

**SKIN IN THE GAME: TATTOOS,  
COPYRIGHT, AND PROFESSIONAL  
ATHLETES**

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Introduction .....	96
I. The Copyright Threshold.....	98
A. Infringement .....	100
1. The “Egyptian Family” and Rasheed Wallace .....	101
2. “The most descriptive tattoo in the world” and Mike Tyson .....	103
II. Distributing a Tattoo.....	105
A. The Right to First sale .....	105
1. UMG Recordings, Inc. v. Augusto .....	106
2. Vernor v. Autodesk, Inc. ....	107
3. Burke & Van Heusen, Inc. v. Arrow Drug, Inc....	108
B. Tattooed Athletes and the First Sale Doctrine .....	109
III. Determining the Tattoo’s Intent .....	110
A. The Implied License .....	110
B. The Scope .....	112
1. Effects Associates, Inc. v. Cohen .....	112
2. Nelson-Salabes, Inc. v. Morningside Development, LLC .....	113

3. Krause v. Titleserv.....	115
C. Tattooed Athletes and the Implied Licenses .....	116
IV. Effecting a Tattoo .....	117
A. The Tattoo and Entertainment Industry .....	118
B. Competing Policies .....	119
1. Expansion of Natural Law .....	119
C. Bettering the Public .....	120
Conclusion .....	122

#### INTRODUCTION

‘We want to be as authentic as possible, so we were pleased that Colin was able to secure the rights to the tattoos,’ said Seann Graddy, senior producer of ‘Madden 15’ . . . ‘There’s a ton of buzz around this. In this game, we only have Colin’s tattoos, but we’d love to secure the rights to the tattoos of other players in the future.’<sup>1</sup>

On June 4, 2014, for the first time, a video game depicted a professional athlete’s personal tattoos.<sup>2</sup> Electronic Arts (“EA”) recently released an action screenshot of Colin Kaepernick, the San Francisco 49ers’ quarterback, with the football firmly in his hands and his tattooed arms clearly exemplified.<sup>3</sup> Ironically, a year earlier, the questions of whether the tattoos would make the cut onto a video screen were still in play.<sup>4</sup>

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<sup>1</sup> See Darren Rovell, *New ‘Madden’: Deal Done in Ink*, ESPN.COM (June 5, 2014, 3:44 PM), [http://espn.go.com/nfl/story/\\_id/11036778/madden-15-feature-san-francisco-49ers-qb-colin-kaepernick-tattoos](http://espn.go.com/nfl/story/_id/11036778/madden-15-feature-san-francisco-49ers-qb-colin-kaepernick-tattoos).

<sup>2</sup> See *id.*

<sup>3</sup> See *id.*

<sup>4</sup> See Darren Heitner, *Questions Concerning Copyright of Athlete Tattoos Has Companies Scrambling*, FORBES (Aug. 14, 2013, 8:01 AM), <http://www.forbes.com/sites/darrenheitner/2013/08/14/questions-concerning-copyright-of-athlete-tattoos-has-companies-scrambling/>.

Kaepernick admitted that he hoped the upcoming Madden video game would incorporate his tattoos.<sup>5</sup> The National Football League Players Association (“NFLPA”) and EA’s mandate that tattoo artists release ownership of the tattoos, which they had created and etched onto the player’s skin, complicated his hope. In other words, the tattoo artists needed to sign waivers granting the NFLPA and EA the right to reproduce Kaepernick’s tattoo.<sup>6</sup>

Courts have weighed in on tattoo ownership in only a handful of cases over the past decade. The first high profile case regarding the question of copyright ownership of tattoos on a human medium involved former NBA champion Rasheed Wallace, Nike, and the author of the “Egyptian Family” themed pyramid on Wallace’s arm, Matthew Reed.<sup>7</sup> Reed initiated the lawsuit after a commercial featured the pyramid tattoo he had created for Wallace.<sup>8</sup> Wallace, Nike, nor the advertising agency reached out to Reed for permission to use the tattoo image or sought to include him in the process.<sup>9</sup>

Arguably, the most notable case for tattoos and copyright involves Warner Brothers Studios and Mike Tyson’s tattoo artist, who created Tyson’s distinct and infamous tribal face tattoo.<sup>10</sup> In that case, the tattoo artist sued over the original recreation of the face tattoo in the movie, *The Hangover: Part II*.<sup>11</sup> Specifically, the

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<sup>5</sup> Kaepernick’s tattoos serve as a financial avenue for image branding and marketing. See Doug Farrar, *Colin Kaepernick Wants You to Know: He’s Smarter Than You May Think*, SPORTS ILLUSTRATED (Aug. 14, 2013), <http://nfl.si.com/2013/08/14/colin-kaepernick-wants-you-to-know-hes-smarter-than-you-may-think/> (highlighting the important role Kaepernick’s tattoos have played in furthering his football career); David Gianatasio, *Is Tim Howard the Perfect Brand Partner? World Cup Phenom Already Has Deals with Nike, McDonald’s—More on the Way?*, ADWEEK (July 14, 2014, 6:31 AM), <http://www.adweek.com/news/advertising-branding/tim-howard-perfect-brand-partner-158889> (commenting on the rise of Tim Howard and how he is cashing in on his image right after the World Cup). In particular, Kaepernick’s best-known tattoos are those on his bicep that he kisses during his signature touchdown celebration.

<sup>6</sup> See Rovell, *supra* note 1.

<sup>7</sup> See *generally* Complaint, Reed v. Nike, No. CV 05 198 (D. Or. 2005), 2005 WL 1182840 [hereinafter Reed Complaint].

<sup>8</sup> See *id.*

<sup>9</sup> *Id.* at 4.

<sup>10</sup> See *generally* Verified Complaint for Injunctive and Other Relief, Whitmill v. Warner Bros. Entm’t Inc., No. 4:11-CV-752, 2011 WL 2038147 (E.D. Mo. filed Apr. 25, 2011) [hereinafter Whitmill Complaint].

<sup>11</sup> See *id.*

movie identically copied the tattoo on Tyson's face by placing it on another actor's face.

This Article suggests that copyright challenges the public's belief in personal liberty to control one's body. Indeed, this notion tends to explain the public interest in the ability to copyright tattoos. Additionally, this suggestion aligns with the generalization that a human being should be granted the right to reasonably and commercially utilize designs that one intentionally puts on his or her body.

This Article specifically addresses the issue of copyright and tattoos on the professional athlete's body. Unlike other contentions, this comment dismisses the issue of whether an image on a professional athlete is copyrightable by firmly contending that they are. Rather, the most pressing issue for copyright and tattoos center on the scope of the attainable rights for the professional athlete once the tattoo is copyrightable for the artist.

Copyrighting tattoos is more than a copyright issue. This Article asserts that the resolution to a tattoo artist's enforceable copyright over a professional athlete's tattoo revolves around implied contract law. In other words, the NFLPA is concerned with a pressing issue that merges copyright law and contract law.<sup>12</sup>

This Article contends that copyright law, as it stands today, is too expansive in its current format. Furthermore, copyright law should embrace the tattoo industry similarly to the entertainment industry as demonstrated by the Ninth Circuit in *Effects Associates Incorporated v. Cohen*, which narrowed copyright law to the nuances of a particular trade.<sup>13</sup>

### I. THE COPYRIGHT THRESHOLD

An original tattoo, such as the one on Mike Tyson's face, is an art design and is likely copyrightable. In order for an art design to receive copyright protection, there are two minimum requirements: originality and fixed tangible medium of

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<sup>12</sup> See *id.*

<sup>13</sup> 908 F.2d 555 (9th Cir. 1990).

expression.<sup>14</sup> Due to the threshold of originality, cliché or trivial tattoos will likely not be available for copyright security.<sup>15</sup>

Tattoos are “sufficiently permanent,” which allows them to be “perceived, reproduced, or otherwise communicated” during an athlete’s expected lifetime.<sup>16</sup> This peripheral element satisfies the statutory requirement that an image or design must be attached to a tangible medium of expression for “more than a transitory duration.”<sup>17</sup> A tangible medium of expression can be paper, canvas, wall, and even skin.<sup>18</sup> A tattoo applied to the skin of a human body would have no trouble also satisfying this “fixed” requirement.<sup>19</sup>

The 1976 Copyright Act set out eight categories of copyrightable works.<sup>20</sup> Tattoos are either a pictorial, graphical, or sculptural work classification.<sup>21</sup> This means that tattoos are graphic art applied to a three-dimensional human canvas.<sup>22</sup> After

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<sup>14</sup> 17 U.S.C. § 102 (2006).

<sup>15</sup> *See id.* *See also* Feist Publ’ns Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 358-59 (1991). For example, a generic peace symbol would like not be considered original.

<sup>16</sup> Copyright qualification requires that a work must be “fixed in any tangible medium of expression, now known or later developed, from which [the expression] can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” 17 U.S.C. § 102(a) (2006).

<sup>17</sup> *See* Carell v. Shubert Org., 104 F. Supp. 2d 236, 247 (S.D.N.Y. 2000) (granting a copyright to a makeup artist’s facial design, used in a musical production, because they were sufficiently original and expressive).

<sup>18</sup> *See* Cartoon Network LP v. CSC Holdings, Inc., 536 F.3d 121, 129 (2d Cir. 2008) (“[N]o case law or other authority dissuades us from concluding that the definition of ‘fixed’ imposes both an embodiment requirement and a duration requirement.”). *See also* Heitner, *supra* note 4 (“If it is copyrightable on paper, it’s similarly copyrightable on any medium that lasts, including skin.”(quoting Professor Jeffrey Harrison)).

<sup>19</sup> *See* Natasha Singer, *Erasing Tattoos, Out of Regret or for a Fresh Canvas*, N.Y. TIMES (June 17, 2007), [http://www.nytimes.com/2007/06/17/us/17tattoo.html?\\_r=2&](http://www.nytimes.com/2007/06/17/us/17tattoo.html?_r=2&) (explaining that even though medical physicians occasionally remove tattoos, the process is complicated and at time unsuccessful).

<sup>20</sup> 17 U.S.C. § 102 (2006). Depending on the category of the eligible work, certain exclusive rights and copyright protection will either attach or not attach. For instance, under 17 U.S.C. § 106(4), copyright owners of pictorial, graphical or sculptural work are not entitled to exclusive rights such as the right to publicly perform the work.

<sup>21</sup> 17 U.S.C. § 102(a)(5) (2006). *See also* 17 U.S.C § 101 (2010) (“Pictorial, graphic, and sculptural works include 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>22</sup> *See* 17 U.S.C. § 101 (2010).

a tattoo is statutorily categorized, it would be deemed a “work of visual art” and would likely receive copyright protection.<sup>23</sup>

In copyright, tattoo artists’ most valuable asset is their “bundle of rights.”<sup>24</sup> When a tattoo artist initially applies an original tattoo onto the skin of the professional athlete, “authorship” establishes automatically in his or her favor.<sup>25</sup> At that point, the tattoo artist controls the design of that image and may assign or license it to anyone he or she chooses.<sup>26</sup>

### A. Infringement

A violation of the tattoo artist’s “bundle of rights” occurs when a copyright protected tattoo is either directly copied or placed in an unpermitted forum.<sup>27</sup> When an offender recreates a design, and the design is largely similar to the copyrighted work, such as Warner Brother’s use of the Tyson tattoo, the tattoo artist has a copyright infringement claim.<sup>28</sup> For example, absent an express or implied license granting recreation, EA’s desire to represent Colin Kaepernick’s tattoos in the video game infringed on the tattoo artist’s copyright over Kaepernick’s tattoos.

In the past, tattoo artists have been hesitant to registering their designs for copyright control. Moreover, tattoo artists rarely sought the court’s help for copyright enforcement of their designs, if they registered it at all.<sup>29</sup> Conversely, this mentality may be changing in the current court system. One practical dilemma facing most tattoo artists is monitoring their copyrighted work

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<sup>23</sup> *Id.* (explaining that a work of visual art is only applicable if the design exists in a single copy or in a “limited edition of 200 copies or fewer” that is numbered by the author).

<sup>24</sup> See 17 U.S.C. § 102 (1996) (explaining that the “bundle of rights” for authors contains the right to (1) reproduce a work, (2) prepare derivative works, (3) distribute copies of the work, (4) publicly perform the work, and (5) publicly display the work).

<sup>25</sup> *Id.*

<sup>26</sup> 17 U.S.C. § 201(d) (2006).

<sup>27</sup> See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991). (There are two elements of copyright infringement: “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”).

<sup>28</sup> *Id.*

<sup>29</sup> Thomas F. Cotter & Angela M. Mirabole, *Written on the Body: Intellectual Property Rights in Tattoos and Other Body Art*, 10 UCLA ENT. L. REV. 97, 101-102 (2003).

among the general public.<sup>30</sup> However, this dilemma is not as daunting when applied to accessing and viewing professional athletes because they are public figures. Due to the increasing popularity of tattoos on professional athletes,<sup>31</sup> it becomes much less difficult, if not entirely possible to monitor an artist's design.

### 1. The "Egyptian Family"<sup>32</sup> and Rasheed Wallace

The first case to raise the copyright issue for tattoos in court was *Reed v. Nike*.<sup>33</sup> In 1998, Rasheed Wallace received an Egyptian Themed tattoo from a self-employed graphic artist, Matthew Reed.<sup>34</sup> During the initial meetings, Wallace traded ideas with Reed concerning the tattoo.<sup>35</sup> After several meetings and suggested changes from Wallace, Reed etched the tattoo onto Wallace's arm for \$450.<sup>36</sup> Most notably, Wallace did not require Reed to sign any licensing agreement, or other related documents that would have explicitly clarified Wallace as receiving all or some ownership of the original Egyptian design.<sup>37</sup> As a result, Reed was the exclusive owner of the tattoo design.

Not long after Wallace's NBA championship with the Detroit Pistons in 2004, Nike approached Wallace with an endorsement

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<sup>30</sup> *Id.*

<sup>31</sup> See, e.g., *What Does Body Ink Say About NBA Players' Pain and Personalities?*, NPR (June 18, 2014, 2:26 PM), [http://www.npr.org/2014/06/18/323205114/what-does-body-ink-say-about-nba-players-pain-and-personalities?utm\\_source=facebook.com&utm\\_medium=social&utm\\_campaign=npr&utm\\_term=nprnews&utm\\_content=20140618](http://www.npr.org/2014/06/18/323205114/what-does-body-ink-say-about-nba-players-pain-and-personalities?utm_source=facebook.com&utm_medium=social&utm_campaign=npr&utm_term=nprnews&utm_content=20140618). (noting that in 2010, 55 percent of NBA players were tattooed).

<sup>32</sup> See Reed Complaint, *supra* note 7. (Reed's copyright application was entitled the "Egyptian Family.").

<sup>33</sup> *Id.* See also Christopher Harkin, *Tattoos and Copyright Infringement: Celebrities, Marketers, and Businesses Beware of the Ink*, 10 LEWIS & CLARK L. REV. 313, 315 (2006) (commenting on the potential paradoxical shift in the Copyright community by questioning whether this case would "open the floodgate for other lawsuits of its kind and may inspire creative theories of copyright infringement against other defendants in the media, sports, and entertainment industries.").

<sup>34</sup> See Reed Complaint, *supra* note 7, at 3-4.

<sup>35</sup> *Id.*

<sup>36</sup> *Id.*

<sup>37</sup> See *id.* at 3. The only document Wallace did sign was an "Information and Release Document," which had zero bearing on assignments or Reed's copyright interest. *Id.* at 2.

deal.<sup>38</sup> As a result of an agreement to advertise and promote Nike's products, Wallace and Nike agreed to develop a commercial.<sup>39</sup> The commercial would reconstruct Wallace's Egyptian-themed arm tattoo through computer effects and incorporate Wallace's voice explaining the origin of the tattoo.<sup>40</sup> When Reed saw the commercial featuring the tattoo he applied to Wallace, he promptly filed a copyright application to validate his complaint.<sup>41</sup>

At the time of the commercial, Matthew Reed was the sole owner of the "Egyptian Family" drawing on Rasheed Wallace's arm. Therefore, the relationship between Reed and Wallace was not one that involved work made for hire.<sup>42</sup> This is because the design created by Reed was independent of the scope of his relationship with Wallace who was seeking the tattoo.<sup>43</sup>

The primary way to determine whether a work qualifies as a work made for hire is deciding whether the paying party had the right and ability to influence the manner and means outlining the creation of the artist's design.<sup>44</sup> Specific details concerning the tattoo artist and the professional athlete's paying relationship as well as their individual conduct are highly persuasive. For

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<sup>38</sup> See *id.* at 3. Nike wanted Wallace and his captivating persona to serve as a spokesperson to their products. *Id.*

<sup>39</sup> *Id.*

<sup>40</sup> See *id.* To produce the commercial, Nike hired advertising agency, Weiden & Kennedy. *Id.*

<sup>41</sup> See *id.* Count 1 specifically notes Nike and Weiden & Kennedy violated section 501 under the Copyright Act of 1976. ("Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 122, or of the author as provided in section 106A(a), or who imports copies or phone records into the United States in violation of section 602, is an infringer of the copyright or right of the author, as the case may be.")

<sup>42</sup> See 17 U.S.C. § 201(b) (1996). In a work for hire transaction, instead of ownership initially vesting with the artist, control endows in the paying party, or the tattoo holder.

<sup>43</sup> See 17 U.S.C. § 101 (defining a "work made for hire").

<sup>44</sup> See *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 751-52 (1989). Other factors in the work for hire analysis consist of: the location of the work, the skill required, the source of the instrumentalities and tools, whether the hiring party has the right to assign additional projects to the hired party, the extent of the paying party's discretion over when and how long to work, the method of payment, the hired party's role in choosing assistance to the artist, whether the work is considered as part of the regular business of the paying party, the employee's benefits, and the tax implications for the hiring party. *Id.*

instance, the fact that Reed considered himself an independent contractor would weigh in his favor as being the sole author and, thus, having ownership of the tattoo design.<sup>45</sup>

Despite the fact that Reed and Wallace discussed the ultimate goal of the design together, there was no intent to create a joint work or develop a work for hire arrangement.<sup>46</sup> Conversely, Reed named Wallace individually in his complaint for the final two counts.<sup>47</sup> The first count alleged that Wallace was liable for contributory infringement,<sup>48</sup> while the second count sought any revenue that Wallace received from the advertisement.<sup>49</sup> When Nike and its advertising agency digitalized the tattoo on Wallace's arm without first receiving Reed's permission, Nike infringed on Reed's interests.<sup>50</sup>

## 2. "The most descriptive tattoo in the world"<sup>51</sup> and Mike Tyson

On the day former heavyweight champion of the world, boxer Mike Tyson, received his highly recognized face tattoo, he signed an authorization form that granted "all artwork, sketches and drawings related to [his] tattoo and any photographs of [his] tattoo" to body artist Victor Whitmill.<sup>52</sup> In the complaint, Whitmill alleged that Warner Brothers infringed on an "original and

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<sup>45</sup> See Reed Complaint, *supra* note 7. See also *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 86 (2d Cir. 1995), (decisive factors for determining an independent contractor involve: level of skill involved, the ownership of tools needed for application of the tattoo, and tax details regarding employment).

<sup>46</sup> See Reed Complaint, *supra* note 7, at 3. If Wallace could have proven that he had even partial ownership over the Egyptian tattoo design, he would have escaped liability. See 17 U.S.C.A. § 201(a). See also *Thomson v. Larson*, 147 F.3d 195, 199 (2d Cir. 1988) ("Joint authorship entitles the co-authors to equal undivided interests in the whole work, such that each joint author has the right to use or to license the work as he or she wishes, subject only to the obligation to account to the other joint owner for any profits that are made.").

<sup>47</sup> Reed Complaint, *supra* note 7, at 5.

<sup>48</sup> *Id.* at 5. According to the complaint, Wallace induced or encouraged Nike and Weiden & Kennedy to commit direct infringement by holding out that he had exclusive ownership in the tattoo. *Id.* Reed alleged Wallace did this while knowing that Nike and its advertising agency would rely on his representation in creating the infringing commercial. *Id.*

<sup>49</sup> *Id.*

<sup>50</sup> Stipulation of Dismissal with Prejudice, *Reed v. Nike, Inc.*, No. 05-CV-198 BR (D. Or. Oct. 19, 2005).

<sup>51</sup> See Whitmill Complaint, *supra* note 10.

<sup>52</sup> *Id.* at 1

distinctive tattoo” he “created and applied” to the left side of Tyson’s face.<sup>53</sup> Specifically, the complaint contended that Warner Brothers interfered with Whitmill’s design when they applied an exact copy of the tattoo onto the face of actor Ed Helms in its movie, *The Hangover: Part II*.<sup>54</sup> Whitmill additionally asserted copyright violations occurred through blatant advertisements and promotions for the movie that displayed a replica of Tyson’s tattoo.<sup>55</sup>

Warner Brothers responded by claiming fair use<sup>56</sup> and parody<sup>57</sup> defenses.<sup>58</sup> When the federal judge dismissed the case, she expounded on the legitimacy of Whitmill’s complaint against the asserted defenses.<sup>59</sup> She noted in detail that the movie production “did not comment on the artist’s work or have any critical bearing on the original composition.”<sup>60</sup> Furthermore, she added, “there was no change to this tattoo or any parody of the tattoo itself.”<sup>61</sup> This commentary demonstrates that a tattoo is clearly copyrightable and that the movie’s use of the image amounted to infringement.

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<sup>53</sup> *Id.* at 2.

<sup>54</sup> *See id.*

<sup>55</sup> *See id.* at 1 (distinguishing Tyson’s tattoo as the “Original Tattoo” from Ed Helms’s replica as the “Pirated Tattoo”).

<sup>56</sup> *See* Transcript of Proceedings of Preliminary Injunction Hearing at 2, Whitmill v. Warner Bros. Entm’t Inc., No. 4:11-CV-752 CDP, 2011 WL 11819138 (E.D. Mo. 2011) [hereinafter Whitmill Hearing Transcript]. *See also* 17 U.S.C. § 107 (2012) (laying out the elements of fair use). Fair use is classified as being applied in situations that criticize, comment, report the new, teach or explain, scholarship purposes, and research. The factors included in a fair use analysis include:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

*Id.*

<sup>57</sup> *See generally* Whitmill Hearing Transcript, *supra* note 56, at 2 (explaining, based on the Supreme Court case *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 594 (1994), that section 107 of the Copyright Act encompasses parody as fair use).

<sup>58</sup> *See* Whitmill Hearing Transcript, *supra* note 56, at 2. *See also* Whitmill Complaint, *supra* note 10. Warner Brothers did not dispute the satisfaction of the “originality” threshold required for copyright authorship. *Id.*

<sup>59</sup> *See generally* Whitmill Hearing Transcript, *supra* note 56, at 2.

<sup>60</sup> *Id.* at 4.

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

While the *Reed* and *Whitmill* cases did not produce written precedent because of settlements, both strongly suggest that tattoos are copyrightable. As digital and paper re-creation inch closer to reality, however, legal questions regarding copyright and ownership of an athlete's image remain. These types of questions are particularly germane to professional athletes because of the endorsement deals and licenses issued by players' associations for products that feature athletes' likenesses, such as video games.

## II. DISTRIBUTING A TATTOO

### A. *The Right to First Sale*

An athlete inherits the right to first sale through the purchase and receipt of his or her tattoo.<sup>62</sup> The first sale doctrine entails that once the tattoo artist has sold a design, the buyer then can resell it, lend it, or rent it.<sup>63</sup> In comparison, once a tattoo artist transfers a purchased tattoo onto a professional athlete, the tattoo artist's exclusive right to control distribution is no longer valid. This means that the professional athlete upon receiving the tattoo obtains an implied but imperfect property right to use or dispose of his or her particular tattoo without regard to the wishes of the tattoo artist.<sup>64</sup>

The first sale doctrine is limited. For example, if a tattoo artist leases, rents, or loans the copyrighted image, then the first sale doctrine does not apply.<sup>65</sup> This means the first sale doctrine only applies to an individual in legal possession of the item.<sup>66</sup> As a result, the primary defense to the first sale doctrine for owners is

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<sup>62</sup> See 17 U.S.C. § 109(d) (2012) ("The privileges prescribed by subsections (a) and (c) do not, unless authorized by the copyright owner, extend to any person who has acquired possession of the copy or phonorecord from the copyright owner, by rental, lease, loan, or otherwise, without acquiring ownership of it.").

<sup>63</sup> See 17 U.S.C. § 109(a) (2012) ("[T]he owner of a particular copy . . . lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy . . .").

<sup>64</sup> See *id.*

<sup>65</sup> See *UMG Recordings, Inc. v. Augusto*, 558 F. Supp. 2d 1055 (C.D. Cal. 2008), *aff'd*, 628 F.3d 1175 (9th Cir. 2011) (discussing how this exception concerns whether the tattoo maintains a temporary element or not).

<sup>66</sup> Another exception regards reproducing or creating derivatives of the copyrighted work. See 17 U.S.C. § 109(a) (2012).

to construct all copyright transactions as licenses, rather than sales.<sup>67</sup>

### 1. UMG Recordings, Inc. v. Augusto

In analyzing the first sale doctrine, the *UMG Recordings* court explained that the first step is to decide whether the transaction constitutes a sale or other transfer of ownership.<sup>68</sup> Specifically, the court noted that protection from the first sale doctrine does not have to stem from an actual “sale.”<sup>69</sup> All the doctrine requires is the “authorized disposition by which title passes.”<sup>70</sup> This can occur through a transfer by gift or sale.<sup>71</sup>

In *UMG Recordings*, a music distributor routinely sent out promotional music to specific “industry insiders” to market upcoming CD releases.<sup>72</sup> Each publicity CD included warning labels that issued property rights to the “record company” and described a license agreement contingent upon acceptance of the CD.<sup>73</sup> In addition, the label asserted language that prohibited “resale or transfer of possession.”<sup>74</sup>

The defendant, despite not being an industry insider, acquired multiple “promotion CDs from music shops and online auctions.”<sup>75</sup> The defendant then sold many of the CDs on eBay, using enticing descriptions such as “rare collectibles not available in stores.”<sup>76</sup> After ignoring many warnings from the music

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<sup>67</sup> 17 U.S.C. § 117 (2012).

<sup>68</sup> *UMG Recordings*, 558 F. Supp. 2d at 1059 (explaining that, in addition, the defendant must also demonstrate that (a) the items were produced by the plaintiff; (b) he was the lawful owner of the copyrighted items; and (c) he disposed, not reproduced, the items).

<sup>69</sup> *Id.* See also 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.12(B)(1)(a) (2008).

<sup>70</sup> NIMMER & NIMMER, *supra* note 69, § 8.12(B)(1)(a).

<sup>71</sup> *Id.* See also PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 7.6.1 n.4 (3d ed. 2005) (“[A] gift of copies or phonorecords will qualify as a ‘first sale’ to the same extent as an actual sale for consideration.”).

<sup>72</sup> *UMG Recordings*, 558 F. Supp. 2d at 1058.

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

<sup>74</sup> *Id.*

<sup>75</sup> *Id.*

<sup>76</sup> See *id.* (noting that one description said, “[T]he promotional CD is similar to the new CD, although a promotional CD may contain fewer songs and may not include the artwork included with the new CD.”).

distributor and eBay, the defendant received notice of a copyright infringement claim.<sup>77</sup>

The question the court had to answer was whether the music industry licensed or transferred the title to the promotional CDs when it delivered them to the entertainment insiders.<sup>78</sup> The court quickly dismissed “the fact that the agreement labels itself a ‘license,’” noting that wording alone does not constitute a license contract.<sup>79</sup> Rather, like many implied scope disputes, intent is the vital evidence.<sup>80</sup>

Based on music distributor’s conduct, the court found that they did not intend to recoup the promotional CDs, and subsequently released their title to control distribution.<sup>81</sup> The plaintiffs did not mark the CDs to inform the insiders that they were to return the CDs, nor did they attempt to maintain some type of record of the number of CDs distributed.<sup>82</sup> The court categorized the physical license label as an attempt to “restrain transfer of its music,” which the Supreme Court rejected.<sup>83</sup> Accordingly, the music producer’s delivery of promotional CDs constituted a “gift or sale,” which restrained the company from claiming control over the insiders and their first sale rights.<sup>84</sup>

## 2. *Vernor v. Autodesk, Inc.*

Two years after *UMG Recordings*, in a computer software case, the Court of Appeals for the Ninth Circuit delivered its own reasoning to resolve the frequent dilemma in determining whether an outright sale or a license to use transpired.<sup>85</sup> After reversing the trial court’s grant of summary judgment, the court of appeals remanded the case with several factors to guide the lower court in

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<sup>77</sup> *Id.*

<sup>78</sup> *See id.* at 1061. To reach this conclusion, the court weighed the “economic realities” of the transaction. *Id.*

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

<sup>80</sup> *See id.* In this case, the “[o]wner’s [i]ntent to [r]egain [p]ossession” of the copyrighted items is the dominant turning point in determining if the item was sold or licensed. *Id.*

<sup>81</sup> *See id.*

<sup>82</sup> *See id.* (emphasizing that if the insiders were to lose or destroy the promotional CD, there existed no consequence).

<sup>84</sup> *Id.*

<sup>85</sup> *Vernor v. Autodesk, Inc.*, 621 F.3d 1102 (9th Cir. 2010).

distinguishing a sale from a license to use.<sup>86</sup> Essentially, the court stated that the vendor must take explicit steps to ensure the transaction is a license and not a sale.<sup>87</sup> As the vender, Autodesk exhibited the necessary steps to ensure the software license transactions.<sup>88</sup>

In this case, the plaintiff acquired second-hand copies of Autodesk's software and then sold them through eBay, despite several warnings from Autodesk.<sup>89</sup> The Ninth Circuit fashioned its holding based on the fact that Autodesk "imposed significant transfer and use restrictions."<sup>90</sup> For instance, Autodesk placed its license agreement on each physical copy, which stated, "the license is nontransferable, the software could not be transferred or leased without Autodesk's written consent, and the software could not be transferred outside the Western Hemisphere."<sup>91</sup> Autodesk also advised against "modifying, translating, or reverse-engineering," or removing any proprietary marks from the software.<sup>92</sup> Lastly, customers were required to agree to specific licensing terms, which provided for "termination of the license upon the licensee's unauthorized copying or failure to comply with other license restrictions."<sup>93</sup>

### 3. *Burke & Van Heusen, Inc. v. Arrow Drug, Inc.*

A Pennsylvania federal district court held that the first sale doctrine overrides any pre-sale license arrangement attempting to control distribution.<sup>94</sup> The *Burke* court arrived at this conclusion

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<sup>86</sup> *Id.* at 1108. *See, e.g.*, at 1112 (holding "[t]hat a software user is a licensee rather than an owner of a copy where the copyright owner: (1) specifies that the user is granted a license; (2) significantly restricts the user's ability to transfer the software; and (3) imposes notable use restrictions.").

<sup>87</sup> *Id.* at 1105. Notably, the court later indicated that the first sale doctrine should only apply when the transaction narrowly defined as an "outright sale." *Id.* Many consider this approach the minority, and the *UMG Recordings* holding the majority for many circuits. *See* 558 F. Supp. 2d 1055.

<sup>88</sup> *Id.* at 1111.

<sup>89</sup> *Id.* at 1103.

<sup>90</sup> *Id.* at 1113.

<sup>91</sup> *Id.* at 1111.

<sup>92</sup> *Id.* at 1112.

<sup>93</sup> *Id.* at 1113.

<sup>94</sup> *Burke & Van Heusen, Inc. v. Arrow Drug, Inc.*, 233 F.Supp. 881 (E.D. Pa. 1964).

by declining to enforce a narrow license contract on a subsequent purchaser of musical compositions.<sup>95</sup>

In *Burke*, the plaintiff and a company agreed to a restrictive transfer contract in exchange for a musical composition.<sup>96</sup> According to the license, the musical composition was exclusive to the sale of a certain shampoo.<sup>97</sup> The company eventually sold the musical compositions to the third party defendant.<sup>98</sup> Later, the third party sold the copyrighted items individually, which cast doubt on the scope of the license agreement.<sup>99</sup>

Leaning on the landmark first sale case, *Harrison v. Maynard, Merrill & Co.*,<sup>100</sup> the federal district court found that the third party defendant was not subject to a restrictive license that limited transfer privileges.<sup>101</sup> Specifically, the court stated, “[t]he fact that defendants knew of the restrictions which were part of the license agreement between plaintiff and [the company] neither binds defendants to a contract to which they were not parties nor widens the scope of control granted by the Copyright Act.”<sup>102</sup> Moreover, the court reasoned that under the first sale doctrine, the plaintiff received adequate compensation for his copyright work and still maintained ownership of the remaining items not transferred.<sup>103</sup>

### *B. Tattooed Athletes and the First Sale Doctrine*

For most tattooed professional athletes, the first sale doctrine is available as a potential defense to copyright infringement. In other words, professional athletes can claim some percentage of ownership once the tattoo is applied. As the cases above explain, the crucial point is determining if the tattoo transaction was a sale or a license. This Article argues that an “implied license” occurs when a tattoo artist apportions the ink onto the athlete’s

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<sup>95</sup> *Id.* at 884.

<sup>96</sup> *Id.* at 882.

<sup>97</sup> *Id.*

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

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

<sup>100</sup> *Harrison v. Maynard, Merrill & Co.*, 61 F. 689 (2d Cir. 1894).

<sup>101</sup> *Burke*, 233 F. Supp. at 882-84.

<sup>102</sup> *Id.* at 884.

<sup>103</sup> *Id.*

skin. As a result, the real issue is then defining the implied contractual parameters of ownership for the image on their body.

### III. DETERMINING THE TATTOO'S INTENT

This comment asserts that the tattooed athlete inherits an implied right to commercial marketing and advertising based on tattoo industry customs, the expectations of the tattoo artist and the tattooed professional athlete, and the conduct of the two parties. In other words, to the tattooed athlete, these implied rights serve as *de facto* exceptions to the tattoo artist's bundle of rights.<sup>104</sup> The basis for determining the scope of these implied exceptions derive from an "implied license."

#### A. *The Implied License*

A copyright license is simply authorization to use another's work, and it is an important affirmative defense to an allegation of copyright infringement.<sup>105</sup> Kaepernick, himself, had a licensing contract created that granted him and EA exclusive permission to use his tattoos.

Copyright licenses come in three forms: written,<sup>106</sup> oral,<sup>107</sup> and implied.<sup>108</sup> Within these three types, the licenses are either exclusive<sup>109</sup> or nonexclusive.<sup>110</sup> In order for the license to contain

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<sup>104</sup> See *Effects Assoc., Inc. v. Cohen*, 908 F.2d 555, 559 (9th Cir. 1990).

<sup>105</sup> *Recursion Software, Inc. v. Interactive Intelligence*, 425 F. Supp. 2d 756 (N.D. Tex. 2006). See also *Baisden v. I'm Ready Productions, Inc.*, 693 F.3d 491, 500 (5th Cir. 2012), *cert. denied*, 133 S. Ct. 1585 (2013) ("Consent for an implied license may take the form of permission or lack of objection.").

<sup>106</sup> *Tattoo Art, Inc. v. TAT Int'l, LLC*, 794 F. Supp. 2d 634, 640 (E.D. Va. 2011).

<sup>107</sup> *Bergt v. McDougall Littell*, 661 F. Supp. 2d 916 (N.D. Ill. 2009).

<sup>108</sup> See *Batesville Servs., Inc. v. Funeral Depot, Inc.*, No. 1:02-CV-01011-DFH-TA, 2004 WL 2750253 (S.D. Ind. Nov. 10, 2004). See also *Effects Assoc., Inc.*, 908 F.2d at 558. There are three developments that lead to an implied license between the tattooed athlete and tattoo artist: (1) when the athlete requests the construction of the tattoo, (2) when tattoo artist creates the tattoo and applies it to the human medium, and (3) when the tattoo artist intends the athlete to use the work as the tattoo holder anticipates.

<sup>109</sup> See 17 U.S.C. § 106 (1976). "Exclusive" means actual transfer of ownership from the tattoo artist to the tattoo holder or a person of choosing.

<sup>110</sup> *Lowe v. Loud Records*, 126 Fed. App'x 545 (3d Cir. 2005) ("Circumstances establishing permission, or even lack of objection, can establish a nonexclusive [implied] license. . . . However, since [an] . . . implied, license does not transfer

exclusive rights, the Copyright Act mandates that the license must be in writing.<sup>111</sup>

In Kaepernick's circumstance, due to the extensive access EA needed, he retrieved the vital consent from the two tattoo artists and delivered the written license to the NFLPA.<sup>112</sup> For the NFLPA and other similar players' associations, analogizing Colin Kaepernick's situation is the best-case scenario for other tattooed professional athletes hoping to pursue commercialization.<sup>113</sup> At that point, EA could proceed with describing Kaepernick's tattoos in the video game.

While a non-exclusive license will not transfer sole ownership to a tattoo holder, it does "permit the use of a copyrighted work in a particular manner."<sup>114</sup> In most situations, a non-exclusive license will only derive from a verbal or implied license.<sup>115</sup> Essentially, a non-exclusive license serves as an exception to the writing requirement.<sup>116</sup>

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ownership, there may still be a claim of copyright infringement if the licensed use goes beyond the scope of the license.").

<sup>111</sup> See 17 U.S.C. § 204 (1976). Exclusive rights include the right of reproduction, adaptation, public display, and in some instances moral rights. However, the tattoo artist does not have to transfer all rights completely. See also, 17 U.S.C. § 201(d)(1) (1976) ("The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession."). See, e.g., Meredith Hatic, *Who Owns Your Body Art?: The Copyright and Constitutional Implications of Tattoos*, 23 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 396, 431 ("[T]he artist might choose to transfer the right to prepare derivative works to the subject to avoid interfering with the subject's right to control his or her own body. Further, he could transfer the right to publicly display the work to preserve the subject's right to publicity.").

<sup>112</sup> See Rovell, *supra* note 1. See also *Effects Assoc., Inc.*, 908 F.2d at 599. Once an implied license creates, the athlete becomes the licensee, and the tattoo artist becomes the licensor.

<sup>113</sup> See, e.g., *What Does Body Ink Say About NBA Players' Pain And Personalities*, *supra* note 31.

<sup>114</sup> *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775 (7th Cir. 1996).

<sup>115</sup> See *Foad Consulting Grp. V. Musil Govan Azzalino*, 270 F.3d 821, 825-26 (9th Cir. 2001).

<sup>116</sup> See 17 U.S.C. § 204(a) (1976) Transfer may be "by operation of law or "in writing." *Id.* However, § 204(a) does not define the phrase "by operation of law," and inference from case law is limited.

Within each license, there are actions that are acceptable in regards to using the tattoo and actions that are not.<sup>117</sup> Where the athlete exceeds the scope of the license, the tattoo artist may then commence an action for infringement. Indeed, determining is the scope of infringement is largely unsettled because the law is unsettled and each analysis is fact dependent.

### *B. The Scope*

Intent is the turning point for determining the scope of an implied license.<sup>118</sup> For tattoos, the parameters of the implied license, or implied-in-fact contract, rely on the custom of the industry and conduct of the two parties.<sup>119</sup>

For tattoo transactions, this Article asserts that the most appropriate intent analysis is the three-prong, “*Effects Test*.”<sup>120</sup> The Ninth Circuit “*Effects Test*” looks objectively at the circumstances and conduct that created the implied license.<sup>121</sup>

#### 1. *Effects Associates, Inc. v. Cohen*

In the fact-specific *Effects* case, a horror movie producer employed a special effects company to construct footage for a

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<sup>117</sup> See *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1235 (11th Cir. 2010); *Estate of Hevia v. Portrio Corp.*, 602 F.3d 34, 41 (1st Cir. 2010) (“Uses of a copyrighted work that stay within the bounds of an implied license do not infringe the copyright.”).

<sup>118</sup> *Teter v. Glass Onion, Inc.* 723 F. Supp. 2d 1138, 1149 (W.D. Mo. 2010).

<sup>119</sup> See, e.g., *Korman v. HBC Florida, Inc.*, 182 F.3d 1291 (11th Cir. 1999) (jingle writer’s conduct of allowing a station’s use of jingles for years created license); *Natkin v. Winfrey*, 111 F. Supp. 2d 1003, 1011 (N.D. Ill. 2000). See *Latimer*, 601 F.3d at 1235 (“[T]he Ninth Circuit held that a copyright owner must express the intent to restrict the scope of a license when they deliver the copyright work. Thus, an implied license will be limited to a specific use only if that limitation is expressly conveyed when the work is delivered.”) (citing *Asset Marketing Systems, Inc. v. Gagnon*, 542 F.3d 748, 756 (9th Cir. 2008)).

<sup>120</sup> *Effects Assoc., Inc. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990). An implied license is granted where the work is requested, delivered, and intended to be used in a certain way. *Id.*

<sup>121</sup> By looking at the totality of circumstances, courts can infer what the two parties reasonably intended to be acceptable actions of the licensed rights. See, e.g., *Johnson v. Jones*, 149 F.3d 494, 501–02 (6th Cir. 1998) (applying *Effects* test to determine whether the copyright owner of architectural designs had granted an implied license that later permitted their use); *Nat’l Ass’n for Stock Car Auto Racing, Inc. v. Scharle*, 184 Fed. App’x 270, 276 (3d Cir. 2006) (applying *Effects* test to determine whether the copyright owner of certain images had granted an implied license that later permitted their use by NASCAR).

film.<sup>122</sup> The movie producer and the special effects company reached a loose, verbal agreement that did not specify who would own the copyright to the material.<sup>123</sup> Accordingly, in the entertainment industry, it is customary “not to have written licenses.”<sup>124</sup>

After some time, the movie executive became discontented with the requested footage, and, as a result, shorted the special effects company half of the arranged amount in spite of constant demands for full payment.<sup>125</sup> The producer, although dissatisfied, used the footage in the film.<sup>126</sup> The special effects company sued for copyright infringement.<sup>127</sup>

In determining “whether Effects had transferred . . . the right to use the footage,”<sup>128</sup> the Ninth Circuit court recognized that a nonexclusive implied license was established based on the industry’s custom and the parties’ conduct.<sup>129</sup> The court reached this conclusion because the special effects company “created a work at the defendant’s request and handed it over, intending that defendant copy and distribute it.”<sup>130</sup>

## 2. *Nelson-Salabes, Inc. v. Morningside Development, LLC*

The Fourth Circuit, in *Nelson-Salabes*, used the *Effects* test and added their own “totality of circumstances” factors to guide the court in inferring intent.<sup>131</sup> In this case, an architect design company agreed to create precise task-oriented drawings for real estate development group.<sup>132</sup> Sometime later, the business arrangement dissipated for various reasons.<sup>133</sup> The real estate

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<sup>122</sup> *Effects*, 908 F.2d at 556.

<sup>123</sup> *Id.*

<sup>124</sup> *Id.* at 557.

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

<sup>126</sup> *Id.*

<sup>127</sup> *Id.* See also *id.* at 556. In its opinion, the court initially noted the special effects company could have sued the movie producer for breaching the implied contract by failing to pay full for the footage. *Id.* The creative effects company, however, isolated their claim by requesting the court to rule strictly on copyright infringement. *Id.*

<sup>128</sup> *Id.* at 556.

<sup>129</sup> *Id.* at 558-59

<sup>130</sup> *Id.* at 558

<sup>131</sup> *Nelson-Salabes, Inc. v. Morningside Dev., LLC*, 284 F.3d 505, 515 (4th Cir.2002).

<sup>132</sup> *Id.* at 515.

<sup>133</sup> *Id.*

company, however, kept and eventually used specific drawings.<sup>134</sup> The real estate company claimed an implied license to the use the drawings.<sup>135</sup>

The *Nelson-Salabes* Court stated that “existence of an implied nonexclusive license” depends on at least three factors:

- (1) [W]hether the parties were engaged in a short-term discrete transaction as opposed to an ongoing relationship; (2) [W]hether the creator utilized written contracts . . . providing that copyrighted materials could only be used with the creator’s future involvement or express permission; and (3) [W]hether the creator’s conduct during the creation or delivery of the copyrighted material indicated that use of the material without the creator’s involvement or consent was permissible.<sup>136</sup>

In other words, in situations where the tattoo artist completes a requested task, with “no indication of their further involvement in the project, and where they did not suggest in their proposed contracts or by their conduct that use of the copyrighted material without their involvement was impermissible,” the court infers an implied license.<sup>137</sup>

When the court applied the facts to the guideposts above, they found a combination of the factors satisfied.<sup>138</sup> For instance, the task-specific contract between the real estate developer and the architect design firm included language that suggested “long-term involvement” with the project.<sup>139</sup> Furthermore, the contract contained language that prohibited use of drawings without the architects’ approval.<sup>140</sup>

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<sup>134</sup> *Id.* at 511. NSI Drawings in its complaint alleged that the Defendants copied the footprint and exterior elevations. *Id.*

<sup>135</sup> *Id.* at 514.

<sup>136</sup> *Id.* at 516.

<sup>137</sup> *Id.* at 516.

<sup>138</sup> *Nelson-Salabes, Inc.*, 284 F.3d at 516.

<sup>139</sup> *Id. Cf. Foad Consulting Grp. v. Musil Govan Azzalino*, 270 F.3d 821, 832 (9th Cir. Cal. 2001). The court held that an architect, hired to create a plot plan for a shopping center, was engaged in a short-term discrete transaction. *Id.* Therefore, absent agreement or conduct to contrary, the architect permitted use of the plans without future involvement. *Id.*

<sup>140</sup> *See Nelson-Salabes, Inc.*, 284 F.3d at 516. In addition, the designers specifically informed the real estate developers that use of the designs would infringe on their copyright “on at least two occasions.” *Id.*

Taking all relevant facts into consideration, the court declined to find an implied license.<sup>141</sup> The court suggested it was particularly persuaded because the two parties were “engaged in an ongoing relationship that contemplated . . . future involvement.”<sup>142</sup>

### 3. Krause v. Titleserv

Even though other circuits often use the *Effects* standard, an “intent” investigation will differ based on the facts. For instance, the original *Effects* analysis is specific to the entertainment industry, which is analogous to the tattoo industry and sports athletes.<sup>143</sup> One recent case from the Second Circuit did not use the *Effects* test, but instead relied upon the facts and the plain meaning of section 117(a) for computer programs to decide the scope of an implied agreement.<sup>144</sup> Notably, section 117(a) offers protection for purchasing owners of a computer program by limiting exclusive rights for the creator of the computer program.<sup>145</sup>

In *Krause*, a company employed an independent contractor for a substantial amount of computer and communication source codes.<sup>146</sup> After a dispute, the independent contractor informed the company that its ownership and use of the programs would be restricted.<sup>147</sup> Based on a fact intensive analysis, the court disagreed with this limitation.<sup>148</sup>

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<sup>141</sup> *Id.*

<sup>142</sup> *Id.* This is distinguishable from the Wallace and Tyson scenarios, and likely many other professional athletes. The involvement with tattoo artists exist for a single project or short-term involvement.

<sup>143</sup> *Effects Assoc., Inc. v. Cohen*, 908 F.2d 555 (9th Cir. 1990).

<sup>144</sup> *Krause v. Titleserv, Inc.* 402 F.3d 119 (2nd Cir. 2005).

<sup>145</sup> *See* 17 U.S.C. § 117(a) (“Notwithstanding the provisions of section 106 [which generally provides, inter alia, that copyrighting of a protected work is an infringement], it is not an infringement for the owner of a copy of a computer program to make or authorize the making of another copy or adaption of that computer program provided: (1) that such a new copy or adaption is created as an essential step in the utilization of the computer program in conjunction with a machine and that it is used in no other manner. . .”).

<sup>146</sup> *Krause*, 402 F.3d at 120.

<sup>147</sup> *Id.* at 121.

<sup>148</sup> *Id.* at 125-29. To reach this conclusion, the Krause court determined: whether the company acted as “owner of the computer copy”; changed the program as part of an

The court concluded that the company served as the rightful owner of the computer programs because they paid a significant amount for their sole benefit, such as individual customization of the programs.<sup>149</sup> Indeed, the company's rights, which included the option to discard or destroy at-will, existed regardless of the relationship between the independent contractor and the company.<sup>150</sup> The court emphasized that the independent contractor's restricting comments at the end of the business relationship were contrary and immaterial due to his prior conduct, which failed to object to any restrictions.<sup>151</sup>

### *C. Tattooed Athletes and the Implied Licenses*

Until the courts officially define the scope of tattoo ownership rights of tattoo authors and athletes have over the tattoo, the NFLPA is urging players to obtain releases when they get new ink.<sup>152</sup> As some commentators have suggested, and Kaepernick's situation has indicated, it may become necessary for players to track down parlor artists from the past to negotiate current releases.<sup>153</sup> For most tattooed athletes, they will encounter scenarios where there is likely no written agreement, which offers little into the tattoo artist and the tattooed athlete's expectation for ownership or control of the tattoo.<sup>154</sup>

A more complicated copyright determination would be when a third party enters for commercial purposes. Specifically, one that is absent a formal agreement that allows marketable efforts

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"essential step in the utilization of that computer program"; and if the program was "used in no other manner" contrary to its initial use. *Id.* at 122.

<sup>149</sup> *Id.* at 124. Further, the independent contract never "reserved the right to repossess the copies" and agreed that the company "had the right to continue to possess and use the programs forever." *Id.*

<sup>150</sup> *Id.* at 124-25. For the other two requirements to section 117(a), the court found that the changes to the program were "essential steps to cultivation," and that the programs were satisfactorily "used in no other manner" than their specified use. *Id.* at 129-31.

<sup>151</sup> *Id.* at 124.

<sup>152</sup> See Mark Schiff, *Who Owns the Copyright on an Athlete's Tattoo?*, SPORTS EXAMINER (Aug. 14, 2013), <http://www.examiner.com/article/who-owns-the-copyright-on-an-athlete-s-tattoo>.

<sup>153</sup> *Id.* See also, 17 U.S.C. § 201(d).

<sup>154</sup> See *id.* A lack of a written agreement could signal the formation of a non-exclusive license.

or “derivative works” for the tattoo to be used. One example is EA’s, potentially infringeable, animated depiction of Colin Kaepernick’s tattoos.

Due to the expected publicity tattooed athletes receive, tattoo artists imply to the tattooed athlete the right to publically display the tattoo. In other words, for professional athletes, commercial opportunity is an expected derivative of a professional career. In an otherwise potential copyright infringement situation, courts permit tattooed athletes to be photographed for a newspaper, magazine, or other media.<sup>155</sup> To assume otherwise would be completely unreasonable and unnecessarily taxing on a professional athlete.<sup>156</sup>

#### IV. EFFECTING A TATTOO

“I own Beck’s Tattoo . . . and I’ll sue.”<sup>157</sup>

In most situations, the protections afforded by Copyright law are concrete, but when it comes to art on human flesh, should a single copyright be so expansive? Based on the court’s reasoning in *Effect*, the customs of an industry can override the norms of copyright.<sup>158</sup>

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<sup>155</sup> See *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 413 (9th Cir. 1996) (explaining the right of publicity is necessary due to its spontaneous elements.) Publicity means, in essence, “the reaction of the public to name and likeness, which may be fortuitous or which may be managed and planned, endows the name and likeness of the person involved with commercially exploitable opportunities.” *Id.*

<sup>156</sup> This is especially true in the case of a highly visible tattoo, such as Mike Tyson’s facial tattoo. Furthermore, Kaepernick could argue that the digital recreation of his tattooed arm is simply a display that is analogous to his image transmitted during a live game.

<sup>157</sup> Fiona Cummins & Sharon Feinstein, *Exclusive: I Own Beck’s Tattoo . . . and I’ll Sue*, DAILY MIRROR (June 27, 2005), <http://www.mirror.co.uk/celebs/news/2005/06/27/exclusive-i-own-beck-s-tattoo-and-i-ll-sue-115875-15668908> (tattoo artist Louis Molloy on his public dispute with David Beckham after Beckham announced he planned to highlight his tattoos in an advertisement).

<sup>158</sup> *Effects Assoc., Inc. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990) (“Although we reject any suggestion that moviemakers are immune to section 204, we note that there is a narrow exception to the writing requirement that may apply here.”).

A. *The Tattoo and Entertainment Industry*

Copyright law should consider the nuances of the tattoo industry, such as the expectation surrounding a verbal agreement. Courts interpret the *Effects* ruling broadly because it is particular to the entertainment industry and its custom of creating paperless transactions between two parties.<sup>159</sup> Relatedly, copyright law should be flexible to the implied understanding when professional athletes receive a tattoo.

Many artists express no issue because of the free promotion for their tattooing business, and the publicity that they will receive as a result of advertising opportunities tattooed athletes receive during their professional career and beyond. When tattoo artist Matthew Reed sued Rasheed Wallace and Nike for copyright infringement, he acknowledged that he etched the tattoo on Wallace for a lower-than-usual price.<sup>160</sup> Through his admittance and lack of express objection, Reed acknowledges an implied license with Wallace.<sup>161</sup> For a tattoo artist to deny such a license would unfairly affect the way the professional athlete lived in the public eye, and preclude their ability to use a tattoo or other work they purchased.

Moving forward, analyses should favor the tattooed professional athlete based on a wide-ranging implied license that includes exclusive rights related to specific financial gain through commercial opportunities. This analysis would accurately reflect the custom of the tattoo industry and the conduct of both parties before and after the inking.

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<sup>159</sup> *Id.* (another reason the entertainment industry is analogous to the tattoo industry is because of the cross-over of well-known individuals in both industries, such as Jessie James). *See, e.g.,* MIKE SEATE, *JESSE JAMES: THE MAN AND HIS MACHINES* 15 (2003).

<sup>160</sup> Associated Press, *Artist Sues Wallace over Use of Tattoo*, ESPN.COM (Feb. 16, 2005), <http://sports.espn.go.com/espn/sportsbusiness/news/story?id=1992812>. *See also* Reed Complaint, *supra* note 7, at 3-4. Reed charged a lower price primarily because he knew that his personal work would benefit his business more through free exposure on a well-known NBA player, than for any paid for advertisement. *Id.*

<sup>161</sup> *See* Asset Marketing Systems, Inc. v. Gagnon, 542 F.3d 748, 757 (9<sup>th</sup> Cir. 2008) (noting that to limit an implied contract, the owner must “express an intent to retain control over the programs and limit AMS’s license if he intended to do so”).

*B. Competing Policies*

The Copyright Act of 1976 is Congress's constitutional expression of promoting "Science and useful Arts."<sup>162</sup> The Act grants creative authors ownership of their works. Indeed, copyright law revolves around two distinct and competing policies that balance the betterment of the public and private control for artists. The two policies represent two theories: natural law and public incentive for creative works. Natural law, which is rooted in copyright law today, focuses on the assertion that the owner of a creation should maintain complete control over said creation. Conversely, the underlying policy for granting copyrights is to create incentives to generate artistic designs for the betterment of the general public.

*1. Expansion of Natural Law*

Over the past half a century, the scales have grossly tipped in favor of the creative artist or owner.<sup>163</sup> The protection for an owner, in some form, for a non-work for hire consists for the life of the author plus seventy years.<sup>164</sup> In comparison, if the transaction is a work for hire, the rights granted to the hiring party exists for ninety-five years from the first publication, 120 years from creation, or whichever expired first.<sup>165</sup>

The damages for an artist claiming copyright infringement have likewise grown to match the expanding nature of copyright law.<sup>166</sup> For example, in the *Whitmill* case concerning Mike Tyson's tribal tattoo, the tattoo artist sought preliminary and permanent injunctions on the advertising and release of *The Hangover: Part II*,<sup>167</sup> actual damages and profits,<sup>168</sup> as well as cost and attorney's

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<sup>162</sup> U.S. CONST. art I, § 8, cl. 8.

<sup>163</sup> See, e.g., 17 U.S.C. § 102(a)(7) (extending federal copyright protection to sound recordings on Feb. 15, 1972). See also 17 U.S.C. § 102(a)(8) (extending federal copyright protection to buildings on Dec. 1, 1990).

<sup>164</sup> See 17 U.S.C. § 302(a) (1996).

<sup>165</sup> 17 U.S.C § 302(c) (1996).

<sup>166</sup> To be clear, complaints do not necessarily display the greedy nature of tattoo artists. Rather, these claims merely display the current stage of copyright law that overwhelmingly favors creative artists.

<sup>167</sup> Whitmill Complaint, *supra* note 10, at 1. See also 17 U.S.C. § 502(a) (2012).

<sup>168</sup> Whitmill Complaint, *supra* note 10, at 1. See also 17 U.S.C. § 504(b) (2010).

fees.<sup>169</sup> In *Reed v. Nike*, the tattoo artist pursued all of the above damages, as well as prejudgment interest relating to the Egyptian Pyramid he had tattooed onto Rasheed Wallace.<sup>170</sup>

For some tattoo artists, exercising the right to a copyright claim involving a professional athlete has subjected them to public criticism, or worse.<sup>171</sup> In 2012, after a of Phoenix-based tattoo artist, Chris Escobedo, sued current-bankrupt videogame developer THQ Inc., “over a mixed-martial arts game in which one of his tattoos—a large, scowling lion on the right rib cage of Ultimate Fighting Championship star Carlos Condit—makes a cameo appearance,” he received hate mail and threats on his Facebook page from gamers who blamed Escobedo for the lawsuit.<sup>172</sup>

### C. Bettering the Public

Copyrighting a tattoo is highly intriguing to the public.<sup>173</sup> Specifically, the ability to control or limit economic opportunities

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<sup>169</sup> Whitmill Complaint, *supra* note 10, at 1. *See also* 17 U.S.C. § 505 (“In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney’s fee to the prevailing party as part of the costs.”).

<sup>170</sup> Reed Complaint, *supra* note 7, at 7. *See also, e.g.*, *MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005) (the United States Supreme Court recognized secondary liability for copyright infringement and the theory of contributory copyright infringement).

<sup>171</sup> Jacob Gershman, *Athletes’ Tattoo Artists File Copyright Suits, Leaving Indelible Mark*, WALL ST. J. (June 16, 2014 11:59 PM) <http://online.wsj.com/articles/athletes-tattoo-artists-want-more-skin-in-the-game-1402972074> (Megan Wilson, a tattooist from San Jose, said “We’re hired to make a piece of art and give it to someone, to say we own it at that point is kind of absurd.”).

<sup>172</sup> *See id.* Even though Escobedo said he has known Condit since the latter was a teenager, the attempt to control an aspect of Condit’s personal life ruined their friendship. *Id.*

<sup>173</sup> Prestigious media moguls such as the New York Times, Business Week, and the Wall Street Journal all comment periodically on the theme of a professional athlete’s tattoo getting them sued. *See, e.g.*, Noam Cohen, *On Tyson’s Face, It’s Art. On Film a Legal Issue.*, N.Y. TIMES (May 20, 2011), [http://www.nytimes.com/2011/05/21/business/media/21tattoo.html?pagewanted=2&\\_r=1&](http://www.nytimes.com/2011/05/21/business/media/21tattoo.html?pagewanted=2&_r=1&); Ira Boudway, *Hey, Pro Athletes: Your Tattoo Is Going to Get You Sued*, BUS. WK. (Sept. 4, 2013), <http://www.businessweek.com/articles/2013-09-04/hey-pro-athletes-your-tattooed-arms-are-going-to-get-you-sued>; Gershman, *supra* note 172.

based on a tattoo is puzzling to many people because it involves personal liberty.

Previous advocates have asserted that copyright enforcement over a tattoo resembles “involuntary servitude.”<sup>174</sup> Even though these comparisons are disconcerting, the level of control a design artist would need to exhibit would likely never rise to the level that the Thirteenth Amendment prohibits. Nonetheless, the idea that a voluntary decision to receive a tattoo could unintentionally subject a professional athlete to an implied contract of narrow restrictions is troubling.

Courts should coil back copyright law in deference to the harmful implications to the general public.<sup>175</sup> The consequences of copyright lawsuits over tattoos unfairly affect an undeserving third party – the paying public.<sup>176</sup> Ultimately, commercial availability to the public is the key factor when declining extensive protection to a copyrighted item that stimulates overwhelming community interest.

Copyright law must create a niche for the tattoo industry as it has for computer software, musical compositions, and artists in both the formal and the informal sense. To do this Congress should glean from the customs of the tattoo industry. For instance, similar to the Hollywood showbiz industry in *Effects*, the growing tattoo trade often conducts business without contracts.<sup>177</sup>

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<sup>174</sup> See Craig P. Bloom, *Hangover Effect: May I See Your Tattoo, Please?*, 31 CARDOZO ARTS & ENT. L.J. 435, (2013) (linking a tattoo artist’s control over a professional athlete’s tattoo is arguably, a “badge of slavery” that the thirteenth amendment clearly denounced; this theory derives from the copyright language that details direct or indirect control over one’s work).

<sup>175</sup> See Whitmill Hearing Transcript, *supra* note 56, at 6-7. The Federal Judge of the Mike Tyson case assessed the harm to the public in her decision to dismiss. *Id.* She admitted “she should have enjoined the studio from releasing the film – a decision that could have cost the studio as much as \$100 million.” *Id.* Nonetheless, she concluded that the harm to the “public interest” from stopping the release of the movie outweighed the harm to Mr. Whitmill. *Id.*

<sup>176</sup> See Gershman, *supra* note 172. According to the Wall Street Journal, “when videogame giant EA Sports, a brand of Electronic Arts Inc., developed its own fighting game featuring Mr. Condit . . . it left out the lion, causing gamers to growl.” *Id.* Said one fan on an EA online forum after seeing screenshots of Condit, without his tattoo, “[t]hat tattoo artist must feel he now owns a portion of carlos condits rib cage too huh?” *Id.*

<sup>177</sup> See *Effects Assoc., Inc. v. Cohen*, 908 F.2d 555 (9th Cir. 1990).

Most athletes do not intend to share ownership of their body with a temporary tattoo artist.<sup>178</sup> As the Ninth Circuit indicated, movie studios would not want to share ownership with a production assistant based merely on verbal agreements.<sup>179</sup> Congress should adopt this mindset. This mindset occurs by broadening the scope of the implied license created at the time of inking, relaxing its exclusive rights standard, and including the right to reproduce a design based on the first sale doctrine.

### CONCLUSION

Tattoos are copyrightable. Nevertheless, does that contention alone imply that a tattoo artist should be entitled to the proceeds that a professional athlete earns based on his or her publicity? In particular, publicity that derives specifically from an athlete's physical ability and not the sporadic artwork inked on their body. This Article contends that based on the public policy outlining the concern from the general public, a creative author should not be able to control the commercial actions of a professional athlete. Analogous to the *Effect's* standard, the scope of an implied license should be interpreted broadly when applied to verbal agreements and conduct between a tattoo holder and a tattoo artist.

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<sup>178</sup> See also, Gershman, *supra* note 172, Megan Wilson, a tattooist from San Jose, said "We're hired to make a piece of art and give it to someone, to say we own it at that point is kind of absurd." *Id.*

<sup>179</sup> See *Aalmuhammed v. Lee*, 202 F.3d 1227, 1235 (9th Cir. 2000) ("It would be illogical to conclude that [the movie studio], while not wanting to permit [the producer] to own the copyright, intended to share ownership with individuals like [the consultant] who worked under [the producer's] control, especially ones who at the time had made known no claim to the role of co-author.").