Foster Garvey

Sports & Entertainment Spotlight

The Ink Isn't Dry

Stephen G. Rickershauser on 4.28.16 | Posted in Sports

Stephen G. Rickershauser, a law student at Brooklyn Law School, is GSB's spring 2016 legal extern working out of its New York office.

What rights based in copyright law does a tattoo artist have in a tattoo itself, and to what extent can an artist use those rights to restrict the rights of others, including the people whose skin has been inked?

In February, Solid Oak Sketches LLC, a company holding the copyrights to eight NBA players' tattoos, sued the videogame makers of NBA 2K16 in the United States District Court for the Southern District of New York. The Complaint alleged that the videogame makers, Take Two Interactive Software Inc., infringed on the company's right to license its copyrights in the tattoo designs when the videogame maker depicted the tattoos in its recent game without the company's permission.[1]

The designs infringed include butterflies on Kobe Bryant's arm and a child's portrait on LeBron James's forearm.[2] Negotiations between the parties were initiated with respect to licenses for featuring the tattoos. Those negotiations, however, apparently fell through when the company asked for $1.1 million dollars for the right to depict the tattoos in the videogame.[3] Take Two proceeded to include them in the game regardless.

In Whitmill v. Warner Brothers Entertainment, S. Victor Whitmill sued Warner Bros. for alleged copyright infringement.[4] The copyright at issue was one in the very recognizable tribal tattoo inked on former heavyweight boxing champion, Mike Tyson's face.[5] Mr. Whitmill alleged that Warner Bros. illegally appropriated Mr. Whitmill's art by placing a virtually identical tattoo on the face of actor Ed Helms in the motion picture, The Hangover 2.[6] The unauthorized exploitation of the tattoo, Mr. Whitmill claimed, constituted copyright infringement. Before the case could be tried on the merits, however, the case was settled for an undisclosed amount.[7]

In Escobedo v. THQ Incorporated, a case more factually similar to the Solid Oak case, plaintiff tattoo artist brought suit against the makers of an Ultimate Fighting Championship (UFC) videogame.[8] The Complaint alleged that the videogame maker infringed the artist's copyright when the videogame makers depicted a lion tattoo on one of the fighters in the game.[9] Indeed, the tattoo is inked on the fighter, Carlos Condit, in real life. Ultimately the case was dismissed for failure to prosecute, and therefore was never decided on the merits.[10] Eventually, the parties settled, and the tattoo artist received $22,500.[11]

Though both cases were not decided on the merits, there is some evidence that the tattoo artists could have succeeded on their claims for copyright infringement if the issue were ultimately adjudicated. The judge in Whitmill, in denying a preliminary injunction against Warner Bros.' release of the movie, stated "plaintiff has a strong likelihood of prevailing on the merits for copyright infringement."[12] The judge believed that "the tattoo itself and the design itself can be copyrighted."[13]

While Whitmill might appear to be good precedent for tattoo artists wishing to protect their copyrights, the case may be able to be distinguished from both Escobedo and Solid Oak. In Whitmill, the tattoo artist and Mike Tyson had a written agreement granting rights in the tattoo to the artist. Moreover, in Whitmill, the infringement claim related to the use of the tattoo on *someone else's* face. In Escobedo and in Solid Oak, the tattoos at issue were not recreated on someone else's face, but rather digitally recreated on the faces of the persons that the tattoos were inked on in real life.

There is little doubt whether a tattoo *design* is copyrightable. If a tattoo artist designs a tattoo on paper (before inking it on any flesh), then according to traditional elements of copyright law (originality + fixed medium), that artist has procured a copyright in that design. Theoretically, following that same logic, a tattoo itself could be copyrightable. Assuming originality in the design, once inked onto a person's flesh, the elements of originality and fixed medium are met. It would follow then, that the unauthorized use of the tattoo may constitute copyright infringement, as eluded to in Whitmill, *unless* the use falls under some exception to copyright infringement.

The problem implicit in granting a copyright interest in a tattoo to a tattoo artist is the burden such right could place on the person permanently inked with the tattoo. Assuming a tattoo is copyrightable, there are three possible concepts a court might recognize to address the problem of the artist's copyright interest in the tattoo: an implied license, the right of publicity and fair use.

A court may find that by tattooing the design on LeBron James, for example, that tattoo artist has granted James an implied license to use the tattoo. An implied license is a license created by law in the absence of an actual agreement between the parties. The purpose of an implied license is to allow the licensee some right to use the copyrighted work but only to the extent that the copyright owner would have allowed had the parties negotiated an agreement.[14] Implied licenses are non-exclusive licenses and do not need to be in writing.[15] For example, if James had to secure permission from the tattoo artist every time he wanted to be in a picture, such restriction would severely limit James' ability to exercise his free will as a person.[16] Therefore, it can be said with some degree of certainty that James has an implied license to use the tattoo in photographs. Whether this reasoning should be extended to the recreation of his image (including his ink) in a videogame is likely a more difficult question for the courts.

The right of publicity, or the right to determine who can use one's name, image or likeness for commercial gain, which is implicated by the celebrity status of NBA players, may also be a factor in tattoo copyright analysis. The court would need to consider whether a tattoo that is permanently fixed onto a player's skin becomes part of his persona, and accordingly becomes intertwined with his right of publicity, and if so, whether it would be reasonable to permit a tattoo artist, as the copyright holder, to restrict that player's right to publicity.

Furthermore, according to the Copyright Act of 1976[17], the videogame maker's accurate depiction of James' and Bryant's tattoos may constitute fair use. The ultimate test of fair use under the Copyright Act is whether the copyright law's goal of promoting the progress of science and useful arts would be better served by allowing the use than by preventing it.[18] Accordingly, fair use permits reproduction of copyrighted work without the copyright owner's consent for purposes such as criticism, comment... scholarship, or research.[19] The list is not exhaustive but merely illustrates the types of copying typically embraced by fair use.[20] Four statutory factors guide courts' application of the fair use doctrine. Specifically, courts look to: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.[21] The court would need to weigh these factors and determine whether the benefit to art and science outweighs the commercial nature and any likely effect on the tattoo artist's market. Because fair use is an "equitable rule of reason," courts are free to adapt the doctrine to particular situations on a case-by-case basis, including as applied to videogame and movie contexts.[22]

If the Solid Oak case gets decided on the merits, the court will have to decide whether any of the above considerations allow the videogame maker to depict the tattoos on the NBA players in the videogame. However, the ink on this case isn't dry yet.

In practice, it would be prudent for tattoo recipients to get a written acknowledgement from the artist that the artist created the tattoo on a work for hire basis such that it is owned by the recipient. At the very least, the recipient should demand the grant of a license, in writing, to use and potentially sublicense the rights in the tattoo. On the other hand, tattoo artists may want to have their clients sign releases acknowledging the artist's copyright interest in the work, as was the case with Mike Tyson and his tattoo artist. Having such agreements in place will protect the rights of both tattoo artists and recipients while tattoo copyright law remains unclear.

[1] Complaint at 1, Solid Oak Sketches, LLC, v. Visual Concepts, LLC, No. 1:16-cv-00724 (S.D.N.Y. Feb. 1, 2016).

[2] Eriq Gardner, *'NBA 2K' Videogame Maker Sued for Copyright Infringement Over LeBron James' Tattoos*, The Hollywood Reporter (February 1, 2016, 2:25 PM), http://www.hollywoodreporter.com/thr-esq/nba-2k-videogame-maker-sued-861131.

[3] *Id.*

[4] Complaint, Whitmill v. Warner Brothers Ent., No. 4:11-cv-752, (E.D. Mo. April 28, 2011).

[5] *Id.*

[6] *Id.* at 3.

[7] Matthew Belloni, *Warner Bros. Settles 'Hangover II' Tattoo Lawsuit*, The Hollywood Reporter (June 20, 2011, 1:39 PM), http://www.hollywoodreporter.com/thr-esq/warner-bros-settles-hangover-ii-203377.

[8] Complaint, Escobedo v. THQ Inc., No. 2:12-cv-02470, (D. Ariz. November 16, 2012).

[9] *Id* at 2.

[10] *Id.*

[11] Gardner *supra* note 2.

[12] Hearing on Motion for Preliminary Injunction, Whitmill v. Warner Brothers Ent., No. 4:11-cv-752, (E.D. Mo. April 28, 2011).

[13] *Id.* at 3.

[14] *Copyright Licenses and Assignments*, BitLaw, (April 19, 2016), http://www.bitlaw.com/copyright/license.html

[15] *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990).

[16] Notably, Mike Tyson himself was featured in the Hangover movie franchise, yet in Whitmill there was no claim that depicting *his* face with the tattoo constituted infringement on the part of Warner Bros.

[17] U.S. Const., art. I, § 8, cl. 8.

[18] *Capitol Records, LLC v. ReDigi Inc.*, 934 F. Supp. 2d 640 (S.D.N.Y. 2013)

[19] 17 U.S.C.S. § 107

[20] *Capitol Records,* 934 F. Supp 2d at 653.

[21] 17 U.S.C.S. § 107.

[22] *Capitol Records,* 934 F. Supp 2d at 653.

Tags: Copyright Act of 1976, copyright holder, copyright infringement, copyright law, fair use, implied license, NBA players' tattoos, releases, Southern District of New York, sublicense, tattoo artist, tattoo artist designs, tattoo copyright analysis, the right of publicity, United States District Court