

Avoiding Copyright Liability For Tattoo Depiction In Media

By **Rowley Rice** (November 23, 2020, 2:49 PM EST)

The federal courts have seen a steady stream of copyright infringement litigation over media featuring professional athletes' tattoos.[1]

Although this issue is prevalent across multiple types of media, the majority of claims have involved sports video games. This is likely because these games often depict professional sports and their athletes as realistically as possible — including their visible tattoos. Yet, until recently, every case had settled before reaching the merits.



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Two recent district court decisions provide insight on when digital reproductions may infringe copyrighted tattoos.[2] The defendant in both cases is Take-Two Interactive Software Inc., which produces the professional basketball game NBA 2K and the professional wrestling game WWE 2K. A major selling point of these games is realism: The games provide lifelike depictions of the sports and athletes.[3] In both games, video game players see visual displays of individual athletes, including their tattoos, and also see them in action — playing basketball or wrestling in the ring.[4]

The first case, Solid Oak Sketches LLC v. 2K Games Inc., alleged that NBA 2K infringed the plaintiff's copyright in tattoos etched on three National Basketball Association players — LeBron James, Eric Bledsoe and Kenyon Martin. The U.S. District Court for the Southern District of New York granted Take-Two's motion for summary judgment, concluding that any copying was de minimis, permitted under an implied license, which the players had acquired from the tattoo artist, and protected by fair use.[5]

The second case, Alexander v. Take-Two, alleged that Take-Two infringed the copyright in professional wrestler Randy Orton's tattoos in the depiction of Orton in WWE 2K. In contrast to Solid Oak, the U.S. District Court for the Southern District of Illinois in Alexander denied Take-Two's motion for summary judgment, concluding that disputed issues of fact existed over whether Take-Two's conduct was protected by an implied license or fair use.[6]

While in tension, the two decisions offer guidance that may be helpful in evaluating infringement claims and the defenses to them.

Implied Licenses

Implied licenses are recognized as a defense under copyright law. To defeat an infringement claim, a

publisher may argue that any copying or display of the tattoo is permitted by an implied license from the tattoo artist.

However, implied licenses are nonexclusive. And, nonexclusive licenses generally are held not to be transferrable.[7] Hence, whether such a license protects publishers from infringement claims by the tattoo artist likely will depend on the scope of the license from the artist to the athlete.[8] Implied licenses generally arise by virtue of the parties' conduct. Solid Oak and Alexander offer contrasting examples of this fact-specific issue.

The Solid Oak court concluded that, by contracting for a tattoo, James and the other NBA players received implied licenses to display their tattoos.[9] The court relied on testimony from the tattoo artists that, when they inked the tattoos, they understood that their works would become elements of the players' likenesses and that the players would likely display the tattoos in public, on television and in other forms of media.[10] The court held that Take-Two's right to use the tattoos in NBA 2K derived from these implied licenses.[11]

By contrast, the Alexander court held that a factual dispute existed over whether an implied license received from the tattoo artist would have allowed Orton to sublicense his rights to WWE and Take-Two.[12] The court cited testimony from the tattoo artist that "she has never given permission to any of her clients to use copies of her tattoo works in videogames."

Accordingly, the court held that:

It is unclear whether Alexander and Orton discussed permissible forms of copying and distributing the tattoo works or whether any implied license included sublicensing rights such that Orton could give permission for others to copy Alexander's tattoo works.[13]

In short, Solid Oak and Alexander show that the existence and scope of an implied license will depend on the discussions, conduct and agreements — if any — between the athlete and the tattoo artist. So video game makers and other publishers concerned about possible infringement claims should investigate the facts of how an athlete acquired his or her tattoos and the facts that may be relevant to the existence and scope of an implied license.

Fair Use Considerations

A publisher faced with claims of copyright infringement would also likely raise fair use as a defense. The Solid Oak and Alexander decisions came to different conclusions about each of the four fair use factors. But, although fair use is very fact-specific, the competing analyses in these cases provide guidance for analyzing the strength of a fair use defense.

Factor One: The Purpose and Character of the Use

The use of a tattoo is much more likely to be considered transformative — and thus weigh in favor of fair use — if the video game combines the reproduction of a tattoo with other expressive elements. The Solid Oak court concluded that Take-Two's use of the tattoos was transformative in large part because NBA 2K used the tattoos in combination:

with myriad other auditory and visual elements, like the other players, referees, the sound of shoes

against the court's surface, the noise of the crowd, the horns and other audible warnings signaling elapsing shot clocks, ending timeouts, television announcers performing play-by-play.[14]

So makers of video games are on much stronger footing where they show the tattoo as part of an athlete or character in action — LeBron James playing basketball — rather than a static depiction — a digital image of James with his tattoos clearly visible. Yet, this alone may not be enough; Take-Two raised this argument in *Alexander*, but the court denied summary judgment because it concluded a factual dispute existed as to the tattoos' prominence and visibility in *WWE 2K*. [15]

In addition, with respect to whether the use is commercial, video game makers run a risk by featuring the tattoos on any of the game's marketing materials. Although video games are undoubtedly commercial, the *Solid Oak* court found that the fact that *NBA 2K* did not include the tattoos in its marketing showed that the tattoos were merely incidental to *NBA 2K*'s commercial value, which weighed in favor of fair use. [16]

And, while the *Alexander* court did not address this issue, other plaintiffs have emphasized a tattoo's prominence in marketing materials to support their infringement claims.

For instance, in *Allen v. Electronic Arts Inc.* in the U.S. District Court for the Western District of Louisiana, the plaintiff sued a video game maker for featuring tattooed National Football League player Ricky Williams on the covers of the games *NFL Street* and *Madden NFL 11*. [17] Therefore, video game makers will be on stronger footing if they avoid placing tattoos on game covers or other marketing materials.

Factor Two: The Nature of the Copyrighted Work

The tattoo's level of expressiveness and originality will also affect fair use. In *Solid Oak*, the court concluded that the tattoo designs were "more factual than expressive because they are each based on another factual work or comprise representational renderings of common objects and motifs that are frequently found in tattoos." [18] For instance, the court noted that one of James' tattoos merely reproduced a photograph of his son without any additional originality. [19]

By contrast, the *Alexander* court held that Orton's tattoos — which include a tribal design, a Bible verse, a dove, a rose and a skull — "naturally entail[ed] creative and expressive efforts." [20] These decisions suggest that content creators should consider the particular tattoos at issue when assessing the risk of infringement litigation.

Factor Three: Amount and Substantiality of the Use

In most cases, publishers will want to copy a tattoo in its entirety, which both courts recognized weighs against fair use. [21] However, the *Solid Oak* court reasoned that shrinking the tattoos' size in the video game reduces this factor's impact. [22] Accordingly, although this factor will generally weigh against fair use, content creators can reduce its impact by limiting the tattoo's size.

Factor Four: Effect on the Market

The fact that a market for licensing tattoos does not currently exist weighs in favor of fair use. As the *Solid Oak* court explained, "there is no evidence from which a reasonable fact finder could conclude that a market for licensing tattoos for use in video games or other media is likely to develop." [23]

On the other hand, the Alexander court acknowledged this argument but denied summary judgment because the remaining factors did not weigh in favor of fair use as a matter of law.[24] So, while this factor is more favorable to video game makers, the fact-specific, multifactor nature of fair use means it is unlikely to be dispositive.

Conclusion

Tattoo copyright infringement remains a developing area of law with many open questions, and, in light of the frequency with which such cases settle, it may be years before appellate courts answer them. In the meantime, publishers would do well to consider the Solid Oak and Alexander cases before deciding whether and how to include tattoos in their media.

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[1] Allen v. Electronic Arts, Inc., No. 5:12-CV-3172, Dkt. No. 1 (W.D. La. Dec. 31, 2012) (alleging defendant infringed copyright by featuring football player in videogame and on game's cover art); Escobedo v. THQ, Inc., No. 2:12-cv-02470, 2012 WL 5815742 (D. Ariz. Nov. 16, 2012) (alleging defendant infringed copyright by featuring tattooed mixed martial artist in videogame); Whitmill v. Warner Bros. Entertainment, Inc., No. 4:11-cv-752CDP, Dkt. No. 1 (E.D. Mo. 2011) (alleging defendant infringed tattoo design by reproducing it on film character); Reed v. Nike, Inc., No. 3:05-CV-198 BR, Dkt. No. 1 (D. Or. Feb. 10, 2005) (alleging defendant infringed copyright by featuring basketball player's tattoo in advertisement).

[2] Solid Oak Sketches, LLC v. 2K Games, Inc., 449 F.Supp.3d 333 (S.D.N.Y. 2020); Alexander v. Take-Two Interactive Software, Inc., No. 18-CV-966-SMY, 2020 WL 5752158 (S.D. Ill. Sept. 26, 2020). Neither court addressed the question whether tattoos are in fact copyrightable, a subject on which no court has issued a written decision and commentators have diverged. Compare 1 Nimmer on Copyright § 2A.15 ("[T]here may be ample reason to deny copyright protection to tattoos qua tattoos.") with Yolanda M. King, The Challenges "Facing" Copyright Protection for Tattoos, 92 OR. L. REV. 129, 152–55 (2013) (arguing the opposite). In the Whitmill case, the district judge indicated at a hearing that "tattoos can be copyrighted," Whitmill, Dkt. 56 at 3, but the case settled before there were any rulings on the question.

[3] Solid Oak, 449 F. Supp. 3d at 349; Alexander, 2020 WL 575215 at *1.

[4] Solid Oak, 449 F. Supp. 3d at 341–42; Alexander, 2020 WL 575215, at *1–2.

[5] Solid Oak, 449 F. Supp. 3d at 344–50.

[6] Alexander, 2020 WL 575215, at *4-6.

[7] In re Patient Educ. Media, Inc., 210 B.R. 237, 240 (Bankr. S.D.N.Y. 1997) ("[T]he nonexclusive license is personal to the transferee, and the licensee cannot assign it to a third party without the consent of the copyright owner."); see also 1 Nimmer on Copyright § 2A.15, n.38 (2020) ("[N]on-exclusive licenses are not themselves subject to further sub-licensing."); id. § 10.02 ("The limitations on a licensee's right

to re-sell or sublicense under the 1909 Act would appear to continue under the current Act with respect to nonexclusive licensees, but not as to exclusive licensees.").

[8] See *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1235 (11th Cir. 2010) ("Implied licenses may be limited and a defendant who exceeds the scope of an implied license commits copyright infringement. Courts focus on objective evidence revealing the intent of the parties to determine if an implied license exists, and this inquiry also reveals the scope of that license."); Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 22 *J. Intell. Prop. L.* 29, 41 (2014) (arguing any implied license "does not cover commercial uses by third parties, or . . . a client's cooperation with third parties' commercial use of a tattoo").

[9] *Solid Oak*, 449 F. Supp. 3d at 346.

[10] *Id.*

[11] *Id.*

[12] *Alexander*, 2020 WL 575215 at *4.

[13] *Id.*

[14] *Solid Oak*, 449 F. Supp. 3d at 347–48.

[15] *Alexander*, 2020 WL 575215 at *4–5.

[16] *Id.* at 348.

[17] *Allen*, Dkt. No. 1 ¶11.

[18] *Solid Oak*, 449 F. Supp. 3d at 348.

[19] *Id.*

[20] *Alexander*, 2020 WL 575215, at *5.

[21] *Solid Oak*, 449 F. Supp. 3d at 349; *Alexander*, 2020 WL 575215, at *5.

[22] *Solid Oak*, 449 F. Supp. 3d at 349.

[23] *Solid Oak*, 449 F. Supp. 3d at 350.

[24] *Alexander*, 2020 WL 575215, at *5.