

HANGOVER EFFECT: MAY I SEE YOUR TATTOO, PLEASE?♦

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INTRODUCTION: FROM THE BIG SCREEN TO THE COURTROOM

Headaches, nausea and regret often accompany a hangover. Just ask Warner Brothers Entertainment, Inc. (“Warner Bros.”), which narrowly escaped a court order that would have halted the release of its big-budget film, *The Hangover: Part II* (“*Hangover II*”).¹ One month prior to the film’s release, Steven Whitmill (“Whitmill”) filed a complaint against Warner Bros. alleging copyright infringement.²

To most, Whitmill is not a recognizable name. In fact, he is “an

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¹ Transcript of Hearing on Motion for Preliminary Injunction, *Whitmill v. Warner Bros. Entm’t Inc.*, No. 4:11-CV-752 (E.D. Mo. May 24, 2011) (denying plaintiff’s request for a preliminary injunction).

² *See* Complaint, *Whitmill v. Warner Bros. Entm’t Inc.*, No. 4:11-CV-752 (E.D. Mo. Apr. 25, 2011).

award-winning³ tattoo artist from a small town in Missouri. If that does not ring any bells, perhaps this will help. In 2003, Whitmill created and inked arguably one of the most “distinctive” tribal tattoos of all time.⁴ It was not necessarily the design that made Whitmill so famous, but rather the tattoo’s benefactor and placement. Whitmill left his mark where virtually no other person on the planet would dare: the upper left side of Mike Tyson’s face (“Tyson Tattoo”).⁵ The bells must certainly be going off now. Unfortunately for Warner Bros., at the time it developed, shot, advertised and prepared to release *Hangover II*, these bells were a distant, almost inaudible noise.

The trouble arose when Warner Bros. reproduced a nearly identical version of the Tyson Tattoo on the upper left side of actor Ed Helms’ face. Helms and the tattoo not only appear throughout *Hangover II*, but also in advertising and other promotional materials.⁶

In the film, the *Hangover II* cast travels to Thailand for a wedding, where excessive partying leads to debauchery and the tattoo at issue.⁷ While audiences may have found this to be a humorous story line, Whitmill was not laughing. Instead, Whitmill filed a complaint alleging that he created the tattoo exclusively for Mike Tyson, held the copyright and did not authorize Warner Bros.’ use of it. He sought to enjoin the film from being released in addition to monetary damages for infringement and any profits Warner Bros. had realized from its use of the Tyson Tattoo.⁸

While the court ultimately denied Whitmill injunctive relief based on a balance of the equities,⁹ it signaled that Whitmill was likely to win his copyright infringement claim on the merits.¹⁰ The court opined that a “tattoo itself and the design itself can be copyrighted.”¹¹ The court went on to state that the prior notion is “entirely consistent with the copyright law.”¹² Nevertheless, the case never made it to trial. The parties entered into a private settlement shortly after the preliminary injunction motion was decided.¹³

³ *Id.* at 2.

⁴ *Id.*

⁵ *Id.* at 3.

⁶ See Verified Answer to Complaint at 5–6, *Whitmill v. Warner Bros. Entm’t Inc.*, No. 4:11-CV-752 (E.D. Mo. May 20, 2011).

⁷ See Michael Rechtshaffen, *The Hangover Part II: Movie Review*, HOLLYWOOD REP., May 23, 2011, <http://www.hollywoodreporter.com/review/hangover-part-ii-movie-review-190754>.

⁸ See Complaint, *supra* note 2, at 7–8.

⁹ Transcript of Hearing on Motion for Preliminary Injunction, *supra* note 1, at 6–7 (holding that the millions of dollars spent by Warner Bros. to make, market and distribute the film outweighed the harm of losing control over “one tattoo” to Whitmill).

¹⁰ *Id.* at 9 (“I do think that the plaintiff has a strong likelihood of success on the merits, and will probably win the case at trial for money damages.”).

¹¹ *Id.* at 3.

¹² *Id.*

¹³ Matthew Belloni, “*Hangover*” Tattoo Lawsuit Settled, REUTERS, June 20, 2011, <http://www.>

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Thus, the issue of whether tattoos can be copyrighted remains unsettled and novel in the sense that no judicial decision has been rendered on the merits. Still, the *Whitmill v. Warner Bros.* case and similar suits seem to suggest that copyright protection could be extended to tattoos.

Consider another high-profile tattoo dispute between NBA star Rasheed Wallace and tattoo artist Matthew Reed. Reed alleged that Wallace, Nike, Inc. and its advertising agency committed copyright infringement when an advertisement featured a tattoo created by Reed.¹⁴ “[T]he advertisement . . . included a close up of the tattoo that filled the screen and then showed the tattoo being created by a computerized simulation with a voice-over from Rasheed Wallace describing and explaining the meaning behind the tattoo.”¹⁵ As in *Whitmill v. Warner Bros.*, the parties similarly settled the case privately.¹⁶ Such settlement could again suggest that tattoos are copyrightable.

If the prior scenarios do not keep studio executives, inked actors, athletes and other celebrities up at night, they may very well start to. Tattoos are prevalent in American society,¹⁷ and a lawsuit seems increasingly likely to be brought against tattoo-toting celebrities who are constantly in the public eye, have deep pockets and who stand to gain the most from their persona or look. While tattoos are *personal* and often represent memories, aspirations and milestones, it is unlikely that a tattoo artist will allow his subject or anyone else to benefit financially from such artwork.¹⁸ That is, of course, if they hold a valid copyright.

This note examines the threshold issue of whether tattoos are copyrightable and concludes that they fall within the plain language of the Copyright Act. While many argue that the Thirteenth Amendment and the Doctrine of Separability block such a conclusion, this note examines both issues and finds that neither will act as a bar. With that understanding, this note then examines ownership and whether the work-for-hire doctrine applies to a tattoo artist, as well as whether the

reuters.com/article/2011/06/21/us-hangover-idUSTRE75K0DF20110621.

¹⁴ Christopher A. Harkins, *Tattoos and Copyright Infringement: Celebrities, Marketers, and Businesses Beware of the Ink*, 10 LEWIS & CLARK L. REV. 313 (2006).

¹⁵ *Id.* at 316.

¹⁶ *Id.* at 318.

¹⁷ Press Release, Harris Interactive, Three in Ten Americans with a Tattoo Say Having One Makes Them Feel Sexier (Feb. 12, 2008) (“Currently, 14 percent of the population says they have a tattoo . . .”) (on file with author).

¹⁸ In *Whitmill v. Warner Bros.*, Whitmill took issue with the commercial use of his tattoo, arguing that Warner Bros. used it “to capitalize on the now-iconic image Mr. Whitmill created . . . and to provide a vivid image for a massive marketing campaign.” Plaintiff’s Reply Memorandum in Support of His Motion For Preliminary Injunction at 2, *Whitmill v. Warner Bros. Entm’t Inc.*, No. 4:11-CV-752 (E.D. Mo. May 23, 2011).

resulting tattoo design may be considered a joint work. After concluding that each would apply in only rare circumstances, this note reviews how an implied license nevertheless protects a tattoo holder from copyright infringement. By virtue of the unique nature of a tattoo, which is permanently affixed to and displayed on a person's skin, a tattoo holder has an implied license to use, display and exploit the tattoo. Thus, an implied license terminates some of the exclusive rights of the copyright holder, such as the ability to control how the work is displayed. Where the tattoo holder is a celebrity, the implied license likely covers appearances of tattoos in TV, film and advertisements.

While a tattoo artist may hold the copyright, he is not likely to experience a windfall payment from the celebrity or film company simply because the tattoo is shown.

I. A THRESHOLD ISSUE: TATTOOS ARE COPYRIGHTABLE WORKS OF ART UNDER THE PLAIN LANGUAGE OF THE COPYRIGHT ACT

The Copyright Act protects "original works of authorship" that are "fixed in any tangible medium of expression."¹⁹ A work of authorship includes "pictorial, graphic, and sculptural works."²⁰ To be original, the work need only possess "at least some minimal degree of creativity."²¹ Novelty is not a requirement.²² This relatively low standard of originality is likely to be met by most tattoo artists and may not raise any significant interpretive issues. In *Whitmill v. Warner Bros.*, for example, neither party raised the originality argument²³ even though the Tyson Tattoo was shown to be a "tribal" design that may be questionably unoriginal.²⁴

"A work is 'fixed' in a tangible medium . . . when . . . [it] is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."²⁵ Thus, a tattoo is likely to be copyrightable under the plain language of the statute where it is an original pictorial work, which is fixed in a tangible medium of expression such as the human body.²⁶

¹⁹ 17 U.S.C. § 102 (2006).

²⁰ *Id.* § 102(a)(5).

²¹ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

²² *Id.*

²³ See Complaint, *supra* note 2.

²⁴ Warner Bros.' silence on this issue may have indicated that it had no material dispute or simply could be a missed opportunity. The tribal design was not necessarily unique and could have been shown to be a design in the public domain. See *Tyson's Moko Draws Fire From Maori*, N.Z. HERALD, May 25, 2011, http://www.nzherald.co.nz/nz/news/article.cfm?c_id=1&objectid=10727836 (according to Professor Ngahuia Te Awekotuku, author of *Mau Moko: The World of Maori Tattoo*, "[t]he tattooist has an incredible arrogance to assume he has the intellectual right to claim the design form of an indigenous culture that is not his.").

²⁵ 17 U.S.C. § 101 (2006).

²⁶ See Timothy C. Bradley, *The Copyright Implications of Tattoos*, 29 ENT. & SPORTS LAW. 1, 27

A. *The Thirteenth Amendment: Control By Tattoo and Involuntary Servitude*

A common argument against the copyrightability of tattoos is that such a holding would lead to unintended consequences under the Copyright Act, which confers a number of exclusive rights to the copyright owner.²⁷ These privileges include the exclusive right to display, reproduce, copy and make derivative works.²⁸ By virtue of this, an individual holding the copyright over a tattoo design could conceivably dictate how the tattoo holder acts. For example, a tattoo holder who is not authorized to display the copyrighted tattoo may be restricted from appearing in a magazine or newspaper. Similarly, he could be stopped from appearing on television and in films because the unauthorized display of the copyrighted design is deemed to be infringement.²⁹ With regard to Tyson and other tattooed celebrities, these situations would significantly impede their ability to be shown on television, promote their image and make a living.

The result is *control by tattoo*, which some believe amounts to *involuntary servitude* or a form of ownership in the body of another. Since both outcomes are prohibited under the Thirteenth Amendment, it is argued that Congress could not have intended for tattoos to be copyrightable.³⁰ While the statutory rights that vest in a copyright holder raise elements of “control” and even create suspicion under the Thirteenth Amendment or similar federal statute, the actual enforcement of such rights does not amount to “slavery” or “involuntary servitude.”

1. Section 1 of the Thirteenth Amendment

The first section of the Thirteenth amendment provides that “[n]either slavery nor involuntary servitude, except as a punishment for crime whereof the party shall have been duly convicted, shall exist within the United States, or any place subject to their jurisdiction.”³¹ This section affirmatively abolishes slavery in the United States as it

(2011).

²⁷ See Declaration of David Nimmer at 4–5, *Whitmill v. Warner Bros. Entm’t Inc.*, No. 4:11-CV-752 (E.D. Mo. May 20, 2011).

²⁸ See 17 U.S.C. § 106 (2006). It is unlikely that 17 U.S.C. § 106A would extend to tattoos since the provision covers a very narrow class of works. See Nathan M. Davis, *As Good As New: Conserving Artwork and the Destruction of Moral Rights*, 29 CARDOZO ARTS & ENT. L.J. 215, 223 (2011) (discussing the limited confines of 17 U.S.C. § 106A).

²⁹ See Declaration of David Nimmer, *supra* note 27, at 6.

³⁰ See Plaintiff’s Reply Memorandum in Support of His Motion For Preliminary Injunction, *supra* note 18, at 13. See also Declaration of David Nimmer, *supra* note 27, at 7 (“[H]uman flesh cannot serve as the ‘medium of expression’ that Congress intended to embody legally protectable authorship.”).

³¹ U.S. CONST. amend. XIII, § 1.

existed at the time of the Civil War,³² and also seeks to stamp out anything that could resemble ownership of human beings. The phrase “involuntary servitude,” while creating a broader category of prohibited conduct, has confounded many as to “the exact range of conditions it prohibits.”³³ The Supreme Court has interpreted it as extending to “those forms of compulsory labor akin to African slavery which in practical operation would tend to produce like undesirable results.”³⁴ This definition provides little help in understanding the scope of involuntary servitude. Justice Brennan pointed to several useful factors that are “the hallmarks” of slavery and that could constitute servitude. These factors include “complete domination over all aspects of the victim’s life, oppressive working and living conditions, and lack of pay or personal freedom.”³⁵

Various Supreme Court decisions are also useful in determining the boundaries of involuntary servitude. The Court has held that involuntary servitude exists in instances where the victim has had no choice but to work or face legal sanctions.³⁶ Additionally, the Court has invalidated state laws subjecting debtors to legal sanctions for failing to perform labor after receiving an advance payment.³⁷ These “precedents clearly define a Thirteenth Amendment prohibition of involuntary servitude enforced by the use or threatened use of physical or legal coercion.”³⁸ In some instances, psychological coercion may even give rise to a finding of involuntary servitude.³⁹

In application, lower courts have been reluctant to prohibit all forms of compulsory labor, and some have implemented a balancing test.⁴⁰ The Second Circuit held “[t]he Thirteenth Amendment does not bar labor that an individual may, at least in some sense, choose not to perform, even where the consequences of that choice are ‘exceedingly bad.’”⁴¹ In *Immediato v. Rye Neck School District*,⁴² the court held that

³² *United States v. Kozminski*, 487 U.S. 931, 942 (1988) (stating that the primary purpose of the Thirteenth Amendment was “to abolish the institution of African slavery as it had existed in the United States at the time of the Civil War.”).

³³ *See Id.* (“While the general spirit of the phrase ‘involuntary servitude’ is easily comprehended, the exact range of conditions it prohibits is harder to define.”).

³⁴ *Id.* (citing *Butler v. Perry*, 240 U.S. 328, 332 (1916)).

³⁵ *Id.* at 962–63 (Brennan, J., concurring).

³⁶ *See United States v. Reynolds*, 235 U.S. 133 (1914); *Clyatt v. United States*, 197 U.S. 207 (1905).

³⁷ *See Pollock v. Williams*, 322 U.S. 4 (1944); *Taylor v. Georgia*, 315 U.S. 25 (1942); *Bailey v. Alabama*, 219 U.S. 219 (1911).

³⁸ *Kozminski*, 487 U.S. at 944.

³⁹ *Id.*

⁴⁰ *See Lauren Kares, The Unlucky Thirteenth: A Constitutional Amendment in Search of A Doctrine*, 80 CORNELL L. REV. 372, 394 (1995) (“Several courts have implemented balancing tests to determine whether specific servitudes should be actionable. These tests vary in methodology, but most take into account the identity of the plaintiff and the nature of the service rendered.”).

⁴¹ *See Immediato v. Rye Neck Sch. Dist.*, 73 F.3d 454, 459 (2d Cir. 1996) (mandatory

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a student could be required to do community service before graduating. The court reasoned that the work was not severe given that the required forty hours of community service could be completed over four years.⁴³ Further, students were able to choose the time, place and manner in which to complete the community service.⁴⁴ Lastly, the court noted that students unwilling to comply had the option to transfer schools or be home-schooled.⁴⁵ The court held that “[w]hile these choices may be economically or psychologically painful, choices they are, nonetheless.”⁴⁶ Thus, the court took into account the nature of the work, the relative freedom to prescribe how and when the work is completed and choice.

It is theoretically true that an individual holding the copyright over a tattoo design would possess statutory rights that enable him to control how the work is used, thereby indirectly controlling his subject. However, it is extreme to conclude that this relationship resembles ownership of a human being consistent with slavery at the time of the Civil War. The copyright holder of a tattoo design owns just that—the copyright in a tattoo design. It seems extreme to suggest that he has a property or ownership interest *in the body* of the individual bearing his tattoo design on technical or theoretical grounds under the Copyright Act. As stated by Judge Catherine Perry addressing the merits of Whitmill’s copyright claim:

[The tattoo artist is] not copyrighting Mr. Tyson’s face, or restricting Mr. Tyson’s use of his own face, as [Warner Bros.] argues, or saying that someone who has a tattoo can’t remove the tattoo or change it, but the tattoo itself and the design itself can be copyrighted, and I think it’s entirely consistent with the copyright law⁴⁷

Thus, the relationship is more appropriately reviewed under the phrase “involuntary servitude.” Yet, the type of control previously described similarly does not fit within the Supreme Court’s definition of “involuntary servitude” under the Thirteenth Amendment. A tattoo holder is never under any affirmative *compulsion to perform labor* in the traditional or broadly interpreted meaning.⁴⁸ While a tattoo holder

community service program at school is not involuntary servitude). *See also* *Watson v. Graves*, 909 F.2d 1549, 1552 (5th Cir. 1990) (“When the employee has a choice, even though it is a painful one, there is no involuntary servitude.”).

⁴² 73 F.3d 454 (2d Cir. 1996).

⁴³ *Id.* at 460.

⁴⁴ *Id.*

⁴⁵ *Id.*

⁴⁶ *Id.*

⁴⁷ Transcript of Hearing on Motion for Preliminary Injunction, *supra* note 1, at 3.

⁴⁸ “Labor” is defined as “work of any type, including mental exertion. The term usually refers to work for wages as opposed to profits.” BLACK’S LAW DICTIONARY 405 (3d Pocket ed. 2006). While “labor” can be narrowly construed to its formal definition, this note also presumes labor to

might be faced with the decision to either obey the statutory schema or face an infringement lawsuit, such ultimatums are ubiquitous in our everyday life. In fact, the threat of a lawsuit does not render an action compulsory however “economically or psychologically painful” it may be.⁴⁹ Further, a tattoo holder retains the ability to move freely during his life. While he may be restricted from displaying the copyrighted design in various mediums, such as films, the tattoo holder is always given a choice. He can simply cover up the tattoo design or appear in a way that does not show the tattoo. The element of choice is ever-present, and the individual’s liberty is never truly restricted. Lastly, it is important to keep in mind that an individual voluntarily chooses to get a tattoo. A tattoo artist neither physically nor legally coerces him, thereby negating the “involuntary” component.

It is unsettling to think that a copyright holder could dictate how another person may display the tattoo on *his* body. Nevertheless, this scenario does not amount to *involuntary servitude* under the Thirteenth Amendment. Consequently, tattoos remain copyrightable.

2. Section 2 of the Thirteenth Amendment

Where Section 1 prohibits conduct deemed to be slavery or within the scope of involuntary servitude, Section 2 provides Congress with wide authority to enforce the Thirteenth Amendment through appropriate legislation.⁵⁰ Although this power has expanded and contracted throughout history,⁵¹ the Supreme Court has firmly stated that Congress surely “has the power under the Thirteenth Amendment rationally to determine what are the badges and the incidents of slavery, and the authority to translate that determination into effective legislation.”⁵²

Thus, it is evident that Congress has the ability to regulate conduct that it perceives to be a badge of slavery. Private individuals, however, “cannot challenge actions that they believe are badges of slavery in the absence of specific congressional authorization.”⁵³ The Court’s stance highlights its belief that Congress, and not the judicial system, is the appropriate body to interpret the bounds of the Thirteenth Amendment.⁵⁴ To date, Congress has been silent about whether tattoos

mean any type of activity, thus reading “involuntary servitude” very broadly. In this sense, the question becomes whether the copyright owner can effectuate a compulsion to do anything.

⁴⁹ *Immediato*, 73 F.3d at 460.

⁵⁰ U.S. CONST. amend. XIII, § 2.

⁵¹ See generally Alexander Tsesis, *Interpreting the Thirteenth Amendment*, 11 U. PA. J. CONST. L. 1337, 1362 (2009).

⁵² *Jones v. Alfred H. Mayer Co.*, 88 S.Ct. 2186, 2203–04 (1968).

⁵³ Lauren Kares, *The Unlucky Thirteenth: A Constitutional Amendment in Search of A Doctrine*, 80 CORNELL L. REV. 372, 380 (1995).

⁵⁴ *Id.*

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constitute a badge of slavery with respect to the Copyright Act. In fact, its silence may indicate a belief that the Copyright Act, which protects tattoos, is entirely consistent with the Thirteenth Amendment. Therefore, Section 2 similarly does not invalidate the copyrightability of tattoos—at least until Congress determines that it does.

While still troubling, fear not. In the context of tattoos, the ability of a copyright owner to effectuate *control* through his statutory rights is rendered ineffective by an implied license. As discussed below in Section III, a tattoo holder possesses an implied license that enables him to use the tattoo during the normal course of life. This license undermines the *control by tattoo* argument and removes any barriers regarding whether a human canvas is an appropriate medium of expression under the Copyright Act.

B. A Tattoo is Conceptually Separate from the Body

“Separability” is another argument alleged by opponents to preclude a tattoo from being copyrighted. The separability argument is two-fold. First, it is rooted in the idea that the human body is a “useful article,” as defined in the Copyright Act.⁵⁵ A useful article is one that has “an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”⁵⁶ For example, a chair that is creatively sculpted also functions as a piece of furniture to sit on, and is therefore a “useful article.” In this light, a person with a tattoo can be considered a useful article because the individual is not functioning “merely to portray” the tattoo.⁵⁷ People are not simply canvases, but rather exist for other reasons.

The second part of the separability argument is that “[t]he ‘useful article’ definition limits the scope of copyright protection” in accordance with the definition of pictorial, graphic, and sculptural works.⁵⁸ The latter is defined in the Copyright Act as:

[I]nclud[ing] 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. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be

⁵⁵ See 17 U.S.C. § 101 (2011).

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ Warner Bros.’ Memorandum in Opposition to Plaintiff’s Motion for Preliminary Injunction at 16, *Whitmill v. Warner Bros. Entm’t Inc.*, No. 4:11-CV-752 (E.D. Mo. May 23, 2011).

identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.⁵⁹

Thus, opponents argue that in order for a tattoo to gain protection under the Copyright Act as a pictorial work, the “separability” requirement (italicized above) must be met. The courts have analyzed separability along two lines. In *Chosun International, Inc. v. Chrisha Creations, Ltd.*,⁶⁰ the court held that where “a useful article incorporates a design element that is *physically* or *conceptually* separable from the underlying product, the element is eligible for copyright protection.”⁶¹ Therefore, the separability requirement may be satisfied either through physical or conceptual separation.

Physical separability occurs when the design element “of a useful article can actually be removed from the original item and separately sold, without adversely impacting the article’s functionality.”⁶² Today, tattoos are commonly removed through laser technology.⁶³ While the procedure does not adversely impact the body’s functionality, it effectively destroys the tattoo, making it incapable of existing independently from the body.⁶⁴ For these reasons, it is argued that tattoos fail to satisfy the physical separability test and are not entitled to protection under the Copyright Act.

Remaining, however, is the issue of whether a tattoo is conceptually separable from the body. Despite its abstractness, several courts have recognized and applied a conceptual analysis.⁶⁵

⁵⁹ 17 U.S.C. § 101 (2011) (emphasis added) (defining “[p]ictorial, graphic, and sculptural works”).

⁶⁰ 413 F.3d 324 (2d Cir. 2005).

⁶¹ *Id.* at 328 (emphasis added).

⁶² *Chosun*, 413 F.3d at 329.

⁶³ Natasha Singer, *Erasing Tattoos, Out of Regret or Simply to Get a Fresh Canvas*, N.Y. TIMES, June 17, 2007.

⁶⁴ *Id.* (“Devices called Q-switched lasers are used to shatter tattoo pigment into particles that are cleared by the body’s lymphatic system. Full removal takes an average of eight treatments, spaced at least a month apart, using different Q-switched lasers for different-colored inks, said Dr. Suzanne Kilmer, a dermatologist and laser researcher in Sacramento.”).

⁶⁵ See generally *Chosun, Ltd.*, 413 F.3d at 330 (applying conceptual separability analysis to plush animal themed Halloween costumes and holding that the design elements may “invoke in the viewer a concept separate from that of the costume’s ‘clothing’ function, and that their addition to the costume was not motivated by a desire to enhance the costume’s functionality.”); *Galiano v. Harrah’s Operating Co.*, 416 F.3d 411, 422 (5th Cir. 2005) (applying conceptual separability to casino uniforms and noting the test is whether the design element is “marketable independently of their utilitarian function as casino uniforms.”); *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 932 (7th Cir. 2004) (applying conceptual separability analysis to a mannequin and holding that “because [the mannequin] was the product of a creative process unfettered by functional concerns, its sculptural features ‘can be identified separately from, and are capable of existing independently of,’ its utilitarian aspects. It therefore meets the requirements for conceptual separability and is subject to copyright protection.”); *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987); *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985) (applying conceptual separability to mannequins and holding “that since the aesthetic and artistic features of the . . . forms are inseparable from the forms’ use

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Accordingly, conceptual separability exists when:

[T]he artistic aspects of an article can be “conceptualized as existing independently of their utilitarian function.” This independence is necessarily informed by “whether the design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.” If the elements do reflect the independent, artistic judgment of the designer, conceptual separability exists. Conversely, when the design of a useful article is “as much the result of utilitarian pressures as aesthetic choices,” the useful and aesthetic elements are not conceptually separable.⁶⁶

A tattoo arguably satisfies this test, which more or less requires the artistic aspect to be primary over utility. A tattoo is artwork created independent and separate from the function of a person’s body. Thus, it is conceptually separate.

In *Kieselstein-Cord v. Accessories by Pearl, Inc.*,⁶⁷ a designer created and sold unique decorative belt buckles, which were occasionally “worn around the neck or elsewhere on the body rather than around the waist.”⁶⁸ Finding commercial success in this endeavor, the designer sought to enforce his copyright of the belt buckles in order to stop others from manufacturing and selling cheaper replicas.⁶⁹ The designer’s copyright was contested on the grounds that the belt buckles were useful articles, and thus, the decorative or artistic elements were conceptually inseparable from the belt buckles’ utilitarian function.⁷⁰

The court held that the designer’s belt buckles could be copyrighted upon finding that their principal use was for ornamentation of the body.⁷¹ Such ornamental use was found to be conceptually separable from the belt buckle’s utilitarian function given that “the buckles’ wearers . . . have used them as ornamentation for parts of the body other than the waist.”⁷² Thus, since the designer’s “ornate belt buckles . . . could be and were worn separately as jewelry”, they were conceptually separate and copyrightable.⁷³

Several years later, in *Carol Barnhart Inc. v. Economy Cover*

as utilitarian articles the forms are not copyrightable.”); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (applying conceptual separability analysis to belt buckles and holding that “[t]he primary ornamental aspect of the . . . buckles is conceptually separable from their subsidiary utilitarian function.”).

⁶⁶ *Pivot Point Int’l*, 372 F.3d at 931 (citations omitted).

⁶⁷ 632 F.2d 989 (2d Cir. 1980).

⁶⁸ *Id.* at 991.

⁶⁹ *Id.*

⁷⁰ *Id.* at 993.

⁷¹ *Id.* at 993–94.

⁷² *Id.* at 993.

⁷³ *Brandir*, 834 F.2d at 1144.

Corp.,⁷⁴ the Second Circuit held that the artistic components of a mannequin were inseparable from its utilitarian function.⁷⁵ In *Barnhart*, the seller of department store displays created two male and two female mannequins.⁷⁶ The mannequin designs resembled a human torso, without the features of a neck, back or arms.⁷⁷ Subsequently, the mannequin designs were copied, giving rise to a suit for copyright infringement.

Since the mannequins were deemed to be “useful articles,” the court analyzed “whether they possess artistic or aesthetic features that are physically or conceptually separable from their utilitarian dimension.”⁷⁸ With respect to conceptual separability, the court found that the mannequin’s utilitarian function, the display of clothing, was “inextricably intertwined” with its aesthetic or artistic features, the configuration of the torso.⁷⁹ Accordingly, the court held that the mannequins were not copyrightable.⁸⁰ In distinguishing *Barnhart* from *Kieselstein-Cord*, the court opined that “[w]hereas a model of a human torso, in order to serve its utilitarian function, must have some configuration of the chest and some width of shoulders, a belt buckle can serve its function satisfactorily without any ornamentation of the type that renders the *Kieselstein-Cord* buckles distinctive.”⁸¹

Soon after, in *Brandir International, Inc. v. Cascade Paific Lumber Co.*,⁸² the Second Circuit held that the artistic component of a bicycle rack did not meet the requirements for conceptual separability.⁸³ In *Brandir*, the manufacturer of a bicycle rack brought a copyright infringement claim against a competitor in order to stop it from producing a similar rack.⁸⁴ The bicycle rack at issue was made from bent metal tubing and allegedly originated from a wire sculpture.⁸⁵ The rack allowed bicycles and similar instruments to be parked under or on top of the “overloops.”⁸⁶ The manufacturer’s copyright was again contested on the grounds that the bicycle rack served a utilitarian function and that the design element was not conceptually separable.⁸⁷

In determining whether the bicycle rack was conceptually separate,

⁷⁴ 773 F.2d 411 (2d Cir. 1985).

⁷⁵ *Id.* at 418–19.

⁷⁶ *Id.* at 412.

⁷⁷ *Id.*

⁷⁸ *Id.* at 414.

⁷⁹ *Id.* at 419.

⁸⁰ *Id.* at 418–19.

⁸¹ *Id.* at 419.

⁸² 834 F.2d 1142 (2d Cir. 1987).

⁸³ *Id.* at 1147–48.

⁸⁴ *See id.* at 1146.

⁸⁵ *Id.* at 1143.

⁸⁶ *Id.* at 1146.

⁸⁷ *Id.*

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the court applied a similar test to that used in *Kieselstein-Cord* and by other circuits.⁸⁸ Accordingly, the court reviewed whether the “design elements reflect a merger of aesthetic and functional considerations” or if they “can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences.”⁸⁹ A finding of the former would mean that the work is not conceptually separable and thus not copyrightable.⁹⁰

In holding that conceptual separability did not exist in the bicycle rack, the court opined that the rack “remain[ed] [a] product of industrial design” despite its aesthetically pleasing nature.⁹¹ The court further found that both “[f]orm and function [were] inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices.”⁹² Since the bicycle rack was primarily designed to adhere to the optimal function of parking bikes, it was not copyrightable.

Like *Kieselstein-Cord*, where the buckles were found to be ornamentation of the body given their use in places other than the waist, a tattoo is similarly ornamentation of the body since it does not contribute to a person’s function. A tattoo is simply art, and the design on a person’s skin resembles the ornate lines found on the belt buckles. Rarely, if ever, is a tattoo created with preconceived notions of improving or altering the body’s utility. Its purpose and meaning, either to the holder or tattoo artist, exists entirely separate from the body.⁹³ A tattoo is therefore unlike the mannequin in *Barnhart* or bicycle rack in *Brandir*, which, although aesthetic in appearance, was designed with the aim of being functional. As mentioned, a tattoo is not inked onto a person’s body with the intention that it will improve the utilitarian function of that body. For example, the Tyson Tattoo does not make Tyson see better because it is located around his eye. Nor does the tattoo increase his IQ because it is on his head. Similarly, a tattoo inked on a person’s arm would not make the arm function any differently. It would not allow the person to lift more weight, write better or throw a baseball more effectively.

Absent from the prior conceptual analysis is the idea of marketability expressed by the Fifth Circuit.⁹⁴ Nevertheless, a tattoo

⁸⁸ *Id.* at 1143–45

⁸⁹ *Id.* at 1145.

⁹⁰ *See id.*

⁹¹ *Id.* at 1147.

⁹² *Id.*

⁹³ It is remotely foreseeable that a person would solicit a tattoo over his eyelids to more effectively block out the light. In that case, perhaps it could be argued that the tattoo, regardless of how artistic it is, was created with the purpose of improving the body’s functionality. This is an example of conceptual and physical inseparability that is not protected by copyright law.

⁹⁴ *See Watson v. Graves*, 909 F.2d 1549 (5th Cir. 1990).

also satisfies this test. It is apparent that a tattoo design may be sold independently from the person's body it is affixed to. For example, the Tyson Tattoo can easily be sold and reproduced onto another person's body without regard to Mike Tyson's functionality.

Taking one step back, it is possible that the separability analysis does not apply to tattoos because it is questionable as to whether Congress intended the human body to be considered a "useful article" in the first place.⁹⁵ Courts that have applied the separability analysis have done so to "industrial" works like clothing, mannequins and jewelry. Nevertheless, should a court decide to analyze tattoos on the human body as "useful articles" under the Copyright Act, it is clear that the artwork is conceptually separate from the body—or article.

Despite the various assertions made by critics, a court is likely to find that tattoos are protected under the plain language of the Copyright Act. A tattoo is a "pictorial work" that, if found to be "original" as defined by the courts, will be afforded protection when affixed to the "tangible medium" of a human body.⁹⁶

II. AND THE COPYRIGHT GOES TO . . .

With an understanding that tattoos are likely copyrightable, this note now examines various issues pertaining to ownership. Ownership is paramount, as no claim for copyright infringement will lie, unless a plaintiff first establishes a valid copyright.⁹⁷ The Copyright Act provides that the "copyright in a work . . . vests initially in the author or authors of the work."⁹⁸ In *Community for Creative Non-Violence v. Reid*,⁹⁹ the Supreme Court held that "[a]s a general rule, the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection."¹⁰⁰ Therefore, a tattoo artist who inks an original tattoo onto another person's body is presumed to be the copyright holder of the resulting work. While ownership over a copyright is often straightforward, the Copyright Act carves out a few exceptions which allow ownership to be challenged in a number of ways. One method is to assert that the work was made for hire. Another is to assert that the

⁹⁵ See Plaintiff's Reply Memorandum in Support of His Motion For Preliminary Injunction, *supra* note 18, at 5 ("as the Copyright Office's Factsheet SL 103 explains, examples of useful articles 'are clothing; automobile bodies; furniture; machinery, including household appliances; dinnerware; and lighting fixtures.' Missing from these examples, of course, are human body parts.").

⁹⁶ See 17 U.S.C. § 102 (2011); *supra* note 26.

⁹⁷ See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) ("To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.").

⁹⁸ 17 U.S.C. § 201(a) (2011).

⁹⁹ 490 U.S. 730 (1989).

¹⁰⁰ *Id.* at 737.

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work was jointly created. If the tattoo holder can assert complete or partial ownership over the tattoo design, then he would not be deemed an infringer.

A. Works Made for Hire

Where a work is made for hire, the hiring party “for whom the work was prepared is considered the author . . . and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.”¹⁰¹ Such rights would persist in the hiring party for ninety-five years from the first publication or 120 years from creation, whichever expired first.¹⁰²

The Copyright Act defines a “work made for hire” as either “a work prepared by an employee within the scope of his or her employment” or “a work specially ordered or commissioned for use” in any one of ten “specially ordered or commissioned for use” categories.¹⁰³ It further requires that the parties expressly agree to a work-made-for-hire in a signed writing.¹⁰⁴ A tattoo does not appear to fall within any of the ten categories enumerated under the Copyright Act, and therefore, should be analyzed against the standard of employment.

In *Community for Creative Non-Violence v. Reid*,¹⁰⁵ a non-profit organization contracted with a sculptor to create a statue that would “dramatize the plight of the homeless.”¹⁰⁶ The statue was to portray a homeless family on top of a steam grate, and it was to be displayed during Christmas.¹⁰⁷ The non-profit agreed to pay the sculptor \$15,000 for the statue.¹⁰⁸

The sculptor and non-profit organization discussed the artistic components of the statue on several occasions, but never discussed ownership.¹⁰⁹ The sculptor made sketches of the statue, which the non-profit organization was to either approve or use as promotional material for the display.¹¹⁰ In some instances, representatives of the non-profit organization requested changes and made suggestions pertaining to the statue design.¹¹¹ Eventually, the statue was created based on the specifications of the non-profit and was displayed. Ultimately, disagreements about further use of the statue arose, and the parties filed

¹⁰¹ See 17 U.S.C. § 201(b) (2006).

¹⁰² *Id.* § 302(c).

¹⁰³ *Id.* § 101 (defining “work made for hire”).

¹⁰⁴ *Id.*

¹⁰⁵ 490 U.S. 730 (1989).

¹⁰⁶ *Id.* at 733.

¹⁰⁷ *Id.* at 733.

¹⁰⁸ *Id.* at 735.

¹⁰⁹ *Id.* at 734.

¹¹⁰ *Id.*

¹¹¹ *Id.*

competing claims for the copyright over the statue.¹¹²

In determining whether the statue was a work for hire, the Supreme Court held that “a court first should ascertain, using principles of general common law of agency, whether the work was prepared by an employee or an independent contractor.”¹¹³ A finding of the former leads to the conclusion that the work was made for hire.¹¹⁴ A finding of the latter would require that the work fit into one of the ten “specially ordered or commissioned for use” categories.¹¹⁵ While no one factor is determinative of whether a hired party is an employee, the Court considered the following factors:

[T]he hiring party’s right to control the manner and means by which the product is accomplished[;] . . . the skill required; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired party; the extent of the hired party’s discretion over when and how long to work; the method of payment; the hired party’s role in hiring and paying assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hired party.¹¹⁶

Applying the before mentioned factors, the Court held that the sculptor was an independent contractor.¹¹⁷ Although the non-profit organization exercised control over the specifications of the statue, other factors “weigh[ed] heavily against finding an employment relationship.”¹¹⁸ For example, the sculptor was involved in a skilled occupation, supplied his own tools, was retained for a short period of time, and the non-profit “had no right to assign additional projects” to him.¹¹⁹ Further, the non-profit organization paid the sculptor “a sum dependent on ‘completion of a specific job, a method by which independent contractors are often compensated.’”¹²⁰ Based on the Court’s finding that the sculptor was an independent contractor, and the fact that the statue was not in one of the ten “specially ordered or commissioned for use” categories, it held that ownership vested in the sculptor.¹²¹

Like the sculptor in *Community for Creative Non-Violence*, it

¹¹² *Id.* at 735.

¹¹³ *Id.* at 751.

¹¹⁴ *Id.* at 750–53.

¹¹⁵ *Id.*

¹¹⁶ *Id.* at 751–52.

¹¹⁷ *Id.* at 752–53.

¹¹⁸ *Id.* at 752.

¹¹⁹ *Id.* at 753.

¹²⁰ *Id.* (citation omitted).

¹²¹ *Id.*

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appears that a tattoo artist is also an independent contractor. Similar to sculpting, tattooing is a skilled occupation. In addition, a tattoo artist typically owns the tools used to ink the design. While a person seeking a tattoo does exercise some control, it resembles that which the non-profit organization exercised over the sculptor—namely, to ensure that the tattoo met certain visual specifications. A person seeking a tattoo usually instructs the tattoo artist on the type of design he is looking for, leaving it up to the tattoo artist to create it on his body. Further, the typical tattoo transaction is short and involves the payment of a fee much like the fee paid to the sculptor.

Other factors also seem to support the conclusion that a tattoo artist is an independent contractor. For example, the work of a tattoo artist is oftentimes not part of the regular business of the hiring party. Indeed, it is difficult to imagine that a tattoo artist could ever be an employee of his customer. The dynamic in a tattoo transaction resembles other common retail transactions, such as getting a haircut. In no respect would we consider the barber an employee of his customer simply because he dictates how his hair should be cut.

Combined, these factors may lead a court to decide that a tattoo artist is not an employee. Nevertheless, a court's analysis would be fact-specific, and depending on the unique circumstances of a tattoo transaction, it is possible that a court could find the existence of an employee relationship. Even assuming that a court determines that a tattoo artist is an independent contractor, it is unlikely that a tattoo falls under one of the ten "specially ordered or commissioned for use" categories. As such, the resulting tattoo would not be considered a work made for hire, and ownership over the copyright would vest in the tattoo artist.

While a tattoo may not be considered a work made for hire, it is always possible to have the tattoo artist transfer his rights.¹²² A transfer is only valid when it is memorialized in a signed writing.¹²³ The writing need not contain specific language so long as it signifies "an agreement to transfer copyright."¹²⁴ Additionally, the writing may be completed after the transfer occurs.¹²⁵ Such writing is important as it guarantees that the copyright was not transferred accidentally.¹²⁶ It also clarifies

¹²² See 17 U.S.C. § 201(d) (2006). See also *id.* § 101 (defining transfer of copyright ownership as "an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect, but not including a nonexclusive license.").

¹²³ See *id.* § 204(a). See also *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1235 (11th Cir. 2010) ("The Copyright Act requires a writing for all exclusive transfers of copyright.").

¹²⁴ *Lyrick Studios, Inc. v. Big Idea Prods., Inc.*, 420 F.3d 388, 392 (5th Cir. 2005).

¹²⁵ *Id.*

¹²⁶ *Id.*

what rights are being transferred.¹²⁷

Thus, a person seeking a tattoo may still obtain rights over the copyright through transfer. Celebrities and athletes should seriously consider this option if they want to avoid potential and costly lawsuits.

B. Joint Authorship

Where classification as a work for hire is not available, a tattoo holder may instead assert joint authorship over a work. The Copyright Act defines a “joint work” as one that is “prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”¹²⁸ A part of a unitary whole is inseparable when it has “little or no independent meaning standing alone.”¹²⁹ On the other hand, such parts “are ‘interdependent’ when they have some meaning standing alone but achieve their primary significance because of their combined effect.”¹³⁰ To illustrate these differences, the legislative committee provided the examples of a novel to describe the former, and a song to represent the latter.¹³¹

The statute also requires that joint authors possess “the intention that their contributions be merged.”¹³² Although it appears that Congress is primarily concerned with the authors’ “state of mind regarding the unitary nature of the finished work”, such interpretation would result in joint authorships that Congress likely never intended.¹³³ For example, a person who edits the work of a writer frequently makes alterations and suggestions. While both the editor and the writer intended for those edits to be merged into the finished writing, neither would consider the editor a joint author. Another example often cited is the contributions of a research assistant to an author’s work. While the research assistant provides the author with additional materials that may alone be considered copyrightable, the final product is not intended to be a joint work. The primary distinction then is “the lack of intent of both participants in the venture to regard themselves as joint authors.”¹³⁴ Therefore, a helpful inquiry is whether “each participant intended that all would be identified as co-authors” at the time the writing was done.¹³⁵

¹²⁷ *Id.*

¹²⁸ *See* 17 U.S.C. § 101.

¹²⁹ *Childress v. Taylor*, 945 F.2d 500, 505 (2d Cir. 1991).

¹³⁰ *Id.*

¹³¹ *Id.* (citing H.R. REP. NO. 94-1476, at 120 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5736; S. REP. NO. 94-473, at 103-04 (1975)).

¹³² 17 U.S.C. § 101.

¹³³ *Childress*, 945 F.2d at 507.

¹³⁴ *Id.*

¹³⁵ *Id.* at 508.

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Further complicating the intent analysis are the committee reports, which provide that “a work is ‘joint’ if the authors collaborated with each other.”¹³⁶ As such, Congress appears to incorporate collaboration between the authors as an alternative standard. In doing so, a person seeking to establish joint authorship seemingly does not need to show intent, only that he collaborated on the work. Nevertheless, courts typically read the statutory language literally and apply the requirement of intent to every work of joint authorship.¹³⁷

The issue that has created the most contention among the courts and various academics is whether each author must make “an independently copyrightable contribution” for joint authorship to exist.¹³⁸ Professor Nimmer, an expert on copyright law, concluded that no such requirement exists in the language of the Copyright Act. Nimmer opined that “copyright’s goal of fostering creativity is best served . . . by rewarding all parties who labor together to unite idea with form, and that copyright protection should extend both to the contributor of the skeletal ideas and the contributor who fleshes out the project.”¹³⁹ In his view, where each author’s contribution is “more than *de minimis*”, joint authorship can exist regardless of the copyrightability of the individual contributions.¹⁴⁰

A majority of courts have soundly rejected Professor Nimmer’s view¹⁴¹ and have required that each author’s contribution be independently copyrightable. In *Erickson v. Trinity Theatre, Inc.*,¹⁴² a playwright sought to enjoin a theatre company from performing several of the plays that she wrote. The theatre company and its actors challenged the playwright’s copyright by asserting joint authorship over

¹³⁶ *Id.* at 505 (citing H.R. REP. NO. 94-1476, at 120 (1976) and S. REP. NO. 94-473, at 103 (1975)).

¹³⁷ *Id.* at 505–06. See also *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1068 (7th Cir. 1994) (“[I]t is important to note, at the outset, that the statute itself requires that there be an intent to create a joint work.”).

¹³⁸ 1-6 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 6.07 (Matthew Bender & Co. eds., 2011) (“The most contentious issue in this domain revolves around whether A and B must each contribute material that, standing alone, would be separately copyrightable in order to style them joint authors.”).

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ See *Richlin v. Metro-Goldwyn-Mayer Pictures, Inc.*, 531 F.3d 962, 968 (9th Cir. 2008). See also *Erickson*, 13 F.3d at 1071 (“We agree that the language of the Act supports the adoption of a copyrightability requirement.”); *Childress*, 945 F.2d at 507 (“Nevertheless, we are persuaded to side with the position taken by the case law and endorsed by the agency administering the Copyright Act.”); *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 521 (9th Cir. 1990) (“Even though this issue is not completely settled in the case law, our circuit holds that joint authorship requires each author to make an independently copyrightable contribution.”); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1493 (11th Cir. 1990) (“His ideas, conveyed to the author of the copyrighted work . . . were not copyrightable.”).

¹⁴² 13 F.3d 1061.

the works.¹⁴³

The actors argued that they provided the playwright with ideas for dialogue, and that such collaboration formed a joint work.¹⁴⁴ The court held that in order to establish a joint work, the actors must show that “the parties intended to be joint authors at the time the work was created,” and that their “contributions to the works were independently copyrightable.”¹⁴⁵

With respect to two of the plays, the court found that the actors’ suggestions did not make them joint authors because the intent requirement was not met.¹⁴⁶ The court determined that the playwright, and not the actors, had the final word on what was included in the script.¹⁴⁷ Additionally, the playwright had a licensing agreement with the theatre to perform the plays.¹⁴⁸ Combined, these facts suggested that both the actors and the playwright did not intend to be joint authors.

Conversely, the court did find the requisite intent with respect to the third play, given that the playwright attributed the script to herself and another actor.¹⁴⁹ The court acknowledged that “billing” or “credit” may be evidence of intent.¹⁵⁰ Nevertheless, the court ultimately found that a joint work did not exist because the actors’ contributions, with respect to all of the plays, were not independently copyrightable.¹⁵¹ The court held that “[i]deas, refinements, and suggestions, standing alone, are not the subjects of copyrights.”¹⁵²

In *Childress v. Taylor*,¹⁵³ an actress approached a playwright about writing a script based on an off-Broadway production.¹⁵⁴ To facilitate the writing, the playwright accepted the assistance of the actress, which consisted primarily of research.¹⁵⁵ In addition to providing research, the actress made several suggestions relating to the subject of the play.¹⁵⁶ She also spoke to the playwright on a “regular basis about the progress of the play.”¹⁵⁷ Eventually a dispute arose about ownership over the copyright.

In examining joint work, the court reviewed whether the parties intended to be joint authors. The court concluded that the actress’

¹⁴³ *Id.* at 1064–65.

¹⁴⁴ *Id.* at 1071–72.

¹⁴⁵ *Id.* at 1071.

¹⁴⁶ *Id.* at 1072.

¹⁴⁷ *Id.* at 1071–72.

¹⁴⁸ *Id.* at 1072.

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ 945 F.2d 500 (2d Cir. 1991).

¹⁵⁴ *Id.* at 502.

¹⁵⁵ *Id.*

¹⁵⁶ *Id.*

¹⁵⁷ *Id.*

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contributions never “evolved into more than the helpful advice that might come from the cast, the directors, or the producers of any play.”¹⁵⁸ Thus, it held that a joint work did not exist.¹⁵⁹ Although the court resolved its stance that each author’s work must be independently copyrightable,¹⁶⁰ the case was decided based on the intent factor alone.¹⁶¹ Nevertheless, the District Court held that the actress’ “furnishing of an idea, even when the idea is accompanied by factual research, cannot justify the status of co-authorship because such contributions are not copyrightable.”¹⁶²

In *Aalmuhammed v. Lee*,¹⁶³ a consultant for the movie “Malcolm X” brought an action against the producer, claiming to be a joint author. The consultant argued that he reviewed and made several revisions to the script, which he claimed were ultimately included in the film.¹⁶⁴ According to the court, “[m]ost of the revisions . . . were to ensure the religious and historical accuracy and authenticity of scenes depicting Malcolm X’s religious conversion and pilgrimage to Mecca.”¹⁶⁵

The court held that in order for a joint work to exist, each author must make an independently copyrightable contribution.¹⁶⁶ While recognizing the “substantial and valuable” contributions that the consultant made, the court held that they were not copyrightable.¹⁶⁷ For example, facilitating Arabic conversations and coaching actors how to behave as Muslims were held not to be copyrightable contributions.¹⁶⁸ Nevertheless, the court found that if the consultant did rewrite portions of the dialogue, such contribution could be independently copyrightable.¹⁶⁹

Ultimately, the court dismissed the consultant’s claim for joint authorship given the lack of intent by the parties to be joint authors.¹⁷⁰ The consultant never controlled the work, and the “absence of control is strong evidence of the absence of co-authorship.”¹⁷¹ Additionally, the producer signed a work-for-hire agreement. Thus, the court found that

¹⁵⁸ *Id.* at 509.

¹⁵⁹ *Id.*

¹⁶⁰ *Id.* at 507.

¹⁶¹ *Id.* at 509.

¹⁶² *Childress v. Taylor*, No. 87 CIV. 6924 (CSH), 1990 WL 196013, at *5 (S.D.N.Y. Nov. 28, 1990), *aff’d*, 945 F.2d 500 (2d Cir. 1991).

¹⁶³ 202 F.3d 1227 (9th Cir. 2000).

¹⁶⁴ *Id.* at 1229–30.

¹⁶⁵ *Id.* at 1230.

¹⁶⁶ *Id.* at 1231.

¹⁶⁷ *Id.*

¹⁶⁸ *Id.*

¹⁶⁹ *Id.* at 1232.

¹⁷⁰ *Id.* at 1235.

¹⁷¹ *Id.*

[i]t 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.¹⁷²

The court also opined whether the consultant was an “author” under the Copyright Act.¹⁷³ On this point, the court stated, “[i]t is striking in *Malcolm X* how much the person who controlled the hue of the lighting contributed, yet no one would use the word ‘author’ to denote that individual’s relationship to the movie. A creative contribution does not suffice to establish authorship of the movie.”¹⁷⁴

Taking the before mentioned cases and applying them to the context of tattoos, it is probable that a court would determine that a tattoo holder does not qualify for joint authorship. A person seeking a tattoo will typically discuss his ideas for the design with the tattoo artist. Further, he will make various suggestions about coloring, size and location. He may even detail what the tattoo design should look like. However, much like the actress in *Trinity Theatre* or the consultant in *Lee*, such ideas and suggestions are not independently copyrightable despite being valuable contributions. Thus, short of the tattoo holder physically inking part of the design onto his own body, it would be clear that he provided no independently copyrightable contribution.

Nonetheless, it is plausible for a tattoo patron to make an independently copyrightable contribution. For example, he may sketch out part of the tattoo design, similar to the consultant’s revisions of the script in *Lee*. Ultimately, the issue of whether a tattoo patron’s contribution is independently copyrightable will depend upon the specific facts.

The intent of the authors is also factored into a court’s analysis of whether a joint work exists. Control is one element that the court in *Trinity Theatre* considered. However, unlike in *Trinity Theatre*, where the playwright had the final word on the script, a tattoo artist generally must obtain approval of the final design from the person seeking the tattoo. Thus, control over the work remains with the tattoo patron. Rarely, if ever, will a person permit the rendering of a tattoo on his body subject only to the whims of a tattoo artist. Conversely, like the movie studio in *Lee*, it appears illogical to conclude that a tattoo artist would permit his tattoo subject to have ownership over a tattoo design that he created.

Although the before mentioned cases make it relatively clear that

¹⁷² *Id.*

¹⁷³ *Id.* at 1233.

¹⁷⁴ *Id.*

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Nimmer's view has been rejected by most courts, at least one has taken the position that an independently copyrightable contribution is unnecessary with respect to a narrow set of circumstances. In *Gaiman v. McFarlane*,¹⁷⁵ a famous comic book author brought an action against a celebrated comic book publisher and illustrator. The publisher, and creator of a new comic book series, invited the author to write a script for one of the issues.¹⁷⁶ In doing so, the author introduced three new characters to the series, which were subsequently illustrated by the publisher.¹⁷⁷ The illustrations were primarily based on the author's verbal description and written dialogue contained within the script.¹⁷⁸ Thus, the author sought declaration from the court that he was a joint author.¹⁷⁹

In addressing the argument that the author purely contributed ideas for the characters, the court remarked, "it is true that people who contribute merely nonexpressive elements to a work are not copyright owners."¹⁸⁰ Yet, the court went on to state that

where two or more people set out to create a character jointly in such mixed media as comic books and motion pictures and succeed in creating a copyrightable character, it would be paradoxical if though the result of their joint labors had more than enough originality and creativity to be copyrightable, no one could claim copyright.¹⁸¹

In a sense, the court highlighted a narrow circumstance in which no one contribution is independently copyrightable because of the "nature of the particular creative process that had produced it."¹⁸² Accordingly, a comic book, which is typically created from the joint works of four separate people, will certainly achieve copyright status in its finished form.¹⁸³ Yet the court pointed out that there are instances where each of the four contributions may not be copyrightable. For example,

[t]he writer might have contributed merely a stock character . . . that achieved the distinctiveness required for copyrightability only by the combined contributions of the penciler, the inker, and the colorist,

¹⁷⁵ 360 F.3d 644 (7th Cir. 2004).

¹⁷⁶ *Id.* at 649.

¹⁷⁷ *Id.* at 650, 657–58.

¹⁷⁸ *Id.* at 657–58.

¹⁷⁹ *Id.* at 648.

¹⁸⁰ *Id.* at 658.

¹⁸¹ *Id.* at 658–59.

¹⁸² *Id.* at 659.

¹⁸³ *Id.*

with each contributing too little to have by his contribution alone carried the stock character over the line into copyright land.¹⁸⁴

Therefore, the court found that the character “became sufficiently distinctive to be copyrightable.”¹⁸⁵ The court further determined that the author’s “contribution had expressive content without which [the character]” would have been only a drawing.¹⁸⁶ Thus, the court concluded that the character was a joint work and that the contributions of both the producer and author were “equal.”¹⁸⁷

Whether the creation of a copyrightable tattoo design by the joint contributions of a tattoo patron and artist is comparable to that of the character created in *McFarlane* by the publisher and author will undoubtedly depend upon the facts at issue. Nevertheless, it is conceivable that such a narrow situation could arise in the context of tattoos. Person A is a tattoo patron with brilliant ideas but can’t draw; B is an excellent tattoo artist but his ideas are commonplace. They collaborate on a tattoo design: A contributing the ideas, which are not independently copyrightable, and B contributing the artistry. The intent of both A and B to be joint owners of the copyright in the tattoo design is apparent, and as the court in *McFarlane* declared, “that should be enough to constitute them joint authors within the meaning of 17 U.S.C. § 201(a).”¹⁸⁸

As discussed, the crux of whether a tattoo may be considered a joint work will undoubtedly turn on the facts at issue, as well as the jurisdiction. There are narrow instances in which the contributions of a tattoo patron and an artist will combine to form a joint work. But given that such classifications will rarely occur, one can assume that joint work is likely unavailable. Such is the fate of classification as a work for hire. Thus, where a tattoo holder does not retain part-ownership over the tattoo, it is critical to examine defenses to infringement.

III. IMPLIED LICENSE

This note first examined whether tattoos are copyrightable. After reviewing the various arguments, tattoos are likely copyrightable under the plain language of the Copyright Act. With the understanding that tattoos are copyrightable works, the prior section addressed ownership. Because it is likely that a tattoo holder would not be considered a copyright owner of the tattoo design, any unauthorized use would be deemed an infringement. Thus, this section turns to defending an

¹⁸⁴ *Id.*

¹⁸⁵ *Id.* at 661.

¹⁸⁶ *Id.*

¹⁸⁷ *Id.*

¹⁸⁸ *Id.* at 659.

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infringement claim by asserting the existence of an implied license, which has a unique application to tattoos.

The Copyright Act requires that transfers of ownership be made in writing.¹⁸⁹ A non-exclusive license, however, is excluded from the writing requirement.¹⁹⁰ Instead, a non-exclusive license can be granted verbally or implied from conduct.¹⁹¹ While such an implied license will not transfer ownership to a licensee, it “permits the use of a copyrighted work in a particular manner”¹⁹² and serves as an affirmative defense to copyright infringement.¹⁹³

There are three critical components implicated in asserting an implied license defense: (1) whether a copyright owner granted an implied license; (2) whether the use of the copyrighted work was within the scope of the implied license; and (3) whether the copyright owner revoked the implied license prior to the infringing conduct.

A. An Implied License is Granted Where the Work is Requested, Delivered and Intended to be Used in a Certain Way

The courts have identified several ways to determine whether the copyright holder granted an implied license. The Ninth Circuit’s three-prong test, developed in *Effects Associates, Inc. v. Cohen*,¹⁹⁴ is perhaps the most widely adopted approach.¹⁹⁵

¹⁸⁹ 17 U.S.C. § 204.

¹⁹⁰ *Id.* See also *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775 (7th Cir. 1996) (“[E]ven though section 204(a) of the Copyright Act invalidates any transfer of copyright ownership that is not in writing, section 101 explicitly removes a nonexclusive license from the section 204(a) writing requirement. . . . [A] nonexclusive license is, therefore, an exception to the writing requirement of section 204.”).

¹⁹¹ *Teter v. Glass Onion, Inc.*, 723 F. Supp. 2d 1138, 1147 (W.D. Mo. 2010). See *Jacob Maxwell, Inc. v. Veeck*, 110 F.3d 749, 752 (11th Cir. 1997); *Shaver*, 74 F.3d at 775.

¹⁹² *Shaver*, 74 F.3d at 775.

¹⁹³ *Id.*

¹⁹⁴ 908 F.2d 555 (9th Cir. 1990).

¹⁹⁵ See, e.g., *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1235 (11th Cir. 2010) (applying *Effects* test to determine whether the copyright owners of custom paint, graphics and photographs had granted an implied license that later permitted their use as promotional instruments); *Nat’l Ass’n for Stock Car Auto Racing, Inc. v. Scharle*, 184 F. 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); *Nelson-Salabes, Inc. v. Morningside Dev., LLC*, 284 F.3d 505, 515 (4th Cir. 2002) (applying *Effects* test to determine whether the copyright owner of architectural designs had granted an implied license that later permitted their use during construction of an assisted living facility); *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); *Lulirama Ltd., Inc. v. Axxess Broad. Servs., Inc.*, 128 F.3d 872, 879 (5th Cir. 1997) (applying *Effects* test to determine whether the copyright owner of musical “jingles” had granted an implied license that later permitted their use on radio and television); *Shaver*, 74 F.3d at 776 (applying *Effects* test to determine whether the copyright owner of architectural designs had granted an implied license that later permitted their use during construction of an airport); *MacLean Assocs., Inc. v. Wm. M. Mercer-Meidinger-Hansen, Inc.*, 952 F.2d 769, 779 (3d Cir. 1991) (applying *Effects* test to determine whether the copyright owner of computer software had granted an implied license that later permitted its use

In *Effects*,¹⁹⁶ a movie producer hired a special effects company to create footage for a film.¹⁹⁷ The parties verbally agreed to the deal without discussing who would own the copyright of the footage.¹⁹⁸ The producer became dissatisfied with the footage prepared by the special effects company and paid only half of the promised amount, despite continued requests for full payment.¹⁹⁹ Nevertheless, the producer incorporated the footage into the film, and the special effects company sued for copyright infringement.²⁰⁰

The court found that the special effects company had granted an implied license to the producer since it “created a work at defendant’s request and handed it over, intending that defendant copy and distribute it.”²⁰¹ Therefore, use of the footage was permitted in the film.²⁰²

The *Effects* test was later applied by the Third Circuit in *National Association for Stock Car Auto Racing, Inc. v. Scharle*,²⁰³ where an independent contractor was hired by an intermediary to design a new trophy cup for NASCAR.²⁰⁴ Upon completion of the design, NASCAR unveiled the trophy and began to promote it through various marketing efforts.²⁰⁵ However, NASCAR failed to attribute the trophy’s design to the independent contractor.²⁰⁶ Instead, the trophy was credited to another, giving rise to a dispute over ownership.²⁰⁷

In examining whether NASCAR infringed upon the independent contractor’s copyright in the trophy design, the court reviewed whether an implied license existed between the parties that would bar such a claim.²⁰⁸ The court applied the *Effects* test, and held that “NASCAR, through the [intermediary], requested the designs, [the independent contractor], through the [intermediary], created and delivered those designs to NASCAR, and [the independent contractor] expected NASCAR to use the trophy in the ‘high-profile’ manner it eventually did.”²⁰⁹ Accordingly, the court found that the independent contractor granted an implied license to NASCAR since he was aware that the design would ultimately be used by NASCAR for the purpose of

in a competing software program).

¹⁹⁶ 908 F.2d 555 (9th Cir. 1990).

¹⁹⁷ *Id.* at 556.

¹⁹⁸ *Id.*

¹⁹⁹ *Id.*

²⁰⁰ *Id.*

²⁰¹ *Id.* at 558.

²⁰² *Id.* at 559.

²⁰³ 184 F. App’x 270 (3d Cir. 2006).

²⁰⁴ *Id.* at 272.

²⁰⁵ *Id.*

²⁰⁶ *Id.*

²⁰⁷ *Id.*

²⁰⁸ *Id.* at 274.

²⁰⁹ *Id.* at 275.

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replacing the previous trophy.²¹⁰

The *Effects* test was also applied by the Seventh Circuit in *Shaver*,²¹¹ where a general contractor was hired to design and construct a cargo hanger for an airport.²¹² The general contractor in turn hired an architect to prepare schematic design drawings as part of the first phase in the design of the project.²¹³ The architect later completed the drawings and submitted them to the general contractor with a notice of copyright.²¹⁴ The drawings were accepted and the architect was paid a fee for his work.²¹⁵ Subsequently, the general contractor hired another company to complete the remaining phases for the design of the project.²¹⁶ The architect did not contest the hiring, and in fact sent a letter to the general contractor stating, “[w]e trust that our ideas and knowledge exhibited in our work will assist the Airport in realizing a credible and flexible use Cargo/Hangar facility.”²¹⁷ Eventually, the general contractor sought declaratory judgment from the court that it could use the architect’s drawings without infringing his copyright.²¹⁸

In applying the *Effects* test, the court held that “[the architect] created a work at [the general contractor’s] request and handed it over, intending [the general contractor] to copy and distribute it for the Airport Project.”²¹⁹ Further, the court highlighted several factors that tended to show that the architect intended for his drawings to be used by the general contractors without his further involvement in the project.²²⁰ First, the architect’s certificate of registration stated that the copyrighted designs were “to be used for the ‘Airport Facility.’”²²¹ Secondly, the architect’s contract only provided for the initial phase of design work.²²² Lastly, the architect’s actions and statements to the general contractor after handing over the drawings conveyed an understanding that his work would be used for the airport project.²²³ Accordingly, the court held that the architect had granted the general contractor an implied license.²²⁴

Based upon the prior mentioned cases, the Ninth Circuit’s *Effects* can be expressed as recognizing “that an implied nonexclusive license

²¹⁰ *Id.*

²¹¹ 74 F.3d 768 (7th Cir. 1996).

²¹² *Id.* at 770.

²¹³ *Id.*

²¹⁴ *Id.* at 771.

²¹⁵ *Id.*

²¹⁶ *Id.*

²¹⁷ *Id.*

²¹⁸ *Id.*

²¹⁹ *Id.* at 776.

²²⁰ *Id.* at 776–77.

²²¹ *Id.* at 776.

²²² *Id.* at 776–77.

²²³ *Id.* at 777.

²²⁴ *Id.*

has been granted when (1) a person (the licensee) requests the creation of a work, (2) the creator (the licensor) makes that particular work and delivers it to the licensee who requested it, and (3) the licensor intends that the licensee-requestor copy and distribute his work.”²²⁵

Although “request” and “delivery” are factors to be considered,²²⁶ intent is often the cornerstone in determining whether an implied license exists.²²⁷ Intent is also indicative of the scope of the license, which “takes its form from the circumstances and conduct that created them.”²²⁸

Determinations of intent can be problematic. In essence, they require the court to speculate as to what the individual was thinking. In determining intent, the courts make an “objective inquiry into the facts”²²⁹ and review the “totality of the parties’ conduct.”²³⁰ Accordingly, “the private hopes of the creator are not relevant” to the court’s decision.²³¹

Yet, an objective analysis of the parties’ conduct is still rather thorny, and the courts have identified several other factors to help with deciding intent. The Seventh Circuit in *Shaver* reviewed several factors to decide whether there was evidence of intent: “the language of the copyright registration certificate, [the agreement between the parties], and deposition testimony[,] and the delivery of the copyrighted material without warning that its further use would constitute copyright infringement.”²³² Similarly, the First Circuit has reviewed such factors as

- (1) whether the parties were engaged in a short-term discrete transaction as opposed to an ongoing relationship;
- (2) whether the creator utilized written contracts . . . providing that copyrighted materials could only be used with the creator’s future involvement or

²²⁵ *Id.* at 776.

²²⁶ “Request” and “delivery” are relatively easy factors to discern and therefore require only limited discussion. *See* *Effects Assocs.*, 908 F.2d at 558 n. 6. (“While delivery of a copy ‘does not of itself convey any rights in the copyrighted work,’ it is one factor that may be relied upon in determining that an implied license has been granted.”(citation omitted)).

²²⁷ *See* *Estate of Hevia v. Portrio Corp.*, 602 F.3d 34, 41 (1st Cir. 2010); *Wilchombe v. TeeVee Toons, Inc.*, 555 F.3d 949, 956 (11th Cir. 2009) (“In determining whether an implied license exists, a court should look at objective factors evincing the party’s intent . . .”).

²²⁸ *Teter v. Glass Onion, Inc.*, 723 F. Supp. 2d 1138, 1149 (W.D. Mo. 2010) (quoting *RAYMOND T. NIMMER & JEFF DODD, Modern Licensing Law* § 10:17 (2009)).

²²⁹ *Nat’l Ass’n for Stock Car Auto Racing, Inc. v. Scharle*, 184 F. App’x 270, 275 (3d Cir. 2006).

²³⁰ *Estate of Hevia v. Portrio Corp.*, 602 F.3d 34, 41 (1st Cir. 2010) (citation omitted). *See also* *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1235 (11th Cir. 2010) (“Courts focus on objective evidence revealing the intent of the parties to determine if an implied license exists . . .”); *Nelson-Salabes, Inc. v. Morningside Dev., LLC*, 284 F.3d 505, 515 (4th Cir. 2002) (“[I]n assessing whether [the licensor] granted [the licensee] an implied non-exclusive license, [the court] should examine the totality of the circumstances surrounding [the licensor’s] conduct.”).

²³¹ *Scharle*, 184 F. App’x at 275.

²³² *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 776 (7th Cir. 1996) (citing *Effects Assocs. v. Cohen*, 908 F.2d 555, 559 (9th Cir.1990)).

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express permission; and (3) whether the creator's conduct during the creation or delivery of the copyrighted material indicated that use of the material without the creator's involvement or consent was permissible.²³³

Nevertheless, the above-mentioned factors are not exhaustive and vary based upon the specific facts in question.²³⁴

In the context of tattoos, there are two implied rights formed under the auspices of *Effects*, which a tattoo artist always grants to a tattoo holder. These fundamental rights include: (1) the right to display the tattoo publicly during the normal course of life; and (2) the right to make alterations including (a) complete removal of the tattoo from the body; and (b) the addition of a new tattoo to an existing design. Such rights alleviate concerns of involuntary servitude²³⁵ and block claims of infringement that would otherwise make life with a tattoo untenable.

When applied to tattoos, the first two prongs of the *Effects* test—request and delivery—are straightforward and easily satisfied. As in *Effects*, where the element of request was satisfied by the movie producer actually asking the special effects company to prepare the footage, here it is met when an individual solicits a tattoo from the artist. Also like *Effects*, where the element of delivery was satisfied when the special effects company physically handed the footage over to the movie producer, here it is met when the artist physically inks or transfers the tattoo onto an individual's body.²³⁶ These factors may alone suggest that a tattoo holder is granted an implied license; however, it is critical to also examine intent.

The third prong of the *Effects* test requires a showing that the “licensor intends that the licensee-requestor copy and distribute his work.”²³⁷ Although copy and distribution rights were at issue in *Effects*, they do not stand alone as the only rights that may be covered under an implied license. The scope of a license varies depending on intent and conduct.²³⁸ Courts have also found such licenses to cover the right to display or make derivative works.²³⁹

²³³ Estate of Hevia, 602 F.3d at 41 (citation omitted).

²³⁴ *Id.*

²³⁵ See *supra* note 30.

²³⁶ *Effects Assocs.*, 908 F.2d at 558 (showing that request and delivery were met when a special effects company created and handed over footage to the film producer).

²³⁷ *Shaver*, 74 F.3d at 776.

²³⁸ *Supra* notes 145–43.

²³⁹ See Nat'l Ass'n for Stock Car Auto Racing, Inc. v. Scharle, 184 F. App'x 270, 276 (3d Cir. 2006) (holding that the licensor “created the [work] with the intent that [it] would be used and displayed by [the licensee.]”); see also *Effects Assocs.*, 908 F.2d at 559 (concluding that the licensor “granted nonexclusive licenses to [the licensees] to incorporate [the copyrighted work] into [the licensee's film]”); *Odde v. Ries*, 743 F.2d 630 (9th Cir. 1984) (finding an author of a series of articles impliedly granted a license to a publisher to use the articles in a book on the same topic).

Before reviewing specific uses that, in the context of tattoos, may be covered by an implied license under *Effects*, it is informative to first examine whether there is ever an instance in which a tattoo artist intends to grant *any* use. The intent of a tattoo artist is revealed through an objective inquiry into the facts and surrounding circumstances, as well as by looking at the parties' conduct.²⁴⁰ What are the relevant facts and circumstances surrounding a tattoo? What types of conduct does a tattoo artist or holder typically display?

The underlying facts of a tattoo transaction are unique and unmistakable. They are also nearly identical in all instances. An (1) individual desiring a tattoo, (2) solicits a tattoo artist to (3) create and ink a design (original or otherwise) onto his skin, with (4) an intention that it become permanently affixed to his body. The (5) tattoo artist voluntarily complies by (6) creating and permanently inking the tattoo onto the individual (7) for a fee.

What causes the prior transaction to be unique in the framework of an implied license analysis is the underlying fact that a tattoo is *permanently affixed to another person's body*. Knowledge of this fact suggests that a tattoo artist likely possesses the intent to grant some type of implied license to a tattoo holder.

At the instant when a tattoo artist voluntarily inks a tattoo onto the body of another, he reveals his subconscious intent to surrender some level of control over his work. The tattoo artist understands that when the tattoo holder stands up and leaves his shop, the sole power to direct how the tattoo is used no longer resides with him.²⁴¹ The tattoo artist recognizes that by *his doing*, the tattoo has become part of *another person's body* and its use will no longer flow from his hand. Rather, the tattoo will now take its direction from the tattoo holder. Behind every tattoo artist's actions, therefore, lies the intent to transfer specific rights that may be exercised during the normal course of his life.

Like the architect in *Shaver*, who handed over his drawings to the general contractor with the intent that they be used in the remaining phases of the airport design and construction, or like the independent contractor in *Scharle*, who handed over his trophy designs to NASCAR with the intent that they be used for the creation of a new trophy, or even like the special effects company in *Effects*, who provided the footage to the movie producer so that it could be incorporated into the film, a tattoo artist inks a design onto another with the intent that it be

²⁴⁰ *Supra* notes 115–120 and accompanying text.

²⁴¹ Allowing the tattoo holder to walk out of the shop and go about his normal course of life can be considered a lack of objection and may therefore establish the grant of an implied license. See *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775 (7th Cir. 1996) (“[C]onsent given in the form of mere permission or lack of objection is also equivalent to a nonexclusive license and is not required to be in writing.”).

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used by that individual throughout his being. The tattoo artist, like the architect or independent contractor, created something with a purpose. Here, the purpose is that the tattoo be worn and displayed by the tattoo holder.

Based upon such facts and circumstances surrounding a tattoo, a court is likely to find the existence of an implied license that covers general use of the tattoo throughout the tattoo holder's being. This necessarily includes the right to display and alter the work.²⁴² As Whitmill admitted, "[w]herever [the tattoo holder] goes, his tattoo goes."²⁴³

When considered against the relevant factors identified by the First and Seventh Circuits, it is again evident that a tattoo artist might intend to grant an implied license. One factor the courts consider is "whether the parties were engaged in a short-term discrete transaction as opposed to an ongoing relationship."²⁴⁴ This inquiry seeks to understand whether, from an objective view of the length of the transaction, the licensor intends to have further involvement. It aids the court in determining if "use of the copyrighted material without [the licensor's] involvement was impermissible."²⁴⁵

Courts that have applied this analysis tend to find that a long-term transaction cuts against the finding of an implied license.²⁴⁶ The courts reason that the longer a relationship persists, the more likely a licensor intended to be involved in the project and therefore would not have permitted use of the copyrighted work without his participation.²⁴⁷ Conversely, a short-term and discrete transaction is indicative of intent to remain uninvolved, making it more likely that a licensor granted use of the copyrighted work without his involvement.²⁴⁸

It can be argued that tattoos typically involve a short-term transaction, which begins when an individual enters the tattoo artist's shop and terminates at the moment the tattoo is inked onto an

²⁴² See Plaintiff's Reply Memorandum in Support of His Motion For Preliminary Injunction, *supra* note 18, at 10–11 ("The implied license gives Mr. Tyson the right to go anywhere, appear anywhere, be photographed, be videotaped, appear in documentaries, news features, sporting events, movies – and yes, in all types of marketing and promotional events involving his persona. . . . The implied license also gives Mr. Tyson the right to alter or remove the tattoo, or cover it with a mask or makeup . . .").

²⁴³ *Id.* at 10.

²⁴⁴ Nelson-Salabes, Inc. v. Morningside Dev., LLC, 284 F.3d 505, 516 (4th Cir. 2002).

²⁴⁵ *Id.*

²⁴⁶ *Id.* (discussing several Sixth and Ninth Circuit decisions, which found the length of the transactions in issue to be determinative of whether an implied license existed). See also Johnson v. Jones, 149 F.3d 494, 500–01 (6th Cir. 1998) (finding that the contracts and conduct of a licensor demonstrated his intent to remain on the project until completion. Held that no implied license was granted and that use of the copyrighted material was impermissible without the licensor's involvement).

²⁴⁷ *Morningside*, 284 F.3d at 516.

²⁴⁸ *Id.*

individual's body. Absent an agreement to the contrary, there can be no intent on the part of the tattoo artist to remain involved in the project since the transaction has been completed (i.e., the tattoo is inked). Therefore, a court could find that the tattoo artist permits some use of the tattoo without his future involvement.²⁴⁹

Conversely, it could be argued that because tattoos are permanent, they inherently involve a long-term relationship. This argument is deceptive and distorts the purpose of the court's test. Instead of examining the length of the *transaction*, the latter view focuses on the permanence of the *copyrighted work*. Although tattoos can persist indefinitely, this characteristic does not necessarily mean that an artist intends to remain involved in its use. This argument would be similar to an architect drafting plans for a contractor and suggesting that since the plans can persist forever, he necessarily must have intended to be involved in the construction project through completion.

The typical tattoo transaction is short-lived. It is therefore plausible that a tattoo artist permits some use of the tattoo without his future involvement after the tattoo is inked. A more controversial application of this test could involve a scenario in which the tattoo artist creates a tattoo design at the request of another but does not ink it onto that person's body. In this instance, the transaction is short and discrete, but whether the tattoo artist intends to have future involvement in the project is unclear. For example, it is unclear whether the tattoo artist may have granted an implied license to the patron that would permit him to hire another tattoo artist to ink the copyrighted design. Absent an agreement stating otherwise, a court may find that such a discrete transaction cuts in favor of an implied license.²⁵⁰

Another factor the courts consider is "whether the creator's conduct during the creation or delivery of the copyrighted material indicated that use of the material without the creator's involvement or consent was permissible."²⁵¹ The conduct of a tattoo artist will no doubt vary with each tattoo. Things like what was said and done during or after the tattoo transaction will matter. For example, a tattoo artist might tell a patron that only he may alter the tattoo. This suggests that he intends to remain involved in the creation of derivative works. Absent any extraneous conduct, however, it appears that the act of inking a permanent tattoo onto another cuts in favor of an implied license.

²⁴⁹ See *Foad Consulting Grp. v. Musil Govan Azzalino*, 270 F.3d 821, 832 (9th Cir. Cal. 2001) (holding that an architect, hired to create a plot plan for a shopping center, was engaged in a short-term discrete transaction, and therefore, absent agreement or conduct to contrary, permitted use of the plans without future involvement).

²⁵⁰ *Id.*

²⁵¹ *Nelson-Salabes, Inc. v. Morningside Dev., LLC*, 284 F.3d 505, 516 (4th Cir. 2002).

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In light of the above, it is evident that a court could find, under the auspices of *Effects*, that a tattoo artist has granted an implied license to a tattoo holder. The elements of request and delivery are met when a tattoo artist creates and inks a design onto the body of another at the latter's behest. The element of intent is satisfied upon an examination of the facts and circumstances surrounding the tattoo, including conduct. When a tattoo artist knowingly and voluntarily inks a permanent design onto another person's body, he reveals his subconscious intent to surrender control over the work. In essence, he is permitting that individual's use of the tattoo without his further involvement. Such use may include the right to display or alter the work during the normal course of the licensee's life. An implied license can even be granted where payment has not yet been received.²⁵² Therefore, an implied license may be formed at the moment a tattoo is inked onto the body of another.

Remaining, however, is the important issue of when a licensee goes beyond the permitted use.

B. The Scope of an Implied License is Defined by the Parties' Intent and Conduct

The scope of an implied license is limited,²⁵³ and a licensee who exceeds its bounds commits copyright infringement.²⁵⁴ Thus, it is critical that a licensee adhere to the permitted use of an implied license. Scope is determined by examining the parties' intent and overall conduct.²⁵⁵ Such determinations are made through an objective inquiry of the facts.²⁵⁶ Courts have sometimes relied upon a written contract between the parties as evidence of their intent.²⁵⁷ Where a licensor seeks to restrict the scope of a license, the Ninth and Eleventh Circuits have required the copyright owner to express such intent upon delivery of the protected work.²⁵⁸

²⁵² See *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 778 (7th Cir. 1996); *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 559 n.7 (9th Cir. 1990).

²⁵³ See *Shaver*, 74 F.3d at 775 ("The copyright owner simply permits the use of a copyrighted work in a particular manner.").

²⁵⁴ *Id.* See also *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.").

²⁵⁵ See *Latimer*, 601 F.3d at 1235 ("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."); *Teter v. Glass Onion, Inc.*, 723 F.Supp.2d 1138, 1149 (W.D. Mo. 2010) ("The scope of an implied license takes its form from the circumstances and conduct that created them [T]he core focus lies in determining what scope of the parties' conduct reasonably suggests as the range of permitted use of the licensed rights." (citation omitted)).

²⁵⁶ See *Teter*, 723 F.Supp.2d at 1147.

²⁵⁷ See *Shaver*, 74 F.3d at 776.

²⁵⁸ 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

It was argued that a court could find that a tattoo artist has granted an implied license to a tattoo holder, which covers the right to use the copyrighted work throughout the normal course of his life. The basic rights to display and alter a tattoo are so fundamental to a tattoo holder's life that they are likely the intended and permitted uses of the copyrighted work. While a tattoo artist may attempt to limit the scope of an implied license either verbally or by written contract, the default presumption is that display and alteration uses are within the bounds of the implied license. For example, it is likely that a tattoo holder may appear in public with the copyrighted tattoo design visible to others. It is also likely that he may alter a copyrighted tattoo design by adding another tattoo to his body. Similarly, he may cover up the copyrighted tattoo with clothing or even entirely remove it from his body.

The prior mentioned uses are fundamental to a tattoo holder's existence and are likely permitted by the tattoo artist. However, at what point does a tattoo holder push beyond the boundaries of fundamental and permitted use? Recent cases suggest that the line is drawn at commercial use or when a tattoo holder seeks to profit directly from the copyrighted tattoo. Nevertheless, it is evident that commercial use is permitted by a tattoo holder's implied license in certain situations, and never permitted by third parties.

In the lawsuit involving Rasheed Wallace, a tattoo artist brought an action for copyright infringement when his copyrighted tattoo design was used as part of an advertisement for Nike.²⁵⁹ There are two important aspects of this lawsuit that shed light on the instant discussion about the scope of an implied license: The first involves timing of the lawsuit, and the second involves the actual claims.

With regard to the former, the tattoo artist inked the copyrighted design onto Rasheed Wallace's body in 1998.²⁶⁰ It was not until some six years later that the disputed commercial aired in 2004 and another year until the complaint was filed in 2005.²⁶¹ All the while, Rasheed Wallace continued to play in the NBA and remained a celebrity.²⁶² His tattoo was shown on television, in photographs and displayed to the public. Thus, the timing of the lawsuit suggests that Rasheed Wallace was granted an implied license that covered use of the tattoo during the normal course of his life. In fact, the tattoo artist essentially admitted to the grant of an implied license that covered Wallace's right to publicly

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)).

²⁵⁹ See Harkins, *supra* note 14, at 315–16.

²⁶⁰ *Id.* at 314.

²⁶¹ *Id.* at 329.

²⁶² See *Rasheed Wallace*, ESPN, http://espn.go.com/nba/player/_id/883/rasheed-wallace (last visited Oct. 9, 2012).

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display the tattoo during his life as an NBA player.²⁶³ It was not until the copyrighted tattoo was featured in a commercial advertisement that the tattoo holder brought an action.

Although commercial use seems to be a line that tattoo artists are unwilling to cross, it is argued that this distinction does not actually apply to the tattoo holder himself, but rather, to third parties. It is argued that the scope of an implied license covers commercial use by the tattoo holder, particularly where (1) he is a celebrity and (2) such fact is known to the tattoo artist at the time of delivery.

For example, when Rasheed Wallace was inked, the tattoo artist knew he was an NBA player and was likely to be seen on television and in newspapers.²⁶⁴ He therefore permitted use in that manner.²⁶⁵ He also permitted Rasheed Wallace to appear in commercial advertisements and in several movies.²⁶⁶ The tattoo artist did not, however, permit third parties to benefit from the tattoo (i.e., Nike).²⁶⁷

The actual claims of the lawsuit reveal this intent. Note that Rasheed Wallace was never sued for being a direct infringer.²⁶⁸ Only Nike and its advertising agency were alleged to be direct infringers.²⁶⁹ Wallace was sued on a theory of contributory liability.²⁷⁰ In other words, the claim was more or less that he induced another to directly infringe.²⁷¹ This suggests that Wallace was permitted to appear in the advertisement, but that third parties could not copy, reproduce or make derivative works.

Also consider Whitmill's suit against Warner Bros., or perhaps more telling, his non-suit against Mike Tyson. Whitmill expressly stated that Mike Tyson had an implied license that covered his appearance in the film, as well as other commercial uses.²⁷² Instead of going after Tyson, Whitmill argued that he did not authorize a third party to reproduce the Tyson Tattoo (i.e., Warner Bros.).²⁷³

Thus, it likely that the scope of an implied license covers display

²⁶³ Harkins, *supra* note 259, at 316 (“[The tattoo artist] believed he and his business would receive exposure and recognition from the tattoo being on an NBA player. Indeed, Reed admitted to observing without concern the tattoo during televised NBA games in which Wallace participated as a player. Moreover, [the tattoo artist] expected that the tattoo would be publicly displayed on Wallace’s arm and conceded that such exposure would be considered common in the tattoo industry.”).

²⁶⁴ *Id.*

²⁶⁵ *Id.*

²⁶⁶ *Rasheed Wallace*, IMDB, <http://www.imdb.com/name/nm1133466/> (last visited Oct. 9, 2012).

²⁶⁷ HARKINS, *supra* note 250, at 316–17.

²⁶⁸ *Id.*

²⁶⁹ *Id.* at 329.

²⁷⁰ *Id.* at 320–21.

²⁷¹ *Id.*

²⁷² Plaintiff’s Reply Memorandum in Support of His Motion For Preliminary Injunction, *supra* note 18, at 1..

²⁷³ *Id.* at 1–2.

rights in commercial and non-commercial uses. It would not, however, permit a third party to engage in either. Scope is defined by intent and conduct. Where a tattoo artist knowingly inks a permanent design onto the body of a celebrity, he realizes that such person will potentially appear in films, commercial advertisements, newspapers and on television. He therefore grants an implied license to that individual to use the tattoo during his normal life. In this scenario, it just so happens that the tattoo holder is a celebrity, and thus, his life will be more public. The celebrity tattoo holder makes a living by appearing in films, on television, and across other mediums of commercial media. If such use was intended to be taken out of the implied license, the Ninth and Eleventh circuits would require that it be expressed on delivery by the tattoo artist. Even though a tattoo holder may be within the scope of an implied license, there is always the issue of revocation.

C. Revocation

An implied license is generally revocable by the copyright owner.²⁷⁴ Where the license has been revoked, further use of the copyrighted work will constitute infringement, absent another affirmative defense.²⁷⁵ An implied license that is supported by consideration, however, is irrevocable.²⁷⁶ Such a license is considered a contract.²⁷⁷

In the context of tattoos, a critical question is whether consideration was given in exchange for use of the copyrighted work. If so, an implied license granting use of the tattoo during the normal course of a tattoo holder's life is irrevocable. A typical tattoo transaction involves the payment of a fee by the tattoo holder to the artist. It is questionable as to whether this fee, which is paid in consideration for creating and inking the design, also covers an implied license to use the tattoo. A court may require that additional consideration be given for the implied license, particularly where there is no showing that the license is part of the initial tattoo transaction.

Nevertheless, when a tattoo artist grants an implied license to a tattoo holder covering use of the copyrighted work during the normal course of his being, such license is so closely bound with the transaction

²⁷⁴ See *Teter v. Glass Onion, Inc.*, 723 F. Supp. 2d 1138, 1150 (W.D. Mo. 2010) ("Where no consideration is given, a nonexclusive implied license is revocable.")

²⁷⁵ *Id.*

²⁷⁶ See *Lulirama Ltd., Inc. v. Axxess Broad. Servs., Inc.*, 128 F.3d 872, 882 (5th Cir. 1997) ("A nonexclusive license may be irrevocable if supported by consideration. This is so because a nonexclusive license supported by consideration is a contract.") (citations omitted).

²⁷⁷ *Id.* See also *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 776 (7th Cir. 1996) ("[I]mplied licenses are like implied contracts . . ."); *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 559 n.7 (9th Cir. 1990) ("[An implied license] seems to us to be a creature of law, much like any other implied-in-fact contract.")

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that it becomes irrevocable. A tattoo artist who accepts payment for his work also accepts that the work will be used throughout the tattoo holder's life. Thus, the consideration paid for the tattoo will also support use of the tattoo in such a manner. It is inconceivable that a tattoo holder would pay for a tattoo design that he could not display, add to or remove.

Although the right to display and alter a tattoo may be irrevocable, other uses may still be revoked. Therefore, it is important that a tattoo holder be aware of his permitted use so he can stay within those bounds.

CONCLUSION

Hanging over every tattooed individual is the potential for a copyright infringement lawsuit. Yet, an implied license remains a powerful shield that protects a tattoo holder from such actions. Given the unique nature and circumstances of a tattoo, a court could find the existence of an implied license and therefore permit use of the copyrighted work in a particular manner. Absent an agreement or conduct to the contrary, an implied license would cover the right to display and alter the copyrighted work during the course of a tattoo holder's life. Where that individual is a known celebrity, the implied license likely covers various commercial uses as well.

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