

TATTOOS AND COPYRIGHT INFRINGEMENT: CELEBRITIES,
MARKETERS, AND BUSINESSES BEWARE OF THE INK

by
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Tattoos are almost ubiquitous these days, with body piercing likely following closely behind. With advertising increasingly displaying skin—from hip huggers to cropped shirts to a basketball jersey showing an athlete’s tattooed arm—actors, actresses, and sports figures display both forms of body art on television, the silver screen, billboards, and the Internet for consumer product and service providers who hope to benefit from increased sales. But businesses, advertising agencies, and celebrities often lose sight of any interest that tattoo artists may have in the tattoos and body piercings. In this Article, Mr. Harkins uses the recent copyright infringement lawsuit stemming from the advertising use of basketball player Rasheed Wallace’s tattoo to analyze the current state of copyright law’s application to body art.

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I. INTRODUCTION

How long does getting a tattoo really hurt? Pose that question to Nike, Inc., its advertising agency, and professional basketball player Rasheed Wallace from the world champion Detroit Pistons, and you may be surprised to hear the answer. The tattoo Wallace got in 1998 still hurts, or more accurately stated, hurts anew, seven years later in 2005. Indeed, long after the pain subsided from needles delivering tattoo ink, the same tattoo artist delivered other ink that brought back the pain: legal ink in a complaint for copyright infringement.

Tattoos are almost ubiquitous these days, with body piercing likely following closely behind. With advertising increasingly displaying skin—from hip huggers to cropped shirts to a basketball jersey showing Rasheed Wallace's tattooed arm—actors, actresses, and sports figures display both forms of body art on television, the silver screen, billboards, and the Internet for consumer product and service providers who hope to benefit from increased sales.

Businesses, advertising agencies, and celebrities often lose sight of any interest that tattoo artists may have in the tattoos and body piercings, perhaps thinking the tattoo artist has already been paid in full or mistakenly thinking that tattoo customers own the artwork and have a right to display their own bodies with impunity. Ownership of the copyright is distinct, however, from ownership in any material object (e.g., the permanent mark or design made on the skin with indelible ink) that embodies the work.¹ Moreover, even innocent parties may be liable for copyright infringement, because while culpability of the infringer may come into play in determining the amount of damages owed to the copyright owner, an innocent infringer is no less liable than a willful infringer.²

¹ 17 U.S.C. § 202 (2000) (“Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied. Transfer of ownership of any material object, including the copy or phonorecord in which the work is first fixed, does not of itself convey any rights in the copyrighted work embodied in the object; nor, in the absence of an agreement, does transfer of ownership of a copyright or of any exclusive rights under a copyright convey property rights in any material object.”).

² *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 537 (6th Cir. 2004) (“copyright infringement does not have a scienter requirement”); *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 693, 706 (2d Cir. 1998) (“The innocent infringement defense can result in the mitigation of actual or statutory damages.”); *Chavez v. Arte Publico Press*, 204 F.3d 601, 607 (5th Cir. 2000) (“Copyright infringement actions, like those for patent infringement, ordinarily require no showing of intent to infringe. Instead, knowledge and intent are relevant in regard to damages.”); *Procter & Gamble Co. v. Colgate-Palmolive Co.*, 199 F.3d 74, 77 (2d Cir. 1999) (“‘innocent’ copying is still copying”); *Los Angeles News Serv. v. Reuters Television Int'l, Ltd.*, 149 F.3d 987, 995–96 (9th Cir. 1998) (Defendants failed to prove innocent infringement and “were not entitled to the reduction in statutory damages.”); *Repp v. Webber*, 132 F.3d 882, 889 (2d Cir. 1997) (“The fact that infringement is ‘subconscious’ or ‘innocent’ does not affect liability, although it may have some bearing on remedies.”).

The recent copyright case discussed below, perhaps the first case to assert copyright infringement based on a tattoo, may signal a floodgate for other lawsuits of its kind and may inspire creative theories of copyright infringement against other defendants in the media, sports, and entertainment industries. At a minimum, however, the marketing agencies, sellers and suppliers of products and services, and celebrities that feature tattoos in their advertising campaigns need to consider and, indeed, confront head-on, many copyright issues if they wish to avoid legal action, mitigate damages, or successfully defend against lawsuits relating to body piercing and tattoos.

II. TATTOO ARTIST LAUNCHES A THREE-POINTER AT NBA STAR RASHEED WALLACE, NIKE, AND AN ADVERTISING AGENCY

Two years ago, Rasheed Wallace and the National Basketball Association (NBA) Detroit Pistons defeated the Los Angeles Lakers four games to one to become the 2004 NBA Champions.³ While Wallace was reaping the benefits of stardom off the basketball court with shoe deals and commercials shots, the tattoo artist was taking a shot of his own. Tattooist Matthew Reed was filing registrations for copyrights for artwork displayed on Wallace's right arm.

A. *In the Tattoo Parlor*

Turn back the clock to 1998. Rasheed Wallace had just been traded to play for the NBA franchise Portland Trailblazers and made his home in Portland, Oregon. Also working in the Portland area, Matthew Reed was a self-employed graphic artist, a licensed tattoo artist, and owner of TigerLily Tattoo and Design Work, where he would sketch artwork and then transfer the artwork to the skin in the form of tattoos. Reed, whose reputation was increasing, had applied his works on several athletes, including Rasheed Wallace, who visited TigerLily that year for a tattoo.

As is routine in the tattoo business, Wallace and Reed met to discuss ideas for the artwork. Wallace presented his own ideas for incorporating an Egyptian-themed family design of a king and a queen and three children with a stylized sun in the background. Reed listened to the ideas, took notes, and made sketches. Wallace suggested some changes, including a headdress for the king and a change to the orientation of the staff the king was holding, all of which Reed incorporated in the final drawing. Before inking the tattoo, however, Wallace failed to ask Reed or TigerLily to execute any assignment, licensing agreement, or written contract transferring to Wallace ownership or other rights in the tattoo design that would become the tattoo on Wallace's upper right arm.

³ Wallace's fame and the Pistons' success continued in 2005 when they made the NBA championship but fell four games to three to the San Antonio Spurs.

B. From the Basketball Court to the Courtroom

Wallace paid \$450 for the tattoo. Reed considered the price low, but 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, Reed 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.

That all changed in spring 2004 during the Detroit Pistons' championship run, when Reed saw the tattoo highlighted in an advertising campaign promoting Nike's products in a commercial broadcast on television and over Nike's website on the Internet. Although the advertisement featured Wallace as an NBA basketball player, it also 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.

The advertisement resulted from an agreement that Wallace had with Nike to promote Nike's products. In order to create and produce the advertisement, Nike also engaged Weiden & Kennedy as its advertising agency. However, Nike, the advertising agency, and Wallace had overlooked one other player off the basketball court. Reed, after seeing the commercial advertisement, filed an application to register copyrights drawings relating to the tattoo and later was issued visual art Copyright Registration Numbers VA 1-265-074 and VA 1-236-392 for the Egyptian Family Pencil Drawings.⁴

On February 10, 2005, Reed filed a complaint in the United States District Court for the District of Oregon against Nike, Inc., Rasheed Wallace, and Weiden & Kennedy.⁵ In Count I, Reed alleged copyright infringement⁶ against both Nike and Weiden & Kennedy based on copying, reproducing, distributing, or publicly displaying Reed's copyrighted work without Reed's consent.⁷ The

⁴ Copyright Registration Number VA 1-265-074, entitled "Egyptian Family," was registered on August 11, 2004. Copyright Registration Number VA 1-236-392, also entitled "Egyptian Family," is a supplement to the earlier registration and has an effective registration date of March 7, 2005.

⁵ Complaint, Reed v. Nike, Inc., No. 05-CV-198 BR (D. Or. Feb. 10, 2005). The complaint alleged infringement of Copyright Registration Number VA 1-265-074. After filing the complaint, however, Reed was issued Copyright Registration Number VA 1-236-392 and, therefore, filed an amended complaint to allege that the defendants had also infringed that copyright.

⁶ *Id.* at 4-5. Reed alleged that Nike and Weiden & Kennedy infringed his copyright and exclusive rights under the Copyright Act of 1976, as amended, 17 U.S.C. § 501 (2000) ("Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 122, or of the author as provided in section 106A(a), or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright or right of the author, as the case may be.").

⁷ Complaint, *supra* note 5, at 5. As the copyright owner, Reed claimed that under section 106 of the Copyright Act of 1978, the defendants infringed three of his exclusive rights: (1) to reproduce the copyrighted work; (2) to prepare derivative works based on the

remaining two counts were against Wallace individually. Count II claimed contributory infringement based on Wallace allegedly holding himself out to Nike as the exclusive owner in the tattoo, which conduct induced Nike to reproduce, distribute, and publicly display Reed's copyrighted work.⁸ In the alternative to Count II, if Wallace were found to be a co-owner of the artwork, then Count III sought an accounting for which Reed would share in any revenue that Wallace realized from the advertisement.⁹

C. *An Arm and a Leg?*

Did Reed recover an arm and a leg for the tattoo on Wallace's upper right arm? Reed sought all of the defendants' profits, a share of the revenue that Wallace received from Nike, prejudgment interest, an injunction,¹⁰ and actual damages,¹¹ costs, and disbursements in bringing the lawsuit. The parties

copyrighted work; and, (3) to distribute copies of the copyrighted work for sale to the public. Among other things, section 106 of the Copyright Act of 1976, as amended, provides that the owner of copyright under this title has the exclusive rights to do and to 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.

17 U.S.C. § 106(1)–(3) (2000). There remains a split in the circuits as to whether the right “to authorize” the use of the copyrighted works creates a separate and independent exclusive right that a copyright owner may allege to be copyright infringement. Christopher A. Harkins, *Overcoming the Extraterritorial Bar to Bringing Copyright Actions: On Pleading Copyright Infringement to Protect Copyrighted Works from the Defendant That Ships Overseas for Distribution Abroad*, 17 INTELL. PROP. & TECH. L.J. 1, 2–3 (2005).

⁸ Complaint, *supra* note 5, at 5. Reed alleged that Wallace induced or encouraged Nike and Weiden & Kennedy to commit direct infringement by advising the co-defendants that Wallace had exclusive ownership in the tattoo, knowing that the co-defendants would rely on that representation in creating the infringing advertising campaign. Wallace's conduct, according to Reed, constituted contributory infringement of Reed's copyright and exclusive rights in violation of 17 U.S.C. §§ 106, 501. *See, e.g.*, Harkins, *supra* note 7, at 3 (arguing contributory infringement theory as a viable distinct legal theory of copyright infringement); *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 125 S. Ct. 2764, 2776 (2005) (recognizing liability for acts of copyright infringement by third parties under theories of contributory and vicarious infringement).

⁹ Complaint, *supra* note 5, at 7.

¹⁰ *Id.* Reed sought to enjoin Nike and Weiden & Kennedy from continuing to use the tattoo in the accused advertisements. *See* 17 U.S.C. § 502(a) (2000) (“Any court having jurisdiction of a civil action arising under this title may, subject to the provisions of section 1598 of title 28, grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright.”).

¹¹ Complaint, *supra* note 5, at 7. Reed demanded both actual damages and profits from the defendants. *See* 17 U.S.C. § 504(b) (2000) (“The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages. In establishing the infringer's profits, the copyright owner is required to present proof only of the infringer's gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work.”).

recently dismissed the case,¹² however, presumably pursuant to a confidential settlement agreement.

So, how much does getting a tattoo really hurt? Beyond Wallace's initial pain of getting "inked," these defendants learned the hard way that a tattoo can also hurt years later in the courtroom. We probably will not learn how much the defendants paid to settle the case, the effect the lawsuit had on stock, and the attorneys' fees the defendants paid to defend the case.

The question then becomes, what can be learned from this tattoo? Though not a shot heard around the world, it should sound a warning to companies and advertising agencies that feature celebrities (sporting tattoos and body art) in advertisements on television, billboards, and the Internet.

III. AT LEAST INITIALLY, TATTOOS ARE COPYRIGHTABLE SUBJECT MATTER OWNED BY THE AUTHOR, WHO MAY OBTAIN AND ENFORCE THE COPYRIGHT

To be copyrighted, a work must be "fixed" and "original." The "fixed"¹³ requirement means that the work has been embodied in a form that is sufficiently permanent or stable long enough that it may be perceived, reproduced, or communicated. The "original"¹⁴ requirement is relatively low and usually satisfied so long as the work was not copied from another¹⁵ and the work was more than merely trivial.¹⁶ Although copyright protection attaches to

¹² Stipulation of Dismissal with Prejudice, *Reed v. Nike, Inc.*, No. 05-CV-198 BR (D. Or. Oct. 19, 2005).

¹³ 17 U.S.C. § 101 (2000) ("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. A work consisting of sounds, images, or both, that are being transmitted, is 'fixed' for purposes of this title if a fixation of the work is being made simultaneously with its transmission.").

¹⁴ 17 U.S.C. § 102 (2000) ("(a) Copyright protection subsists, in accordance with this title, 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. . . . (b) In no case does copyright protection for an original work of authorship extend to an idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.").

¹⁵ 17 U.S.C. § 103 (2000) ("(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully. (b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.").

¹⁶ In order to be copyrightable, a work need not be completely original. *See supra* note 15. Rather, validly copyrighted works may incorporate preexisting material that was copyrightable or actually copyrighted. So long as the derivative work entails "a minimal degree of creativity" it is "sufficiently original" under copyright laws. *Feist Publications*,

a work upon its creation, an author must file an application for registration¹⁷ of the work with the Copyright Office in order to sue for copyright infringement.¹⁸ Registration also entitles a plaintiff to seek statutory damages and attorneys' fees¹⁹ for an infringement commenced after the effective date of the copyright registration or when the effective date of the copyright registration occurs after infringement, but within three months of the first publication (presumably the author's first publication) of the work.²⁰

Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345–46 (1991); *see also id.* (“at least some minimal degree of creativity”; “a modicum of creativity”); *see also id.* at 363 (copyrights protect works possessing “more than a *de minimus* quantum of creativity”); *see also* Swirsky v. Carey, 376 F.3d 841, 851 (9th Cir. 2004) (“In this circuit, the definition of originality is broad, and originality means ‘little more than a prohibition of actual copying.’ All that is needed to satisfy originality is for the author to contribute ‘something more than a “merely trivial” variation.’”).

¹⁷ A valid copyright registration affords an author a number of benefits, including the right to sue for copyright infringement in federal court under 17 U.S.C. § 501 (2000). *See supra* notes 6–8; *see also* 17 U.S.C. § 411(a) (2000) (“Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), no action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.”).

¹⁸ More precisely, an application to register the copyright must be filed, and either granted or refused, before bringing suit. 17 U.S.C. § 411(a) (“[W]here the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute an action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.”); *see also* La Resolana Architects, PA v. Clay Realtors Angel Fire, 416 F.3d 1195, 1200–01 (10th Cir. 2005); *Gaiman v. McFarlane*, 30 F.3d 644, 655 (7th Cir. 2004). The plaintiff may even file an application for registration in anticipation of litigation and request an expedited examination in a procedure called a “special handling.” *See* U.S. Copyright Office, CIRCULAR 10: SPECIAL HANDLING (2003).

¹⁹ 17 U.S.C.A. § 412 (West 2005) (“In any action under this title . . . for infringement of the copyright of a work that has been preregistered under section 408(f) before the commencement of the infringement and that has an effective date of registration not later than the earlier of 3 months after the first publication of the work or 1 month after the copyright owner has learned of the infringement, . . . no award of statutory damages or of attorney’s fees, as provided by sections 504 and 505 shall be made for—(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or (2) 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.”).

²⁰ For purposes of section 412, infringement commences at “the time when the first act of infringement in a series of ongoing discrete infringements occurs.” *Johnson v. Jones*, 149 F.3d 494, 506 (6th Cir. 1998). At least one court has held that the accused infringer’s publication shall not be considered a publication for purposes of the plaintiff’s copyright application. *Cipes v. Mikasa, Inc.*, 346 F. Supp. 2d 371, 374–75 (D. Mass. 2004). The *Cipes* court found that the infringement plaintiff’s photographs were properly registered as part of an “unpublished” collection, even though the defendant had previously used photographs on a website and in magazines, because the exclusive right to “publish” a work is reserved to the author by 17 U.S.C. § 106(3), and an unauthorized user thus cannot change the status of an author’s work from unpublished to published, and the photographs had not been licensed to the defendant at the time of the defendant’s use. *Id.*

The elements of a copyright infringement cause of action are: “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”²¹ Absent direct proof of copying, the copying may be inferred where the defendant had access to the copyrighted work and the accused work is substantially similar to the copyrighted work. In the case of a tattoo, body piercing, or other form of body art, the “access” and “substantially similar” standards ought to be easily met—the actual artwork that was transferred to the human body or otherwise applied to the skin is at issue.²² Assuming the plaintiff owns a valid copyright (and a defendant proves no other defense), then the defendant who reproduces, prepares a derivative work based on, or distributes copies of the tattoo, for instance, without consent, permission, or authority of the copyright owner thereby directly infringes the copyright.

In addition to the defendant who commits an act of direct infringement (e.g., Nike and Weiden & Kennedy’s alleged use of the tattoo or a copy of the tattoo in an advertising campaign), the United States Supreme Court recently recognized secondary liability for copyright infringement, including the theory of contributory copyright infringement. According to the Court in *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*,

[o]ne infringes contributorily by intentionally inducing or encouraging direct infringement . . . , and infringes vicariously by profiting from direct infringement while declining to exercise a right to stop or limit it. Although ‘[t]he Copyright Act does not expressly render anyone liable for infringement committed by another,’ these doctrines of secondary liability emerged from common law.²³

Thus, Reed alleged that Wallace intentionally induced and encouraged Nike and Weiden & Kennedy to infringe Reed’s copyright by failing to advise those defendants of Reed’s ownership interest in the tattoo.

Co-owners in a copyrighted work may use that work to generate revenues. If their use generates revenues, however, then absent an agreement to the contrary they must share any profits with the other co-owner in the copyrighted work. Known as an “accounting” theory, plaintiffs sometimes assert an

²¹ Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991).

²² A derivative work by its very definition is bound to be very similar to the original. 17 U.S.C. § 103(a) (2000) (copyrightable subject matter includes derivative works); see *supra* note 15. Even if the accused infringer may obtain a copyright to a derivative work, reproducing and distributing copies of that work may still infringe the original copyright. 17 U.S.C. § 106(2) (2000) (the owner of the original copyright possesses the exclusive right to prepare derivative works based on the copyright); see *supra* note 7; see also *Liu v. Price Waterhouse LLP*, 302 F.3d 749, 754 (7th Cir. 2002), *cert. denied* 539 U.S. 958 (2003).

²³ 125 S. Ct. 2764, 2776 (2005). See also *Bridgeport Music, Inc. v. Diamond Time, Ltd.*, 371 F.3d 883, 889 (6th Cir. 2004); *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1020 (9th Cir. 2001); *Matthew Bender & Co. v. West Publ’g Co.*, 240 F.3d 116 (2d Cir. 2001); *Cable/Home Comm’n Corp. v. Network Prods., Inc.*, 902 F.2d 829, 845 & 846 n.29 (11th Cir. 1990); *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 434 (1984); *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971).

accounting cause of action in the alternative to a claim for contributory copyright infringement,²⁴ which Reed did here.

Federal courts have original²⁵ and exclusive²⁶ jurisdiction to hear actions arising under the Copyright Act. A plaintiff asserting copyright infringement must file the lawsuit in a federal district court in any jurisdiction where the defendant resides, the defendant may be found, or the action arose.²⁷ If the defendant is a corporation, then the plaintiff may bring the action in the state where the corporation is incorporated, registered to do business, or has a principal place of business.²⁸

In general, federal courts also have jurisdiction to hear state law claims under principles of supplemental jurisdiction.²⁹ The rationale behind supplemental jurisdiction is that it “promotes judicial economy by making it possible to try related claims in a single federal action instead of splitting them between federal and state actions.”³⁰ Thus, a party may bring, in addition to a copyright infringement claim, claims arising under state law so long as those

²⁴ The Federal Rules of Civil Procedure permit alternative, albeit ostensibly inconsistent, pleading. FED. R. CIV. P. 8(a) (“Relief in the alternative or of several different types may be demanded.”). A theory of contributory infringement may maintain that the plaintiff is sole owner in the copyrighted work, while an “accounting” theory may allege that the defendant is a “co-owner” who must share any profits for using the copyrighted work to generate a gain.

²⁵ 28 U.S.C. § 1331 (2000) (“The district courts shall have original jurisdiction of all civil actions arising under the Constitution, laws, or treaties of the United States.”).

²⁶ 28 U.S.C. § 1338(a) (2000) (“The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.”).

²⁷ 28 U.S.C. § 1391(b) (2000) (“A civil action wherein jurisdiction is not founded solely on diversity of citizenship may, except as otherwise provided by law, be brought only in (1) a judicial district where any defendant resides, if all defendants reside in the same State, (2) a judicial district in which a substantial part of the events or omissions giving rise to the claim occurred, or a substantial part of the property that is the subject of the action is situated, or (3) a judicial district in which any defendant may be found, if there is no district in which the action may otherwise be brought.”).

²⁸ See 28 U.S.C. § 1391(c) (2000) (“For purposes of venue under this chapter, a defendant that is a corporation shall be deemed to reside in any judicial district in which it is subject to personal jurisdiction at the time the action is commenced. In a State which has more than one judicial district and in which a defendant that is a corporation is subject to personal jurisdiction at the time an action is commenced, such corporation shall be deemed to reside in any district in that State within which its contacts would be sufficient to subject it to personal jurisdiction if that district were a separate State, and, if there is no such district, the corporation shall be deemed to reside in the district within which it has the most significant contacts.”).

²⁹ 28 U.S.C. § 1367(a) (2000) (“Except as provided in subsections (b) and (c) or as expressly provided otherwise by Federal statute, in any civil action of which the district courts have original jurisdiction, the district courts shall have supplemental jurisdiction over all other claims that are so related to claims in the action within such original jurisdiction that they form part of the same case or controversy under Article III of the United States Constitution. Such supplemental jurisdiction shall include claims that involve the joinder or intervention of additional parties.”).

³⁰ FLEMING JAMES, JR. ET AL., CIVIL PROCEDURE § 2.28 (5th ed., 2001).

claims have not been preempted by the Copyright Act.³¹ To survive a preemption attack, state law claims must be based on rights that are qualitatively different from the rights protected under the Copyright Act and must contain an extra element to the cause of action making it different in nature from proving copyright infringement.³²

IV. INTELLECTUAL PROPERTY MAY BELONG TO A HIRING PARTY SUCH AS A CUSTOMER UNDER CERTAIN LIMITED CIRCUMSTANCES

In addition to the registration requirement, only the exclusive owner of the copyright has standing to bring a suit for infringement of a registered copyright.³³ Generally, a copyright holder can prove ownership by a copyright registration.³⁴ Just as every case may involve multiple defendants, however, a case may also require other plaintiffs who are not already parties to join, or be joined to, the lawsuit.

³¹ 17 U.S.C. § 301(a) (2000) (“[A]ll legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by this title. [N]o person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.”).

³² *Davidson & Assocs. v. Jung*, 422 F.3d 630, 638–39 (8th Cir. 2005) (breach of license agreement not preempted); *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1199 n.2 (10th Cir. 2005) (copyright infringement may also give rise to state law claims for unfair competition, tortious interference, or breach of contract); *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905, 908–10 (7th Cir. 2005) (Illinois Right of Publicity Act protecting individual’s right to control use of identity (e.g., name, signature, photograph, image, likeness, or voice) for commercial purpose was not preempted); *Ritchie v. Williams*, 395 F.3d 283, 287–88 (6th Cir. 2005) (breach of contract claim preempted); *Stromback v. New Line Cinema*, 384 F.3d 283, 302–07 (6th Cir. 2004) (commercial misappropriation claim preempted; misappropriation of trade secrets claim not preempted; conversion claim usually not preempted; tortious interference with prospective economic advantage claim preempted); *Grosso v. Miramax Film Corp.*, 383 F.3d 965, 968 (9th Cir. 2004) (breach of implied contract claim not preempted); *Dunlap v. G&L Holding Group, Inc.*, 381 F.3d 1285, 1297–98 (11th Cir. 2004) (conversion claim not preempted when related to non-copyrightable subject matter, but holding the case must be remanded to state court when there is no other basis for federal subject matter jurisdiction); *Briarpatch Ltd. v. Phoenix Pictures, Inc.*, 373 F.3d 296, 306–07 (2d Cir. 2004) (unjust enrichment claim preempted; breach of fiduciary duty claim not preempted; conversion and trover claims not decided).

³³ 17 U.S.C. § 501(b) (2000) (“The legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of section 411, to institute an action for any infringement of that particular right committed while he or she is the owner of it.”).

³⁴ *See* 17 U.S.C. § 410(c) (2000) (“In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.”).

The legal rule is known as “joinder.”³⁵ When, for instance, a person has an interest in the subject of the action that would be impaired or complete relief cannot be accorded without substantial prejudice to the parties who are already parties, then the court may consider dismissing the action.³⁶ Permissive joinder, on the other hand, covers a scenario where the person has a right to relief in the action that shares a question of law or fact common to the parties who are already parties.³⁷ Finally, a non-party may seek to intervene as a plaintiff to protect an interest in the subject matter of the action that may be impaired, or if a United States statute confers such a right.³⁸

Joinder applies equally in a copyright infringement under the Copyright Act if there is or may be more than one exclusive owner.³⁹ That begs the question, who owns the copyright in a tattoo?

Although ownership vests in the author of the work,⁴⁰ one need not be the author of a copyrighted work to be its owner. “Works made for hire” and “joint works” are two specific exceptions.⁴¹ Furthermore, the author may transfer the copyright to the tattoo customer.⁴²

³⁵ See FED. R. CIV. P. 13(h) (“Persons other than those made parties to the original action may be made parties to a counterclaim or cross-claim in accordance with the provisions of Rules 19 and 20.”).

³⁶ See FED. R. CIV. P. 19(a) (“If the person should join as a plaintiff but refuses to do so, the person may be made a defendant, or, in a proper case, an involuntary plaintiff.”); see also FED. R. CIV. P. 19(b) (“[T]he court shall determine whether in equity and good conscience the action should proceed among the parties before it, or should be dismissed, the absent person being thus regarded as indispensable.”).

³⁷ See FED. R. CIV. P. 20(a) (“All persons may join in one action as plaintiffs if they assert any right to relief jointly, severally, or in the alternative in respect of or arising out of the same transaction, occurrence, or series of transactions or occurrences and if any question of law or fact common to all these persons will arise in the action.”).

³⁸ See FED. R. CIV. P. 24 (“(a) Intervention of Right”; “(b) Permissive Intervention”; and “(c) Procedure.”).

³⁹ 17 U.S.C. § 501(b) (2000) (The legal or beneficial owner of an exclusive right under a copyright may bring the copyright action, but “[t]he court may require such owner to serve written notice of the action with a copy of the complaint upon any person shown, by the records of the Copyright Office or otherwise, to have or claim an interest in the copyright, and shall require that such notice be served upon any person whose interest is likely to be affected by a decision in the case. The court may require the joinder, and shall permit the intervention, of any person having or claiming an interest in the copyright.”).

⁴⁰ 17 U.S.C. § 201(a) (2000) (“Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.”).

⁴¹ *Id.* See also 17 U.S.C. § 201(b) (2000) (“In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.”).

⁴² 17 U.S.C. § 201(d)(1) (2000) (“The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law. . . .”).

A. *Works Made for Hire Belong to the Hiring Party*

In a work made for hire, the employer or other person for whom the work was prepared is considered to be the author and, unless the parties expressly agreed in writing to the contrary, owns all of the rights in the copyright.⁴³ Thus, the work made for hire treats the hiring party as both the owner and the author as a matter of law. There are two types of works made for hire under section 101 of the Copyright Act,⁴⁴ and the Supreme Court, in *Community for Creative Non-Violence v. Reid*,⁴⁵ found each type to be “mutually exclusive” of the other.

The first type of work made for hire is a work prepared by an “employee” within the scope of his or her employment. In the tattoo industry, it seems unlikely that the tattooist meets any of the approximately 13 factors that the *Community for Creative Non-Violence* Court identified as comprising the employee-type of work made for hire:

[W]e consider the hiring party’s right to control the manner and means by which the product is accomplished. Among the other factors relevant to this inquiry are 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.⁴⁶

The other type of work made for hire applies to works created by independent contractors. While that ostensibly appears on its face to cover the tattooist, the customer should not miss out on two critical requirements.

First, a work created by an independent contractor can constitute a work made for hire only if “the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.”⁴⁷ Does the

⁴³ 17 U.S.C. § 201(b).

⁴⁴ 17 U.S.C. § 101 (2000) (“A ‘work made for hire’ is—(1) a work prepared by an employee within the scope of his or her employment; or (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.”).

⁴⁵ 490 U.S. 730, 743 (1989) (interpreting 17 U.S.C. § 101 (*see supra* note 44) and 17 U.S.C. § 201(b) (*see supra* note 41)); *see also id.* at 742–43 (section 101, paragraph 1 applies to works created by employees and section 101, paragraph 2 to works created by independent contractors).

⁴⁶ *Id.* at 751–52 A work made for hire is “a work prepared by an employee within the scope of his or her employment.” *See* 17 U.S.C § 101(1), *supra* note 44.

⁴⁷ *Id.* at 738 A work made for hire is “a work specially ordered or commissioned.” *See* 17 U.S.C. § 101, *supra* note 44.

written agreement need to use any magic language in order to satisfy the Copyright Act? Interpreting section 101's "work made for hire" definition number 2, the Ninth Circuit found that whether a written agreement used "the talismanic words 'specially ordered or commissioned' matters not, for there is no requirement, either in the Act or the case law, that work-for-hire contracts include any specific wording," but the written agreement at issue had used the phrase "works made for hire."⁴⁸ Courts generally require, however, that the written agreement exists before the work is created.⁴⁹ Furthermore, the tattooist may still attack a written agreement under traditional principles of contract law.⁵⁰

Second, the work must fit within one of the nine categories of "specially ordered or commissioned" works enumerated in the Act: "a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas."⁵¹ Absent an extension, modification, or reversal of existing law, or the establishment of new law, a traditional tattoo as transferred to the skin does not seem to fit the categories for a specially ordered or commissioned work.

Therefore, the tattoo would probably not constitute a work made for hire under either paragraph of section 101. But do not forbear considering this theory: Under unusual circumstances on a case-by-case basis, the *Community for Creative Non-Violence* factors might militate toward making the argument and asserting the work to be one made for hire.

B. Joint Works Are Co-Owned by the Authors

As an alternative solution to a situation that does not support the work for hire doctrine, an accused infringer may allege joint authorship. For instance, there was some suggestion in Reed's complaint that Wallace may have researched and come up with the idea for an Egyptian-themed family design with a stylized sun in the background and made additional changes to Reed's

⁴⁸ *Warren v. Fox Family Worldwide, Inc.*, 328 F.3d 1136, 1141 (9th Cir. 2003) (written agreement complied with section 101 where, although the writing had not used the term "copyright" or the phrase "specially ordered or commissioned," it had used the phrase "work made for hire.").

⁴⁹ *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F.3d 586, 591 (7th Cir. 2003) ("For an item to be a commissioned work, then, the parties must agree in advance that that is what it will be.").

⁵⁰ For instance, an agreement may be rescinded in the event of breach that is so material and substantial in nature that it affects the very essence of the contract and defeats the object of the parties. *Warren*, 328 F.3d at 1143. Also, a hired party may try to argue that she or he is a beneficial owner under section 501(b), but at least one circuit has held that "Congress did not intend to extend the concept of beneficial ownership to include an employee in a work made for hire arrangement." *Moran v. London Records, Ltd.*, 827 F.2d 180, 183 (7th Cir. 1987).

⁵¹ *Cnty. for Creative Non-Violence*, 490 U.S. at 738; see also "work made for hire"(2), 17 U.S.C. § 101, *supra* note 44.

sketch. This arguably could make Wallace a co-author in the work he brandishes on his upper right arm, one of the more distinctive tattoos in sports.

The authors of a joint work are co-owners of any copyright in the work.⁵² Moreover, co-authors of a joint work “hold undivided interests in a work, despite any differences in each author’s contribution.”⁵³

A joint work is “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”⁵⁴ Joint authorship requires, first, that “putative coauthors make objective manifestations of a shared intent to be coauthors.”⁵⁵ Second, “[a] collaborative contribution will not produce a joint work, and a contributor will not obtain a co-ownership interest, unless the contribution represents original expression that could stand on its own as the subject matter of copyright.”⁵⁶

Perhaps thinking that half recovery is better than full recovery, a defendant might rush into pleading joint authorship via an accounting theory as an alternative to exclusive ownership as a work made for hire. While the Federal Rules of Civil Procedure ought to permit alternative pleading, a defendant needs to exercise some caution and judgment in pleading, discovery, oral argument, and the record. Indeed, a court might find as a matter of law that a work was not made for hire, and then in the face of a defendant’s repeated claims of exclusive authorship as a work made for hire, might grant summary judgment against a theory of joint authorship by finding that the defendant cannot possibly demonstrate the requisite shared intent to be a co-author.

If successful, however, proving joint authorship gets the defendant only halfway home. Absent a written agreement to the contrary, each co-owner has the right to use the copyright, but might be required to share the profits with other co-owners.⁵⁷ Nonetheless, proving a contribution to the copyrighted work, even a relatively minor contribution, entitles the contributor to joint authorship status and a potentially significant benefit by possibly reducing the damages.⁵⁸

⁵² 17 U.S.C. § 201(a) (2000).

⁵³ *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1068 (7th Cir. 1994).

⁵⁴ 17 U.S.C. § 101. *See also Cmty. for Creative Non-Violence*, 490 U.S. at 753 & n.32 (1989) (if the district court on remand should determine that the parties prepared the work “with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole,” then the parties “would be co-owners of the copyright in the work”).

⁵⁵ *Aalmuhammed v. Lee*, 202 F.3d 1227, 1234 (9th Cir. 2000).

⁵⁶ *Erickson*, 13 F.3d at 1070. Thus, to establish co-ownership of a copyright, a litigant 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.” *Id.* at 1071.

⁵⁷ *Childress v. Taylor*, 945 F.2d 500, 505 (2d Cir. 1991).

⁵⁸ *See Cmty. for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1498 (D.C. Cir. 1988), *aff’d*, 490 U.S. 730 (1989).

C. *A Copyright May Be Transferred Before or After the Fact*

The previous theories had a time element to them in that the copyright vested initially with the author (the hiring party in a work made for hire) or authors (e.g., a joint work) of the work. A transfer theory centers on the work at or after the time of its creation, and might provide the alchemy for transmuting the issue from one of authorship into one of ownership—a complete defense to copyright infringement.

Ownership in copyrights, like other property rights, may be transferred in whole or in part.⁵⁹ In addition, any of the exclusive rights specified in section 106 may be transferred and owned separately.⁶⁰ Section 204(a) of the Copyright Act sets forth the requirements of a valid transfer: “A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of transfer, is in writing and signed by the owner of the rights conveyed or such owner’s duly authorized agent.” Parsing that section, transfer may be “by operation of law” or “in writing.”

Section 204(a) does not define the phrase “by operation of law,” and case law is quite sparse. The few courts to have considered the phrase interpret it to mean “transfers by bequest, bankruptcy, mortgage foreclosures, and the like.”⁶¹ Presumably, that narrow interpretation only would benefit a party defending against a tattooist’s copyright action in the most unusual circumstances.

The “in writing” distinction for a transfer under section 204(a) has two requirements. First, the writing in question does not have to be a magnum opus or an epistle: “a one-line pro forma statement will do.”⁶² In fact, section 204(a) is explicit that “a note or memorandum” may transfer the copyright. Therefore, the document need not even use the term “copyright” or contain any particular language so long as the writing or writings as a whole suggest that the parties intended to transfer a copyright interest.⁶³

Second, the writing that transfers the interest in a copyright must be signed by the transferor of the copyright or his agent. Other than any superficial similarity to the Statute of Frauds, section 204(a) is quite different. The Statute

⁵⁹ 17 U.S.C. § 201(d)(1) (2000) (“The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.”).

⁶⁰ 17 U.S.C. § 201(d)(2) (2000) (“Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by clause (1) and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.”).

⁶¹ *Taylor Corp. v. Four Seasons Greetings, LLC*, 403 F.3d 958, 963 (8th Cir. 2005).

⁶² *Lyrick Studios, Inc. v. Big Idea Prods., Inc.*, 420 F.3d 388, 392 (5th Cir. 2005).

⁶³ *ITOFCA, Inc. v. MegaTrans Logistics, Inc.*, 322 F.3d 928, 931 (7th Cir. 2003); *see also* *Radio Television Espanola S.A. v. New World Entm’t, Ltd.*, 183 F.3d 922, 927 (9th Cir. 1999). The writing requirement serves to prevent inadvertent transfer of a copyright, forces the acquiring party to negotiate with the creator the rights being transferred and at what price, and gives some guidance in resolving disputes between the parties. *Effects Assocs. v. Cohen*, 908 F.2d 555, 557 (9th Cir. 1990).

of Frauds serves an evidentiary function to render unenforceable an otherwise valid agreement, whereas, the agreement under section 204(a) is invalid *ab initio*.⁶⁴ An oral assignment later confirmed in writing, however, may validate the transfer from the date of its inception (at least against an outsider to the assignment, e.g., the accused infringer).⁶⁵

In contrast to an exclusive license or the exclusive rights associated with a transfer under section 204(a), a copyright holder can grant an implied non-exclusive license via an oral agreement.⁶⁶ Thus, sometimes a defendant alleges to have a valid license to use the copyrighted works. A license may not always be, however, the magic bullet to defending against a copyright infringement suit. First, the owner of the original copyright possesses the exclusive right to prepare derivative works. Second, using copyrighted material that exceeds the scope of the license constitutes an infringement.⁶⁷

V. FOREWARNED IS FOREARMED

In basketball, as with other sports, a good offense sometimes makes the best defense. Likewise, Wallace's experience forewarns others with lessons for avoiding similar lawsuits.

Before getting a tattoo, anyone with a reasonable expectation of fame should arm herself or himself with a work-made-for-hire contract, a joint work agreement specifying the customer's contributions and expressing intent to make the customer a joint author, or some other written document transferring ownership from the tattooist and the tattoo business to the customer. As shown, many courts are fairly liberal on the specific wording. The would-be celebrity should seek legal advice or, if acting *pro se*, should ensure the written instrument uses the word "copyright" and states that all "ownership" in the tattoo and any drawing, sketch, and other work that becomes or embodies the tattoo vests in, belongs to, and is transferred in whole to the customer.

⁶⁴ *Lyrick Studios, Inc.*, 420 F.3d at 391–92.

⁶⁵ See *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F.3d 586, 592 (7th Cir. 2003) (an oral agreement, by itself, cannot support one's ability to sue for copyright infringement, but a *nunc pro tunc* document that memorializes a previous oral agreement is recognized, even if that document is executed during trial, against third party challenges to the agreement.).

⁶⁶ An exclusive license qualifies as a transfer requiring a written agreement under section 204(a) ("A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent."). See also 17 U.S.C. § 101 (2000) ("A 'transfer of copyright ownership' is an assignment, . . . exclusive license . . . or any of the exclusive rights [under section 106] comprised in a copyright, whether or not it is limited in time or place of effect, but not including a nonexclusive license.").

⁶⁷ See, e.g., *Liu v. Price Waterhouse, LLP*, 302 F.3d 749, 754 (7th Cir. 2003); see also *Liu v. Price Waterhouse, LLP*, 182 F. Supp. 2d 666, 672 (N.D. Ill. 2001); *Palladium Music, Inc. v. EatSleepMusic, Inc.*, 398 F.3d 1193, 1197 (10th Cir. 2005) ("A work can generally be copyrighted as a derivative work only if the new work was produced with the permission of the copyright owner of the preexisting work or its duly authorized licensee.") (citing 17 U.S.C. § 103(a) (2000); see *supra* note 15).

Moreover, the written instrument should express that the parties negotiated the agreement, that the transfer was bargained for, and that the agreed upon price included services and a transfer of ownership in whole of all copyright interests. If you want further insurance, then the agreement could reference and attach a copy of section 201 of the Copyright Act. Above all, the written instrument must be signed—before any work begins—by the tattooist and, preferably, also by the principal of the tattoo business.

What if that tattoo happened years ago and without any contract according to the previous paragraph? It is never too late to obtain a transfer of ownership.

Check the Copyright Office for any copyright registrations naming the tattooist or assigned to the tattoo business.⁶⁸ Admittedly, many people have long forgotten the name of the tattooist who inked them or have no idea of the tattoo business where they may have received the tattoo. But hopefully the celebrity, accustomed to would-be fortune seekers crawling out of the woodwork, can come forward with a name. If a copyright covers the tattoo, then seek a transfer of ownership under section 204(a). The copyright holder might try digging for gold in return for ownership transfer, or may have hit rock bottom and a bargain price might follow. Either way, it is better to know this prior to committing a potentially infringing act.

If the tattooist has no copyright certificate of registration, then perhaps a transfer of ownership might still be an option. Alternatively, if there is a good faith belief and corroborative evidence supporting the belief that the work was one made for hire, was a joint work, or was the subject of a document that arguably amounts to a transfer, then a race to the Copyright Office could result in ownership for the tattoo recipient.

Nothing prevented Wallace from pursuing his own copyright in 1998 or any time thereafter. Nor did anything prevent Nike, via a transfer from Wallace, from filing an application at any time. Indeed, Reed did not file his applications for copyright registration until after viewing the commercials in 2004, with his first application filed months later and his second application filed a year later.⁶⁹ Simply put, Wallace and Nike could possibly have had copyright registrations before Reed even filed his first application. Even when there are competing applications, the Copyright Office generally accepts both applications and ownership becomes an issue for courts to decide.⁷⁰

Registering a copyright is relatively simple and inexpensive. The application for a work of the visual arts contains, however, a few interesting questions from a strategic perspective: identifying authorship and claiming a

⁶⁸ See <http://www.copyright.gov/records/cohd.html>.

⁶⁹ Reed's 2004 Copyright Registration Number VA 1-265-074 for the Egyptian Family has an effective registration date of August 11, 2004. This preexisting registration material was included in his 2005 Copyright Registration Number VA 1-236-392 which had an effective registration date of March 7, 2005, and which added, as new matter, a stylized line drawing with updated and stylized objects, and modified the sun graphic.

⁷⁰ See *Lambert v. Pem-America, Inc.*, No. 03-C-3330, 2004 WL 422636, at *6 (N.D. Ill. Feb. 12, 2004); *Cherie Amie, Inc. v. Windstar Apparel Corp.*, 191 F. Supp. 2d 343, 351 (S.D.N.Y. 2001); see also *Comty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 735 (1989).

transfer. If the work was made for hire, then applicants would name and identify themselves as the “employer for hire of [the tattooist’s name].” If a Certificate of Registration issues, then the ownership vests originally with the applicants. Alternatively, applicants may identify themselves as co-authors who contributed to the work and, thereby, become co-owners but must share any profits with other owners in the copyrighted work. Finally, applicants must name the claimant who seeks the copyright. If an applicant decides to pursue a transfer theory and is not the author or joint author of the subject work, then provide a brief statement⁷¹ of how the applicant obtained ownership of the copyright and for which the applicant seeks registration⁷² in the copyrighted work: “by written contract,” “transfer of all rights by author,” or “assignment” should probably do.

Generally speaking, a Certificate of Registration is issued after about four to six months of examination. The tattooist might try to invalidate the copyright registration by arguing there was no transfer, work made for hire, or joint work. If registration occurs fewer than five years from the first publication, however, then under section 410(c) of the Copyright Act, an evidentiary rebuttable presumption of both the copyright validity “and of the facts stated in the certificate” is established and the burden shifts to the opposing party to prove why the copyright is invalid.⁷³

Indeed, courts generally forgive mistakes in the registration and invalidate a copyright only if the copyright holder’s claim to sole ownership or authorship was made intentionally or purposefully, which would amount to fraud on the Copyright Office.

For example, in *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, the accused infringer alleged that the copyright was invalid for claiming that the work was made for hire.⁷⁴ The court found that the work did not fit into one of the “nine specified categories” to be a commissioned work because the parties failed to agree in advance that this was how it would be known or categorized. In upholding the copyright, however, the court held that “[i]nadvertent mistakes on registration

⁷¹ 17 U.S.C. § 409(5) (2000) (“The application for copyright registration shall be made on a form prescribed by the Register of Copyrights and shall include . . . (5) if the copyright claimant is not the author, a brief statement of how the claimant obtained ownership of the copyright.”).

⁷² 17 U.S.C. § 408(a) (2000) (“The owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708. Such registration is not a condition of copyright protection.”).

⁷³ *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200–01 (10th Cir. 2005); *Palladium Music, Inc. v. EatSleepMusic, Inc.*, 398 F.3d 1193, 1196 (10th Cir. 2005); *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 534 (6th Cir. 2004); *Swirsky v. Carey*, 376 F.3d 841, 851 (9th Cir. 2004); *MyWebGrocer, LLC v. Hometown Info, Inc.*, 375 F.3d 190, 192 (2d Cir. 2004); *Mid America Title Co. v. Kirk*, 59 F.3d 719, 721 (7th Cir. 1995); *Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 507 (7th Cir. 1994).

⁷⁴ *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F.3d 586, 590 (7th Cir. 2003).

certificates” do not invalidate absent a showing that the copyright claimant “intended to defraud the Copyright Office by making the misstatement.”⁷⁵

In *Estate of Burne Hogarth v. Edgar Rice Burroughs, Inc.*,⁷⁶ the commissioning party listed the commissioned party as the author of a derivative work on the copyright registration from the early 1970s. The court found that this admission on the earlier registration did not preclude the commissioning party from later claiming the book was work for hire.⁷⁷ Rather, it shifted the burden of going forward to the commissioning party.⁷⁸ This was so even though the commissioning party had in fact made earlier corrections to the registration (spelling errors) but did not fully correct the registration until 1999.⁷⁹ On the facts decided by the district court and under Second Circuit law applicable to those facts, the Second Circuit Court of Appeals found that the books were works made for hire and, therefore, that Edgar Rice Burroughs, Inc. was, for purposes of the Copyright Act, the “author.”⁸⁰

⁷⁵ *Id.* at 591; *see also* *Gaiman v. McFarlane*, 360 F.3d 644, 655 (7th Cir. 2004); *Lambert*, 2004 WL 422636, at *6 (“Many courts also have required a party alleging fraud to demonstrate that it was prejudiced by the alleged fraud.”); *LZT/Filliung P’ship v. Cody/Braun & Assocs.*, 117 F. Supp. 2d 745, 751 (N.D. Ill. 2000) (“It is well established that immaterial, inadvertent errors in an application for copyright registration will be excused and do not destroy the validity of the registration. . . . Generally, an error is immaterial if its discovery is not likely to have resulted in the Copyright Office’s refusal of the application.”).

⁷⁶ *Estate of Burne Hogarth v. Edgar Rice Burroughs, Inc.*, 342 F.3d 149 (2nd Cir. 2003).

⁷⁷ *Id.* at 164–65 (“Even if the filing of an application for registration by an adverse party could start a limitations period, a matter we do not decide, a party cannot be held to have started the limitations period for assertion of its copyright claims by filing its own applications for registration, no matter how erroneous.”) (emphasis in original).

⁷⁸ *Id.* at 166–67 (“[A] certificate of registration creates no irrebuttable presumption of copyright validity. Extending a presumption of validity to a certificate of copyright merely orders the burdens of proof. . . . [A]ll that the statutory presumptions flowing from the certificates of registration do is to shift the burden of going forward.”) (internal citations omitted).

⁷⁹ *Id.* at 167 (“We acknowledge that we are disturbed that a corporation as sophisticated in the protection of its copyrights as ERB [Edgar Rice Burroughs, Inc.] did not correct the registrations for the Books to identify them as works for hire until 26 and 23 years, respectively, after the initial registrations. It is even more perplexing that Marion Burroughs, an officer of ERB and the daughter-in-law of Edgar Rice Burroughs, would file an application for a supplementary registration for *Tarzan of the Apes* in 1979 that only corrected the misspelling ‘Edgard’ and added Edgar Rice Burroughs as author of original text, but left Burne Hogarth identified as the author of the work with no indication that ERB claimed to be the proprietor of a work for hire. However, as we noted in rejecting the Hogarths’ laches contention, there is no evidence of prejudicial reliance by Burne Hogarth or his heirs on the lack of work-for-hire identification before 1999, nor is there any basis for rejecting the District Court’s well supported conclusion that the Books are works for hire.”).

⁸⁰ *Id.*

VI. CONCLUSION

So you want a tattoo, or want to display a tattoo in an advertisement? Beware: A veritable gauntlet of copyright issues may lurk beneath the best intentions.

Endorsements fuel many modern-day advertising campaigns, and celebrity sponsors sometimes adorn their bodies with one or more tattoos. Such an advertisement might feature or otherwise innocently use the tattoo without realizing that United States copyright laws protect the tattoo artist's interest in the tattoo and the drawing, sketch, or design that became the tattoo. In years past, copyright protection was a non-issue or ignored because tattooists were either too reticent to sue a customer or too complacent to challenge tattoo lore, favoring any and all available exposure for their work. Tomorrow's tattooist, however, may unabashedly forego the glory in favor of dowsing for gold when a celebrity is at the end of the divining rod, such as when the tattooist sees a potential payoff from the celebrity's accepting a lucrative sponsorship deal.

The *Reed* case—and its nascent theory of a tattoo artist asserting copyrights in tattoos—has a potentially far-reaching impact on any would-be celebrity with a reasonable expectation of fame and on any present-day athlete, actor or actress, as well as advertising agencies and product purveyors and service providers. But the *Reed* case may also cause alarm for other media industries such as magazines, newspapers, Internet websites, motion pictures, television broadcasting, and the entertainment industry.

Unless the tattooist's potential intellectual property is resolved, the celebrities and the companies they sponsor may have no alternative. To their dismay, they might need to digitally remove the tattoo from the commercial shot, or cover up the tattoo, thereby showing less skin.