

## Implied Copyright License Defense Shapes Up In Tattoo Cases

By **David Sussman** and **Kara Brandeisky** (March 12, 2021, 4:09 PM EST)

As tattoos and body art have become a \$3 billion industry in the U.S.,<sup>[1]</sup> an increasing number of athletes, celebrities and other public figures are inked. But who owns a tattoo — the artist who designed it, or the person who bears it?

And even if tattoo artists have copyrights in their creations — as courts have assumed but never ultimately decided — do famous tattoo bearers need to obtain consent from the tattoo artists who inked them before licensing their likenesses bearing the tattoos? And would the failure to do so subject tattoo wearers — or their licensees — to copyright infringement liability as to the tattoos?

The Copyright Act offers exclusive rights to original works "fixed in any tangible medium of expression."<sup>[2]</sup> But when an original work is affixed to a human being, there is a tension between the tattoo artist's usual exclusive rights as copyright owner and the tattoo bearer's rights to freedom of expression — not to mention the tattoo bearer's publicity rights to promote himself and control commercial exploitation of his own persona.

This legal tension has become increasingly important to the video game industry, which is facing a series of lawsuits from tattoo artists alleging copyright infringement for video game portrayals of famous athletes with all their ink.<sup>[3]</sup>

But video game makers are not the only ones vexed by these issues, as evidenced by two recent ongoing copyright lawsuits in the U.S. District Court for the Central District of California: *Sedlik v. Von Drachenberg*, brought against a tattoo artist who inked a photographer's portrait of Miles Davis on a customer's arm,<sup>[4]</sup> and *Brophy v. Belcalis*, a right of publicity lawsuit filed against Cardi B brought by the man who bears the tattoo that was photoshopped onto one of her album covers.<sup>[5]</sup>

Thus far, courts have taken divergent approaches to address these knotty new problems. But as tattoos become more prevalent, especially among celebrities, the media and entertainment industry needs to know what the rules will be.

One way in which courts could reconcile the competing rights held by tattoo artists and tattoo bearer is by finding an implied license. In other words, courts infer from the circumstances that the tattoo artists



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understood that they were inking designs on people — sometimes famous people, and sometimes people who may one day become famous — and thus must be impliedly granting the tattoo bearers a license to display those tattoos in public and in various forms of media.

However, there are two aspects of the implied license doctrine that still require further clarity in the context of tattoo litigation.

### **Legal Standard**

The implied license test for copyright varies by circuit and has different iterations, but generally, as "Patry on Copyright" states:

an implied license results (1) when the putative licensee asks the copyright owner to create the work for it; (2) the copyright owner creates the work and delivers it to the alleged licensee; and (3) the copyright owner intends the licensee to use the work as it does.[6]

The transaction between a tattoo artist and tattoo bearer appears to satisfy this basic test: The tattoo bearer requests that the tattoo artist create the work; the tattoo artist inks the work on the tattoo bearer; and the tattoo artist intends the tattoo bearer to display the work and be photographed or otherwise depicted, which would require reproducing the work or creating a derivative work.

### **Scope of the License**

The first question is how far the scope of the implied license extends. Defendants in tattoo litigation have argued that a tattoo artist expects and intends the tattoo bearer to authorize others to depict his likeness, including the tattoo, in any media. Plaintiffs have said that the scope of any implied license does not extend to novel and commercial forms of media, such as video games.

For example, in the March 2020 *Solid Oak Sketches LLC v. 2K Games Inc.* decision, U.S. District Judge Laura Taylor Swain in the U.S. District Court for the Southern District of New York found that the plaintiff owned valid exclusive licenses to five tattoos depicted on NBA players LeBron James, Eric Bledsoe and Kenyon Martin, having acquired the licenses from the tattoo artists who actually inked the designs.[7]

The court also found that James, Bledsoe and Martin had granted the NBA the right to license their likenesses to third parties — such as 2K Games and Take-Two Interactive Software Inc., the makers of the video game series NBA 2K — and the video games NBA 2K14, 2K15 and 2K16 had featured James, Bledsoe and Martin with those copyrighted tattoos.

Nevertheless, the court granted summary judgment to dismiss the plaintiff's copyright claims on three different grounds, one of which was the implied license defense. The court found that the "tattooists necessarily granted the Players nonexclusive licenses to use the Tattoos as part of their likenesses" and, in fact, had done so before *Solid Oak Sketches* had acquired the copyrights to the tattoos.[8] The court also separately held for the defendants on the grounds that their use of the tattoos was both fair and de minimis.[9]

But another court is still considering the scope of the implied license in an almost identical lawsuit. In *Alexander v. Take-Two Interactive Software*, the tattoo artist Catherine Alexander sued Take-Two and 2K Games in the U.S. District Court for the Southern District of Illinois for depicting World Wrestling Entertainment professional wrestler Randy Orton in WWE 2K video games with the tattoos Alexander had inked on Orton.[10] Like the NBA players in *Solid Oak Sketches*, Orton licensed his likeness to the

WWE, which in turn licensed his likeness to 2K Games.

Alexander moved for partial summary judgment on the question of whether the defendants had copied her work, and the court granted it, ruling, "It is undisputed that Alexander holds valid copyrights for the five tattoos at issue and that Defendants copied her copyrighted works."<sup>[11]</sup>

However, unlike in *Solid Oak Sketches*, the court in *Alexander* denied the defendants' motion for summary judgment on their implied license defense, finding there were questions of material fact as to whether Alexander intended that Orton copy and distribute the tattoos.<sup>[12]</sup>

In particular, the court noted:

Alexander testified that she has never given permission to any of her clients to use copies of her tattoo works in videogames and argues that Defendants are conflating Orton's rights to his own likeness and right to appear in media with an implied license to use her copyrights in unlimited and other commercial ways, such as in video games.<sup>[13]</sup>

The trial in *Alexander* is set for September 2021 and will turn in part on the existence and scope of any implied license that Alexander granted to Horton.

Notably, some case law suggests that if a copyright holder grants an implied license and intends to limit it, the copyright holder must limit it expressly.<sup>[14]</sup> If so, Alexander's testimony that she has never given permission for Orton to be depicted in video games with her tattoo appears to be nearly irrelevant; what would matter would be evidence that she had instructed Orton that he did not have permission to allow himself to be depicted in video games.

### **An Implied Sublicense?**

But even if a court finds an implied license with a broad enough scope, the second question is whether the tattoo bearer is in fact sublicensing the tattoo artist's copyright when the tattoo bearer licenses his own publicity rights. If the tattoo bearer's publicity rights are construed as a kind of sublicense of the tattoo artist's copyright, this creates a new wrinkle.

Under the Copyright Act, implied licenses can only be nonexclusive, since the act requires that exclusive licenses be in writing.<sup>[15]</sup> However, the holder of a nonexclusive license generally cannot grant a sublicense without express authorization.<sup>[16]</sup> That is because a nonexclusive license is not a transfer of ownership, but rather, a covenant not to sue by the licensor so long as the licensee uses the work in the manner contemplated by the parties.<sup>[17]</sup>

Therefore, tattoo copyright holders may credibly argue that even if the tattoo artist has granted the tattoo bearer a nonexclusive implied license to copy and reproduce the tattoo, the tattoo bearer may not sublicense that implied license to other entity — such as the NBA, 2K Games or another agent.

One solution is to construe the implied license not as the right to sublicense the tattoo, but as an implied or even actual waiver of any claims to the tattoo license, because the tattoo artist is on notice that the tattoo bearer may license depictions of himself, including the tattoo. Put another way, the implied license means that the celebrity will be granting licenses of his or her likeness that include the tattoo, but do not specifically segregate the tattoo for licensing.

Another solution is to assume that if the tattoo bearer is indeed sublicensing the implied license, the

tattoo bearer has apparent authority, if not express authority, to license his own publicity rights, including the tattoo. The "Nimmer on Copyright" treatise has noted that there is some authority that "a licensee may, in any event, have apparent authority to sublicense, which would be sufficient to bind the licensor."<sup>[18]</sup>

Namely, in the 1983 U.S. Court of Appeals for the Seventh Circuit case *Gracen v. Bradford Exchange*, Metro-Goldwyn-Mayer Studios Inc. licensed Bradford Exchange to use characters and scenes from "The Wizard of Oz" to create a series of collectors' plates.<sup>[19]</sup> Bradford Exchange then held a competition inviting artists to "submit paintings of Dorothy as played by Judy Garland, with the understanding that the artist who submitted the best painting would be offered a contract for the entire series."<sup>[20]</sup>

The plaintiff Jorie Gracen's painting was chosen as the winner, but then Bradford Exchange signed another artist to complete the series, and that artist copied Gracen's painting. Gracen sued MGM and Bradford Exchange for copyright infringement of her painting, and MGM and Bradford Exchange counterclaimed.

The Seventh Circuit found that even though MGM had not expressly authorized Bradford Exchange to sublicense, Bradford Exchange may have had apparent authority to do so, which meant there was a genuine issue of material fact concerning the scope of Gracen's implied license to make a derivative work.<sup>[21]</sup>

Applying the apparent authority framework to sublicenses of tattoos, courts could construe the relationships between rights this way: The tattoo artist would grant an implicit, nonexclusive license to the tattooed celebrity. The celebrity would have apparent authority to license his publicity rights. The celebrity's license of publicity rights would then include a sublicense of the tattoo artist's implicit license to create derivative works of the tattoo, insofar as such derivative works are necessary to depict the celebrity persona accurately.

As a public policy matter, apparent authority would be a way to ensure celebrities still have commercial control over their own personas — even if their personas incorporate a tattoo artist's copyrighted work — unless and until the celebrity expressly contracts that control away.

### **Implied Licenses in Video Games and Other Media**

Finding that the tattoo artist has granted some kind of implied license both rings true and creates important stability in the sports and entertainment industry, where celebrities frequently license their likenesses to third parties. To find that there is no implied license, or no implied sublicense, could create a chaotic and expensive system in which content creators would need to seek permission from tattoo artists before depicting tattooed celebrities in other media.

Additionally, the absence of legislative or judicial uniformity as to the right to license a likeness bearing a tattoo creates potential confusion for licensees as to liability, which may vary from state to state or among the federal circuits.

Under the implied license theory, any photographic, videographic or other artistic depictions of tattooed celebrities would clearly not constitute copyright infringement of the tattoos. Likewise, other depictions of a tattooed celebrity's likeness, such as dolls or action figures that incorporate celebrity tattoos, would not be considered copyright infringement under the implied license theory.<sup>[22]</sup>

But that is not to say the implied license theory has no limiting principle. The Solid Oak Sketches court and the Alexander court both recognized valid copyrights in the tattoos themselves.[23] As a result, exploiting the tattoo image itself, disaggregated from the tattooed celebrity's persona, could still constitute infringement.

For example, a third lawsuit, *Hayden v. 2K Games* in the U.S. District Court for the Northern District of Ohio, alleges that a newer NBA 2K video game allows users to purchase custom tattoo add-ons and includes "a customizable 'MyPlayer' feature that includes over 3,000 customizable tattoos that can be moved, scaled, rotated, and placed" on players.[24] Once a tattoo is literally detached from the NBA player who bears it, it's arguably less obvious whether the use of the tattoo is within the scope of the implied license.

Likewise, apparel featuring famous tattoos could potentially pose unique problems for the implied license theory. For instance, the plaintiff in *Alexander* also alleges that WWE sold tattoo sleeves featuring her work in 2009.[25] On one hand, such cosplay apparel could be a kind of depiction of a celebrity's likeness within the scope of the implied license. On the other hand, apparel exploiting the tattoo itself — and only the tattoo, without other aspects of the celebrity's likeness — could potentially be deemed infringing of the tattoo artist's work.

The outer bounds of implied licenses may consist of temporary tattoos that mimic celebrity tattoos. Temporary tattoos are increasingly popular, and temporary versions of the ink on Ariana Grande, Kylie Jenner and Mike Tyson are readily available for sale online.[26] Even under *Solid Oak Sketches*, an implied license may not provide a defense to infringement of a copyrighted tattoo, completely disaggregated from the person originally tattooed.

Even if a court finds that there is no implied license in the tattoo context, defendants can fall back on fair use or *de minimis* arguments.[27] But as these cases wind through the courts, hopefully more judges will follow *Solid Oak Sketches* in providing guidance on this emerging problem in copyright law. In the meantime, content creators have no choice but to exercise caution with depictions of tattooed celebrities in new media such as video games.

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[1] John LaRosa, *Tattoo Parlors & Tattoo Removal Is Now a Booming \$3 Billion Industry*, MarketResearch.com (Sept. 12, 2018), <https://blog.marketresearch.com/tattoo-parlors-tattoo-removal-is-now-a-booming-3-billion-industry>.

[2] 17 U.S.C. § 102(a); see also *id.* § 101 ("A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.").

[3] See *Solid Oak Sketches, LLC v. 2K Games, Inc.*, 449 F. Supp. 3d 333 (S.D.N.Y. 2020); *Alexander v. Take-*

Two Interactive Software, Inc., No. 18-cv-966-SMY, 2020 WL 5752158 (S.D. Ill. Sept. 26, 2020); Fourth Amended Complaint, Hayden v. 2K Games, Inc., No. 17-cv-02635-CAB, 2019 WL 4179634 (N.D. Ohio, Aug. 19, 2019).

[4] Complaint, Jeffrey Sedlik v. Katherine Von Drachenberg, No. 2:21-cv-01102 (C.D. Cal. Feb. 7, 2021).

[5] Brophy v. Belcalis et al., No. 8:17-cv-01885 (C.D. Cal. Dec. 4, 2020).

[6] 2 Patry on Copyright § 5:131.

[7] Solid Oak Sketches, LLC, 449 F. Supp. 3d at 340.

[8] *Id.* at 346.

[9] *Id.* at 343–45, 346–50.

[10] Alexander v. Take-Two Interactive Software, Inc., 18-CV-966-SMY, 2020 WL 5752158 (S.D. Ill. Sept. 26, 2020).

[11] *Id.* at \*3.

[12] *Id.* at \*4.

[13] *Id.* at \*3.

[14] See 2 Patry on Copyright § 5:131 (quoting *Karlson v. Red Door Homes, LLC*, 611 Fed.Appx. 566, 2015 WL 2117247 (11th Cir. May 7, 2015)).

[15] 17 U.S.C. § 204(a); see also 2 Patry on Copyright § 5:118 ("Oral and implied licenses can only be nonexclusive since Section 204(a) requires exclusive licenses to be in writing.").

[16] 3 Nimmer on Copyright § 10.01(C)(4) (collecting cases); see also § 10.02(B)(4)(a) (explaining the 1909 Copyright Act forbid all licensees from sublicensing, but the current Act only limits nonexclusive licensees from sublicensing).

[17] 2 Patry on Copyright § 5:127 (emphasis added); see also *Photographic Illustrators Corp. v. Orgill, Inc.*, 953 F.3d 56, 63 (1st Cir. 2020) (distinguishing an implied sublicense of an express license from an implied sublicense of an implied license).

[18] 3 Nimmer on Copyright § 10.01(C)(4) n.73.

[19] *Gracen v. Bradford Exch.*, 698 F.2d 300 (7th Cir. 1983).

[20] *Id.* at 301.

[21] *Id.* at 303.

[22] See, e.g., *McFarlane Toys NBA Series 26 LeBron James Action Figure*, Amazon.com, <https://www.amazon.com/McFarlane-Toys-Lebron-Action->

Figure/dp/B00P45FULU/ (last visited March 8, 2021).

[23] Solid Oak Sketches, LLC, 449 F. Supp. 3d at 340; Alexander v. Take-Two Interactive Software, Inc., 18-CV-966-SMY, 2020 WL 5752158 at \*3.

[24] Fourth Amended Complaint at ¶¶ 116, 122, Hayden v. 2K Games, Inc., No. 17-cv-02635-CAB, 2019 WL 4179634 (N.D. Ohio, Aug. 19, 2019).

[25] Plaintiff Catherine Alexander's Memorandum of Law in Opposition to Defendants' Motion for Summary Judgment, Alexander v. Take-Two Interactive Software, Inc., 18-CV-966-SMY (S.D. Ill. Sept. 10, 2020), ECF 215, at 15–16.

[26] E.g., H2GKMO Ariana Grande Temporary Tattoos (Set of 4), Etsy, <https://www.etsy.com/listing/686749657/h2gkmo-ariana-grande-temporary-tattoos> (last visited March 8, 2021); Kylie Jenner Inspired Temporary Tattoos, Etsy, <https://www.etsy.com/listing/661543884/kylie-jenner-inspired-temporary-tattoos> (last visited March 8, 2021); Mike Tyson Temporary Tattoos (2-Pack), Etsy, <https://www.etsy.com/listing/816297190/mike-tyson-temporary-tattoos-2-pack> (last visited March 8, 2021).

[27] E.g., Solid Oak Sketches, LLC, 449 F. Supp. 3d at 343–45, 346–50 (finding the defendants' use of the tattoos was both de minimis and fair); Alexander v. Take-Two Interactive Software, Inc., 18-CV-966-SMY, 2020 WL 5752158 at \*4–\*6 (denying defendants' motion for summary judgment on their fair use and de minimis defenses); see also Latimer v. Roaring Toyz, Inc., 574 F. Supp. 2d 1265, 1276 (M.D. Fla. 2008) (finding a photographer granted a motorcycle company an implied license to use his photographs, and when the motorcycle company put those photographs in a press kit, the magazine that printed the photographs had engaged in fair use), affirmed in part and reversed in part by Latimer v. Roaring Toyz, Inc., 601 F.3d 1224 (11th Cir. 2010).