tipped too heavily in Warner Brothers' favor to grant the injunction sought by Whitmill. Due to the amount of money spent on the advertising and promotion of the film, the court stated the irreparable harm suffered due to the loss of control of the artwork was not enough to outweigh the potential money lost – as much as \$100 million – from advertising a would-be enjoined film.<sup>50</sup> Additionally, the economic harm potentially suffered by the general public – namely, movie theatres, sponsors, concession vendors, and others not a party to the suit – would be far too great a loss. This last factor served as the predominant reason for the Judge's denial of Whitmill's motion for preliminary injunctive relief.<sup>51</sup>

While *Whitmill v. Warner Brothers* went on to settle outside of court, opinions such as the one written by Judge Catharine Perry serve as a window into how future litigation may conclude if given the chance to fully carry out in trial.

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man.org/archives/2011/05/copyright\_and\_t.htm (exploring court's decision to deny preliminary injunction).

48. *Id.*; see also Noam Cohen, *Citing Public Interest, Judge Rules for 'Hangover II'*, MEDIA DECODER (May 24, 2011, 4:05 PM), [http://mediadecoder.blogs.nytimes.com/2011/05/24/citing-public-interest-judge-rules-for-hangover-ii/?\\_php=true&\\_type=blogs&\\_php=true&\\_type=blogs&r=2](http://mediadecoder.blogs.nytimes.com/2011/05/24/citing-public-interest-judge-rules-for-hangover-ii/?_php=true&_type=blogs&_php=true&_type=blogs&r=2) (Judge Perry stating, "This use of the tattoo did not comment on the artist's work or have any critical bearing on the original composition. There was no change to this tattoo or any parody of the tattoo itself. Any other facial tattoo would have worked as well to serve the plot device.").

49. See Liebesman, *supra* note 47 ("The court was concerned with the Plaintiff's loss of control over his design as irreparable harm, and that while there was no presumption of harm, this was a low bar to reach, and was met by the Plaintiff.").

50. See *id.*

51. See Cohen, *supra* note 48 (explaining Judge Perry conceding that, but for harm to public interest, she should have enjoined Warner Brothers from releasing *Hangover II*).

## IV. WHO OWNS THE COPYRIGHT?

As demonstrated in these prior cases and the Copyright Act, the issue of who owns the exclusive copyright in a tattoo involves much more than deciding whether an explicit grant of rights were reserved to the artist or conferred to the recipient of the tattoo upon completion. Furthermore, the question still remains as to whether tattoo artists who register their artwork for copyright protection are able to effectuate a successful copyright infringement claim.

A potential argument by tattoo artists to assert ownership is that, based upon the language of the Copyright Act, it can be assumed that copyright ownership immediately vests in the artist – as the creator of the artwork – the moment the design has been drawn, inked, and completed on the recipient.<sup>52</sup> This argument is strengthened by the notion that in order for the tattoo recipient to claim ownership, the artist must have assigned, licensed, or transferred ownership via a written contract to the recipient.<sup>53</sup> Such an argument is comparable and can be extrapolated from other scenarios that involve copyrightable work. For example, when J.K. Rowling completed her work on the first *Harry Potter* novel, and all subsequent novels in the series, she immediately owned an exclusive copyright in the original work and all derivative forms.<sup>54</sup> Therefore, in order for Warner Brothers to create the *Harry Potter* films, it had to execute a licensing agreement in order to acquire the film rights from Rowling.<sup>55</sup> If Warner Brothers had not done

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52. See Kevin Smith, *Copyright Gets Under Your Skin*, DUKE UNIV. LIBR. (May 4, 2011), <http://blogs.library.duke.edu/scholcomm/2011/05/04/copyright-gets-under-your-skin/> (noting that rights vest in author once original work is fixed in tangible form, and “applying the tattoo is certainly fixation in tangible form, so the actual tattoo artist will often hold the rights”).

53. See Steven Olenick, *Own That Ink: Tattoo Copyrights Matter for Athletes, Sponsors*, SPORTS BUS. (Sept. 24, 2012), <http://m.sportsbusinessdaily.com/Journal/Issues/2012/09/24/Opinion/From-the-Field-of-Sports-Law.aspx> (listing requirements for tattoo recipient to claim ownership of tattoo artwork); see also 17 U.S.C. §§ 201-205 (2012).

54. See 17 U.S.C.A. §101 (“A ‘derivative work’ is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a ‘derivative work.’”).

55. See generally Tony Lisanti, *Warner Bros. and the Magic World of Harry Potter*, LICENSE GLOBAL (June 1, 2009), <http://www.licensemag.com/license-global/warner-bros-and-magic-world-harry-potter> (describing process Warner Brothers went through to obtain control of Harry Potter series).

so, the company would have been subjected to a copyright infringement lawsuit similar to the one faced by Steven Vander Ark. Rowling brought legal action and gained a permanent injunction against Vander Ark for his attempt to publish *Harry Potter Lexicon*, a guide to the seven Harry Potter books that included detailed descriptions of characters, creatures, spells, and potions.<sup>56</sup> Because the reference book appropriated an enormous amount of Rowling's books without adding any original commentary or seeking her consent, United States District Judge Robert P. Patterson permanently blocked publication of the book and awarded the author statutory damages.<sup>57</sup>

However, as touched upon above, there are multiple arguments that tattoo recipients may assert to challenge a tattoo artist's supposed exclusive copyright and claim ownership themselves. One such defense is that the tattoo artist's design should be considered a work made for hire. In a work made for hire, the person for whom the work was prepared for is considered to be the author, and therefore retains all exclusive rights in the work.<sup>58</sup> As stated earlier, there are two types of works made for hire.<sup>59</sup> At first glance, the first type of work made for hire – work prepared by an employee during the scope of his or her employment – fails to encompass the relationship between a tattooist and his or her clientele. In order to determine whether a hired party qualifies as an employee acting within the scope of his or her employment, the Supreme Court has stated that courts must consider “the hiring party's right to control the manner and means by which the product is accomplished.”<sup>60</sup> In *Community for Creative Non-Violence v. Reid*, the Supreme Court enumerated a list of non-determinative factors for courts to consider in making this determination, including:

[T]he skill required; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired

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56. See Larry Neumeister, *J.K. Rowling Wins Copyright Infringement Case*, DIE WELT (Sept. 9, 2008), <http://www.welt.de/english-news/article2416332/J-K-Rowling-wins-copyright-infringement-case.html> (exploring copyright action brought by JK Rowling).

57. See *id.* (stating holding of court in blocking publication of questionable book).

58. See 17 U.S.C.A. § 201(b) (2012).

59. See *id.* § 101.

60. *Comty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 751 (1989) (interpreting “work made for hire” under 17 U.S.C.A. § 101).

party; the extent of the hired party's discretion over when and how long to work; the method of payment; the hired party's role in hiring and paying assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hired party.<sup>61</sup>

It is unlikely that a tattoo artist qualifies as an employee, or "hired party," of a tattoo recipient based upon these factors. On the other hand, the second type of work made for hire – works created by independent contractors – seems more amenable to a recipient's claim for ownership of a tattoo. However, it is important to note that simply paying for something does not make it a work for hire.<sup>62</sup> Additionally, a work created by an independent contractor constitutes a work made for hire only if "the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire."<sup>63</sup> Furthermore, the work must fall under one of the nine categories of "specially ordered or commissioned work for use" espoused in the Copyright Act, namely: (1) as a contribution to a collective work; (2) as a part of a motion picture or other audiovisual work; (3) as a translation; (4) as a supplementary work; (5) as a compilation; (6) as an instructional text; (7) as a test; (8) as answer material for a test; or (9) as an atlas.<sup>64</sup> As the debate currently stands, a tattoo does not fall within any of these enumerated categories; and again, even if tattoos do qualify as a "specially ordered or commissioned work" in the near future, an explicit agreement would still be required stating that the work should be considered a work made for hire.<sup>65</sup>

Another option for the recipient is to claim joint authorship of the work. If a tattoo is considered a joint work, then both the artist and the recipient would be granted exclusive ownership interest, precluding any claims of copyright infringement.<sup>66</sup> A work is jointly

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61. *Id.* (stating list of factors considered when determining whether hired party qualifies as employee).

62. *See* Smith, *supra* note 52 (noting payment is alone insufficient to establish work for hire).

63. *Reid*, 490 U.S. at 751-52 (finding independent contractor can be work for hire only when certain conditions are met); *see also* 17 U.S.C.A. §101.

64. *See* 17 U.S.C. § 101 (2012) (providing definitions for various copyrightable works).

65. *Id.*

66. *See* DeBitetto v. Alpha Books, 7 F. Supp. 2d. 330, 335 (S.D.N.Y. 1998) (examining whether published work was considered "joint work" or "collective art").



created if the authors intended “that their contributions be merged into inseparable or interdependent parts of a unitary whole.”<sup>67</sup> For example, in *Reed v. Nike, Inc.*, Rasheed Wallace could have argued that without his artistic input and suggestions, Matthew Reed would not have been able to create the tattoo as is shown on Wallace’s arm and in the commercials. If done successfully, this argument would have granted Wallace the right to use or license the tattoo without Reed’s permission.<sup>68</sup> The elements Wallace would have to prove to show joint authorship include, but are not limited to, “whether (1) an alleged author exercises control over the work, serves as the inventive or master mind, or creates or gives effect to an idea; (2) there exists an objective manifestation of a shared intent to be co-authors; and (3) the audience appeal turns on both contributions and the share of each in its success cannot be appraised.”<sup>69</sup> However, it must be remembered that pleading this affirmative defense would not make Wallace the sole and exclusive owner of tattoo; this claim would only defeat any claim of sole ownership by Reed.<sup>70</sup> As a result, Reed would still be entitled to half of any profits earned by Wallace from any commercial use of the tattoo.

The tattoo recipient may also argue that by virtue of inking the body, essentially a public, mobile canvas for broadcasting an artist’s talent, the tattooist has no control over the public display or commercialization of the artwork as it appears on the recipient’s body.<sup>71</sup> To give a tattoo artist control over a client’s ability to appear in photos or profit off their inherent right of publicity – a person’s “name, image, and likeness”<sup>72</sup> – essentially is to give the artist power over how the client may move about in public, a right the Copyright Act does not explicitly, or was ever meant to, grant.<sup>73</sup> This “implied license” argument was the foundation behind another one of Warner Brothers’ defenses against Whitmill. In *Whitmill*, Warner

67. 17 U.S.C. § 101 (providing definitions for various copyrightable works).

68. See *Reinsdorf v. Skechers U.S.A.*, 922 F. Supp. 2d 866, 872 (C.D. Cal. 2013) (citing 1 NIMMER ON COPYRIGHT § 6.06[A]) (finding work must be creation of other joint author as well and not solely one author).

69. *Aalmuhammed v. Lee*, 202 F.3d 1227, 1233-35 (9th Cir. 2000) (listing necessary requirements for joint authorship) (internal citations and quotations omitted).

70. See 17 U.S.C. § 201(a) (“The authors of a joint work are coowners of copyright in the work.”).

71. See Raustiala & Sprigman, *supra* note 2 (discussing possible argument that athlete’s body is not capable of being controlled by tattoo artist).

72. *Brief History of RoP*, RIGHT OF PUBLICITY, <http://rightofpublicity.com/brief-history-of-rop> (last visited May 8, 2014) (describing what right of publicity entails).

73. See Raustiala & Sprigman, *supra* note 2 (explaining Copyright Act was not meant to grant artist power over how client may move).

Brothers' expert witness, David Nimmer, stated that tattoos are not subject to copyright protection because "augmentation of the body should not be copyrightable."<sup>74</sup> Nimmer elaborated as to why, explaining what may occur if the court were to grant Whitmill an exclusive right to the Tyson tattoo:

Mr. Tyson literally may not show his own face to the world; that is, he will be required to keep Mr. Whitmill's handiwork spread across his face, regardless of his own desires. Copyright law thereby becomes the instrument to impose, almost literally, a badge of involuntary servitude, akin to the mark which ranchers brand the cattle they own<sup>75</sup>

Under this view, it is argued that the bundle of inherent individual rights, such as the First Amendment right to freedom of expression and right of publicity, would outweigh any copyright allegations asserted by the tattooist.

This argument is further bolstered when the recipient is a well-known public figure, such as an athlete or actor. When a tattoo artist inks a celebrity, it should be expected that the tattoo will be displayed prominently in public, potentially for money-making purposes; this belief was conceded by Reed in his lawsuit against Nike and Rasheed Wallace. Additionally, this argument would seem to trump element four of any copyright infringement claim because the display of the artist's work on a celebrity could be seen as bringing in more clientele, thus increasing, and not taking away from, the profitability of the artist's work. However, this defense is extremely subjective to the individual facts of each case. Not every tattooist claiming copyright infringement may see an increase in business as the result of a client showcasing the artwork in public. Furthermore, this argument seems to go against the text of the Copyright Act. A body fits the definition of a "tangible medium" needed for copyright protection to reach tattoos because skin allows artists a permanent method for which their work can be repeatedly viewed.<sup>76</sup> As University of Florida Levin College of Law Professor of Copyright, Jeffrey Harrison, stated, "If it is copyright-

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74. David Kravets, *Hangover Tattoo Lawsuit: Can You Copyright Flesh*, WIRED (May 25, 2011, 3:25 PM), <http://www.wired.com/threatlevel/2011/05/human-flesh-copyright/> (noting David Nimmer's testimony was blocked by U.S. District Judge Catherine Perry after Whitmill's attorneys objected on the basis that it constituted a legal opinion "on what copyright law should be," rather than expert testimony.)

75. Declaration of David Nimmer, ¶ 20(a), *Whitmill v. Warner Bros. Ent.*, No. 4: 11-cv-752, 2011 WL 2038147 (E.D. Mo. May 20, 2011).

76. 17 U.S.C. § 101 (2012).

able on paper, it's similarly copyrightable on any medium that lasts, including skin."<sup>77</sup> Therefore, making a legal rule that copyright laws should not grant artists exclusive rights due to an implied license to the recipient would be too stringent of an application.

Warner Brothers also argued that the human body was exempt from copyright protection because it is a "useful article."<sup>78</sup> Under the Copyright Act, a useful article is one "having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."<sup>79</sup> Useful articles, as a whole, are not eligible for copyright protection; however, their individual elements may be entitled to such protection.<sup>80</sup> When making this determination, courts look at the following factors: (1) whether the designs are conceptually separable from the utilitarian aspects of the article; and (2) whether the separable designs are entitled to copyright protection.<sup>81</sup> Warner Brothers' "useful article" defense rested on the conclusion that Tyson's body, including his head and face, served an intrinsically utilitarian function beyond the purpose of portraying the Tyson tattoo because it "[helped] him complete the most mundane, daily activities," and "[enabled] him to win boxing championships."<sup>82</sup> However, under the two-prong analysis, it follows that tattoos qualify as an individual element of the body, subject to copyright protection due to its pictorial and graphic nature, as defined above.<sup>83</sup> In an attempt to prove that Tyson's body qualified as a useful article under the "utilitarian aspect" prong of

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77. Darren Heitner, *Questions Concerning Copyright of Athlete Tattoos Has Companies Scrambling*, FORBES.COM (Aug. 14, 2013, 8:01 AM), <http://www.forbes.com/sites/darrenheitner/2013/08/14/questions-concerning-copyright-of-athlete-tattoos-has-companies-scrambling/>; see also Lizerbram, *supra* note 24 (pointing out David Nimmer's position before *Whitmill v. Warner Bros.* as one supporting copyright protection for tattoos, "as they are works of graphic art, regardless the medium they were designed to be affixed to.").

78. Warner Bros.' Memorandum, *supra* note 44, at 16 (explaining Warner Bros.' position that human body was exempt from copyright).

79. 17 U.S.C. § 101 (providing definitions for copyrightable works).

80. See *Pan-Amer. Products & Holdings, LLC v. R.T.G. Furniture Corp.*, 825 F. Supp. 2d 664, 702 (M.D.N.C. 2011) (stating rule that individual elements may be eligible for copyright protection).

81. *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 432 (4th Cir. 2010) (providing requisite factors for individual elements to be found copyrightable).

82. Warner Bros.' Memorandum, *supra* note 44, at 16-17 (summarizing Warner Brothers' "useful article" defense).

83. See 17 U.S.C. § 101 (2012) ("[The design of a useful article] shall be considered a pictorial, graphic, or sculptural work [and thus subject to copyright protection] only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.").

the above analysis, Warner Brothers points to the body's ability to help Tyson get through daily activities; yet, the design of the Tyson tattoo on Tyson's head – already determined to be entitled to copyright protection – plays no role in his body carrying out these day-to-day functions.<sup>84</sup>

## V. WHERE ARE WE NOW?

As evidenced, the full extent of copyright law as it applies to tattoos is still an issue of first impression for courts. While there have been legal opinions written that hint at how future copyright infringement cases involving tattoos may play out if given the opportunity, until a case produces a direct order stating how copyright right law shall apply, all other views are seen as merely dicta for courts to adopt at their discretion. Further, there are still unanswered questions pertaining to issues beyond the scope of prior lawsuits .

One issue that has yet to be addressed is the applicability of the “implied license” doctrine. As stated above, a strict application of this rule – that the use of bodies makes tattoos exempt from copyright protection because it encourages the unintended result of controlling peoples' movement – would run counter to the language of the Copyright Act. However, this does not mean that courts cannot attempt to formulate and subsequently adopt a lower standard. For example, courts may prohibit tattoo artists from bringing claims against clients who get tattoos on commonly seen parts of their bodies, such as football players who get tattoos on their arms, or a soccer player who receives a tattoo on his calf. However, if a tattoo artist spends a considerable amount of time designing a tattoo to draw on Oklahoma Thunder superstar Kevin Durant, known for getting tattoos on parts of the body not visibly seen when he plays basketball, it follows that a court may allow the artist to benefit from a portion of any profits Durant may receive from any use of the tattoo.<sup>85</sup> After all, it was the artist that designed the original artwork that attracted the sponsors who discovered a

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84. *Leicester v. Warner Bros.*, 232 F.3d 1212, 1216-17, 1219, n.3 (stating that Copyright Act offers no protection to useful articles or items with intrinsic utilitarian function such as automobiles, but carves out exception to nonfunctional, artistic elements of automobile design that can be conceptually separated from automobile).

85. See generally Eric Freeman, *Kevin Durant Has a Lot of Tattoos Under His Jersey*, YAHOO SPORTS (July 21, 2011, 7:00 PM), [http://sports.yahoo.com/nba/blog/ball\\_dont\\_lie/post/Kevin-Durant-has-a-lot-of-tattoos-under-his-jers?urn=nba-wp6742](http://sports.yahoo.com/nba/blog/ball_dont_lie/post/Kevin-Durant-has-a-lot-of-tattoos-under-his-jers?urn=nba-wp6742) (explaining that Kevin Durant has many tattoos not visible when wearing his jersey).

way to commercialize the artwork in conjunction with a promotional campaign directed at the public. However, the inherent problem remains in determining whether the artist should benefit from any incidental use of the tattoo in a commercial setting, such as with an action figure of a wrestler who happens to have a tattoo, or if his commission should strictly stem from purposeful use of the tattoo, such as Warner Brothers' use of the Tyson tattoo. Furthermore, if courts were to adopt a "middle ground" standard and settle on a sliding scale for assessing use, would this evaluation be used solely when determining whether a potentially infringed party could bring a claim, or would courts use this scale to help assess actual damages? The uncertainty regarding an answer to this question plays a role in why so few cases exist today.

Additionally, because the interrelation between copyright law and tattoos is a new concept, it has yet to be discovered how this intersection relates to the right of publicity, an individual's right to limit the public's use of his or her name, likeness, or identity for commercial purposes. If courts were to legally recognize that artists own the exclusive right to profit from commercial use of the tattoo, companies seeking to showcase athletes would not only have to seek permission from the athletes and their representatives, but also from the tattoo artist who designed the tattoos on the athletes' bodies. Failure to do so could result in a potential lawsuit. This was evident in the case of David Beckham, who was threatened with a lawsuit by United Kingdom tattooist Louis Molloy for being a part of a promotional campaign that focused on his "guardian angel tattoo," custom designed for him by Molloy.<sup>86</sup> Lawsuits such as this one would mean that for undertakings such as ESPN's *Body Issue*, the company would have to seek the permission of each respective tattoo artist who inked any of the twenty-one athletes' visible tattoos in the photos, in order to avoid litigation. While searching and acquiring a license agreement from the tattoo artist that inked Colin Kaepernick's arms may prove a tall task, it is one already proven to be possible. Matt Seigler, an account management representative at CEB, a publicly traded company that provides advisory services to businesses worldwide, sought to use the artwork of famous athletes' tattoos on merchandise for sale. Working under the belief that tattoo artists own the exclusive copyright in the designs, Seigler spent

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86. Marisa Kakoulas, *Tattoo Copyright & Celebrities*, NEEDLESANDSINS.COM (Aug. 8, 2012, 8:48 AM), <http://www.needlesandsins.com/2013/08/tattoo-copyright-celebrities.html> (describing lawsuit threatened against David Beckham by his former tattoo artist).

thousands of hours researching and cold-calling in order to obtain partnerships with tattoo artists that allowed him exclusive permission to use the artwork they created. As a result, Seigler procured licensing agreements with over six artists, representing work on at least eight athletes, including LeBron James and Kobe Bryant.<sup>87</sup> These agreements only grant Seigler the right, for example, to use LeBron James' famous "Chosen 1" tattoo on t-shirts. However, what happens when an athlete comes across the use of one his tattoos in a way he deems inconsistent with his image? At this point, the athlete may attempt to prohibit the person's right to associate his tattoo with the immoral cause; however, the user may have a readily available defense by simply pointing to the presence of a licensing agreement entered into by him and the athlete's tattooist. Currently, the law is open as to whether said agreement would restrict the athlete's ability to enjoin such use through his right of publicity. As a result, it is unclear if the athlete would be able to succeed on his or her claim based on the theory that, because the tattoo is commonly associated with, and viewed on his or her body, it falls under his or her "image and likeness" for the purposes of his or her right of publicity. Further, allowing tattoo artists to sue athletes as part of their copyright infringement claims would seem to run contrary to the purpose of the right of publicity. Thus far, the majority of copyright infringement cases have resulted in settlement, with the artist receiving an undisclosed amount of money in exchange for a dismissal of all claims. This monetary relief seems to run counter to the purpose of limiting a third-party's ability to make money off the famousness of their celebrity clients.

Another foreseeable issue not yet sufficiently addressed is how to determine who owns the exclusive copyright to a design when multiple artists work on one tattoo. In such a situation, courts have two manners by which to assign rights: (1) equally distribute rights in the tattoo based on upon the number of artists it took to complete the work, i.e. if it took three artists to fully complete a tattoo, each would share a one-third ownership right in the tattoo akin to joint ownership; or (2) assign rights based upon the approximate value of the services rendered by the artist towards the design, i.e., if the three artists supplied varying contribution, they would receive compensation based on their respective amounts of input and

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87. See Darren Heitner, *Exclusive Licensee of LeBron James and Kobe Bryant Tattoo Artwork Preps to Profit Off of Images*, FORBES.COM (Oct. 2, 2013, 8:06 AM), <http://www.forbes.com/sites/darrenheitner/2013/10/02/exclusive-licensee-of-lebron-james-and-kobe-bryant-tattoo-artwork-preps-to-profit-off-of-images/> (providing examples of tattoo artists obtaining agreements from players).

work. While this seems like a solution proffered by the Copyright Act, it should be noted that the Act only grants authors coownership of a joint work rather than prescribing it, and how to assign proprietorship amongst them. Due to these, and many other unanswered questions, it is best that tattoo artists and their clients explicitly define who has exclusive ownership right to the tattoo before applying any ink to skin as a means to avoid litigation. Based upon the party seeking ownership, the steps used to declare one's exclusive copyright in the tattoo may differ.

Because of prior litigation, and the nature of the legal opinions fostered by these cases, the initial belief is that rights are immediately bestowed upon tattoo artists the minute the tattoo dries on the recipient's skin. As a result, the only extra step that an artist must take to further protect their exclusive rights through litigation is to acquire copyright registrations for their artwork. Copyright registration is not required to establish rights in a work, but it is a necessary component for artists who seek to initiate a copyright infringement suit against any alleged infringers. Therefore, in order to avoid a lawsuit from an artist who subsequently files a copyright registration in his artwork, the recipient should seek a transfer of right in the copyright creation *prior* to the ink drying on the recipient's body. Generally speaking, any written contract must clearly state that ownership was properly transferred or assigned from the artist to the individual.<sup>88</sup> A work made for hire contract, a joint ownership agreement, or a licensing agreement that removes the artist's exclusive rights in the tattoo by fully, or partially, granting same to the customer, are all viable options one can execute to disavow any potential for liability. To hurdle the obstacles typical to characterizing a tattoo as a work made for hire, the customer should name and identify themselves as the "employer for hire of [the tattooist's name]."<sup>89</sup> This statement would render a tattooist an employee of the recipient for the purposes of designing and applying the tattoo; it would also serve to define an artist's actions on behalf of the client as falling within the scope of their employment. For a joint authorship agreement, the contract should highlight the recipient's contributions to the design, and showcase the clear in-

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88. See Christopher A. Harkins, *Tattoos and Copyright Infringement: Celebrities, Marketers, and Businesses Beware of the Ink*, 10 LEWIS & CLARK L. REV. 313, 328 (2006) (stating that to ensure that ownership has been transferred, contract should use "copyright" and state that all "ownership" in tattoo and any drawing, sketch, and other work that becomes or incorporates tattoo "vests in, belongs to, and is transferred in whole to the customer").

89. *Id.* at 330 (giving example of how to register tattoo).

tent to make the recipient a joint author. In the event the tattoo was completed months, or even years ago, and the athlete does not remember who designed and completed the artwork, the U.S. Copyright office may be a resource for information regarding the particular tattoo artist or where that artist works, if a copyright registration was filed.<sup>90</sup> Through this route, the recipient may still procure a transfer of copyright ownership after already receiving the tattoo.

Tattoo artists should consider a number of factors if they are amenable to relinquishing or transferring their rights in a tattoo for a limited purpose. For the tattooist who agrees to release any and all rights to the design, an extra fee on top of the cost of the tattoo may be added to compensate the artist for his loss of exclusivity. However, this requires the artist to make an on-the-spot evaluation of how much the design should be worth. Factors the artist may consider include: (1) does the tattoo have any marketing potential, i.e. is it a unique design that will most likely attract attention from endorsers looking to make that artwork a part of the celebrity's marketing campaign; (2) the degree of famousness of the person the tattoo is being designed for, i.e. should a tattoo being designed for a A-list celebrity cost more money simply because the person, and therefore the tattoo, is more likely to be in the spotlight; and (3) the location of the tattoo in relation to the recipient's celebrity, i.e. should a tattoo inked on Michael Phelps' chest cost more than the same one placed on Kevin Durant's, simply because Phelps is more prone to do advertisements and endorsements shirtless because he is a swimmer? While the utilization of such factors may prove instructive to the artist in determining how much money should be added on top of his normal fee, it may prove unwieldy to those seeking the tattoo. Athletes may not be receptive to being treated differently, especially if such treatment will cost them extra dollars from their pockets. Chris Escebedo, the tattoo artist suing THQ for its use of the Lion Tattoo he inked on an MMA fighter in its video game *UFC Undisputed*, stated "he would charge from \$50,000 to \$200,000 to sign away his copyright to an NFL Player."<sup>91</sup> Furthermore, if the artist were to make an inaccurate assessment, the mistake could potentially cost the artist much more revenue than what he anticipated in his initial calculation.

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90. See Olenick, *supra* note 53.

91. Ira Boudway, *Hey, Pro Athletes: Your Tattoo Is Going to Get You Sued*, BUS. WK. (Sept. 4, 2013), <http://www.businessweek.com/articles/2013-09-04/hey-pro-athletes-your-tattooed-arms-are-going-to-get-you-sued> (explaining inevitability of athletes being sued by tattoo artists).



If a tattooist decides instead to license the art of the tattoo, all exclusive rights granted by the Copyright Act would be reserved to the artist; however, the other party to the licensing agreement would have authorization to use the design for marketing, on merchandise, or for any other limited purpose of use explicitly defined in the agreement. The act of licensing would enable artists to ask for a fee independent of the cost to design and apply the tattoo. Because of this, tattooists would be able to make better-informed decisions as to how they would like to be compensated. For example, if an artist allows his or her tattoo design to appear on Nike merchandise for its upcoming line of products, an artist may conduct due diligence and determine the true value of his work based upon how many products will bear the design and how many units Nike plans to sell that incorporate the tattoo.

While these dealings between tattooists and their clients may appear cumbersome as compared to the actual event of getting a tattoo, various professional sports organizations have already begun to institute precautionary measures. During the 2013 NFL preseason, NFL Players Association (NFLPA) officials started advising players to get copyright waivers or licenses from their tattoo artists as a result of Stephen Allen's lawsuit against EA Sports and former NFL running back Ricky Williams for use of a tattoo on *NFL Street* video game covers.<sup>92</sup> As of now, tattoo artists are complying with requests, and there have been no reports of football players having any difficulty obtaining waivers.<sup>93</sup> For the future, it would be wise for other union representatives, such as the National Basketball Players Association and MLB Players Association, to adopt the proactive measures employed by the NFLPA.

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92. *See id.* (describing proactive steps taken by NFLPA).

93. *See id.* (stating athletes have been successful in obtaining releases from tattoo artists).