

HOW TATTOOS FIT WITHIN THE REALM OF COPYRIGHT LAW: DO WE FINALLY HAVE A LAWSUIT THAT WILL PROVIDE SOME CLARITY?

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I. INTRODUCTION

The *NBA 2K* video game series is reaching unprecedented levels of success thanks to its latest version, *NBA 2K16*.¹ In an effort to make the game more realistic, developers reproduced real-life tattoos on the virtual personas of National Basketball Association (NBA) players.² These players include some of the best in the league – LeBron James, Kobe Bryant, DeAndre Jordan, Kenyon Martin, and Eric Bledsoe.³ Whether this “realistic” strategy is what caused the great success may be up for some debate, but there is no debating the sales-success the video game has had since its release.⁴

The game was released on September 25, 2015 and within its first week on the market it sold over four million copies.⁵ By the next month, the game more than doubled the previous year’s sales for digital copies, while nearly tripling the amount of online games played.⁶ Jason Argent, who is a Senior Vice President of Operations for 2K, described the success, stating, “*NBA 2K* fans around the world are buying this title faster and in greater numbers than ever before.”⁷ *NBA 2K16* was the best-selling video game in the United States, topping other

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1. See Bryan Wiedey, *Lawsuit Filed Over Copyrighted Tattoos on Players in NBA 2K16*, SPORTINGNEWS (Feb. 2, 2016), <http://www.sportingnews.com/other-sports/news/lawsuit-filed-over-copyrighted-tattoos-on-players-in-nba-2k16-lebron-james-kobe-bryant/15pm9g4a2xfdr1xkz6hnfjry3h>.

2. See Ahiza Garcia, *NBA 2K Video Game Company Sued for Showing Players’ Tattoos*, CNN MONEY (Feb. 3, 2016, 6:05 PM), <http://money.cnn.com/2016/02/03/media/nba-2k-lawsuit-tattoos-video-game/index.html>.

3. *Id.*

4. See generally Eddie Makuch, *NBA 2K16 Breaks Records With 4 Million Copies Shipped in Under One Week*, GAMESPOT, <http://www.gamespot.com/articles/nba-2k16-breaks-records-with-4-million-copies-ship/1100-6431093/> (last updated Oct. 2, 2015).

5. *Id.*

6. *Id.*

7. *Id.*

well-known video game franchises such as *Madden NFL 16*, *Metal Gear Solid*, and *FIFA 16*.⁸ In fact, *NBA 2K16* wasn't just the best selling video game at that time – it was the best ever.⁹ The video game had the best launch month ever for a sports game on the 8th generation of video game consoles.¹⁰ The game was so successful that 2K's video-game rival, Electronic Arts' *NBA Live 16*, couldn't even crack the top ten on the list of best-selling video games.¹¹

The financial rewards for Take-Two, 2K's parent company, are astounding.¹² For the second quarter of 2015, the quarter in which *NBA 2K16* was released, Take-Two saw tremendous increases in revenue and net income.¹³ When compared to the same quarter of the year before, revenue jumped 169 percent to \$364.9 million.¹⁴ The company produced a net income of \$32.7 million.¹⁵ The company lost \$35.4 million the year before.¹⁶ All told, that's a remarkable difference of \$68.1 million. While the company also released two other major video games, *Grand Theft Auto V* and *WWE 2K16*, the majority of this revenue undoubtedly came from the chart-topping NBA series.¹⁷ This financial success passed on to Take-Two's shareholders, with their predicted earnings of 15 cents per share doubling to 30 cents per share.¹⁸

So what makes this version of the virtual basketball game so much better than the rest? Sports media empire Bleacher Report gives three reasons why

8. *September 2015 NPD Sales Analysis: NBA2K16 has the Best Launch for a Sports Game on 8th gen*, GEARNUKE (Oct. 20, 2015), <http://gearnuke.com/september-2015-npd-sales-analysis-nba2k16-best-launch-sports-game-8th-gen/>.

9. *See id.*

10. *Id.* (A "generation" of a video game console is an era in which the video game was produced. So, here, this game sold on the 8th version of the video game console, which is the most recent generation.)

11. *Id.*

12. *See* Christin Nutt, *Take-Two Revenues Leap as NBA 2K16 Soars*, GAMASUTRA (Nov. 5, 2015), http://www.gamasutra.com/view/news/258619/TakeTwo_revenues_leap_as_NBA_2K16_soars.php.

13. *See id.*

14. *Id.*

15. *Id.*

16. *Id.*

17. *See id.*

18. *Id.*

this version is better than the rest: (1) team customization and 2K Pro-am; (2) colleges in MyCareer; and (3) the aforementioned tattoos.¹⁹ The new team customization and 2K Pro-am tour allows players to customize their own team – with everything from branding the team with a new logo, to building a new arena, to designing a new uniform, or relocating the team entirely.²⁰ This customized team can then be used for the 2K Pro-am setting, which allows for players to team up with up to five friends to play a game together.²¹ The addition of colleges in the game’s MyCareer feature allows players to choose which college they want to attend before controlling the player throughout a simulated NBA career.²² Third, critics love the improvement of player tattoos, which have appeared in the game since at least the *2K14* version.²³ *NBA 2K16* contains updated, accurate player tattoos, as well as a feature that allows gamers to build their own player and deck them out in personalized tattoos.²⁴ The tattoo feature plays a large role in the video game’s great success, as it is “leagues ahead of what has been offered in the past.”²⁵ With record-breaking sales, exponentially increased income, and beloved new features, all was well with *NBA 2K16*.

However, in February of 2016, 2K Sports, Take-Two, and Visual Concepts (a subsidiary of 2K that is in charge of the marketing and development of 2K’s products) (collectively “Defendants”) were hit with a lawsuit.²⁶ Solid Oak Sketches (“Plaintiff”) filed a copyright infringement lawsuit against the makers of *NBA 2K16* in the United States District Court for the Southern District of New York.²⁷ The complaint alleges that six tattoos on the five players previously

19. Brian Mazique, *NBA 2K16: Breaking Down Best New Features for This Year’s Game*, BLEACHER REPORT (Aug. 31, 2015), <http://bleacherreport.com/articles/2558410-nba-2k16-breaking-down-best-new-features-for-this-years-game>.

20. *Id.*

21. *See id.*

22. *Id.*

23. *See id.*

24. *Id.*

25. *Id.*

26. *See* Peter Perkowsky, *Tattoos, Copyright Infringement, and Celebrities: Litigation Edition, Round Four*, THE WHITE BRONCO (Feb. 5, 2016), <http://thewhitebronco.com/2016/02/tattoos-copyright-infringement-and-celebrities-litigation-edition-round-four/>.

27. *See generally* Complaint for Copyright Infringement, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124.

mentioned – LeBron James, Kobe Bryant, DeAndre Jordan, Kenyon Martin, and Eric Bledsoe – were unlawfully reproduced in the game, with some even being featured in advertisements and cover art.²⁸ Solid Oak Sketches, who is represented by Heitner Legal, owns the copyright to these tattoo designs and seeks compensation for their use.²⁹ This note attempts to predict what the outcome of this case will be if it continues on to trial.

II. BACKGROUND

The issue of copyright and tattoos is not an issue of first impression.³⁰ As TheWhiteBronco.com puts it, “[t]his is not the first litigation volley in the tattoo copyright wars.”³¹ However, no court has ever confirmed whether tattoos are copyrightable.³² There have been several cases concerning the issue, but they have all settled out of court and without a ruling.³³ This section will take an in-depth look at these previous instances, highlighting the facts of each case to show similarities to the complaint filed by Solid Oak Sketches.

A. *Escobedo v. THQ, Inc.*

Chris Escobedo is a tattoo artist based in Phoenix, Arizona.³⁴ In 2009, he applied a large lion tattoo on the right ribcage of the Ultimate Fighting Championship’s (“UFC”) Carlos Condit, who went on to become the interim UFC Welterweight Champion.³⁵ Prior to applying the tattoo to Condit’s skin, Escobedo drew the design out on paper.³⁶ In 2012, the United States Copyright Office recognized Escobedo as the copyright owner of the work.³⁷ The work was

28. Perkowsky, *supra* note 26.

29. ‘NBA 2K’ Videogame Maker Sued for Copyright Infringement Over LeBron James’ Tattoos, Yahoo! (Feb. 1, 2016), <https://www.yahoo.com/movies/nba-2k-videogame-maker-sued-copyright-infringement-over-222528485.html>.

30. Perkowsky, *supra* note 26.

31. *Id.*

32. *Id.*

33. *Id.*

34. Complaint, *Escobedo v. THQ*, No. 2:12CV02470 (D.Ariz. 2012), 2012 WL 5815742.

35. *Id.*

36. *Id.*

37. *Id.*

given the title “Lion Tattoo.”³⁸ THQ is a company that develops and publishes video games – most relevant here is the game *UFC Undisputed 2010*, which was released around May of 2010.³⁹ Two years later, THQ released another game – *UFC Undisputed 3* – as a follow-up feature.⁴⁰ In both games, the “Lion Tattoo” was featured on Condit’s character.⁴¹

As a result, Escobedo brought suit for copyright infringement, claiming the tattoo was prominently shown in several of the game’s features – particularly during highlight reels, replays, between each fight’s rounds, and during the rounds.⁴² While Escobedo admitted that he had impliedly licensed Condit to publicly display the tattoo on his body, he gave no such license to the makers of the video game.⁴³ Therefore, Escobedo claimed that THQ had violated his rights by reproducing, copying, creating a derivative work, distributing, and displaying his work.⁴⁴ Escobedo cited the game’s retail price (\$59.99) and sales data (it had sold approximately 660,00 copies at the time the complaint was filed) to claim a right to receive actual damages.⁴⁵ Escobedo was seeking \$4 million in compensation.⁴⁶

A bankruptcy court eventually awarded Escobedo \$22,500 for the tattoo.⁴⁷ Escobedo appealed this judgment, challenging the award as inadequate.⁴⁸ The matter was settled out of court shortly thereafter for an undisclosed amount.⁴⁹

38. *Id.*

39. Complaint, Escobedo v. THQ, No. 2:12CV02470 (D.Ariz. 2012), 2012 WL 5815742.

40. *Id.*

41. *Id.*

42. *See id.*

43. *Id.*

44. Complaint, Escobedo v. THQ, No. 2:12CV02470 (D.Ariz. 2012), 2012 WL 5815742.

45. *Id.*

46. Bryan Wiedey, *Lawsuit Filed Over Copyrighted Tattoos on Players in NBA 2K16*, SPORTINGNEWS (Feb. 2, 2016), <http://www.sportingnews.com/other-sports/news/lawsuit-filed-over-copyrighted-tattoos-on-players-in-nba-2k16-lebron-james-kobe-bryant/15pm9g4a2xfdr1xkz6hnfjry3h>.

47. *‘NBA 2K’ Videogame Maker Sued for Copyright Infringement Over LeBron James’ Tattoos*, Yahoo! (Feb. 1, 2016), <https://www.yahoo.com/movies/nba-2k-videogame-maker-sued-copyright-infringement-over-222528485.html>.

48. Wiedey, *supra* note 46.

49. *Id.*

EA Sports eventually gained the rights to the *UFC* virtual series, and prior to releasing their first version of the game, they removed the tattoo from Condit's body.⁵⁰ While it appears (though we don't know for sure since no opinion was issued) the bankruptcy court acknowledged the infringement of Escobedo's work, the public is left with little information about the details of infringement on tattoos or, thanks to the confidentiality agreement in the settlement, the value of such infringement.

B. Allen v. Electronic Arts, Inc.

Allen v. Electronics Arts, Inc. is another case that bears a striking resemblance to the one involving Solid Oak Sketches and Take-Two.⁵¹ Stephen Allen is a tattoo artist for Crybabies Tattoo and works out of Shreveport, Louisiana.⁵² In 2003, Ricky Williams, a player in the National Football League (NFL), sought out Allen for a tattoo.⁵³ Allen applied the tattoo to Williams' arm, charged Williams \$200 for the work, and had Williams sign a document entitled "Consent to Tattoo or Piercing Procedure Release of Claims."⁵⁴ Allen knew Williams was a professional football player and expected to see the tattoo on television.⁵⁵

However, several years later Allen filed suit against Williams and Electronic Arts (EA) when he saw the tattoo appearing on the cover of EA's video games *NFL Street*, *Madden NFL 10*, and *Madden NFL 11*.⁵⁶ The complaint alleged that Allen was never contacted in regards to permission to use the tattoo, but nevertheless EA "copied, reproduced, distributed, adapted and/or publicly displayed" the copyrighted work.⁵⁷ The complaint named Williams as a defendant due to his alleged "contributory infringement of Plaintiff's copyright and exclusive rights."⁵⁸ Allen asked the court to force Williams to produce

50. *Id.*

51. *See generally* Complaint for Copyright Infringement and Accounting and Other Relief, *Allen v. Electronics Arts*, No. 5:12-V-3172 (W.D.La. 2012), 2012 WL 6852208.

52. *See id.*

53. *See id.*

54. *Id.*

55. *Id.*

56. *See id.*

57. Complaint for Copyright Infringement and Accounting and Other Relief, *Allen v. Electronics Arts*, No. 5:12-V-3172 (W.D.La. 2012), 2012 WL 6852208.

58. *Id.*

documents showing how much money he made from the use of the tattoo and, based off those numbers, compensate Allen his fair share.⁵⁹ Just three and a half months after the complaint was filed, and before a court could give a ruling on the issue, the case was settled out of court for an undisclosed amount.⁶⁰

C. Reed v. Nike, Inc.

A similar conflict comes out of the United States District Court for the District of Oregon.⁶¹ Matthew Reed filed a lawsuit against Nike, Rasheed Wallace, and Weiden+Kennedy for the alleged infringement of his work.⁶² According to Reed's complaint, Wallace, who was an NBA player, sought him out for a tattoo involving an Egyptian theme.⁶³ The two met on multiple occasions, with Wallace offering up the general idea, Reed drafting up an image, Wallace requesting changes, and finally a reduction of the final tattoo to a stencil.⁶⁴ The tattoo was then applied to Wallace's arm for a fee of \$450 (which was actually below value, but Reed was willing to sacrifice some money in exchange for the exposure it would bring for his business).⁶⁵ Reed obtained a copyright for the work, titled "Egyptian Family Pencil Drawing."⁶⁶

In 2004, Reed learned that Nike, whom Wallace had an endorsement deal with, was featuring the tattoo in a new advertising campaign.⁶⁷ Weiden+Kennedy, the third defendant in the complaint, was hired by Nike to create, manage, and coordinate the advertising campaign.⁶⁸ The commercial involves an image of the tattoo being recreated over Wallace's skin, with

59. *Id.*

60. Jennifer L. Commander, Note, *The Player, The Video Game, and The Tattoo Artist: Who has the Most Skin in the Game?*, 72 Wash. & Lee L. Rev. 1947, 1964 (2015).

61. *See generally* Complaint Copyright Infringement Accounting, Reed v. Nike, No. CV 05 198 (D.Or. 2005), 2005 WL 1182840.

62. *See id.*

63. *Id.*

64. *See id.*

65. *Id.*

66. Jennifer L. Commander, Note, *The Player, The Video Game, and The Tattoo Artist: Who has the Most Skin in the Game?*, 72 Wash. & Lee L. Rev. 1947, 1957 (2015).

67. Reed, *supra* note 61.

68. *Id.*

Wallace doing a voice-over explaining the tattoo's meaning.⁶⁹ After learning of this, Reed filed suit, alleging that Nike and Weiden+Kennedy copied, reproduced, distributed, adapted, and/or publicly displayed his copyrighted work.⁷⁰ Much like in *Allen* above, this lawsuit alleged Wallace advised his co-defendants that he had exclusive ownership of the tattoo and, at a minimum, his conduct "caused or materially contributed to the unauthorized" infringement.⁷¹ Additionally, Reed claimed that if it were found he and Wallace were co-owners of the tattoo, he was entitled to a portion of Wallace's profit from the endorsement.⁷² Unfortunately, like the other cases, the issue settled out of court and the terms of the settlement are still private.⁷³

D. Whitmill v. Warner Bros.

This case is perhaps the most well-known and insightful case we have on this issue.⁷⁴ It is "the most (in)famous of the tattoo and copyright cases."⁷⁵ Victor Whitmill applied a tattoo to professional boxer and former world heavyweight champion Mike Tyson's face, which, as Whitmill describes it, has since become "one of the most distinctive tattoos in the nation."⁷⁶ Eight years later, Warner Bros. began advertising for their new movie, *The Hangover Part II*.⁷⁷ Warner Bros. admits to copying the tattoo to the face of a character in the movie, Stu Price.⁷⁸ In addition to being featured for over half the film, the tattoo is the "prominent focus" of an advertising campaign, a promotional event in which fans can get a collectible cup with an image of Stu's face (with the tattoo), and an iPhone app that allows users to download a badge that consists of the tattoo on a blank background, presumably so users can take a picture of a

69. *See id.*

70. *Id.*

71. *Id.*

72. *Id.*

73. Jennifer L. Commander, Note, *The Player, The Video Game, and The Tattoo Artist: Who has the Most Skin in the Game?*, 72 Wash. & Lee L. Rev. 1947, 1960 (2015).

74. *See id.*

75. *Id.*

76. Verified Complaint for Injunctive and Other Relief, *Whitmill v. Warner Bros.*, No. 4:11-cv-752 (E.D.Mo. 2011) 2011 WL 2038147.

77. Commander, *supra* note 73 at 1960.

78. Plaintiff's Reply Memorandum in Support of His Motion for Preliminary Injunction, *Whitmill v. Warner Bros.*, No. 4:11-cv-752CDP (E.D.Mo. 2011) 2011 WL 11569200.

face so it will appear with the tattoo on it.⁷⁹ After learning of this, Whitmill sued Warner Bros. for infringing on his exclusive rights to the tattoo.⁸⁰

The complaint alleged that on the day that tattoo was completed, Tyson signed a release form stating “that all artwork, sketches and drawings related to [his] tattoo and any photographs of [his] tattoo are property of Paradox-Studio of Dermagraphics.”⁸¹ Whitmill claimed to have a copyright to the tattoo and stated he had never applied the tattoo onto anyone else or authorized anyone “to copy, distribute, or publicly disseminate” the tattoo.⁸² The complaint stated Warner Bros. infringed on the copyright by copying, distributing, and publicly displaying the tattoo, as well as through the making of an unauthorized derivative work based off the original.⁸³ Whitmill sought damages and, more importantly, a preliminary injunction throughout the pendency of the action to stop the movie from being released.⁸⁴

Not surprisingly, Warner Bros. objected to the preliminary injunction and asked the court to deny the motion.⁸⁵ First, Warner Bros. asserted that when a work of art is transformed into a tattoo, it becomes a part of the public domain and is no longer a protectable art.⁸⁶ This is because the tattoo cannot be separated from Tyson’s face, which is a “useful article.”⁸⁷ Second, Warner Bros. used the “Fair Use” defense.⁸⁸ This weighs four factors to determine if one party’s use of the other party’s work should not be punished: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the portion of the work used in relation to the entire work; and (4) the effect of the accused use on the market or value of the copyrighted work.⁸⁹ Third, Warner Bros. claimed to have an implied license to use the tattoo.⁹⁰ Fourth, Warner Bros.

79. *See id.*

80. *Commander, supra* note 73 at 1961.

81. *Whitmill, supra* note 76.

82. *Id.*

83. *Id.*

84. *See id.*

85. *See generally Whitmill*, 2011 WL 11569200.

86. *See id.*

87. *Id.*

88. *Id.*

89. *See id.*

presented an estoppel argument, arguing that since Whitmill did not object to Tyson's appearance (as well as, obviously, the tattoo's appearance) in the first Hangover movie, they could not object now.⁹¹

Whitmill responded with counter-arguments, explaining why each of the claims set forth by Warner Bros. was invalid.⁹² Whitmill claimed that all of Warner Bros. assertions were affirmative defenses for which they cannot meet their burden of proof.⁹³ First, Whitmill claimed that tattoos are copyrightable because "[t]hey are 'pictorial works' 'fixed in any tangible medium of expression . . . from which they can be perceived . . . directly.'"⁹⁴ Then, Whitmill rebutted Warner Bros. by showing that a "useful article" is defined as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey the information."⁹⁵ Whitmill compared tattoos to a pattern on an umbrella; the umbrella is not copyrightable, but the design on the umbrella is.⁹⁶ Then, Whitmill asked Warner Bros. to think of how their own argument would negatively effect them – if tattoos were not copyrightable, Warner Bros. "risks losing a significant portion of its own copyright portfolio anytime someone gets a tattoo of Bugs Bunny."⁹⁷

Second, Whitmill claimed the infringement is not a "fair use."⁹⁸ Whitmill argued the purpose of Warner Bros.' use of the tattoo is purely for commercial reasons – it is used as part of a marketing campaign that will remind viewers of the first *Hangover* movie and entice them to watch *The Hangover Part II* as well.⁹⁹ The four factors for determining "fair use" – (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the portion of the work used in relation to the entire work; and (4) the effect of the accused use on the market or value of the copyrighted work – all favor Whitmill as well,

90. *Whitmill*, 2011 WL 11569200.

91. *See id.*

92. *See generally id.*

93. *Id.*

94. *Id.* (citing 17 U.S.C. § 102(a)).

95. *Id.* (citing 17 U.S.C. § 101).

96. *Whitmill*, 2011 WL 11569200.

97. *Id.*

98. *See id.*

99. *Id.*

according to his memorandum.¹⁰⁰ Third, Whitmill argued that the implied license is limited to Tyson and Tyson only, arguing that since he was never in contact with Warner Bros. they must have gotten the “implied license” as a sub-licensee, which is a legal position for which there is no support.¹⁰¹ Fourth, Whitmill objected to the estoppel argument due to Tyson’s implied license.¹⁰² Because Tyson had an implied license for the tattoo, Whitmill argued, there was nothing to object to in the first *Hangover* movie (in which Tyson appears, playing himself).¹⁰³ Whitmill also explained that the first element to an estoppel claim is the plaintiff’s knowledge of defendant’s conduct.¹⁰⁴ There was nothing in the first movie that would have indicated or put Whitmill on notice that the tattoo would be reproduced in the second movie.¹⁰⁵ Therefore, Warner Bros. does not meet the elements required for an estoppel claim.¹⁰⁶

Judge Perry heard the arguments on Whitmill’s Motion for a Preliminary Injunction, which would have stopped the film from releasing unless the tattoo was removed from Stu’s face.¹⁰⁷ Although she denied the motion, Judge Perry did not seem entirely unconvinced by Whitmill’s arguments, stating that the “[p]laintiff has a strong likelihood of prevailing on the merits for copyright infringement.”¹⁰⁸ She went on to criticize Warner Bros. defenses and proclaimed, “Most of the defendant’s arguments against [copyright infringement] are silly. Of course tattoos can be copyrighted. I don’t think there is any reasonable dispute about that.”¹⁰⁹ Later that same day, the parties settled for an undisclosed amount and the issue was resolved with no court ruling.¹¹⁰

100. *See id.*

101. *Whitmill*, 2011 WL 11569200.

102. *See id.*

103. *Id.*

104. *Id.*

105. *Id.*

106. *See generally id.*

107. Jennifer L. Commander, Note, *The Player, The Video Game, and The Tattoo Artist: Who has the Most Skin in the Game?*, 72 Wash. & Lee L. Rev. 1947, 1962 (2015).

108. *See generally id.*

109. *Id.* at 1963.

110. *Id.*

E. Madden NFL and the approach of the NFLPA

While this section does not discuss a lawsuit, it shows how professional football and the *Madden NFL* video game series are “practicing avoidance” of the issue.¹¹¹ *Madden NFL* no longer depicts players with tattoos, with very few exceptions.¹¹² In *Madden NFL ‘15*, Colin Kaepernick, quarterback for the San Francisco 49ers, was the only player with tattoos.¹¹³ Kaepernick’s tattoos were allowed because they secured the licenses from the quarterback’s tattoo artists, a process which took “a fair amount of work.”¹¹⁴ In the newest release of *Madden*, Odell Beckham Jr. and Martavis Bryant joined Kaepernick.¹¹⁵ These two players also obtained the necessary permission from their artists.¹¹⁶ *Madden NFL* has perhaps been the most cautious on the issue, realizing the potential legal ramifications that could follow putting tattoos on all players.¹¹⁷ Even with the sacrifice of a small piece of authenticity, the game has enjoyed immense success, selling over 100 million copies.¹¹⁸

The NFLPA (National Football League Player’s Association) has taken note of these copyright issues as well, urging players to get waivers, licenses, or assignments from their tattoo artists for all public appearances.¹¹⁹ According to SportingNews, the NFLPA’s caution could also be a contributing factor to

111. See Peter Perkowsky, *Tattoos, Copyright Infringement, and Celebrities: Litigation Edition, Round Four*, THE WHITE BRONCO (Feb. 5, 2016), <http://thewhitebronco.com/2016/02/tattoos-copyright-infringement-and-celebrities-litigation-edition-round-four/>.

112. *Id.*

113. Jennifer L. Commander, Note, *The Player, The Video Game, and The Tattoo Artist: Who has the Most Skin in the Game?*, 72 Wash. & Lee L. Rev. 1947, 1949 (2015).

114. *Id.* (citing Samit Sarker, *Why Tattoos Are Just Now Returning to Madden with Madden NFL 15*, POLYGON (June 5, 2014, 3:00 PM), <http://www.polygon.com/2014/6/5/5782540/madden-nfl-15-tattoos-returning-colin-kaepernick>).

115. Bryan Wiedey, *Lawsuit Filed Over Copyrighted Tattoos on Players in NBA 2K16*, SPORTINGNEWS (Feb. 2, 2016), <http://www.sportingnews.com/other-sports/news/lawsuit-filed-over-copyrighted-tattoos-on-players-in-nba-2k16-lebron-james-kobe-bryant/15pm9g4a2xfdr1xkz6hnfjry3h>.

116. *Id.*

117. Commander, *supra* note 114 at 1948.

118. *Id.*

119. Peter Perkowsky, *Tattoos, Copyright Infringement, and Celebrities: Litigation Edition, Round Four*, THE WHITE BRONCO (Feb. 5, 2016), <http://thewhitebronco.com/2016/02/tattoos-copyright-infringement-and-celebrities-litigation-edition-round-four/>.

Madden NFL's lack of tattoo-covered players.¹²⁰ In 2014, the NFLPA notified players that, absent express written permission, their tattoos “would not appear in products such as video games, on merchandise or in advertising where the art has to be reproduced.”¹²¹ This puts the burden on the players – if they want their tattoos to be shown off, then they need to be the ones to put forth the effort to obtain the proper licensing.¹²² So far, only Kaepernick, Beckham Jr., and Bryant have received the “green light.”¹²³

III. DISCUSSION OF SOLID OAK SKETCHES V. 2K SPORTS

The eight tattoos in question in *Solid Oak Sketches v. 2K Sports* were created by five different tattoo artists, all of which agreed to a deal giving up their rights, in exchange for royalties, to Solid Oak Sketches.¹²⁴ Shawn Rome created the works “330 and Flames Tattoo Artwork,” “Lion’s Head Tattoo Artwork,” and “Script with a scroll, clouds, and doves.”¹²⁵ All three of these tattoos were given to LeBron James.¹²⁶ Justin Wright created the work titled “Child Portrait tattoo Artwork.”¹²⁷ LeBron James was also the recipient of this tattoo.¹²⁸ Tommy Ray Cornett created “Basketball with Stars and Script” and “Wizard.”¹²⁹ “Basketball with Stars and Script” was given to Eric Bledsoe, while “Wizard” was inked onto Kenyon Martin.¹³⁰ Kobe Bryant received the tattoo “Crown with Butterflies,” which was created by Robert Benedetti.¹³¹ Lastly, DeAndre Jordan was the

120. Weidey, *supra* note 116.

121. *Id.*

122. *See id.*

123. *Id.*

124. Ahiza Garcia, *NBA 2K Video Game Company Sued for Showing Players’ Tattoos*, CNN MONEY (Feb. 3, 2016, 6:05 PM), <http://money.cnn.com/2016/02/03/media/nba-2k-lawsuit-tattoos-video-game/index.html>.

125. Complaint for Copyright Infringement, *Solid Oak Sketches v. Visual Concepts, LLC*, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124.

126. *See id.* at Exhibit B.

127. *Id.*

128. *See id.* at Exhibit B.

129. *Id.*

130. *See* Complaint for Copyright Infringement, *Solid Oak Sketches v. Visual Concepts, LLC*, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124, at Exhibit B.

131. *Id.*

recipient of a tattoo created by Leslie Hennelly entitled “Script with a Scroll.”¹³² Solid Oak Sketches claims, and offers copies of agreements to prove, that they are the owner of the rights of each of these tattoo designs.¹³³ Though the negotiation letters list all eight of these tattoos, the actual complaint does not list Bryant’s or Jordan’s tattoos.¹³⁴ This means that the lawsuit only involves six tattoos on three players.¹³⁵

Prior to the filing of the lawsuit, Solid Oak Sketches reached out to the creators of *NBA 2K16* in an attempt to reach an agreement out of court.¹³⁶ In the initial demand letter, Solid Oak Sketches did not specify what compensation they were seeking, instead pushing the issue off on the video game makers and ensuring the agreement would be confidential:

“I can assure you that my clients would prefer to resolve this matter quietly and amicable [sic]. Assuming the parties can reach an agreement as to fair compensation for the prior unlicensed uses of the tattoos and, if your company so desires, a license for future uses, my clients would be willing to include in the settlement documents an appropriate nondisclosure provision designed to maintain the confidentiality of the settlement, including its very existence.”¹³⁷

In Exhibit B of the complaint, Plaintiff, seemingly in response to a request for an exact dollar figure from Defendants, demanded a total of \$819,500 in damages.¹³⁸ Alternatively, Plaintiff offered a perpetual license for a one-time fee of \$1,144,000.¹³⁹

Plaintiff was very generous to defendants in calculating these damages, basing the numbers off the court’s award to Christopher Escobedo in his previously mentioned suit against THQ.¹⁴⁰ Plaintiff’s demand letter

132. *Id.*

133. *See id.* at Exhibit D-K.

134. *See id.*

135. Complaint for Copyright Infringement, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124.

136. *See id.* at Exhibit A.

137. *See id.*

138. *See id.* at Exhibit B.

139. *Id.*

140. Complaint for Copyright Infringement, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124.

acknowledges that Escobedo's actual compensation was settled for an amount undoubtedly greater than the \$22,500 the court awarded, but stated they were using that number solely as a baseline for the "initial discussion[s]."¹⁴¹ Using Escobedo's award and applying it to the sales data for the *NBA 2K14* and *2K15* games, Solid Oak Sketches claimed to be owed \$572,000 in compensation for the in-game infringement.¹⁴² Since two of LeBron James' tattoos were "featured prominently" on the cover of *NBA 2K14*, plaintiffs "conservatively" estimated their value to be at least four times the rest of the tattoos.¹⁴³ The value of these tattoos was then multiplied by the total sales for the *NBA 2K14* game, accumulating to a total of \$819,500 in damages.¹⁴⁴ To determine the one-time licensing fee, Solid Oak Sketches used the in-game infringement numbers and calculated what it would cost to license the tattoos for four additional years, equaling an amount of \$1,144,000.¹⁴⁵ Again, Plaintiff was generous in this calculation, noting that most of the athletes with the tattoos in question will have careers that last much longer than four years.¹⁴⁶ This detailed demand letter was unsuccessful, causing Plaintiff to file an official complaint in New York District Court.¹⁴⁷ Ultimately, Plaintiff requested the court award "appropriate statutory and/or monetary damages" and "reasonable attorneys' fees."¹⁴⁸

A. Take-Two's Motion to Dismiss Statutory Damages and Attorneys' Fees

While refusing to admit they had done anything wrong, Defendants responded to the filed complaint by filing a motion to dismiss.¹⁴⁹ The motion to dismiss was "narrow," as it only sought to dismiss Solid Oak Sketches' claim for the statutory damages and attorneys' fees.¹⁵⁰ According to Defendants, 17

141. *Id.*

142. *Id.*

143. *Id.*

144. *Id.*

145. Complaint for Copyright Infringement, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124.

146. *Id.*

147. *See generally id.*

148. *See id.*

149. *See* Memorandum of Law in Support of Defendants 2K Games, Inc. and Take-Two Interactive Software, Inc.'s Motion to Dismiss, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016) 2016 WL 3086067.

150. *Id.*

U.S.C. § 412 (which plaintiff filed the claim under) does not allow for statutory damages and attorneys fees when the work is registered after the infringement has occurred.¹⁵¹ The alleged infringement began, as plaintiff admits, as early as the *2K14* version of the video game.¹⁵² The copyright registrations did not take place until two years after this initial infringement took place, in June and July of 2015.¹⁵³ § 412 states that there will be no “award of statutory damage or of attorney’s fees” for “any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.”¹⁵⁴ Therefore, Defendant asks the court to grant its motion to dismiss the statutory damages and attorneys’ fees claims.¹⁵⁵

Plaintiff, of course, would not go down without a fight.¹⁵⁶ Plaintiff gave four main reasons why they should be entitled to the statutory damages and attorneys’ fees: (1) because the *NBA 2K16* infringement was “overtly willful,” it is separate from the prior infringements;¹⁵⁷ (2) an “appreciable period of time” had passed between the *2K16* infringements and the past infringements, thus making it a new infringement;¹⁵⁸ (3) since the infringement only occurred in, at most, two prior instances (*NBA 2K14* and *NBA 2K15*), the § 412 bar to damages does not apply;¹⁵⁹ and (4) the *NBA 2K16* game is sufficiently different from the previous versions of the game and should therefore be treated as its own infringement.¹⁶⁰ Defendants responded to this by attacking the reasoning as

151. *Id.* (citing *Knitwaves, Inc. v. Lollytogs Ltd.* 71 F.3d 996, 1012 (2d Cir. 1995)).

152. Complaint for Copyright Infringement, *Solid Oak Sketches v. Visual Concepts, LLC*, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124 at Exhibit B.

153. *Solid Oak Sketches*, *supra* note 148.

154. 17 U.S.C. § 412 (2008).

155. *See Solid Oak Sketches*, *supra* note 148.

156. *See Reply Memorandum in Support of Defendants 2K Games, Inc. and Take-Two Interactive Software, Inc.’s Motion to Dismiss, Solid Oak Sketches v. Visual Concepts, LLC*, No: 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016) 2016 WL 3086071.

157. *See id.*

158. *Id.*

159. *Id.*

160. *Id.*

weak and without precedent or support.¹⁶¹ In fact, Defendants argued that Second Circuit precedent actually bounded the court to do exactly the opposite of what Plaintiff was asking.¹⁶² Defendants again asked the court to grant the motion to dismiss and strike down the opportunity for statutory damages and attorneys' fees.¹⁶³

On August 2, 2016, the court offered a ruling on the issue.¹⁶⁴ In granting the motion to dismiss, the court sided with nearly every one of Defendants' arguments.¹⁶⁵ The court noted the initial infringement occurred with the release of *NBA 2K14* in 2013, yet Plaintiff did not register the tattoo designs with the U.S. Copyright Office until 2015.¹⁶⁶ For each of the four points Plaintiff raised in response to the Motion to Dismiss (listed above), the court explained why Plaintiff's arguments were "unavailing."¹⁶⁷ First, the court pointed out that whether or not Defendants acts were "overtly willful" is irrelevant, as willfulness has nothing to do with § 412.¹⁶⁸ Second, the court showed that the one year gap between each infringement does not constitute "an appreciable period of time" as to render it a new infringement.¹⁶⁹ Third, the court ruled it does not matter that the infringement occurred on only two previous occasions, as § 412 precludes statutory damages and attorney fees where *any* infringement occurred before the copyright was registered.¹⁷⁰ Fourth, the court dismissed the idea that since the newest version of *NBA 2K* is different than the past versions, the infringements are new.¹⁷¹ The court reasoned that the game is

161. See Reply Memorandum in Support of Defendants 2K Games, Inc. and Take-Two Interactive Software, Inc.'s Motion to Dismiss, *Solid Oak Sketches v. Visual Concepts, LLC*, No: 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016) 2016 WL 3086071.

162. *Id.*

163. *Id.*

164. See *generally* *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16CV724-LTS, 2016 WL 4126543 (S.D.N.Y. 2016).

165. *Id.* at *4.

166. *Id.* at *2 (*citing* Complaint for Copyright Infringement, *Solid Oak Sketches v. Visual Concepts, LLC*, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124.).

167. *Id.* at *3-4.

168. *Id.* at 3.

169. *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16CV724-LTS, 2016 WL 4126543 (S.D.N.Y. 2016).

170. *Id.*

171. *Id.*

substantially the same, with only slight changes being the title and visual and graphic improvements, and that the same defendants were allegedly infringing on the same tattoos.¹⁷²

B. Take-Two's Answer and Counterclaims

With this ruling behind them, Defendants filed their Answer to the complaint just two weeks later.¹⁷³ In the Answer, Take-Two denied any wrongdoing.¹⁷⁴ Defendants went on to list, but did not elaborate on, seven defenses they believed favored them: (1) failure to state a claim; (2) *de minimis* use; (3) fair use; (4) license; (5) consent, waiver, estoppel; (6) non-infringement; and (7) fraud on the Copyright Office.¹⁷⁵ The Answer also discussed, in further detail than at any point prior, the tattoos and their history.¹⁷⁶ The Answer even included pictures of the tattoos at the heart of the controversy, and for each one, explained the length of time between the actual inking and its copyright filing and Defendants belief that the players had more influence over what the tattoo would look like than the artist did.¹⁷⁷ The Answer also alleged that the tattooists knew the tattoos would become a part of the athletes' image.¹⁷⁸ Take-Two also stated that the tattoos appear only "fleeting" in the game, and they never appear in any other form than as part of the players' likeness.¹⁷⁹ In discussing these aspects of the tattoos, Take-Two was laying the groundwork to argue their defenses.¹⁸⁰

Take-Two's Answer also included three counterclaims.¹⁸¹ First, Take-Two sought a declaratory judgment that use of the tattoos in *NBA 2K16* constitutes a

172. *Id.*

173. Defendants' Answer and Counterclaims, *Solid Oak Sketches v. 2K Games, Inc.*, No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).

174. *See id.*

175. *Id.* at 9-10.

176. *See id.* at 17-26.

177. *Id.*

178. *Id.* at 27-29.

179. Defendants' Answer and Counterclaims, *Solid Oak Sketches v. 2K Games, Inc.*, No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016), at 29-30.

180. *See generally id.*

181. *See id.* at 36-39.

de minimis use.¹⁸² *De minimis* use means “the law does not concern itself with trifles” – or, as applied here, the use of the tattoos is so small and unimportant that the law should not concern itself with the use.¹⁸³ Take-Two sought this declaratory judgment because the tattoos appear only “fleetingly” and briefly and they are just a small part of the graphic display and virtual world created in *NBA 2K16*.¹⁸⁴ Furthermore, the game features tattoos beyond just the ones at issue in this litigation, and the tattoos are just one of many components that make up *NBA 2K16*.¹⁸⁵ Second, Take-Two sought a declaratory judgment of fair use.¹⁸⁶ As Take-Two said, they “are not creating, distributing, or marketing tattoos; they are creating, distributing, and marketing video games.”¹⁸⁷ Because Take-Two is not impeding on Solid Oak’s ability to market tattoos, and because the tattoos serve a minor purpose as a feature of the players’ likenesses, Take-Two said this was a fair use of the tattoos.¹⁸⁸ Third, Take-Two sought a declaratory judgment of fraud on the Copyright Office, in addition to an order from the court invalidating and cancelling the copyright registration for the tattoo “Lion’s Head Tattoo Artwork.”¹⁸⁹ The tattoo, originally created by and inked onto LeBron James by Shawn Rome in 2000, has since undergone significant changes.¹⁹⁰ These changes were not made by Rome.¹⁹¹ However, when the tattoo was filed with the Copyright Office in 2015, the application listed Rome as the only artist.¹⁹² The application should have listed Rome and at

182. *Id.* at 36.

183. Andrew Inesi, *A THEORY OF DE MINIMIS AND A PROPOSAL FOR ITS APPLICATION IN COPYRIGHT*, 21 Berkeley Tech. L.J. 945, 947 (2006).

184. Defendants’ Answer and Counterclaims at 36, *Solid Oak Sketches v. 2K Games, Inc.*, No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).

185. *Id.*

186. *Id.* at 37.

187. *Id.*

188. *Id.* at 38.

189. *Id.* at 38-39.

190. Defendants’ Answer and Counterclaims at 36, *Solid Oak Sketches v. 2K Games, Inc.*, No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016), at 21-22 (The original tattoo was a lion’s head with a crown on it, but it was later changed such that, among other things, the crown is no longer visible.).

191. *Id.* at 22.

192. *See id.*

least one other artist as the creators of the work, but it did not, and as a result, Take-Two sought a declaratory judgment of fraud on the Copyright Office.¹⁹³

Solid Oak responded with a Motion to Dismiss the counterclaims made by Take-Two.¹⁹⁴ Solid Oak argued that the counterclaims are redundant and duplicative of Take-Two's affirmative defenses.¹⁹⁵ After all, the three counterclaims are the same as three of the affirmative defenses listed in Take-Two's Answer.¹⁹⁶ Solid Oak cited to Federal Rule of Civil Procedure 12(f), which states that "the court may strike from a pleading ... any redundant ... matter."¹⁹⁷ Solid Oak alleged that Take-Two's counterclaims are duplicative of their defenses and "add nothing new from a legal or factual standpoint."¹⁹⁸ Additionally, Solid Oak argued that there is no need to be concerned about putting Defendants at the mercy of Plaintiffs, referring to the possibility that Plaintiffs could drop suit and then re-sue Defendants at any time in the future since the controversy has not been resolved.¹⁹⁹ If the case were to be dismissed, Solid Oak argued that the court has the discretion to determine the proper terms of the dismissal and whether it is with prejudice or not.²⁰⁰ This, Solid Oak claimed, would prevent Defendants from constantly having to worry about another suit being brought against them by Plaintiffs or another owner of tattoo copyrights.²⁰¹

Two weeks later, Take-Two filed a memorandum in opposition of Solid Oak's motion to dismiss the counterclaims.²⁰² First, Take-Two argued that the counterclaims are not redundant as they serve a separate purpose than the affirmative defenses – the declaratory judgment counterclaims serve the

193. *Id.*

194. Memorandum of Law In Support of Plaintiff's Motion to Dismiss, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).

195. *Id.* at 1.

196. *Id.*

197. *Id.*

198. *Id.* at 3.

199. *Id.* at 4.

200. Memorandum of Law In Support of Plaintiff's Motion to Dismiss, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).

201. *Id.*

202. Defendants' Memorandum of Law In Opposition to Plaintiff's Motion to Strike, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).

purpose of providing Take-Two with legal certainty and ensuring that the full case and controversy between the parties is resolved by the court.²⁰³ If the counterclaims are dismissed, Solid Oak could drop the lawsuit and, due to the uncertainty still remaining, Take-Two could face future lawsuits on the issue.²⁰⁴ Allowing the counterclaims would ensure the issue is decided and would provide legal certainty for Take-Two and other similar organizations going forward.²⁰⁵ Second, Take-Two argues the counterclaims are not mirror images of the affirmative defenses because the counterclaim includes 235 paragraphs of factual allegations accompanying the counterclaims.²⁰⁶ Third, Take-Two claims that the counterclaims are not redundant because they are seeking an order cancelling the copyright registration of the “Lion’s Head Tattoo Artwork,” which is something that cannot be achieved by an affirmative defense.²⁰⁷ Take-Two offers case law to show that “when a counterclaimant challenges the validity of the plaintiff’s intellectual property rights, related counterclaims for non-infringement should not be dismissed as redundant either.”²⁰⁸

Seemingly in response to Defendant’s arguments, Solid Oak filed an amended complaint, removing the “Lion’s Head Tattoo Artwork” tattoo from the lawsuit and adding infringement claims for the *NBA 2K14* and *NBA 2K15* versions of the game, in addition to *NBA 2K16*.²⁰⁹ Again, Take-Two was quick to offer a response, this time by submitting a letter to the Honorable Judge Laura Taylor Swain.²¹⁰ This amended complaint, Take-Two argued, was further evidence as to why their counterclaims should not be dismissed.²¹¹ Take-Two argued that the since the “Lion’s Head Tattoo Artwork” was dropped from the newest complaint, the only way to resolve the issues of *de minimis* use, fair use,

203. *Id.* at 1.

204. *Id.* at 8-9.

205. *Id.* at 9.

206. *Id.* at 2.

207. *Id.* at 11.

208. Defendants’ Memorandum of Law In Opposition to Plaintiff’s Motion to Strike, *Solid Oak Sketches v. 2K Games, Inc.*, No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016), at 3 (citing *Leach v. Ross Heater & Mfg. Co.*, 104 F.2d 88 (2d Cir. 1939)).

209. See Second Amended Complaint, *Solid Oak Sketches v. 2K Games, Inc.*, No. 1:16-cv-724 (S.D.N.Y. 2016).

210. Letter from Dale M. Cendali, P.C., Kirkland & Ellis LLP, to the Hon. Judge Laura Taylor Swain, District Judge, S.D.N.Y. (Oct. 28, 2016) (on file with S.D.N.Y.).

211. *Id.*

and fraudulent registration for that particular tattoo is through the counterclaims.²¹² Also, Take-Two argued that by adding the two prior versions of the game to the complaint, they are doing exactly what Take-Two referenced in their opposition brief – bringing suit from the “cloud” of mystery over the lawsuit.²¹³ By allowing the counterclaims in this case, Take-Two argued they would be able to “clear the cloud” of uncertainty and feel confident they would not be sued for any tattoo infringement for prior or future versions of *NBA 2K*.²¹⁴

C. Last Update on the Proceedings

On March 9, 2017, the Honorable Judge Laura Taylor Swain advised the parties that the motion to dismiss the counterclaims was still under advisement and the parties would be notified when a decision was made.²¹⁵ That was the last update on the case at the time of this note.²¹⁶

IV. ANALYSIS

Before diving into this issue specifically, the basics of copyright law must first be analyzed. Copyright protection exists in “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”²¹⁷ There are several categories of “works of authorship,” the most relevant of which is § 102(a)(5).²¹⁸ § 102(a)(5) identifies “works of authorship” as, among other things, “pictorial, graphic, and sculptural work.”²¹⁹

Ultimately, this section will prove that if this case goes to trial, Solid Oak Sketches will come out victorious. The following three subsections address the

212. *Id.*

213. *Id.*

214. *Id.*

215. Letter from Darren Heitner, Attorney for Plaintiff, Heitner Legal, P.L.L.C., to the Hon. Judge Laura Taylor Swain, District Judge, S.D.N.Y. (Mar. 7, 2017) (on file with S.D.N.Y.).

216. *Id.*

217. 17 U.S.C. § 102(a) (1990).

218. *Id.* at § 102(a)(5).

219. *Id.*

three major issues of the case: the ability of tattoos to be copyrighted, possible defenses for Take-Two, and the issue of damages.

A. Are Tattoos Copyrightable?

There are two parts of the tattooing process that must be looked at when determining if they are copyrightable – the flash design, which is the drawn out design of the tattoos (which is often displayed in tattoo shops), and the final inked on-skin product.²²⁰ The flash design is certainly copyrightable, much like any other painting or drawing.²²¹ The actual tattooed, finished product is less certain.²²² However, most scholars agree that it also meets the requirements for being a copyrightable work.²²³ The issue with tattoos is whether they are “fixed” in a “tangible medium of expression.”²²⁴ A work is “fixed” when “its embodiment . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”²²⁵ As Jennifer Commander states, “[a]s skin ages, stretches, shrinks, burns, and varies pigments, a tattoo on that changing skin morphs as well, calling into question whether a tattoo can ever be fixed.”²²⁶ However, in defeating this argument immediately after raising it, Commander discusses the “rather permanent quality” of tattoos.²²⁷ This permanent quality suggests tattoos are “fixed,” while the belief that human skin is “a tangible medium of expression” is the “consensus.”²²⁸

Therefore, since tattoos are copyrightable, the owners of those copyrights are “entitled . . . to institute an action for any infringement of that particular right committed while he or she is the owner of it.”²²⁹ Infringement occurs

220. *Id.*

221. *Id.*

222. *Id.*

223. *Id.* at 1953.

224. *Id.* at 1954.

225. Peter Perkowsky, *Tattoos, Copyright Infringement, and Celebrities: Litigation Edition, Round Four*, THE WHITE BRONCO (Feb. 5, 2016), <http://thewhitebronco.com/2016/02/tattoos-copyright-infringement-and-celebrities-litigation-edition-round-four/>.

226. Jennifer L. Commander, Note, *The Player, The Video Game, and The Tattoo Artist: Who has the Most Skin in the Game?*, 72 Wash. & Lee L. Rev. 1947, 1949 (2015).

227. *Id.*

228. Perkowsky, *supra* note 177.

229. 17 U.S.C. § 501(b) (2002).

when anyone “violates any of the exclusive rights of the copyright owner.”²³⁰ The exclusive rights of the copyright owner include the right “to do or authorize any of the following”:

- “(1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.”²³¹

Defendants publicly displayed the tattoos in a video game that they sold millions of copies of all over the world, without Plaintiff’s authorization, and in direct violation of § 106(5) above.²³² Therefore, Solid Oak Sketches is entitled to file the complaint and sue their infringers (Defendants).²³³

B. What About Take-Two’s Defenses?

Defendants, in their Answer to the Complaint, listed seven affirmative defenses to Solid Oak’s claims. These defenses include: (1) failure to state a claim; (2) *de minimis* use; (3) fair use; (4) license; (5) consent, waiver, estoppel; (6) non-infringement; and (7) fraud on the Copyright Office.²³⁴ Although Defendant did not elaborate on these defenses, the viability of each defense can still be analyzed. Each potential defense is discussed in detail below.

230. *Id.* at § 501(a).

231. 17 U.S.C. § 106 (2002).

232. Complaint for Copyright Infringement, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124.

233. *Supra* note 181.

234. Defendants’ Answer and Counterclaims, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).

1. Failure to State a Claim

Failure to state a claim is not a valid affirmative defense because it is not a defense at all – it is a basis as to file a motion to dismiss.²³⁵ Under the Federal Rules of Civil Procedure, failure to state a claim is not an available affirmative defense under rule 12(c).²³⁶ Pursuant to rule 12(f), the court can strike this defense from the pleadings as insufficient.²³⁷

2. De Minimis Use

Previously in this note, the definition of *de minimis* use was given. *De minimis* use means “the law does not concern itself with trifles.”²³⁸ As one case from the Southern District of New York put it, “if the copying is *de minimis* and so “trivial” as to fall below the quantitative threshold of substantial similarity, the copying is not actionable.”²³⁹ When determining whether the quantitative threshold of substantial similarity has been met, “courts consider the extent to which the copyrighted work is copied in the allegedly infringing work.”²⁴⁰ Here, the tattoos in question were completely copied into the video game – it wasn’t just a part of the tattoos, it was the entire tattoos. The aforementioned case also said “[t]he observability of the copyrighted work is critical, and courts will consider the length of time the copyrighted work is observable as well as factors such as focus, lighting, camera angles, and prominence.”²⁴¹ Though it is tough to see the tattoos from the normal gameplay view, the tattoos can be seen every time the camera zooms in on the players and every time an instant replay is shown from a closer view. When these instant replays are shown, the copyrighted work can be observed for long periods of time, and this observation can have the right focus, lighting, and camera angles to make the observation of the tattoos prominent. Admittedly, this may be Take-Two’s strongest defense, but it is still not enough to defeat Solid Oak’s claim.

235. Malibu Media, LLC v. Popp, 2015 WL 10937405 (E.D.Va. 2015) at *3.

236. *Id.* (citing Fed. R. Civ. P. 12(c)).

237. *Id.* (citing Fed. R. Civ. P. 12(f)).

238. Inesi, *supra* note 184.

239. Gottlieb Development LLC v. Paramount Pictures Corp., 590 F. Supp. 2d 625, 632 (S.D. N.Y. 2008).

240. *Id.*

241. *Id.*

3. Fair Use

“[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.”²⁴² There are several factors used to determine whether a use of work is “fair” or not.²⁴³ These factors are:

“(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.”²⁴⁴

Congress and the courts interpret this defense through two different lenses: the private benefit approach and the public benefit approach.²⁴⁵ This distinction depends on the first factor above – whether the use is commercial or for non-profit purposes.²⁴⁶ The private benefit approach is when the use is for purely commercial purposes; the public benefit approach is when the use is for nonprofit educational purposes.²⁴⁷ When the use of the copyrighted work is for purely commercial reasons (private benefit approach), courts are less likely to give deference to the defense.²⁴⁸ Here, since the use of the tattoos is solely to make the game more realistic, in an attempt to sell more games, the use is purely commercial.²⁴⁹ Next, the nature of the infringement is, as Plaintiff’s earlier described, “overtly willful.”²⁵⁰ Third, all of the tattoos are being copied in

242. 17 U.S.C. § 107 (1992).

243. *Id.*

244. *Id.*

245. *Commander*, *supra* note 186 at 1967.

246. *Id.*

247. *Id.*

248. *See id.* at 1967-68.

249. *See generally* Brian Mazique, *NBA 2K16: Breaking Down Best New Features for This Year’s Game*, BLEACHER REPORT (Aug. 31, 2015), <http://bleacherreport.com/articles/2558410-nba-2k16-breaking-down-best-new-features-for-this-years-game>.

250. *See* Reply Memorandum in Support of Defendants 2K Games, Inc. and Take-Two Interactive Software, Inc.’s Motion to Dismiss, *Solid Oak Sketches v. Visual Concepts, LLC*, No: 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016) 2016 WL 3086071.

their entirety, not just partially.²⁵¹ Fourth, since the game reproduced the tattoos and sold their copies all over, there is a great effect on the market of the copyrighted work.²⁵² Since Solid Oak's work has been widespread, without Solid Oak receiving credit, the value of the copyrights has been effectively nullified. This defense is not very persuasive.

4. License

A recipient of a tattoo is allowed to go out in public and display his/her tattoo due to the implied nonexclusive license granted to them by the artist.²⁵³ This license does not transfer any interest in the copyrighted work, but it allows the client to use the copyrighted tattoo in ways specified by the artist.²⁵⁴ This license is what saves tattoo recipients from a "parade of horrors" that would include being prohibited from appearing in photographs, removing the tattoo, getting tattoos surrounding the original work, or appearing on television.²⁵⁵ But, does this implied nonexclusive license extend to third parties such as Defendants?

Whitmill debunked this third-party-implied-nonexclusive-license theory after Warner Bros. raised it as a defense.²⁵⁶ Whitmill argues that since he never had any discussions with Warner Bros., the implied license must've somehow come in the form of a sublicense from the original licensee (in their case, this was Mike Tyson).²⁵⁷ This thought is quickly dismissed as having no legal support.²⁵⁸ The only issue then becomes whether the scope of an implied license involves allowing third parties to create derivative works.²⁵⁹ The scope

251. See generally Complaint for Copyright Infringement, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124.

252. See generally Eddie Makuch, *NBA 2K16 Breaks Records With 4 Million Copies Shipped in Under One Week*, GAMESPOT, <http://www.gamespot.com/articles/nba-2k16-breaks-records-with-4-million-copies-ship/1100-6431093/> (last updated Oct. 2, 2015).

253. Commander, *supra* note 193 at 1974.

254. *Id.* at 1975.

255. Peter Perkowsky, *Tattoos, Copyright Infringement, and Celebrities: Litigation Edition, Round Four*, THE WHITE BRONCO (Feb. 5, 2016), <http://thewhitebronco.com/2016/02/tattoos-copyright-infringement-and-celebrities-litigation-edition-round-four/>.

256. See Plaintiff's Reply Memorandum in Support of His Motion for Preliminary Injunction, Whitmill v. Warner Bros., No. 4:11-cv-752CDP (E.D.Mo. 2011) 2011 WL 11569200.

257. *Id.*

258. *Id.*

259. See *id.*

of an implied license is determined by the conduct of the parties involved, and since Solid Oak Sketches has filed this lawsuit, their conduct clearly does not allow for third parties to use this implied license.²⁶⁰ While Defendants may try to argue that since Solid Oak did not object to the use of the tattoos in previous versions of the game, they were given an implied license to use the tattoos. However, this argument would be weak, since the reason Solid Oak did not object is because they did not yet have the copyrights for the tattoos, as those were received in 2015.²⁶¹ Furthermore, courts tend to limit their recognition of this defense to noncommercial displays of copyrighted works.²⁶² As discussed earlier, the use of Solid Oak Sketches' tattoos by Defendants is for purely commercial purposes.²⁶³ Like the fair use argument, this defense is not very persuasive.

5. Consent, Waiver, Estoppel

In order to claim this defense, a defendant in a copyright suit must prove four elements: (1) (1) the copyright owner knew of the defendant's infringing conduct; (2) the plaintiff either expressly or impliedly consented to the defendant's infringing act through inaction or acquiescence; (3) the defendant must be ignorant of the true facts; and (4) the defendant must rely on the plaintiff's conduct to its injury.²⁶⁴ In this case, the first point can be proven. Obviously, Solid Oak knew of Take-Two's infringing conduct. However, Take-Two cannot prove the second prong – Solid Oak did the exact opposite of consenting to Take-Two's infringing acts by sending the demand letter before filing suit. Take-Two also cannot prove the third element, as they knew of their infringement due to Solid Oak's negotiation letters and continued with the production of *NBA 2K16* anyway. As for the fourth prong, Take-Two did not act on Solid Oak's conduct – they effectively ignored Solid Oak by continuing with the production of *NBA 2K16* with the tattoos still a part of the game. Since

260. See generally Complaint for Copyright Infringement, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124.

261. *Id.*

262. Jennifer L. Commander, Note, *The Player, The Video Game, and The Tattoo Artist: Who has the Most Skin in the Game?*, 72 Wash. & Lee L. Rev. 1947, 1975 (2015).

263. See generally Brian Mazique, *NBA 2K16: Breaking Down Best New Features for This Year's Game*, BLEACHER REPORT (Aug. 31, 2015), <http://bleacherreport.com/articles/2558410-nba-2k16-breaking-down-best-new-features-for-this-years-game>.

264. Charles M.R. Vethan, *THE DEFENSES OF ESTOPPEL AND IMPLIED LICENSE IN COPYRIGHT INFRINGEMENT CLAIMS IN THE ONLINE WORLD: A CASE STUDY*, 49 S. Tex. L. Rev. 433, 445-46 (2007).

Take-Two can only prove one of the four required elements for this defense, it should be quickly dismissed as having no credibility.

6. Non-infringement

The owners of a copyright have six exclusive rights: (1) the right to reproduce; (2) the right to prepare derivative works; (3) the right to distribute; (4) the right to publicly perform; (5) the right to publicly display; and (6) in the case of sound recordings, the right to perform by means of digital transmission.²⁶⁵ When one of these exclusive rights is violated, an infringement of the copyright occurs.²⁶⁶ In this case, Solid Oak's exclusive rights in regards to 1, 2, 3, and 5 have been violated. By putting the tattoos on the virtual characters in the video game, the copyright was reproduced and a derivative work was prepared. Then, when 2K sold the game containing the recreated copyrights, they violated Solid Oak's exclusive right to distribute the works. Finally, Take-Two violated Solid Oak's exclusive right to publicly display by selling and advertising the game to the general public. Therefore, since four of the six exclusive rights of copyright owners are infringed upon, Take-Two cannot escape liability on this defense.

7. Fraud on the Copyright Office

While this may have been an originally valid and credible defense, it is not anymore. Since Solid Oak submitted their Second Amended Complaint (which no longer listed the tattoo that was allegedly fraudulently filed), this defense no longer matters.²⁶⁷ Take-Two does not allege fraud on the copyright office on any of the tattoos listed in this new complaint, therefore the defense is irrelevant.²⁶⁸

C. *What are proper damages?*

Previously in this note, the financial demands of Solid Oak Sketches were discussed in detail. These demands took place prior to the filing of the lawsuit, with the lawsuit asking for "appropriate statutory and/or monetary damages, together with interest, reasonable attorneys' fees, and costs incurred in [the]

265. *Id.* at 437.

266. *Id.*

267. *See* Second Amended Complaint, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724 (S.D.N.Y. 2016).

268. *See generally* Defendants' Answer and Counterclaims, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).

action.”²⁶⁹ This note also previously discussed the arguments for and eventual granting of the motion to dismiss the statutory damages and attorneys’ fees.²⁷⁰ So, with those remedies out of the picture, Solid Oak Sketches is now simply looking at monetary damages.²⁷¹ How much money should Solid Oak Sketches receive?

The demand letter used Escobedo’s \$22,500 award that was appealed as insufficient and undoubtedly lower than the actual compensation he ultimately received in the settlement.²⁷² The letter also used the same amount to compute a one-time license fee.²⁷³ As the demand letter states, these numbers are too low.²⁷⁴ The “ultimate payment [to Escobedo] no doubt exceeded \$22,500,” so there is also no doubt the number is too low of an indicator.²⁷⁵ Even if we ignore the fact that Escobedo’s award settled for a higher amount, comparing the two is like comparing apples and oranges. Escobedo’s award came from a *UFC* video game, which is focused around the sport of Mixed-Martial Arts – the 10th most popular sport in the United States.²⁷⁶ The *NBA 2K* series is focused around the third most popular American sport.²⁷⁷ Furthermore, LeBron James was identified as the most popular athlete in the United States, according to a 2014 study.²⁷⁸ In 2012, the year of Escobedo’s suit, Carlos Condit (the fighter who received the tattoo) was not even ranked among the top 15 most popular fighters.²⁷⁹ The infringement against Solid Oak Sketches is clearly more high-profile, so consequently the damages should be higher.

269. *Id.*

270. *See* Solid Oak Sketches, LLC v. 2K Games, Inc., No. 16CV724-LTS, 2016 WL 4126543 (S.D.N.Y. 2016).

271. *Id.*

272. Solid Oak Sketches, *supra* note 210 at Exhibit B.

273. *Id.*

274. *See id.*

275. *Id.*

276. *10 Most Popular Sports in America*, THE RICHEST (June 3, 2012), <http://www.therichest.com/sports/most-popular-sports-in-america/>.

277. *Id.*

278. Darren Rovell, *Poll: LeBron Voted Most Popular*, ESPN (July 17, 2014), http://www.espn.com/nba/story/_/id/11228655/harris-poll-lebron-james-cleveland-cavaliers-most-popular-male-athlete.

279. Kyle Symes, *MMA: Most Popular Fighter in 2012*, BLEACHER REPORT (Dec. 20, 2012), <http://bleacherreport.com/articles/1451409-mma-most-popular-fighter-in-2012/page/16>.

Furthermore, when calculating the one-time licensing fee, Solid Oak Sketches based the fee off of the players playing just four more seasons.²⁸⁰ Kobe Bryant (who is mentioned in the demand letter, but not in the actual suit) retired from basketball following the 2015-16 season.²⁸¹ He is 37 years old.²⁸² Using Bryant as an example, the potential remaining playing years for each of the other players named in the lawsuit can be determined (while noting it is entirely possible for players to play beyond, or retire before, they turn 37) by seeing how many years the players have until they are age 37. LeBron James is 31, so he could hypothetically have six more years of playing left.²⁸³ Eric Bledsoe is 26, leaving him with 11 years still to go in the NBA.²⁸⁴ Kenyon Martin has not played since the 2014-15 season, so his tattoo will not be infringed upon anymore.²⁸⁵ Although Martin is no longer an active player, Bledsoe and James' potential time remaining in the NBA is far beyond the conservative four year estimate. Ultimately, the calculated damages in the demand letter are too low, and it is entirely possible the District Court for the Southern District of New York could award damages greater than those listed in the complaint.²⁸⁶

V. CONCLUSION

Copyright law and its relationship to tattoos is an issue that has been brought up many times before, yet never been conclusively and definitively solved by an American court. This issue has led to the lawsuit filed by Solid Oak Sketches. The *NBA 2K16* video game experienced immense success for myriad

280. Solid Oak Sketches, *supra* note 210 at Exhibit B. (While some may think an obvious and easy way to calculate damages would be to use the average career length of an NBA player, this number is skewed and not an accurate representation of the players infringed upon. Many players never see substantial playing time and spend a very short career on the bench, thus causing the average NBA career length to be lower than that of higher-caliber players such as the ones named in the lawsuit.)

281. *Kobe Bryant*, ESPN, http://www.espn.com/nba/player/_id/110/kobe-bryant (Last visited Aug. 21, 2016).

282. *Id.*

283. *LeBron James*, ESPN, http://www.espn.com/nba/player/stats/_id/1966/lebron-james (Last visited Aug. 21, 2016).

284. *Eric Bledsoe*, ESPN, http://www.espn.com/nba/player/_id/4238 (Last visited Aug. 21, 2016).

285. *Kenyon Martin*, ESPN, http://www.espn.com/nba/player/stats/_id/515/kenyon-martin (Last visited Aug. 21, 2016).

286. *See generally* Complaint for Copyright Infringement, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124 at Exhibit B.

reasons, though at least a portion of the success can be appropriated to the game's featuring of realistic tattoos. The issues resulting from these tattoos provide the foundation for Solid Oak's lawsuit. There are many other situations that have involved the tattoo/copyright issue. These situations include Chris Escobedo's claim against video game maker THQ, Stephen Allen's claim against a different video game maker in Electronic Arts, Matthew Reed's claim against Nike, Victor Whitmill's claim against Warner Bros., and finally, how *Madden NFL* and the NFLPA have avoided the issue altogether. Solid Oak Sketches' claim already has an interesting history, from when they attempted to negotiate a settlement to when they ultimately lost out on statutory damages and attorneys' fees to when they were hit with counterclaims.

Solid Oak Sketches is likely to win their lawsuit against Take Two and 2K. This conclusion was reached by looking at the overwhelming consensus that tattoos are in fact copyrightable. Additionally, Defendants are offered no adequate or credible defenses. After the case is argued, it will be shown that their claim for damages is actually low, and it would not be surprising if more damages are awarded. Video game makers, professional athletes, tattoo artists, and scholars of copyright law are, without a doubt, interested to see how this case plays out. Hopefully, this will finally be a case that goes to trial – and with the pending counterclaims, it seems that trial is a real possibility – and provides some clarity on how tattoos fit within the realm of copyright law. If the case is litigated, it is likely Solid Oak Sketches will come out victorious.