

IMPLIED IN INK?: HOW TATTOO ARTISTS CAN CLAIM AND PROTECT THEIR COPYRIGHTS  
AGAINST AN IMPLIED LICENSE DEFENSE

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**INTRODUCTION**

Tattoos, an artistic expression that used to be regarded as taboo, have become increasingly popular and widely accepted in today's society.<sup>1</sup> Once reserved for prison inmates, military personnel, and gang members, tattoos now appear on a multitude of people including athletes, actors, and celebrity tattoo artists.<sup>2</sup> Now that celebrities receive tattoos and prominently display them, often in commercial endeavors, courts are being pressured to delineate the rights that a tattoo artist can assert based on their copyrighted tattoos and the rights of the person who receives the tattoo.<sup>3</sup> No court has rendered a decision on the merits that expressly states the bounds of copyright enforcement for tattoo art.<sup>4</sup>

Pending before the United States District Court for the Southern District of New York is *Solid Oak Sketches, LLC v. 2K Games, Inc.* (hereinafter "*Solid Oak*") a case

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<sup>1</sup> See, e.g., *Millennials: Confident. Connected. Open to Change Executive Summary*, PEW RESEARCH CTR., (Feb. 24, 2010),

<sup>2</sup> See *How Tattoos Went From Subculture to Pop Culture*, THE HUFFINGTON POST BLOG, [http://www.huffingtonpost.com/mik-thobocarlsen/how-tattoos-went-from-sub\\_b\\_6053588.html](http://www.huffingtonpost.com/mik-thobocarlsen/how-tattoos-went-from-sub_b_6053588.html) (last updated Dec. 27, 2014) (explaining how the launch of the television series *Miami Ink* led society to see tattoos as art which helped eliminate the prejudice surrounding tattoos. Additionally, as tattoo artists became celebrities, pop culture celebrities also began to receive and reveal their tattoos).

<sup>3</sup> See Complaint for Copyright Infringement at 5-9, *Solid Oak Sketches, LLC v. Visual Concepts, LLC*, No. 1:16-cv-00724, 2016 WL 445124, (S.D.N.Y. Feb 1, 2016) (*Solid Oak* which owns a license for artwork created by the tattoo artist is suing for copyright infringement based on the portrayal of that art in the NBA 2K16 video game).

<sup>4</sup> Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 29 J. INTELL. PROP. L. 29, 30 (2014).

centered on copyright protections afforded to tattoo artwork.<sup>5</sup> The plaintiff in *Solid Oak* has entered into license agreements with several tattoo artists and has alleged copyright infringement based on the reproduction of those tattoos in a video game series.<sup>6</sup> Solid Oak Sketches alleges explicitly that tattoos are the proper subjects of copyright protection and that the license agreement they entered into with the original artists gave them copyright ownership of the tattoos.<sup>7</sup> Four of the tattoos Solid Oak Sketches claims ownership of appear on the famous basketball player LeBron James, and one appears on the equally if not more famous player, Kobe Bryant.<sup>8</sup> To be clear, Solid Oak Sketches has registered the eight tattoos in question that appear on five different NBA players.<sup>9</sup> The Court granted the defendants' 12(b)(6) motion to dismiss Solid Oak Sketches' claim for statutory damages and attorney's fees.<sup>10</sup> The Court scheduled the pretrial conference for the remaining copyright infringement dispute to commence on November 4, 2016.<sup>11</sup>

The result of *Solid Oak* may answer questions that were raised, but never resolved, by previous copyright infringement suits based on tattoo art that have settled

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<sup>5</sup> Complaint for Copyright Infringement at 5-9, *Solid Oak Sketches, LLC v. Visual Concepts, LLC*, No. 1:16-cv-00724, 2016 WL 445124, (S.D.N.Y. Feb. 1, 2016).

<sup>6</sup> *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16CV724-LTS, 2016 WL 4126543, at \*1 (S.D.N.Y. Aug. 2, 2016).

<sup>7</sup> Complaint for Copyright Infringement at 1, *Solid Oak Sketches, LLC v. Visual Concepts, LLC*, No. 1:16-cv-00724, 2016 WL 445124, (S.D.N.Y. Feb. 1, 2016).

<sup>8</sup> Complaint for Copyright Infringement at 13, *Solid Oak Sketches, LLC v. Visual Concepts, LLC*, No. 1:16-cv-00724, 2016 WL 445124, (S.D.N.Y. Feb. 1, 2016).

<sup>9</sup> *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16CV724-LTS, 2016 WL 4126543, at \*2 (S.D.N.Y. Aug. 2, 2016) (“In the instant case, Defendants’ infringement of the tattoo designs began with the release of NBA 2K14 in 2013 and Plaintiff did not register the tattoo designs with the U.S. Copyright Office until 2015.”).

<sup>10</sup> *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16CV724-LTS, 2016 WL 4126543, at \*4 (S.D.N.Y. Aug. 2, 2016).

<sup>11</sup> *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16CV724-LTS, 2016 WL 4126543, at \*4 (S.D.N.Y. Aug. 2, 2016).

out of court.<sup>12</sup> First and foremost the Court will have to address the relatively straightforward inquiry of whether or not tattoos are subject to copyright protection?<sup>13</sup> The answer is likely yes, the tattoos are registered, they meet the statutory requirements of a copyright, and several scholars agree tattoos are the proper subject of copyright protection.<sup>14</sup> The Court will then have to decide what rights are conferred to the copyright owner and how they may be enforced.<sup>15</sup>

This article will explain how tattoo artists can put themselves in the best position to protect their upcoming substantive rights against an implied license defense. Due to the unique nature of a tattoo transaction, an implied license is a likely mechanism courts could employ to mitigate the control a tattoo artist may assert. Protecting their copyrighted art is especially important for tattoo artists with celebrity clients, therefore

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<sup>12</sup> See, e.g., Verified Complaint for Injunctive and Other Relief at 2-7, *Whitmill v. Warner Bros. Entertainment Inc.*, No. 4:11-cv-752, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011) (tattoo artist who created a tattoo that was fixed onto celebrity Mike Tyson sued Warner Brothers for copyright infringement based on their unauthorized use, reproduction, and creation of a derivative worked identical to his original tattoo art in a movie); Complaint for Copyright Infringement and Accounting and Other Relief at 3-8, *Allen v. Electronics Arts, Inc.*, No. 5:12-V-3172, 2012 WL 6852208 (W.D. La. Dec. 31, 2012) (where tattoo artist sued Electronic Arts for copyright infringement for using his artwork that was tattooed on Ricky Williams on the cover of and in its video games, he also sued Ricky Williams himself for contributory copyright infringement).

<sup>13</sup> See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) (in order to establish copyright infringement the plaintiff must first prove ownership of a valid copyright).

<sup>14</sup> *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16CV724-LTS, 2016 WL 4126543, at \*2 (S.D.N.Y. Aug. 2, 2016); See, e.g., Hearing on Motion for Preliminary Injunction at 3, *Whitmill v. Warner Bros. Entertainment Inc.*, No. 4:11-cv-752, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011) (Judge Perry states “[i]f I look at the likelihood of success on the merits I think plaintiff has a strong likelihood of prevailing on the merits for copyright infringement. Most of defendant’s arguments against this are just silly. Of course tattoos can be copyrighted.”).

<sup>15</sup> Yolanda M. King, *Tattoo Copyrights May Finally Get Their Day in Court*, LAW 360 (Apr. 28, 2016, 10:39 AM), <http://www.law360.com/articles/788694/tattoo-copyrights-may-finally-get-their-day-in-court>.

artists should begin incorporating into their daily routine practices that afford them the most legal protection.

Part I of this article will give a brief overview of what types of work qualify for copyright protections based on the Copyright Act and why it is likely *Solid Oak* will result in clear rights for tattoo artists. Part I will also explain the previous cases that have come before the court regarding copyrights and tattoos and how those cases have set the stage for the *Solid Oak* decision. Part II will discuss why and how a tattoo artist should clearly assert sole ownership of their artwork in order to be in the best position to claim and enforce their copyrights. Part III will discuss why an implied license is a potential tool the courts could use when deciding these delicate cases. Part III will also explain how artists can best combat the implied license affirmative defense that defendants will likely invoke to avoid liability.

## **I. Background**

### *A. What Works Qualify for Federal Copyright Protection*

In order to succeed on a claim for copyright infringement a plaintiff must have ownership of a valid copyright and prove the infringing party copied original elements of the copyrighted work.<sup>16</sup> A valid copyright is defined as “original works of authorship fixed in any tangible medium of expression”<sup>17</sup> Therefore, for a work to be eligible for federal copyright protection it must be original, a work of authorship, and fixed in a tangible medium.<sup>18</sup> The Copyright Act enumerates eight categories of creations that

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<sup>16</sup> Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991).

<sup>17</sup> 17 U.S.C. §102(a).

<sup>18</sup> LISA M. TITTEMORE & JOEL R. LEEMAN, PROTECTING AND ENFORCING COPYRIGHT at 1-2 to 1-8 (MCLE, Inc., 4th ed. 2014).

qualify as works of authorship.<sup>19</sup> The fifth category, pictorial, graphic, and sculptural works is where tattoos would be categorized.<sup>20</sup> Pictorial, graphic, and sculptural works are defined in the statute as “two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.”<sup>21</sup>

The originality requirement is a fairly low standard, requiring only that the author make the selection or arrangement independently and that the product shows a minimal level of creativity.<sup>22</sup> The author is not required to show a great inventive leap in their work, but rather creativity is established when there is a “minimal spark of distinctiveness” identified in the copyrightable expression.<sup>23</sup> Fixation occurs when a copy of the work, 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>24</sup> Thus, it is likely that tattoos, which are two-dimensional works of art, require creativity by the tattoo artist, and are permanently fixed onto human skin meet all the requirements of a copyrightable work.<sup>25</sup>

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<sup>19</sup> See 17 U.S.C. §102(a) (works of authorship include: literary works, musical works, dramatic works, pantomimes and choreographic works, pictorial, graphic, and sculptural works, motion pictures and other audiovisual works, sound recordings, and architectural works).

<sup>20</sup> 17 U.S.C. §102(a)(5).

<sup>21</sup> 17 U.S.C. §101.

<sup>22</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358 (1991).

<sup>23</sup> 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* §2.01[B] (2012).

<sup>24</sup> 17 U.S.C. §101; See, e.g., David M. Cummings, Note, *Creative Expression and the Human Canvas: An Examination of Tattoos as a Copyrightable Art Form*, 2013 ILL. L. REV. ONLINE 279, 289 (2013) (stating an ice sculpture, a computer hard drive, and icing on a cake are all considered fixed expressions within the act).

<sup>25</sup> See, e.g., Brayndi L. Grassi, *Copyrighting Tattoos: Artist vs. Client in the Battle of the (Waiver) Forms*, 42 WM. MITCHELL L. REV. 43, 49 (2016) (stating “the biggest argument

The owner of a valid copyright has exclusive rights that they may exercise as the owner and rights they may authorize others to exercise with their permission.<sup>26</sup> Those rights include the right to reproduce the copyrighted work, prepare derivative works based on the copyrighted work, and in the case of “literary, musical, dramatic, and choreographic works, pantomimes and pictorial, graphic, or sculptural works including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.”<sup>27</sup>

Copyright infringement occurs when the exclusive rights enumerated in Section 106 of the Copyright Act are violated by another party, such as reproducing copyrighted work without permission from the copyright owner.<sup>28</sup> Contributory copyright infringement occurs when a third party intentionally induces or encourages direct infringement.<sup>29</sup> A plaintiff alleging contributory copyright infringement must show that the defendant had knowledge of the infringing activity and using that knowledge caused, induced, or materially contributed to another party’s infringing conduct.<sup>30</sup>

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in support of copyright in tattoos is that a tattoo meets all of the requirements of the basic definition of a work that is copyrightable.”).

<sup>26</sup> 17 U.S.C. §106.

<sup>27</sup> 17 U.S.C. §106.

<sup>28</sup> 17 U.S.C. §501; *See, e.g.,* Central Point Software, Inc. v. Nugent, 903 F. Supp. 1057, 1059 (E.D. Tex. 1995) (holding that a *prima facie* case for copyright infringement is established when plaintiff shows ownership of copyrightable material and that the defendant copied the material, in this case software is copyrightable and copying is established by showing the software has been reproduced onto another computer’s memory without permission of the owner).

<sup>29</sup> United States v. Am. Soc’y of Composers (In re Cellco P’ship), 663 F. Supp. 2d 363, 370 (S.D.N.Y. 2009).

<sup>30</sup> BWP Media USA Inc. v. Hollywood Fan Sites, LLC, 69 F. Supp. 3d 342, 356 (S.D.N.Y. 2014).

B. *History of Copyright Infringement Claims based on Tattoos*

The first claim of copyright infringement based on tattoo art occurred in *Reed v. Nike, Inc.*<sup>31</sup> Mr. Reed tattooed Rasheed Wallace, a famous basketball player, and sued Nike for copyright infringement when the tattoo was featured in a Nike advertisement.<sup>32</sup> He also sued Mr. Wallace for contributory copyright infringement.<sup>33</sup> From then on there have been a handful of cases involving copyright infringement based on tattoo art.<sup>34</sup> For example, a tattoo artist sued THX Incorporated for reproducing a digital image of a tattoo without authorization.<sup>35</sup> The tattoo was originally fixed on the famous UFC fighter Carlos Condit and THX reproduced the art on Mr. Condit's character in a video game.<sup>36</sup>

Another case arose based on the reproduction of a tattoo on a character featured in advertisements for the movie *The Hangover Part II*.<sup>37</sup> The artist tattooed the design on celebrity Mike Tyson's face and registered the copyright.<sup>38</sup> The artist sued for copyright infringement upon seeing his exact design on an advertisement for the upcoming movie

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<sup>31</sup> Complaint at 4, *Reed v. Nike, Inc.*, Case No. CV 05 198, 2005 WL 1182840, (D. Or. Feb. 10, 2005)

<sup>32</sup> Complaint at 4, *Reed v. Nike, Inc.*, Case No. CV 05 198, 2005 WL 1182840, (D. Or. Feb. 10, 2005).

<sup>33</sup> Complaint at 5, *Reed v. Nike, Inc.*, Case No. CV 05 198, 2005 WL 1182840, (D. Or. Feb. 10, 2005).

<sup>34</sup> Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 22 J. INTELL. PROP. L. 29, 30 (2014).

<sup>35</sup> Complaint at 5-6, *Escobedo v. THQ Inc.*, No. 2:12CV02470, 2012 WL 5815742 (D. Ariz. Nov. 16, 2012).

<sup>36</sup> Complaint at 2-4, *Escobedo v. THQ Inc.*, No. 2:12CV02470, 2012 WL 5815742 (D. Ariz. Nov. 16, 2012).

<sup>37</sup> Plaintiff's Memorandum in Support of His Motion for Preliminary Injunction at 1, *Whitmill v. Warner Bros. Entertainment Inc.*, No. 4:11-cv-752, 2011 WL 12893042 (E.D. Mo. Apr. 28, 2011).

<sup>38</sup> Plaintiff's Memorandum in Support of His Motion for Preliminary Injunction at 5, *Whitmill v. Warner Bros. Entertainment Inc.*, No. 4:11-cv-752, 2011 WL 12893042 (E.D. Mo. Apr. 28, 2011).

and inferred the design would be featured in the movie.<sup>39</sup> The two parties settled and dismissed the case before a decision could be rendered.<sup>40</sup> *Solid Oak* is similar to these cases but the plaintiff is not the artist, rather the plaintiff is a company with an exclusive license to the copyrighted tattoos.<sup>41</sup> Solid Oak Sketches originally sued three separate parties, they voluntarily dismissed their case against Visual Concepts, LLC, which leaves 2K Games Inc. and Take-Two Interactive Software, Inc. as the defendants.<sup>42</sup>

## **II. Tattoo Artists Should Try to Establish Complete Ownership of the Copyrighted Tattoos**

### *A. Avoiding Joint Authorship Claims*

The first hurdle that tattoo artists need to overcome to successfully protect their intellectual property vested in tattoo art is establishing ownership of the copyright.<sup>43</sup> To be clear, courts have decided that tattoo designs that are fixed in a book of other designs may be copyrighted.<sup>44</sup> They have also held infringement occurs in those cases when someone who does not own the book uses the designs.<sup>45</sup> There are companies that are in the business of creating tattoo designs, fixing them onto paper, copyrighting them, and then selling the designs to tattoo parlors.<sup>46</sup> These pre-printed designs are referred to as a

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<sup>39</sup> Verified Complaint for Injunctive and Other Relief at 4-7, *Whitmill v. Warner Bros. Entertainment Inc.*, No. 4:11-cv-752, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011).

<sup>40</sup> Order of Dismissal at 1, *Whitmill v. Warner Bros. Entertainment Inc.*, No. 4:11-cv-752 CDP, 2011 WL 1170653 (E.D. Mo. Jun. 22, 2011).

<sup>41</sup> Matthew W. Parker, *That Old Familiar Sting: Tattoos, Publicity, and Copyright*, 15 J. MARSHALL REV. INTELL. PROP. L. 761, 769 (2016).

<sup>42</sup> *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16CV724-LTS, 2016 WL 4126543, at \*1 (S.D.N.Y. Aug. 2, 2016).

<sup>43</sup> See 17 U.S.C. § 106 (the *owner* of the copyright is given the exclusive rights of the copyright).

<sup>44</sup> See *Tattoo Art, Inc. v. TAT Int'l, LLC* 711 F. Supp. 645, 647-648 (E.D. Va. 2010).

<sup>45</sup> *Tattoo Art, Inc. v. TAT Int'l, LLC* 711 F. Supp. 645, 647-648 (E.D. Va. 2010).

<sup>46</sup> *Tattoo Art, Inc. v. TAT Int'l, LLC* 711 F. Supp. 645, 647 (E.D. Va. 2010).

flash tattoos.<sup>47</sup> The difference between flash tattoo litigation and the issues arising in *Solid Oak* is the infringement with flash tattoos occurs when someone copies the printed design and tattoos it on another person. *Solid Oak* and other similar cases, concern infringement when a design that is already tattooed is reproduced in a digital medium, or on a character in a movie, or in an advertisement.

In regards to ownership, tattoo artists are in the strongest position to assert their exclusive rights if they are the sole owner of the copyright.<sup>48</sup> The strongest way to establish sole ownership is through an explicit written agreement.<sup>49</sup> Tattoo artists seeking to enforce their rights are advised to execute a document with the recipient of the tattoo stating explicitly that they (the artist) are the sole author of the design, and therefore the sole owner of the copyright, and possess exclusive rights to reproduce or display the design.<sup>50</sup> Without an official agreement the artist is more vulnerable to claims that the design was created through joint authorship or that it was a work for hire and belongs to the employer of the artist.<sup>51</sup>

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<sup>47</sup> *Owens v. Ink Wizard Tattoos*, 533 S.E.2d 722, 723 n.1 (Ga. 2000).

<sup>48</sup> Timothy C. Bradley, *The Copyright Implications of Tattoos: Why Getting Inked Can Get you Into Court*, 29 ENT. & SPORTS LAW. 1, 29 (2011) (explaining that copyright law affords owners of copyrights a “bundle of rights” that on the face of the statute with tattoos would allow the owner substantial control over the design as the only owner, however there are some rights the recipient must be given due to the nature of tattoos).

<sup>49</sup> See Mary LaFrance, *Authorship, Dominance, and the Captive Collaborator: Preserving the Rights of Joint Authors*, 50 EMORY L.J. 193, 247 (2001) (articulating that the best manifestation of intent is a contract that explicitly states if the work is one of joint authorship or not one of joint authorship).

<sup>50</sup> See Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 29 J. INTELL. PROP. L. 29, 30 (2014) (explaining that signed tattoo copyright ownership agreements are rare but can serve to clear up ambiguity of ownership upon enforcement of rights).

<sup>51</sup> Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 29 J. INTELL. PROP. L. 29, 37-43 (2014).

A work of joint authorship 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>52</sup> Intent is a key element in asserting joint authorship and therefore joint ownership; the definition in the statute reflects a venture where partners are working together towards the creation of a preconcerted design.<sup>53</sup> Joint authorship does not exist if there is no preconcerted design.<sup>54</sup> The consequence of joint ownership is that the joint author, in this case the recipient of the tattoo, would be able to grant licenses to third parties to use the artwork despite the protest of the other joint author.<sup>55</sup> This could be a devastating consequence if the celebrity is able to grant major corporations the right to display the tattoo without any compensation for the artist.<sup>56</sup> Thus, in order to ensure sole ownership over the tattoo copyright and control over how it is used, the artist should make it clear that any input given by the recipient does not constitute joint authorship and the artwork is intended to be designed, created, and completed by the tattoo artist alone.<sup>57</sup>

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<sup>52</sup> 17 U.S.C. §101.

<sup>53</sup> 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §6.03 (2012).

<sup>54</sup> 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §6.03 (2012).

<sup>55</sup> 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §6.10 (2012).

<sup>56</sup> See, e.g., Complaint at 4, Reed v. Nike, Inc., Case No. CV 05 198, 2005 WL 1182840, (D. Or. Feb. 10, 2005) (where Mr. Wallace agreed to have his tattoo featured as part of an advertising campaign for Nike without the consent of the tattoo artist).

<sup>57</sup> See, e.g., Gilliam v. ABC, 538 F.2d 14, 22 (2d Cir. 1976) (holding that the joint work theory is inequitable unless at the time of creation by the first author the second author’s contribution is envisioned and intended to be merged into a single work, additionally a contract stating one author has a superior interest has been held to invalidate a claim of joint authorship); Artist may also try to argue that any contribution by the recipient was *De Minimis*, a contribution so minor that the recipient did not add enough quantitatively or qualitatively to be considered a joint author. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §6.07 (2012) (explaining that it is not necessary that the respective contributions of all authors be equal but joint authors must contribute enough

B. *The Work for Hire Hurdle*

There are two ways a work can be considered a work for hire: “it is prepared by an employee within the scope of employment” or it is “specially ordered or commissioned”.<sup>58</sup> The two sections are differentiated by who creates the work, employees clearly fall into the first category and independent contractors or freelance creators fall into the second category.<sup>59</sup> It is not likely that a tattoo could be considered a commissioned work, which leaves the artist vulnerable only to a claim that their art is a work for hire that was prepared by an employee within the scope of employment.<sup>60</sup>

The United States Supreme Court has established several factors that indicate if a work was created by an employee as a work for hire: the hiring party’s control over the manner and means by which the product is created, skill required, source of instrumentalities and tools, location of the work, duration of relationship between the parties, may the hiring party assign additional projects to the hired party, party’s discretion over when and how long to work, payment, 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.<sup>61</sup> The tattoo parlor owner may have a claim that they own the copyrighted tattoo, arguing that they provided the tools to create and fix the tattoo, they

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to actually be considered a joint author, for example in written work it must be more than a line or a word).

<sup>58</sup> 17 USC §101.

<sup>59</sup> LISA M. TITTEMORE & JOEL R. LEEMAN, *PROTECTING AND ENFORCING COPYRIGHT* at 1-26 (MCLE, Inc., 4th ed. 2014).

<sup>60</sup> *See* 17 USC §101 (where a work made for hire is defined as either work prepared by an employee within the scope of employment or work that is specially commissioned, specially commissioned is defined as: a work for a contribution to a collective work, part of a motion picture or other audiovisual work, a translation, supplementary work, instructional text, a test, answers material to a test, or an atlas).

<sup>61</sup> *Cnty. For Creative Non-Violence v. Reid*, 490 U.S. 730, 751-752 (1989).

have discretion over the schedule of when and how long the artist works, it is part of the regular business of the tattoo parlor, they may assign different clients with additional projects to the artist, and the work is created on the parlor owner's premises.

The artist would likely counter that a parlor owner does not supervise closely enough for the art to be considered a work for hire, that the creative process is limited to the artist's work on the recipient, and the immense level of skill required to create the art is vested in the artist not the employer.<sup>62</sup> The tattoo artist however is free to put in writing that they own the copyright for all the art they create for clients.<sup>63</sup> Such an agreement will eliminate any argument the employer could make that they own the copyrighted works.<sup>64</sup> A written agreement between a tattoo artist and his employer, as well as a written agreement between a tattoo artist and his client, will best serve him in establishing that he, the artist, is the sole author and owner of the copyright.<sup>65</sup> This will put him in the best position to enforce his rights in future litigation, this is especially important when

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<sup>62</sup> Cf. *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548, 553 (2d Cir. 1984) (holding that the sculpture created was created within the scope of employment which gave the employer the copyright because employer made several suggestions, supervised the creative process closely, and gave instructions that were more than a general idea but rather specific directions during the crafting of the sculpture).

<sup>63</sup> Joseph E. Edwards, Annotation, *Application of "Works for Hire" Doctrine under Federal Copyright Act (17 U.S.C.A. §1 et seq.)*, 11 A.L.R. Fed. 457 (1972)

<sup>64</sup> Joseph E. Edwards, Annotation, *Application of "Works for Hire" Doctrine under Federal Copyright Act (17 U.S.C.A. §1 et seq.)*, 11 A.L.R. Fed. 457 (1972) (stating that employees are not precluded from agreeing the copyright of the work will belong to the employee and in future practice employees should reduce their intentions in writing in order to avoid problems regarding ownership).

<sup>65</sup> Brayndi L. Grassi, *Copyrighting Tattoos: Artist vs. Client in the Battle of the (Waiver) Forms*, 42 WM. MITCHELL L. REV. 43, 67 (2016) (positing that going forward as tattoo litigation becomes more common the artist should endeavor to address the copyright issues and to be all inclusive the language should include the rights to the design as well as the application).

tattooing celebrities as the probability that the design will be replicated in an unauthorized manner is heightened.<sup>66</sup>

### III. Implied Licenses and Their Limitations

#### A. *Why Implied Licenses Are a Probable Solution for the Court When Deciding Tattoo Copyright Cases*

An implied license is an affirmative defense to copyright infringement and the burden is on the infringing party to show an implied license exists.<sup>67</sup> Such a license is created when three conditions are met “one party creates a work at another person’s request, delivers the work to that person, and intends that the person copy and distribute the work.”<sup>68</sup> If granted, an implied license serves as a non-exclusive license.<sup>69</sup> The law dictates that all exclusive copyright licenses must be reduced to writing.<sup>70</sup> Determining if a party has an implied license to use a copyrighted work is fact specific to each case.<sup>71</sup>

It is not difficult to imagine a successful argument by the recipient of a tattoo, claiming that they had an implied license to publicly display the work and engage in

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<sup>66</sup> Brayndi L. Grassi, *Copyrighting Tattoos: Artist vs. Client in the Battle of the Waiver* Forms, 42 WM. MITCHELL L. REV. 43, 67 (2016) (explaining that the chances of litigation are lowered if the client is not a celebrity).

<sup>67</sup> Atkins v. Fischer, 331 F.3d 988, 992 (D.C. Cir. 2003).

<sup>68</sup> Latimer v. Roaring Toyz, Inc., 601 F.3d 1224, 1235 (11th Cir. 2010).

<sup>69</sup> Effects Assocs. v. Cohen, 908 F.2d 55, 558 (9th Cir. 1990).

<sup>70</sup> See 17 USC §204(a) (“A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note of memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner’s duly authorized agent.”).

<sup>71</sup> See, e.g., 1 JAY DRATLER, JR. & STEPHEN M. MCJOHN, LICENSING OF INTELLECTUAL PROPERTY §3.04 (1994) (stating that implied licenses are fact specific, for example if a person delivers copyrighted artwork to be photographed the photographer may argue he has an implied license to photograph and publish the material because it is reasonable to infer that the artist intended his artwork to be photographed and distributed when he delivered the work to the photographer).

videos and pictures that display the tattoo.<sup>72</sup> After all, the first two factors clearly weigh in favor of an implied license, the tattoo was created at the request of the customer, it was delivered in the most permanent way possible as it was etched onto the recipient's skin. The contention is nestled in the third factor, where the recipient could claim that the artist intended by conduct to bestow an implied license to display and use the copyrighted work when he agreed to permanently mark the recipient with the copyrighted design.<sup>73</sup>

Intrinsically the value of a tattoo arises from the ability to display it, and the permanency of inking the design onto a person's skin almost guarantees it will be publicly displayed at all times, particularly when the recipient is a celebrity.<sup>74</sup> Intent to allow recipients to reproduce and display their copyrighted tattoo has been conceded by previous tattoo artists, including plaintiff Mr. Whitmill, who created Mike Tyson's face tattoo.<sup>75</sup> He allowed Mr. Tyson to reproduce the tattoo in a project where Mr. Tyson put

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<sup>72</sup> See, e.g., Timothy C. Bradley, *The Copyright Implications of Tattoos: Why Getting Inked Can Get You Into Court*, 29 ENT. & SPORTS LAW. 1, 29 (2011) (explaining that recipients of tattoos often choose where they get the tattoo in order to display it thus implicit in obtaining the tattoo is the intent to have it seen and photographed which aids the argument that the artist intended to give an implied license to the recipient's public display of the copyrighted work).

<sup>73</sup> See, e.g., *Effects Assocs. v. Cohen*, 908 F.3d 555, 558 (11th Cir. 2010) (holding that a nonexclusive implied license may be granted orally or implied by conduct).

<sup>74</sup> See Meredith Hatic, Note, *Who Owns Your Body Art? The Copyright and Constitutional Implications of Tattoos*, 23 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 396, 432 (2012) (urging the courts to find nonexclusive implied licenses for tattoo recipients because it is unreasonably and unduly burdensome to ask celebrities to cover up their skin whenever they are in public or to ask publishers of photos to modify the image each time to eliminate the tattoo in the photo).

<sup>75</sup> Scott J. Sholder, *Moving the Needle: Solid Oak Sketches, LLC v. Visual Concepts, LLC and the Copyright Quagmire of Tattoos in Video Games*, COWAN, DEBAETS, ABRAHAMS & SHEPPARD LLP (Feb. 17, 2016), <http://cdas.com/moving-the-needle-solid-oak-sketches-llc-v-visual-concepts-llc-and-the-copyright-quagmire-of-tattoos-in-video-games/> (stating that based on the culture and practices in the industry of tattoo art the expectation is that giving people permanent tattoos presumably gives them an implied license to display the tattoo during the daily course of their life for example, Mr.

the tattoo on action figures of himself.<sup>76</sup> Celebrities who receive tattoos have a strong argument that industry norms indicate tattoo artists intend to grant recipients an implied license to copy the art in photographs and on television, where they as celebrities often appear, when they agree to permanently place the art on the celebrity's body.<sup>77</sup>

It is likely that the decision in *Solid Oak* will give tattoo artists concrete copyright protections in their art.<sup>78</sup> A tattoo meets all the statutory requirements of a federal copyright and most scholars agree tattoos are copyrightable works.<sup>79</sup> This would open up the possibility for future judicial decisions to utilize the implied license doctrine to balance the rights of the artist against the rights of the recipient.<sup>80</sup> Striking a balance between protecting the artist's work and the recipient is exceptionally compelling for

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Whitmill had no problem with Tyson displaying his own tattoo in the movie but alleged infringement when Warner Brothers used the art without an implied license).

<sup>76</sup> Scott J. Sholder, *Moving the Needle: Solid Oak Sketches, LLC v. Visual Concepts, LLC and the Copyright Quagmire of Tattoos in Video Games*, COWAN, DEBAETS, ABRAHAMS & SHEPPARD LLP (Feb. 17, 2016), <http://cdas.com/moving-the-needle-solid-oak-sketches-llc-v-visual-concepts-llc-and-the-copyright-quagmire-of-tattoos-in-video-games/>.

<sup>77</sup> Inventor Paradox, *Who Owns Your Tattoo?*, INKED (Mar. 9, 2012, 12:00 AM), <http://www.inkedmag.com/articles/who-owns-your-tattoo/> (Warner Brothers and Whitmill agreed that the person being tattooed has an implied license to display the tattoo even in front of cameras without permission because there is an expectation that when you apply art to a visible part of a person's body that they will be able to display it in anyway they choose to use their own body).

<sup>78</sup> See supra notes 13-18 and accompanying text.

<sup>79</sup> See Yolanda M. King, *The Right-of-Publicity Challenges for Tattoo Copyrights*, 16 NEV. L.J. 441, 448 (2016) ("Copyright law is exclusively federal and tattoos appear to meet the requirements of copyrightability."); Thomas F. Cotter & Angela M. Mirabole, *Written on the Body: Intellectual Property Rights in Tattoos, Makeup, and Other Body Art*, 10 UCLA ENT. L. REV. 97, 103 (2003) (an original pictorial work embodied in a tattoo would appear copyrightable if fixed on a human body); *Whitmill v. Warner Bros. Entertainment Inc.*, No. 4:11-cv-752, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011) (Judge Perry states "[o]f course tattoos can be copyrighted.").

<sup>80</sup> See, e.g., Jennifer L. Commander, Note, *The Player, the Video Game, and the Tattoo Artist: Who Has the Most Skin in the Game?*, 72 WASH. & LEE L. REV. 1947, 1975 (2015) (scholars have encouraged courts to recognize implied nonexclusive licenses in tattoos as a solution).

future courts because enforcement mechanisms are intertwined with regulating a person's body.<sup>81</sup> Certainly they would not grant copyright protections to tattoos without articulating a limit for how the artist can enforce his rights against the recipient.<sup>82</sup> Therefore it is in the artist's best interest, particularly when tattooing celebrities, to anticipate the implied license defense and attempt to limit the rights of the recipient as clearly as possible.<sup>83</sup>

B. *The Tattoo Artist Should Assert Their Rights By Limiting the Scope of The Implied License*

There is no way around the first two factors in the implied license analysis but the artist may be able to articulate their intent (the third factor) in a way that limits the scope of the license and best protects their rights.<sup>84</sup> In an ideal situation, the artist could make it clear that he did not intend to license the work to the recipient or any other party and retain full rights of the work. Unfortunately, as explained previously, it is likely courts

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<sup>81</sup> See Aaron Perzanowski, *Tattoos & IP Norms*, 98 MINN. L. REV. 511, 530 (2013) (articulating the problems David Nimmer stated would occur if copyright protections were given to tattoos such as allowing the tattoo artist control over the celebrities public display of the tattoo that is on their body, however Perzanowski counters that those consequences could be alarming but the court certainly has instruments to soften that control such as an implied license).

<sup>82</sup> Future Courts would specify limits to avoid the control and fear that Mr. Nimmer exhibits. See, e.g., Declaration of David Nimmer at 7-8, *Whitmill v. Warner Bros. Entertainment Inc.*, No. 4:11-cv-752, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011) (explaining that if the Court approves copyright protections for tattoos, lawsuits will become routine in the future and he fears that it will lead to the artist being able to control the actions of recipients well into the future).

<sup>83</sup> See, e.g., *Johnson v. Jones*, 149 F.3d 494, 502 (6th Cir. 1998) (holding implied licenses of copyrighted works are limited by intent and only extend as far as the licensor intended the license to expand); *Viacom Int'l, Inc. v. Fanzine Int'l, Inc.*, 98 Civ. 7448(KMW), 2000 U.S. Dist. LEXIS 19960, at \*14-15 (S.D.N.Y. July 5, 2000) (holding that an implied license only occurs when the author fails to explain the limit of the license when the author is silent and they have knowledge of the copying, otherwise allowing someone to use a copyrighted work without expressing a limit does not create an implied license).

<sup>84</sup> See *supra* note 53-57 and accompanying text.

will use the implied license defense to keep artists from fully controlling a client's body and find that an artist's choice to give the tattoo in the first place creates an implied license for the recipient.<sup>85</sup> Operating under that premise, it is still possible for the artist to limit that license in such a way that best protects their rights and commercial value in the copyright.

The first limit the tattoo artist should be aware of is whom they intend to grant the license to, they should make it clear that the recipient of the tattoo is the only person who should be able to avail him or herself of the defense.<sup>86</sup> For example, it was clear in the *Whitmill v. Warner Bros. Entertainment, Inc.*, that Mr. Whitmill did not grant any license to Warner Brothers, a third party corporate entity, to use the copyrighted art that he fixed onto Mr. Tyson.<sup>87</sup> Judge Perry stated that "most importantly, there is no evidence at all that Warner Brothers had any kind of a license implied or otherwise to use the tattoo, and so Warner Brothers' use of the tattoo was unauthorized."<sup>88</sup> Therefore artists should explicitly state to their customers, in particular their celebrity customers, under no circumstances should any third party copy and reproduce the tattoo.

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<sup>85</sup> See Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 29 J. INTELL. PROP. L. 29, 65 (2014) (explaining that it is normal practice for tattoo artists to concede that the recipient has an implied license to display the tattoo publicly and to display it in pursuance of their livelihood).

<sup>86</sup> See Craig P. Bloom, Note, *Hangover Effect: May I see your Tattoo, Please*, 31 CARDOZO ARTS & ENT. L.J. 435, 470 (2013) (an implied license given by a tattoo artist would not allow a third party to engage in commercial or non-commercial use of the protected art).

<sup>87</sup> See Hearing on Motion for Preliminary Injunction at 4, *Whitmill v. Warner Bros. Entertainment Inc.*, No. 4:11-cv-752, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011).

<sup>88</sup> Hearing on Motion for Preliminary Injunction at 4, *Whitmill v. Warner Bros. Entertainment Inc.*, No. 4:11-cv-752, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011).

The who question becomes less clear when the copy is based on the likeness of the recipient, like in the *Solid Oak* case.<sup>89</sup> It is not likely that the tattoo artist could ever completely stop the recipient of a tattoo from licensing their likeness to a video game or stop a celebrity from personally appearing in a commercial.<sup>90</sup> However, if the artist makes it clear that the recipient's implied license extends only to their display or copying of the tattoo in their daily life, they can force third parties to pay them royalties for use of the tattoo on a digital version of the celebrity, or a digital reproduction in a commercial.<sup>91</sup> The result would be similar to a celebrity's right of publicity protections which requires a video game creator to get permission and pay for the use of a celebrity's likeness.<sup>92</sup> Thus, the artist would not be able to control the celebrity's choice to give permission for their likeness to be used in a video game, but they could force the third party to compensate them if they wish to use the digital reproduction of the tattoo in the video game.<sup>93</sup>

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<sup>89</sup> Complaint for Copyright Infringement at 13-14, *Solid Oak Sketches, LLC v. Visual Concepts, LLC*, No. 1:16-cv-00724, 2016 WL 445124, (S.D.N.Y Feb 1, 2016).

<sup>90</sup> Timothy C. Bradley, *The Copyright Implications of Tattoos: Why Getting Inked Can Get you Into Court*, 29 ENT. & SPORTS LAW. 1, 29 (2011) (stating that based on the tattoo industry and the potential problems with controlling a persons body that an implied license must necessarily include public display and limited reproduction in photographs).

<sup>91</sup> See Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 29 J. INTELL. PROP. L. 29, 67 (2014) (analyzing an implied license given to the recipient reveals that the scope of the license, especially for celebrities who are athletes would not cover commercial uses by third parties or third parties who collaborate with third parties to use the tattoo).

<sup>92</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION §46 (AM. LAW INST. 1995) (“One who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purpose of trade is subject to liability...”).

<sup>93</sup> See Craig P. Bloom, Note, *Hangover Effect: May I see your Tattoo, Please*, 31 CARDOZO ARTS & ENT. L.J. 435, 469 (2013) (explaining that the scope of an implied license for a celebrity would bar third parties from using the tattoo for profit, for example Rasheed Wallace could appear in a Nike commercial himself but Nike may not feature the tattoo on its own as it did in that case, separate from Mr. Wallace’s body).

The First and Fourth Circuit have enumerated factors to use when analyzing if a party objectively intended to convey a non-exclusive license to another party.<sup>94</sup> The factors are the length of the transaction, were there written contracts that stated the copyrighted materials would only be used with creator's future permission or involvement, whether the conduct of the creator during delivery or creation indicated that the recipient could use the material without the creator's consent or involvement in the future.<sup>95</sup> The primary way artists could protect themselves is by making each client sign a contract stating that the client as the recipient has the right to display the tattoo or copy it in a personal photograph, but any collaboration with a third party, especially for commercial gain, such as video game maker, is impermissible without consent from the artist.<sup>96</sup> Intent can also be exemplified as it was in the *Solid Oak* case where the artist chose to grant an explicit exclusive license of the registered copyright designs to a third party to use in any and all media.<sup>97</sup> A licensing agreement acknowledges that the artist retains rights in the design and intends to be able to choose who is allowed to exercise those rights and for what royalty fee.<sup>98</sup>

The artist should also be aware that though intent is the cornerstone of determining if an implied license exists and the scope of that license, the inquiry is based

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<sup>94</sup> Asset Mktg. Sys. V. Gagnon, 542 F.3d 748, 756 (9th Cir. 2008).

<sup>95</sup> Asset Mktg. Sys. V. Gagnon, 542 F.3d 748, 756 (9th Cir. 2008).

<sup>96</sup> See, e.g., Asset Mktg. Sys. V. Gagnon, 542 F.3d 748, 756 (9th Cir. 2008) (holding that courts have held whether or not a contract is executed or not executed can be used to show the intent of the party submitting the contract).

<sup>97</sup> Complaint for Copyright Infringement at 20, *Solid Oak Sketches, LLC v. Visual Concepts, LLC*, No. 1:16-cv-00724, 2016 WL 445124, (S.D.N.Y Feb 1, 2016).

<sup>98</sup> Complaint for Copyright Infringement at 20-21, *Solid Oak Sketches, LLC v. Visual Concepts, LLC*, No. 1:16-cv-00724, 2016 WL 445124, (S.D.N.Y Feb 1, 2016).

on objective manifestations of intent.<sup>99</sup> Therefore the artist should try to incorporate those manifestations in his daily practice. For example, the artist could display a visible sign that states the artist retains all rights in the copyright of their tattoos and allows the recipient to copy the tattoo in personal non-commercial ventures only. The artist could inform each client as they came in that any reproduction of the tattoo for commercial use by a third party would constitute infringement and the artist intends to assert their rights to the fullest extent of the law if that were to happen. Moreover, the artist could display a sign and inform his clients that he monitors any unauthorized use of his art and explain any policing procedures he has in place to do so.<sup>100</sup>

Though these actions may seem trivial there is significant financial value that can be derived from tattoos that are fixed on celebrities and displayed in video games or advertising campaigns.<sup>101</sup> Artists should make it abundantly clear whether it is in writing or through additional practices that any unauthorized commercial reproduction of the tattoo by a third party or by the recipient constitutes infringement.<sup>102</sup> The stage has been set by the previous copyright infringement claims for tattoo artists to now express their intent during their work and clearly assert the boundaries of how the recipient may use the artwork.

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<sup>99</sup> See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §10.03 (2012).

<sup>100</sup> See *Psyhoyos v. Pearson Educ., Inc.*, 855 F. Supp. 2d 103, 125 (S.D.N.Y. 2012) (knowledge of the copying and acquiescence of that behavior could indicate an implied license and shield the defendant from copyright infringement claims).

<sup>101</sup> See Christopher A. Harkins, *Tattoos and Copyright Infringement: Celebrities, Marketers, and Business Beware of the Ink*, 10 LEWIS & CLARK L. REV. 313, 314 (2006) (the influx of copyright litigation based on tattoos will lead marketing agencies, sellers and suppliers of products and services to be careful featuring tattoos in advertising campaigns and attempt to handle the issue head on to avoid legal consequences that will include financial damages).

<sup>102</sup> See Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 29 J. INTELL. PROP. L. 29, 65 (2014)

## CONCLUSION

The right to copyright and assert exclusive rights over a tattoo has been an issue marinating in the judicial system and among legal scholars for many years. Several of the high profile tattoo copyright cases have set the stage for a decision in *Solid Oak* that will likely confer substantive rights to tattoo artists. It is especially likely that *Solid Oak* will result in a decision and not a settlement, because the plaintiff intentionally secured an exclusive license to the copyrighted tattoos, which makes it probable that they will defend that investment into an outcome. Moreover, the more tattoos become popular and accepted as a form of expression the more likely it is that courts will have to identify how copyright law fits into that social trend.

Implied licenses are an attractive mechanism for the courts to use to approve the rights of tattoo artists without giving them inequitable control over the people they tattoo. Therefore artists should anticipate the implied license defense and incorporate into their practice ways of showing their intent to confer very limited non-exclusive rights to each recipient of each tattoo. They should express their intent to allow the recipient to display the copyright in their daily life, but make it clear the recipient should obtain permission and pay a royalty for any use of the tattoo in a commercial endeavor. Additionally, they should have written agreements specifying that they as the designer of the tattoo are the sole authors of the work. Finally, they should make it clear that they do not intend to grant any rights to third parties to reproduce or display the tattoo in any way. Tattoos being displayed in video games or movies is not a practice that is going away, therefore tattoo artists should prepare to capitalize on their art in the same way more traditional artists protect and profit from their creations.

