

Written on the Body: Intellectual Property Rights in Tattoos, Makeup, and Other Body Art

Thomas F. Cotter^{*}
Angela M. Mirabole^{**}

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^{*} Professor of Law and Director of the Intellectual Property Program, University of Florida Fredric G. Levin College of Law.

^{**} J.D. 2003, University of Florida Fredric G. Levin College of Law; Associate, Conroy, Simberg, Gannon, Krevans & Abel, West Palm Beach, Florida, beginning Fall 2003. We thank Gabriel Kotch and Elizabeth Scheffler for their insightful comments and criticism. Any errors that remain are ours.

I. INTRODUCTION

The lights flash, the audience cheers, and the music begins as a controversial foul-mouthed rapper known as Marshall Mathers III, or the Real Slim Shady (“Eminem”), appears bare-chested on the stage. Eminem is promoting his new album with a national tour known as “Celebrity Bash.” Millions of fans around the world purchase CDs, posters, t-shirts, and other memorabilia showing Eminem’s new tattoo on the upper left side of his chest. This tattoo is composed of a red heart with an identical replica of Britney Spears’ squeaky clean, pigtail-wearing face, as seen in the 1999 “Hit Me Baby One More Time” pop video. The only difference is that here her tongue protrudes in the shape of a python. It seems that Eminem is criticizing Britney’s debut performance of the “I’m a Slave 4U” single at the MTV Video Music Awards in 2001. At this awards show, Britney performed her hot debut single while scantily clad with a snake as her main accessory. Eminem also has an entourage of six dancers with identical facial make-up designs as seen on Gene, Paul, Ace, Vinnie, Eric, and Peter, in the 1970s smash rock group KISS.

This hypothetical is not all that far-fetched, and it raises some interesting questions under copyright law, trademark law, and the right of publicity. A few cases have held or implied that an original pictorial work embodied in a tattoo or a make-up design is eligible for copyright protection.¹ Although we are not aware of any cases yet that have discussed the unauthorized reproduction of trademarked words or symbols in tattoos or other body art, the use of these symbols in body art is not uncommon,² and courts have discussed the analogous

¹ See *Gonzales v. Kid Zone, Ltd.*, 2001 WL 930791, at 1, 2 (N.D. Ill. Aug. 15, 2001); *Carell v. Shubert Org.*, 104 F. Supp. 2d 236, 247 (S.D.N.Y. 2000). In *Gonzales*, the court held that an artist’s pictorial works, including depictions of the Virgin Mary, eagles, and national flags were copyrightable, and thus infringed when incorporated into the defendant’s transfer tattoos. 2001 WL 930791, at 2. In *Carell*, the parties agreed that the make-up designs were copyrightable, and that the creator of these designs was entitled to copyright protection even if she did not apply the make-up to the show’s performers. The court stated, “The Designs contain the requisite degree of originality, and are fixed in tangible form on the faces of the *Cats* actors.” 104 F. Supp. 2d at 247.

² For example, one of the contenders for the title of “World’s Most Tattooed

unauthorized use of trademarks on jewelry, clothing, and other objects.³ Finally, right of publicity issues could arise with respect to the unauthorized commercial use of a person's name, image, or other indicia of identity in a work of body art.⁴ In our hypothetical above, both the tattoo artist and Eminem might be viewed as engaging in the unauthorized commercial use of Britney Spears' image, and also of any trademark rights in that image.

The application of standard legal doctrine to body art nevertheless could lead to some disquieting results.⁵ Would it violate the Copyright

Woman," Julia Gnuse, sports several tattoos of fictional characters from cartoons and television sitcoms. See *Guinness World Records Primetime*, Episode 109 (FOX television broadcast, Oct. 6, 1998) available at <http://www.lmnotv.com/new/shows/grb/eg/109/109.htm#>; cf. GUINNESS WORLD RECORDS 2002 17 (Antonia Cunningham ed., 2002) (listing another woman, "Krystyne Kolorful," as the world's most tattooed woman). Presumably, some of these fictional characters are protected under both copyright and trademark law. We don't know whether Ms. Gnuse has obtained permission to use these characters, and we don't want to get her in trouble, so if there are any entertainment lawyers out there reading this Essay, please ignore this footnote. For other examples of the use of cartoon characters and other possibly copyrighted or trademarked pictorial works in tattoos, pick up any tattoo magazine at your local newsstand or visit a website devoted to tattoos, such as Tattoos.com, at <http://www.tattoos.com>, which contains links to many more relevant websites. If you're not already familiar with the world of body art, you may be surprised to discover just how many publications and websites are devoted to this topic.

³ See *infra* Part III.

⁴ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995); see also *infra* Part IV.

⁵ In this Essay, we focus mostly on issues relating to tattoos and makeup designs, but our analysis presumably would apply to other forms of body art as well, such as original hair designs or an original arrangement of piercings. Moreover, we have chosen to limit our analysis to copyright, trademark, and publicity issues only; we do not discuss patent rights for inventions such as new techniques for creating or applying body art. Finally, we do not discuss intellectual property rights in more conventional or related types of art, except as they relate to body art. Copyright rights uncontroversially subsist in jewelry and in fabric design. See, e.g., *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101 (2d Cir. 2001) (jewelry); *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759 (2d Cir. 1991) (fabric design). But see *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971) (holding design of jeweled bee pin uncopyrightable, reasoning that there were so few ways of

Act, for example, to photograph a person sporting makeup or a tattoo, even in a public place? Would the subject's subsequent alteration of his tattoo violate the tattoo artist's exclusive right to prepare derivative works, or her moral rights? What would be the appropriate remedy if a work of body art is itself infringing—could a court order a person wearing body art not to appear in public, to cover up, or to remove an offending tattoo? Would such an order violate some constitutional norm of privacy, bodily integrity and autonomy, or free speech? As for trademark law, is the application of a trademarked picture or logo to a person's body a commercial use, and is it likely to cause confusion or dilution of the mark? Would the artist and the subject⁶ both be liable, or only the artist? Similar issues arise with respect to the right of publicity, which forbids commercial but not artistic uses of a person's name, image, or other indicia of identity. Both trademark law and the right of publicity, in other words, raise the question of whether body art is really "art," or just commerce.

Courts have not yet had to confront these hard questions, for a number of reasons. The difficulty of monitoring the subject or others' subsequent use of their designs may discourage many body artists from attempting to enforce their rights,⁷ or even from registering their

expressing the underlying idea that the idea merged with the expression). As a general rule, however, copyright does not subsist in clothing design, although it may subsist in some fanciful costumes and does subsist in masks. See *Registrability of Copyright Designs*, 56 Fed. Reg. 56530-02 (Nov. 5, 1991); see also *Lyons Partnership v. Morris Costumes, Inc.*, 243 F.3d 789 (4th Cir. 2001) (affirming judgment of copyright infringement with respect to costume); *Poe v. Missing Persons*, 745 F.2d 1238 (9th Cir. 1984) (remanding for consideration of whether disputed item was utilitarian clothing or a work of art); 1-2 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.08[H][3], at 2-148 (2002) (citing additional cases regarding dress and fabric designs). Some other countries do extend copyright protection to clothing designs, however. See André Lucas & Robert Plaisant, *France*, § 2[2][b], at FRA-25, FRA-28 (noting that French law extends copyright protection to original hairstyles and to the creations of the fashion industry), in 1 *INTERNATIONAL COPYRIGHT LAW AND PRACTICE* (David Nimmer & Paul Edward Geller eds., 2002).

⁶ For convenience, we will refer to the person wearing the body art as the "subject."

⁷ Some tattoo artists sell copies of their designs ("flash") for others to use. See, e.g., *Tattoo Flash*, at <http://www.easyriders.com/content/magazines/flash/flash.asp>.

copyrights (a precondition to filing suit and for obtaining statutory damages).⁸ And perhaps copyright owners, trademark owners, and celebrities have not made an issue of others' incorporation of their intellectual property into body art out of concern that doing so would irritate fans and because of the high costs of policing these uses.⁹ As the law of intellectual property continues its relentless expansion into previously-untouched aspects of the human experience,¹⁰ however, it seems virtually inevitable that more people will begin asserting intellectual property rights in their works of body art, or against the unauthorized use of their intellectual property in others' body art. The most likely scenario is probably one in which a person uses a work of body art in a highly-publicized, commercial, and arguably degrading manner, as in our Eminem hypothetical,¹¹ but other scenarios are certainly possible. Body art has become a big business, with one study claiming an increase in the number of tattoo parlors in the United States from about 300 in the 1970s to more than 4,000 in 1999. Surveys estimate that more than ten percent of Americans and Canadians sport tattoos.¹² Tattoos and other forms of body adornment

We are, however, unaware of any cases in which tattoo artists have sued for the unauthorized use of these designs.

⁸ See 17 U.S.C. §§ 411(a) & 412 (2002).

⁹ See, e.g., E-mail from Deborah Wilcox, Esq., Baker & Hostetler, Cleveland, Ohio, to Thomas F. Cotter (Sept. 4, 2002) (on file with author) (making these points). Ms. Wilcox represents, among other clients, United Features Syndicate.

¹⁰ See, e.g., Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999); Lawrence Lessig, *The Creative Commons*, 55 FLA. L. REV. (forthcoming 2003).

¹¹ See *supra*, at 98.

¹² See CANADIAN PRESS/LÉGER MARKETING, HOW CANADIANS FEEL ABOUT TATTOOS AND BODY PIERCING: REPORT 2 (Dec. 2002) (reporting that 11% of Canadians have tattoos), available at

<http://www.legermarketing.com/documents/spclm/021230eng.pdf>; Stephen Lynch, *Tattoo Removal a Laser-Hot Business*, ORANGE COUNTY REGISTER, Dec. 20, 2001 (referencing a study by the American Academy of Dermatology on the number of tattoo parlors); Bryan Rourke, *The Skinny on Tattoos: Mainstream America Is Getting the Point*, PROVIDENCE JOURNAL-BULLETIN, Dec. 2, 2002, at E-1 (reporting on a survey conducted by the University of Connecticut's Center for Survey Research and Analysis, finding that 18% of adults are tattooed); David Whelan, *Ink Me, Stud*, 23 AMERICAN DEMOGRAPHICS 9, 9 (Dec. 2001) (reporting that "10 percent of

have become the subject of serious inquiry on the part of cultural studies scholars,¹³ art historians and art theorists,¹⁴ photojournalists,¹⁵ and others.¹⁶ As these authors demonstrate, body art dates back many millennia and has existed in virtually every human culture.¹⁷ Like other folk artists once shunned by the world of fine arts, body artists take their work quite seriously,¹⁸ and even museums have begun to feature exhibits on tattoo art.¹⁹ When body art cases finally make their way into court, judges too will have to take the claims of body artists seriously because, as Justice Holmes once suggested, judges are not art critics.²⁰ In other words, the courts' lack of institutional competence to decide whether art is good or bad counsels in favor of equal treatment of all art, whether high or low, elite or popular.

Americans have or have had a tattoo, 2 percent have a body piercing other than an earring and 4 percent have both").

¹³ See, e.g., NIKKI SULLIVAN, *TATTOOED BODIES: SUBJECTIVITY, TEXTUALITY, ETHICS, AND PLEASURE* (2001).

¹⁴ See, e.g., *BODY MODIFICATION* (Mike Featherstone ed., 2000); *WRITTEN ON THE BODY: THE TATTOO IN EUROPEAN AND AMERICAN HISTORY* (Jane Caplan ed., 2000).

¹⁵ See, e.g., TED POLHEMUS, *BODY STYLES* (1988); TED POLHEMUS & HOSK RANDALL, *THE CUSTOMIZED BODY* (1996); DONALD RICHIE & IAN BURUMA, *THE JAPANESE TATTOO* (1980); ANDRÉ VIREL ET AL., *DECORATED MAN: THE HUMAN BODY AS ART* (I. Mark Paris tr. 1979).

¹⁶ As any visit to the local newsstand will demonstrate, there is also a wealth of tattoo magazines, including *Skin & Ink*, *Tattoo*, and many, many others.

¹⁷ Polhemus and Randall, for example, note that the 5,000-year-old "Iceman" whose preserved body was discovered in the early 1990s in the Alps bore fifteen tattoos. See POLHEMUS & RANDALL, *supra* note 15, at 23.

¹⁸ See, e.g., *BODY MODIFICATION*, *supra* note 14 (discussing the works of performance artists such as Orlan, whose art consists of the use of plastic surgery to modify her own body). Tattoo magazines frequently contain features about or interviews with leading tattoo artists. See, e.g., *TATTOO* (Oct. 2002) (containing a tribute to the late tattooist Felix Leu and an interview with tattooist/painter Don Nolan).

¹⁹ See, e.g., The British Tattoo History Museum, <http://www.tattoo.co.uk/bthm.htm>; National Maritime Museum, *Skin Deep: A History of Tattooing* (exhibition, Mar. 22, 2002 to Sept. 30, 2002), <http://www.nmm.ac.uk>.

²⁰ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903); see also Robert A. Gorman, *Copyright Courts and Aesthetic Judgments*, 25 COLUM. J. L. & ARTS 1, 11-12 (2001) (arguing that judges sometimes have no choice but to make aesthetic judgments, but that they also sometimes abuse the power to do so).

In this Essay, we shall argue that, when courts do address these issues, they will need to show sensitivity to the specific facts, and in some instances may have to modify standard legal doctrines to account for the competing interests of the body artist, the intellectual property rights owner, and the human subject. With respect to copyright, for example, the entry of injunctive relief against the subject may raise issues of constitutional magnitude. With respect to trademark law and the right of publicity as well, the particular facts will be key. In most instances, courts probably will deem the incorporation of a trademarked logo or a celebrity image into a work of body art to be artistic or ornamental (and thus privileged), but in some instances the subject's use of the art may be commercial (and thus potentially actionable).

In Part II, we discuss the copyright issues that arise in the context of body art. Part III addresses the trademark issues, and Part IV the publicity issues. Part V concludes the analysis.

II. COPYRIGHT ISSUES

Copyright subsists in original works of authorship, including pictorial works that are fixed in a tangible medium of expression.²¹ Some body art designs no doubt lack even the minimal amount of originality that is necessary to sustain copyright protection,²² while others are so common that they would be considered scenes à faire and hence not subject to copyright protection. An example would be a clichéd tattoo design, such as a heart with a couple's first names inside, or perhaps a standard harlequin's makeup.²³ An *original* pictorial work that is embodied in a tattoo or a facial makeup design, however, would appear to be copyrightable, as long as it is fixed in a tangible medium of expression such as a human body. In the *Cats* case, for

²¹ 17 U.S.C. § 102 (1996).

²² See *id.*; see also *Feist Publ'ns, Inc. v. Rural Tel. Serv.*, 499 U.S. 340, 358 (1991).

²³ For a discussion of scenes à faire, see *Sinicola v. Warner Bros.*, 948 F. Supp. 1176, 1190 (E.D.N.Y. 1996) (noting that "[s]imilarities in the works as to these themes, characters, and settings are too general or trivial or are stereotyped expression amounting to unprotectable *scenes a faire*.").

example, the court found that the makeup artist's facial makeup designs used in the famed musical production were sufficiently original and expressive, and thus copyrightable.²⁴ When copyright does subsist in a work of body art, it affords the author of the work a variety of exclusive rights, including the rights of reproduction, adaptation, public display, and in some instances moral rights.²⁵

The assertion of copyright protection in a work of body art nevertheless gives rise to some difficult questions, including questions of copyright ownership, "incidental" reproductions, adaptation and moral rights, and remedies. A related question is whether the incorporation of another person's copyrighted design into a tattoo or other body art infringes, and if so what the appropriate remedy would be. We discuss these issues in the sections that follow.

A. *Ownership*

Copyright initially vests in the "author" of a work of authorship,²⁶ who may thereafter assign or license the copyright to anyone else.²⁷ Depending on the circumstances, however, the "author" of a work of body art could be the body artist (or her employer), the subject (or his employer), or both. The most straightforward case would be one in which the tattoo or makeup artist is a sole proprietor who uses a human "canvas" to create a work of her own choosing. In such a case, the body artist would be analogous to a portrait painter or photographer. Like the portrait painter or photographer, the body artist would own the copyright to her work, even if (1) that work includes the image of another person,²⁸ and (2) another person owns the physical object (a canvas or processed negative, for example) in which the work is embodied.²⁹ In the body art example, of course, the work is (literally) embodied in another person's body.

²⁴ *Carell v. Shubert Org.*, 104 F. Supp. 2d 236, 247 (S.D.N.Y. 2000).

²⁵ 17 U.S.C. §§ 106, 106A (1996); *see also infra* Part III, subsections A-D.

²⁶ 17 U.S.C. § 201(a) (1996).

²⁷ *Id.* § 201(d).

²⁸ *See, e.g.*, 1 NIMMER & NIMMER, *supra* note 5, § 2.08[E][1], at 2-128 (citing *Landau v. Cosmetic & Reconstructive Surg. Ctr.*, 158 F.R.D. 117, 119 (N.D. Ill. 1994)).

²⁹ *See* 17 U.S.C. § 202 (1996).

A second possibility is that the work is a joint work, meaning that it is prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.³⁰ For this result to occur, both the subject and the artist would have to contribute independently copyrightable expression.³¹ For example, the artist might consult the subject for specific, concrete ideas on what to include within the tattoo. This issue arose in the *Cats* case, in which the court determined that a majority of the makeup designs were not, in fact, joint works.³²

A third possibility is that the work is a work made for hire, in which case ownership initially vests in the employer or commissioning party, and not the artist.³³ A work of body art could be a work for hire for several reasons. First, the business that employs the tattoo or makeup artist might claim that the artist's work product is a work for hire, because the product is made within the scope of her employment.³⁴ In determining whether a work is the work of an "employee," courts consider whether the commissioning party had the right and ability to control the manner and means by which the product is made, in light of a variety of factors including

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

³⁰ See *id.* § 101 (defining "joint work").

³¹ See *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231-36 (9th Cir. 2000); *Thomson v. Larsen*, 147 F.3d 195, 200-05 (2d Cir. 1998) (citing *Childress v. Taylor*, 945 F.2d 500, 508-09 (2d Cir. 1991)); *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1067-73 (7th Cir. 1994).

³² *Carell v. Shubert Org.*, 104 F. Supp. 2d 236, 250-51 (S.D.N.Y. 2000). (observing that although there was some ambiguity as to the plaintiff make-up artist's precise ownership claims, "plaintiff has specifically identified the twenty-eight makeup [d]esigns . . . for which she has a valid copyright registration and has alleged sole ownership to some, if not all, of the [d]esigns.").

³³ 17 U.S.C. § 201(b) (1996).

³⁴ See *id.* § 101 (defining a "work made for hire").

employee benefits; and the tax treatment of the hired party.³⁵

The specific facts of the employment relationship therefore would be important, although some of these factors typically would weigh in favor of the body artist being deemed an independent contractor (such as the degree of skill involved). Second, if the subject contributed copyrightable expression such that the work is considered a joint work, and if his contribution occurred within the scope of *his* employment, then it is conceivable that *his* employer might claim to be a joint author with the body artist (or her employer). An example might be that of a clown, employed by a circus, who contributes copyrightable expression to a makeup design which an independent-contractor makeup artist applies to him. If, however, the clown creates and applies his own makeup, or the makeup artist and the clown are both employed by the same entity, this rather convoluted ownership scenario would not arise.

A third possibility is that the subject (or his employer) may claim an exclusive copyright, on the theory that the subject (or his employer) employed the artist to create this work, and thus, the body art is a work for hire prepared by the artist within the scope of her employment. As above, the specific facts will be decisive, but there are reasons to believe that in the typical case the body artist would be viewed as an independent contractor *vis-à-vis* the subject. Among the decisive factors would be the level of skill involved, the ownership of the artist's tools, whether the subject has a right to assign the artist to other projects, and how the parties have structured their relationship for tax and employment law purposes.³⁶

A fourth possibility is that the work may be deemed a work for hire if it is specially ordered or commissioned for use as a contribution to a collective work.³⁷ A collective work is defined as a "work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole."³⁸ An example might be an additional tattoo placed on the body of the World's Most

³⁵ *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 751-52 (1989).

³⁶ *See id.*; *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 86 (2d Cir. 1995).

³⁷ *See* 17 U.S.C. § 101 (1996) (defining a "work made for hire").

³⁸ *Id.* (defining a "collective work").

Tattooed Woman.³⁹ Although the example is a bit whimsical, arguably the tattooed woman's body is her "canvas," a collection of separately copyrightable designs, to which she is commissioning an addition. If so, then the tattooed woman may be considered the author of the new tattoo (but only if there is an agreement to this effect in writing).⁴⁰

Of course, even if the work is not a work for hire, the employer or commissioning party may demand that the artist assign the copyright to the employer or commissioning party as a condition of doing business.⁴¹ A work's initial status as a work made for hire (or not) nevertheless has several consequences, even if the author subsequently assigns the copyright to someone else. One is that the term of copyright for a work made for hire is 95 years from the date of first publication, or 120 years from the date of creation, whichever is shorter.⁴² The term for a non-work for hire consists of the life of the author plus seventy years.⁴³ In addition, the author may terminate a transfer of copyright after 35 years, but this rule does not apply in the case of works made for hire.⁴⁴ Third, a work for hire is not a "work of visual art" for purposes of the Visual Artists Rights Act, and therefore is not entitled to moral rights protection.⁴⁵

³⁹ See *supra* note 2.

⁴⁰ See 17 U.S.C. § 101 (defining a "work made for hire").

⁴¹ See 17 U.S.C. § 201(d) (1996).

⁴² 17 U.S.C. § 302(c) (2002). "Publication" under the Copyright Act means "the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending." *Id.* § 101 (defining "publication"). Offering to distribute copies to a group of persons for purposes of further distribution, public performance, or public display constitutes publication; the public performance or display of work by itself, however, does not. See *id.* Under this definition, the artist's distribution of a single copy of a work to one person (the subject) probably would not constitute a publication. A few cases, however, have held that under the 1909 Copyright Act the public display of a work without any restriction on the ability of others to copy it can constitute a publication. See *Letter Edged in Black Press, Inc. v. Public Bldg. Comm'n of Chicago*, 320 F. Supp. 1303, 1311 (N.D. Ill. 1970); 1 NIMMER & NIMMER, *supra* note 5, § 4.09 (disapproving of this line of cases).

⁴³ See 17 U.S.C. § 302(a) (1996).

⁴⁴ *Id.* § 203(a).

⁴⁵ See *id.* § 101 (defining a "work of visual art"); see also *infra* Part II, subsection C (discussing moral rights).

B. *Unauthorized Reproductions of Copyrighted Body Art*

As a general rule, a person who reproduces a substantial portion of a copyrighted work without the permission of the copyright owner is *prima facie* an infringer,⁴⁶ and therefore must prove some affirmative defense such as fair use in order to escape liability. This would suggest that the unauthorized reproduction of a copyrighted work of body art—whether into another work of body art, an advertisement, a painting, or any other medium—is *prima facie* an infringing act. The question nevertheless arises whether this result necessarily obtains when a person *incidentally* reproduces a work of body art, such as a tattoo or makeup design, by merely photographing or filming the subject. If so, in our Eminem hypothetical, it would appear that the paparazzi, and even the crazed fans who photographed the bare-chested Eminem, are *prima facie* infringers. Indeed, we need not venture into the realm of the hypothetical to pose the question; many celebrities sport well-known and oft-photographed body art. Does the owner of the copyright to these designs have a viable claim for unauthorized reproduction, when someone merely takes a snapshot of the tattooed Angelina Jolie or Shaquille O’Neal in a public place?

At least one recent case suggests that the copyright owner may have a claim with respect to some incidental reproductions. In *Davis v. The Gap, Inc.*,⁴⁷ an eyewear designer filed suit against The Gap, a major international retailer of clothing and accessories, when one of the designer’s copyrighted eyeglass designs appeared on a model in a Gap photographic advertisement.⁴⁸ The court rejected The Gap’s arguments that the reproduction was *de minimis* or protected by the fair use defense.⁴⁹ Because the designer had not timely registered his copyright, however, he was not entitled to statutory damages—although the court concluded that he might be entitled to at least \$50 in actual damages, based on evidence that he had previously accepted a \$50 royalty fee for another use of the design.⁵⁰ In our Eminem

⁴⁶ See *id.* § 106(1).

⁴⁷ 246 F.3d 152 (2d Cir. 2001).

⁴⁸ See *id.* at 157.

⁴⁹ See *id.* at 172-76.

⁵⁰ See *id.* at 161.

hypothetical, the reproduction of Eminem's tattoo in a commercial advertisement, without the permission of the tattoo's author, might have similar consequences—although, as in *Davis*, the author might be limited to recovering actual damages unless the design was timely registered.

Many other incidental reproductions probably would escape liability, however, for a variety of reasons. The incidental reproduction of Eminem's tattoo during a television broadcast, for example, might be *de minimis* (and therefore not actionable) if the tattoo was visible for only a very short period of time or was difficult for viewers to perceive.⁵¹ Alternatively, the reproduction of the tattoo during a television show on which Eminem appears, or in a magazine or newspaper story about him, may be protected by the fair use doctrine.⁵²

⁵¹ See *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 217-18 (2d Cir. 1998). But see *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70, 75-77 (2d Cir. 1997).

⁵² For example, in *Italian Book Corp. v. American Broadcasting Cos.*, 458 F. Supp. 65 (S.D.N.Y. 1978), an ABC television film crew covering the annual San Gennaro Festival in New York's Little Italy filmed a parade during which a band performed the copyrighted song *Dove sta Zaza*. *Id.* at 66-67. ABC broadcast a portion of the film, including the audiotape of the song, during its local evening news show, and the copyright owner filed suit. *Id.* The court held that this incidental use of the song was a fair use. *Id.* at 68-71. The law is not as straightforward as one might expect, however. See *Byrne v. British Broad. Corp.*, 132 F. Supp. 2d 229, 233-36 (S.D.N.Y. 2001) (denying defendant's motion for summary judgment on fair use, in a case involving the unauthorized use of a musical composition during a news story on gun smuggling to Northern Ireland); *Coleman v. ESPN, Inc.*, 764 F. Supp. 290, 294-95 (S.D.N.Y. 1991) (denying plaintiff's motion for summary judgment on defendant's fair use defense, in a case involving the unauthorized broadcast of background music performed during sporting events); *Schumann v. Albuquerque Corp.*, 664 F. Supp. 473, 477 (D.N.M. 1987) (granting plaintiff's motion for partial summary judgment, in a case involving the unauthorized broadcast of musical compositions performed at a public festival); see also 4 NIMMER & NIMMER, *supra* note 5, § 13.05[D][3], at 13-222 to -223. Perhaps the ambient noise cases can be distinguished from our hypothetical tattoo case, on the ground that it is easy to exclude such noise from a non-live broadcast, but relatively difficult to discover and "mask" background body art; or, to put it another way, that the transaction costs of negotiating for permission in the latter case will typically be prohibitive. This observation may or may not be true, however, depending on the facts of a specific case. Another point that might be relevant is that many body artists may prefer that

And it seems unlikely that the author would have much success in asserting claims against the fans who photographed Eminem (and by necessity his tattoo), either. Technically, there may be a cause of action even if a copy is made for personal use,⁵³ and innocent infringement is not a defense to a claim of copyright infringement.⁵⁴ Nevertheless, the cost of enforcing a copyright against the casual fan photographer would probably be prohibitive, except perhaps in cases in which the photograph is presented to a wide audience (such as on an Internet website) or the copyright owner wants to set an *in terrorem* example. And even if the author were to sue, the fan photographer would often have a strong fair use defense because the transaction cost of negotiating for permission in advance of taking the photograph almost certainly would have exceeded the value of the use.⁵⁵ Presumably these reasons explain why there appear to be few attempts to prevent the incidental, noncommercial reproduction of other copyrighted works that people typically wear on their bodies, such as

television reporters *not* mask their works, although it is not clear exactly where this factor fits, if at all, in the conventional fair use analysis.

⁵³ Some commentators have argued, however, that at least until recently some copying of another's work for personal use only (e.g., hand-copying) has not been viewed as an act of infringement. See Roger D. Blair & Thomas F. Cotter, *An Economic Analysis of Seller and User Liability in Intellectual Property Law*, 68 U. CINCINNATI L. REV. 1, 10 n.38 (1999) (citing sources).

⁵⁴ As one court has noted, "copying from a third source wrongfully copied from the plaintiff, without knowledge that the third source was infringing, does not absolve a defendant of liability for copyright infringement." *Lipton v. Nature Co.*, 71 F.3d 464, 471 (2d Cir. 1995) (citing *D.C. Comics, Inc., v. Mini-Gift Shop*, 912 F.2d 29, 35 (2d Cir. 1990)).

⁵⁵ High transaction costs are a typical reason for invoking the fair use doctrine as an excuse for requesting a license. See Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and Its Predecessors*, 82 COLUM. L. REV. 1600, 1614-15 (1982)); William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 357-58 (1989); cf. Wendy J. Gordon, *Excuse and Justification in the Law of Fair Use: Commodification and Market Perspectives*, in *THE COMMODIFICATION OF INFORMATION* 149, 154-57 (Niva Elkin-Koren & Neil Weinstock Netanel eds., 2002) (arguing that high transaction costs are not the *only* reason for invoking the fair use doctrine). Fair use nevertheless might not protect the photographer from some commercial uses of the photograph, such as its use in an advertisement, as noted above.

fabric designs and jewelry designs. Indeed, something would be terribly amiss with copyright law if courts frequently *did* penalize this sort of incidental reproduction.

C. *Unauthorized Adaptations and Violations of Moral Rights*

A second possible cause of action might be for the infringement of the body artist's exclusive right to prepare derivative works (sometimes called the adaptation right),⁵⁶ or for violation of her moral rights.⁵⁷ A few cases have held that substantial modification of a copyrighted work, without permission of the copyright owner, is a violation of the adaptation right.⁵⁸ Suppose, then, that Eminem were to alter the color scheme of his hypothetical Britney tattoo, or to remove the snake configuration—or that the producer of a new version of *Cats* told his makeup artist to create some new “devilish cat” characters, by drawing red bloody streaks on a few of the copyrighted makeup designs. In either case, the owner of the copyright in the original design might have a claim for the unauthorized adaptation of her work, assuming that the court deems the modification to be substantial. We discuss possible remedies for such a violation below.⁵⁹

A related cause of action would be for violation of the artist's moral rights, although for the reasons that follow we think that this cause of action is much less likely to succeed. Under a portion of the Copyright Act known as the Visual Artists Rights Act (VARA), certain “works of visual art” may qualify for protection against distortion and other wrongs, even if the artist no longer owns the exclusive right to prepare derivative works.⁶⁰ In relevant part, section 101 of the Copyright Act defines a “work of visual art” to include

a painting, drawing, print, or sculpture, existing in a single copy [or] in a limited edition of 200 copies or fewer that are signed and consecutively

⁵⁶ See 17 U.S.C. § 106(2) (1996).

⁵⁷ See *id.* § 106A.

⁵⁸ See *Gilliam v. Am. Broad. Cos.*, 538 F.2d 14, 24 (2d Cir. 1976); 3 NIMMER & NIMMER, *supra* note 5, § 8D.04[A][1], at 8D-51 to -54 (discussing other cases).

⁵⁹ See *infra* Part II, subsection E.

⁶⁰ Pub. L. No. 101-650, §§ 601-10, 104 Stat. 5089, 5128-33 (1990) (codified in 17 U.S.C. §§ 101, 106A, 107, 113, 301, 411, 412, 501, 506).

numbered by the author.⁶¹

At first blush (no pun intended), this definition would appear to cover makeup designs and tattoos, which are after all just a type of painting or drawing; and each tattoo or makeup design may exist in only a "single copy."⁶² Section 101, however, goes on to exclude from the definition of a "work of visual art" several types of items, including "any poster, map, globe, chart, technical drawing, diagram, model, applied art," or any work made for hire.⁶³ The Act does not define any of these terms other than works made for hire, although under the common meanings of the terms,⁶⁴ a tattoo or makeup design would not appear to qualify as a poster, diagram, or model (although it might be applied on a model!). Moreover, according to the Second Circuit the term "'applied art' describes 'two- and three-dimensional ornamentation or decoration that is affixed to otherwise utilitarian objects.'"⁶⁵ Assuming that the human body is not merely a "utilitarian object," this limitation as well should pose no problem to the assertion of moral rights in body art. The work for hire doctrine, however, might pose a more serious obstacle to the assertion of moral rights, depending on the facts of the employment relationship.⁶⁶

Assuming that a particular tattoo or design qualifies as a work of

⁶¹ 17 U.S.C. § 101 (1996) (defining a "work of visual art").

⁶² The "single copy" matter may not be entirely free from doubt, however. An artist may attempt to apply the same tattoo or make-up design on different people, or even the same person. Very likely, however, there will be some (perhaps minute) differences, even if inadvertent, between the two executions of the same work. Moreover, the definition of "work of visual art" appears to distinguish a work existing in a single copy from a work existing in multiple copies on the basis of copies of the latter work being derived from a common mechanical process (such as the multiple casting of a sculptural work or the manufacture of several photographs from the same negative). *See id.* § 101 (defining a work of visual art). Because the second and further applications of a tattoo or makeup design are not mechanical, each application may count as a separate work of art.

⁶³ *Id.*

⁶⁴ *See* H.R. REP. NO. 101-514, at 11 (1990) ("The courts should use common sense and generally accepted standards of the artistic community in determining whether a particular work falls within the scope of the definition.").

⁶⁵ *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 84-85 (2d Cir. 1995) (quoting *Carter v. Helmsley-Spear, Inc.*, 861 F. Supp. 303, 315 (S.D.N.Y. 1994)).

⁶⁶ *See supra* Part II, subsection A.

visual art, VARA confers upon the author a variety of moral rights, including rights to attribution and integrity. First, the author has a right to claim authorship of the work and to prevent the use of her name as the author of a work which she did not create.⁶⁷ Second, the author has a right to prevent the use of her name as the author of a work that has been distorted, mutilated, or otherwise modified in a manner that would be prejudicial to her honor or reputation.⁶⁸ Third, the author has a right

to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and . . . to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right.⁶⁹

These rights are subject to a variety of exceptions,⁷⁰ one of which we discuss below,⁷¹ and may be waived in a writing signed by the author.⁷² For works created on or after the effective date of the Act (June 1, 1991), the term of protection consists of the life of the author.⁷³

The assertion of any or all of these rights with respect to a work of body art nevertheless would be problematic. As for the attribution right, it is not clear exactly how an artist would enforce this right, other than by etching her name on the subject. To our knowledge, this is not a common practice among tattoo artists and, while it is conceivable that someday people might become accustomed to wearing signed tattoos, for the present this outcome seems unlikely. With respect to the integrity right, as noted above, the artist has a claim against (1) intentional modifications that prejudice her honor or reputation,⁷⁴ and (2) intentional or grossly negligent destruction of works of

⁶⁷ 17 U.S.C. § 106A(a)(1) (1996).

⁶⁸ *Id.* § 106A(a)(2).

⁶⁹ *Id.* § 106A(a)(3).

⁷⁰ *Id.* § 106A(c).

⁷¹ *See infra* note 82.

⁷² 17 U.S.C. § 106A(e)(1) (1996).

⁷³ *Id.* § 106A(d)(1).

⁷⁴ *Id.* § 106A(a)(3)(A).

recognized stature.⁷⁵ In determining whether a particular modification prejudices the artist's honor or reputation, courts have relied upon expert testimony to determine whether the artist has a significant reputation within the artistic community.⁷⁶ Courts similarly rely upon experts and other objective evidence (such as references to the work in publications) to decide whether the work has stature.⁷⁷ Relatively few cases have been litigated under VARA thus far, and there remains a considerable degree of uncertainty regarding just how well-known the artist or the work must be to qualify for protection. The average tattoo or makeup artist therefore may encounter difficulties in establishing that her reputation or the reputation of her work is sufficiently strong to sustain an assertion of the integrity right. Indeed, since makeup designs are typically applied with the understanding that they will be removed (i.e., destroyed) within a relatively short period of time, it is difficult to imagine how any makeup design could possibly have sufficient stature to merit protection against its intentional "destruction."

Tattoos, however, are usually permanent,⁷⁸ unless the subject undergoes surgical removal, and thus, it is at least conceivable that the modification or removal of a tattoo could implicate the tattoo artist's moral rights. In particular, if a tattoo qualifies as a work of recognized stature, its surgical removal would appear to be an intentional destruction in violation of those rights.⁷⁹ We nevertheless would

⁷⁵ *Id.* § 106A(a)(3)(B).

⁷⁶ See *Carter v. Helmsley-Spear, Inc.*, 861 F. Supp. 303, 324-25 (S.D.N.Y. 1994), *aff'd in part, rev'd in part on other grounds*, 71 F.3d 77 (2d Cir. 1995); *English v. BFC & R E. 11th St. LLC*, No. 97 Civ. 7446 (HB), 1997 WL 746444, at *6 (S.D.N.Y. Dec. 3, 1997).

⁷⁷ See *Martin v. City of Indianapolis*, 192 F.3d 608, 612 (7th Cir. 1999); *Pollara v. Seymour*, 150 F. Supp. 2d 393, 397-98 (2001); *Carter*, 861 F. Supp. at 324-26. Although it is clear that excluding works that lack stature from the scope of the Act precludes an action for, say, the destruction of a five-year-old child's drawing, *see* 3 NIMMER & NIMMER, *supra* note 5, § 8D.06[C][1], at 8D-76 n.109 (citations omitted), it is not entirely clear just how much stature a work must have to merit protection under VARA. See Christopher J. Robinson, Note, *The "Recognized Stature" Standard in the Visual Artists Rights Act*, 68 *FORDHAM L. REV.* 1935, 1968-70 (2000).

⁷⁸ Except, of course, for so-called temporary tattoos.

⁷⁹ See *supra* notes 75-77 and accompanying text.

anticipate considerable resistance to the conclusion that the removal of a tattoo is a violation of the Copyright Act—as well as, perhaps, some bias against the characterization of *any* tattoos as works of recognized stature. Notwithstanding Holmes's dictum,⁸⁰ federal judges do not get to be federal judges by adhering to the motto *épater les bourgeois*. It is perhaps somewhat more conceivable that courts would be willing to entertain claims involving intentional modifications of tattoos. Suppose, for example, that in our hypothetical Eminem were to modify his tattoo of Britney by replacing the python with a crucifix. The altered tattoo is arguably sacrilegious, and the tattoo artist may demand redress (as well as the prevention of the use of her name as the author of the modified work).⁸¹ We nevertheless think that the artist's chances of obtaining relief under section 106A(a)(3)(A) against a prejudicial modification would be slim (real slim shady?) at best, for several reasons. The first is that, unlike the typical case involving a conventional work of art such as an oil painting or a sculpture, most people will remain unaware of the tattoo artist's identity (unless industry practice changes, and tattoo artists begin signing their works)—in which case the artist's reputation probably cannot suffer very much, no matter how egregious the modification may be. Second, just as we would expect courts to conclude that few if any tattoos have sufficient stature to merit protection against destruction, we would expect that, unless and until tattooing comes to be viewed as more of a "high-art" phenomenon, most courts would conclude that few if any tattoo artists have a sufficient reputation to qualify for protection against even offensive modifications of their work. A third problem is that only intentional modifications violate VARA, and thus certain changes in the way the tattoo looks (suppose that Eminem gains a hundred pounds!) might remain unremediable, even if the other elements were satisfied.⁸² Finally, practical problems would no doubt

⁸⁰ See *supra* note 20 and accompanying text. Commentators have noted, however, that *contra* Holmes the application of moral rights laws sometimes does require judges to make judgments of artistic merit. See Thomas F. Cotter, *Pragmatism, Economics, and the Droit Moral*, 76 N.C. L. REV. 1, 15 (1997); see also Gorman, *supra* note 20, at 11-12.

⁸¹ See 17 U.S.C. § 106A(a)(2)-(3) (1996).

⁸² Perhaps intentional weight gain (think Robert DeNiro in *Raging Bull*) would be

present obstacles to the enforcement of moral rights with respect to many modified or obliterated tattoos. Unless the subject was a person with considerable media exposure (like Eminem), the artist would in most cases have a difficult time discovering what the subject has done with the tattoo after the point of sale, much less establishing a case that would be worth the expense of bringing to trial.

One final obstacle to the assertion of either adaptation rights or moral rights is that some modifications might be privileged under the fair use doctrine.⁸³ Although we do not wish to go into a detailed fair use analysis here—different hypothetical cases could spawn very different analyses—we note only that two important factors are the purpose and character of the use, and the effect of the use upon the market for the copyrighted work.⁸⁴ As for the purpose and character of the use, one question is whether and to what extent the defendant's use is "transformative," meaning that it alters the original work with new expression.⁸⁵ In our hypothetical in which Eminem alters his Britney tattoo, Eminem might argue that the modified work is transformative, adding "something new, with further purpose or different character."⁸⁶ He may even claim that the modified work is a parody, and thus like other criticism and commentary entitled to the fair use privilege.⁸⁷ For purposes of copyright law, parody is defined as "the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works."⁸⁸ As for the effect of the use upon the market for the original work, Eminem may argue that "there is little or no risk of market substitution . . . because of the large extent of transformation of the earlier work."⁸⁹

actionable. But even then the subject could argue, with some force, that it is inherent in the "materials" for tattoos to lose their shape and configuration over time. See 17 U.S.C. § 106A(c)(1) (stating that modifications due to "the passage of time or the inherent nature of the materials" do not implicate the author's moral rights).

⁸³ See *id.* § 107.

⁸⁴ See *id.*

⁸⁵ See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

⁸⁶ *Id.*

⁸⁷ See *id.*

⁸⁸ *Id.* at 569-70.

⁸⁹ *Id.* at 580 n.14; see also *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1275-76 (11th Cir. 2001). In this case, the defendant publisher appealed from

One problem with the assertion of fair use on these facts, however, is that for a modification to be a parody, presumably it must comment upon the original *work*—in this case the original tattoo—and not merely on the subject of the original work, here Britney Spears. Would Eminem’s claim that he is parodying the original tattoo, which he paid to have permanently applied to his body, be credible? Assuming the commentary has no critical bearing on the substance or style of the original work, and the alleged infringer “merely uses [it] to get attention or to avoid the drudgery in writing up something fresh,”⁹⁰ a court is less likely to find a valid fair use defense.

D. *Body Art That Infringes*

Yet another possibility is that the body artist uses someone else’s copyrighted pictorial work to create his own work, without authorization of the copyright owner. Suppose, for example, that the tattoo artist reproduces an image taken from a copyrighted photograph of Britney as she appears in one of her Pepsi commercials, and tattoos it across Eminem’s chest. (Another example would be a tattoo of a copyrighted fictional character from television or the comics pages.)⁹¹ On these facts, the tattoo artist is violating the copyright owner’s exclusive right of reproduction—and so, perhaps, are others who photograph the tattoo, as discussed above.⁹² Alternatively, suppose that the tattoo artist alters the image of Britney Spears so that Justin Timberlake and Marilyn Manson are licking either side of her face. Here, the tattoo artist also is arguably violating the copyright owner’s adaptation right.⁹³

The subject also might be liable for a variety of copyright

an order that granted a preliminary injunction in favor of plaintiff trustee, enjoining publication of a work of fiction, *The Wind Done Gone*, that was admittedly based on *Gone with the Wind*. *Id.* The appellate court found that the book at issue was clearly a parody and that there was little risk of market substitution, as the works were unlikely to be confused. *Id.*

⁹⁰ *Campbell*, 510 U.S. at 580.

⁹¹ *See supra* note 2.

⁹² *See supra* Part II, subsection B.

⁹³ *See* 17 U.S.C. § 106(2) (1996).

violations, even though he is not reproducing the infringing image himself. First, the subject would be violating the copyright owner's exclusive right to display the work to the public, if the subject shows the tattoo in a public place.⁹⁴ Second, he might be liable as well for contributory or vicarious infringement, depending on the facts. A person is liable for contributory infringement if he knowingly causes another person to infringe—for example, if he was in a position to control the use of copyrighted works by others and authorized the use without permission of the copyright owner.⁹⁵ Alternatively, vicarious liability can arise if the defendant has the right and ability to supervise the infringing activity and a direct financial interest in those activities.⁹⁶ In our hypothetical, Eminem probably supervised the application of the image onto his body, thus satisfying the first part of the test. Whether he receives a direct financial interest from the infringement is less clear. Perhaps the tattoo will induce more fans to buy Eminem's CDs or see his movies, or the tattoo might be part of a promotional stunt for his "Celebrity Bash" tour. Proving the relevant nexus, however, may prove difficult even in this case,⁹⁷ and in the more typical case in which a non-celebrity sports an infringing tattoo, it may be virtually impossible to prove any direct financial interest.

E. Remedies

A final set of issues involves the appropriate remedies for the infringement of copyrights or moral rights in body art. The Copyright Act specifies that a court may award the aggrieved copyright owner actual damages and any additional profits of the infringer,⁹⁸ or in the alternative, statutory damages.⁹⁹ Actual damages could include either

⁹⁴ See *id.* §§ 101 (defining "display" and "publicly"), 106(5).

⁹⁵ See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 435 (1984).

⁹⁶ See *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259, 262 (9th Cir. 1996).

⁹⁷ See *infra* note 102 and accompanying text (noting that the same problem will arise in connection with the calculation of restitutionary damages).

⁹⁸ 17 U.S.C. § 504(b) (1996).

⁹⁹ *Id.* § 504(c). Copyright liability is joint and several, meaning that if both the artist and the subject are liable for the same offense the plaintiff could sue one or the other or both, and collect from either liable party. See, e.g., *Fitzgerald Publ'g Co. v. Baylor Publ'g Co.*, 807 F.2d 1110, 1116 (2d Cir. 1986).

lost profits or lost royalties.¹⁰⁰ In the typical case involving body art, however, it might be difficult for the plaintiff (either an artist whose work has been incorporated without her permission into a work of body art, or a body artist whose work has been reproduced or adapted without her permission) to prove substantial lost profits or (unless she charges very large fees) substantial lost royalties attributable to the infringement.¹⁰¹ Alternatively, to recover an award of the defendant's profits, the plaintiff must prove some reasonable nexus between those profits and the act of infringement.¹⁰² In our Eminem hypothetical above, it would probably be quite difficult to establish with sufficient certainty the amount of Eminem's profits that would be attributable merely to the infringing tattoo. Statutory damages are, therefore, often more desirable from the standpoint of the copyright owner. In the normal case, these damages may range from \$750 to \$30,000 for each work infringed,¹⁰³ but they are available only if the owner registered her copyright before the infringement or within three months of the work's first publication.¹⁰⁴ As for injunctive relief, presumably a court could enjoin a body artist who has infringed another's work from doing so again in the future. Courts also may order the destruction of infringing works.¹⁰⁵

An award of injunctive relief or an order of destruction directed against the *subject*, however, might be more problematic.¹⁰⁶ In light of

¹⁰⁰ See *Davis v. The Gap, Inc.*, 246 F.3d 152, 161-72 (2d Cir. 2001).

¹⁰¹ Some courts might award, as a component of actual damages, damages for collateral losses such as loss of reputation, but the nexus between the act of infringement and the alleged loss must not be too speculative. See *Abeshouse v. Ultragraphics, Inc.*, 754 F.2d 467, 471 (2d Cir. 1985).

¹⁰² See *Mackie v. Rieser*, 296 F.3d 909, 914-16 (9th Cir. 2002); *Davis*, 246 F.3d at 159-61.

¹⁰³ 17 U.S.C. § 504(c) (1996). In cases of willful infringement, the court may enhance statutory damages up to the amount of \$150,000 for each work infringed. For innocent infringement, it may reduce them to \$200 for each work infringed. *Id.*

¹⁰⁴ *Id.* § 412.

¹⁰⁵ *Id.* § 503(b).

¹⁰⁶ A court might enjoin the subject not to use a tattoo in a commercial way, as in our Eminem hypothetical, and that may be as much relief as the owner will seek in a normal case. Would you want to be the plaintiff asking a court to order a person to undergo surgical removal of a tattoo? Nevertheless, we consider the prospects of

our preceding discussion, there are several ways in which the subject could be infringing: by modifying a work of body art in violation of the author's adaptation rights (or, possibly, her moral rights); by publicly displaying an infringing tattoo or makeup design; or, possibly, by destroying a tattoo in violation of the author's moral rights (although this seems unlikely, for reasons stated above).¹⁰⁷ Could a court enjoin the subject from modifying a tattoo that is, unless removed, permanently attached to his body? Could a court enjoin the removal of the tattoo, if removal would result in the destruction of a work of recognized stature? Alternatively, could a court *order* the removal of an infringing tattoo—or at least order the subject not to display the work publicly? We think that such results are unlikely, for two interrelated reasons. The first is that the Supreme Court has noted in two recent copyright cases that injunctive relief is discretionary,¹⁰⁸ although it has provided little guidance as to when courts should exercise their discretion *not* to award injunctive relief. The second reason is that there are some potential constitutional arguments against injunctions of the type described above. While these arguments at present remain sketchy,¹⁰⁹ a court that wishes to avoid the constitutional issues may

more intrusive injunctive relief in the text above to demonstrate that, even if practical considerations did not deter the plaintiff from requesting this relief, there are sufficient legal reasons for a court to be reluctant to enter such an order.

¹⁰⁷ See *supra* Part II, subsection C.

¹⁰⁸ See *New York Times Co. v. Tasini*, 533 U.S. 483, 505 (2001); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n.10 (1994).

¹⁰⁹ In a few cases, courts have considered whether schools can prohibit students from wearing tattoos, or whether the state may require a person who has been convicted of a crime to remove a gang tattoo as a condition of probation. See *Stephenson v. Davenport Cmty. Sch. Dist.*, 110 F.3d 1303 (8th Cir. 1997) (holding that a school policy against tattoos was void for vagueness); *In re Jessica B.*, 2002 WL 125763, at *6 (Cal. App. Jan. 31, 2002) (unpublished opinion) (agreeing with an earlier California case, *In re Antonio C.*, 83 Cal. App. 4th 1029 (2000), that conditioning probation on the minor's not obtaining any new tattoos was a permissible restriction on speech, but that ordering the removal of existing tattoos was not justified); *A.G. v. State*, 726 So. 2d 834, 834 (Fla. App. 1999) (per curiam) (upholding condition that minor remove tattoo); *In re M.P.*, 697 N.E.2d 1153, 1157-60 (Ill. App. 1998) (holding that conditioning probation on tattoo removal was unreasonable, in light of, *inter alia*, the potential pain and humiliation and the fact that it would be "directly intrusive to the human body").

decide to exercise its discretion against an award of injunctive relief.

The first reason to question the wisdom of such an injunction relates to the subject's First Amendment right of free expression. To be sure, courts generally have rejected First Amendment challenges to copyright liability,¹¹⁰ and thus any argument on the part of the subject that there is a constitutional right to publicly convey a particular message by sporting an infringing tattoo or other body art seems weak. Nevertheless, some commentators and a few courts have argued in favor of some enhanced First Amendment scrutiny in copyright cases.¹¹¹ In one recent case, for example, a court applied intermediate scrutiny to determine whether a provision of the Digital Millennium Copyright Act that imposes some incidental restrictions on speech was consistent with the First Amendment.¹¹² Perhaps in some instances the need to use a particular copyrighted text or image to make one's point would trump the owner's copyright rights—or at least would bolster the argument that an injunction, as opposed to damages, sweeps too far.¹¹³

A second possible ground for a constitutional challenge would be that an injunction ordering the subject to remove a tattoo, or not to remove or alter a tattoo, or barring the subject from displaying his tattooed body in public would violate some constitutional norm of privacy or liberty—some general right to be left alone.¹¹⁴ One problem,

¹¹⁰ See *Eldred v. Ashcroft*, 537 U.S. 186, 217-22 (2003); Thomas F. Cotter, *Gutenberg's Legacy: Copyright, Censorship, and Religious Pluralism*, 91 CAL. L. REV. 323, 328 (2003).

¹¹¹ See Cotter, *supra* note 110, at 328-30 (citing sources).

¹¹² See *United States v. Elcom Ltd.*, 203 F. Supp. 2d 1111, 1129 (N.D. Cal. 2002); *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257 (11th Cir. 2001) (holding that the fair use doctrine probably shielded the publication of a novel based upon the characters and plot of *Gone with the Wind*).

¹¹³ One hypothetical that comes to mind involves the facts of *Cohen v. California*, 403 U.S. 15, 18 (1971), in which the Supreme Court held that the First Amendment precluded the state from punishing the defendant for publicly wearing a tee shirt proclaiming "Fuck the Draft." Short phrases such as the aforementioned comment on the draft, however, are not subject to copyright protection. See 37 C.F.R. § 202.1(a) (2003). For the analogy to hold, then, one would have to come up with a longer, copyrightable phrase that nevertheless expresses its underlying message in a comparatively forceful and memorable way.

¹¹⁴ See *Winston v. Lee*, 470 U.S. 753, 758-59 (1985) (citing *Olmstead v. United*

however, is that arguments grounded in the constitutional right of privacy are usually not successful, except in the limited context of government regulation of such things as marriage and procreation—though perhaps the Supreme Court’s recent decision in *Lawrence v. Texas* heralds a change.¹¹⁵ Courts have rejected arguments, for example, that government prohibitions on public nudity violate the constitutional right of privacy or a more general right of liberty.¹¹⁶ Even so, in an appropriate case it might be worthwhile to explore the limits of the government’s power to force someone to remove or cover up an offending tattoo. Just because the government has the power to force someone to cover his genitals in public may not mean that the government can force a tattoo wearer to wear a long-sleeved shirt, or the World’s Most Tattooed Woman to wear a *burkha* when she appears in public. Again, even if the constitutional argument ultimately would fail, a court that wants to avoid a constitutional problem might opt for the damages-only option.

Third, the privacy argument might be buttressed by analogies to case law developed in the context of the Fourth Amendment prohibition of unreasonable searches and seizures. Arguably, the

States, 277 U.S. 438, 478 (1928)).

¹¹⁵ See *Lawrence v. Texas*, 538 U.S. 918 (2003) (holding that the constitutional right to privacy protects consensual homosexual conduct); see also *Washington v. Harper*, 494 U.S. 210, 221-23 (1990) (holding that there is a limited right to refuse psychoactive medication); *Webster v. Reprod. Health Servs.*, 492 U.S. 490 (1989) (holding that the right to privacy protects a woman’s right to an abortion, subject to some limitations); *Roe v. Wade*, 410 U.S. 113, 129 (1973). But see *Vacco v. Quill*, 521 U.S. 793 (1997) (holding that there is no constitutional right to die).

¹¹⁶ See David Kushner, *Property Interests in Nude Sunbathing*, 18 WHITTIER L. REV. 261, 264-66 (1997) (reviewing the case law). Courts similarly have rejected arguments that the right of free speech precludes the state from regulating nude dancing and entertainment, see *City of Erie v. Pap’s A.M.*, 529 U.S. 277 (2000); *Barnes v. Glen Theatre, Inc.*, 501 U.S. 560 (1991), and public nude sunbathing, see *People v. Hollman*, 68 N.Y.2d 202, 206-09 (N.Y.2d 1986); see also Richard B. Kellam & Teri Scott Lovelace, *To Bare or Not to Bare: The Constitutionality of Local Ordinances Banning Nude Sunbathing*, 20 U. RICH. L. REV. 589 (1986) (reviewing freedom of speech, freedom of association, vagueness, and overbreadth arguments as they relate to public nudity); Reena N. Glazer, Note, *Women’s Body Image and the Law*, 43 DUKE L.J. 113 (1993) (reviewing equal protection arguments).

removal of a tattoo is the type of “substantial bodily intrusion” that would violate a person’s reasonable expectation of privacy if conducted by the state in the context of a search or seizure.¹¹⁷ Although the case law does not directly control the present issues, courts might be hesitant to order the relatively intrusive removal of a tattoo, particularly if the defendant makes a compelling showing of resultant pain and discomfort. Whether an order merely to cover up an offending tattoo would be viewed as equally intrusive is unclear, though perhaps in combination with the First Amendment and privacy arguments there would be sufficient reasons for a court to decide against injunctive relief.

III. TRADEMARK ISSUES

A second set of issues revolves around the use of trademarked symbols in body art: for example, tattoos comprising trademarked words or name (e.g., COCA-COLA, BRITNEY SPEARS¹¹⁸), logos, pictures, or fictional characters. As a general matter, trademark law only prohibits certain *commercial* uses of another’s mark, that is, uses in connection with the sale of goods or services.¹¹⁹ On this logic, merely wearing a counterfeit ROLEX watch is not an act of infringement (or dilution),¹²⁰ although selling the watch would

¹¹⁷ See *Winston*, 470 U.S. at 758-59 (holding that the state must demonstrate more than probable cause to justify the extraction of a bullet from a suspect’s body).

¹¹⁸ Britney has federal registrations or pending registrations for the mark BRITNEY SPEARS for a variety of products, including jewelry and clothing. See Fed. Reg. No. 2491505 (for the mark BRITNEY SPEARS on paper goods and printed matter and on clothing, registered September 18, 2001); Fed. Reg. No. 2302300 (for the mark BRITNEY SPEARS for electrical and scientific apparatuses and for educational and entertainment services, registered Dec. 21, 1999); Fed. Serial No. 76235147 (for the mark BRITNEY SPEARS for jewelry and other items, registered Sept. 17, 2002); Fed. Serial No. 75656349 (pending registration for other paper goods and printed matter and for clothing).

¹¹⁹ See Blair & Cotter, *supra* note 53, at 14-15.

¹²⁰ Infringement is the unauthorized use of a trademark that is likely to cause confusion as to source, sponsorship, or affiliation. See 15 U.S.C. §§ 1114(1), 1125(a)(1)(A); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20 (1995). Dilution occurs when another’s use of a famous, highly distinctive mark causes the mark to lose its source significance—for example, the use of the word “Kodak” on

infringe.¹²¹ The same reasoning therefore would suggest that merely wearing a piece of body art that incorporates another's trademark does not infringe. This reasoning leaves open the possibility, however, that the body artist, like the counterfeiter, could be liable for infringement, assuming (as is likely) that the subject pays the artist for her services. Is it an act of trademark infringement to tattoo a trademarked symbol onto another person's body for money?

One line of cases, involving the unauthorized use of trademarked symbols on jewelry and other merchandise, suggests that the body artist as well probably would escape trademark liability. In *International Order of Job's Daughters v. Lindeburg & Co.*,¹²² for example, the Ninth Circuit held that the defendant's unauthorized use of a fraternal organization's collective mark on jewelry did not infringe, because the name and emblem "were being merchandised on the basis of their intrinsic value, not as a designation of origin or sponsorship."¹²³ Similarly, in *Plasticolor Molded Products v. Ford*

chewing gum. See 15 U.S.C. § 1125(c); *id.* § 1127 (definition of dilution); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 (1995).

¹²¹ The seller infringes by selling the counterfeit watch, even if the buyer *knows* the watch is counterfeit (and therefore is not likely to be confused). Doctrinally, this result is possible because of the likelihood of post-sale confusion; that is, people who encounter the watch after the point of sale might think it is a genuine "Rolex." See Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 964 (1993). Conceivably, the buyer might be liable for inducing the counterfeiter to infringe, though probably not if the inducement consists only of an offer to purchase. See Blair & Cotter, *supra* note 53, at 36 n.128.

¹²² 633 F.2d 912 (9th Cir. 1980). A few other cases have reached similar results. See Supreme Assembly, Order of Rainbow for Girls v. J.H. Ray Jewelry Co., 676 F.2d 1079, 1082-86 (5th Cir. 1982) (holding that use of fraternal emblem on jewelry did not infringe); Univ. of Pittsburgh v. Champion Prods., Inc., 566 F. Supp. 711, 718-21 (W.D. Pa. 1983) (holding that unauthorized use of university's name and insignia on soft goods did not infringe); Bi-Rite Enters., Inc. v. Button Master, 555 F. Supp. 1188, 1195 (S.D.N.Y. 1983) (holding that unauthorized use of trademarks on buttons did not infringe because "buttons tend primarily to be a medium for communicating ideas or positions; they are not commodities sold to serve any other functional purpose").

¹²³ *Job's Daughters*, 633 F.2d at 918. In *Job's Daughters*, the court cited with approval an earlier Ninth Circuit decision, Pagliero v. Wallace China Co., 198 F.2d 339, 343 (9th Cir. 1952), which stated that a feature is functional, and therefore not subject to trademark protection, if it "is an important ingredient in the commercial

Motor Co.,¹²⁴ Judge Kozinski proposed a “middle ground” for analyzing so-called “mixed-use” marks, that is, marks that serve both as source-identifiers and also, in some contexts, as “functional” products themselves.¹²⁵ First, Judge Kozinski proposed that point-of-sale confusion can be reduced by “a clear indication at the point of sale . . . that the product is not manufactured or sponsored by the registrant.”¹²⁶ Second, he suggested that courts may have to tolerate some potential post-sale confusion, but that this confusion “can be diminished . . . by requiring that the manufacturer of a product that employs a trademark for functional purposes take all reasonable steps to eliminate post-sale confusion consistent with the functional use of the mark.”¹²⁷ In some cases, such measures may include “plac[ing] a disclaimer on a portion of the article not generally visible while the article is in use,”¹²⁸ but in other contexts (such as jewelry) no reasonable measures may be feasible.¹²⁹

success of the product.” See *Job’s Daughters*, 633 F.2d at 917. Other courts have criticized this definition, on the ground that many source identifiers may assist in the commercial success of a product, and yet not be so essential that competitors must have access to them in order to succeed. See, e.g., *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 340 (7th Cir. 1985). More recently, the United States Supreme Court has stated that a feature is functional when it “is essential to the use or purpose of the article or if it affects the cost or quality of the article,” or when its exclusive use “would put competitors at a significant non-reputation-related disadvantage.” *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32-33 (2001) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)). Nevertheless, even if the definition of functionality embraced by the court in *Job’s Daughters* is flawed, the rule that merely ornamental uses of trademarks do not infringe appears to remain good law, as the discussion in the text above suggests.

¹²⁴ 713 F. Supp. 1329 (C.D. Cal. 1989) (Kozinski, J., sitting by designation).

¹²⁵ *Id.* at 1338.

¹²⁶ *Id.* at 1339.

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ See *id.* at 1339-40. Judge Kozinski’s approach is consistent with the recommendations of some academic commentators. See Paul J. Heald, *Filling Two Gaps in the Restatement (Third) of Unfair Competition: Mixed-Use Trademarks and the Problem with Vanna*, 47 S.C. L. REV. 783, 786-800 (1996); Note, *Promotional Goods and the Functionality Doctrine: An Economic Model of Trademarks*, 63 TEX. L. REV. 639, 664-69 (1984); see also Robert C. Denicola, *Institutional Publicity*

Judge Kozinski's test for evaluating mixed-use marks overlaps with his analysis of so-called "nominative uses" of trademarks, as developed in cases such as *New Kids on the Block v. New America Publishing, Inc.*¹³⁰ Under this approach, the nominative use of another's mark—that is, the use of another's mark primarily to refer to the other's product or service, rather than to one's own product or service—does not infringe as long as (1) the plaintiff's product is not readily identifiable without the use of the mark; (2) the defendant uses only so much of the mark as is reasonably necessary to identify the plaintiff's product; and (3) the defendant's use does not suggest sponsorship or endorsement on the part of the plaintiff.¹³¹ Thus, in another recent case from the Ninth Circuit, *Cairns v. Franklin Mint Co.*,¹³² the court concluded that the unauthorized use of Princess Diana's name and image on collectors' plates was a permissible nominative use.¹³³ Specifically, the court concluded that there was no substitute for the use of Princess Diana's name and likeness of the defendant's Diana-related products; that the defendant did not appropriate any particular image of Princess Diana associated with the plaintiff, the Diana Princess of Wales Memorial Fund; and that the defendant had not suggested that the Fund endorsed its products.¹³⁴ The court's reliance on the nominative use doctrine may signal an alternative way of accommodating the user's interest in expressive use of trademarks and names, without having to rely upon the ornamental use cases (which the court did not cite) and their

Rights: An Analysis of the Merchandising of Famous Trade Symbols, 62 N.C. L. REV. 603, 639-41 (1984) (arguing that trademark owners generally should have a right to control the use of their marks on promotional goods, but not necessarily the use of those marks as mere ornaments); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 195 [hereinafter Denicola, *Trademarks as Speech*].

¹³⁰ 971 F.2d 302 (9th Cir. 1992).

¹³¹ *Id.* at 308.

¹³² 292 F.3d 1139 (9th Cir. 2002).

¹³³ *Id.* at 1155.

¹³⁴ *Id.* at 1152-55. The court stated that the endorsement issue may have been "a closer call" than the first two elements but noted, among other things, that in instances in which the defendant marketed celebrity-related products with the celebrity's endorsement, it had so stated, and the defendant had promised purchasers of its Diana-related products that it would donate proceeds from these products to Princess Diana's favorite charities. *Id.* at 1155.

expansive view of functionality.¹³⁵

Admittedly, some cases point in the opposite direction. In *Boston Professional Hockey Association v. Dallas Cap & Emblem Manufacturing, Inc.*,¹³⁶ for example, the Fifth Circuit held that the unauthorized sale of embroidered patches bearing the logo of a professional sports team infringed by causing a likelihood of confusion as to sponsorship, even though the logos were not attached to any merchandise.¹³⁷ On this view, the unauthorized use of trademarks in body art might be viewed as an act of infringement (or of dilution, if the mark is sufficiently famous), because the artist is using a mark in connection with the sale of a product or service. Other cases, however, have distinguished or limited the holding of *Boston Professional Hockey Association*. For example, in another case involving the unauthorized use of a mark on jewelry, *Supreme Assembly, Order of Rainbow for Girls v. J.H. Ray Jewelry Co.*,¹³⁸ the same court that decided *Boston Professional Hockey Association* distinguished that case on the ground that the “practice with respect to . . . fraternal jewelry is markedly different” than the practice with respect to sports emblems, in that the latter are so frequently “used to advertise teams and endorse products, that a consumer . . . would assume some sort of sponsorship or association between the product’s seller and the team.”¹³⁹

Even so, some ambiguities remain. Does the quote from *Supreme Assembly* suggest that consumers would mistakenly assume that a sports team had authorized the use its logo in a tattoo (because sports

¹³⁵ See *supra* note 123.

¹³⁶ 510 F.2d 1004 (5th Cir. 1975).

¹³⁷ *Id.* at 1013. More commonly, other courts have concluded that the sale of merchandise and other promotional goods bearing sports team or university names and logos is likely to cause confusion as to sponsorship—although it appears that in these other cases, unlike *Boston Professional Hockey Association*, the defendant sold actual merchandise to which the marks were affixed. See, e.g., *Univ. of Ga. Athletic Assoc. v. Laite*, 756 F.2d 1535, 1546-47 (11th Cir. 1985).

¹³⁸ 676 F.2d 1079, 1085 (5th Cir. 1982).

¹³⁹ *Id.* at 1085; see also *Univ. of Pittsburgh v. Champion Prods., Inc.*, 566 F. Supp. 711, 718-20 (W.D. Pa. 1983); *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1192-96 (S.D.N.Y. 1983).

teams frequently authorize the use of their logos on merchandise), or that they would not (because people generally do not assume that body artists obtain permission)? We suspect the latter, although it is conceivable that a consumer survey might show otherwise.¹⁴⁰

On the other hand, we do not doubt that some uses of a work of body art that incorporates a trademark could give rise to liability. To illustrate, suppose that a commercial for a line of athletic shoes features a celebrity athlete prominently sporting a tattoo of Bugs Bunny (or Cindy Crawford, or the words PEPSI-COLA) on his right bicep. Even if the artist who applied the tattoo is not liable under the theory sketched out above, the display of the tattoo in a commercial advertisement may well convey a false message that the trademark owner endorses the product, depending on how prominently the tattoo is displayed and other factors.¹⁴¹ Another possible example would be the display of a tattooed mark in a work of entertainment, as in our Eminem hypothetical. In this instance, the use of the KISS makeup and Britney tattoo may well be expressive of the entertainer's artistic message, but it also may be more likely than the run-of-the-mill

¹⁴⁰ See *Univ. of Pittsburgh*, 566 F. Supp. at 720 (noting the absence of "any real showing of likelihood of confusion"); *Bi-Rite*, 555 F. Supp. at 1195-96 (stating that "[i]n certain contexts, such as at concerts where the mark's owner performs, the public may . . . assume that the owner of the mark sponsored or even produced the goods—emblems, buttons or T-shirts—that bear its mark," but that the owner would have to establish confusion with a sufficient evidentiary record).

¹⁴¹ See *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407, 413 (9th Cir. 1996) (holding that the former basketball star stated a claim for false endorsement, based upon the defendant's use of his former name as the answer to a trivia question in a commercial for automobiles). Indeed, one can imagine some very un-subtle uses of tattooed marks that almost certainly would convey a message that the mark owner endorses the product. In a recent article in the British tabloid *The Sun*, for example, sportswriter Bill Leckie suggested in jest that soccer star David Beckham could sponsor a variety of products by having their trademarks tattooed on his body. See Bill Leckie, *Just Stick "Old Firm" on Sponsored Ref Tops*, THE SUN (U.K.), Dec. 7, 2001, at 75 (suggesting that Beckham "could have Vodafone tattooed on his arm, Adidas on his leg and This Space to Let on the back of his head"). Presumably, if an athlete or entertainer engaged in such advertising without the consent of the mark owner—or made use of a mark that itself infringed another mark—he could be liable for infringement. (One would hope that Posh Spice would counsel against any such plans on the part of Beck.) The example seems fanciful, but if experience teaches anything it is that truth is often stranger than fiction.

ornamental use to give rise to a false message of endorsement. KISS and Britney, after all, are in the entertainment business, and thus another entertainer's use of their marks, names, or likenesses in his act might cause some audience members to assume some sort of sponsorship relationship.¹⁴² One possible defense would be that these uses are parodic, although the case law on trademark parody is far from clear. One approach that some courts follow, however, is to accommodate the defendant's interest in freedom of expression by requiring a somewhat stronger showing of likelihood of confusion in a case involving a parodic use of a mark.¹⁴³ Other courts nevertheless have found trademark parodies to infringe,¹⁴⁴ or to violate antidilution or other laws,¹⁴⁵ although these latter grounds for relief against parodies may be waning.¹⁴⁶ Although trademarks are, in one sense,

¹⁴² The unauthorized use of a mark or name on a related product or service is one factor that weighs in favor of a finding of likelihood of confusion as to sponsorship or endorsement. See *Abdul-Jabbar*, 85 F.3d at 413.

¹⁴³ See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490, 494-95 (2d Cir. 1989); see also *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900-02 (9th Cir. 2002) (holding that, in cases involving expressive uses such as parodies, courts must take into the public interest in free expression); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 772-77 (8th Cir. 1994) (holding that, in cases involving parodies, courts must consider the defendant's interest in free expression, but concluding that the parodic use at issue nevertheless infringed); *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316, 320-21, 321 n.2 (4th Cir. 1992) (holding that the defendant's parodic use did not cause a likelihood of confusion, but declining to rule whether the First Amendment provides an independent basis for immunity); cf. *Nike, Inc. v. "Just Did It" Enters.*, 6 F.3d 1225, 1233 (7th Cir. 1993) (reversing summary judgment for plaintiff and remanding for trial); *Jordache Enters. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1488 (10th Cir. 1987) (affirming judgment of no likelihood of confusion).

¹⁴⁴ See, e.g., *Anheuser-Busch*, 28 F.3d at 775; *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 401-03 (8th Cir. 1987); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205-06 (2d Cir. 1979); *Am. Dairy Queen Corp. v. New Line Prods.*, 35 F. Supp. 2d 727, 732 (D. Minn. 1998); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1190 (E.D.N.Y. 1972).

¹⁴⁵ See, e.g., *Anheuser-Busch*, 28 F.3d at 777-78; *Am. Dairy Queen*, 35 F. Supp. 2d at 733; *Coca-Cola*, 346 F. Supp. at 1191-92.

¹⁴⁶ Some courts have held or suggested, for example, that antidilution laws do not apply at all to trademark parodies contained in expressive works. See *Mattel*, 296 F.3d at 902-07 (holding that the Federal Trademark Dilution Act exempts uses that

property, they are in another important sense a part of our common culture; as some courts and commentators have begun to recognize, sometimes we need to use these symbols to ridicule and critique that same culture.¹⁴⁷

In sum, we can only sketch out some possible approaches to what remain, for now, hypothetical cases; we leave it to the courts to flesh out (pardon the pun) the legal doctrine as actual disputes arise. When deciding whether expressive and parodic uses of trademarks in body art violate trademark owners' rights, however, courts should be sensitive not only to the interests of mark owners but also to the interests of artists, subjects, and the viewing public. We also suspect that, in marginal cases, the difficulty in crafting an appropriate remedy may influence some courts to find a use expressive (or noncommercial, or parodic, or otherwise noninfringing and nondilutive). Injunctions against violative uses (and orders to destroy infringing merchandise) are probably even more common in trademark than in copyright cases, because of the interest in preventing consumers confusion;¹⁴⁸ while

are "not purely commercial speech"); *Lucasfilm Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897, 900-01 (N.D. Cal. 2002) (same); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32-33 (1st Cir. 1987) (applying similar analysis to state law). Others have held that particular parodies did not give rise to a likelihood of dilution. *See, e.g., Jordache*, 828 F.2d at 1488-91.

¹⁴⁷ *See* ROSEMARY J. COOMBE, *THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES* 41-87 (1998); Denicola, *Trademarks as Speech*, *supra* note 129; Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990); Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.-VLA J.L. & ARTS 123 (1996); Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1583-1605 (1993); Heald, *supra* note 129, at 803-09.

¹⁴⁸ The Lanham Act authorizes courts to award injunctions "according to the principles of equity and upon such terms as the court may deem reasonable" and also to destroy infringing merchandise. 15 U.S.C. §§ 1116, 1118. As the Restatement notes, "[i]n cases of deceptive marketing, trademark infringement, or trademark dilution, a prevailing plaintiff is ordinarily awarded injunctive relief to protect both the plaintiff and the public from the likelihood of future harm." RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 35 cmt. b. (1995). Moreover, under federal law damages are ordinarily *not* available for merely dilutive uses. *See* 15 U.S.C. § 1125(c)(2).

disclaimers may in some rare cases suffice to dispel confusion,¹⁴⁹ the placement of a disclaimer on an existing work of body art may be impractical, to say the least. Perhaps these pragmatic difficulties will provide yet more reasons for courts to conclude that trademark law in general does not provide a good “fit” for most unauthorized uses of trademarked symbols in body art.

IV. PUBLICITY ISSUES

A final set of issues revolves around the right of publicity. According to the rule set forth in the Restatement (Third) of Unfair Competition, “[o]ne who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability.”¹⁵⁰ About half of the states have adopted the right of

¹⁴⁹ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 35 cmt. d (1995) (noting that “[a] trademark owner who proves infringement is ordinarily awarded an absolute injunction prohibiting further use,” and that while limited injunctions may be appropriate when the defendant shows “a legitimate interest in continued use,” disclaimers “are often only partially effective in eliminating the likelihood of confusion”).

¹⁵⁰ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995). Courts and commentators have proposed various reasons why celebrities and others should be granted this right. One argument is that free-riding violates the Lockean principle that one should be able to enjoy the “fruit of his labor” as long as he leaves enough and as good for others. Another is that unauthorized uses of another’s persona can harm the other’s reputation, and violates the respect due that persona under a Kantian or Hegelian theory of personhood. See Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 388, 390 (1999); Roberta Rosenthal Kwall, *Fame*, 73 IND. L.J. 1, 36-40 (1997); Melville Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 216 (1954). Critics argue that these theories do not adequately take into account the fact that celebrities often owe much of their fame to the efforts of other people, including fans, and to luck. See Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 188 (1993). Another theory is that the right of publicity encourages people to invest in becoming celebrities. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576-77 (1977). But do they need the additional encouragement, and does it serve any social good to encourage this type of investment? See Madow, *supra*, at 206-16. Yet another theory is that people enjoy the “consumption” of others’ fame, and that the value of this consumption falls if overused. People would

publicity in one form or another, either by statute or common law. California, for example, recognizes in both its common law and statutory law the “right of a person whose identity has commercial value—most often a celebrity—to control the commercial use of that identity.”¹⁵¹ The question therefore arises whether the use of a celebrity’s name, likeness, or other indicia of identity in a work of body art can constitute a violation of the right of publicity—and if so, once again, what the appropriate remedy would be.

Courts and commentators have recognized the difficulty of reconciling the right of publicity with the First Amendment interest in freedom of expression, and a satisfactory resolution remains elusive. On the one hand, in *Zacchini v. Scripps-Howard Broadcasting Co.*,¹⁵² the United States Supreme Court held that the First Amendment did not bar the plaintiff, a circus performer, from asserting a publicity claim against a broadcaster that showed his entire act on a television news show.¹⁵³ The Court nevertheless left open the possibility that the First Amendment might have shielded the broadcast of a shorter portion of the act, because a shorter excerpt would not have posed as much of a threat to the plaintiff’s livelihood.¹⁵⁴ More recently, however, in *Hoffman v. Capital Cities/ABC Inc.*,¹⁵⁵ the Ninth Circuit held that for a public figure to recover damages for a violation of the right of publicity arising in connection with non-commercial speech, he must prove by clear and convincing evidence that the defendant acted with actual malice.¹⁵⁶

The need to accommodate the competing free speech interests of artists and buyers also influences the types of uses that are deemed to fall within the domain of the right of publicity. According to the Restatement, “[t]he name, likeness, and other indicia of a person’s

get tired of Britney Spears if she appeared on everything (as if she doesn’t already), and therefore would derive less satisfaction from her persona. See Mark A. Grady, *A Positive Economic Theory of the Right of Publicity*, 1 UCLA ENT. L. REV. 97 (1994).

¹⁵¹ *Hoffman v. Capital Cities/ABC Inc.*, 255 F.3d 1180, 1183 (9th Cir. 2001) (quoting *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1098 (9th Cir. 1992)).

¹⁵² 433 U.S. 562 (1977).

¹⁵³ *Id.* at 576.

¹⁵⁴ *Id.* at 575-76.

¹⁵⁵ 255 F.3d at 1180.

¹⁵⁶ *Id.* at 1186-89.

identity are used ‘for purposes of trade’ . . . if they are used in advertising the user’s goods or services, or are placed on merchandise marketed by the user, or are used in connection with the services rendered by the user.”¹⁵⁷ In order to protect the defendant’s interest in freedom of speech and expression, however, the term “for purposes of trade” ordinarily does not include the use of a person’s identity for entertainment or artistic purposes.¹⁵⁸

Courts have interpreted this exception in sometimes unpredictable ways. In *Estate of Presley v. Russen*,¹⁵⁹ for example, a case involving an unauthorized Elvis impersonator, the court quoted with approval the observation that “[t]he public interest in entertainment will support the sporadic, occasional and good faith imitation of a famous person to achieve humor, to effect criticism or to season a particular episode, but it does not give a privilege to appropriate another’s valuable attributes on a continuing basis as one’s own without the consent of the other.”¹⁶⁰ On the other hand, in *ETW Corp. v. Jireh Publishing Inc.*,¹⁶¹ the court held that the right of publicity did not preclude the defendant from marketing 5000 limited edition posters of an original painting of Tiger Woods.¹⁶² And in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,¹⁶³ the California Supreme Court confronted the issue of whether a t-shirt bearing the likenesses of Moe, Curly, and Larry of Three Stooges fame was a work of art or merely an infringing commercial product.¹⁶⁴ Finding in favor of the Stooges’ assignee, the court formulated “a balancing test between the First Amendment and the right of publicity based on whether the work in question adds

¹⁵⁷ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47.

¹⁵⁸ *Id.* § 47, cmt. c.

¹⁵⁹ 513 F. Supp. 1339 (D.N.J. 1981).

¹⁶⁰ *Id.* at 1360 (quoting Victor S. Netterville, *Copyright and Tort Aspects of Parody, Mimicry and Humorous Commentary*, 35 S. CAL. L. REV. 225, 254 (1962)); accord *Apple Corps Ltd. v. A.D.P.R., Inc.*, 843 F. Supp. 342, 349 (M.D. Tenn. 1995) (holding that the defendants’ re-creation of a Beatles concert circa 1964-66 violated the Beatles’ right of publicity).

¹⁶¹ 99 F. Supp. 2d 829 (N.D. Ohio 2000).

¹⁶² *Id.* at 834.

¹⁶³ 21 P.3d 797 (Cal. 2001).

¹⁶⁴ *Id.* at 800-01.

significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.”¹⁶⁵ Under this test, “when an artist’s skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist’s right of free expression is outweighed by the right of publicity.”¹⁶⁶

The application of the right of publicity to body art therefore may vary depending upon the specific factual context. In a case in which the artist has applied a celebrity name or image to a single body, the use would appear indistinguishable from any other painting of a name or image, and therefore should fall within the exception for artistic uses. And as long as the subject too does not use the name or image for commercial gain, it is difficult to see how his mere display of the work runs afoul of the right of publicity.

Different results might ensue, however, if the artist markets her work as more of a mass-merchandise product. Suppose, for example, that a tattoo artist churns out multiple copies of the same celebrity image on demand. Here the law is less clear. On the one hand, in a case involving buttons bearing celebrity images, a court held that the works were merchandise, not art, and therefore infringing of the celebrities’ rights.¹⁶⁷ Presumably this same reasoning would apply to detachable body art, such as temporary tattoos. On the other hand, the Tiger Woods case suggests that the mere fact that the product is mass-marketed does not necessarily undermine its status as art,¹⁶⁸ and a court following *Comedy III Productions* might consider whether the use is sufficiently “transformative.”¹⁶⁹ A risk-averse body artist therefore might shy away from overuse of the same name or image, or might make sure to add significant original elements (e.g., a caricaturer rather

¹⁶⁵ *Id.* at 799.

¹⁶⁶ *Id.* at 810.

¹⁶⁷ *See* *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1198-1201 (S.D.N.Y. 1983). Recall from above that, in that same case, the court held that the ornamental use of the celebrity images did not violate the plaintiffs’ trademark rights. *See supra* note 122.

¹⁶⁸ *See* *ETW Corp. v. Jireh Publ’g, Inc.*, 99 F. Supp. 2d 829, 835 (N.D. Ohio 2000).

¹⁶⁹ *See* *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808-10 (Cal. 2001).

than a more photographic-like reproduction of the celebrity's face).

Another difficult case would be one in which the subject uses the image for commercial gain, as is arguably the case in our Eminem hypothetical. In this instance, a use that has some critical bite might stand a better chance of surviving a publicity claim. As the *Comedy III* court noted, "the creative appropriation of celebrity images can be an important avenue of individual expression."¹⁷⁰ Moreover,

[o]nce the celebrity thrusts himself or herself forward into the limelight, the First Amendment dictates that the right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad scope What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity's fame through the merchandising of the "name, voice, signature, photograph, or likeness" of the celebrity.¹⁷¹

Eminem therefore might argue that his use of a Britney tattoo in his act is a form of self-expression, and that he is entitled to criticize Britney's squeaky-clean turned sex-symbol status and her questionable talent as a singer. Some courts also might apply a copyright-like fair use analysis that focuses on, among other things, whether the use is transformative.¹⁷² Transformative parodies, for example, are "less likely to interfere with the economic interest protected by the right of publicity" because these works "are not, from the celebrity fan's viewpoint, good substitutes for conventional depictions of the celebrity."¹⁷³ Thus, in our hypothetical, Eminem might argue that his tattoo does not interfere with Britney's economic interest insofar as the tattoo is unlikely to induce Britney fans to stop buying Britney CDs, dolls, posters, and other memorabilia. Eminem could further argue that, even if some fans do stop supporting Britney, it is because they find his critique persuasive, and thus the tattoo is still protected under

¹⁷⁰ *Id.* at 803.

¹⁷¹ *Id.* at 807, 810 (quoting WEST'S ANN. CAL. CIV. CODE § 990 (1998), subsequently renumbered and amended as WEST'S ANN. CAL. CIV. CODE § 3344.1 (2002)).

¹⁷² *See id.* at 807-08; *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. d. (1995).

¹⁷³ *Comedy III*, 21 P.3d at 808.

the fair use defense.¹⁷⁴ If the tattoo lacks transformative value, however, its commercial use on a continuing basis might incline some courts to view the tattoo as more like an unauthorized impersonation, and therefore potentially infringing.¹⁷⁵

Another interesting question is whether certain images incorporated into a work of body art would constitute an appropriation of a person's "indicia of identity." Some courts have interpreted the term "indicia of identity" quite broadly, so as to grant protection for a person's distinctive voice¹⁷⁶ and even (more controversially) distinctive performing styles or characters.¹⁷⁷ Suppose then that a makeup artist sets up a "KISS look-alike parlor" and starts making up people with "KISS makeup" so that they may imitate Gene Simmons and other band members. Arguably, the makeup artist is appropriating a distinctive indicium of Gene Simmons's identity for a commercial purpose, in much the same way that the defendants in the *White* and *Wendt* cases arguably used the plaintiffs' distinctive images in those cases by putting robots with physical characteristics reminiscent of Vanna White and George Wendt in settings that called to mind, respectively, *Wheel of Fortune* and *Cheers*.¹⁷⁸ Both cases evoked memorable dissenting opinions, however,¹⁷⁹ and have met with some

¹⁷⁴ See, e.g., *Ty, Inc. v. Publ'ns Int'l Ltd.*, 292 F.3d 512, 517 (7th Cir. 2002) (noting that, absent a fair use defense in copyright law, a book reviewer could not quote from the book he was reviewing without a license from the publisher, thus impairing the reviewer's freedom of expression and also reducing the credibility of book reviews). Courts also have noted that "vulgar forms of expression fully qualify for First Amendment protection." *Comedy III*, 21 P.3d at 809 (citing *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988)). Thus, even if the Britney tattoo is gory and graphic, a court might still find the work sufficiently transformative to merit protection under the fair use doctrine.

¹⁷⁵ See *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1360 (D.N.J. 1981); *Apple Corps Ltd. v. A.D.P.R., Inc.*, 843 F. Supp. 342, 347 (M.D. Tenn. 1993).

¹⁷⁶ See *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1102 (9th Cir. 1992).

¹⁷⁷ See *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 813 (9th Cir. 1997); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992).

¹⁷⁸ See *Wendt*, 125 F.3d at 811-12; *White*, 971 F.2d at 1397-99.

¹⁷⁹ See *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284, 1285 (9th Cir. 1999) (Kozinski, J., dissenting from denial of rehearing en banc); *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en

sharp critical commentary.¹⁸⁰ One problem with these and other cases that extend the definition of “indicia of identity” is their potential conflict with copyright law, which often accords a person other than the performer with exclusive rights in media (such as sound recordings, photographs, or motion pictures) that also capture some aspect of a performer’s style. The case law on preemption remains confused,¹⁸¹ however, and for now we merely note that Gene Simmons’s hypothetical assertion of publicity rights in his masked persona might be vulnerable on this ground if someone else owns the copyright or trademark rights to the makeup design.¹⁸²

As with the copyright and trademark claims, an assertion of the right of publicity with respect to body art raises questions of the

banc).

¹⁸⁰ See, e.g., Heald, *supra* note 129, at 802-08; Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 225-27 (1998); Tyler T. Ochoa, *Dr. Seuss, The Juice and Fair Use: How the Grinch Silenced a Parody*, 45 J. COPYRIGHT SOC’Y U.S.A. 546, 616 n.389 (1998); Michael J. Albano, Note, *Nothing to “Cheer” About: A Call for Reform of the Right of Publicity in Audiovisual Characters*, 90 GEO. L.J. 253 (2001).

¹⁸¹ See, e.g., *Wendt*, 197 F.3d at 1287-89 (Kozinski, J., dissenting from denial of rehearing en banc) (arguing that the result in *Wendt* conflicts with the Copyright Act, the Dormant Commerce Clause, and the First Amendment); see also *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911, 1919 (Cal. App. 1996) (holding that the Copyright Act preempted actors’ right of publicity claim against the authorized distributor of a motion picture); *KNB Enters. v. Matthews*, 78 Cal. App. 4th 362, 364 (2000) (holding that the Copyright Act did not preempt models’ right of publicity claims against a defendant who displayed copyrighted photographs on his website, without permission of the copyright owner). Together these latter two cases suggest that preemption occurs when the plaintiff asserts a right of publicity claim against the copyright owner (or the latter’s licensee) of a work that embodies the plaintiff’s name, image, or likeness, but not when she asserts a right of publicity claim against a non-copyright holder. Does that result make sense?

¹⁸² Alternatively, suppose that a fan of the musical *Cats* copied the makeup design of the character, Grizabella, and applied it to his face. Arguably, these makeup designs are also highly recognizable and distinctive to the general public; *Cats* was one of the longest-running shows in the history of American theater. Most likely, however, the zealous fan has not violated the right of publicity, because it seems unlikely that the makeup has become distinctive of a specific actor’s face. Many different actors have assumed the role of Grizabella in various *Cats* productions all over the world. There would still be a copyright problem, however, as noted above.

appropriate remedy if a violation is found. In addition to awarding damages, a court presumably could enjoin the artist from future commercial uses and could enjoin the subject from using the art in a commercial manner.¹⁸³ Because merely wearing body art is not likely to constitute a commercial use,¹⁸⁴ however, it seems unlikely that a court would have to face the difficult issue of whether the right of publicity authorizes an injunction against the public display of a celebrity's name or image. To the extent that the subject's use raises copyright or trademark issues, however, the court would still have to face the injunction problem with respect to those rights.¹⁸⁵

V. CONCLUSION

As this brief discussion shows, the use of copyrighted works of authorship, trademarked symbols, or indicia of personal identity in works of body art may give rise to a number of thorny problems, some of which implicate constitutional rights. Our hypotheticals are probably not exhaustive of all of the ways in which these issues may arise, but may help courts and potential litigants to isolate some of the relevant issues as well as the possible consequences of alternative ways of resolving them. When these issues do surface, we hope that courts will be sensitive to the needs of artists and subjects to express themselves without unduly trespassing on the rights of content owners. For millennia, the human body has served as a medium of sublime artistic expression. As such, it deserves the same respect and integrity as more conventional—we dare not say traditional—media such as painting and sculpture.

¹⁸³ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 48 (1995).

¹⁸⁴ See *supra* p. 42.

¹⁸⁵ See *supra* notes 106-17 and accompanying text.