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THE ENFORCEMENT CHALLENGES FOR TATTOO COPYRIGHTS

*Yolanda M. King**

TABLE OF CONTENTS

I.	INTRODUCTION	30
II.	OWNERSHIP OF TATTOO COPYRIGHTS.....	33
	A. OWNERSHIP V. AUTHORSHIP	34
	B. TYPES OF AUTHORED WORKS	36
	1. <i>Solely Authored Tattoos</i>	36
	2. <i>Jointly Authored Tattoos</i>	37
	3. <i>Employer-Authored Tattoos?</i>	41
	a. <i>Employee Work</i>	43
	b. <i>Independent Contractor Work</i>	46
	C. COPYRIGHT OWNERSHIP AGREEMENTS.....	47
III.	ENFORCEMENT OF TATTOO COPYRIGHTS	48
	A. REPRODUCTION.....	49
	B. PREPARATION OF DERIVATIVE WORKS.....	51
	C. DISTRIBUTION	53
	D. PUBLIC DISPLAY	54
	E. FAIR USE	57
	F. IMPLIED LICENSE.....	63
	G. THIRTEENTH AMENDMENT.....	67
IV.	CONCLUSION.....	70

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I. INTRODUCTION

*A little secret to make you think:
Why is the crazy stuff we never say
poetry in ink?*

—Lyrics from “Tattoo,” by Van Halen¹

Who owns the copyright in a tattoo? Can the owner enforce a tattoo copyright, and if so, what is the scope of enforcement of a tattoo copyright? These are questions I left unresolved in *The Challenges “Facing” Copyright Protection for Tattoos*.² In that Article, I asserted that, despite a lack of any reported decisions, tattoos are copyrightable works. However, I noted that the related issues of ownership and enforcement are appropriate subject matter for a separate article.³ This Article is the follow-up to the first Article, a natural progression in the analysis of the application of copyright law to tattoos.

Courts have yet to address the questions of ownership and enforcement of tattoo copyrights. Only a few tattoo lawsuits have been filed in the past ten years and, thus far, no lawsuit involving the enforcement of a tattoo copyright has gone to trial.

On December 31, 2012, tattoo artist Stephen Allen instituted an action for copyright infringement against video game marketer and distributor Electronic Arts Inc. and former National Football League (NFL) running back Ricky Williams over tattoos inked on Williams’s right and left arms.⁴ Allen alleged ownership of the copyrights in the tattoos, and he claimed that defendants copied, reproduced, distributed, adapted and/or publicly displayed his copyrighted tattoos on the cover of the NFL Street, Madden NFL 10, and Madden NFL 11 video games.⁵ The parties dismissed the case in April 2013.

¹ VAN HALEN, *Tattoo, on A DIFFERENT KIND OF TRUTH* (Interscope Records 2012).

² See Yolanda M. King, *The Challenges “Facing” Copyright Protection for Tattoos*, 92 OR. L. REV. 129 (2013) (this article was the first of a series of articles to examine the applicability of copyright law to tattoos).

³ *Id.* at 131.

⁴ Complaint ¶¶ 13–16, Allen v. Electronic Arts, Inc., No. 5:12-CV-3172 (W.D. La. Dec. 31, 2012), *dismissed* (W.D. La. Apr. 9, 2013) [hereinafter Allen Complaint].

⁵ *Id.*

Christopher Escobedo, a tattoo artist based in Phoenix, Arizona, sued video game developer and publisher THQ in November 2012.⁶ Escobedo alleged copyright ownership of a lion tattoo on the right ribcage of professional mixed martial artist Carlos Condit.⁷ Further, he claimed that THQ infringed his copyright when it featured “a computer generated depiction of Mr. Condit, including an exact reproduction of the Lion Tattoo” in both the UFC Undisputed 2010 and UFC Undisputed 3 video games.⁸ Escobedo hopes to settle his case before it goes to trial.⁹

On April 28, 2011, tattoo artist S. Victor Whitmill sued Warner Bros. for infringement of his copyright in the tattoo inked on Michael Gerard “Mike” Tyson’s face in *Whitmill v. Warner Bros. Entertainment, Inc.*¹⁰ Whitmill claimed that Warner Bros. infringed his copyright based upon the production company’s unauthorized¹¹ copying of the tattoo onto the face of another actor¹²

⁶ Complaint ¶¶ 12, 20, *Escobedo v. THQ, Inc.*, No. 2:12-CV-02470-JAT (D. Ariz. Nov. 16, 2012) [hereinafter *Escobedo Complaint*], *bankruptcy status conference ordered* (D. Ariz. June 26, 2013), *sub. nom. In re THQ, Inc.*, 1:12-BK-133398 (Bankr. D. Del. Dec. 19, 2013) (transferred to bankruptcy court); Notice of Appeal by Christopher Escobedo, 1:12-BK-133398, 1143 (Bankr. D. Del. Sept. 9, 2013) Corrected Order Estimating Claim Filed By Christopher Escobedo, 1:12-BK-133398, 1093 (Bankr. D. Del. Aug. 19, 2013) (estimating Escobedo’s unsecured claim at \$22,500 and administrative claim at \$0).

⁷ *Escobedo Complaint*, *supra* note 6, ¶ 16.

⁸ *Id.* ¶ 28.

⁹ Ira Boudway, *Hey, Pro Athletes: Your Tattoo Is Going To Get You Sued*, BLOOMBERG BUSINESSWEEK (Sept. 4, 2013), http://www.businessweek.com/articles/2013-09-04/hey-pro-athlet-es-your-tattooed-arms-are-going-to-get-you-sued?campaign_id=DN090413 (noting that Escobedo’s complaint is now part of THQ’s bankruptcy proceedings); Michael Bathon, *THQ Gets Approval of Liquidating Plan Ending Bankruptcy*, BLOOMBERG (July 16, 2013), <http://www.bloomberg.com/news/2013-07-16/thq-gets-approval-of-liquidating-plan-ending-bankruptcy.html> (noting THQ received approval from U.S. Bankruptcy Judge for plan to liquidate assets).

¹⁰ Complaint ¶ 1, *Whitmill v. Warner Bros. Entm’t Inc.*, No. 4:11-CV-752 CDP (E.D. Mo. Apr. 28, 2011), *dismissed* (E.D. Mo. June 22, 2011) [hereinafter *Whitmill Complaint*] (tattoo artist alleging infringement of copyright in tattoo design).

¹¹ The court concluded that the facts were largely uncontested and that “[n]either Tyson nor Warner Brothers sought approval from Whitmill [to reproduce the tattoo] before either movie.” Transcript of Preliminary Injunction Hearing at 2, *Whitmill*, No. 4:11-CV-752 CDP (filed June 21, 2011) [hereinafter *Hearing Transcript*]. Further, the court determined that Whitmill had not granted Warner Bros. a license, implied or otherwise, to “use the tattoo.” *Hearing Transcript, supra*, at 4.

¹² Mike Tyson appeared in *The Hangover* and *The Hangover Part II*. See Verified Answer to Complaint by Warner Bros. Entm’t Inc. ¶¶ 15–16, *Whitmill*, No. 4:11-CV-752 CDP (filed May 20, 2011) [hereinafter *Warner Bros. Answer*] (“Warner Bros. states that Mr. Tyson appeared, with Mr. Tyson’s tattoo, in the first Hangover movie, as well as in an advertising poster for the first Hangover movie, and that thousands of images of Mr. Tyson, with Mr. Tyson’s tattoo, have

in its motion picture *The Hangover Part II*.¹³ Whitmill further claimed that Warner Bros. infringed his copyright “through its unauthorized copying, distribution[,] and public display of the Pirated Tattoo in advertising and promotion for the Movie and by making an unauthorized derivative work—namely, the Pirated Tattoo—that is based upon and copies virtually all of the copyrightable subject matter of the Original Tattoo.”¹⁴ The parties reached a settlement, the terms of which were confidential, shortly following the denial of Whitmill’s motion for a preliminary injunction.¹⁵

In a 2005 case, *Reed v. Nike, Inc.*, tattoo artist Matthew Reed sued not only the advertising agency and athletic footwear and apparel company responsible for the commercial in which the tattoo at issue appeared, but he also sued the bearer of the tattoo, former National Basketball Association (NBA) player Rasheed Wallace.¹⁶ This case also settled,¹⁷ but it raised complex issues regarding ownership and enforcement of a tattoo copyright.

The objective of this Article is to address the challenges that the owner of a copyright in a tattoo will face if the owner decides to enforce her rights in court. The Article explores the complexities in determining the ownership of the copyright in a tattoo, mostly due to the fluidity and informality of the process of tattoo creation. The analysis then moves to infringement of the tattoo copyright. In order to prove copyright infringement, the copyright owner must show a violation of one of the exclusive rights of the owner. This Article examines the rights most relevant to the owner of a tattoo copyright and considers how the tattoo artist’s choice of medium, the human body, affects those rights.

appeared in magazines, television and on the internet since February 10, 2003.”). Warner Bros. admitted that Tyson’s tattoo and the tattoo appearing on actor Ed Helms’ face in *The Hangover Part II* are similar but denied that there was any copyrightable expression in Tyson’s tattoo or that the tattoo on Helm’s face was pirated. *Id.*

¹³ See Whitmill Complaint, *supra* note 10, ¶ 1.

¹⁴ *Id.* ¶ 18. While Tyson appeared in both *Hangover* movies, there were no non-Tyson uses of the tattoo in the first movie. Hearing Transcript, *supra* note 11, at 2, *Whitmill*, No. 4:11-CV-752 CDP (*motion denied* May 24, 2011) (Judge Catherine D. Perry noting, “[t]he first movie didn’t do anything except show Mr. Tyson’s face”).

¹⁵ Order Denying Plaintiff’s Motion for Preliminary Injunction at 1, *Whitmill*, No. 4:11-CV-752 CDP (E.D. Mo. May 24, 2011).

¹⁶ Complaint, ¶¶ 4–5, *Reed v. Nike, Inc.*, No. 3:05-CV-00198 (D. Or. Feb. 10, 2005), *dismissed*, (D. Or. Oct. 19, 2005) [hereinafter *Reed Complaint*].

¹⁷ Order of Dismissal at 1, *Reed*, 3:05-CV-00198 (D. Or. Oct. 7, 2005) (dismissing the case with prejudice after the parties reached a settlement agreement).

Part II of the Article first evaluates how authorship of a work and copyright ownership are defined and interpreted under the federal copyright statute and related case law. It then analyzes the various types of authorship and recommends that the tattoo artist and her customer discuss copyright ownership in the tattoo prior to affixing the tattoo on the customer's body.

In Part III, the Article scrutinizes the exclusive rights of the copyright owner and the challenges faced by the owner of a tattoo copyright in the enforcement of those rights. This Part also explores constitutional limitations on enforcement of a copyright in a tattoo on someone's body.

This Article concludes with a recommendation that tattoo copyright owners pursue enforcement of their rights in court but cautions these owners that it is likely that courts will determine that the choice of a human medium necessitates the diminution of the exclusive rights of the copyright owner. While the owner of a tattoo copyright must accept that some uses of the work will be beyond her control, especially many uses of the work by the bearer of the tattoo, the copyright owner should be vigilant in enforcement of her rights against media companies and other businesses that seek to exploit the value of the work without the consent or compensation of the owner.

II. OWNERSHIP OF TATTOO COPYRIGHTS

Section 106 of the Copyright Act of 1976 provides several exclusive rights to the copyright owner of a work.¹⁸ The copyright owner has the exclusive right to, *inter alia*, reproduce, distribute, display, and create derivatives of the copyrighted work.¹⁹

However, before a copyright can be enforced, a court must first determine the owner of the copyright.²⁰ Section 201 of the Act states that “[c]opyright in a work protected under this title vests in the author or authors of the work.”²¹

¹⁸ See 17 U.S.C. § 106 (2012) (the reproduction, distribution, display and derivative works rights are the most relevant to the owner of a copyright in a tattoo, but a copyright owner also has the right to publicly perform a copyrighted work (which does not apply to a pictorial, graphic, or sculptural work) and, in the case of sound recordings, to publicly perform the work by means of digital audio transmission); see also King, *supra* note 2, at 132 (as previously concluded in *The Challenges “Facing” Copyright Protection for Tattoos*, tattoos can meet the 1976 Act's requirements of a copyrightable work—some tattoos are original, many, if not most, are fixed in a tangible medium of expression, and, the useful article doctrine does not preclude copyrightability of this type of pictorial work).

¹⁹ 17 U.S.C. § 106.

²⁰ *Id.* § 201.

²¹ *Id.* § 201(a).

There are exceptions to this rule, such as “works made for hire.”²² Further, the author of a tattoo may transfer the copyright in the work to the customer.²³ Section 202 distinguishes ownership of a copyright from ownership of the work: “Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied.”²⁴ When interpreting and applying these provisions to tattoos, it is apparent that the author of the tattoo is the owner of the copyright, but that author may not be, and in most cases is not, the person who owns the tattoo itself. The owner of the “material object” will most often be the client or customer of the tattoo artist, or the bearer of the tattoo. Thus, the critical question: Who is the author of a tattoo?

A. OWNERSHIP V. AUTHORSHIP

Congressional authority to enact federal copyright law is limited by the U.S. Constitution to the protection of the works of “authors.”²⁵ Although the Copyright Act vests initial ownership of the copyright in a work to the author, Congress did not define the term “author.” The Supreme Court has defined an author as “he to whom anything owes its origin; originator; maker; one who

²² See *id.* § 201(b):

In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.

Id. A work for hire has been considered as a possible type of copyright ownership for tattoos. See, e.g., Thomas F. Cotter & Angela M. Mirabole, *Written on the Body: Intellectual Property Rights in Tattoos, Makeup, and Other Body Art*, 10 UCLA ENT. L. REV. 97, 105 (2003). However, this determination of ownership is unlikely in the relationship between a tattoo artist and his customer. Works made for hire are either prepared by an employee within the scope of his or her employment or by an independent contractor. See 17 U.S.C. §§ 101(1) to 101(2) (2012) (defining works made for hire). The tattoo artist-customer relationship is not an employer-employee relationship under § 101(1)’s definition of a work made for hire, nor does a tattoo fall within any of the required, enumerated categories of § 101(2). See generally *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 739–40 (1989) (“In the past, when Congress has used the term ‘employee’ without defining it, we have concluded that Congress intended to describe the conventional master-servant relationship as understood by common-law agency doctrine.”).

²³ *Community for Creative Non-Violence*, 490 U.S. at 739–40; see also 17 U.S.C. § 201(d)(1) (“The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law . . .”).

²⁴ 17 U.S.C. § 202 (2012).

²⁵ U.S. CONST. art. I, § 8, cl. 8; see also 17 U.S.C. §§ 101, 102(a).

completes a work of science or literature.”²⁶ Yet, authorship requires more than the contribution of creativity or originality to a work.²⁷ The author is the person “who superintended the whole work, the ‘master mind.’”²⁸

The nature of the process by which tattoo art is created complicates the determination of authorship for the work. The author of the tattoo owns the copyright in it; however, the owner of the copyright may not be the person whose body is adorned with the tattoo. Ownership of the copyright is distinct from ownership of the tattoo itself.²⁹

Ownership and authorship become conflated in the context of tattoos because of the uniqueness of the medium on which the work is affixed. The concept is easier to reconcile in the context of other copyrightable works. For example, the ownership of the copyright in a painting is distinct from ownership of the painting itself.³⁰ The author of the painting itself would own the copyright in the painting. The original painting itself, however, would likely be owned by a separate person or entity. Furthermore, a substantial number of unknown persons or entities could own reproductions of the painting.³¹

For tattoos, the owner of the physical object is the person to whose skin the tattoo is affixed. However, is this person also the author of the tattoo art, and therefore, the owner of the copyright in the tattoo?³² Or could the copyright owner be another party—the tattoo artist, the tattoo parlor owner, or other parties who may have a copyright interest in a drawing or other material used to create the tattoo?³³ Or, in some cases, are the tattoo artist and his customer

²⁶ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

²⁷ *See Aalmuhammed v. Lee*, 202 F.3d 1227, 1233 (9th Cir. 2000).

²⁸ *Id.* (citing *Burrow-Giles Lithographic Co.*, 111 U.S. at 53, 61).

²⁹ *See* 17 U.S.C. § 202 (“Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied.”).

³⁰ *See, e.g., Ringgold v. Black Entertainment Television, Inc.*, 126 F.3d 70, 72 (2d Cir. 1997) (“Although Ringgold has retained all rights in the copyright in ‘Church Picnic [Story Quilt],’ the work itself is owned by the High Museum of Art (the ‘High Museum’) in Atlanta, Georgia.”). In this case, the High Museum held a non-exclusive license to reproduce the “Church Picnic” as a poster, and the museum sold thousands of those reproductions. *See id.* Even after the High Museum’s license terminated, copies of the poster remained available for sale. *See id.*

³¹ *See* 17 U.S.C. § 202 (ownership of a copyright in a work is distinct from ownership of an object in which a work is embodied); *Ringgold*, 126 F.3d at 72.

³² *See* 17 U.S.C. §§ 202, 201(a) (2012).

³³ Jordan S. Hatcher, *Drawing in Permanent Ink: A Look at Copyright in Tattoos in the United States* 7 (Apr. 15, 2005) (unpublished manuscript), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=815116 (concluding there are four potential owners of a tattoo copyright: “(1) the tattoo client—the art, (2) the tattoo artist, (3) the tattoo parlor owner, and (4) any third parties with a copyright in a drawing or other material used for a tattoo.”).

joint authors of the tattoo, and therefore, co-owners of the copyright in the work?³⁴

B. TYPES OF AUTHORED WORKS

In order to resolve questions regarding ownership of a tattoo copyright, one must first determine the author of the copyrightable work. The 1976 “Act recognizes three kinds of authorship: sole authorship, joint or co-authorship,³⁵ and employer authorship of ‘works made for hire.’”³⁶ Thus, a tattoo can be solely authored, collaboratively or jointly authored, or made under the “work made for hire” provisions of the 1976 Act.³⁷

1. *Solely Authored Tattoos.* The claim of sole authorship of a tattoo is likely to be highly contested not only because of the straightforward application of the statute—only one individual has authored the work, and therefore, absent the application of the “work made for hire” provisions of the Act, the copyright vests with that individual—but also because this classification of authored works is a zero-sum game. If the client or customer requesting the fixation of the work to her skin is the author, then she is the copyright owner. The tattoo artist would then have no copyright interest in the tattoo. If the tattoo artist is deemed to be the author of the work, by contrast, then the copyright interest vests with the artist. In light of the collaborative nature of tattoo creation,³⁸ it will be difficult for a court to find sole authorship of a tattoo in circumstances

³⁴ See 17 U.S.C. § 101 (2012) (defining a joint work as “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole”); see also *id.* § 201 (prescribing authors of a joint work co-ownership of copyright in the work). The fundamental requirement of joint authorship “is the intention at the time the writing is done that the parts be absorbed or combined into an integrated unit.” *Thomson v. Larson*, 147 F.3d 195, 199 (2d Cir. 1998) (citing legislative history of the 1976 Act). In the context of tattoos, this requirement means the tattoo artist and his customer must intend to combine their contributions at the time of creation of the tattoo.

³⁵ This Article also refers to joint or co-authored works as “collaborative works.”

³⁶ JULIE E. COHEN ET AL., *COPYRIGHT IN A GLOBAL INFORMATION ECONOMY* 116 (3d ed. Aspen Law & Bus. 2010).

³⁷ 17 U.S.C. §§ 101, 201.

³⁸ A collaborative nature is assumed in circumstances where the client brings a sketch to the tattoo artist, or describes it to the tattoo artists, e.g., Reed Complaint, *supra* note 16, as opposed to the common instance of a client walking into a tattoo parlor and simply choosing a design from tattoo flash, without significant modification by the client or artist before application to the skin. See Cotter & Mirabole, *supra* note 22, at 138 n.7 (defining “tattoo flash” as a copy of a tattoo artist’s design sold to others for their use); see also *infra* text accompanying note 46 (citing Matthew Beasley, Note, *Who Owns Your Skin: Intellectual Property Law and Norms Among Tattoo Artists*, 85 S. CAL. L. REV. 1137, 1157–58 (2012)).

where ownership is challenged and the evidence of authorship is weak or unclear.³⁹

2. *Jointly Authored Tattoos.* A jointly authored work is defined in the 1976 Act as “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”⁴⁰ The statute also prescribes co-ownership of the copyright in a jointly authored work; each co-owner has the right to use or license the work, subject to an accounting to the other co-owners for any profits.⁴¹

The 1976 Act does not define the key terms in the joint work definition. As previously discussed, the Act does not define the term “author.” Further, the statute does not define the terms “inseparable” or “interdependent.”⁴² Courts and intellectual property scholars have proposed various interpretations of the “joint work” definition, and these interpretations emphasize different parts of the definition.⁴³ In fact, the Seventh Circuit has noted that the legislative history of the definition creates more ambiguity than clarification of the

³⁹ Reed Complaint, *supra* note 16, ¶¶ 36–37.

⁴⁰ 17 U.S.C. § 101.

⁴¹ *Id.* § 201(a) (“The authors of a joint work are co-owners of copyright in the work.”); *see also* Erickson v. Trinity Theatre, Inc., 13 F.3d 1061, 1068 (7th Cir. 1994) (citing Childress v. Taylor, 945 F.2d 500, 505 (2d Cir. 1991)); Weinstein v. University of Illinois, 811 F.2d 1091, 1095 (7th Cir. 1987); 1 MELVIN B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 6.02, at 6-7 to 6-8 (Matthew Bender, 92d Rev.).

⁴² *Erickson*, 13 F.3d at 1068 (citing H.R. REP. NO. 94-1476, at 120 (1976) (“[A] work is ‘joint’ if the authors collaborated with each other, or if each of the authors prepared his or her contribution with the knowledge and intention that it would be merged with the contributions of other authors as ‘inseparable or interdependent parts of a unitary whole.’ The touchstone here is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit . . .”).

⁴³ *Id.* at 1068–69 (rejecting Trinity’s “collaboration alone test” as inconsistent with the plain meaning of the statute and the goal of the Act to promote progress and concluding that, “[e]ven if two or more persons collaborate with the intent to create a unitary work, the product will be considered a ‘joint work’ only if the collaborators can be considered ‘authors . . .’” which requires more than the supply of “direction or ideas”); *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231–35 (9th Cir. 1999) (“The statutory language establishes that for a work to be a ‘joint work’ there must be (1) a copyrightable work, (2) two or more ‘authors,’ and (3) the authors must intend their contributions be merged into inseparable or interdependent parts of a unitary whole. A ‘joint work’ in this circuit ‘requires each author to make an independently copyrightable contribution’ to the disputed work But there is another element to a ‘joint work.’ A ‘joint work’ includes ‘two or more authors.’” The Ninth Circuit identifies a number of factors as criteria for joint authorship, such as superintendence of the work, objective manifestation of an intent to be co-authors, and audience appeal of the work based on both contributions. *Id.* at 1234. The *Aalmuhammed* court notes that control is the most important factor in many cases. *Id.*)

definition.⁴⁴ Yet, it is clear from the plain meaning of the statute that there must not only be collaboration of the “inseparable” or “interdependent” parts but also, from the very beginning of the collaborative relationship, an intent by the authors to merge these parts.⁴⁵

It is customary in the tattoo industry for the tattoo artist to collaborate with the customer in the creation of the artwork that will be affixed to the customer’s skin.⁴⁶ Courts have considered two approaches to evaluating whether one’s contributions to a copyrighted work amount to authorship.⁴⁷ The first test, proposed by the late Professor Melville B. Nimmer, requires only that the combined product of the joint contributions be copyrightable (the “*de minimis test*”).⁴⁸ The second test, proposed by Professor Paul Goldstein, requires that each contribution be copyrightable (the “copyrightability test”).⁴⁹ While the majority of courts have adopted the copyrightability test,⁵⁰ it is not a

⁴⁴ *Erickson*, 13 F.3d at 1068 (“The legislative history states that examples of inseparable parts are the joint contributions of two authors to a single novel or the contributions of two painters to a single work; an example of interdependent parts are the lyrics and music for a song Apart from these examples, the reports do little to clarify the criteria for determining joint authorship. Indeed, they increase the ambiguity.”).

⁴⁵ *Id.* (agreeing with the Second Circuit’s view that a “disjunctive standard based solely on the legislative history would not square with the plain meaning of the statute, and therefore, ‘the statutory language clearly requires that each author intended’” to merge their respective contributions into a unitary whole).

⁴⁶ Beasley, *supra* note 38, at 1162 (explaining that some clients seeking to get a tattoo “often bring in photographs or drawings which they want copied exactly, or from which they want the tattoo artist to base his or her conceptual framework in creating a new drawing to be tattooed.” However, other clients “walk into tattoo parlors with ideas and work with the artist to develop and draw their concepts on paper before the drawing is transferred onto skin.”). Beasley’s brief explanation of the process of getting a tattoo does not differentiate between a client who brings in her own photograph or drawing and a client who brings in a photograph or drawing created by a third party. If a client brings in the former, then this Article posits that the client has contributed more than an idea to the collaborative process. However, if the client brings in the latter, then an additional coauthor may be a part of the collaborative process (or the tattoo is an authorized derivative work of the photograph or drawing, assuming the client has the author/copyright owner’s permission to use the photograph or drawing), or the resulting tattoo actually may be an infringement of the presumable copyrighted photograph or drawing. The challenges posed by enforcement of such tattoo copyrights will be discussed *infra*, Part III of this Article.

⁴⁷ See *Erickson*, 13 F.3d at 1069–71.

⁴⁸ *Id.* at 1069–70.

⁴⁹ *Id.* at 1070–71.

⁵⁰ NIMMER & NIMMER, *supra* note 41, § 6.07[A][3][b], at 6-22 to 6-23 (noting that while the Second Circuit in *Childress v. Taylor* called the issue concerning copyrightable contributions “open and troublesome,” *dictum* in that case rejected Nimmer’s *de minimis* test and became “the prevailing

statutory requirement for determination of joint authorship.⁵¹ Goldstein's copyrightability test has been embraced for its "simplicity and predictability."⁵² However, Nimmer grounded his test in his observation that the definition of a joint work contains no requirement of an independently copyrightable contribution, nor does the legislative history of the definition address the copyrightability of the contribution.⁵³

Indeed, the *de minimis* test may have validity in the context of tattoo creation between a tattoo artist and her customer.⁵⁴ In this type of relationship, the exchange of suggestions concerning the creation of the work between the artist and her customer is customary and would promote, not inhibit, creativity.⁵⁵ Further, the *de minimis* test might better recognize the flexibility and fluidity in

view in the case law"). See, e.g., Cotter & Mirabole, *supra* note 22, at 105 (concluding that both the artist and customer would have to "contribute independently copyrightable expression" in order for the tattoo to be considered a joint work).

⁵¹ NIMMER & NIMMER, *supra* note 41, § 6.07[A][3][a], at 6-22.

⁵² Roberta Rosenthal Kwall, "Author-Stories: Narrative's Implications for Moral Rights and Copyright's Joint Authorship Doctrine," 75 S. CAL. L. REV. 1, 53 (2001) (citing *Erickson*, 13 F.3d at 1071).

⁵³ *Id.* But compare 1 PAUL GOLDSTEIN, COPYRIGHT PRINCIPLES, LAW, AND PRACTICE § 4.2.1.2, at 379, ¶ 4:13 (2d ed. 1989) ("A collaborative contribution will not produce a joint work, and a contributor will not obtain a coownership interest, unless the contribution represents original expression that could stand on its own as the subject matter of copyright. Section 101's definition of a joint work as a work prepared by two or more 'authors' implies that the contribution of each must be a copyrightable 'work of authorship' within the term of section 102(a)."), with GOLDSTEIN, *supra*, § 4.2.1.2, at 379, ¶ 4:14 ("But a collaborator who accompanies his ideas with original and expressive suggestions will be a joint author even though his contribution is smaller than the contributions of other authors. Further, it is not necessary to the creation of a joint work that each collaborator actually fix the work in a tangible medium of expression."). See also NIMMER & NIMMER, *supra* note 41, § 6.07[A][3][a], at 6-22 ("[The Copyright Act] contains no requirement that each contribute an independently copyrightable component to the product. The legislative history similarly elevates intention as the touchstone, without placing any further parsing as to the copyrightable status of each individual component that the parties intend to contribute to the work as a whole.").

⁵⁴ See *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1496 n.15 (D.C. Cir. 1988), *aff'd*, 490 U.S. 730 (1989) (stating that "[i]f Nimmer is correct on the point that the contribution of a joint author need not be copyrightable," then CCNV's contributions may satisfy the *de minimis* test). But see *Erickson*, 13 F.3d at 1070 ("Restrictions on an author's use of existing ideas in a work, such as the threat that accepting suggestions from another party might jeopardize the author's sole entitlement to a copyright, would hinder creativity.").

⁵⁵ NIMMER & NIMMER, *supra* note 41, § 6.07[A][3][a], at 6-22. Nimmer submits that, in the motion picture context, "copyright's goal of fostering creativity is best served . . . by rewarding all parties who labor together to unite idea with form, and that copyright protection should extend both to the contributor of the skeletal ideas and the contributor who fleshes out the project." This Article asserts that the same policy reasons for rewarding both types of collaborators in the motion picture industry exist in the tattoo industry.

the process of tattoo creation.⁵⁶ The copyrightability test ignores the significance of the contributions of the customer in most instances, and as a result of its harshness, treats a collaboratively created work as the solely authored work of the tattoo artist. While sole authorship, and therefore sole copyright ownership, may be appropriate in some instances, the rigidity of the copyrightability test does not recognize joint authorship where the customer is working with the tattoo artist to create a custom design. While the customer owns the physical embodiment of the work on his body,⁵⁷ under the current interpretation of copyright law, he has no legal rights to the work if he did not provide copyrightable contributions to it.⁵⁸ Courts' current application of the joint authorship doctrine places courts out of touch with the collaborative nature of tattoo creation.⁵⁹

For example, in *Allen v. Electronic Arts, Inc.*, tattoo artist Stephen Allen acknowledged that the court could find that Williams was the co-owner of the tattoo on Williams's left arm, even though Williams signed a "Consent to Tattoo or Piercing Procedure and Release of Claims" that stated the "artwork remains property of [Stephen] Allen unless otherwise expressed."⁶⁰ Therefore, as an alternative claim, Allen sought an accounting for any profits realized by Williams from the exploitation of the tattoo.⁶¹

Similarly, in *Reed v. Nike, Inc.*, tattoo artist Matthew Reed met with NBA player Rasheed Wallace to discuss ideas for Wallace's tattoo, and Reed took notes of Wallace's description of his concept of "incorporating an Egyptian-themed family design of a king and a queen and three children with a stylized

⁵⁶ Kwall, *supra* note 52, at 44 ("In light of the current application by the judiciary of the copyright provision for joint authorship, nondominant authors have little chance of receiving either personal recognition or appropriate compensation for the contributions."); Aaron Perzanowski, *Tattoos and IP Norms*, 98 MINN. L. REV. 511, 535 (2013) (observing that although the "highly collaborative tattoo design process is highly strongly suggestive of the requisite intent" of joint authors, "the contributions of most clients are unlikely to meet the threshold of authorship" adopted by most courts. Further, copyright law would treat most custom tattoos as the solely authored work of the tattoo artist).

⁵⁷ 17 U.S.C. § 202 (2012) ("Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied.")

⁵⁸ Kwall, *supra* note 52, at 44 (recognizing that "courts have applied copyright's concept of 'authorship' in a way that evidences little recognition" for the "personal dignity, honor, and respect" of nondominant authors).

⁵⁹ Kwall concludes that the courts are out of step with the increasing prominence of joint authorship in the copyright industries in general. *See id.* at 62–64.

⁶⁰ Allen Complaint, *supra* note 4, ¶¶ 8, 28.

⁶¹ *Id.* ¶¶ 26–30.

sun in the background.”⁶² Reed made sketches and incorporated Wallace’s suggested changes into the final drawing.⁶³ Reed then used this drawing and proceeded with inking the tattoo on Wallace’s upper right arm.⁶⁴ Thus, the collaborative creation of Wallace’s tattoo raised the question of whether Wallace not only owned the physical object tattooed on his arm, but also owned any copyright interest in the artwork. The settlement of these cases has left uncertainty as to how joint authorship of a copyright would have been determined in such situations.⁶⁵

3. *Employer-Authored Tattoos?* The 1976 Act includes “work made for hire” provisions, which provide authorship of a copyrightable work to an employer or other person for whom the work was prepared.⁶⁶ Section 101 of the Act sets forth the definition of works made for hire, and the definition divides works made for hire into two categories: (1) employee-created works and (2) independent contractor-created works.⁶⁷ The statute defines an employee-created work as one “prepared by an employee within the scope of his or her employment” and an independent contractor-created work as one “specially ordered or commissioned” by a person or entity.⁶⁸ While courts have grappled

⁶² See King, *supra* note 2, at nn.18–19 (citing Christopher A. Harkins, *Tattoos and Copyright Infringement: Celebrities, Marketers, and Businesses Beware of the Ink*, 10 LEWIS & CLARKE L. REV. 313, 316 (2006)).

⁶³ Harkins, *supra* note 62, at 315.

⁶⁴ *Id.*

⁶⁵ ROBERTA ROSENTHAL KWALL, *THE SOUL OF CREATIVITY: FORGING A MORAL RIGHTS LAW FOR THE UNITED STATES* 106 (2010).

⁶⁶ 17 U.S.C. § 201(b) (2012) (“In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless, the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.”); *see also id.* § 101.

⁶⁷ *Id.* § 101 (“A ‘work made for hire’ is — (1) a work prepared by an employee within the scope of his or her employment; or (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. For the purpose of the foregoing sentence, a ‘supplementary work’ is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an ‘instructional text’ is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.”).

⁶⁸ 17 U.S.C. § 101 (2006).

with interpretation and applicability of the employee category, analysis of this category, as it applies to tattoos, is rather uncomplicated compared to the independent contractor category.⁶⁹

Scholars have previously addressed whether tattoos could be considered works made for hire.⁷⁰ A straightforward application of the work made for hire doctrine to tattoos would be a circumstance in which a tattoo artist is employed by a tattoo parlor, and therefore, any tattoos created by the tattoo artist may have been prepared within the scope of the artist's employment at the parlor.⁷¹ However, the more difficult question before a court would be applicability of the work made for hire provisions to the tattoo artist-customer relationship. Some scholars have concluded that it is unlikely that a tattoo could qualify as an employee-created or independent contractor-created work made for hire.⁷² Others have reached the conclusion that a tattoo could acquire a work made for hire status in this context.⁷³ This Article agrees with the rationale that tattoos

⁶⁹ *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 739 (1989).

⁷⁰ Cotter & Mirabole, *supra* note 22, at 105 (considering several ways in which a work of body art could be a work made for hire); Harkins, *supra* note 62, at 324–25 (analyzing applicability of work made for hire provisions to tattoos).

⁷¹ See *Community for Creative Non-Violence*, 490 U.S. at 751–52 (stating factors considered in determining whether a hired party is an employee under the common law of agency, including “the 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 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”); see also *Aymes v. Bronelli*, 980 F.2d 857, 861 (2d Cir. 1992) (noting that “the *Reid* test can be easily misapplied” because “[the Court] gave no direction concerning how the factors were to be weighed.” The court then listed factors that “will almost always be relevant and should be given more weight in the analysis,” including: “(1) the hiring party’s right to control the manner and means of creation; (2) the skill required; (3) the provision of employee benefits; (4) the tax treatment of the hired party; and (5) whether the hiring party has the right to assign additional projects to the hired party.”); see *infra* note 81; NIMMER & NIMMER, *supra* note 41, § 5.03[B][1][a], at 5-14 to 5-17.

⁷² Harkins, *supra* note 62, at 324–25 (concluding that a “tattoo would probably not constitute a work made for hire under either paragraph of section 101.” However, Harkins does not rule out the possibility that there could be a basis for asserting a work made for hire status for a tattoo in unusual circumstances.); Perzanowski, *supra* note 56, at 534 (concluding that “[c]ustom tattoos are almost certainly not works made for hire as defined by the Copyright Act”).

⁷³ Cotter & Mirabole, *supra* note 22, at 105 (listing possibilities for a tattoo to qualify as a work made for hire, such as when a business employs a tattoo artist, when a customer “employs” a tattoo artist, and when a party specially orders or commissions a tattoo for use as a contribution to a collective work, arguably an additional tattoo placed on the body of an individual with other

cannot be considered works made for hire and finds little support for the contrary position. Absent the determination of an employer-employee relationship between an artist and customer, which is highly improbable, a tattoo cannot qualify as a work made for hire because it will not meet the requirements of an independent contractor work.

a. Employee Work. In *Community for Creative Non-Violence v. Reid*, the Supreme Court interpreted the employee category of the work made for hire provisions.⁷⁴ In *Reid*, the Petitioner, a nonprofit association dedicated to raising awareness of homelessness in the United States, conceived of an idea for a Christmas pageant display, entitled “Third World America,” to highlight the plight of homelessness.⁷⁵ CCNV contacted the Respondent, an artist named James Earl Reid, to sculpt three human figures as part of a larger display for a Christmas pageant.⁷⁶ While the parties discussed several details regarding their respective responsibilities for the completed work, including a timeline for completion and costs, they did not discuss copyright ownership of the work.⁷⁷ Following a disagreement concerning CCNV’s plans to take the statue on a tour of several cities to raise money for the homeless, each party filed a certificate of copyright registration.⁷⁸ CCNV then filed a complaint against Reid, alleging copyright ownership of the “Third World America” under § 101, the work made for hire provision, and seeking to permanently enjoin Reid from infringing upon that copyright.⁷⁹ The Court held that Reid was an independent contractor—not an employee of CCNV.

In reaching its determination, the *Reid* Court set forth the appropriate test for interpreting the undefined terms of the employee category set forth in

tattoos); see also David M. Cummings, Note, *Creative Expression and the Human Rights Canvas: An Examination of Tattoos as a Copyrightable Art Form*, 2013 U. ILL. L. REV. 279, 314 (arguing that tattoos originally created on human flesh should be classified as works made for hire under the independent contractor provision of § 101 because the tattoo recipient “likely provides some general idea or vision . . . analogous to that of a hiring party commissioning an independent contractor to create a work”).

⁷⁴ *Community for Creative Non-Violence*, 490 U.S. at 739–40 (“In the past, when Congress has used the term ‘employee’ without defining it, we have concluded that Congress intended to describe the conventional master-servant relationship as understood by common-law agency doctrine. . . . Nothing in the text of the work for hire provisions indicates that Congress used the words ‘employee’ and ‘employment’ to describe anything other than ‘the conventional relation of employer and employe[e].’”).

⁷⁵ *Id.* at 730.

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ *Id.*

§ 101, namely, “a work prepared by an employee within the scope of his or her employment.”⁸⁰ The Court concluded that Congress must have meant to incorporate the established meaning of these terms, and therefore, looking to the ordinary canons of statutory interpretation and legislative history of the 1976 Act, classification of a hired party should be made with reference to the common law meaning of the terms under agency law.⁸¹ In order to determine whether a hired party is an employee under the general common law of agency, the Court considered “the hiring party’s right to control the manner and means by which the product is accomplished.”⁸² The Court considered several factors relevant to this analysis, including:

[T]he skill required; the source of the instrumentalities and the 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 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.⁸³

However, the Court noted that no one factor was determinative of an employer-employee relationship,⁸⁴ and that no one factor should be weighed more heavily in the analysis than another.⁸⁵

The Second Circuit then refined the Supreme Court’s test for employee works. In *Aymes v. Bonelli*, the court determined that some factors are given more weight than others because they are more indicative of an employment relationship: “(1) the hiring party’s right to control the manner and means of creation; (2) the skill required; (3) the provision of employee benefits; (4) the tax treatment of the hired party; and (5) whether the hiring party has the right to assign additional projects to the hired party.”⁸⁶

⁸⁰ *Id.* at 738.

⁸¹ *Id.* at 740.

⁸² *Id.* at 751.

⁸³ *Id.* at 751–52.

⁸⁴ *Id.* at 752 (in light of the circumstances in *CCNV*, the Supreme Court determined from its analysis of the factors that Reid was an independent contractor, not an employee).

⁸⁵ *Id.*

⁸⁶ *Aymes v. Bonelli*, 980 F.2d 857, 861 (2d Cir. 1992).

An analysis of all of the factors under *Reid*, or under the most significant factors identified in *Aymes*,⁸⁷ would not support finding an employer-employee relationship between a tattoo artist and her client. Although in many circumstances a tattoo artist receives considerable input from the client about the type of tattoo sought by the client, the tattoo artist has a greater right to control the manner and means of her creation because the artist is the person actually fixing the tattoo on the skin of the client. This factor seems to weigh in favor of an employer-employee relationship with the tattoo artist as the hiring party and the client as the hired party. However, this characterization of the relationship does not make much sense because the client seeks out the tattoo artist for a tattoo, not vice versa.

In addition, the other factors do not support the finding of an employment relationship between the tattoo artist and client. A high degree of skill is required to fix a tattoo on human skin. “[C]ourts that have addressed the level of skill necessary to indicate that a party is an independent contractor have held architects, photographers, graphic artists, drafters, and indeed computer programmers to be highly-skilled independent contractors.”⁸⁸ A tattoo artist possesses a comparable level of skill to perform his work, and therefore, this factor weighs in favor of finding that a tattoo artist is a highly-skilled independent contractor. Neither party extends employee benefits to the other nor pays the other’s payroll taxes. Therefore, both of these factors weigh heavily against a determination of an employment relationship.⁸⁹

⁸⁷ Ryan Vacca, *Work Made for Hire—Analyzing the Multifactor Balancing Test*, 42 FLA. ST. U. L. REV. 29–30 (forthcoming 2015). Professor Ryan Vacca conducted a recent study of all work made for hire cases since *Reid*, a total of forty-five cases. For each case, he examined “whether the case cited *Aymes* in the context of the five factors *Aymes* found to almost always be important,” how frequently the case addressed the *Reid* factors, and the court’s consistency in the use of a factor to determine the status of the hired party. *Id.* at 30–31. Professor Vacca created a continuum of the work made for hire factors, which grouped together factors based on their relative importance, i.e., least important to most important factors. *Id.* at 36. The results of the study revealed that four of the five *Aymes* factors were in the two groups on the most important side of the continuum—all except the hiring party’s right to control the manner and means of creation. *Id.* at 39. Vacca found the low importance of this factor to be surprising because the Supreme Court in *Reid* suggested that this factor was the ultimate question to be answered, not a factor itself. *Id.* Although courts other than the Second Circuit have ignored the importance of this one factor, courts still treat four of the five factors as some of the most important factors to determine the status of a hired party. *Id.*

⁸⁸ *Aymes v. Bonelli*, 980 F.2d at 862.

⁸⁹ *Id.* at 863 (“The importance of these two factors is underscored by the fact that every case since *Reid* that has applied the test has found the hired party to be an independent contractor where the hiring party failed to extend benefits or pay social security taxes.”).

b. Independent Contractor Work. The other work made for hire category is works prepared by an independent contractor. The Act defines this category of work as:

specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas. . . .⁹⁰

Therefore, in order to qualify as independent contractor work, the work must fall into one of the nine enumerated categories. In addition, “the parties [must] expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.”⁹¹ While some courts have determined that the agreement need not use the exact words “work made for hire,” it is clear that the language of the agreement must set forth this understanding between the parties.⁹²

Even if the parties agree in writing that the tattoo is a work made for hire,⁹³ a tattoo does not fall into one of the enumerated categories of an independent contractor work. While it has been suggested that a tattoo could be considered a contribution to a collective work,⁹⁴ it is unlikely that a court would accept this classification of tattoos. Therefore, the “contribution to a collective work” enumerated category is not applicable to tattoos.⁹⁵ Absent this classification,

⁹⁰ 17 U.S.C. § 101.

⁹¹ *Id.*

⁹² See *Eliscu v. T.B. Harms Co.*, 151 U.S.P.Q. 603, 604 (N.Y. Sup. Ct. 1966) (noting that the phrase “we engage and employ you” does not necessarily create a for-hire relationship); see also *NIMMER & NIMMER*, *supra* note 41, § 5.03[B][3][b], at 5-14 to 5-17; *Armento v. Laser Image, Inc.*, 950 F. Supp. 719, 729–30 (W.D.N.C. 1996) (noting that the absence of the term “work made for hire” in the contract was not fatal when the parties expressly intended that the work be owned by Laser Image).

⁹³ It is rare for tattoo artists to enter into any copyright agreement with their clients, much less one that would identify the tattoo as a work made for hire. See *Perzanowski*, *supra* note 56, at 534–35 (observing that “signed agreements that contemplate copyright ownership are practically unheard of in the tattoo industry”).

⁹⁴ *Cotter & Mirabole*, *supra* note 22, at 105.

⁹⁵ See 17 U.S.C. § 101 (defining a collective work as “a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.” Even in instances where a tattoo is applied to the body of a person who has a number of other tattoos, this type of contribution does not seem consistent with the illustrative examples in the definition of a

tattoos would not fall within one of the independent contractor categories of works.

C. COPYRIGHT OWNERSHIP AGREEMENTS

Signed agreements concerning tattoo copyright ownership are rare.⁹⁶ However, in *Whitmill*, Mike Tyson signed an agreement acknowledging “that all artwork, sketches and drawings related to [his] tattoo and any photographs of [his] tattoo are property of Paradox-Studio of Dermagraphics.”⁹⁷ In *Allen*, Williams executed an agreement with broader language regarding copyright ownership of the artwork.⁹⁸ While it may be an uncommon practice in the tattoo industry at present, the discussion of copyright ownership and execution of an agreement is advisable to clarify any ambiguities concerning ownership of the copyright interest in a tattoo at the time of its creation.⁹⁹

The *Allen* lawsuit troubled the NFL Players Association (NFLPA).¹⁰⁰ The NFLPA has advised players to seek copyright waivers or licenses from their tattoo artists in order to protect the players, and the union, from liability.¹⁰¹ For example, NFL quarterback Colin Kaepernick has already secured copyright waivers from two tattoo artists so his digital avatar can appear in the Madden NFL 15 video game.¹⁰²

collective work. Several tattoos may be fixed on one human medium, and they may even be interconnected. However, tattoos are not “assembled” into one whole work like periodicals or encyclopedias.)

⁹⁶ Perzanowski, *supra* note 56, at 534–35.

⁹⁷ *Whitmill* Complaint, *supra* note 10, ¶ 7 (tattoo artist alleging infringement of copyright in tattoo design).

⁹⁸ *Allen* Complaint, *supra* note 4, at 12–13 (the agreement stated: “Artwork remains property of [Stephen] Allen unless otherwise expressed. All rights are reserved by owner. Any form of reproduction is prohibited by state and federal [copyright] laws.”).

⁹⁹ See Meredith Hatic, Note, *Who Owns Your Body Art?: The Copyright and Constitutional Implications of Tattoos*, 23 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 396, 427 (2012) (“Requiring a written instrument or a contract detailing who owns the work and providing what the subject can do with the work would eliminate a great deal of confusion in tattoo copyright infringement cases.”); see also Hatcher, *supra* note 33, at 21 (“Specific contractual terms between tattoo artists and their clients can reduce many of the risks of tattoo copyright. Clear, one-person ownership, whenever possible, would avoid future difficulties.”).

¹⁰⁰ Boudway, *supra* note 9.

¹⁰¹ *Id.*

¹⁰² Ira Boudway, *Tattooed Quarterback Colin Kaepernick Got Copyright Waivers To Appear In Video Game*, BLOOMBERG BUSINESSWEEK (June 5, 2014), <http://www.businessweek.com/news/2014-06-05/tattooed-quarterback-colin-kaepernick-got-copyright-waivers-to-appear-in-video-game> (discussing the

Tattooing has become more socially acceptable and commonplace in the United States,¹⁰³ and tattoos are increasingly visible on celebrities and athletes.¹⁰⁴ Sports have continued to gain prominence and profitability in the United States, and athletes, and the numerous tattoos they bear, are often seen in television, film, video games and other media. The prominent reproduction and display of these tattoos in lawsuits such as *Allen* increases the likelihood of tattoo artists going outside the norms of their industry to enforce their rights against uses by third parties. It is prudent for organizations, such as the NFLPA, to continue to insist that players seek waivers or licenses from tattoo artists, in an effort to reduce their potential copyright liability.

III. ENFORCEMENT OF TATTOO COPYRIGHTS

Even if ownership of the copyright in a tattoo is not an ambiguous or a contested issue, the copyright owner will face challenges in the enforcement of the copyright. Section 106 of the 1976 Copyright Act provides several exclusive rights to the copyright owner.¹⁰⁵ The reproduction, derivative works, distribution, and public display rights are the most relevant to the owner of a tattoo copyright. In the context of tattoo copyright ownership, these rights are subject to the defenses of fair use and an implied license.¹⁰⁶ In addition, Thirteenth Amendment¹⁰⁷ concerns have been raised in connection with the copyrightability of tattoos and enforcement of tattoo copyrights,¹⁰⁸ and such

NFLPA's and Electronics Arts Inc.'s insistence that Kaepernick obtain copyright waivers in order for his digital avatar to appear in EA's video game).

¹⁰³ King, *supra* note 2, at 135.

¹⁰⁴ Wendy Haywood, Kent Patrick, Anthony M.A. Smith, Judy M. Simpson, Marian K. Pitts, Juliet Richters & Julia M. Shelley, *Who Gets Tattoos? Demographic and Behavioral Correlates of Ever Being Tattooed in a Representative Sample of Men and Women*, 22 AEP 51 (2012) (conducting telephone interviews of Australian adults to determine prevalence of and motivations for having been tattooed and summarizing telephone study of prevalence of tattooing among American adults); Ramin Setoodeh, *Kat Von D: Are Celebrities Driving Tattoo Culture?*, NEWSWEEK (Nov. 8, 2010), <http://www.newsweek.com/kat-von-d-are-celebrities-driving-tattoo-culture-69897> (discussing growth in popularity of tattoos among celebrities).

¹⁰⁵ 17 U.S.C. § 106.

¹⁰⁶ The exclusive rights of the copyright owner are also subject to a number of limitations and exemptions, most of which are not relevant to this Article. *See, e.g., id.* §§ 109(a), 110.

¹⁰⁷ U.S. CONST. amend. XXIII, § 1 ("Neither slavery, nor involuntary servitude, except as a punishment for crime whereof the party shall have been duly convicted, shall exist within the United States, or any place subject to their jurisdiction.")

¹⁰⁸ Declaration of David Nimmer, ¶¶ 16, 20, *Whitmill*, No. 4:11-CV-752 [hereinafter Nimmer Declaration].

concerns are addressed below following an analysis of the exclusive rights of the owner of a tattoo copyright and the defenses to copyright infringement claims.

A. REPRODUCTION

The right to reproduce a copyrighted work is considered to be the core right of the copyright owner.¹⁰⁹ The reproduction right “encompasses all acts by which a copyrighted work is embodied in a copy . . . without regard to whether the copy . . . is used for commercial or noncommercial purposes, whether it is made for public distribution or private use, or whether many copies or . . . but a single copy . . . are produced.”¹¹⁰ Unlike the rights of distribution, display and to create derivative works, further fixation in a tangible object is required in order to infringe the reproduction right.¹¹¹

The plaintiffs in *Allen*, *Whitmill*, *Reed* and *Escobedo* all alleged violation of their exclusive right to reproduce their copyrighted work.¹¹² In these four tattoo lawsuits, the plaintiffs were primarily concerned about the copying of their works by third-party companies—movie production studios, advertising agencies, footwear companies, and video game developers, for the commercialization of a product—a film, athletic shoe and video game.¹¹³ In *Whitmill* and *Escobedo*, the tattoo bearers were not defendants. In *Allen* and *Reed*, the tattoo artists’ clients were defendants because the plaintiffs alleged their

¹⁰⁹ *Sony Corp. of America v. Universal City Studios*, 464 U.S. 417, 477–81 (1984) (“Copyright is based on the belief that by granting authors the exclusive rights to reproduce their works, they are given an incentive to create . . . [S]uch an extension [to the fair use doctrine] risks eroding the very basis of copyright law, by depriving authors of control over their works and consequently of their incentive to create.”).

¹¹⁰ 2 GOLDSTEIN, *supra* note 53, § 5.1, ¶ 5:9.

¹¹¹ *Id.*

¹¹² *Allen* Complaint, *supra* note 4, ¶ 17, No. 5:12-CV-3172 (W.D. La. Dec. 31, 2012), *dismissed* (W.D. La. Apr. 9, 2013); *Whitmill* Complaint, *supra* note 10, ¶ 17 No. 4:11-CV-752 CDP (E.D. Mo. Apr. 28, 2011), *dismissed* (E.D. Mo. June 22, 2011); *Reed* Complaint, *supra* note 16, ¶ 28, No. 3:05-CV-00198 (D. Or. Feb. 10, 2005), *dismissed* (D. Or. Oct. 19, 2005); *Escobedo* Complaint, *supra* note 6, ¶ 49, No. 2:12-CV-02470 (D. Ariz. Nov. 16, 2012), *bankruptcy status conference ordered* (D. Ariz. June 26, 2013), *sub. nom. In re THQ, Inc.*, 1:12-BK-13398 (Bankr. D. Del. Dec. 19, 2013) (transferred to bankruptcy court); Notice of Appeal By Christopher Escobedo, 1:12-BK-13398, 1143 (Bankr. D. Del. Sept. 9, 2013); Corrected Order Estimating Claim Filed By Christopher Escobedo, 1:12-BK-13398, 1093 (Bankr. D. Del. Aug. 19, 2013) (estimating Escobedo’s unsecured claim at \$22,500 and administrative claim at \$0).

¹¹³ *See Allen* Complaint, *supra* note 4; *Whitmill* Complaint, *supra* note 10; *Reed* Complaint, *supra* note 16; *Escobedo* Complaint, *supra* note 6.

clients asserted that they had exclusive or co-ownership of the tattoo copyrights and, in *Reed*, the plaintiff artist alleged that his client did so with knowledge that the other defendants would rely upon this representation in the creation of infringing reproductions.¹¹⁴

Tattoo artists recognize that they have little control over the customer's body.¹¹⁵ As discussed in Parts III.D and III.E, tattoo artists expect their clients to publicly display their works,¹¹⁶ and they acknowledge the prevalence of such exposure in the tattoo industry.¹¹⁷ The plaintiffs in each of the tattoo lawsuits conceded that their athlete clients had an implied license to publicly display the work in order to pursue a livelihood in acting and sports.¹¹⁸ However, the plaintiffs did not authorize reproduction by their clients and certainly did not authorize the exercise of this right by third party companies.¹¹⁹ As explained in Part III.F, an implied license "permits the use of a copyrighted work in a particular manner,"¹²⁰ and the copyright owner must have the intent that the person exercises a particular exclusive right of the copyright owner.¹²¹ While tattoo artists expect a client to publicly display a tattoo on the client's body (and the complaints in tattoo lawsuits support this consent),¹²² it does not follow that tattoo artists are also granting an implied license to the client to reproduce the

¹¹⁴ Allen Complaint, *supra* note 4, ¶ 28; Reed Complaint, *supra* note 16, ¶ 37. However, plaintiffs acknowledged the possibility of joint authorship of the tattoos, and therefore, co-ownership of the works. *Id.* In light of this alternative, plaintiff sought an accounting for his share of any revenue realized by his client from exploitation of the co-owned tattoo. *Id.* ¶ 38.

¹¹⁵ Perzanowski, *supra* note 56, at 532 ("Both during and after the design process, tattooers consistently demonstrate a respect for client autonomy. To varying degrees, client input helps shape the design of a custom tattoo. And once an image is created on the client's skin, tattooers uniformly acknowledge that control over that image, with some limited exceptions, shifts to the client."). Tattoo artists' recognition of the clients' autonomy in the display of the tattoo should minimize some Thirteenth Amendment concerns, further discussed *infra* note 230. See also Perzanowski, *supra* note 56, at 530; David M. Cummings, Comment, *Creative Expression and the Human Canvas: An Examination of Tattoos as a Copyrightable Art Form*, 2013 U. ILL. L. REV. 279, 308, 316–17.

¹¹⁶ Allen Complaint, *supra* note 4, ¶ 10 (stating that Allen knew Williams was a professional football player, and therefore, Allen "assumed he would see his art on television").

¹¹⁷ Reed Complaint, *supra* note 16, ¶ 14.

¹¹⁸ See Allen Complaint, *supra* note 4; Whitmill Complaint, *supra* note 10; Escobedo Complaint, *supra* note 6.

¹¹⁹ See Allen Complaint, *supra* note 4; Escobedo Complaint, *supra* note 6; Whitmill Complaint, *supra* note 10; Reed Complaint, *supra* note 16.

¹²⁰ I.A.E., Inc. v. Shaver, 74 F.3d 768, 775 (7th Cir. 1996).

¹²¹ See *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1235 (11th Cir. 2010).

¹²² See Allen Complaint, *supra* note 4, ¶ 10; Whitmill Complaint, *supra* note 10; Escobedo Complaint, *supra* note 6.

tattoo in cooperation with third-party companies.¹²³ Such uses are not acceptable under the norms of the tattoo industry,¹²⁴ and there is no evidence that any of the plaintiffs' in the tattoo lawsuits to date intended to grant an implied license of this scope to their clients. Tattoo artists disfavor uses of their tattoos that are disconnected from the body of the tattoo bearer,¹²⁵ which has been demonstrated in the tattoo lawsuits to date and is likely to be the case in the future when third-party companies are reproducing the likeness of a tattoo bearer or the tattoo itself.

B. PREPARATION OF DERIVATIVE WORKS

A derivative work is defined as:

a work based upon one or more pre-existing works, such as a translation fictionalization, motion picture version, sound recording, art reproduction, abridgement, 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."¹²⁶

The language "based upon one or more preexisting works" has been interpreted to imply that a derivative work must incorporate underlying copyrightable subject matter.¹²⁷ In order to be considered a derivative work, the latter work must contain a sufficient amount of the underlying work to amount to an infringement of the underlying work.¹²⁸ The conclusion of the

¹²³ *Latimer*, 601 F.3d at 1235 ("Implied licenses may be limited and a defendant who exceeds the scope of an implied license commits copyright infringement.")

¹²⁴ Perzanowski, *supra* note 56, at 537 ("In addition to public displays of their tattoos, [tattoo artists] acknowledge clients' rights to re-produce images of their tattooed bodies, whether by uploading images to their Facebook profiles, submitting photos for publication in tattoo magazines, or even reproducing a picture of the tattoo for commercial purposes. . . . But under prevailing industry norms, not all client uses are acceptable. Tattooers distinguish between uses of the tattoo as applied to the body, which are universally accepted, and uses of the tattoo design as a work disconnected from the body, which are subject to greater skepticism.")

¹²⁵ *Id.*

¹²⁶ 17 U.S.C. § 101.

¹²⁷ NIMMER & NIMMER, *supra* note 41, § 3.01, at 3–4.

¹²⁸ 2 *id.* § 8.09[A], at 8-142.8 (13) n.3 ("There would be infringement only if the pre-existing work has itself not entered the public domain and has not been licensed for use in the later work.")

first article in this series that addresses the applicability of copyright law to tattoos, concludes that tattoos are subject to copyright law.¹²⁹ The copyright owner of the pre-existing work has the exclusive right to prepare derivative works based upon that underlying copyrighted material. Thus, the owner of a tattoo copyright has the exclusive right to prepare works based upon that tattoo.

According to the legislative history of the 1976 Act, the derivative works right overlaps with the reproduction right to some extent, but the derivative works right is broader than that right.¹³⁰ Fixation in a tangible medium of expression is required in order to create an infringing copy of a work, but fixation is not required in order to prepare an infringing derivative work.¹³¹ In addition, the derivative works right has been interpreted as picking up where the reproduction right leaves off—the point at which the contribution of original material to an existing work creates a new work.¹³²

The plaintiffs in *Allen*, *Escobedo*, *Whitmill*, and *Reed* all alleged infringement of their derivative works right,¹³³ and it is possible that the defendants created infringing derivative works in these cases. It is arguable whether the defendants added sufficiently original material to the tattoos in the video games in *Escobedo* and *Allen*, the Maori-style facial tattoo reproduced onto the face of another actor in *Whitmill*,¹³⁴ and the digital reproduction of the Egyptian-themed family tattoo in the Nike commercial in *Reed*.¹³⁵ Professors Glynn Lunney and Mark Lemley provide less protection to derivative users who have made no or little changes to the underlying works.¹³⁶ This approach disfavors the uses of the tattoos in all of the aforementioned lawsuits. In *Allen*, *Escobedo*, and *Whitmill*, the defendants made no changes to the underlying works.¹³⁷ In fact, the defendants' intentions were to replicate the appearance of the tattoos as closely

¹²⁹ King, *supra* note 2, at 160–61.

¹³⁰ H.R. REP. NO. 94-1476, at 62 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5675.

¹³¹ *Id.*

¹³² GOLDSTEIN, *supra* note 53, § 5.1, ¶ 5:8.

¹³³ See *Allen* Complaint, *supra* note 4; *Whitmill* Complaint, *supra* note 10; *Reed* Complaint, *supra* note 16; *Escobedo* Complaint, *supra* note 6.

¹³⁴ *Whitmill* Complaint, *supra* note 10.

¹³⁵ *Reed* Complaint, *supra* note 16.

¹³⁶ Amy B. Cohen, *When Does a Work Infringe the Derivative Works Right of a Copyright Owner?*, 17 CARDOZO ARTS & ENT. L.J. 623, 648–49 (1999) (Professors Glynn Lunney and Mark Lemley argue that the law should be more willing to hold defendants who contribute little to the “progress of useful arts and sciences” liable for infringement).

¹³⁷ *Allen* Complaint, *supra* note 4; *Escobedo* Complaint, *supra* note 6; *Whitmill* Complaint, *supra* note 10.

as possible.¹³⁸ In *Reed*, the defendants digitally recreated the tattoo onto the arm of the tattoo bearer in the television advertisement.¹³⁹ Again, the purpose was to recreate the same tattoo, with no changes to it.¹⁴⁰ Even if there was sufficiently original material added to the context surrounding the tattoos, there was little creativity in their use.

C. DISTRIBUTION

The owner of a copyright has the exclusive right “to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending.”¹⁴¹ It has been observed that the distribution right “is unlikely to be infringed in the tattoo context given that tattoos are fixed upon human skin.”¹⁴² This Article disagrees with that proposition. While a human being (and the tattoo affixed to that person) cannot be distributed, the person can appear in various media, in which the work is widely distributed. For example, in *Whitmill*, the defendant first reproduced the tattoo onto the face of another actor before distributing copies of the tattoo in the broadcast of the film as well as promotional and advertising materials for the film.¹⁴³ In *Allen* and *Escobedo*, the likenesses of the athletes, which included their tattoos, were digitally recreated or reproduced to appear in widely distributed video games.¹⁴⁴ Thus, while in some cases the distribution right does not necessitate reproduction in order to be infringed,¹⁴⁵ reproduction in some medium has preceded the infringing distribution of the tattoo in the tattoo lawsuits to date.

¹³⁸ *Allen* Complaint, *supra* note 4; *Escobedo* Complaint, *supra* note 6; *Whitmill* Complaint, *supra* note 10.

¹³⁹ *Reed* Complaint, *supra* note 16.

¹⁴⁰ *Id.*

¹⁴¹ 17 U.S.C. § 106(3) (2012).

¹⁴² *Hatic*, *supra* note 99, at 407. *Hatic* appears to assume that the tattoo is fixed to the skin in the first instance and infringement of the distribution right would necessitate reproduction of the sketch or stencil of the design created by the tattoo artist prior to fixing the design on the body. *Id.*

¹⁴³ *Whitmill* Complaint, *supra* note 10, ¶ 1.

¹⁴⁴ *See Allen* Complaint, *supra* note 4, ¶ 12; *Escobedo* Complaint, *supra* note 6, ¶ 47.

¹⁴⁵ 2 *NIMMER & NIMMER*, *supra* note 41, § 8.12[A], at 8-249.

D. PUBLIC DISPLAY

A tattoo is a pictorial work, part of one of the eight categories of copyrightable subject matter set forth in Section 102(a) of the Copyright Act.¹⁴⁶ Owners of a copyright for a pictorial work enjoy the exclusive right to publicly display their works.¹⁴⁷

The public display right is the most significant limitation on the ability of tattoo bearers to appear in public with their tattoos in view.¹⁴⁸ It is especially problematic if the tattoo bearer is a celebrity, such as an athlete, music artist, or television or film actor, because the pursuit of that person's livelihood depends on public appearances. Infringement of the public display right would seem nearly unavoidable. If the tattoo artist is the owner of the copyright in the tattoo, then he is in a precarious position. One of the ways in which tattoo artists generate business is through the display of their works to the public. Tattoo artist Matthew Reed charged Rasheed Wallace \$450.00 for an elaborate tattoo on Wallace's arm.¹⁴⁹ However, Reed expected that the public display of the tattoo on Wallace—a famous athlete—would generate publicity for his work and Reed “conceded that such exposure would be considered common in the tattoo industry.”¹⁵⁰ How should copyright law balance the tattoo artist's copyright ownership of a work, and the exclusive rights to control the reproduction, distribution, and display of the work that flow from such ownership,¹⁵¹ with the unavoidable and often desired display of that work?

¹⁴⁶ King, *supra* note 2, at 160 (categorizing tattoos as pictorial, graphic, and sculptural (PGS) works and concluding that the useful article doctrine does not preclude copyrightability of this type of PGS work).

¹⁴⁷ 17 U.S.C. § 106(4)–(5). Tattoos, like other pictorial, graphic and sculptural works are capable of being displayed, but they cannot be performed. Hatic, *supra* note 99, at 408.

¹⁴⁸ Hatic, *supra* note 99, at 408.

¹⁴⁹ Harkins, *supra* note 62, at 316.

¹⁵⁰ *Id.*

¹⁵¹ 17 U.S.C. § 106 (“[T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public . . . (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the copyrighted work publicly by means of digital audio transmission.”).

Professor Roberta Kwall proposes a solution for balancing a tattoo artist's copyright with the inevitable diminution of the exclusive right of display.¹⁵² Kwall's book *The Soul of Creativity* focuses on the lack of concern for moral rights in the U.S. copyright system. She analyzes these rights in the context of a number of copyrightable works, including tattoos.¹⁵³ Professor Kwall concludes that "[a] moral rights claim . . . is more complicated in light of the tattoo being incorporated into the very being of another individual."¹⁵⁴ A copyright infringement claim is also more complicated for this same reason—the tattoo becomes a part of the customer's likeness. As Whitmill testified during the preliminary injunction hearing of the *Whitmill v. Warner Bros. Entertainment* case, his client Mike Tyson was allowed to go anywhere and be seen anywhere with the tattoo on his face because it is a part of his likeness.¹⁵⁵ A tattoo artist who is the sole copyright owner in a work is entitled to control over *use* of the work;¹⁵⁶ however, the artist has no control over the human medium.¹⁵⁷ Although Professor Kwall acknowledges that Reed's lawsuit revealed uncertainty regarding the application of joint authorship law, she proposes the following resolution when "someone in Wallace's position advertises something to which the tattoo artist objects, and the tattoo is a prominent part of the advertisement":

¹⁵² KWALL, *supra* note 65, at 106.

¹⁵³ *Id.*

¹⁵⁴ *Id.*

¹⁵⁵ Hearing Transcript, *supra* note 11, at 20 (first session, May 23, 2011) (Whitmill's response to question by defendant's counsel regarding Whitmill's understanding of what Tyson could do with the artwork tattooed on this face without Whitmill's approval: "I would have imagined he would be allowed to go anywhere he wanted and be seen anywhere he wants with that tattoo. It's his likeness now. He's more than welcome to be anywhere he wants to be with it."). This line of reasoning raises more intriguing questions concerning a client's right of publicity in his likeness, which might include his tattoos. Such considerations are beyond the scope of this Article.

¹⁵⁶ See 17 U.S.C. § 106 (2012).

¹⁵⁷ I agree with Professor David Nimmer's rationale that cosmetic changes to the body itself are not copyrightable and may raise Thirteenth Amendment concerns; see David Nimmer, *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 Hous. L. Rev. 1, 29 (2001) ("Hopefully, any court presented with such an obscene claim would dismiss it summarily, if on no other basis than the constitutional prohibition on involuntary servitude and other badges of slavery."). However, I disagree with (1) the analogy of cosmetic surgery to tattooing and (2) an unqualified prohibition of copyrightability of tattoos. See Nimmer Declaration, *supra* note 108, ¶ 16. Unlike surgical alterations to the human flesh performed by a cosmetic surgeon, a tattoo artist seeks to protect the artwork fixed on the human body, not the human body itself. Nevertheless, possible Thirteenth Amendment concerns could result from the tattoo artist's attempted enforcement of his rights, which is why I argue that such enforcement is limited in light of the client's autonomy.

Perhaps this situation can be resolved by invoking a type of public display right pursuant to which the subject of the tattoo can display the tattoo publicly under the theory that once the tattoo artist puts her artwork into the public eye by placing it on another person, she arguably loses the ability to control subsequent displays of her work by the person wearing the tattoo.¹⁵⁸

Professor Kwall analogizes her proposal to a current limitation on the public display right of the copyright owner, 17 U.S.C. § 109(c).¹⁵⁹ Under Section 109(c), the owner of a lawfully made copy of a work, or any person authorized by that owner “is entitled, without the authority of the copyright owner, to display that copy publicly, either directly or by the projection of no more than one image at a time, to viewers present at the place where the copy is located.”¹⁶⁰ In the context of tattoos, this means that if a customer purchases a tattoo from a tattoo artist, then a type of public display limitation similar to Section 109(c) could be invoked to allow the customer to display the tattoo to the public without the permission of the tattoo artist. This type of public display right would significantly limit the ability of the tattoo artist to control the manner in which his work is displayed. On the other hand, the tattoo artist’s ability to control the public display of his work is already compromised in light of the mobility of the medium on which his work is fixed.

While a public display right would protect tattoo customers in Wallace’s position,¹⁶¹ it would not protect defendants like Warner Bros. in *Whitmill*. In that case, defendants took the use of a tattoo artist’s copyrighted tattoo a step further. Tattoo artist Whitmill sued Warner Bros. for the unauthorized reproduction of Whitmill’s tattoo, which is displayed on the face of former

¹⁵⁸ KWALL, *supra* note 65, at 107.

¹⁵⁹ *Id.*

¹⁶⁰ 17 U.S.C. § 109(c) (2012).

¹⁶¹ It appears that Professor Kwall’s proposed public display right is broader than § 109(c), and therefore, it would also shield the corporate defendants in *Reed v. Nike*, advertising agency Weiden & Kennedy and footwear company Nike, Inc. Section 109(c) does not protect transmissions of the copyrighted work, but Professor Kwall does not suggest a similar limitation for tattoo bearers’ subsequent displays of a work. In fact, she asserts that tattoo bearers should be able to publicly display their tattoos in advertisements without fear of an infringement suit. Similarly, this Article posits that the public display right of tattoo bearers should be broader than the current limitation set forth in § 109(c).

heavyweight boxing champion Mike Tyson, onto the face of another actor¹⁶² in its motion picture *The Hangover Part II*.¹⁶³ Whitmill further claimed that Warner Bros. infringed his copyright through the creation of this derivative work, and the distribution and public display of the derivative tattoo in the advertisement and promotion of the movie.¹⁶⁴ It is notable that Whitmill did not sue Tyson for appearing in the first “Hangover” movie or the sequel. Professor Kwall’s proposed limitation on the public display right would provide an exemption for Tyson’s appearance in the film, not Warner Bros.’ reproduction of Tyson’s tattoo on the face of another actor in the film.

E. FAIR USE

In *Whitmill*, Judge Catherine D. Perry denied tattoo artist S. Victor Whitmill’s motion to preliminarily enjoin the release of the motion picture *The Hangover Part II*.¹⁶⁵ During the preliminary injunction hearing, she cursorily rejected “Warner Bros.’ fair use and parody arguments, noting Warner Bros. reproduction of Whitmill’s 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.’”¹⁶⁶ Judge Perry also suggested that Warner Bros.’ use of another tattoo could have accomplished the same purpose as the use of the allegedly infringing tattoo.¹⁶⁷

¹⁶² Mike Tyson appeared in *THE HANGOVER* and *THE HANGOVER PART II*. See *Warner Bros. Answer*, *supra* note 12, ¶¶ 15–16; Warner Bros. states that Mr. Tyson appeared, with Mr. Tyson’s tattoo, in the first Hangover movie, as well as in an advertising poster for the first Hangover movie, and that thousands of images of Mr. Tyson, with Mr. Tyson’s tattoo, have appeared in magazines, television and on the internet since February 10, 2003. *Id.* Warner Bros. admitted that Tyson’s tattoo and the tattoo appearing on actor Ed Helms’s face in *The Hangover Part II* are similar but denied that there was any copyrightable expression in Tyson’s tattoo or that the tattoo on Helms’s face was pirated. *Id.*

¹⁶³ See *Whitmill Complaint*, *supra* note 10, ¶ 1.

¹⁶⁴ Judge Perry found that Whitmill had shown irreparable harm if Warner Bros. sequel was not enjoined because Whitmill had “lost control over the image he had created, and a good example of that was the 7-Eleven promotion, where the image itself was being used to signify something, and he had no compensation, no right to stop that, no right to control it.” Hearing Transcript, *supra* note 11, at 6.

¹⁶⁵ King, *supra* note 2, at 141 (citing Hearing Transcript, *supra* note 11, at 3).

¹⁶⁶ *Id.* at 141–42 (citing Hearing Transcript, *supra* note 11, at 4).

¹⁶⁷ *Id.* at 142 (citing Hearing Transcript, *supra* note 11, at 4).

Whitmill is the only tattoo lawsuit to consider the issues of fair use or parody.¹⁶⁸ Fair use provides an affirmative defense to infringement for “the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research.”¹⁶⁹ The Supreme Court has held that parody may be a fair use within the meaning of § 107 of the Copyright Act.¹⁷⁰ Parody is defined as, *inter alia*, a “literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule.”¹⁷¹

The parodic nature of a work significantly impacts the analysis of the four fair use factors set forth in § 107: (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.¹⁷² For example, in *Campbell*, a case in which rap group 2 Live Crew wrote, recorded and distributed the song “Pretty Woman,” an alleged parody of the song “Oh, Pretty Woman,” a rock song written by Roy Orbison and William Dees, the Court noted that the Court of Appeals properly

¹⁶⁸ Parody seems inapplicable in the other tattoo lawsuits to date; however, the defense of fair use could have been raised in other lawsuits had they proceeded.

¹⁶⁹ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 576 (1994) (citing 17 U.S.C. § 107).

¹⁷⁰ *King*, *supra* note 2, at 141, n.70 (citing *Campbell*, 510 U.S. at 594).

¹⁷¹ *Id.* (citing *Campbell*, 510 U.S. at 580) (“Modern dictionaries accordingly describe a parody as a ‘literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule,’ or as a ‘composition in prose or verse in which the characteristic turns of thought and phrase in an author or class of authors are imitated in such a way as to make them appear ridiculous.’”).

¹⁷² 17 U.S.C. § 107 (2012). Professor David A. Simon proposes a different test in order to determine whether a parody is fair use. He asserts that the Reasonable Perception Test (RPT) should be used to determine whether the parodic character of the work can be reasonably perceived. David A. Simon, *Reasonable Perception and Parody in Copyright Law*, 2010 UTAH L. REV. 779, 781.

“Reasonably perceiving” a parody requires that the following can reasonably be perceived: (1) the work comments, at least in part, on the underlying work’s substance or style; (2) the work does not use the underlying work merely as a vehicle to comment on society generally; and (3) the work is not used merely to garner attention or (4) to avoid the effort required to create something new.

Id. at 786. Professor Simon argues that the scope of the parody doctrine should be refocused to include “not only parodies that comment on the underlying work, but also parodies that comment on individuals’ associations with it.” *Id.* at 816. While I disagree with a proposal to abandon the fair use factors, even in cases of parody, Warner Bros.’ use of the copyrighted tattoo in *The Hangover Part II* would fail the RPT because, as discussed below, it fails the first two factors of the test, which are the “heart of the parody inquiry.” *Id.* at 786.

assumed that 2 Live Crew's song contained parody commenting on and criticizing the original work, but found that it erred in giving virtually dispositive weight to the commercial nature (factor one) of that parody by way of a presumption.¹⁷³ The Supreme Court also rejected the lower court's presumption of market harm (factor four) when it analyzed whether 2 Live Crew's parody was a transformative¹⁷⁴ and, thus, a fair use of "Oh, Pretty Woman."¹⁷⁵

During the preliminary injunction hearing, the *Whitmill* parties discussed the applicability of the *Campbell* case.¹⁷⁶ In response to Judge Perry's request that Warner Bros.' counsel explain the parody in *The Hangover Part II*, counsel responded:

Well, sure. You have got this powerful figure, Mike Tyson, in the original film with the tattoo on his face. What does he do? He knocks someone out when he is angry at them. He is the epitome of male aggression. Instead, now you have this milk toast character with the same tattoo on his face. It's a real spoof on men and their misadventures.¹⁷⁷

Judge Perry replied:

Yeah, I get that. I thought you had to have something that was parodying or commenting on the actual copyrighted thing. They are not saying they have got a copyright on men and their stupid behavior, and so how is this parody with regard to the tattoo?¹⁷⁸

Judge Perry correctly identifies a critical obstacle to the success of the parody defense in a case like *Whitmill*. In *Campbell*, the Supreme Court drew a distinction between parody, which may be protected under the fair use defense,

¹⁷³ *Campbell*, 510 U.S. at 584.

¹⁷⁴ The Court defines the transformative nature of a work, which is the "central purpose" of the first factor inquiry, as "whether the new work 'merely supersedes' the objects of the original creation, 'supplanting' the original, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message." *Id.* at 579 (citation omitted).

¹⁷⁵ *Id.* at 594.

¹⁷⁶ Hearing Transcript, *supra* note 11, at 57 (Warner Bros.' counsel argued that under *Campbell*, "if there is a colorable claim for fair use no injunction should issue").

¹⁷⁷ *Id.*

¹⁷⁸ *Id.*

and satire, which is not protectable: Parody needs to mimic an original to make its point, “and so has some claim to use the creation of its victim’s (or its collective victims’) imagination,” whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.¹⁷⁹ As defendant’s counsel explains, the use of the tattoo is actually a satire of men’s behavior, specifically the masculinity and aggression of Mike Tyson, the bearer of the copyrighted tattoo, and the other movie character’s lack of these qualities.

In addition, counsel’s explanation raises the issue of whether the tattoo itself is the subject of the commentary, or whether the subject is actually Mike Tyson. The plot of *The Hangover Part II*, as well as counsel’s explanation of the use of the tattoo in the movie, both support a finding of the latter.¹⁸⁰ If a character in the movie is the true subject of the commentary, and the use of the tattoo is incidental or irrelevant to that commentary, then such use is not fair use.¹⁸¹

Defendant’s counsel also concedes that the same tattoo on Mike Tyson’s face is used on the face of another actor in the movie.¹⁸² Judge Perry is critical of the parody defense because no changes were made to the tattoo.¹⁸³ Factor three asks whether “the amount and substantiality of the portion used in relation to the copyrighted work as a whole, . . . are reasonable in relation to the purpose of the copying.”¹⁸⁴ According to the Supreme Court, this factor hinges on the “persuasiveness of a parodist’s justification for the particular copying done, and the enquiry will harken back to the first of the statutory factors [because the Court] recognize[s] that the extent of permissible copying varies with the purpose and character of the use.”¹⁸⁵ Further, factor three “tend[s] to

¹⁷⁹ *Campbell*, 510 U.S. at 580–81.

¹⁸⁰ After watching the movie, I would assert that the subject of the commentary is Mike Tyson. Further, I posit that Warner Bros. chose to reproduce the tattoo on the face of another actor because the tattoo now conveyed qualities associated with Mike Tyson’s likeness (now a face adorned with a tattoo), such as aggression, masculinity and strength. The use of this tattoo raises issues regarding the overlap of a tattoo artist’s rights in the copyright and a celebrity’s right of publicity. These issues are beyond the scope of this Article.

¹⁸¹ See *Campbell*, 510 U.S. at 580 (“If . . . the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another’s work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger.”).

¹⁸² Hearing Transcript, *supra* note 11, at 69–70.

¹⁸³ King, *supra* note 2, at 141–42 (citing Hearing Transcript, *supra* note 11, at 4).

¹⁸⁴ *Campbell*, 510 U.S. at 586 (citing 17 U.S.C. § 107(3)).

¹⁸⁵ *Id.* at 586–87 (citing *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 449–50 (1984) (reproduction of entire work does not have its ordinary effect of militating against a finding of fair use as to home videotaping of television programs)).

address the fourth [factor] by revealing the degree to which the parody may serve as a market substitute for the original or potentially licensed derivatives.”¹⁸⁶ Thus, by its very nature, “parody must be able to ‘conjure up’ at least enough of [the] original to make the object of its critical wit recognizable.”¹⁸⁷

Once enough [of the original work] has been taken to assure identification, how much more is reasonable will depend, say, on the extent to which the song’s overriding purpose and character is to parody the original or, in contrast, the likelihood that the parody may serve as a market substitute for the original.¹⁸⁸

Applying this factor to *Whitmill*, Warner Bros. took too much—the entire tattoo. Further, the nontransformative use weighs against using any more of the tattoo than necessary to make a parody.¹⁸⁹

In other lawsuits, such as *Allen, Escobedo* and *Reed*, where athletes’ tattoos are used as part of the athletes’ likenesses, a defendant has a slight chance of success with a fair use defense. In *Allen* and *Escobedo*, the uses are also apart from the tattoo bearers’ bodies¹⁹⁰ because video game publishers and distributors make digital reproductions of tattoo bearers, though they make little or no changes to the tattoos, in order to present literal depictions of athletes. Such uses may cut against finding a transformative use under fair use

¹⁸⁶ *Id.* at 587.

¹⁸⁷ *Id.* at 588.

¹⁸⁸ *Id.*

¹⁸⁹ Even without relying on the parody/satire distinction, an analysis of the fair use factors weighs against finding that Warner Bros.’ use of the tattoo is fair use. See Kathryn D. Piele, Comment, *Three Years After Campbell v. Acuff-Rose Music, Inc.: What Is Fair Game for Parodists?*, 18 LOY. L.A. ENT. L.J. 75, 99 (1997) (“The satire/parody distinction is unnecessary because the four-pronged fair use analysis will ferret out secondary works that merely hijack a copyrighted work for no purpose other than to avoid creativity. For example, the first fair use prong requires a court to look at whether the parody is transformative of the original work, which results in the creation of a new work. Through this analysis, a court can lean toward disallowing fair use protection for a parody that, instead of adding and building on the original work, merely uses the copyrighted work to ‘avoid the drudgery in working up something fresh.’” (citing *Campbell*, 510 U.S. at 580)).

¹⁹⁰ In *Whitmill*, Judge Perry pointed out that unlike in the first *Hangover* movie, the use of the tattoo was disconnected from Tyson’s face in the sequel, and though it was prominently displayed on the face of another actor throughout the movie, the display of the tattoo was insignificant to the plot of the movie. Hearing Transcript, *supra* note 11, at 56.

factor one,¹⁹¹ but defendants may be more successful in showing that the amount of copying was reasonable under factor three in order to convey an accurate representation of the athlete. Factor four, the effect upon the potential market for or value of the copyrighted work, could also pose an obstacle for such defendants.¹⁹²

In *Reed*, the tattoo was reproduced by computer simulation on the arm of the athlete and was the focus of defendants' television advertisement about the meaning of the athlete's tattoo, as opposed to an incidental display of the tattoo as part of the athlete's likeness. This type of use, arguably apart from the tattoo bearer's body, seems more transformative than an exact reproduction of the likeness of an athlete and his tattoo, which would lean in favor of the defendants.

Based on current third-party uses, factor one, the purpose and character of the use, may not weigh in a defendant's favor, unless the defendant can show transformative use. Factor two, the nature of the copyrighted work, favors the plaintiff if the work is a creative one and use of the work is minimally transformative.¹⁹³ Factor three "must be examined in context" to determine whether "[t]he extent of the . . . copying" is consistent with or more than necessary to further "the purpose and character of the use."¹⁹⁴ This factor seems to weigh against finding fair use if the tattoo is used in its entirety and not a transformative use. Factor four must also be determined in context, but it

¹⁹¹ Compare *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, Case No. 10-15387, 2013 U.S. App. LEXIS 15649 (9th Cir. July 31, 2013) (court, using the transformative test derived from the first factor of copyright law for balancing the First Amendment and the right of publicity, held that video game developer's unauthorized use of athlete's likeness in a video game is not protected by the First Amendment because such use is not sufficiently transformative), with *Brown v. Electronic Arts, Inc.*, Case No. 09-56675, 2013 U.S. App. LEXIS 15647 (9th Cir. July 31, 2013) (court, using a different test to balance the First Amendment and Lanham Act, held that plaintiff could not assert a Lanham Act false endorsement claim based on the use of his likeness in a line of video games because such use was protected by the First Amendment).

¹⁹² Plaintiff tattoo artists assert that there is harm to the potential market for their works. Tattoo artist Christopher Escobedo stated that he would charge \$50,000 to \$200,000 to license a tattoo copyright because copyright owners obtain similar licensing fees for the use of their music during sporting events. Boudway, *supra* note 9.

¹⁹³ *Castle Rock Entertainment v. Carol Publishing Group, Inc.*, 150 F.3d 132, 144 (2d Cir. 1998) (defendants conceded that "the scope of fair use is somewhat narrower for fictional works, such as *Seinfeld*, than others," and the court concluded that "[a]lthough this factor may be of less (or even of no) importance when assessed in the context of certain transformative uses . . . the fictional nature of the copyrighted work remains significant in the instant case, where the secondary use is at best minimally transformative").

¹⁹⁴ *Campbell*, 510 U.S. at 586-87.

is difficult for a defendant to succeed on this factor without favorable evidence about relevant markets.¹⁹⁵

F. IMPLIED LICENSE

In *Whitmill*, Judge Perry concluded that “most importantly, there is no evidence at all that Warner Bros. had any kind of a license implied or otherwise to use the tattoo, and so Warner Brothers’ use of the tattoo was unauthorized. . . .”¹⁹⁶ She also noted that “until hearing about this movie, Mr. Whitmill was not aware of any non-Tyson uses of the tattoo.”¹⁹⁷ Thus, while Whitmill impliedly licensed Mike Tyson’s use of the tattoo on his face in *The Hangover*, *The Hangover Part II*, and various other media, he did not grant any rights to third parties other than his client Tyson.¹⁹⁸

While the Copyright Act requires that a transfer of copyright ownership¹⁹⁹ be in writing, there is no writing requirement for an implied nonexclusive license.²⁰⁰ An implied license “may be granted orally, or may even be implied from conduct.”²⁰¹ In *Effects Associates, Inc. v. Cohen*, the Ninth Circuit set forth a three-prong test to determine when an implied nonexclusive license has been granted: (1) licensor created the work at licensee’s request, (2) licensor delivered the work to licensee, and (3) licensor intended that licensee copy and distribute the work.²⁰²

The “touchstone” for finding an implied license is intent.²⁰³ In *Asset Mktg. Sys., Inc. v. Gagnon*, the Ninth Circuit expanded the three-prong test set forth in *Effects*.²⁰⁴ The court reasoned that the last prong of the *Effects* test “is not

¹⁹⁵ *Id.* at 590.

¹⁹⁶ Hearing Transcript, *supra* note 11, at 56.

¹⁹⁷ *Id.*

¹⁹⁸ *Id.* (“The only use that Mr. Whitmill knew of this tattoo before this movie was all associated with Mr. Tyson, and he had a contract with Mr. Tyson.”).

¹⁹⁹ A “transfer of copyright ownership” is defined, in the Copyright Act, as “an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright. . . .” 17 U.S.C. § 101 (2012). The definition expressly excludes a nonexclusive license. *Id.*

²⁰⁰ *Id.* § 204.

²⁰¹ *Effects Assoc., Inc. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990) (citing 3 NIMMER & NIMMER, *supra* note 41, § 10.03[A], at 10-36).

²⁰² *Id.* at 559. The *Effects* test has been adopted by other courts, such as the Seventh and Eleventh Circuits. See *L.A.E.*, 74 F.3d at 776; *Latimer*, 601 F.3d at 1235.

²⁰³ *Estate of Hevia v. Portrio Corp.*, 602 F.3d 34, 41 (1st Cir. 2010).

²⁰⁴ *Asset Mktg. Sys., Inc. v. Gagnon*, 542 F.3d 748, 755 (9th Cir. 2008).

limited to copying and distribution.”²⁰⁵ Further, the relevant inquiry should look to the intent of the parties—“the licensor’s objective intent at the time of the creation and delivery” of the work “as manifested by the parties’ conduct.”²⁰⁶ Even an objective determination of intent requires a court to speculate about what the licensor was thinking at the time of creation and delivery of the work.²⁰⁷ In response to this problem, courts have examined several factors to determine whether a licensor had the requisite intent to grant an implied license to a party. The Seventh Circuit has reviewed “the language of the copyright registration certificate, the letter agreement, and deposition testimony; and the delivery of the copyrighted material without warning that its further use would constitute copyright infringement.”²⁰⁸ The First Circuit has considered:

(1) whether the parties were engaged in a short-term discrete transaction as opposed to an ongoing relationship; (2) whether the creator utilized written contracts . . . providing that copyrighted materials could only be used with the creator’s future involvement or express permission; and (3) whether the creator’s conduct during the creation or delivery of the copyrighted material indicated that use of the material without the creator’s involvement or consent was permissible.²⁰⁹

In the context of tattoos, the first two prongs of the *Effects* test are easily met. The first prong—requiring the licensee to request creation of the work—is satisfied when an individual requests a tattoo from the tattoo artist. The second prong—creation and delivery of the work—is fulfilled when the tattoo artist physically transfers the tattoo onto the individual’s body. Thus, the major inquiry is the third element—the requirement that the licensor intend that the licensee exploit one or more of the exclusive rights of the copyright owner.

As discussed in Parts III.D and III.G, the choice to permanently fix a work on another’s human body, in and of itself, necessitates a diminution in the

²⁰⁵ *Id.*; see also *Nat’l Ass’n for Stock Car Auto Racing, Inc. v. Scharle*, 184 F. App’x 270, 276 (3d Cir. 2006) (holding that the licensor “created the [work] with the intent that [it] would be used and displayed by [the licensee]”).

²⁰⁶ *Asset Mktg. Sys., Inc.*, 542 F.3d at 756.

²⁰⁷ Craig P. Bloom, Note, *Hangover Effect: May I See Your Tattoo, Please*, 31 CARDOZO ARTS & ENT. L.J. 435, 462 (2013).

²⁰⁸ *I.A.E.*, 74 F.3d at 776.

²⁰⁹ *Estate of Hevia*, 602 F.3d at 41.

exclusive rights of the copyright owner and some acknowledgment by the copyright owner that there will be an inevitable exercise of some of these exclusive rights by the tattoo bearer. The tattoo artist impliedly grants the following rights to the tattoo bearer: the right of public display, the right to make derivative works, but only to the extent required to make alterations for the complete removal of the tattoo or the addition of a new tattoo to an existing design,²¹⁰ and limited rights of reproduction and distribution to the extent necessary for the tattoo bearer to photograph himself and capture video of himself (and to be photographed and recorded) during everyday life, particularly for non-commercial purposes.²¹¹

An examination of the factors used to determine whether a licensor intends to grant an implied license supports the conclusion that a court is likely to find a tattoo bearer has the right to display and alter a tattoo on his body. Using the relevant factors set forth by the Seventh Circuit, tattoo artists intend to at least grant the right of public display. It is unlikely that a tattoo artist would warn a tattoo bearer that *any* further use of the tattoo would constitute copyright infringement. In fact, tattoo artists who have filed lawsuits alleging copyright infringement of their tattoos conceded in their complaints that their athlete clients had an implied license to publicly display the work in order to pursue a livelihood in acting and sports.²¹² Regarding the existence of a letter agreement, Mike Tyson executed a release acknowledging “that all artwork, sketches and

²¹⁰ Bloom, *supra* note 207, at 463. Bloom opines that “[b]ehind every tattoo artist’s actions, therefore, lies the intent to transfer specific rights that may be exercised during the normal course of his life.” *Id.* at 464. Bloom’s use of the term “including” prior to identifying the types of alterations seems to suggest that alterations other than the complete removal of the tattoo or addition of a new tattoo to an existing design are the implied rights of the tattoo bearer. To the extent he suggests other types of alterations are permissible, I disagree. The tattoo bearer has an implied right to make derivative works only to remove the tattoo or add a new one.

²¹¹ Perzanowski, *supra* note 56, at 537. Perzanowski observes from his interviews with tattoo artists that they accept broad uses of copyrighted tattoos by their clients, namely, public display and reproduction “of their bodies, whether by uploading images to their Facebook profiles, submitting photos for publication in tattoo magazines, or even reproducing a picture of the tattoo for commercial purposes.” Courts would likely determine that a tattoo artist intended to grant a narrower implied license of reproduction and distribution to a tattoo bearer. The scope of the license would depend, in part, on the identity of the tattoo bearer. For example, a non-celebrity’s normal reproduction activities might be limited to taking “selfies” and photographs and videos with family and friends and normal distribution activities might be sending photographs and videos to family and friends and posting them on social media. In contrast, a celebrity’s or professional athlete’s normal reproduction and distribution activities would be more extensive.

²¹² See Allen Complaint, *supra* note 4; Whitmill Complaint, *supra* note 10; Escobedo Complaint, *supra* note 6.

drawings related to [his] tattoo and any photographs of [his] tattoo” were the property of tattoo artist S. Victor Whitmill.²¹³ Ricky Williams signed a document stating the artwork remained the property of tattoo artist Stephen Allen unless otherwise expressed.²¹⁴ Although both tattoo artists conceded that their clients had a right to publicly display their tattoos in order to pursue their livelihood, the parties had written agreements.

The application of the relevant factors of the First Circuit yields the same result that tattoo artists intend to grant the right of public display to tattoo bearers. The first factor—whether the parties were engaged in a short-term or an ongoing relationship—weighs in favor of finding an implied license.²¹⁵ The relationship between a tattoo artist and his client is typically a short one, which suggests that the tattoo artist does not intend to be involved with the work after the client receives the tattoo, and therefore, some use is permissible without the artist’s involvement.²¹⁶ The second factor—whether the creator utilized written contracts providing that copyrighted materials could only be used with the creator’s future involvement or express permission—is similar to a Seventh Circuit factor. In rare cases, a tattoo artist uses a written contract,²¹⁷ and in only one of the tattoo lawsuits did the contract require the express permission of the artist for use of the tattoo.²¹⁸ The absence of a written contract, likely in most cases, also weighs in favor of an implied license.

The third factor—“whether the creator’s conduct during the creation or delivery of the copyrighted material indicated that use of the material without the creator’s involvement or consent was permissible”—is a fact-specific inquiry.²¹⁹ Even absent a determination on this factor, the other factors weigh in favor of finding an implied license. However, while the scope of this license

²¹³ Whitmill Complaint, *supra* note 10, ¶ 7.

²¹⁴ Allen Complaint, *supra* note 4, ¶¶ 8, 28.

²¹⁵ Bloom, *supra* note 207, at 465 (“Courts that have applied this analysis tend to find that a long-term transaction cuts against the finding of an implied license. The courts reason that the longer a relationship persists, the more likely a licensor intended to be involved in the project and therefore would not have permitted use of the copyrighted work without his participation. Conversely, a short-term and discrete transaction is indicative of intent to remain uninvolved, making it more likely that a licensor granted use of the copyrighted work without his involvement.”).

²¹⁶ *Id.*

²¹⁷ Perzanowski, *supra* note 56, at 534–35 (“[S]igned agreements that contemplate copyright ownership are practically unheard of in the tattoo industry.”).

²¹⁸ Allen Complaint, *supra* note 4, ¶¶ 8, 28.

²¹⁹ Bloom, *supra* note 207, at 466 (“The conduct of a tattoo artist will no doubt vary with each tattoo. Things like what was said and done during or after the tattoo transaction will matter.”).

may encompass commercial use of the work, particularly for clients who are athletes and celebrities, the license does not cover commercial uses by third parties, or in instances like *Reed*, a client's cooperation with third parties' commercial use of a tattoo.²²⁰

In any event, implied licenses are generally revocable by the copyright owner.²²¹ Yet, an implied license supported by consideration is irrevocable and constitutes a contract.²²² The relevant inquiry in the context of tattoos is whether consideration was given in exchange for use of the work.²²³ While consideration is established when the tattoo bearer pays for the tattoo, it is unknown whether the fee only serves as consideration for creating and applying the design or whether it also covers an implied license to use the tattoo.²²⁴ Regardless, when an implied license is granted to a tattoo bearer covering the use of the copyrighted work over the normal course of his life, the license is so closely bound with the transaction that it becomes irrevocable.²²⁵ A client would not pay for a tattoo design that he could not display, add to, or remove.²²⁶

G. THIRTEENTH AMENDMENT

Professor David Nimmer sets forth a list of purported impediments to the recognition of copyright protection for tattoos in his declaration filed in support of the defendants in *Whitmill*.²²⁷ Nimmer concluded that a claim for copyright protection of a tattoo should be dismissed "if on no other basis than

²²⁰ *Id.* at 468 ("Recent cases suggest that the line is drawn at commercial use or when a tattoo holder seeks to profit directly from the copyrighted tattoo. Nevertheless, it is evident that commercial use is permitted by a tattoo holder's implied license in certain situations, and never permitted by third parties."); Perzanowski, *supra* note 56, at 537 ("But under prevailing industry norms, not all client uses are acceptable. Tattoos distinguish between uses of the tattoo as applied to the body, which are universally accepted, and uses of the tattoo design as a work disconnected from the body, which are subject to greater skepticism.").

²²¹ Bloom, *supra* note 207, at 470.

²²² *Id.*

²²³ *Id.*

²²⁴ *Id.*

²²⁵ *Id.* at 470–71.

²²⁶ *Id.* at 471.

²²⁷ Nimmer Declaration, *supra* note 108, ¶ 20. Whitmill filed a motion to exclude David Nimmer's testimony on May 23, 2011, on the ground that such expert testimony was nothing more than "thinly disguised legal argument and an attempt to circumvent the Court's already generous 40-page limit for Defendant's brief." See Plaintiff's Motion to Exclude Testimony of David Nimmer, ¶ 10, *Whitmill*, No. 4:11-CV-752. The court sustained Whitmill's motion. *Id.*

the constitutional prohibition on involuntary servitude and other badges of slavery. . . .”²²⁸ While Nimmer incorrectly challenges copyrightability on the basis of the Thirteenth Amendment,²²⁹ he raises legitimate constitutional concerns about the enforceability of tattoo copyrights. He describes instances where a court could require the destruction of a “work of visual art that may gain ‘recognized stature,’” order laser removal of an unauthorized derivative work tattooed elsewhere on Tyson’s body, or find violations of the copyright’s display and performance right from Tyson’s magazine and television appearances.²³⁰

Nimmer’s predictions are unlikely to come to fruition.²³¹ Professor Aaron Perzanowski addresses Nimmer’s arguments in his article *Tattoos & IP Norms*:

[C]opyright law offers courts many tools aside from the blunt instrument of protectability that they could, and almost certainly would, use to avoid this parade of horrors. These include narrow readings of exclusive rights, fair use, first sale and related exhaustion doctrines, implied license, and equitable discretion over injunctive relief.²³²

Moreover, Professor Perzanowski observes that the most practical reason for dismissing Nimmer’s concerns lies in the “norms of the tattoo industry.”²³³ Tattoo artists rarely sue their clients. Perzanowski notes Matthew Reed, the tattoo artist who sued his client Rasheed Wallace for contributory copyright infringement (if the court found Reed was the sole owner of the copyright) or

²²⁸ Nimmer Declaration, *supra* note 108, ¶ 16.

²²⁹ King, *supra* note 2, at 159 n.184 (“While Thirteenth Amendment concerns may be relevant to the breadth of enforcement of a tattoo copyright, this Article fails to see the relevance to the copyrightability of tattoos, particularly the useful articles’ limitation on copyrightability.”).

²³⁰ Nimmer Declaration, *supra* note 108, ¶ 20.

²³¹ Perzanowski, *supra* note 56, at 530 (identifying reasons “why Nimmer’s fears [are] unwarranted”); *see also* Bloom, *supra* note 207, at 442 (“[A] tattoo holder retains the ability to move freely during his life. While he may be restricted from displaying the copyrighted design in various mediums, such as films, the tattoo holder is always given a choice. He can simply cover up the tattoo design or appear in a way that does not show the tattoo. The element of choice is ever-present, and the individual’s liberty is never truly restricted.”). While theoretically a tattoo bearer may have a choice in how to display a tattoo, it is conceivable that a court could grant remedies that would limit the tattoo bearer’s freedom to do display (or even modify or remove) the tattoo. This Article agrees with Perzanowski’s conclusion that a court’s exercise of its discretion will avoid such Thirteenth Amendment problems. Perzanowski, *supra* note 56, at 530.

²³² Perzanowski, *supra* note 56, at 530.

²³³ *Id.*

an accounting for any profits realized by Wallace in the exploitation of the tattoo (if the court found Reed and Wallace were co-owners of the tattoo copyright), “operated outside of the accepted norms of the tattoo industry.”²³⁴ However, Reed filed the lawsuit due to the “prominent use” of the tattoo in the television advertisement, not Wallace’s public displays of it.²³⁵ As prominent use of tattoo artists’ tattoos by third parties increases, it is likely that more tattoo artists like Reed will (and should) seek to enforce their rights against such uses. Such enforcement is distinguishable from instances where tattoo artists would seek to enforce their rights against their customers solely based on their public display of the tattoos.²³⁶ The latter enforcement is at odds with the tattoo artists’ expectations of how their tattoos will be used by their customers.²³⁷

In his interviews with more than a dozen tattoo artists in the United States, Perzanowski learned that tattoo artists acknowledge their clients’ rights to publicly display their tattoos, reproduce images of their tattooed bodies, and create new works that incorporate or destroy the tattoo artists’ original designs.²³⁸ In sum, Perzanowski’s survey of the tattoo artists found that the industry accepts a broad array of client uses of tattoos as applied to the body.²³⁹ However, the tattoo industry disfavors client uses of tattoos disconnected from the body.²⁴⁰ Perzanowski predicts that these circumstances are more likely to give rise to enforcement by tattoo artists.²⁴¹ This Article not only concurs with Perzanowski’s conclusion that tattoo artists may break from the industry norm against litigation when such third party uses take place but also encourages tattoo artists to enforce their rights against these uses.²⁴² Tattoo artists’ copyright lawsuits have not gone to trial. As a result, companies like Warner Brothers in *Whitmill*,²⁴³ may be emboldened by a lack of precedent on the distribution, reproduction, and public display of tattoos in media.

²³⁴ *Id.* at 532.

²³⁵ *Id.* at 531.

²³⁶ *Id.* at 537.

²³⁷ *Id.*

²³⁸ *Id.*

²³⁹ *Id.*

²⁴⁰ *Id.*

²⁴¹ *Id.* at 538.

²⁴² *Id.*

²⁴³ *Whitmill* Complaint, *supra* note 10.

IV. CONCLUSION

A tattoo is often developed in collaboration between the tattoo artist and the person seeking to purchase a tattoo. In many cases, the tattoo copyright will be owned by the tattoo artist. However, the fluidity and informality of the tattoo creation process generates ambiguities regarding ownership in some circumstances. It is advisable for the tattoo artist and her customer to discuss copyright ownership in the tattoo and reduce their agreement to writing. Organizations with many tattoo-bearing members, such as the NFL Players Association, have started recognizing the risk of leaving copyright ownership and uses of copyrighted works undocumented. Copyright ownership agreements are not customary in the tattoo industry at this time, but instances in which tattoo artists are asked to reduce an agreement to writing will become more commonplace. Tattoo artists should be knowledgeable of the law and prepared to negotiate an agreement that will protect their interests.

Enforcement of tattoo copyrights will be difficult. The artists' choice of medium will result in diminution of the exclusive rights of the copyright owners. Tattoo artists should understand the need to relinquish some control over their inked creations, and they already seem generally accepting of uses of their works by tattoo bearers.

However, tattoo copyright owners must be vigilant in enforcing their rights against non-client uses of their works. Tattoos have caught the attention of big businesses seeking to market famous tattoo bearers as well as monetize tattoos through media advertising. Such third party uses will become more prevalent due to the growth in the popularity and visibility of tattoos, particularly among celebrities and athletes. Uses by third-party companies have been and will continue to be the catalyst for the filing of lawsuits by tattoo artists. Tattoo artists should not face the same diminution of their rights in enforcement efforts against such uses by parties outside of the tattoo artist-client relationship.