

# Copyright, Tattoos, and Animated Likeness: Why Size Should Not Matter

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## **I. Introduction**

Once considered a taboo form of expression, tattoos have become increasingly

popular and accepted in modern American society.<sup>1</sup> With tattoos' ever-increasing popularity, more and more people have inked their skin with tattoos. The increase in tattoos has not just occurred among the average population. From famous athletes and musical artists to movie stars and models, many celebrities and prominent figures have tattoos that have become synonymous with their image and brand. The increased prevalence of tattoos has led to the legal debate surrounding the extent of the copyright interests of tattoos. This legal debate has only been expedited by the high visibility of some well-known tattooed individuals. Although some legal questions have had clear answers, like a tattooed individual's ability to publicly display their tattooed skin publicly, other legal issues have not been fully settled by the courts.

One of these legal issues has been whether an individual may reproduce an image of a tattoo on their body in the process of reproducing their own likeness in an animated or other similar form. Until the recent case *Solid Oak Sketches, LLC v. 2k Games*,<sup>2</sup> no federal court had issued an opinion involving the implications of copyright law when a tattooed individual's likeness is recreated, through animation or other similar methods. The *Solid Oak Sketches* case involved a copyright infringement claim against defendants who reproduced certain copyrighted tattoos on the realistic depiction of the basketball players in their NBA 2K video games.<sup>3</sup> The district court in *Solid Oak Sketches* reached a relatively limited holding, since it was heavily influenced by the tattoos' *de minimis* appearance in the video games.<sup>4</sup> This article, on the other hand, aims to answer any remaining legal uncertainty after the *Solid Oak Sketches* decision. Specifically, it will outline the different legal considerations and conclusions a court should make if deciding a case involving reproduction of tattoos on an individual's animated likeness where the use of the tattoos is not insignificant, but rather where the use of the tattoos is a focal point of the secondary work and thus easily observable.

Part II of this article will outline the background of the current legal landscape of copyright law and tattoos. In Part II(a), it will illuminate the growing popularity and acceptance of tattoos. In Part II(b), the article will describe the basic statutory requirements that the Copyright Act of 1976 require in order for a work to be copyrightable, and then apply these statutory requirements to tattoos to show merits of copyright protection of tattoo images. In Part II(c), the article will outline the District Court for the Southern District of New York's summary judgment decision in *Solid Oak Sketches*, highlighting the brief facts of the case and outlining its holdings on *de minimis* use, implied license, and fair use.

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<sup>1</sup> See *Millennials: Confident. Connected. Open to Change Executive Summary*, PEW RESEARCH CTR., (Feb. 24, 2010), <https://www.pewsocialtrends.org/2010/02/24/millennials-confident-connected-open-to-change/> (noting that Millennials have an increased amount of tattoos compared to older generations).

<sup>2</sup> 449 F. Supp. 3d 333 (S.D.N.Y. 2020).

<sup>3</sup> *Id.* at 338.

<sup>4</sup> *Id.* at 345.

Part III of this article will analyze the still unanswered legal questions revolving around tattoos and animating a tattooed individual's likeness. In Part III(a), it will address the different factual circumstances that could give merit to different forms of authorship of tattoos, including potentially sole authorship, joint authorship, and authorship of a "work for hire," and analyze the impact each of these forms of authorship may have in subsequent copyright infringement cases involving the tattoos.

In Part III(b), this article will outline the most applicable affirmative defenses against the potential copyright infringement claims that would potentially be brought against alleged infringers who use animated likenesses of tattooed individuals. Unlike the *Solid Oak Sketches* decision, this article will not assume that the use of the tattoos is *de minimis* and will outline the defenses in the hypothetical scenario that the tattoos would be reproduced to be prominent and easily observable in the secondary work. The first affirmative defense this Section will outline is that the tattooed individual received an implied license from the owner of the copyright to reproduce, distribute, and display the copyrighted tattoo as a part of their real or animated likeness. The second plausible affirmative defense is that a potential defendant's use of the tattoo on a realistic or stylized depiction of the tattooed individual would constitute a fair use, primarily due to the use's transformative purpose and character and non-effect on the potential market of the original tattoo's copyright owner.

In Part III(c), this article will analyze the implications these copyright infringement lawsuits have on the tattooed individual's right of publicity. Namely, it will discuss how an individual's tattoos have become synonymous with their image and identity, but the potential issues with relying upon a right of publicity argument to ensure an individual can license their likeness and image.

Finally, in Part III(d), this article will discuss how public policy favors of the potential lawsuits, highlighting the negative impacts and restrictions that will be imposed on individuals with tattoos if they do not control the rights to the tattoos on their body. It will discuss potential implications of the Thirteen Amendment, issues involving the proper remedies if courts find a tattoo's copyright interest enforceable against a tattooed individual licensing their animated image and likeness, and the issues of forcing tattooed individuals to contract for an express license to use their tattoos as a part of their animated likeness.

## II. Background

### a. Tattoos in Modern Culture

A tattoo is a form of body modification where a design is created by inserting ink, pigment, or dyes into the dermis layer of the skin to change its pigment. Tattoos were an artistic expression that used to be regarded as taboo; however, they have become increasingly popular and widely accepted in modern society.<sup>5</sup> In 2017, the

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<sup>5</sup> See PEW RESEARCH CTR., *supra* note 1 ("Nearly four-in-ten [of millennials] have a tattoo (and for

tattoo industry “generated an estimated \$1.6 billion in revenue, according to the market research firm IBISWorld.”<sup>6</sup>

Although tattoos were not a rarity thirty years ago, the people with tattoos usually belonged to certain subcultures—like “sailors, prison inmates, and members of tough motorcycle gangs.”<sup>7</sup> However, a recent poll done by Ipsos in late 2019 revealed that more Americans have tattoos today than earlier in the decade. “Three in ten (30%) of Americans have at least one tattoo, an increase from 21% in 2012.”<sup>8</sup> The same poll reported that the “average number of tattoos that tattooed Americans report having is four” with two tattoos per person (33%) being the most commonly reported.<sup>9</sup> Furthermore, “forty-six percent of respondents have had at least one tattoo for more than ten years.”<sup>10</sup> For younger demographics, the percentage of people with tattoos increases to 40% for ages 18–34 and 36% for ages 35–54.<sup>11</sup>

It is not just average people who are embracing tattoo culture. Many celebrities and famous athletes have also gotten tattoos. For example, in 2014 over half (55%) of the players in the National Basketball Association (NBA) had tattoos.<sup>12</sup> From movie stars, like Angelina Jolie, to famous musical artists, like Rihanna and Adam Levine, several “mainstream media icons . . . have tattoos and openly display them.”<sup>13</sup> These tattoos have become “a part of who they are now.”<sup>14</sup> With more and more famous individuals who normally profit from their own image and likeness getting tattoos, the legal questions about the extent they can use potentially copyrighted tattoos as a part of their real and animated likeness will only become more common.

#### b. Copyright Protection of Tattoos

In order to file a successful copyright infringement lawsuit, a potential plaintiff must first own a valid copyright.<sup>15</sup> In order to own a valid copyright in a tattoo de-

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most who do, one is not enough: about half of those with tattoos have two to five and 18% have six or more”).

<sup>6</sup> Jo Craven McGinty, *Tattoo Industry Wins Over Millennials*, THE WALL STREET JOURNAL (Aug. 31, 2018), <https://www.wsj.com/articles/tattoo-industry-wins-over-millennials-1535713200>.

<sup>7</sup> Mik Thobo-Carlsen & Victor Chateaubriand, *How Tattoos Went from Subculture to Pop Culture*, THE HUFFINGTON POST (Dec. 27, 2014), [https://www.huffpost.com/entry/how-tattoos-went-from-sub\\_b\\_6053588](https://www.huffpost.com/entry/how-tattoos-went-from-sub_b_6053588).

<sup>8</sup> Chris Jackson, *More Americans Have Tattoos Today than Seven Years Ago*, IPSOS (Aug. 29, 2019), <https://www.ipsos.com/en-us/news-polls/more-americans-have-tattoos-today>.

<sup>9</sup> *Id.*

<sup>10</sup> *Id.*

<sup>11</sup> *Id.*

<sup>12</sup> *What Does Body Ink Say About NBA Players' Pain And Personalities?*, NATIONAL PUBLIC RADIO (Jun. 18, 2014), <https://www.npr.org/2014/06/18/323205114/what-does-body-ink-say-about-nba-players-pain-and-personalities>.

<sup>13</sup> Thobo-Carlsen & Chateaubriand, *supra* note 7.

<sup>14</sup> *Id.*

<sup>15</sup> *Unicolors, Inc. v. Urban Outfitters, Inc.*, 853 F.3d 980, 984 (9th Cir. 2017) (“To prove copyright infringement, a plaintiff must demonstrate (1) ownership of the allegedly infringed work and (2) copying of the protected elements of the work by the defendant.”) (quoting *Pasillas v. McDonald’s Corp.*, 927 F.2d 440, 442 (9th Cir. 1991)).

sign or individual tattoos, the tattoos must constitute a valid copyrightable subject matter.<sup>16</sup> A valid copyright gives the owner of that copyright several exclusive rights, including the rights “to reproduce,” “to prepare derivative works,” “to distribute copies,” and “to display” the copyrighted work.<sup>17</sup>

The Copyright Act of 1976 outlines that “[c]opyright protection subsists . . . in *original* works of authorship *fixed* in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated.”<sup>18</sup> Tattoos fall under a category of copyrightable works of authorship, namely they fall within “pictorial, graphic, and sculptural works.”<sup>19</sup> Thus, the two elements that are required are fixation and originality.

### *i. Fixation*

The Copyright Act outlines that “[a] work is ‘fixed’ in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”<sup>20</sup> A copy is defined by the statute as a “material object[] . . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>21</sup>

No reasonable person would argue that tattoos are not “fixed” as defined by the Copyright Act.<sup>22</sup> By their very definition, a tattoo is “a mark, figure, design, or word intentionally *fixed* or placed on the skin.”<sup>23</sup> Tattoos by nature are permanent fixtures

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<sup>16</sup> See 17 U.S.C. § 102 (requiring a work of authorship to fall within a category of copyrightable subject matter in order to receive copyright protection).

<sup>17</sup> 17 U.S.C. § 106.

<sup>18</sup> 17 U.S.C. § 102(a) (emphasis added).

<sup>19</sup> 17 U.S.C. § 102(a)(5); see also 17 U.S.C. § 101 (“‘Pictorial, graphic, and sculptural works’ include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions . . .”).

<sup>20</sup> 17 U.S.C. § 101.

<sup>21</sup> *Id.*

<sup>22</sup> Although David Nimmer, author of the well-known treatise *Nimmer on Copyright Law*, took the position that tattoos are not “fixed” and thus not copyrightable as an expert witness in a case that was ultimately settled out of court, many have not minced words in questioning his conclusion’s merits or motivations. See, e.g., Ann Bartow, *When a Treatise Writer Tries to Reconfigure Copyright Law to Benefit a Client*, MADISONIAN: MICHAEL MADISON ON GOVERNANCE AND MORE (May 25, 2011), <http://madisonian.net/2011/05/25/when-a-treatise-writer-tries-to-reconfigure-copyright-law-to-benefit-a-client/> (stating Nimmer admitted in his declaration that he had taken the position that tattoos were copyrightable but later realized his conclusion was wrong, citing a law review article in which he determined that the human body is not copyrightable, outside the context of tattoos); Douglas Lichtman, *Are Tattoos Eligible for Copyright Protection?*, MEDIA INST. (Jun. 15, 2011), <http://www.mediainstitute.org/IPI/2011/061511.php> (“I find Nimmer’s declaration shockingly unconvincing. . . . Nimmer argued that the tattoo is not eligible for protection because it is not ‘fixed in a tangible medium of expression’ and thus fell short of a threshold requirement. . . . That makes no sense.”).

<sup>23</sup> *Tattoo*, MERRIAM-WEBSTER DICTIONARY (11th ed. 2016) (emphasis added).

on a person's skin and can easily be perceived when that part of the individual's skin is showing. Even temporary tattoos that last only a few days are "fixed" to a person's skin for longer than the statutorily required "transitory duration."<sup>24</sup> Any argument that a tattoo is not "fixed" because it may be removed via laser surgery or covered with another tattoo would be analogous to arguing a traditional penciled etching is not "fixed" because it can be later erased or painted over with darker pigments. Even though the tattoo is on a person's skin and not a traditional canvas, there is no language in the fixation definition nor the legislative history of the Copyright Act that places any restrictions on the copyrightability of a work fixed in a particular type of medium.<sup>25</sup> In every context a tattoo is "fixed" on a person's skin, it is "sufficiently permanent or stable" to be able to be perceived for "a period of more than transitory duration."

*ii. Originality*

The Supreme Court has held that "[o]riginal, as the term is used in copyright, means only that the work was *independently created* by the author (as opposed to copied from other works), and that it possesses at least *some minimal degree of creativity*."<sup>26</sup> This holding breaks the originality inquiry into two parts: 1) was the work independently created; and 2) does the work have some minimal degree of creativity.

The first inquiry, if the work was independently created, is more a case-by-case question for litigation. All that is necessary for a work to be "independently created" is for an author to create a work "without copying . . . from another work."<sup>27</sup> Unlike patent registration, originality in copyrights does not require novelty.<sup>28</sup> The question of if a specific tattoo artist "independently created" their tattoo will determine if an artist has a copyright interest or if they are infringing upon another prior art. For example, a tattoo artist cannot claim they "independently created" a tattoo that is an exact recreation of a famous copyrighted cartoon character like Scooby Doo, so this tattoo design would not be "original." However, if an artist creates a tattoo that is not novel, and even identical to another artist's design but were ignorant to the other artist's design, both works would still be original and

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<sup>24</sup> *Cf.* MAI Sys. Corp. v. Peak Computer, Inc., 991 F.2d 511, 518 (9th Cir. 1993) (where temporary memory on a computer's RAM was still considered "fixed" even though it was erased every time the computer shut down).

<sup>25</sup> H.R. REP. NO. 94-1476, at 52 (1976) ("Under the bill it makes no difference what the form, manner, or medium of fixation may be—whether it is in words, numbers, notes, sounds, pictures, or any other graphic or symbolic indicia, whether embodied in a physical object in written, printed, photographic, sculptural, punched, magnetic, or any other stable form, and whether it is capable of perception directly or by means of any machine or device 'now known or later developed.'").

<sup>26</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (citing 1 Melville Nimmer & David Nimmer, NIMMER ON COPYRIGHT §§ 2.01[A], [B] (1990)) (emphasis added).

<sup>27</sup> *Feist Publ'ns*, 499 U.S. at 358–59 ("Presumably, the vast majority of [works] will pass this test.").

<sup>28</sup> *See Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 53 (2d Cir. 1936) ("We are to remember that it makes no difference how far the play was anticipated by work in the public demesne which the plaintiffs did not use. The defendants appear not to recognize this [and erroneously suggest that] like patent, a copyrighted work must be not only original, but new.").

copyrightable.<sup>29</sup>

The more substantive debate over the copyright merits of tattoos surrounds whether they exhibit the requisite amount of “minimal degree of creativity.” “To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.”<sup>30</sup> This inquiry can change on a case-by-case basis for tattoos. For cases of an original design by a tattoo artist, there would be little question that it possesses the low “minimal degree of creativity.”

In *Bleistein v. Donaldson Lithographing Co.*, the Supreme Court held that a realistic etching used as an advertisement for a circus was not precluded from copyright protection.<sup>31</sup> Even though it was an etching that was intended to be a realistic depiction of circus acts, the Court focused on the personality of the work, finding that all creative works have “unique” and “irreducible” expressions from their creators.<sup>32</sup> This would be applicable in situations where the tattoo is a realistic depiction of something in the world—like an American flag, a wolf, or countless other possibilities.

The one situation where a tattoo may not meet the requisite level of creativity is where the tattoo is nothing but mere “typographical ornamentation,” like a number or word. The U.S. Copyright Office has opined that “[a]s a general rule, typeface, typefont, lettering, calligraphy, and typographic ornamentation are not registrable” for copyright.<sup>33</sup>

A tattoo artist also does not have to intend to create a copyrighted work; they enjoy copyright protection once they fix their original works. In *Alfred Bell v. Catalda*, an author of mezzotints copied public domain works, but the finished works had slight variations due to artist error.<sup>34</sup> The Second Circuit held that due to these slight variations, a new copyright interest was established, even though the author did not intend to create a copyrighted creation.<sup>35</sup> This case would parallel situa-

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<sup>29</sup> See *id.* at 54 (“if by some magic a man who had never known it were to compose anew Keats’s Ode on a Grecian Urn, he would be an ‘author,’ and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats’s. But though a copyright is for this reason less vulnerable than a patent, the owner’s protection is more limited, for just as he is no less an ‘author’ because others have preceded him, so another who follows him, is not tort-feasor unless he pirates his work.”) (citations omitted).

<sup>30</sup> *Feist Publ’ns*, 499 U.S. at 345 (quoting 1 Melville Nimmer & David Nimmer, NIMMER ON COPYRIGHT §§ 1.08[C][1] (1990)).

<sup>31</sup> 188 U.S. 239, 248–249 (1903).

<sup>32</sup> *Id.* at 250 (“The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man’s alone. That something he may copyright unless there is a restriction in the words of the act.”).

<sup>33</sup> Excerpt of U.S. Copyright Office, Compendium of U.S. Copyright Office Practices § 906.4 (3d ed. 2017) (citing 37 C.F.R. § 202.1(a), (e)).

<sup>34</sup> 191 F.2d 99, 104 (2d Cir. 1951).

<sup>35</sup> *Id.* at 104–05 (“[E]ven if their substantial departures from the paintings were inadvertent, the copy-

tions where a tattoo artist is copying a previous unprotected work<sup>36</sup> and must make slight variations in order to translate a pictorial depiction onto an individual's skin.

Courts and lawyers should not be the parties responsible for determining artistic merit and what is “creative” outside of the most obvious cases. In fact, Justice Holmes held in his majority opinion in *Bleistein v. Donaldson Lithographing Co.* that:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke . . . At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge . . . [A]nd the taste of any public is not to be treated with contempt.<sup>37</sup>

Holmes held that, no matter how repellant or non-artistic a critic of tattoos may find them, it is not for the courts to decide if tattoos are “worthy” enough of copyright protection.

Although no federal court has explicitly ruled on the issue of a tattoo's copyright, some have hinted that they are “generally within the subject matter of copyrightable works” and deferred to valid copyright registrations when deciding whether the Copyright Act should preempt state law claims when deciding whether to grant a motion to dismiss.<sup>38</sup> To date, no cases concerning the copyrightability of tattoos have gone to trial.<sup>39</sup> The Copyright Alliance, an advocacy group for the interests of content creators and organizations, has opined that tattoos are clearly eligible for copyright protection “so long as a tattoo meets the requirements for originality.”<sup>40</sup> The Copyright Alliance does not have an opinion on whether the copying of tattoos on an tattooed individual's animated likeness constitutes copyright infringement or is protected by an implied license or fair use, given the lack of litigation in federal court.<sup>41</sup>

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rights would be valid. A copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the ‘author’ may adopt it as his and copyright it.”)

<sup>36</sup> Either a non-copyrighted work, a work in the public domain, or a work the artist has received permission to use. An artist cannot receive copyright protection if they infringe upon a previously copyrighted work. See 17 U.S.C. § 103 (“protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully”).

<sup>37</sup> 188 U.S. 239, 251–52 (1903).

<sup>38</sup> See, e.g., *Hayden v. 2K Games, Inc.* 375 F. Supp. 3d 823, 827–28 (N.D. Ohio 2019).

<sup>39</sup> Many tattoo copyright infringement cases have been settled out of court. See, e.g., *Complaint at 1, Whitmill v. Warner Bros. Entm't, Inc.*, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011), *dismissed*, No. 4:11-CV-752 CDP (E.D. Mo. June 22, 2011); *Complaint, Reed v. Nike, Inc.*, 3:05-CV-00198, 2005 WL 1182840 (D. Or. Feb. 10, 2005) (*dismissed* Oct. 19, 2003).

<sup>40</sup> *Are Tattoos Protected by Copyright?*, COPYRIGHT ALLIANCE (2020), [https://copyrightalliance.org/ca\\_faq\\_post/tattoos-copyright/](https://copyrightalliance.org/ca_faq_post/tattoos-copyright/).

<sup>41</sup> *Id.*



c. Solid Oak Sketches, LLC v. 2k Games, Inc.

The first court decision involving copyright infringement of tattoos on animated likenesses was *Solid Oak Sketches, LLC v. 2k Games, Inc.*,<sup>42</sup> which was finally decided and signed on March 26, 2020. The Defendants in the case, 2K Games, Inc. and Take-Two Interactive Software, Inc., “annually release an updated basketball simulation video game that depicts basketball with realistic renderings of different National Basketball Association (“NBA”) teams, including lifelike depictions of NBA players and their tattoos.”<sup>43</sup> The Plaintiff brought the lawsuit alleging that the Defendants “infringed its copyrights by publicly displaying works for which the Plaintiff owns copyrights—five tattoos . . . that are depicted on [three] NBA players,” including Eric Bledsoe, LeBron James, and Kenyon Martin.<sup>44</sup> Specifically, the Plaintiff alleged infringement in the NBA 2K14, NBA 2K15, and NBA 2K16 versions of the game.<sup>45</sup>

Following the Defendants’ denied motion for judgment on the pleadings,<sup>46</sup> the Defendants moved for summary judgment “requesting (i) an order dismissing Plaintiff’s copyright infringement claim and (ii) entry of declaratory judgment in Defendants’ favor on their de minimis use and fair use counterclaims.”<sup>47</sup> The district court granted Defendants’ motion for summary judgment, relying on its findings on Defendants’ *de minimis* use of the tattoos, the Defendants’ fair use of the tattoos, and Defendants’ authorization to use the tattoos under an implied license.<sup>48</sup>

i. *De Minimis Use*

The first issue the court addressed was whether the Defendants’ use of the tattoos was *de minimis* as a matter of law. For a plaintiff to establish a claim for copyright infringement, “a plaintiff with a valid copyright must demonstrate that: (1) the defendant has actually copied the plaintiff’s work; and (2) the copying is illegal because a substantial similarity exists between the defendant’s work and the protectible elements of plaintiff’s.”<sup>49</sup>

For an alleged infringement to be substantially similar, “the amount copied must be more than de minimis.”<sup>50</sup> In order for a defendant to establish that the alleged infringement of the copyright is *de minimis*, and therefore not actionable, “the alleged infringer must demonstrate that the copying of the protected material is so

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<sup>42</sup> 449 F. Supp. 3d at 333.

<sup>43</sup> *Id.* at 339.

<sup>44</sup> *Id.* (of the five tattoos in question, three were on LeBron James, and one each on Eric Bledsoe and Kenyon Martin).

<sup>45</sup> *Id.* (these three versions of the game were released in 2013, 2014, and 2015, respectively).

<sup>46</sup> *Solid Oak Sketches, LLC v. 2K Games, Inc.*, 2018 WL 1626145, at \*1 (S.D.N.Y. Mar. 30, 2018).

<sup>47</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 339.

<sup>48</sup> *Id.* at 343–350.

<sup>49</sup> *Id.* at 343–44 (citing *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., Inc.*, 150 F.3d 132, 138 (2d Cir. 1998)).

<sup>50</sup> *Id.* at 344 (citing *Castle Rock Entm’t Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132, 138 (2d Cir. 1998)) (emphasis omitted).

trivial ‘as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying.’”<sup>51</sup>

The quantitative component of the *de minimis* analysis has three parts: “[1] ‘the amount of the copyrighted work that is copied,’ [2] ‘the observability of the copied work—the length of time the copied work is observable in the allegedly infringing work,’ and [3] factors such as ‘focus, lighting, camera angles, and prominence.’”<sup>52</sup> The court stressed that “observability” is the key factor in order to determine whether the quantitative threshold of substantial similarity has been met.<sup>53</sup>

The substantial similarity standard in the Second Circuit is determined through the application of the “ordinary observer test,” which factors “whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”<sup>54</sup> The court is allowed to consider whether the ordinary observer would be “disposed to overlook” the disparities in the work unless otherwise set out to detect them.<sup>55</sup> “Summary judgment may be granted on a *de minimis* use claim when ‘no reasonable trier of fact could find the works substantially similar.’”<sup>56</sup>

The district court held that the Defendants’ use of the tattoos was *de minimis*, focusing on how the tattoos in the game were “so small and distorted” and were “indiscernible to the average game users.”<sup>57</sup> The court focused on the quantitative insignificance of the tattoos in the game, noted the few number of players they appeared on, how small the players were in the game, and how the various other game elements obscured the observability of the tattoos.

The tattoos “only appear[ed] on the player upon whom they [were] inked, which is just three out of over 400 available players.”<sup>58</sup> When one of the tattoos did appear during the gameplay, the court found that “the [t]attoos cannot be identified or observed.”<sup>59</sup> The court factored in the “significantly reduced” size of the tattoos, measuring “a mere 4.4% to 10.96% of the size that they appear in real life.”<sup>60</sup> It further noted that whenever the tattoos appeared in the game, they were “out of focus” and were “observable only as undefined dark shading on the [p]layers’ arms.”<sup>61</sup> In addition, the player avatars had “quick and erratic movements up and down the basketball court” that added to the difficulty “to discern even the unde-

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<sup>51</sup> *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 217 (2d Cir. 1998) (quoting *Ringgold v. Black Entertainment Television, Inc.*, 126 F.3d 70, 74 (2d Cir. 1997)).

<sup>52</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 344 (citing *Ringgold*, 126 F.3d at 75).

<sup>53</sup> *Id.* (“observability of the copyrighted work in the allegedly infringing work” is fundamental to a determination of whether the “quantitative threshold” of substantial similarity has been crossed.” (citing *Sandoval*, 147 F.3d at 217)).

<sup>54</sup> *Id.* (quoting *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992)).

<sup>55</sup> *Id.* (citing *Rogers*, 960 F.2d at 307–08).

<sup>56</sup> *Id.* (quoting *Estate of Smith v. Cash Money Records, Inc.*, 253 F. Supp. 3d 737, 746 (S.D.N.Y. 2017)).

<sup>57</sup> *Id.* at 345.

<sup>58</sup> *Id.* (emphasis added).

<sup>59</sup> *Id.*

<sup>60</sup> *Id.*

<sup>61</sup> *Id.*

fined dark shading.”<sup>62</sup>

The tattoos “often [did] not appear during the NBA 2K video game” and when they were displayed, “they [were] so small and distorted by the camera angles and other game elements that they [were] indiscernible to the average game users.”<sup>63</sup> The evidence prompted the court to hold that the tattoos were “not displayed in NBA 2K with sufficient detail for the average lay observer to identify even the subject matter of the [t]attoos, much less the styles used in creating them.”<sup>64</sup> A player of the game would only be able to perceive the tattoos in any significance if they “employ[ed] the broad range of the video game’s features to focus, angle the camera on, or make the subject tattoos more prominent” in order to make “the overall observability of the subject tattoos . . . fairly significant.”<sup>65</sup>

As a result, the court held on summary judgment that the Defendants’ use was *de minimis* since the “undisputed evidence . . . show[ed] that . . . the [t]attoos in NBA 2K [fell] below the quantitative threshold of substantial similarity . . . [and n]o reasonable fact finder could conclude that Plaintiff . . . carried its burden of proving that Defendants’ use of the copyrighted material was substantially similar to Plaintiff’s copyrighted work.”<sup>66</sup>

#### ii. Implied License<sup>67</sup>

The next issue the court addressed was whether the Plaintiff’s copyright infringement claim should fail due to the Defendants being authorized by an implied license to feature the tattoos as a part of pertinent players’ likenesses in the video game. Defendants argued that each of the tattooist’s expectation was for the tattoos to become a part of his or her client’s likeness.<sup>68</sup> Although the court did not conduct an in-depth analysis of the legal precedent of implied copyright licenses; however, the court did note that courts in the Second Circuit “have found an implied non-exclusive license ‘where one party created a work at the other’s request and handed it over, intending that the other copy and distribute it.’”<sup>69</sup> The court focused on three particular facts that were undisputed in the factual record to support its holding:

- (i) the [p]layers each requested the creation of the [t]attoos, (ii) the tattooists created the [t]attoos and delivered them to the [p]layers by inking the designs onto their skin, and (iii) the tattooists intended the [p]layers to copy and distribute the [t]attoos as elements of their likenesses, each knowing that the [p]layers were likely to appear in public, on television, in commercials, or in other forms of media.<sup>70</sup>

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<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

<sup>64</sup> *Id.* (quoting *Sandoval*, 147 F.3d at 218) (internal citation and brackets omitted).

<sup>65</sup> *Id.* at 344.

<sup>66</sup> *Id.*

<sup>67</sup> A more in-depth discussion on the legal standards of implied licenses of copyrights is presented *infra* in Section III(b)(i) (merely summarizing the district court’s conclusions of the specific case).

<sup>68</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 346.

<sup>69</sup> *Id.* (quoting *Weinstein Co. v. Smokewood Entm’t Grp., LLC*, 664 F. Supp. 2d 332, 344 (S.D.N.Y. 2009)).

<sup>70</sup> *Id.* (internal quotes omitted).

Given these uncontroverted facts, the court held that since the NBA players “neither requested nor agreed to limit the display or depiction of the images tattooed onto their bodies, [the players] had implied licenses to use the tattoos as elements of their likenesses.”<sup>71</sup> The Defendants’ right to use the tattoos in depicting the players “derives from these implied licenses, which predate the licenses that Plaintiff obtained from the tattooists.”<sup>72</sup> The players in question gave the NBA the right to license their likenesses to third-parties, and the Defendants received such right from the NBA. This chain of permissions prompted the court’s conclusion that the Defendants “had permission to include the [t]attoos on the [p]layers’ bodies in NBA 2K because the [p]layers had an implied license to use the [t]attoos as part of their likeness, and the [p]layers either directly or indirectly granted Defendants a license to use their likenesses.”<sup>73</sup> As a result, the court held that the Defendants were also entitled to dismiss the Plaintiff’s copyright infringement claim due to the presence of an implied license.

iii. *Fair Use*<sup>74</sup>

The court’s third ruling on the motions was on Defendants’ motion for a declaration that their use of the tattoos in the video game was fair use.<sup>75</sup> The four statutory factors that the court must weigh in determining if an allegedly infringing use was a fair use are the “purpose and character of the use,” the “nature of the copyrighted work,” the “amount and substantiality of the use,” and the “effect on the market.”<sup>76</sup> After weighing all four factors, the Court held that “the uncontroverted evidence demonstrate[d] that all four factors weigh[ed] in Defendants’ favor . . . [and] no reasonable fact finder could determine that Defendants’ use of the [t]attoos in NBA 2K was not fair use.”<sup>77</sup>

For the first factor, the purpose and character of the use, the court held that the Defendants’ use was of a different purpose and different character because “the undisputed evidence demonstrate[d] that Defendants’ use of the [t]attoos [was] transformative.”<sup>78</sup> The court cited four reasons for why the Defendants’ use was transformative. First, the Defendants’ video game’s purpose for displaying the tattoos was “entirely different from the purpose for which the [t]attoos were originally created. The tattoos were “originally created as a means for the [p]layers to express themselves through body art.”<sup>79</sup> In contrast, the Defendants only reproduced the tattoos in the video game “in order to most accurately depict” the NBA players, with

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<sup>71</sup> *Id.*

<sup>72</sup> *Id.*

<sup>73</sup> *Id.*

<sup>74</sup> A more in-depth discussion on fair use and tattoos is presented *infra* in Section III(b)(ii) (merely summarizing the district court’s conclusions of the specific case).

<sup>75</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 347.

<sup>76</sup> *Id.* at 347–50; 17 U.S.C. § 107.

<sup>77</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 350.

<sup>78</sup> *Id.* at 347.

<sup>79</sup> *Id.*

“the particulars of the [t]attoos [] not observable.”<sup>80</sup> “The uncontroverted evidence” showed that the video game’s purpose, “general recognizability of game figures as depiction of [NBA players],” was “different than that for which they were originally created.”<sup>81</sup>

Second, the Defendants “significantly reduced the size of the [t]attoos in the video game.”<sup>82</sup> The tattoos in the game appeared “at 4.4% to 10.96% of their actual size because the player figures are themselves proportionately smaller than in real life.”<sup>83</sup> This small size, in addition to the various other game elements, made the tattoos “more difficult to observe,” meaning the video game did not “offer more than a glimpse of the [t]attoos’ expressive value.”<sup>84</sup>

Third, the court held that the tattoos’ “expressive value [was] minimized in NBA 2K.”<sup>85</sup> The images of the tattoos were used “infrequently and only imprecisely observable and [] combined with myriad other auditory and visual elements . . . .”<sup>86</sup> All the other elements obscured the creative expression of the tattoos, supporting the finding that the tattoos “were not included for their expressive value, but rather to most accurately recreate certain NBA players’ likenesses.”<sup>87</sup>

Fourth, the court held that the tattoos “constitute[d] an inconsequential portion of NBA 2K.”<sup>88</sup> The court again stressed the small size of the tattoos, stating how the tattoos “cannot be seen clearly during gameplay,” that the tattoos in question appear “on three out of 400 available players,” and that game players who saw that the players had tattoos still could not “identify the specific [t]attoos at issue.”<sup>89</sup> In addition, the tattoos comprised “only 0.000286% to 0.000431% of the total game data.”<sup>90</sup>

In addition to finding that the Defendants’ use was transformative, the court also considered if Defendants’ video game’s purpose was commercial.<sup>91</sup> Although the video game, and the tattoos’ inclusion in the game by extension, was commercial, the court held that the tattoos were “indistinguishable during gameplay and [are] not feature[d] in any of the game’s market materials,” and that the tattoo images were “merely incidental to the commercial value of the game, because consumers do not buy NBA 2K video games for the tattoos on LeBron James, Eric Bledsoe or Kenyon

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<sup>80</sup> *Id.*

<sup>81</sup> *Id.*

<sup>82</sup> *Id.* (internal citation omitted).

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* at 347–48 (comparing to *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006) (finding thumbnail-sized images to be transformative)) (internal citation omitted).

<sup>85</sup> *Id.* at 348.

<sup>86</sup> *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> *Id.*

<sup>90</sup> *Id.*

<sup>91</sup> *Id.*

Martin.”<sup>92</sup> Due to the transformative use and the incidental commercial nature by focusing heavily on the tattoos’ small size and low observability, the court held that the first factor weighed in favor of fair use.<sup>93</sup>

For the second factor, the nature of the copyrighted work, the court held that there was “no evidence from which a reasonable fact finder could conclude that the [t]attoos were sufficiently ‘expressive’ or ‘creative’ to . . . weigh against a finding of fair use.”<sup>94</sup> First, the court noted that the Plaintiff already conceded that the tattoos were previously published.<sup>95</sup> Second, the court held that the tattoo designs were “more factual than expressive because they [were] each based on another factual work or comprise representational renderings of common objects and motifs that are frequently found in tattoos.”<sup>96</sup> For example, one of LeBron James’s tattoos was “a reproduction of a photograph of Mr. James’s son, which was copied as closely as possible from the picture Mr. James provided [to the tattoo artist],” while another tattoo was a result of just adding flames, “a common tattoo motif,” to a number tattoo already on LeBron James’s skin.<sup>97</sup> The tattoo artist themselves testified that each tattoo either “copied common tattoo motifs or were copied from designs and pictures they themselves did not create.”<sup>98</sup> As a result, the court weighed the second factor in favor of fair use.

For the third factor, the amount and substantiality of the use, the court held that “the undisputed evidence show[ed] that, while the [t]attoos were copied in their entirety, Defendants did so in order to effectuate the transformative purpose of creating a realistic game experience.”<sup>99</sup> The court found that the amount and substantiality was reasonable considering its purpose of creating a realistic game, and “it would have made little sense for Defendants to copy just half or some smaller portion of the [t]attoos, as it would not have served to depict realistically the [p]layers’ likenesses.”<sup>100</sup> The court also considered that the tattoos “were reduced in size, such that ‘the visual impact of their artistic expression [was] significantly limited.’”<sup>101</sup> Since the tattoos in the game were not recognizable, the court held that the impact of the tattoos’ artistic expression was reduced, and the third factor accordingly did not weigh against fair use.<sup>102</sup>

For the fourth factor, the effect on the market, the court held the factor favored a finding of fair use since the tattoos in the video game could not serve as market substitutes for the original and the Plaintiff “failed to proffer any evidence from

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<sup>92</sup> *Id.* (internal punctuation omitted).

<sup>93</sup> *Id.* at 347–48.

<sup>94</sup> *Id.* at 349.

<sup>95</sup> *Id.* at 348.

<sup>96</sup> *Id.*

<sup>97</sup> *Id.* (internal quotation omitted).

<sup>98</sup> *Id.* at 349.

<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* (quoting *Bill Graham Archives*, 448 F.3d at 613).

<sup>102</sup> *Id.*

which a reasonable fact finder could conclude that a market for licensing tattoos for use in video games or other media is a traditional, reasonable, or likely to be developed market.<sup>103</sup> The Plaintiff tried to argue that the Defendants' use "diminished the commercial value of the tattoo artwork in the marketplace for licensing its use in other works including, but not limited to, video games, apparel, and memorabilia."<sup>104</sup>

The court made two findings that contradicted the Plaintiff's argument. First, the court reemphasized that the Defendants' use of the tattoos was transformative, such that "the [t]attoos as featured in the video game cannot serve as substitutes for use of the [t]attoo designs in any other medium."<sup>105</sup> The Defendants' use could not "deprive the rights holder of significant revenues because potential purchasers of the [t]attoo designs are unlikely to opt to acquire the copy in preference to the original."<sup>106</sup>

Second, the court found "no evidence from which a reasonable fact finder could conclude that a market for licensing tattoos for use in video games or other media [would] likely [] develop."<sup>107</sup> The Defendants offered expert testimony that was not disputed by the Plaintiff "that such a market is unlikely to develop and that, if it did, Plaintiff could not capitalize on such a market because the [t]attoos are imprinted on the bodies of the [p]layers and Plaintiff is not licensed to use the [p]layers' publicity rights."<sup>108</sup>

After finding all four factors favored a finding of fair use, the court held that the Defendants were "entitled to judgment as a matter of law on their second counterclaim and to a declaration that their use of the [t]attoos in the challenged video game versions constitutes fair use."<sup>109</sup>

### III. Analysis

One limitation of the *Solid Oak Sketches* decision is that the court focused heavily on how small quantitatively the tattoos were in the video game.<sup>110</sup> Although this decision was warranted given the facts of the case, it does limit the scope of the holding while leaving many additional questions unanswered for future cases. Since the quantitative significance of the tattoos in NBA 2K video game was so small, it is not only easy to imagine but inevitable that future litigants will distinguish the case in situations where the tattoos are prominently shown or are at least more observable in the secondary work. For example, instead of depicting LeBron James and his tattoos in a video game with all NBA players, arenas, fans, and other gameplay, what if an animated television show depicted LeBron James as a special guest

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<sup>103</sup> *Id.* at 350 (internal citation omitted).

<sup>104</sup> *Id.* (internal citation omitted).

<sup>105</sup> *Id.* ("Indeed, Plaintiff has conceded that NBA 2K is not a substitute for the [tattoos].").

<sup>106</sup> *Id.* (internal citation omitted).

<sup>107</sup> *Id.*

<sup>108</sup> *Id.*

<sup>109</sup> *Id.*

<sup>110</sup> *Id.* at 344–45, 347–49.

of an episode where he and his tattoos were featured more prominently? Better yet, what if LeBron James was featured in his own comic strip where his tattoos were clearly observable in a static picture? Furthermore, what if LeBron James, or any tattooed individual, wanted to commission an oil painting of themselves? The *Solid Oak Sketches* decision would not squarely answer these questions of the extent a secondary work could be infringing the tattoo design's copyright when the tattoo is reproduced in a prominent or observable manner on an animated likeness of the tattooed individual.

In order for a plaintiff to succeed on a copyright infringement claim, the plaintiff must prove: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original."<sup>111</sup> In the hypothetical future cases this article addresses, it is assumed that the tattoos being reproduced have valid copyright protection.<sup>112</sup> The question whether the potential plaintiff bringing the action is the proper owner of the copyright is discussed *infra* in Section III(a).

In order to prove the second element, the plaintiff must show that "the defendant has actually copied the plaintiff's work," and that "the copying is illegal because a substantial similarity exists between the defendant's work and the protectible elements of the plaintiff's."<sup>113</sup> In order for two works to be "substantially similar," the Second Circuit has held that "the amount copied must be more than *de minimis*."<sup>114</sup> Again, in the hypothetical (but very possible) future cases in the context of this article meet both of these standards. The secondary work is actually copying the original tattoo design and reproducing it in a manner that an ordinary observer can perceive the "substantial similarity" between the two works.

In the following discussion, two general scenarios of reproducing a tattooed individual's likeness will be considered, under the assumption that the reproduction of the tattoo will be both prominent and observable in the secondary work. First, it will consider the scenario where the secondary work will recreate the tattooed individual in a realistic fashion, copying the individual and their tattoo as close as possible to how they appear in real life, either a one-to-one replication or a proportionally scaled replication in cases where the individual is enlarged or shrunk in order to fit the secondary work's medium. For example, an image of LeBron James on a billboard would be bigger than life-size, while his depiction in a comic series would be smaller than life-size. Second, it will consider the scenario where the tattoo has been reproduced in a different stylized manner. For example, if LeBron James and his tattoos were reproduced in an Andy Warhol style work or a cubist painting. There, the tattoos would not be exact replicas, but would still be observable and potentially infringe the copyright owner's right to create derivative works.<sup>115</sup>

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<sup>111</sup> *Feist Publ'ns*, 499 U.S. at 361.

<sup>112</sup> For example, it meets the requirements of originality discussed *supra* in Section II(b).

<sup>113</sup> *Peter F. Gaito Architecture*, 602 F.3d at 63.

<sup>114</sup> *Castle Rock Entm't*, 150 F.3d at 138 (citing *Ringgold*, 126 F.3d at 75).

<sup>115</sup> See 17 U.S.C. § 106(2); 17 U.S.C. § 101 ("A 'derivative work' is a work based upon one or more preexisting works").



### a. Ownership of Copyright

One way for a tattooed individual to have the ability to license their tattooed image without fearing potential copyright infringement lawsuits is to be a valid owner of the copyright of the tattoos on their body. After establishing that tattoos are subject to copyright protection and that animating an entire tattoo within someone's likeness copies "constituent elements of the work that are original,"<sup>116</sup> a court must then determine the proper owner of the copyright before the copyright can be enforced. Section 201 of the Copyright Act states that the "[c]opyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work."<sup>117</sup>

Assuming that no contract with a third-party has been made to assign copyright ownership, the owner of the copyright is the author of the work. Further, the original author is important, since their ownership predates any third-party contract by any party, so any initial implied licenses by the author at the time of creating the work will predate any subsequent assignment of exclusive license.<sup>118</sup> With this framework in mind, there are three potential types of authorships for tattoos: (1) sole authorship; (2) joint authorship; and (3) authorship of a "work made for hire."

#### i. Sole Authorship

Sole authorship of a tattoo would likely be the most contested form of authorship of tattoos "not only because of the straightforward application of the statute—only one individual has authored the work, and therefore . . . the copyright vests with the individual—but also because this classification of authored works is a zero-sum game."<sup>119</sup>

"As a general rule, the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection."<sup>120</sup> This definition would clearly favor the tattoo artist constituting the "author," since they are the one that *actually creates* the tattoo and translates the idea in the fixed tangible expression of the tattoo. However, the answer is not that simple, since "an 'author' can authorize another to 'fix' his original idea."<sup>121</sup> This means that a client who creates their own tattoo design but directs a tattoo artist of fixing their design idea would be a potential author. Another general way to approach the inquiry is by recognizing that "[a]n author . . . is he to whom anything owes its origin; originator; maker; one who completes a work of science or

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<sup>116</sup> *Feist Publ'ns*, 499 U.S. at 361.

<sup>117</sup> 17 U.S.C. § 201(a).

<sup>118</sup> See *Solid Oak Sketches*, 449 F. Supp. 3d at 346 (holding that the "[p]layers derive[d] [] implied licenses . . . predate the licenses that Plaintiff obtained from the tattooists").

<sup>119</sup> Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 22 J. INTELL. PROP. L. 29, 36 (2014).

<sup>120</sup> *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989).

<sup>121</sup> *Medforms, Inc. v. Healthcare Mgmt. Sols., Inc.*, 290 F.3d 98, 107 (2d Cir. 2002) (citing *Andrien v. S. Ocean Cnty. Chamber of Commerce*, 927 F.2d 132, 134 (3d Cir. 1991)).

literature.”<sup>122</sup> For example, a client who has created an expressive tattoo design is the “originator” in whom the tattoo design “owes its origin,” not the tattoo artist who ultimately fixes the design on the client’s skin.

As a result of this guidance of what constitutes an “author,” determining whether the client or the tattoo artist is the “author” of the tattoo is a fact-specific inquiry. Tattoo artists that are advised by counsel know that “[t]he strongest way to establish sole ownership is through an explicit written agreement.”<sup>123</sup> A written agreement explicitly stating that the tattoo artist is the sole author and assigning them all the copyright interests’ artist would provide clear evidence that the tattoo artist is the sole author.

However, tattoo artists generally do not consult attorney’s in their daily business. Absent the contract, the inquiry of authorship becomes extremely fact specific. Using the tattoos that were the subject of litigation in the *Solid Oak Sketches* decision, the different outcomes become more apparent. For example, one of the tattoos on LeBron James “was copied from a baby picture provided by Mr. James.”<sup>124</sup> The tattoo artist was instructed by the client, LeBron James, to tattoo a reproduction of the photograph of his son “as closely as possible.”<sup>125</sup> In this situation, the final tattoo on LeBron James’s skin can be seen as a “copy” of the original photograph of James’s baby. This photograph is copyrightable with the “author” and “owner” of the copyright most likely being the person who took the photograph originally.<sup>126</sup> - Assuming for this situation that LeBron James took the photograph of his son (or has been assigned the copyright interests in the photograph), LeBron James would own the copyright interests in the tattoo himself, since he has authorized the image to be tattooed, or “fixed,” upon his body, a “tangible medium.”

The distinction here is that the tattoo artist is fixing the expressive elements of the photograph. In order for a situation to be considered an authorization of creating a copy of a copyright protected work, “that process must be rote or mechanical transcription that does not require intellectual modification or highly technical enhancement.”<sup>127</sup> A tattoo artist does not make any intellectual modifications when a client brings a preexisting work they want the artist to tattoo the preexisting work “as closely as possible.” The special skills involved with fixing the tattoo on someone’s skin is not creative and is not the “highly technical enhancement” the Third Circuit was referring. An analogous situation would be where poets, essayists, or novelists own the copyright in their work, even though they do not run the printing presses or process the photographic plates necessary to fix the writing into book

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<sup>122</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57–58 (1884).

<sup>123</sup> Amelia G. Pennington, *Implied in Ink?: How Tattoo Artists Can Claim and Protect Their Copyrights Against an Implied License Defense*, 48 BOSTON PAT. L. ASS’N NEWSL. 1 (2016).

<sup>124</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 340.

<sup>125</sup> *Id.* at 348.

<sup>126</sup> The source of the photograph is not known, since it was not relevant for the purposes of the specific litigation. It could be possible that LeBron James himself is the copyright owner of the photograph, but so could his spouse, other family members, or a hired photographer.

<sup>127</sup> *Andrien*, 927 F.2d at 135.

form, even if these mechanical tasks take skill and training to complete.<sup>128</sup> Simply, “a person is not an author if he expresses another’s idea [or expression] in tangible form without any original contribution.”<sup>129</sup>

Another example is another of LeBron James’s tattoos, the script with a scroll, clouds, and doves tattoo.<sup>130</sup> This “script” tattoo “was copied from a design in [the tattoo artist’s] sketchbook.”<sup>131</sup> In this situation, the final tattoo on LeBron James’s skin can be construed as a “copy” of the image in the tattoo artist’s sketchbook. The image in the sketchbook has its own copyright, and the tattoo on LeBron James would be an authorized derivative work. In this scenario, the tattoo artist (assuming that is who owns the copyright in the sketchbook image) would be the sole owner of the copyright of the tattoo on LeBron James’s skin.

A different scenario not found in the *Solid Oak Sketches* facts is where an individual has merely an *idea* for a tattoo that they bring to a tattoo artist. For example, if an individual tells a tattoo artist they want a tattoo of a lion, the individual will have no claim of authorship of the final product since they only provided the *idea* for the creative work.<sup>132</sup> In this scenario, the tattoo artist completes all the expressive components of the finalized tattoo with the individual giving final approval. Here, the tattoo artist would be the “author” and own the copyright in the completed work. However, the alternate scenario where both the tattoo artist and the individual client collaborate on what the final tattoo resembles, the tattoo may not be a work of a sole author, but possibly a work of joint authorship.

#### ii. Joint Authorship

A jointly authored work is defined in the Copyright 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.”<sup>133</sup> 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 separable or interdependent parts of a unitary whole.”<sup>134</sup> In addition to the statutory language, federal circuit courts have required “each author to make an independently copyrightable contribution to the [] work.”<sup>135</sup> In order to be con-

<sup>128</sup> *Id.*; see also H.R. REP. NO. 94-1476, at 53 (1976) (“Thus, in the sense of the bill, a ‘book’ is not a work of authorship, but is a particular kind of ‘copy.’ Instead, the author may write a ‘literary work,’ which in turn can be embodied in a wide range of ‘copies’ and ‘phonorecords,’ including books, periodicals, computer punch cards, microfilm, tape recordings, and so forth.”).

<sup>129</sup> *Medforms*, 290 F.3d at 107–08.

<sup>130</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 340.

<sup>131</sup> *Id.*

<sup>132</sup> See *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (“[copyright] protection is given only to the expression of the idea—not the idea itself.”).

<sup>133</sup> 17 U.S.C. § 101.

<sup>134</sup> *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231 (9th Cir. 1999).

<sup>135</sup> *Id.* (internal citation omitted); see also *Gaylord v. U.S.*, 595 F.3d 1364, 1377 (Fed. Cir. 2010) (holding that the government did not have joint ownership of a sculptor’s project was not because it did not add an independently copyrightable contribution to the work); *Richlin v. Metro-*

sidered an author, “one must supply more than mere direction or idea: one must translate [] an idea into a fixed, tangible expression entitled to copyright protection.”<sup>136</sup>

It is common in the tattoo industry for tattoo artists and individual clients to collaborate in the creation of the tattoo artwork that will be subsequently fixed to the individual’s skin.<sup>137</sup> The first element, that the work must be a copyrightable work is present in any tattoo that meets the modicum of creativity standard.<sup>138</sup> For the third element, the “highly collaborative tattoo design process is strongly suggestive of the requisite intent” of joint authors.<sup>139</sup>

The issue is the second element, since “the contribution of most clients are unlikely to meet the threshold of authorship” of an independently copyrightable contribution.<sup>140</sup> Although an individual has the final authority to approve or disapprove whatever final design goes on their body, the individual often only contributes the general idea or guidance of what they want their tattoo to look like, leaving the creative expressive decisions to the tattoo artist.<sup>141</sup> In the other extreme, the individual brings a preexisting work, like LeBron James with the photograph of his son, and the tattoo artist does not add any expressive elements when fixing the tattoo on the individual’s skin. These are the most common scenarios, and both would treat only one party as a sole author with copyright interests in the work. In order for the tattoo to be a work of joint authorship, both the tattoo artist and individual would have to contribute actual expressive elements, possibly by the individual bringing an original sketch and the tattoo artist later modifying the sketch by adding new creative elements to create a finished work. In this case, both the individuals would have independently copyrightable contributions.

However, even if an individual can prove joint authorship in the tattoo, it does not solve the problem of potential legal actions against them. The statute outlines co-ownership of the copyright in a jointly authored work, with each co-owner having “the right to use or license the work, subject to an accounting to the other co-owners for any profits.”<sup>142</sup> The result would be that the individual would still not be

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Goldwyn-Mayer Pictures, Inc., 531 F.3d 962, 968 (9th Cir. 2008) (analyzing motion picture for independently copyrightable contribution to the product to determine the existence of joint authorship); *Erickson v. Trinity Theatre*, 13 F.3d 1061, 1071 (7th Cir. 1994) (awarding all benefits of joint authorship to an author that made a minor contribution because the contribution was independently copyrightable).

<sup>136</sup> *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1087 (9th Cir. 1989) (internal citation omitted).

<sup>137</sup> *King*, *supra* note 119, at 38.

<sup>138</sup> See discussion *supra* Section II(b) (discussing what kind of tattoos meet the standards to be copyrighted and which would not).

<sup>139</sup> Aaron Perzanowski, *Tattoos and IP Norms*, 98 MINN. L. REV. 511, 535 (2013).

<sup>140</sup> *Id.*

<sup>141</sup> See *id.* (“Although each tattoo features a mix of contributions . . . clients typically contribute uncopyrightable ideas, not protected expression.”).

<sup>142</sup> *Erickson*, 13 F.3d at 1068 (citing *Childress v. Taylor*, 945 F. 2d 500, 505 (2d Cir. 1991)); 17 U.S.C. § 201(a) (“The authors of a joint work are coowners of copyright in the work.”). See also *Weinstein v. University of Illinois*, 811 F.2d 1091, 1095 (7th Cir. 1987) (discussing the entitlement

able to license their tattooed image without accounting the tattoo artist for the profits from their licensed image, even if they do not need the artist's permission to license the work as a part of their likeness. This still presents burdens and logistical hardships for an individual trying to license their own image in animated form,<sup>143</sup> and opens themselves to risk of litigation if they do not compensate the co-author, the tattoo artist, correctly.

*iii. Authorship of a "Work Made for Hire"*

The 1976 Copyright Act also provides for authorship of a copyright work to be a "work made for hire."<sup>144</sup> The statute defines the author of a "work made for hire" as "the employer or other person for whom the work was prepared . . . and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright."<sup>145</sup> The statute defines a "work for hire" as either "a work prepared by an employee within the scope of his or her employment," or "a work specially ordered or commissioned for use as a contribution to a collective work . . . if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire."<sup>146</sup> The second possibility, that the tattoo artist is an independent contractor that creates the tattoo as a work for hire for the individual client is a non-starter. First, the tattoo artist and individual client would need to have an express written agreement signed by both, which is far from the norm of the tattoo industry and most likely to never develop.<sup>147</sup> Further, even if the two parties agreed in writing that the tattoo is a work for hire, a tattoo most likely does not fall within one of the enumerated categories of an independent contractor work.<sup>148</sup>

One scenario where authorship of a "work made for hire" may impact an individual's ability to license their tattooed likeness is if the tattoo artist is employed by a tattoo parlor. This scenario could result in a tattoo artist preparing the tattoo work "within the scope of the artist's employment at the parlor."<sup>149</sup> However, many tattoo artists are considered independent contractors and own their individual tattoo art de-

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of a joint author to have the rights of a co-owner).

<sup>143</sup> See *infra* Section III(d).

<sup>144</sup> 17 U.S.C. § 201(b).

<sup>145</sup> *Id.*

<sup>146</sup> 17 U.S.C. § 101.

<sup>147</sup> See Perzanowski, *supra* note 139, at 534–35 (observing that "signed agreements that contemplate copyright ownership are practically unheard of in the tattoo industry").

<sup>148</sup> See 17 U.S.C. § 101 (defining the categories of the second possibility of a work for hire "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. . ."). The best argument would be that a tattoo constitutes a part of a "compilation," defined in § 101 as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship," if an individual receives a tattoo that combines with previous tattoos to make one larger work, like a tattoo "sleeve" or larger work on a person's back for example.

<sup>149</sup> King, *supra* note 119, at 42.

signs.<sup>150</sup>

The last scenario for potential application of the work for hire doctrine is the argument that the “within the scope of his or her employment” is made with reference to the common law meaning of the terms under agency law.<sup>151</sup> The argument would be that the individual client and tattoo artist are in an employee-employer relationship via general common law of agency. The leading case from the Supreme Court is *Community for Creative Non-Violence v. Reid*, which sets out several factors to consider. The general determining factor is “the hiring party’s right to control the manner and means by which the product is accomplished.”<sup>152</sup> The Court gives several factors to consider in this inquiry:

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.<sup>153</sup>

Applying these factors, it becomes clear that a tattoo artist and individual client do not qualify as an employee relationship to consider the tattoo a work made for hire. Although none of the factors are determinative,<sup>154</sup> none of the factors weigh in favor of finding a work made for hire. The tattoo artist possess high amounts of skill in their craft, owns all their own instruments, and tattoos their client in their own tattoo parlor. Furthermore, the duration of the relationship between the two parties is relatively short, no more than a few weeks for consultation and actual tattooing.<sup>155</sup> The client does not have the right to assign more work to the tattoo artist. Even if a client wants an additional tattoo, it is within the tattoo artist’s discretion whether to accept the client’s business a second time. In that light, the tattoo artist decides when and for how long they will work on the tattoo, and no client has authority to hire or pay an artist’s assistants. Although some individuals receive many tattoos, none would assert they are in the “regular business” of receiving tattoos, and by nature are individuals and not businesses. Since they are not businesses, and the relationship between the parties is short and temporary, the relationship between a client and tattoo artist never includes provisions for employee benefits or employment

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<sup>150</sup> Jason Rittie, *Tattoo Artists: Independent Contractors or Employees?*, EINHORN BARBARITO ATTORNEYS AT LAW (May 21, 2013), <https://www.einhornharris.com/businesslawblog/tattoo-artists-independent-contractors-or-employees/>.

<sup>151</sup> *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. at 740–41.

<sup>152</sup> *Id.* at 751 (internal citations omitted).

<sup>153</sup> *Id.* at 751–52 (internal citations omitted).

<sup>154</sup> *Id.* at 752 (internal citations omitted).

<sup>155</sup> Although some larger tattoos, like full-arm tattoo sleeves may take months or even years to complete, most of the time is designated for the tattoo to heal when the parties are separated, and no work is being done. See Michelle Nguyen, *Everything You Need to Know Before Getting a Sleeve Tattoo*, TATRING (Mar. 12, 2020), <https://tatriring.com/getting-tattooed/Everything-You-Need-to-Know-Before-Getting-a-Sleeve-Tattoo> (noting that work usually “for an arm sleeve is 10–15 hours, but some take 80 hours or more”).

like tax treatment. For all these reasons, it is fairly clear a court would treat the relationship between an individual client and a tattoo artist as one between an individual and a highly-skilled independent contractor, not as an employee-employer relationship.

#### b. Copyright Affirmative Defenses

If ownership of the valid copyright does not belong to the tattooed individual, then a potential plaintiff, either tattoo artist or other third party, would be able to bring a copyright infringement claim. The potential plaintiff would be able to support a prima facie case of copyright infringement, since they have “ownership of a valid copyright” and can prove “copying of constituent elements of the work that are original.”<sup>156</sup>

Once a prima facie case has been proven, the burden shifts to the potential defendant in the case to produce evidence of a copyright affirmative defense or another superseding area of law in order to dismiss a potential infringement claim. The two most applicable affirmative defenses for reproducing a tattoo on a person’s animate likeness are: 1) the tattooed individual received an implied license from the copyright owner (usually the tattoo artist) to reproduce, distribute, and display the image of the tattoo with their real and animated likeness; and 2) a potential defendant’s animated reproduction of a tattooed individual’s likeness, either realistically or stylized, constitutes a fair use.

##### *i. Implied Licenses*

The 1976 Copyright Act sets out limitations of a copyright owner’s right to control a work after a transfer of ownership of a copy of that work.<sup>157</sup> One of these limitations is that “the owner of a particular copy . . . is entitled, without the authority of the copyright owner, to display that copy publicly . . . to viewers present at the place where the copy is located.”<sup>158</sup> This limitation allows individuals with tattoos to walk down a public street or perform in a live play with their tattoos exposed; however, it does not extend to allow the individual to reproduce the tattoo or include it in derivative works.

Once the individual’s use falls outside of this narrow statutory exception, the individual must then rely upon their secondary use of the tattoo on their animated likeness fits within a recognized affirmative defense. The first affirmative defense for potential defendants who reproduced a tattooed individual’s animated likeness is that the tattoo artist (or holder of the copyright in the tattoo image) has given to the tattooed individual an implied license to reproduce, distribute, and display the image of the tattoo with their likeness, either real or animated. As a general matter, a copyright owner “who grants a nonexclusive license to use his copyrighted material

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<sup>156</sup> *Feist Publ’ns*, 499 U.S. at 361.

<sup>157</sup> 17 U.S.C. § 109.

<sup>158</sup> 17 U.S.C. § 109(c).

waives his right to sue the licensee for copyright infringement.”<sup>159</sup> A license can be a result of a written contract, or a result of implied license. Implied licenses are created when “one party (1) creates a work at another person’s request; (2) delivers the work to that person; and (3) intends that the person copy and distribute the work.”<sup>160</sup> Implied licenses by nature can be limited, usually being a non-exclusive license,<sup>161</sup> and are subject to the scope that the parties intend that the work can be copied or distributed.

The first element, that a tattoo artist “creates a work at another person’s request” is quite clear. Outside an absurd situation where a tattoo artist sedates an unknowing person and tattoos them without their knowledge or consent, it is quite clear that individuals receive tattoos from the artist as a result of the individual’s request for a tattoo. This decision includes the final approval of what image is tattooed and where on their body the tattoo will appear, a decision that impacts how often the tattoo is seen or displayed. The second element is also clear: the tattoo artist “delivers the work” to the individual by tattooing the work onto the individual’s body.

The only element that needs further analysis is if a tattoo artist “intends that [an individual] copy and distribute the work.” Tattoo artists “embrace a more robust set of exhaustion rights favoring their clients.”<sup>162</sup> Tattoo artists already know that they cannot control their customer’s body after tattooing them, and in fact they “expect their clients to publicly display their works” and “acknowledge the prevalence of such exposure in the tattoo industry.”<sup>163</sup>

In addition to displaying their tattooed body in public allowed in §109(c) of the Copyright Act, tattoo artists “acknowledge clients’ rights to reproduce 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.”<sup>164</sup> This includes the expectation of the higher publicity with professional athletes, famous movie stars, or other public figures. This higher publicity includes the possibilities that their tattoos will be displayed in a movie an actress appears in or on television when an athlete competes in an athletic event or makes public appearances.<sup>165</sup> This widely accepted practice and form of implied license only covers images or footage of the actual individual with tattoos;

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<sup>159</sup> *Graham v. James*, 144 F.3d 229, 236 (2d Cir. 1998).

<sup>160</sup> *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1235 (11th Cir. 2010).

<sup>161</sup> *See Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990) (describing that leading copyright law treatises allow implied licenses as non-exclusive licenses).

<sup>162</sup> *Perzanowski*, *supra* note 139, at 537.

<sup>163</sup> *King*, *supra* note 119, at 50.

<sup>164</sup> *Perzanowski*, *supra* note 139, at 537 (tattoo artists also “recognize that clients are free to create new works that incorporate or even destroy their original designs” when receiving subsequent tattoos to “coverup,” or add on to an existing tattoo).

<sup>165</sup> *Compl. at 3, Allen v. Elec. Arts, Inc.*, No. 5:12-CV-3172 (W.D. La. Dec. 31, 2012), *dismissed*, (W.D. La. Apr. 9, 2013) (stating that tattoo artist knew his client was a professional football player, and therefore, he “assumed he would see his art on television”).



it does not answer whether this license is extended to cover an individual's animated likeness.

The natural question becomes, what is the extent of this implied license between the tattoo artist and tattooed individual, and more importantly, does the implied license include reproducing the tattoo on an animated likeness of the individual? Some tattoo artists have argued that this implied license ends when an individual cooperates with a third party to use the individual's image (including their tattoos) when it is "disconnected from the body of the tattoo bearer."<sup>166</sup> The distinction is 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."<sup>167</sup> To answer the first question, the scope of the implied license ends once the tattoo is no longer used as applied to the body, and its secondary use is a work "disconnected from the body." The second question, whether the implied license includes reproducing the tattoo on an animated likeness of the individual, is only answered by determining if a tattoo on an animated likeness is "disconnected" from the body or used "as applied to the body."

Although those who have filed copyright infringement claims believe that the digital or animated likeness is "detached" and thus "disconnected" from the tattooed individual's body,<sup>168</sup> reproduction of an individual's tattooed image in animated form (either in video games, movies, pictorial works, etc.) falls directly under what tattoo artists and clients currently understand the implied license to include: to reproduce images of their tattooed bodies. This is not a scenario where an individual is using their tattoo for something "external" or "disconnected" from their body like a clothing line or a logo. The secondary works are only reproducing the tattoos to the extent that they are reproducing the image of the individuals' tattooed bodies. Tattoo artists intend for the tattoos to be incorporated "as elements of their likenesses," and absent a "request[] [or] agree[ment] to limit the display or depiction of the images tattooed" onto the individual's body, the individual has an implied license to reproduce the tattoos as a part of their image and likeness.<sup>169</sup>

Courts have repeatedly found that non-photographic depictions of an individual still constitutes their likeness.<sup>170</sup> Furthermore, applying the implied licenses to

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<sup>166</sup> King, *supra* note 119, at 50–51.

<sup>167</sup> Perzanowski, *supra* note 139, at 537.

<sup>168</sup> See, e.g., *Solid Oak Sketches*, 449 F. Supp. 3d at 346; Perzanowski, *supra* note 139, at 537–38 (discussing different copyright infringement actions involving video games depicting tattooed athletes).

<sup>169</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 346.

<sup>170</sup> See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936 (6th Cir. 2003) (where a painting of Tiger Woods constituted a likeness of Tiger Woods); *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, 95 F.3d 959, 962, 976 (10th Cir. 1996) (where readily identifiable caricatures of major league baseball players using similar names, recognizable caricatures, and distinctive team colors that left no doubt about the caricatures "identity" was a reproduction of the baseball players' likenesses); *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (where a female-shaped robot wearing a long gown, blonde wig, large jewelry, and turning letters in what appeared to be the "Wheel of Fortune" game show set constituted a likeness of Vanna White);

cover digital or animated recreation of tattooed individuals' likenesses would not upset or be contrary to what many tattoo artists believe their copyright interest in the tattoos are currently.<sup>171</sup> For example, the copyright owner of Mike Tyson's famous face tattoo has never brought an action against Mike Tyson's use of the tattoo as a part of his real or animated likeness,<sup>172</sup> but he has filed claims of copyright infringement when third parties reproduced his tattoo artwork on the face of another person in another work.<sup>173</sup> The lawsuits that have been brought to court involving tattoos on the originally tattooed individuals' likenesses are brought by a small minority of tattoo copyright holders with claims that legal scholars have said "amount[] to a shakedown and copyright trolling."<sup>174</sup>

### ii. Fair Use

Although existing prior to 1976, the fair use affirmative defense was finally codified in the 1976 Copyright Act.<sup>175</sup> The fair use defense exists to advance copyright's purpose of "promot[ing] the Progress of Science and useful Arts."<sup>176</sup> The defense accomplishes this by allowing "others to build freely upon the ideas and information conveyed by a work."<sup>177</sup> Fair use "is not designed to protect lazy appropriators. Its goal instead is to facilitate a class of uses that would not be possible if users always had to negotiate with copyright proprietors."<sup>178</sup>

The "ultimate test" of fair use is whether the progress of human thought "would be better served by allowing the use than preventing it."<sup>179</sup> In analyzing the fair use defense, courts balance the four factors outlined in the 1976 Copyright Act:

- (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;

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Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 802 (Cal. 2001) (where lithograph reproduction of drawing of the Three Stooges constituted likenesses).

<sup>171</sup> Jason M. Bailey, *Athletes Don't Own Their Tattoos. That's a Problem for Video Game Developers*, New York Times (Dec. 27, 2018), <https://www.nytimes.com/2018/12/27/style/tattoos-video-games.html> (noting tattoo artist's surprise that an athlete asked for their permission to use their tattoo in their animated likeness).

<sup>172</sup> See *Mike Tyson Mysteries*, IMDB (2020), <https://www.imdb.com/title/tt3038546/> (where an animated depiction Mike Tyson regularly displays his facial tattoo in the television series).

<sup>173</sup> See Complaint at 4, *Whitmill v. Warner Bros. Entm't, Inc.*, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011) (No. 4:11-cv-00752).

<sup>174</sup> Bailey, *supra* note 171 (citing Christopher Jon Sprigman, intellectual-property professor at New York University).

<sup>175</sup> 17 U.S.C. § 107. ("the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringement of copyright.")

<sup>176</sup> U.S. CONST. art. I, § 8, cl. 8; see also *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994) (discussing that the fair use opportunity is meant to fulfill the purpose of copyright afford by the U.S. Constitution).

<sup>177</sup> *Feist Publ'ns*, 499 U.S. at 350.

<sup>178</sup> *Kienitz v. Scornie Nation LLC*, 766 F.3d 756, 759 (7th Cir. 2014).

<sup>179</sup> *Cariou v. Prince*, 714 F.3d 694, 705 (2d Cir. 2013) (quoting *Castle Rock Entm't*, 150 F.3d at 141) (internal quotation marks omitted).

- (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.<sup>180</sup>

The fair use doctrine “permits and requires courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.”<sup>181</sup> Instead the statute “employs the terms ‘including’ and ‘such as’ in the preamble paragraph to indicate the illustrative and not limitative function of the examples given, which thus provide only general guidance about the sorts of copying that courts and Congress most commonly had found to be fair uses.”<sup>182</sup> Courts should not weigh “the four statutory factors . . . in isolation, one from another. All are to be explored, and the results weighed together, in light of the purposes of copyright.”<sup>183</sup> There are no “bright-line rules,” but instead the statute “calls for case-by-case analysis.”<sup>184</sup>

Reproducing an individual’s tattoos on their animated likeness would constitute a fair use due to its transformative purpose and character and its nearly non-existent effect upon the potential market for the original work. Since fair use calls for a case-by-case analysis weighing all four factors, this section will analyze each factor individually with both hypothetical situations outlined at the beginning of this Section: 1) the tattoo is reproduced in a 1 to 1 or proportionally scaled depiction of the animated tattooed individual and 2) the tattoo is reproduced in a different stylization of the animated tattooed individual.

### 1. Purpose and Character of the Use

The first fair use factor to consider is the “purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes.”<sup>185</sup> Many courts have considered this first factor to be “[t]he heart of the fair use inquiry.”<sup>186</sup> To determine if the “purpose and character of the use” weighs in favor of fair use, Courts must ask:

whether the new work merely “supersedes the objects” of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message [,] . . . in other words, whether and to what extent the new work is “transformative.” . . . [Transformative works] lie at the heart of the fair

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<sup>180</sup> 17 U.S.C. § 107.

<sup>181</sup> *Campbell*, 510 U.S. at 577 (quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990)) (internal punctuation omitted).

<sup>182</sup> *Id.* at 577–78; *see* 17 U.S.C. § 107 (“the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.”).

<sup>183</sup> *Campbell*, 510 U.S. at 578.

<sup>184</sup> *Id.* at 577; *see also* *Harper & Row, Publishers v. Nation Enters.*, 471 U.S. 539, 560 (1985) (reasoning that fair use is a mixed question of law and fact that requires an evaluation of the specific case at issue).

<sup>185</sup> 17 U.S.C. § 107.

<sup>186</sup> *Blanch v. Koons*, 467 F.3d 244, 251 (2d Cir. 2006) (quoting *Davis v. The Gap, Inc.*, 246 F.3d 152, 174 (2d Cir. 2001)); *Campbell*, 510 U.S. at 579; *Cariou*, 714 F.3d at 705.

use doctrine's guarantee of breathing space . . . .<sup>187</sup>

In *Campbell*, the Supreme Court held that the more “transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.”<sup>188</sup> For this reason, even if the reproduction of the tattoo is part of a commercial secondary work, like it was in *Solid Oak Sketches*, the first factor can still favor fair use if the secondary work is “transformative.”

The secondary creator's intent or lack of intent to be transformative is not an issue, but rather “whether a [transformative] character may reasonably be perceived.”<sup>189</sup> This test means that the creators of the NBA video game in *Solid Oak Sketches* and later creators of other video games, comics, cartoons, and other illustrations do not have to intend their work with the recreation of the tattoo to be “transformative.” Instead, the test is if a reasonable observer can perceive this use as transformative.

Even though “many types of fair use, such as satire and parody, invariably comment on an original work and/or popular culture . . . [t]he law imposes no requirement that a work comment on the original or its author in order to be considered transformative.”<sup>190</sup> A secondary work “may constitute a fair use even if it serves some purpose other than those (criticism, comment, news reporting, teaching, scholarship, and research) identified in the preamble to the statute.”<sup>191</sup> What is

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<sup>187</sup> *Campbell*, 510 U.S. at 579; see also *Castle Rock Ent.*, 150 F.3d at 142 (“If the secondary use adds value to the original—if [copyrightable expression in the original work] is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.”) (internal quotation marks omitted); Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990) (for a use to be fair, it “must be productive and must employ the quoted matter in a different manner or for a different purpose from the original”).

<sup>188</sup> *Campbell*, 510 U.S. at 578–79 (emphasis added) (noting “nearly all of the illustrative uses listed in the preamble paragraph of § 107, including news reporting, comment, criticism, teaching, scholarship, and research . . . are generally conducted for profit”) (internal quotation marks omitted); *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 922 (2d Cir. 1994) (“The commercial/nonprofit dichotomy concerns the unfairness that arises when a secondary user makes unauthorized use of copyrighted material to capture significant revenues as a direct consequence of copying the original work.”).

<sup>189</sup> *Campbell*, 510 U.S. at 582; see also *Cariou*, 714 F.3d at 707 (“the fact that [defendant did not defend his use as transformative] is not dispositive. What is critical is how the work in question appears to the reasonable observer, not simply what an artist might say about a particular piece or body of work.”); *Dr. Seuss v. Penguin Books*, 109 F.3d 1394, 1405 (9th Cir. 1997) (labeling a work a “parody” does not make it a parody or transformative).

<sup>190</sup> *Cariou*, 714 F.3d at 706 (“[Defendant’s] work could be transformative even without commenting on [plaintiff’s] work or on culture, and even without [defendant’s] state intention to do so.”). *But see Dr. Seuss*, 109 F.3d at 1394 (where court rejected fair use defense where defendant satirized multiple *Dr. Seuss* short stories to critique the outcome of the O.J. Simpson trial).

<sup>191</sup> *Cariou*, 714 F.3d at 706; see also *Campbell*, 510 U.S. at 577 (discussing how the fair use doctrine requires the courts to avoid a rigid application and thus is not bound to only the purposes explicitly provided statutorily); *Harper & Row*, 471 U.S. at 561. (where the court reasoned that the examples listed in § 107 were not intended to be exhaustive).

more important is that the new work “must alter the original with new expression, meaning, or message.”<sup>192</sup>

Both hypothetical situations, realistic or stylized, of reproductions of the tattoos on an animated likeness would constitute a transformative use. First, a secondary work with a realistic reproduction of the tattoo on the animated tattooed individual would have a purpose “entirely different from the purpose for which the [t]attoos were originally created.”<sup>193</sup> The original tattoos were created as some combination of the tattoo artist’s artistic expression and tattooed individual’s personal expression through unique body art, while the tattoos in the secondary work are used in order to most accurately depict the tattooed individual’s likeness. The tattoos are not used to recreate their creative purpose, but to create recognizable depictions of real individuals. The result is that the secondary work is not “superseding” the original tattoo work, instead it alters the purpose and character.

For the situations where the tattooed individual is recreated in some stylized manner, courts have already held as a matter of law that a secondary work is transformative if “looking at the [two works] side-by-side,” the secondary work “ha[s] a different character . . . a new expression, and employ[s] new aesthetics with creative and communicative results distinct” from the original.<sup>194</sup> The result is a heads-the-tattooed-individual-wins-tails-the-tattoo-copyright-owner-loses situation. If the secondary work accurately depicts tattoo, it is transformative for the reasons that its purpose of accurately depicting the likeness of an individual is different than the original tattoos creative purpose. If the secondary work combines the purpose of depicting a tattooed individual’s likeness with new creative expression, that expression will also be transformative since it will employ new aesthetics and new expression to the tattoo’s original character.

## 2. Nature of the Copyrighted Work

The next statutory factor, the “nature of the copyrighted work,” “calls for recognition that some works are closer to the core of intended copyright protection than others, with the consequence that fair use is more difficult to establish when the former works are copied.”<sup>195</sup> Courts consider “(1) whether the work is expressive or creative, . . . with a greater leeway being allowed to a claim . . . where the work is factual or informational, and (2) whether the work is published or unpublished, with the scope. . .[for] unpublished works being considerably narrower.”<sup>196</sup> For example, fictional short stories are closer to the core of intended copy-

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<sup>192</sup> *Cariou*, 714 F.3d at 706 (quoting *Campbell*, 510 U.S. at 579) (internal quotation marks omitted).

<sup>193</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 347.

<sup>194</sup> *Cariou*, 714 F.3d at 707–08; see also *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 325–26 (S.D.N.Y. 2019) (holding that, as a matter of law, a secondary that creates a new expression is transformative).

<sup>195</sup> *Campbell*, 510 U.S. at 586.

<sup>196</sup> *Cariou*, 714 F.3d at 709–10 (quoting *Blanch*, 467 F. 3d at 256); see also *Harper & Row*, 471 U.S. 539, 553 (noting the applicability of the fair use doctrine to unpublished works is narrowly limited, due to availability concerns).

right protection than factual works;<sup>197</sup> a soon-to-be-published memoir is closer to the core of intended copyright protection than a published speech;<sup>198</sup> and motion pictures are closer to the core of intended copyright protection than news broadcasts.<sup>199</sup>

First, by nature of tattooing an individual that goes out into the world, that tattoo can be considered published, which weighs in favor of fair use. Second, a tattoo is a pictorial work that is usually considered highly expressive and creative. The court in *Solid Oak Sketches* held that the tattoo designs in the case were “more factual than expressive because they [were] each based on another factual work or comprise representational renderings of common objects and motifs that are frequently found in tattoos.”<sup>200</sup> The analysis that tattoos are not creative is possibly true when a tattoo is depicting something factual, like an image of a person, or in cases of designs that are not subject to copyright, like a number or font. However, even photographs, like the one of LeBron James’s son that the court in *Solid Oaks* held as not creative, have been held by many courts to be “creative” works.<sup>201</sup> Further, many courts would disagree with the court in *Solid Oak Sketches* that tattoos using “common tattoo motifs” like flames, wizards, and basketballs are not creative. If this were the case, every painting of a bowl of fruit, every song about heartbreak, and every haunted house movie would not be “creative.” This would be an absurd result. More realistically, a court would find that a tattoo is a creative work and potentially weigh this factor against a finding of fair use.

But similar to the commercial nature of the secondary work, this factor “may be of limited usefulness where the creative work of art is being used for a transformative purpose.”<sup>202</sup> As a result, the second factor may weigh against a finding of fair use for reproducing an individual’s tattoos in their animated likeness, but it is not determinative or detrimental to the overall fair use analysis.<sup>203</sup>

### 3. Amount and Substantiality of the Portion Used

The third factor is the “amount and substantiality of the portion used in relation to *the copyrighted work as a whole*.”<sup>204</sup> This factor is reviewed “with reference to the copyrighted work, not the [secondary] work.”<sup>205</sup> It does not matter how much of

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<sup>197</sup> *Stewart*, 495 U.S. at 237–38.

<sup>198</sup> *Harper & Row*, 471 U.S. at 563–64.

<sup>199</sup> *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 455 n.40 (1984).

<sup>200</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 348.

<sup>201</sup> *See, e.g., Cariou*, 714 F.3d at 710; *Blanch*, 467 F.3d at 257; *Andy Warhol Foundation*, 382 F. Supp. 3d at 327.

<sup>202</sup> *Bill Graham Archives*, 448 F.3d at 612; *see also Campbell*, 510 U.S. at 586 (stating that the second factor is not “likely to help much in separating the fair use sheep from the infringing goats” in cases involving transformative copying of “publicly known, expressive works”).

<sup>203</sup> *Authors Guild v. HathiTrust*, 755 F.3d 87, 102 (2d Cir. 2014) (where the court held that factor two is not dispositive, and in fact unhelpful in transformative use cases.).

<sup>204</sup> 17 U.S.C. § 107 (emphasis added).

<sup>205</sup> *Bill Graham Archives*, 448 F.3d at 613; *see also New Era Publications Intern., ApS v. Carol Pub. Grp.*, 904 F.2d 152, 159 (2d Cir. 1990) (rejecting an appellee’s argument to look beyond the copy-

the tattoo makes up the secondary work, instead it only matters how much of the tattoo the secondary work uses.

Courts must examine the quantitative and qualitative aspects of the portion of the copyrighted material taken.<sup>206</sup> For both a realistic and stylized reproduction of a tattoo on an animated likeness, the secondary work would take the entire work, quantitatively and qualitatively. However, a large amount and substantiality taken does not guarantee that the third factor weighs against a finding of fair use.

The Supreme Court in *Campbell* held that “the extent of permissible copyright varies with the purpose and character of the use.”<sup>207</sup> The question courts must ask is “whether the quantity and value of the materials used[] are reasonable in relation to the purpose of the copying.”<sup>208</sup> In fact, there are many cases where courts have found fair use when the secondary use took all of the original copyrighted work but the use was transformative.<sup>209</sup> Furthermore, the “courts have concluded that such copying does not necessarily weigh against fair use because copying the entirety of a work is sometimes necessary to make a fair use of the image.”<sup>210</sup> Reproducing the entire tattoo in the secondary work is necessary to achieve the transformative purpose of accurately depicting a tattooed individual, either realistically or stylized.

As a result, in the context of transformative works, the circumstances involving whether a proper amount or too much was taken often tend to be addressed instead by the fourth factor, “by revealing the degree to which [the transformative work] may serve as a market substitute for the original or potentially licensed derivatives.”<sup>211</sup>

#### 4. Effect of the Use Upon the Potential Market

The fourth factor, the effect of the secondary use upon the potential market for

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righted work to secondary materials).

<sup>206</sup> *Campbell*, 510 U.S. at 586.

<sup>207</sup> *Id.* at 586–87; see also *Sony v. Universal*, 464 U.S. at 449–50 (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); *Harper & Row*, 471 U.S. at 564 (“[E]ven substantial quotations might qualify as fair use in a review of a published work or a news account of a speech” but not in the scope of a soon-to-be-published memoir).

<sup>208</sup> *Cariou*, 714 F.3d at 710 (quoting *Blanch*, 467 F.3d at 257) (quotation marks omitted).

<sup>209</sup> See, e.g., *Perfect 10 v. Amazon*, 508 F.3d 1146 (9th Cir. 2007) (holding that even if 100% of the work was taken, the use was transformative because images were being used for search indexing, not their original expressive purpose); *Bill Graham Archives*, 448 F.3d at 613 (finding use of thumbnail sized photographs for archival and historical purposes in anthology were fair use because they were not used for the original expressive purpose).

<sup>210</sup> *Bill Graham Archives*, 448 F.3d at 613.

<sup>211</sup> *Campbell*, 510 U.S. at 587; see also *HathiTrust*, 755 F.3d at 97 (where a group of colleges scanned 100% of books in their libraries to make a searchable data base, the court found the use was transformative since it provides a different function than original rather than being used as a substitute, and it provides a different market than the original. Making copies of the full works was “necessary” in order to enable the search functions); *Bill Graham Archives*, 448 F.3d at 613 (“[T]he third-factor inquiry must take into account that the extent of permissible copying varies with the purpose and character of the use.”).

the original copyrighted work, usually works in conjunction with the first factor as the two most important factors in cases of a “transformative use.”<sup>212</sup> The courts consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also “whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market for the original.”<sup>213</sup>

The fourth factor is “concerned with only one type of economic injury to a copyright holder: the harm that results because the secondary use serves as a substitute for the original work.”<sup>214</sup> Even if an individual commercialized their animated tattooed likeness, there is “[n]o ‘presumption’ or inference of market harm . . . [in] a case involving something beyond mere duplication for commercial purposes . . . when, on the contrary, the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred.”<sup>215</sup> In fact, “the more the copying is done to achieve a purpose that differs from the purpose of the original, the less likely it is that the copy will serve as a satisfactory substitute for the original.”<sup>216</sup> For example, a song parody like the one in the *Campbell* case would not operate as a market substitute the same way a pure cover of the same song would. The “market harm” courts are concerned about for the fourth factor is “market substitution,” not if a secondary use hurts the prestige or credibility of the original.<sup>217</sup>

The question of “market substitution” is quite simple. Does the animated likeness of a tattooed individual replace (not suppress) the demand for the original tattoo; or as an alternative, are animated tattoos on an individual’s likeness an otherwise licensable market? The first question is simple since no reasonable person would be deterred from receiving a tattoo if they saw an animation of a celebrity with tattoos,<sup>218</sup> the same tattoos the public already witnesses on the individual in real life. In other words, potential purchasers of tattoos are unlikely to “opt to acquire the copy in preference to the original” to result in “depriv[ing] the rights holder of

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<sup>212</sup> See *Leibovitz v. Paramount Pictures*, 137 F. 3d 109, 114 (2d Cir. 1998) (noting the importance of the fourth factor varies dependent on the relative strength of the other factors, and thus analyzing the fourth factor in conjunction with the first factor).

<sup>213</sup> Nimmer § 13.05[A][4], p. 13-102.61 (footnote omitted).

<sup>214</sup> *HathiTrust*, 755 F.3d at 99.

<sup>215</sup> *Campbell*, 510 U.S. at 591.

<sup>216</sup> *Authors Guild v. Google, Inc.*, 804 F.3d 202, 223 (2d Cir. 2015); see also *HathiTrust*, 755 F.3d at 99 (holding that transformative uses do not cause actionable economic harm because “by definition, [such uses] do not serve as substitutes for the original work”).

<sup>217</sup> See *Campbell*, 510 U.S. at 591–92 (“We do not, of course, suggest that a parody may not harm the market at all, but when a lethal parody, like a scathing theater review, kills demand for the original, it does not produce a harm cognizable under the Copyright Act.”); see also *Fisher v. Dees*, 794 F.2d 432, 438 (9th Cir. 1986) (the role of the courts is to distinguish between “[b]iting criticism [that merely] suppresses demand [and] copyright infringement[, which] usurps it.”).

<sup>218</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 350 (noting that the tattoo copyright owner conceded that the NBA video game depicting animated players with their tattoos did not act as a substitute for the tattoos themselves).



significant revenues.”<sup>219</sup> The only remaining question is if the use of the tattoo in the individual’s animated likeness is a licensable market.

Courts can only consider the “impact on potential licensing revenues for traditional, reasonable, or likely to be developed markets.”<sup>220</sup> It is not sufficient for original copyright owners to state that they have chosen not to license this type of market for proof of a licensing market, or any works of criticism or negative commentary would never develop.<sup>221</sup> While there may be a market for licensing tattoo designs to tattoo artists and parlors,<sup>222</sup> there is no current market for licensing tattoo images to third parties that recreate a tattoo individual’s likeness and image, nor is one likely to develop.<sup>223</sup> Further, the tattoo copyright owner would not be able to “capitalize on such a market” if one becomes available since the tattoos “are imprinted on the bodies” of the individuals, and the tattoo copyright owners are “not licensed to use the [individuals’] publicity rights.”<sup>224</sup> As a result, a court would weigh the fourth factor in favor of a finding of fair use

### 5. Balancing the Factors

On balance, the argument that reproducing a tattoo as a part of a tattooed individual’s animated likeness constitutes fair use is compelling. Since tattoos are most likely creative works and usually the entire tattoo is copied, the second and third factors will usually weigh against fair use. However, courts have found a secondary use to be fair use, even when the second and third factors weigh against fair use when that secondary use is highly “transformative” and has little effect upon the potential market for the original copyrighted work. Using a tattoo in an individual’s animated likeness, when that tattoo is already a part of their likeness constitutes a transformative use. It is a completely different use with a different purpose: to accurately depict through animation, digitalization, or other form how an individual actually looks like in real life. Due to its transformative use, it has its own market that is distinct and separate from the market of the original copyrighted work. Because of the transformative use of the original material and the lack of effect upon the market for the original work, a court, after balancing the fair use factors, would find that reproducing an individual’s tattoo as a part of their animated likeness constitutes a fair use.

#### c. Right of Publicity

One area of law that the *Solid Oak Sketches* case did not address was the im-

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<sup>219</sup> *Google*, 804 F.3d at 223.

<sup>220</sup> *Swatch Grp. Mgmt. Servs. Ltd. v. Bloomberg L.P.*, 756 F.3d 73, 91 (2d Cir. 2014).

<sup>221</sup> *Campbell*, 510 U.S. at 592 (“The market for potential derivative uses includes only those that creators of original works would in general develop or license others to develop. Yet the unlikelihood that creators of imaginative works will license critical reviews or lampoons of their own productions removes such uses from the very notion of a potential licensing market.”).

<sup>222</sup> *See Tattoo Art Inc. v. TAT Intern. LLC*, 498 F. App’x 341, 343 (4th Cir. 2012) (where the subject of the lawsuit was the breach of a copyright license agreement involving “flash” tattoo designs).

<sup>223</sup> *Solid Oak Sketches*, 449 F. Supp. 3d at 351–52.

<sup>224</sup> *Id.* at 350.

plications on the tattooed person's right of publicity. The right of publicity is "an intellectual property right of recent origin which has been defined as the inherent right of every human being to control the commercial use of his or her identity."<sup>225</sup> Although the original interpretation of a person's identity for their right of publicity was limited to the person's name and likeness,<sup>226</sup> Restatement (Third) of Unfair Competition includes the appropriation of "other indicia of identity" as an infringement of the right of publicity.<sup>227</sup>

Tattooed individuals see their tattoos as a part of their "persona and identity," and that any reproduction of their image and likeness without their tattoos would not really be a depiction of themselves.<sup>228</sup> If individuals with tattoos are unable to license their image and likeness due to a tattoo's copyright, then the copyright owner of the tattoo would effectively control that individual's right of publicity.<sup>229</sup> An individual cannot ink away an inherent right simply by receiving a tattoo, and if a court enforces a copyright infringement action against an individual or authorized third-party who reproduces the tattoo in an animated likeness of the individual, that court would be hindering that individual's right of publicity.

However, a right of publicity argument would not be a preferred legal avenue for tattooed individuals who want to license their tattooed image and likeness. First, right of publicity laws do not exist in all fifty states.<sup>230</sup> Second, the vast majority of statutes and case law related to the right of publicity revolves around celebrities su-

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<sup>225</sup> *ETW Corp.*, 332 F.3d at 928; *see also* *Miller v. Glenn Miller Prods.*, 318 F. Supp. 2d 923, 923 n.6 (C.D. Cal. 2004) ("Fundamentally, the right of publicity "is the inherent right of every human being to control the commercial use of his or her identity") (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 18:43 (4th ed.)); *Hoffman v. Capital Cities/ABC Inc.*, 255 F.3d 1180, 1183 (9th Cir. 2001) (California recognizes in both its common law and statutory law the "right of a person whose identity has commercial value—most often a celebrity—to control the commercial use of that identity.") (quoting *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1098 (9th Cir. 1992)).

<sup>226</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 2015).

<sup>227</sup> *Id.* cmt. d ("The use of other identifying characteristics or attributes may also infringe the right of publicity, but only if they are so closely and uniquely associated with the identify of a particular individual that heir use enables the defendant to appropriate the commercial value of the person's identity."); Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853, 857 (1995) ("But, of, course, for certain people, there may be other indicia of the unique persona; certain traits, characteristics, mannerisms, or even paraphernalia may be peculiarly attached to the individual so as uniquely to evoke that individual.").

<sup>228</sup> *See* Decl. of LeBron James at 2, *Solid Oak Sketches, LLC v. 2K Games, Inc.*, 449 F. Supp. 3d 333 (S.D.N.Y. 2020) (No. 1:15-cv-724-LTS-SDA) (LeBron James, one of the players whose tattoos were at issue in the case, in his declaration of support stated: "My tattoos are a part of my persona and identity; if I am not shown with my tattoos, it wouldn't really be a depiction of me.").

<sup>229</sup> Craig Bloom, *Hangover Effect: May I See Your Tattoo Please*, 31 CARDOZO ARTS & ENT. L.J. 435, 439 (2013) ("By virtue of [getting a tattoo subject to copyright protection], an individual holding the copyright over a tattoo design could conceivably dictate how the tattoo holder acts.").

<sup>230</sup> *See* Yolanda King, *The Right-of-Publicity Challenges for Tattoo Copyrights*, 16 NEV. L.J. 441, 441 (2016) ("Right-of-publicity laws exist in more than thirty of the states in the United States, in common law, by statute, or both.").

ing others who appropriate their name and likeness.<sup>231</sup> Finally, there is the open question of whether a defense grounded on state law right of publicity would be preempted by the federal Copyright Act.<sup>232</sup> Between the non-existence of right of publicity law in some states, lack of clear precedent in the states where right of publicity is recognized, and potential for federal copyright law preemption, relying upon an argument of a tattooed individual's right of publicity provides too many risks and uncertainties to provide an adequate remedy for tattooed individuals wanted to reproduce their image and likeness in animated form.

#### d. Public Policy

Public policy demands for tattooed individuals to have the same capability of licensing their animated image and likeness as a non-tattooed individual. If a court would hold the opposite, that tattoo copyright owners can restrict a tattooed individual from licensing their lifelike or stylized tattoo image and likeness, the result would invoke negative implications of the Thirteenth Amendment, an issue of enforcing a just remedy, and would force individuals to turn to costly and impactable alternatives.

##### i. Implication of Thirteenth Amendment

A common argument against the copyrightability of tattoos is that granting copyright's exclusive rights to a tattoo artist or other third party could lead to unintended consequences of the Copyright Act.<sup>233</sup> If taken literally, a copyright owner of a tattoo could prevent the person with the tattoo from appearing in a magazine, on television, or even animating an accurate representation of their image and likeness. These restrictions would result in "control by tattoo, which some believe amounts to involuntary servitude or a form of ownership in the body of another."<sup>234</sup> Both outcomes would be prohibited under the Thirteenth Amendment.

The first section of the Thirteenth Amendment provides that "neither slavery

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<sup>231</sup> See, e.g., *Comedy II Production*, 21 P.3d at 797; *ETW Corp. v. Jireh Publ'g Inc.*, 99 F. Supp. 2d 829, 830 (N.D. Ohio 2000); *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1344 (D.N.J. 1981).

<sup>232</sup> *Compare Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231–32 (1964) (holding state unfair competition laws regarding selling of identical lamps are preempted by federal copyright and patent law), with 17 U.S.C. § 301(b)(3) ("Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to. . . activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106"); see also H.R. REP. NO. 94-1476 ("The intention of section 301 is to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright and that extend to works coming within the scope of the Federal copyright law," while also stating that § 301 is consistent with the decision in *Sears, Roebuck & Co.*). The question becomes if state right-of-publicity laws are viewed as equivalent rights to copyright law, or distinct causes of action. Given courts have described right of publicity as an offshoot of intellectual property rights, it is foreseeable that state right of publicity laws will be preempted by the 1976 Copyright Act.

<sup>233</sup> See Decl. of David Nimmer at 5–6, *Whitmill v. Warner Bros. Ent. Inc.*, 2011 WL 2038147 (E.D. Mo. May 20, 2011) (No. 4:11-CV-752) (outlining the unintended consequences of recognizing copyright protection for a tattoo).

<sup>234</sup> Bloom, *supra* note 229, at 439.

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.”<sup>235</sup> This section abolishes slavery and “also seeks to stamp out anything that could resemble ownership of human beings.”<sup>236</sup> The term “involuntary servitude,” while creating a broader category of prohibited conduct, has confounded many as to “the exact range of conditions it prohibits.”<sup>237</sup> The general consensus is that “precedents clearly define a Thirteenth Amendment prohibition of involuntary servitude enforced by the use or threatened use of physical or legal coercion.”<sup>238</sup> Although a copyright owner could use “legal coercion” via the Copyright Act to control certain decisions of a tattooed individual, “[i]t seems extreme to suggest that [a copyright owner] has a property or ownership interest in the body of the individual bearing his tattoo design on technical or theoretical grounds under the Copyright Act.”<sup>239</sup>

Implied licenses and fair use, when applied properly, allow the Copyright Act and copyright interests to exist without running afoul to Thirteenth Amendment concerns. Without proper application of implied licenses and fair use to allow tattooed individuals to use and license their animated image and likeness, extreme and absurd results related to the Thirteenth Amendment would occur.

#### *ii. Issues of Proper Remedy*

Even if a court enforces a copyright exclusive right of a tattoo copyright owner against a tattooed individual’s use of the tattoo in the animated likeness, there would be a complicated issue of resolving the proper remedy. The Copyright act specifies that an infringer is liable for either “the copyright owner’s actual damages and any additional profits of the infringer”<sup>240</sup> or statutory damages.<sup>241</sup>

Actual damages could include lost profits or lost royalties.<sup>242</sup> In a case involving tattoos, however, it would be difficult for the plaintiff to prove substantial lost profits or substantial lost royalties that are attributable to the infringement. For example, it would be difficult to determine how much lost revenue a tattoo artist suffered due to an individual with their tattoo design appeared in a cartoon show.

Alternatively, a plaintiff could ask to recover an award of the defendant’s profits. “In establishing the infringer’s profits, the copyright owner is required to present proof only of the infringer’s gross revenue,” while the infringer is “required to

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<sup>235</sup> U.S. CONST. amend. XIII, § 1.

<sup>236</sup> Bloom, *supra* note 229, at 440.

<sup>237</sup> United States v. Kozminski, 487 U.S. 931, 942 (1988) (“While the general spirit of the phrase ‘involuntary servitude’ is easily comprehended, the exact range of conditions it prohibits is harder to define.”).

<sup>238</sup> *Id.* at 944.

<sup>239</sup> Bloom, *supra* note 229, at 441.

<sup>240</sup> 17 U.S.C. § 504(a)(1).

<sup>241</sup> 17 U.S.C. § 504(a)(2).

<sup>242</sup> See *Davis*, 246 F.3d at 164–67 (providing an in-depth analysis of the meaning of the term actual damages within Section 504(a) and (b) of the Copyright Act).

prove his or her deductible expenses and the elements of profit” that are not attributable to the copyrighted work.<sup>243</sup> In order to recover any or all of the defendant’s profits, the plaintiff must prove some reasonable nexus between those profits and the act of infringement.<sup>244</sup>

Since actual damages would be practicably impossible to calculate, statutory damages would be the most desirable remedy from the standpoint of the copyright owner. The copyright owner:

may elect, at any time before final judgment is rendered, to recover . . . an award of statutory damages for all infringements involved in the action, with respect to any one work . . . in a sum of not less than \$750 or more than \$30,000 as the court considers just[.]<sup>245</sup>

These statutory damages could increase “to a sum of not more than \$150,000” for cases of willful infringement or decrease “to a sum of not less than \$200” for cases of innocent infringement.<sup>246</sup> In order to properly request statutory damages, a copyright owner must register their copyright in a timely manner. Statutory damages are available to any claimant that has received copyright registration before an infringement occurs, or, for infringements after the first publication of the work, registration must be “made within three months after the first publication of the work.”<sup>247</sup>

Statutory damages are problematic for two reasons. First, it is not a common practice for tattoo artists to register their tattoo designs. As a result, statutory damages are often not available in cases involving tattoos. Second, the amount of statutory damages could result in excessive liability for tattooed individuals—especially those with multiple tattoos. For example, a person with four tattoos licenses their image and likeness to appear in a comic book. Since all four tattoos are shown, four separate copyrighted works could potentially be infringing. Six infringing works would result in a *minimum* statutory damage award of \$3,000 (\$750 x 4) and potentially a maximum statutory damage award of \$600,000 (\$150,000 x 4) if the infringement is determined to be willful. The potential damages balloon for individuals with multiple small tattoos, since each tattoo is a separate copyrighted work, and the damage amount appears more unjust the less commercial the secondary work becomes.<sup>248</sup>

Besides actual or statutory damages, another possible relief would be injunctive relief. The Copyright Act states “the court may order the destruction or other reasonable disposition of all copies or phonorecords found to have been made or

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<sup>243</sup> 17 U.S.C. § 504(b).

<sup>244</sup> See *Mackie v. Rieser*, 296 F.3d 909, 914–16 (9th Cir. 2002) (reasoning that there must be a demonstration of a tangible nexus between infringing use and revenues to prevail on a claim for profits); *Davis*, 246 F.3d at 159–61 (holding that the party must show a causal connection between the infringement and the infringer’s profits to claim entitlement of the profits).

<sup>245</sup> 17 U.S.C. § 504(c)(1).

<sup>246</sup> 17 U.S.C. § 504(c)(2).

<sup>247</sup> 17 U.S.C. § 412.

<sup>248</sup> For example, an individual commissions an oil painting of herself to hang in her home.

used in violation of the copyright owner's exclusive rights."<sup>249</sup> Destruction of the work could be highly problematic. It would not be in the interest of justice for a court to order the *removal* of a tattoo from a tattooed individual's body. It would also be against an individual's autonomy to have a court order an injunction against the dissemination of a tattooed individual's animated likeness and image. The Supreme Court has already held the injunctive relief is discretionary in copyright cases,<sup>250</sup> although "it has provided little guidance as to when courts should exercise their discretion *not* to award injunctive relief."<sup>251</sup> Limiting the dissemination of an animated likeness of a tattooed individual has an autonomy cost on the tattooed individual, which would most likely lead courts to determine that injunction relief would be inappropriate.

Any possible remedy would either be 1) impactable to calculate, 2) lead to unjust statutory damage amounts, or 3) denied by a court in their discretion to avoid questions of bodily autonomy. Therefore, to avoid the issue of proper remedy, public policy also favors finding all animated likenesses of tattooed individuals to be non-infringing works, either by implied licenses or fair use.

### *iii. Issues with Alternative Solution*

Some have suggested a "simpler" solution to the issue of reproducing tattooed individuals' likenesses: these individuals should contract with the tattoo artist for explicit licenses to allow reproduction in their animated images. In professional sports, player unions, who license the athletes' likenesses to video game publishers, and sports agents have begun to advise athletes to contract licensing agreements with their tattoo artists before getting tattooed.<sup>252</sup> The rationale is that a tattoo artist would not turn down a famous athlete or movie star with these conditions because the opportunity to market their work on someone of notoriety outweighs any interest in withholding a licensing agreement.<sup>253</sup> The first issue is that this solution assumes that tattoo artists would always accept these terms, and not hold out for further compensation depending on the level of notoriety of the individual. The second issue is the solution is very limited, since it only helps those who get tattoos after they have become famous professional athletes or celebrities whose image and likeness may be recreated. This solution provides no relief to non-famous individuals who may potentially gain notoriety and license their likeness and image in the future.

Anyone over the age of 18 is considered an adult and can get a tattoo, and

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<sup>249</sup> 17 U.S.C. § 503(b).

<sup>250</sup> See *New York Times Co. v. Tasini*, 533 U.S. 483, 505 (2001) (holding that injunctive relief did not have to be issued for the case at issue); *Campbell*, 510 U.S. at 578 n.10 (discussing that injunctive relief is only granted in situations where the court deems it is reasonable, as a means to respect the doctrine of fair use).

<sup>251</sup> Thomas F. Cotter & Angela M. Mirabole, *Written on the Body: Intellectual Property Rights in Tattoos, Makeup, and Other Body Art*, 10 UCLA ENT. L.R. 97, 120 (2003).

<sup>252</sup> Bailey, *supra* note 171.

<sup>253</sup> *Id.*

many states allow minors under the age of 18 to get a tattoo with parental consent.<sup>254</sup> As a result, many individuals are able to get tattoos while still in high school or college, well before they have a certainty of being a professional athlete, famous movie star, model, or other influential person with a profitable image. As a result, there are still problems for individuals who were tattooed before becoming famous or influential. First, since they may not foresee a future as a professional athlete, movie star, model, or public figure (and most certainly do not consider the copyright repercussions of licensing their image in the future if they have tattoos), these individuals will not have the foresight to contract future licensing agreements with their tattoo artists.

Second, the tattoo artists would have less incentive to agree to these conditions when they are proposed by a non-famous individual. For example, a high school or collegiate athlete would have no negotiating leverage to dictate terms to a copyright licensing contract to a tattoo artist, since the high school or collegiate athlete does not provide the same type of marketability for the tattoo artist's work as a professional athlete's marketability.<sup>255</sup> The tattoo artist would be in no position to feel compelled to accept a legal contract limiting their rights, since they are receiving no consideration in return.<sup>256</sup>

Finally, it is difficult for individuals to retroactively find the tattoo artists responsible for their tattoos to get permission to reproduce the tattoos in potential secondary works. The fact that many tattoo artists are considered independent contractors and own their individual tattoo art designs means that the individual would have to find the specific artist and not just the tattoo parlor where they had their tattoo completed.<sup>257</sup> This increases the cost since many tattoo artists move around tattoo parlors, and it may be impossible for an individual to track down the specific artist that tattooed them several years in the past, assuming the individual even remembers who was the tattoo artist. This would need to be done tattoo by tattoo, increasing the time and costs for individuals with multiple tattoos by multiple tattoo artists.

For these reasons, contracting between individuals and tattoo artists on an individual, case-by-case basis is both costly and impracticable. This furthers the need for there to be a defense for tattooed individuals' images to be reproduced. The alternative would be that individuals with tattoos could not license their life-like images to any digital or animated recreation of their likenesses including cartoon shows, comics, video games, and other pictorial and audiovisual works.

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<sup>254</sup> *Tattooing and Body Piercing; State Laws, Statutes and Regulations*, NATIONAL CONFERENCE OF STATE LEGISLATURES (Aug. 31, 2018), <http://www.ncsl.org/research/health/tattooing-and-body-piercing.aspx>.

<sup>255</sup> Also, it is important to note that these types of agreements may violate NCAA amateurism rules that control an athlete's eligibility during college. See generally NCAA Bylaw 12.5.1.1(h), <https://web3.ncaa.org/lstdbi/reports/getReport/90008>.

<sup>256</sup> Unless the individual client offers monetary compensation for the copyright license.

<sup>257</sup> Rittie, *supra* note 150.

#### IV. Conclusion

The District Court for the Southern District of New York provided a baseline ruling regarding copyright infringement claims involving the reproduction of tattoos on an individual's animated likeness when they decided *Solid Oak Sketches*, but the decision did not go far enough in clarifying the uncertainties surrounding the legal implications of animating a tattooed individual's likeness. By focusing heavily on the small size and infrequency the tattoos were shown in the video game, the district court avoided addressing the crucial issue: whether an individual reproduce their tattooed likeness in animated or digital form.

As a public policy matter, a person should have the freedom to license and reuse their image for commercial gain or other creative pursuits. A tattooed individual should have the same right of publicity and right to exploit their image and likeness as an individual without tattoos. An individual's tattoos should not act as figurative copyright shackles, preventing that individual from having their likeness and image limited in ways that non-tattooed individual's likeness and image are not limited. Tattooed individuals should not be subject to unjustly high statutory damages for reproducing their likeness in animated form, nor should they lose their tattoos be ground for injunctions that would be a detriment to their autonomy. Tattooed individuals should also not have to turn to costly and impactable alternatives that force them to individually contract with tattoo artists, many of whom the tattooed individual would not be able to locate or with whom the tattooed individual would not have any remotely similar bargaining power.

There are several legal solutions a court can utilize to ensure the just outcome that tattoo individuals can reproduce their image and likeness in animated form. First, an analysis of whether the tattooed individual is the actual sole author of their tattoo would allow the individual to hold the exclusive copyright interests to copy, reproduce, and display their tattooed animated likeness without any potential for meritorious third-party copyright infringement claims against them.

Second, if a third-party has an authorship, and thus ownership, stake in the copyright of the tattoo, an individual with tattoos can rely on one of two copyright infringement affirmative defenses: (1) that the tattooed individual received an implied license from the copyright owner (usually the tattoo artist) to reproduce, distribute, and display the image of the tattoo with their real and animated likeness; and (2) that a potential defendant's animated reproduction of a tattooed individual's likeness, either realistically or stylized, constitutes a fair use.

A tattooed individual has received an implied license from the copyright owner because the tattoo artist has created the work at the individual's request, delivered the work to the individual by tattooing it onto their body, and the tattoo artist fully intends for that person to use the tattoo as part of the likeness and image, even if the likeness is reproduced digitally or through animation since the tattoo is never "disconnected" from the individual's body. The secondary use of the tattoo on the animated likeness of the tattooed individual also constitutes a fair use due to the highly transformative purpose and character of the use and the non-existent impact the



secondary work has on the market for the original tattoo work.

Finally, finding that an individual cannot reproduce their animated likeness accurately to include their tattoos without prior permission from the tattoos copyright owner would be against the legal understanding of an individual's right of publicity and bodily autonomy, as well as contrary to public policy.

Future courts have many different legal avenues to use when faced with the question of whether an animated likeness of a tattooed individual infringes upon the tattoo's copyright, but the answer should always remain the same. No matter how much of the tattoo is copied and reproduced and no matter the size of the tattoo in the secondary work, an owner of a copyright in a tattoo cannot prevent a tattooed individual from exploiting their tattooed image in reality or in animated form, nor are they entitled to royalties from the profits of the tattooed individual's animated image or likeness.