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Copyright Ownership and the Need for Implied Licenses in the Realm of Tattoos

Kyle Alan Ulscht

This article argues that there is a need for an implied license to be issued when an individual is tattooed. In spite of a rich history spanning millennia, the legal community has not come up with an adequate system of determining copyright ownership in affixed tattoos. Complicating this lack of certainty in the field of copyright rights in tattoos is the general unwillingness of courts to invoke the de minimus use exception in cases of copyright violation. This unwillingness coupled with the ubiquitous nature of technology and social media could lead virtually every tattooed person to be held to be an infringer and prevent them from a variety of activities ranging from appearing in advertisements, or movies, to more common activities such as posting photos on Facebook, without a complicated trial or trail of paperwork and accounting. Fortunately courts, relying on theories of equity, have invented the concept of implied licenses for instances when a party commissions a work but does not meet the more formal requirements to own the copyright rights of that work. In such instances, to prevent injustice, courts have held that while the creator retains rights in the commissioned work, the commissioner has an implied license to use the commissioned work in certain circumstances. This paper argues that: tattoos are copyrightable; that often times the tattooed individual is not the sole owner of that copyright; and that current trends in the tattoo community are leading to egregious abuses of copyright law which call for the issuances of implied non-exclusive licenses to those with newly applied tattoos. The solution, if implemented, would allow an individual an implied license to all rights under copyright law and the ability to do as they wished with their body and the ink placed on it: display it in photographs; videos; or even recreate it artistically, while leaving the rights to other uses of the image to the original owner, untouched.

II. Tattoos: In Society and in Practice

Tattoos have a history spanning thousands of years and dozens of cultures; from prisoners to presidents, yet in all that time no set standard for regulating intellectual property ownership in them has arisen. That is not to say that no proposal exists for how to treat tattoos under copyright law, just that no standard has been officially adopted, as thus far, all cases on the matter have been settled before a holding has been issued. Using precedent from more general issues in copyright law, however, can give us a basis of how a court would decide such issues.

A. Tradition to Modern Day

As of 2012, 24% of Americans still believe that those with tattoos are more likely to engage in deviant behavior, while a similar percentage believes those with tattoos are less intelligent, healthy, and spiritual; despite this misconception, tattoos actually play an important role in many cultures.¹ Despite these beliefs, tattooing as an “[a]rt is attested in almost every culture worldwide,” with evidence suggesting that tattooing was being practiced in Predynastic and Early Dynastic Egypt as early as 4,5000 BC.² The earliest surviving examples of tattoos, found on Ötzi the Iceman, date back to 3,330 BC coming from an area between modern day Austria and Italy, and were believed to be an early form of acupuncture.³ In other areas of the world, such as Samoa, tattoos or Pe’a, have great cultural significance and were linked to a boy’s transition into manhood, his high social status, eligibility for marriage, and his courage.⁴ In fact, lack of a tattoo or an unfinished tattoo can be considered a mark of shame.⁵ In Japan, tattooing, known as the art of irezumi, was practiced for spiritual and decorative purposes, and sometimes

¹ Samantha Braverman, *One in Five U.S. Adults Now Has a Tattoo*, HARRIS INTERACTIVE 1(Feb 23, 2012), http://www.harrisinteractive.com/vault/Harris%20Poll%2022%20-Tattoos_2.23.12.pdf.

² 30 THE DICTIONARY OF ART 366 (Jane Turner ed., 1996).

³ KATHLYN GAY & CHRISTINE WHITTINGTON, BODY MARKS: TATTOOING, PIERCING, AND SCARIFICATION 20-21 (2002).

⁴ BRIJ V. LAL & KATE FORTUNE, THE PACIFIC ISLANDS: AN ENCYCLOPEDIA 492 (2000).

⁵ MARGO DEMELLO, ENCYCLOPEDIA OF BODY ADORNMENT 213(2007).

covered an individual's entire back.⁶ The cultural importance of tattoos isn't limited to the past or to foreign countries either.

America, too, has a rich cultural history of tattoos. Dating as far back as the Civil War, American military personnel including the Army, Navy, and the Marines were getting tattoos as a sign of their patriotism.⁷ Often called "pledge" tattoos, they consisted of a soldier's unit, military division, and a bald eagle.⁸ In the realm of politics, Sen. Barry Goldwater, former Secretary of State George Shultz, Representative Jesse Jackson Jr., and Representative Mary Bono have all admitted to having tattoos, and even President Theodore Roosevelt was said to have his family crest tattooed on his chest.⁹ Another American institution, prisons, is also responsible for the proliferation of tattoos in the modern era.¹⁰

While the popularity and acceptability of tattoos has waned from time to time, they seem to be here to stay. In 1986, *The Wall Street Journal* was reporting on tattoos as a legitimate art form.¹¹ By the 1990's, tattoos had "achieved mainstream popularity," no longer relegated to members of the counter culture, some tattoo artists were reporting that their client list "on any given day might be students, professionals, even senior citizens,"¹² while others noted the prevalence of "lawyers, accountants and homemakers."¹³

Pertinent to this paper, tattoos are becoming ubiquitous in the realms of pop-culture and mainstream society. *Sports Illustrated* noted that "[t]attoos have become the sport's world's most

⁶ DENNIS E. DWYER, GOD, COUNTRY AND TATTOOS: A CRY FOR FREEDOM 220 (2011).

⁷ DeMello, *supra* note 5, at 188.

⁸ Dwyer, *supra* note 6, at 99.

⁹ Jilian Fama, *Tattooed U.S. Politicians*, ABC NEWS BLOGS POLITICS (Sep. 26, 2012, 4:29 PM), <http://abcnews.go.com/blogs/politics/2012/09/tattooed-u-s-politicians/>

¹⁰ Gay & Whittington, *supra* note 3, at 45-47.

¹¹ Hoag Levins, *The Changing Cultural State of the Tattoo Arts In America: A Report*, TATTOOARTIST.COM (1997) <http://www.tattooartist.com/historyhtml> (citing Ed Ward, *Skin Pix: New Breed of Tattoo Artists Makes Its Mark*, THE WALL ST. J., April 8, 1986, at 28).

¹² Levins, *supra* note 11 (citing Maria Puente, *Teens' Tattoos Getting Under Parents' Skin*, USA TODAY, March 24, 1997, at 11A).

¹³ Levins, *supra* note 11 (citing Ellie Linger, *Bodies of Art*, PALM BEACH POST, Nov. 6, 1997, at 16E).

flaunted form of self-expression. Ten years ago, only boxers or wrestlers had visible tattoos; today, they are everywhere, in every sport.”¹⁴ Giving credence to that statement, a 1995 report revealed that 35.1% of NBA players had at least one tattoo.¹⁵ By 2003 that number had climbed to more than 70%, a number that seems to remain fairly accurate in 2013.¹⁶ While rosters change more frequently in the UFC, a quick perusal of the top ten fighters (as of October 2013) shows that only one, Anderson Silva, has no visible tattoos.¹⁷ Similarly, of the nine different UFC champions, all have tattoos.¹⁸ On a broader level, a 2012 poll shows that 21% of American adults have at least one tattoo, a number that jumps to 38% if you look at those 30-39.¹⁹

Cases have already arisen where artist have sued their clients for appearing in video games and violating their exclusive rights of reproduction, and the right of display, so it isn’t hard to envision a scenario where a tattoo artist sues their client for appearing in an ad as a model, or even for posting pictures of their tattoo on Facebook.²⁰ As tattoos become more ubiquitous, the need for a solution on how to treat copyright in tattoos is becoming even greater.

B. Implied Licenses

In order to combat this potentially growing problem, the law should assume that upon tattooing an individual, a tattoo artist is granting that individual an implied license to use that tattoo and the underlying design within that tattoo, in a limited number of ways. Perhaps the most well-known instance of the implied license being used in the context of copyright comes

¹⁴ Levins, *supra* note 11 (citing Leigh Montville, *Skins Game: Athletes' Tattoos*, SPORTS ILLUSTRATED, Nov. 6, 1995, at 90).

¹⁵ Levins, *supra* note 11 (citing Sandra McKee, *Mark of an Athlete*, THE BALTIMORE SUN, Dec. 3, 1997, at 1D).

¹⁶ Chris Tomasson, *Wade One of Few NBA Players without Tattoos*, FOX SPORTS FL. (February 14, 2012, 12:18 PM) http://www.foxsportsflorida.com/02/14/12/Wade-one-of-few-NBA-players-without-tatt/landing_heat.html?blockID=665790 (citing ANDREW GOTTLIEB, IN THE PAINT: TATTOOS OF THE NBA AND THE STORIES BEHIND THEM (2003)).

¹⁷ *UFC Fighter Rankings*, UFC.COM, <http://www.ufc.com/rankings> (last visited Oct. 16, 2013).

¹⁸ *Id.*

¹⁹ Braverman, *supra* note 1, at 1.

²⁰ Complaint at 3, *Escobedo v. THQ Inc.*, No. 2:12-cv-02470-JAT (D. Ariz. filed Nov. 16, 2012). (Describing how tattooed individual’s appearance in a video game violated tattoo artist’s right of reproduction in the tattooed image).

from the case of *Effects Associates, Inc. v. Cohen*.²¹ In *Effects*, a movie director, hired a company to produce special effects for his film, however never acquired ownership of the footage through a written assignment of the copyright rights as required by 17 U.S.C. §204(a).²² In order to avoid an inequitable result, the court held that §204(a) only applies to the granting of exclusive licenses, such as where Cohen had exclusive rights to use the footage, but that the granting of a non-exclusive license did not fall under §204(a) and thus did not require any written documentation of the transfer.²³ As a result Cohen had the ability to use the footage as he saw fit without accounting to Effects for profits, but Effects would retain the ability to sell or license non-exclusive rights.²⁴ Applying this case law to the application of tattoos would allow tattoo artists to continue to profit from their work, both through applying tattoos and licensing the underlying image, without interfering with an individual's ability to market their likeness. Those who oppose granting implied licenses to the tattooed argue that: tattoos are not copyrightable; that if copyrightable a client would own at least a partial interest in the tattoo and thus would not need a license; and that involving the law in the tattoo community is contrary to the preferred norms of that industry. However, current legal trends suggest that: tattoos are copyrightable; that even if a client holds a joint interest in the tattoo problems will arise; and that avoiding the legal community is no longer the preferred norm of the tattoo community.

C. Application

While papers have previously explored copyright protection in tattoos, few have explained how tattoos are applied, an explanation that would aid debate.²⁵ Clients wishing to be

²¹ 908 F.2d 555 (9th Cir. 1990).

²² *Id.* at 555-556.

²³ *Id.* at 558.

²⁴ *Id.* at 559.

²⁵ See Timothy C. Bradley, *The Copyright Implications of Tattoos: Why Getting Inked Can Get You into Court*, 29 ENT. & SPORTS L. 1, 27 (2011); Meredith Hatic, *Who Owns Your Body Art?: The Copyright and Constitutional Implications of Tattoos*, 23 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 396 (2012); Christopher A. Harkins,

tattooed often bring in photographs or drawings as reference for the tattoo artist to either create a new drawing or to copy exactly.²⁶ Other clients pick pre-designed “flash art” out of binders or wall displays, others still simply present an idea to their artist and allow them to design an image from scratch.²⁷ If the design doesn’t already exist as flash art and if it hasn’t already been drawn by the customer or a third party, the chosen design will be drawn by the tattoo artist who will then scan the image into a thermal-fax which will print out transfer paper with the chosen design on it.²⁸ While the transfer paper will not contain any of the coloring or finer shading related details that may later be found in the tattoo, it should contain all the major line work and detail that will be found in the final design. From here, the artist will dampen the skin, apply the transfer, and tattoo over the mark left by the transfer.²⁹

II. Copyright Ownership in Tattoo

A. Are Tattoos Copyrightable?

One of the arguments against offering those with tattoos an implied license to use the image, is that tattoos are not copyrightable and that by instituting such a policy you would be legitimizing the idea that they can be copyrighted. While there are arguments for why tattoos should not be copyrighted, general principles of copyright law as well as some recent actions of the legal community seem to suggest that tattoos are copyrightable and both the legal community and that tattoo community need to adapt to that reality through the issuance of implied licenses.

Although the standards are seemingly low, in order for copyright to attach to a work, certain criteria must be met. The work must first fit into one of the protected categories

Tattoos and Copyright Infringement: Celebrities, Marketers, and Businesses Beware of the Ink, 10 LEWIS & CLARK L. REV. 313 (2006).

²⁶ Matthew Beasley, *Who Owns Your Skin: Intellectual Property Law and Norms Among Tattoo Artists*, 85 S. CAL. L. REV. 1137, 1162 (2012).

²⁷ *Id.*

²⁸ RUPERT E. JENNINGS, CHOOSING THE RIGHT TATTOO 108-109 (2012).

²⁹ *Id.* at 109-110

enumerated in the Copyright Act.³⁰ If the work does fit within one of the categories, then it must also be original and fixed in a tangible medium.³¹ The first requirement is easily satisfied. While tattoos are placed on a person's skin instead of on paper and are drawn with needles instead of pens or pencils, they all at some point spend time as sketches on a tattoo artist's transfer paper. Thus there is no discernible reason to treat tattoos any differently under copyright law than any other drawing. As such, of the eight categories described under section 102(a) of the Copyright Act, tattoos, and the initial designs they are based on, clearly fall under Subsection 5; "pictorial, graphic, and sculptural works."³² The originality requirement is broken into two parts; independent creation and creativity.³³ Independent creation means only that the work was created by the author without copying from other works either purposefully or subconsciously.³⁴ The second prong of originality, according to the Supreme Court, is "extremely low" and only requires a "modicum of creativity."³⁵

While none of these requirements disqualify tattoos from copyright protection per se, they do disqualify many individual tattoos. Primarily the types of individual tattoos which would not be copyrightable under the above standard would be those based off of material in the public domain or those created by infringing on another's copyright. This paper, however, is only concerned with those tattoos which are copyrightable.

The question of whether or not tattoos are "fixed in a tangible medium of expression" has fostered a little more debate, but ultimately it seems they are.³⁶ In order to be fixed, a work must

³⁰ 17 U.S.C. § 102(a) (2006).

³¹ *Id.*

³² *Id.*

³³ *Feist Publ'n, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991).

³⁴ *Id.*; *see ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988, 998, 999 (2d Cir. 1983) (finding subconscious copying).

³⁵ *Feist Publ'n*, 499 U.S. at 345, 346.

³⁶ *See Christine Lesicko, Tattoos as Visual Art: How Body Art Fits into Visual Artists Rights Act*, 53 IDEA: THE INTEL. PROP. L.J. 39 (2013) (describing applicability of copyright law to tattoos); *see also infra* Part II.A.

be “sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”³⁷ According to the renowned copyright expert David Nimmer in a note in the 1985-1999 editions of his widely cited treatise, *Nimmer on Copyright*, “a tattoo may presumably qualify as a work of graphic art, regardless of the medium in which it is designed to be affixed (in this instance, human flesh).”³⁸ However, in 2001, Nimmer revised his opinion, positing that the human body did not qualify as a fixed medium of expression, and thus that “a body, even as augmented, simply is not subject to copyright protection.”³⁹ If Nimmer is correct, what he is saying is not only are images not copyrighted by placement of ink on one’s skin, but also that a tattoo could not infringe even if directly copied without authorization from previously copyright material.⁴⁰ Essentially, anytime art is placed on the human body, the laws of copyright do not come into play.

Nimmer was able to further elaborate on this opinion in 2011, when he offered to testify as an expert in the case of *Whitmill v. Warner Bros. Entm’t, Inc.*⁴¹ The impetus in that case was Warner Brother’s recreation of a tribal tattoo, originally designed by tattoo artist S. Victor Whitmill and placed on Mike Tyson’s face, on actor Ed Helm’s face for his role in *The Hangover Part II* which Whitmall felt constituted infringement.⁴² In his testimony on behalf of Warner Brothers, Nimmer proffered that, like drawing with frost on a cold window or writing in wet sand, the tribal tattoo on Mike Tyson’s face was not placed on a “fixed medium” and thus

³⁷ 17 U.S.C. § 101 (2006).

³⁸ NIMMER ON COPYRIGHT § 1.01[B][1][i] n.392 (1999). Nimmer has since revised his treatise.

³⁹ David Nimmer, *Copyright in the Dead Sea Scrolls: Originality and Authorship*, 38 HOUS. L. REV. 1, 29-30, 209 (2001) [hereinafter Nimmer Scrolls].

⁴⁰ Declaration of David Nimmer at 14, 17, *Whitmill v. Warner Bros. Entm’t, Inc.*, No. 4:11-cv-00752 (E.D. Mo. May 20, 2011) [hereinafter Nimmer Declaration].

⁴¹ No. 4:11-cv-00752 (E.D. Mo. May 20, 2011).

⁴² Verified Complaint for Injunctive and Other Relief at 1-2, *Whitmill v. Warner Bros Entm’t Inc.*, No. 4:11-cv-752 (E.D. Mo. Dismissed June 6, 2011).

not copyrightable.⁴³ The legislative history of the Copyright Act provides more guidance than Nimmer's source-less guess and have stated that to be considered fixed, a work must exist for more than a "transitory duration," meaning works which are captured only "momentarily" or are "purely evanescent or transient", such as writing in frost, do not receive copyright protection.⁴⁴

Looking at how the issue has been dealt with in other areas of the law bolsters the idea that the bar for "fixed duration" isn't as high as Nimmer suggests. In 1974, Congress created the National Commission on New Technological Uses of Copyrighted Works to study ways copyright law to deal with the problems of new technologies and based on the Commission's findings, some courts have held that "[t]ransitory duration" is a relative term that must be interpreted and applied in context."⁴⁵ In fact, at one point, the Copyright Office even stated that if a work was capable of being copied from a medium for any amount of time, then it was to be considered "fixed."⁴⁶ Of course that contradicts some of the language in the legislative history of the Copyright Act, but does demonstrate the Copyright Office's preference for finding fixation.⁴⁷ Courts, too, seem to have that preference; as one Court held that that a program that was only stored in computer's RAM until a computer was shutoff was "sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated" and as a result was "fixed."⁴⁸ If the *Triad* Court is right and "transitory" is a relative term, then when dealing with the human body, tattoos would seem to be relatively permanent when compared to other markings such as cuts, bruises, dirt, paint or pen, and thus would seemingly meet the low standard of fixation.

⁴³ Nimmer Declaration *supra* note 40, at 4, 5.

⁴⁴ H.R. Rep. No. 94-1476, 2d Sess. at 52-53 (1976).

⁴⁵ *Triad Sys. Corp. v. Se. Exp. Co.*, C 92 1539-FMS, 1994 WL 446049 (N.D. Cal. Mar. 18, 1994) *aff'd in part, rev'd in part*, 64 F.3d 1330 (9th Cir. 1995) (citing NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS, FINAL REPORT ON THE NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS (1979)).

⁴⁶ *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121, 129 (2d Cir. 2008).

⁴⁷ *Id.*

⁴⁸ *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 518 (9th Cir. 1993).

In addition to the legal argument presented above which suggests that tattoos could meet the standard of fixed, common sense dictates that to call tattoos “transitory” is certainly a stretch. Tattoos, which can last for the life of an individual with proper care, certainly do not qualify as “transient.” Estimates suggest that of the 40 million Americans with tattoos, at least 17% are looking to have one removed and they are paying an average of \$1,600 a tattoo to do so.⁴⁹ The process of completely removing a single tattoo can take roughly one year.⁵⁰ According to the American Society for Dermatologic Surgery, in 2010 alone, ASDS doctors performed nearly 86,000 removals, a number that jumped to almost 100,000 in 2011.⁵¹ During that same year, tattoo removal practitioners brought in \$65.6 million in revenue.⁵² When people are paying thousands of dollars to erase a work from their body, it is hard to credibly call tattoos “transitory” in the same vein as writing on a frosted window.

Nimmer also argued that the human body is a “useful article” and that useful articles are only copyrightable to the extent that the design “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article” thus a tattoo, such as the one on Mike Tyson’s face, was not copyrightable.⁵³ However, on this point Nimmer misleadingly cited the 1985 case of *Carol Barnhart Inc. v. Economy Cover Corp.*⁵⁴. Had Nimmer cited the more recent 1987 case of *Brandir International, Inc. v. Cascade Pacific Lumber Co.*⁵⁵ he would have found that a court would likely find that by “applying the standard

⁴⁹ Hilary Kramer, *Tattoo Removal: A Bigger Business than Tattooing*, HUFFINGTON POST BUSINESS (Feb. 24, 2010), http://www.huffingtonpost.com/hilary-kramer/tattoo-removal-a-bigger-b_b_474675.html.

⁵⁰ *Id.*

⁵¹ *Unwanted Tattoos* AMERICAN SOCIETY FOR DERMATOLOGIC SURGERY. <http://www.asds.net/TattooRemovalInformation.aspx> (last visited Oct. 16, 2013).

⁵² Bill Gillette, *Business Booms for Tattoo Removers, Analysts Say*, COSMETIC SURGERY TIMES (Feb 9, 2012), <http://cosmeticsurgerytimes.modernmedicine.com/cosmetic-surgery-times/news/modernmedicine/modern-medicine-news/business-booms-tattoo-removers-analy#sthash.zo912HjD.dpuf>

⁵³ Nimmer Declaration *supra* note 40, at 8 citing 17 U.S.C. § 101.

⁵⁴ 773 F.2d 411 (2d Cir. 1985).

⁵⁵ 834 F.2d 1142 (2d Cir. 1987).

test for separability, Tyson’s tattoo is easily divorced from his skin as a conceptual matter.”⁵⁶

The actual pictorial design of any tattoo could easily be applied to any other canvas, and thus would be “separable” from the body itself. As a result this utility argument holds little weight.

Nimmer’s last argument against extending copyright protection to tattoos stems from the Thirteenth Amendment. According to Nimmer, if a tattoo artist is allowed to hold copyright in an individual’s tattoo, they would also then have the ability to: prevent the tattooed individual from publicly displaying the tattoo; reproducing it in photographs; or if the individual created a derivative work by adding to the tattoo, force the individual to have the tattoo removed.⁵⁷ To give a tattoo artist this level of control over an individual would, to Nimmer, violate the “constitutional prohibition on involuntary servitude and other badges of slavery”.⁵⁸ Although patent law differs from copyright law in many respects, as the patent law statute calls for destruction of infringing goods as a potential remedy, this same thirteenth amendment argument could easily be used to deny patents to surgically implanted medical devices or prosthetics such as hip, knee, or heart valve replacements.⁵⁹ The fact that the Patent and Trademark Office has issued patents to replacement hips and heart valves and that courts have found patents for medical implants valid, seems to suggest that courts would similarly reject the Thirteenth Amendment argument in the copyright context.⁶⁰ It seems highly unlikely that in the case of an already surgically implanted knee replacement or an applied tattoo, that a court would require

⁵⁶ Aaron Perzanowski, *Tattoos & IP Norms*, 98 MINN. L. REV. 511, 529 (2013).

⁵⁷ See Nimmer Declaration *supra* note 40, at 11, 12.

⁵⁸ Nimmer Scrolls, *supra* note 39, at 209.

⁵⁹ 15 U.S.C.A. § 1118 (West 2013).

⁶⁰ See U.S. Patent No. 4,983,183 (filed Sep 21, 1989) (issued Jan. 8, 1991) (describing patent on a hip prosthesis or replacement hip); see also U.S. Patent No. 2,583,640 (filed Feb. 15, 2007) (issued July 17, 2013) (describing patent on heart valve replacement component); *Ramos v. Biomet, Inc.*, 828 F. Supp. 1570 (S.D. Fla. 1993) *aff’d in part, rev’d in part on other grounds*, 69 F.3d 553 (Fed. Cir. 1995) (holding patent for hip replacement valid and infringed).

destruction of the infringing article; a knee replacement removed or a tattoo lasered off. More likely, the court would seek an equitable remedy, like a forced license or damages.⁶¹

While these arguments are certainly interesting, the responses they have gotten from the courts and the Copyright Office have all but confirmed that tattoos are, in fact, subject to copyright. In the case Nimmer was testifying, *Whitmill v. Warner Bros. Entm't, Inc.*, the tattoo artist suing for infringement had been granted a certificate of U.S. Copyright Registration.⁶² The certificate, which was issued on April 19, 2011, lists the “author” of the work as Victor Whitmill doing business as Paradox-Studio of Dermagraphics, and the date of publication was listed as the date the tattoo was applied, February 10, 2003.⁶³ In order to issue such a certificate, the Register of Copyrights in the US Copyright office must determine that the work “constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met.”⁶⁴ While these certificates can be invalidated if challenged, they do constitute prima facie evidence of validity of the copyright if registered within five years after the first publication of the work.⁶⁵ The evidentiary weight given to a certificate of registration made after that five year period, as was the case in *Whitmill*, is within the discretion of the court.⁶⁶

Whitmill’s copyright registration wasn’t the first such certificate issued to a tattoo either. In 2004, Christina Juliani, known in the modeling world as Suicide Girl Amina Munster, received a tattoo on her chest from artist Tim Kern.⁶⁷ Less than a year after receiving her tattoo Juliani received notice another artist had duplicated her tattoo, although she never filed suit over the infringing tattoo, she did file for copyright registration for both the tattoo as applied on her

⁶¹ See 17 U.S.C. §§ 901-914 (1988) (providing compulsory licenses for innocent infringers of semiconductor chips).

⁶² TRIBAL TATTOO, U.S. Copyright Registration No. VA 1-767-704.

⁶³ *Id.*

⁶⁴ 17 U.S.C.A. § 410(a) (West 2013).

⁶⁵ *Id.* § 410(c).

⁶⁶ *Id.*

⁶⁷ Amina Munster, *Tattoos and Copyright*, TATTOODLES (March 31, 2006), <http://www.tattooables.com/magazine/editorial/147/>.

body and the original drawing used to create the tattoo.⁶⁸ On October 4, the US Copyright Office issued Copyright Registrations for both of those works.⁶⁹

The Court in the *Whitmill* case seemed to agree with the US Copyright Office. Responding to Nimmer's offered testimony, Judge Catherine Perry, blocked Nimmer from testifying on the basis that his aforementioned thoughts were not only "just silly," but they were also not expert testimony on the current state of copyright law, but rather his opinion "on what copyright law should be."⁷⁰ Although according to press "the judge conceded, she should have enjoined the studio from releasing the film," Judge Perry ultimately denied Whitmill's request for an injunction against the release of the movie.⁷¹ The reasoning behind such a ruling was a finding that an injunction was not in the "public interest" as it would unduly prejudice Warner Brother's \$80 million investment in the film, and cause financial harm to "thousands of other business people in the country," all the while doing relatively little harm to Whitmill that couldn't be remedied through an award of damages.⁷² Despite not issuing the injunction, Judge Perry stated in court, that if she looks "at the likelihood of success on the merits, I think plaintiff has a strong likelihood of prevailing on the merits of copyright infringement."⁷³ Attempting to put the discussion to rest while speaking from the bench, Perry capped off the hearing by stating:

Of course tattoos can be copyrighted, I don't think there is any reasonable dispute about that. They are not copyrighting Mr.

⁶⁸ *Id.*

⁶⁹ DEAD MEN TELL NO TALES: AMINA MUNSTER TATTOO, U.S. Copyright Registration No. VAu 000-687-365; DEAD MEN TELL NO TALES: AMINA MUNSTER DRAWING, U.S. Copyright Registration No. VAu 000-687-366.

⁷⁰ David Kravets, *Hangover Tattoo Lawsuit: Can You Copyright Flesh*, WIRED (May 27, 2011), <http://www.wired.com/threatlevel/2011/05/human-flesh-copyright/>

⁷¹ Noam Cohen, *Citing Public Interest, Judge Rules for 'Hangover II'*, NEW YORK TIMES BLOG (May 24, 2011, 4:05 PM), http://mediadecoder.blogs.nytimes.com/2011/05/24/citing-public-interest-judge-rules-for-hangover-ii/?_r=1 ; Order, *Whitmill v Warner Bros Entm't Inc.*, No. 4:11-cv-752 (E.D. Mo. Dismissed June 6, 2011).

⁷² Cohen, *supra* note 71.

⁷³ Hearing on Motion for Preliminary Injunction at II-3:11-13, *Whitmill v. Warner Bros. Entm't Inc.*, No. 4:11-cv-752 (E.D. Mo. Dismissed June 6, 2011).

Tyson's face, or restricting Mr. Tyson's use of his own face...and I think it's entirely consistent with the copyright law.⁷⁴

Facing not only a loss in the case, but also risking setting permanent precedent, Warner Brothers chose to settle the case out of court and so the case was dismissed with prejudice.⁷⁵ With that statement, Judge Perry joins a host of legal scholars who believe that "it is likely that tattoos would be found to be copyrightable."⁷⁶ As a result, the need for an implied license persists.

B. Who Owns the Ink?

Opponents of issuing implied licenses to those who receive tattoos will rebut, that even if tattoos are copyrightable, that clients will have an ownership stake in the image and thus will not need a license, however it seems that in many cases a client has no ownership interest in their tattoo, and even when they do other issues such as accounting for profits still necessitate the need for an implied license.

When determining who owns the copyright to a work of art one must look at the entire circumstances surrounding its creation. In the case of tattoos, the owner of copyright could be the tattoo artist, the tattooed individual, the owner of the tattoo parlor, a joint work owned by some combination of the three, or in a scenario which is of little interest to this discussion, a third party uninvolved in the transaction. Additionally, the work could be a joint work, a work made for hire, or a derivative work. What type of work the tattoo is defined as controls not only who owns the copyright, but also how long it lasts and how it can be transferred. However, the proposal set forth in this paper are meant to apply to all situations in which full ownership is not vested in the tattooed individual, thus it is simpler to point out only situations where a client is or might be the sole owner of a work, and an exhaustive discussion of ownership is not necessary.

⁷⁴ Cohen, *supra* note 71.

⁷⁵ Hearing, *supra* note 73.

⁷⁶ Lesicko, *supra* note 36, at 46.

i. Non-Copyrightable Tattoos

In many instances, a person choosing a tattoo will be selecting from pre-designed material. Two options arise; the work is in the public domain or the work is protected by copyright. If a work is no longer protected by copyright it enters the public domain meaning anyone is free to use it, however “no individual—not even the creator—may copyright it” unless they contribute a sufficient level of creativity to the pre-existing work.⁷⁷ In these instances, where a tattoo was merely copied from the public domain, no one would own the copyright in that tattoo. With no party owning the copyright in the tattoo, the tattoo cannot later be infringed, and thus the issues discussed later in this article will not arise.

Where a client selects source material which is already protected by copyright and does so without the permission of the copyright owner, the newly created work will constitute infringement and the derivative work will not be protected by copyright.⁷⁸ This type of infringement could involve someone getting their favorite painting, comic book or cartoon character, even song lyrics. Even the flash art books commonly seen at tattoo shops often contain warnings that the works contained within them are copyrighted and that they may not “be copied or reproduced in any manner whatsoever: electronic, mechanical photocopy, recording, etc. without written permission from the author.”⁷⁹ While tattoo shops might lawfully buy this flash art and negotiate licenses to place it on their clients, some within the industry admit that flash “bootlegging” is extremely prevalent.⁸⁰ While this type of infringement certainly raises issues that need to be tackled, these issues are not within the scope of this article.

⁷⁷ *Golan v. Gonzales*, 501 F.3d 1179, 1184 (10th Cir. 2007); see *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, S.D.N.Y.2002, 237 F.Supp.2d 376 vacated 338 F.3d 127 (holding that a rug adapted from two public domain works constituted a derivative work which could receive “thin” copyright protection).

⁷⁸ U.S. Copyright Office Circular 14, *Copyright in Derivative Works and Compilations*, 2 (Oct. 2013).

⁷⁹ Beasley, *supra* note 26, at 1157.

⁸⁰ Ccflash, *Flash Bootlegging*, TATTOODLES (Mar. 31, 2005). <http://www.tattooables.com/magazine/editorial/40/>

Despite the prevalence of infringement, numerous instances still exist where a tattoo will be validly subject to copyright. In these situations, unless a work is a work made for hire or a joint work, the owner of a copyright will be the “author.”⁸¹

ii. Joint and Derivative Works

Assuming a customer isn’t choosing a design based on previously copyrighted material, or material in the public domain, it will be up to either the client or the artist to provide a design for the tattoo. The person who first draws this design will own the copyright in that design, meaning that a client who designs their own tattoo could also own copyright in the finished product. However, there is also the possibility that in applying the tattoo, that a joint or derivative work could be created. Depending on what type of work is ultimately placed on the client’s skin, different complications will arise.

Copyright ownership vests in the author at the time of fixation regardless of whether the work is registered with the Copyright Office.⁸² As outlined earlier, before a tattoo is applied, it is generally placed on transfer paper and at this moment, becomes “fixed.”⁸³ Thus, a tattoo design is already copyrighted before it is placed on a client’s skin. If a client has an idea of what he wants, but not a concrete drawing of it, and the artist creates an image for the client, the artist would be the sole author and owner of that image, although not necessarily the forthcoming tattoo.⁸⁴ On the other hand, if a client comes to an artist with a finished drawing to be transferred to his skin exactly as is, the client would be the sole author and owner of that image, but again not necessarily of the forthcoming tattoo. Sometimes, however, a client “contributes specific ideas about, or rough sketches of, what the tattoo should look like” and then the tattoo artist will

⁸¹ 17 U.S.C. § 106.

⁸² *See, e.g.,* Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 737 (1989).

⁸³ Jennings, *supra* note 28, at 108-109.

⁸⁴ Hatic, *supra* note 25, at 403.

clean up or elaborate on the sketch.⁸⁵ In this instance, the image placed on the transfer paper could be either a joint or derivative work. For the purposes of this paper, our only concern is whether a client designing their own tattoo will result in them being the sole owner of copyright in that design. Such a result could only happen if a client designed their own tattoo.

So the question arises, in instances where a client designed their own tattoo, is transferring copyrighted material from one medium to another enough of a “contribution” to create a derivative work? According to the Ninth Circuit Court of Appeals, “courts and commentators seem to agree that making decisions that enable one to reproduce or transform an already existing work into another medium or dimension—though perhaps quite difficult and intricate decision—is not enough to constitute the contribution of something ‘recognizably [one’s] own’” and thus not enough for the new piece to be considered a “derivative work.”⁸⁶ Similarly, a tattoo artist who merely took a client’s design and applied it, without change, to a client’s body would not have “contributed copyrightable elements” or creativity to the tattoo and would not be given any rights to the work as a “joint author.”⁸⁷ As such, when a client provides an artist with an image to be transferred directly to their skin without alteration, a derivative work would not be created and the tattoo artist would not have an ownership right in the tattoo. In this situation a client could do whatever they pleased with their tattoo with no need to account to the tattoo artist and thus there would be no need for an implied license to protect the client.

It is important to note that even where a work is considered to have “joint authors,” the tattoo artist and client “would be co-owners with equal rights for the purposes of copyright law.”⁸⁸

⁸⁵ *Id.*

⁸⁶ Jordan S Hatcher, *Drawing in Permanent Ink: A Look at Copyright in Tattoos in the United States* 9-10 (May 21, 2010) (unpublished manuscript, available at <http://ssrn.com/abstract=815116> (quoting *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1222 (9th Cir. 1997)).

⁸⁷ Hatcher *supra* note 86, at 10.

⁸⁸ Hatic, *supra* note 25, at 430.

Each party would be able to use or license someone else to use the image, however, they would have to account to the other co-owners for any profits derived from their use or licensing of the image.⁸⁹ Furthermore, as joint authors they would be unable to grant exclusive licenses.⁹⁰

iii. Work Made for Hire

Section 201(b) of the Copyright Act sets forth the statutory requirements for a work to be considered a “work for hire.”⁹¹ Section 101 of the Copyright Act provides for two types of “mutually exclusive” “works for hire;” work made during the course of employment and commissioned works.⁹² In these instances, it is not the person who puts pen to paper or needle to skin who owns the work, but rather the “employer or other person for whom the work was prepared is considered the author...unless the parties have expressly agreed otherwise in a written instrument signed by” both of them.⁹³

a. Works of “Employees”

The first type of “work for hire,” covers those works “prepared by an employee within the scope of his or her employment” which in the case of tattoos could be either the tattoo studio or the client getting the tattoo.⁹⁴ Although an adequate determination of whether or not a tattoo is the work of an “employee” will be fact specific, the topic has been exhaustively covered and the general consensus has been that many of the factors a court would look to “lean towards a tattoo artist being considered an independent contractor instead of an employee.”⁹⁵ Similarly, writers have noted that factors such as “the level of skill involved, the ownership of the artist’s

⁸⁹ *Id.* (citing *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1068 (7th Cir. 1994)).

⁹⁰ *Davis v. Blige*, 505 F.3d 90, 99 (2d Cir. 2007) (restricting the ability of a co-author to license or assign his or her rights to a work without the consent of the work’s other co-authors).

⁹¹ *Cmt. for Creative Non-Violence v. Reid*, 490 U.S. 730, 750-51 (1989); 17 U.S.C. § 201.

⁹² 17 U.S.C. § 101.

⁹³ *Id.* § 201.

⁹⁴ *Id.*

⁹⁵ Lesicko, *supra* note 36, at 48; *see also* Harkins, *supra* note 25, at 325 (describing lack of likelihood that tattoo artists are “employees”); Bradley, *supra* note 25, at 27 (describing how tattoo artist Victor Whitmill was an independent contractor when tattooing Mike Tyson and thus Mike Tyson’s tattoo was not a “work for hire.”)

tools, whether the subject has the right to assign the artist to other projects, and how the parties have structured their relationship for tax and employment law purposes,” make it even less likely that a tattoo artist is an employee of their customer.⁹⁶

b. Tattoos as Collective Works

The second type of “work for hire” is “a work specially ordered or commissioned for use as a contribution to a collective work...if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.”⁹⁷ The statute further defines “collective work” as a work “in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.”⁹⁸ Some have proffered that when an already-tattooed person wants to get a “sleeve” or “chest piece” commissions another individual tattoo, to “fit together to form a larger tattoo, those individual tattoos might be considered...work[s] made for hire.”⁹⁹ However, even those who have suggested this theory have criticized this interpretation of “collective work” as “a stretch” and as “unlikely,” while others have flat-out rejected the proposition.¹⁰⁰ Even if tattoos were defined as “collective works,” the artist and client would still need to sign a written contract agreeing that the work was “made for hire,” something that has similarly been labeled as unlikely.¹⁰¹ Thus, a client would likely have no ownership interest in a tattoo based on it being a “work for hire.”

If, as a general matter, tattoos are not works for hire or joint works, then there are a limited number of circumstances, specifically where a client wishes for a self-created design to be directly transferred to their skin, where a client would own the rights to their own tattoos

⁹⁶ *Supra* note 102.

⁹⁷ 17 U.S.C. § 101.

⁹⁸ *Id.*

⁹⁹ Lesicko, *supra* note 36, at 48-49.

¹⁰⁰ Hatic, *supra* note 25, at, 429; *see also* Lesicko, *supra* note 36, at at 49 (finding that it is unlikely that a tattoo is a “collective work”); Harkins, *supra* note 25 (rejecting the idea that tattoos could be defined as “collective works”).

¹⁰¹ *See* Hatic, *supra* note 25, at 429 (discussing lack of written agreements); Lesicko, *supra* note 36, at 49 (discussing lack of written agreements); Harkins, *supra* note 25 (discussing lack of written agreements).

unencumbered by the rights of their tattoo artist. As such there is a good possibility that the averaged tattooed individual is infringing their tattoo artist copyright on a regular basis, an occurrence that could easily be remedied through the issuance of an implied license to the client upon application of the tattoo.

III. The Problem with Copyright in Tattoos

A. Rights in Copyright

Regardless of whether a work is created on skin or on paper, the Copyright Act will provide the author or authors of a work with a variety of exclusive rights. Unfortunately, those rights have not always adapted with changes in technological or cultural circumstances. Although courts created doctrines, such as the fair use exception, in order to expand the public's access to copyrighted works, those measures have been proving inadequate not only generally, but also as specifically applied to the problem of copyright in tattoos. The lack of such exceptions could lead virtually every tattooed person to be held to be an infringer and prevent them from a variety, of what has become for the average American, everyday activities.

Under the Copyright Act, the author of any work has the exclusive right to: reproduce a work; prepare derivative works; distribute copies of the work; perform the work publicly; and display the work publicly.¹⁰² In terms of tattoos specifically, the right to perform the work publicly would obviously not come into play, however the other four rights certainly would.

The right to publicly display the tattoo would be tempered by the first sale doctrine.¹⁰³ The first sale doctrine states that “the owner of a particular copy lawfully made... is entitled... to display that copy publicly, either directly or by the projection of no more than one image at a

¹⁰² 17 U.S.C. § 101.

¹⁰³ *Id.* § 109.

time, to viewers present at the place where the copy is located.”¹⁰⁴ While the first sale doctrine would protect a tattooed individual who displays their tattoo in a public place like a park or mall, it would not protect transmitting that image through a live video feed or by posting a picture or video to the internet as the image would be displayed at a location where the copy is not located. As a result, an individual taking a picture of their tattoo and uploading it to Facebook or appearing in a YouTube video where their tattoo was being displayed would be a violation of the author’s exclusive right to publicly display the tattoo.

The right to prepare a derivative work and the right of reproduction often times overlap in what they cover. The Copyright Act defines a “derivative work as a work based upon one or more preexisting works” which is then “recast, reformed, or adapted.”¹⁰⁵ These rights would preclude an individual, other than the author or authors of that tattoo, from recreating that tattooed image, or one substantially similar to it, in other mediums. This could include: drawing the image on a sheet of paper; placing the tattoo on an action figure, t-shirt, or another individual; or even capturing the tattoo in a picture or video.¹⁰⁶ Thus in addition to violating the right to publicly display, taking a picture of your tattoo would also violate the author’s right to reproduce the image. Furthermore if a third party were to photograph a tattoo, for instance a member of the paparazzi taking a picture of a celebrity or a cameraman filming an athlete with visible tattoos, they would also be subject to liability for reproducing the author’s work.

Compounding this issue is that fact that some courts have effectively stripped the de minimus use exception of any real value, by holding that the protected image doesn’t have to be

¹⁰⁴ *Id.* § 109(c).

¹⁰⁵ 17 U.S.C. § 101.

¹⁰⁶ *See Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513 (7th Cir. 2009) (discussing how, among other things, photographs of copyrighted material can constitute copyrightable derivative works if prepared with permission of the copyright holder). Such a holding dictates that a photograph of copyrighted material would constitute unauthorized infringing derivative works if prepared without the permission of the author.

prominently featured, in one instance finding infringement where a television show displayed an artist's poster in the background of the television show nine separate times for a total of a mere 26.75 seconds.¹⁰⁷ With such a holding even something as minute as a cameraman catching a baseball player's arm tattoo while at bat could, in theory, lead to liability for the MLB for reproducing and displaying that tattoo without permission from the author.

Thus in any situation where the tattooed individual was not considered one of the tattoo's authors and nonetheless did one of the aforementioned acts they would be violating copyright law. For such violations the tattooed individual could be liable to the creator of the tattoo for either the profits derived from the infringement or for statutory damages ranging from \$200 to \$150,000 for each work infringed which are awarded at the discretion of the court if the image is registered within three months of the infringement.¹⁰⁸ Furthermore, even if the tattooed individual was considered a joint author, they would still be liable to the tattoo artist for a share of any profits acquired as a result of the infringing act.¹⁰⁹ As discussed in the previous section, it is likely that the only instance where a tattooed person would be the sole owner of copyright in their own tattoo would be if they designed it themselves and had their tattoo artist apply it without alteration. Meaning in instances where a celebrity is paid to be in advertisement, movie, or sporting event, they may be required to turn over a portion of their paycheck to their artist.

The tattoo community and those opposed to the issuance of implied licenses have argued that all this is mere speculation and merely lawyers trying to create trouble where there is none. In fact, when tattoo blogger and attorney Marisa Kakoulas first brought up the idea of researching the intersectionality of tattoos and copyright with tattoo artists, she was told that

¹⁰⁷ Ringgold v. Black Entertainment Television, Inc., 126 F.3d 70 (2d Cir. 1997).

¹⁰⁸ 17 U.S.C. § 504.

¹⁰⁹ Erickson, 13 F.3d at 1068 (7th Cir. 1994) (stating that co-owners of a copyright work must account to each other for any profits derived from use of that work).

“[a]ttempting to bring lawyers in always makes things worse. They are the Harpies...No one in their right mind would ever try to bring lawyers into the tattoo world” because “those who want to live lives of creativity will suffer.”¹¹⁰ According to Kakoulas, the feeling remains, as the tattoo community as a whole feels they are entirely capable of self-regulation and furthermore, that proposals such as this one are contrary to the strong anti-authoritarian value system of many in the tattoo community.¹¹¹ Unfortunately, the events succeeding the *Whitmill* case have shown this to be nothing more than cock-eyed optimism, the need for implied licenses remains.

B. Real World Complications

In the aforementioned *Whitmill* case revolving around Mike Tyson’s face tattoo, the tattoo artist involved stated that he had no issue with Tyson’s reproducing or displaying that tattoo so long as that reproduction was attached to Tyson himself, such as a 2003 action figure which contained the now famous face tattoo.¹¹² *Whitmill* conceded that because the tattoo was now part of Tyson’s identity and because that is what Tyson looks like now, that he had “no objection to that whatsoever” despite the fact that it constituted infringement.¹¹³ If all tattoo artists adapted *Whitmill*’s stance there would be no need for an implied license. Unfortunately, it seems that Judge Perry’s comments have resonated with both the tattoo and legal community.

Some have actually begun to seek out previously applied tattoos as intellectual property investment opportunities. Matt Siegler, was one of the first to get in on the action and currently claims to own the exclusive licenses to the tattoos of at least eight athletes, including Chris Bosh, Ray Rice, and Kobe Bryant.¹¹⁴ One of the first artists he contacted was Ben Corn of Ben Corn

¹¹⁰ Marisa Kakoulas, Presentation before the Seton Hall University School of Law Art Law Society (Nov 7, 2013).

¹¹¹ *Id.*

¹¹² Cohen, *supra* note 71.

¹¹³ *Id.*

¹¹⁴ Darren Heitner, *Exclusive Licensee of LeBron James and Kobe Bryant Tattoo Artwork Preps to Profit Off of Images*, FORBES (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/>.

Tattoos, the artist who worked on LeBron James' "Chosen•1" tattoo.¹¹⁵ Seigler claims that in April 2012, the two signed a license agreement granting Siegler an "exclusive, worldwide, perpetual, irrevocable and fully sublicensable right in and to the artwork."¹¹⁶ Ultimately, Seigler claims that he plans to put the works on clothing and other merchandise, but also hints that athletes who already have these tattoos might have to go through him to appear in video games, ads or even play sports on television.¹¹⁷ In theory, if Seigler's license is valid and the tattooed players were not the sole owners of their tattoos, then the NBA could be liable for infringing the right to publicly display the tattoo and the individual players could be liable as secondary infringers for the same reason.

The NFL is cognizant of such a threat, as the NFL Players Association recently labeled tattoos as a "pressing issue."¹¹⁸ In fact, at the most recent NFL combine, incoming players and their agents were told "that when they get tattoos going forward they should get a release from the tattoo artist and if they can track down their former artists, they should get a release."¹¹⁹ Going forward, players that fail to get releases may be required "to indemnify and hold harmless the NFLPA (and the companies it associates with as part of its...licensing program) from any and all claims made by the player's tattoo artist(s)."¹²⁰ According to the NFLPA, the NFL currently works with over 60 licensees who use roughly 2,000 NFL players in products ranging from trading cards to video games, meaning that in addition to the tattooed player and the NFL there are over 60 other parties that will likely infringe an artist's work.¹²¹

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ *Id.*

¹²¹ *Id.*

The NFLPA's fears aren't misplaced either, as in November, 2012, tattoo artist Christopher Escobedo filed a suit against video game developer THQ Inc..¹²² The impetus for the suit was the release of the video games *UFC Undisputed 2010* and *UFC Undisputed 3*(2001), both which feature UFC fighter Carlos Condit as well as the lion tattoo that Escobedo had placed on him in 2009.¹²³ Escobedo alleged that the use of image in the game violated his exclusive right to create a copy of the image, a derivate work based on the image, to distribute the image, and to display the image.¹²⁴ Before the completion of the lawsuit, THQ filed for bankruptcy, resulting in the case being transferred to Bankruptcy court where Escobedo requested \$4,160,000 for the use of his image, based upon the fact that roughly 4,160,000 copies of the game were sold at an average retail value of \$50 and that he believes he should be entitled to 2% of the sale of every game.¹²⁵ THQ rebutted this amount by pointing out that the games contained over 100 other fighters and instead suggested that Escobedo might be entitled to a portion of the \$22,500 Condit received for licensing his image in the game, adjusted of course for the fact that the tattoo covers a limited portion of Condit's body and that Condit was paid for other attributes, such as: his general appearance; the time given to developers to capture his image and movement for use in the game; and the brand name recognition, popularity, and fame he has acquired as a UFC champion.¹²⁶ According to the defense, it would not make sense for the "value provided by one attribute of Mr. Condit [,the tattoo, to]... exceed the total value provided by all of the attributes associated with Mr. Condit."¹²⁷ Additionally, the defense argued that the amount awarded to Escobedo should be reduced to account for the fact that: tattoos might not be subject to copyright

¹²² Complaint *supra* notes 20, at 3.

¹²³ *Id.*

¹²⁴ *Id.* at 6.

¹²⁵ Declaration of Robert W. Underlich in Support Debtor's Motion at 6, In re: THQ INC, et al., Debtors, No. 12-13398-MFW (Bankr. D. Del. filed June 25, 2013).

¹²⁶ *Id.* at 4, 7.

¹²⁷ *Id.* at 4.

law; that this particular tattoo is based off of a public domain image and thus is not copyrightable; Condit was a “joint-author” and can thus license his tattoo to THQ; and that even if Condit is not a joint-author, that he has an implied license which allows for the image to be used in the game.¹²⁸ As previously, joint-authors must account to each other for profits, so THQ’s third point would not shield them from liability. Ultimately, the Court awarded Escobedo the full value of Condit’s video game contract, \$22,500, an amount currently under appeal.¹²⁹

In his appeal, Escobedo’s attorneys points out that when dealing with other artists, such as musicians, THQ would have “had literally millions of songs to choose from when deciding what music clips to include in its games... Thus, they had the opportunity to choose the least expensive music license they could get,” but had no such choice in placing Condit or his tattoo in the game.¹³⁰ A fact that puts Escobedo in a position to have negotiated a larger licensing fee.

Of course this argument is flawed in two senses: first, that argument suggests that Escobedo’s work was more valuable to the game than Condit’s image as a whole; and secondly that the purpose of the copyright law is to maximize profit for artists. However, the purpose of copyright law is not to allow artists such as Escobedo to maximize profit, but rather for society as a whole to maximize creativity.¹³¹ As Judge Perry stated in the *Whitmill* case, when she denied Whitmill’s request for an injunction, enforcing claims such as Escobedo’s, while in line with the Copyright Act, are harmful to the “public interest” as they raise costs for all involved and restrict access to entire catalogs of material.¹³² Tattoos have been around as an art form for

¹²⁸ *Id.* at 11-16.

¹²⁹ Corrected Order Establishing Interim Distributions at 2, In re: THQ INC, et al., Debtors, No. 12-13398-MFW (Bankr. D. Del. filed Aug. 19, 2013); Escobedo Notice of Appeal at 1, In re: THQ INC, et al., Debtors, No. 12-13398-MFW (Bankr. D. Del. filed Aug. 19, 2013).

¹³⁰ Eriq Gardner, *Tattoo Artist Looks to Show Value of Copyright Claim Against Videogame Publisher*, HOLLYWOOD REPORTER (Sept. 10, 2013, 2:20 PM), <http://www.hollywoodreporter.com/thr-esq/tattoo-artist-looks-show-value-625509>.

¹³¹ U.S. Const. art. I, § 8, cl. 8.

¹³² Cohen, *supra* note 71.

thousands of years. For almost the entirety of their existence, tattoo artists were applying tattoos without the incentive of licensing royalties. There is no reason to think that by issuing an implied license to a client, thus alleviating the need of the client to account to their artist for profits deriving from the tattoo, that tattoo artist would cease practicing their craft. Furthermore, issuing an implied license to clients would not prevent a tattoo artist from licensing the image to other parties without the client's permission.

If however an implied license is not issued and Escobedo is entitled to Condit's full paycheck in this instance, what is to stop Escobedo and other artists from going after the paycheck an athlete receives for appearing in a DVD of their "greatest fights?" An athlete who performs on broadcast television would be violating the tattoo artist's right to display as the image would be displayed in an area, at a viewer's home, which is separate from the location of the original, and therefore the tattoo artist could be entitled to the full salary of any athlete who appears in such broadcasts? Under the ideas laid out in the *Escobedo* and *Whitmill* cases, there is no reason to believe that that wouldn't be the case. How would the court have divided up damages if Condit had multiple tattoos by multiple artists: would it be by number, size, prominence on the body, popularity, or simply whoever claimed his paycheck first? It is exactly this type of uncertainty that mandate the need for an implied license. Clearly these are unequitable results not intended by the Copyright Act.

It isn't just the celebrities that could be targeted. There is no reason to believe that a tattoo artist would not, under the current trends, be able to access the pay check of a small time model that forgot to cover up a tattoo or two. Even those who utilize Youtube could be targeted by their artist. Although ads do not play before every video, as of March, 2013, Youtube paid

out \$6.33 per 1,000 views of pre-video ads.¹³³ This means a Youtube user such as Jenna Marbles, who has over one billion views of her videos, could, in theory, have made over \$6 million from her videos.¹³⁴ Using the model set forth in *Escobedo*, it is entirely plausible, that if Marbles had a tattoo on her arm, that a judge would force her to turn over that entire amount for violating her artist's right reproduction or display. Even if Marbles was a joint author of this hypothetical tattoo, she would still have to account to her artist for a share of the profits made from her tattoo, which under *Escobedo* would likely mean that her artist is entitled to half.

Obviously such results were not the intended of copyright protection. In order to prevent such inequitable results, the issuance of an implied license from tattoo artist to client is needed. Ideally the license would bestow upon the recipient of the tattoo the right to display, the right reproduce, the right to distribute, the right to create derivative works, and the right to sub-license any of these rights on a non-exclusive basis without any need to account for profit. While these rights should be subject to negotiation, any modification to them must be accomplished in writing and under no circumstance should a client be able to waive the right of display.

Where a client was already the sole owner of the copyright in their tattoo, no licenses would be issued and the client would retain their ability to grant exclusive licenses.

By granting the client a license to display their tattoo, the client would now be able to appear in a televised event, a Youtube video, a print advertisement, and post a picture online, without violating their tattoo artist's rights and without having to enter into long, expensive, fact specific, and from the looks of the *Escobedo* case, unjust, negotiations of fees and fee splitting. The granting of the right to reproduce would similarly allow a client to do things described in the

¹³³ Anita Hamilton, *It's Getting Harder to Make Money on Youtube*, BLOOMBERG BUSINESSWEEK (April 22, 2013), <http://www.businessweek.com/articles/2013-04-22/its-getting-harder-to-make-money-on-youtube#p1>.

¹³⁴ Amy O'Leary, *The Woman With 1 Billion Clicks, Jenna Marbles*, NEW YORK TIMES (April 14, 2013), http://www.nytimes.com/2013/04/14/fashion/jenna-marbles.html?_r=0.

aforementioned list, and would also allow a client to decide if they would like to license the image to a third party who may be interested in putting the image on themselves as seen in the *Whitmill* case, on a t-shirt or poster separate and apart from the client's body as contemplated by Matt Seigler.¹³⁵ A client with the right to create a derivative work would give a client the ability to add to or touch up pre-existing tattoos without violating their tattoo artist's right to create derivative works.

These licenses would be issued even in instances where a tattoo artist and client are joint-owners of a work. The reason for this is because even when two parties jointly own a work, problems arise because joint-owners must account to each other for profits, something that can be particularly difficult where a client has multiple tattoos by multiple parties.¹³⁶ By issuing a license, you are telling the tattoo artist that for the price of the tattoo they are forfeiting the right to any future share of profits their client may obtain from sub-licensing their right to display, reproduce, to distribute, and to prepare derivative works. However, that is not to say a tattoo artist would be unable to generate further profit from the image once the tattoo is applied, as issuing an implied license in no way revokes any of the tattoo artist's rights to reproduce, etc. So, while a client's right of personality might prevent a tattoo artist from licensing their client and their tattoo to appear in a video game as seen in the *Escobedo* case, it would not prevent a tattoo artist from making t-shirts with their client's tattoo on them or from creating a line of temporary tattoos utilizing the same design. What would occur, however, is a race to license as either the tattoo artist or client would have the ability to license the image to an interested party.

IV. Conclusion

¹³⁵ See *infra* Part III.B.

¹³⁶ See *infra* Part II.B.ii.

Despite a lengthy history and continued popularity, society has failed to come up with a uniform system of determining who owns the intellectual property rights contained within affixed tattoos. While this may not have been an issue centuries or even decades ago, recent events have proven that the intersectionality of copyright and tattoos will be an issue facing those in the entertainment industry and even the general population for years to come. Ultimately, the likelihood that tattoos are copyrightable, that a client does not own or share ownership with her tattoo artist, the ease of infringement, and the abuses of copyright law by tattoo artists, all point to the need for implied licenses to be issued to clients upon receiving a tattoo. While implied licenses cannot solve all issues that arise when tattoos are copyrightable, it can reduce the number of claims brought to the court in the future.