Solid Oak Sketches v. 2K Games: is this lawsuit the beginning of the end of uncertainty concerning the enforceability of tattoo copyrights?

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Abstract: In the past several years, a number of tattoo artists and one of their exclusive licensees have filed lawsuits against a variety of businesses for copyright infringement of their tattoos. However, none of these lawsuits have gone to trial. This case review examines a pending tattoo copyright lawsuit filed against a video game maker in 2016, *Solid Oak Sketches, LLC v. 2K Games et al*, and mentions another more recently filed lawsuit against the same video game maker, *Hayden v. 2K Games, Inc. et al*.

Keywords: copyright, tattoo, infringement, Solid Oak Sketches, 2K Games

1. Introduction

Video game makers,¹ a film production company,² a restaurant,³ and an athletic footwear and apparel company⁴ – tattoo artists, and in one instance, the artists' exclusive licensee, have alleged that these businesses have infringed the copyrights in their tattoos. None of these lawsuits have gone to trial. But currently, there are two pending lawsuits concerning the use of copyrighted tattoos in the NBA 2K video games.

On February 2, 2016, Solid Oak Sketches filed a lawsuit against the makers of the NBA 2K series of video games.⁵ In *Solid Oak Sketches, LLC v. 2K Games et al*, Solid Oak Sketches alleges it is the exclusive licensee of the rights in five copyrighted tattoos created by tattoo artists Tommy Ray Cornett, Shawn Rome, and Justin Wright, and inked on the bodies of three players in the National

Basketball Association ('NBA'), Eric Bledsoe, LeBron James, and Kenyon Martin.⁶

Solid Oak alleges the tattoos, exclusively licensed by Solid Oak and federally registered with the U.S. Copyright Office, have been reproduced and displayed on the bodies of the avatars of Bledsoe, James, and Martin in the NBA 2K video games (including, but without limitation to, NBA 2K14, NBA 2K15, and NBA 2K16) without authorization, and therefore, the defendants have infringed the copyrights in the tattoos.⁷

Defendants 2K Games, Inc. and Take-Two Interactive Software, Inc. sought to dismiss Solid Oak's copyright infringement claim as a matter of law under the *de minimis* use and fair use doctrines.⁸ On March 30, 2018, the court denied the defendants' motion.⁹

In the other pending tattoo copyright lawsuit filed on December 18, 2017, *Hayden v. 2K Games, Inc. et al*,

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1 *Allen v. Elec. Arts, Inc.*, No. 5:12-CV-03172 (W.D. La. December 31, 2012); *Escobedo v. THQ*, No. 2:12-CV-02470 (D. Ariz. November 16, 2012); *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 01, 2016); and *Hayden v. 2K Games, Inc. et al*, No. 1:17-CV-02635 (N.D. Ohio December 18, 2017).

2 Complaint, *Whitmill v. Warner Bros. Entm't Inc.*, 2011 WL 2038147 (E.D. Mo. April 28, 2011), *dismissed*, No. 4:11-CV-752 CDP (E.D. Mo. June 22, 2011) [hereinafter *Whitmill Complaint*] (involving a tattoo artist alleging infringement of copyright in a tattoo design).

3 *Ladouceur v. Macado's Inc.*, No. 17-CV-00588 (W.D. Va. October 30, 2015).

4 Complaint, *Reed v. Nike, Inc.*, No. 3:05-CV-00198 (D. Or. February 10, 2005), *dismissed*, (D. Or. October 19, 2005) [hereinafter *Reed Complaint*].

5 Complaint, *Solid Oak Sketches, LLC v. Visual Concepts, LLC et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

6 Second Amended Complaint, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

7 Second Amended Complaint, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016); Defendant's Response to Judgment on the Pleadings, Second Amended Complaint, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

8 Defendants' Motion for Judgment on Pleadings, Second Amended Complaint, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

9 Memorandum Opinion and Order, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

tattoo artist James Hayden is suing the same corporations, 2K Games, Inc. and Take-Two Interactive Software, Inc., for, *inter alia*, copyright infringement.¹⁰ Hayden alleges the defendants are using six of Hayden's copyrighted tattoos inked on the bodies of NBA players LeBron James, Danny Green, Tristan Thompson, and Kyrie Irving, in the NBA 2K16 and NBA 2K17 video games.¹¹

Hayden alleges the tattoos on the avatars of James, Green, Thompson, and Irving are prominently featured in the video games and 'appear to be the result of a painstaking effort by Defendants to precisely copy' the copyrighted works.¹² Thus, Hayden asserts that the defendants' unauthorized reproduction, distribution, and creation of derivative works of Hayden's federally registered and copyrighted designs violates the Copyright Act.¹³

The allegations of Hayden closely parallel the allegations of Solid Oak, except Hayden, as the tattoo artist and creator of the works, has broader rights in his works than the rights licensed by Solid Oak. If the Solid Oak lawsuit proceeds to trial, Hayden (as well as other potential plaintiffs considering a tattoo copyright lawsuit) should be mindful of the outcome. For example, the *Solid Oak* court has already ruled on Solid Oak's claim for attorney's fees and statutory damages.

2. Damages

Under Section 504 of the Copyright Act of 1976, the current federal copyright statute, an infringer of copyright is liable for either 'the copyright owner's actual damages and any additional profits of the infringer' or statutory damages.¹⁴ The court, in its discretion, 'may also award a reasonable attorney's fee to the prevailing party.'¹⁵ However, in order to obtain statutory damages and attorney's fees, a plaintiff must have registered its copyright prior to the alleged infringement.¹⁶

Initially, Solid Oak sought statutory damages and attorney's fees. Defendants then filed a motion to dismiss these claims, on the ground that the works at issue were not registered with the U.S. Copyright Office

prior to the alleged infringement.¹⁷ On August 2, 2016, the court granted defendants' motion to dismiss, stating:

Courts in this district have held that Section 412 of the Copyright Act imposes a bright-line rule that precludes recovery of statutory damages and attorneys' fees where the first act of infringement in a series of ongoing infringements occurred prior to the work's copyright registration, finding such a bright-line rule preferable to case-by-case analyses of whether a series of infringements 'has stopped sufficiently such that the restart constitutes a new set of infringements.'...

In the instant case, Defendants' infringement of the tattoo designs began with the release of NBA 2K14 in 2013...and Plaintiff did not register the tattoo designs with the U.S. Copyright Office until 2015.Thus, Defendants' alleged infringement commenced prior to effective registration of the works.¹⁸

The court was not persuaded by Solid Oak's primary arguments that it should be entitled to statutory damages and attorney's fees because:

1. NBA 2K16 was released after registration of the works and that release 'constituted a separate instance of infringement giving rise to a discrete claim[.]';
2. defendants created only two infringing games (with an appreciable period of time between them) before registration of the works so there was no ongoing or continuous series of infringements; and
3. the updates to NBA 2K16 distinguished it as a separate work from prior NBA 2K versions.¹⁹

It is advisable for tattoo artists like Hayden and other tattoo copyright owners to closely follow the progress of the *Solid Oak* lawsuit. For instance, in light of Judge Swain's August 2, 2016 order dismissing Solid Oak's claims for statutory damages and attorney's fees, Hayden may expect the Northern District of Ohio court to rule similarly on his claims for statutory damages and attorney's fees.

3. Defenses

In *Solid Oak*, defendants 2K Games, Inc. and Take-Two Interactive Software, Inc. have filed a motion for judgment on the pleadings, which seeks to dismiss Solid Oak's copyright infringement claim as a matter of law

10 Complaint, *Hayden v. 2K Games, Inc. et al*, No. 1:17-CV-02635 (N.D. Ohio December 18, 2017).

11 Ibid.

12 Ibid.

13 Ibid.

14 17 U.S.C. § 504(a).

15 17 U.S.C. § 505.

16 17 U.S.C. § 412; see also Order Dismissing Solid Oak's Claims for Statutory Damages and Attorney's Fees. *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

17 Defendants' Motion to Dismiss, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

18 Memorandum Opinion and Order, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

19 Ibid. Solid Oak also claimed that the NBA 2K16 video game's use of the tattoos constituted a separate act of infringement because (1) Solid Oak filed the action within the Copyright Act's three-year statute of limitations and (2) unlike the prior allegedly infringing games, the NBA 2K16 infringement was willful due to Solid Oak putting defendants on notice of the copyrighted works.

under the *de minimis* use and fair use doctrines.²⁰ Due to the fact-specific nature of the inquiries that constitute the analyses of those defenses, this article examines those defenses, as well as the defense of implied licence (which was not raised by the defendants in *Solid Oak*), in the context of the *Solid Oak* and *Hayden* lawsuits.

3.1. *De minimis*

The terms *de minimis* are derived from the Latin maxim *de minimis non curat lex*; the English translation of this Latin phrase is ‘the law does not concern itself with trifles.’²¹ In other words, ‘the law is not concerned with insignificant or minor matters.’²²

In *Ringgold v. Black Entertainment Television, Inc.*,²³ the Second Circuit has identified three potential meanings of the *de minimis* defense in the copyright context:

1. ‘a technical violation of a right so trivial that the law will not impose legal consequences[.]’;
2. an instance where ‘copying has occurred to such a trivial extent as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying’; and
3. a defense ‘relevant to the fair use[.]’ namely the third statutory factor in the fair use determination—the amount and substantiality of the portion used in relation to the copyrighted work as a whole....²⁴

The *Ringgold* court observed that cases are rarely litigated illustrating use of the first meaning and the third definition inappropriately incorporates the *de minimis* defense into the fair use determination, which analyses the quantity of copying along a continuum as part of the third factor and necessitates a careful examination of multiple additional factors.²⁵ Thus, the court concludes that the appropriate meaning of *de minimis* is the second meaning, whether the copying of the work occurred to an extent to constitute substantial similarity, or copyright infringement.²⁶ In determining whether or not the allegedly infringing work falls below this quantitative threshold, ‘courts often look to the amount of the

copyrighted work that was copied, as well as, (in cases involving visual works), the observability of the copyrighted work in the allegedly infringing work.’²⁷

In *Solid Oak*, defendants argue that their use of the copyrighted works is *de minimis* because:

1. the tattoos rarely appear in the NBA 2K video games as they only are displayed when the players on whom they are inked are selected from the over 400 other NBA players that are available[.]
2. the tattoos are not prominently displayed when they do appear in the games as the game camera uses a full court shot with the players’ avatars appearing as small images[.]
3. the tattoos are not full observable due to the fluid movement of the players and other game elements blocking views of the tattoos, and
4. the tattoos ‘are not ‘spot lit’ in any way, but rather are deemphasized by the appearance of other game elements and other tattoos’ appearing on the bodies of Bledsoe, James, and Martin.²⁸

Plaintiff responds that defendants’ use of the copyrighted works is not *de minimis*, because:

1. a user of the NBA 2K video games could pick each player bearing the tattoos at issue in this matter (especially in light of the popularity of James as the ‘highest rated player’ in the game), for hours of play, and, as a result, continuous observability of the tattoos, and
2. defendants provide no support for their conclusions regarding the observability of the tattoos in the games.

On March 30, 2018, the court denied the defendants’ motion for judgment on the pleadings as to *de minimis* use, concluding:

[T]here is no objective perspective as to how the Defendants’ video game is generally played, or to what extent certain game features can be or are actually utilized, that would allow this Court to make determinations about the choices and subsequent observations of the ‘average lay observer,’ or about the observability and prominence of the Tattoos. The Court is thus unable to conclude without the aid of extrinsic evidence that ‘no reasonable jury, properly instructed, could find that the two works are substantially similar.’²⁹

20 Defendant’s Motion for Judgment on the Pleadings, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

21 *Findlaw Legal Dictionary*, <http://dictionary.findlaw.com/definition/de-minimis-non-curat-lex.html> (last visited February 7, 2018); *Ringgold v. BET*, 126 F.3d 70, 74 (2d Cir. 1997).

22 *Findlaw Legal Dictionary*, <http://dictionary.findlaw.com/definition/de-minimis-non-curat-lex.html> (last visited February 7, 2018).

23 In this case, the plaintiff alleged that the defendants infringed her copyright in her story quilt design, ‘Church Picnic Story Quilt,’ when the defendants used a poster reproduction of the work as part of the set decoration on an episode of the television ‘sitcom’ series *ROC*. During a scene of the episode, ‘at least a portion of the poster is shown a total of nine times.’ *Ringgold*, 126 F.3d at 73. The aggregate duration of the visibility of the work was 26.75 seconds. *Ibid* at 76. Defendants raised the *de minimis* defense, arguing ‘the nine instances

in their television program in which portions of the poster were visible, individually and in the aggregate, were *de minimis*, in the sense that the quantity of copying (or at least the quantity of observable copying) was below the threshold of actionable copying.’ *Ibid*.

24 *Ibid* at 74–75.

25 *Ibid* at 74, 76.

26 *Ibid* at 75.

27 *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 217 (2d Cir. 1998) (citing *Ringgold*, 126 F.3d at 75).

28 Defendant’s Memorandum in Support of Motion for Judgment on the Pleadings, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

29 Memorandum Opinion and Order, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

In the author's opinion the use of the copyrighted tattoos in the NBA 2K video games exceeds the quantitative threshold for actionable copying. Considering the amount of the works that were copied – here, the works were copied in their entirety – and the observability of the copyrighted works in the video games – potentially significant in the likely event that a user would select one or more of the three players bearing the tattoos at issue – one reasonably reaches the conclusion that the copying of the works is more than trivial.

3.2. Fair use

'[T]he fair use of a copyrighted work ... is not an infringement of copyright.'³⁰

Section 107 of the Copyright Act of 1976 states:

In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

1. the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
2. the nature of the copyrighted work;
3. the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
4. the effect of the use upon the potential market for or value of the copyrighted work.³¹

The determination 'calls for case-by-case analysis' and all of the statutory factors 'are to be explored, and the results weighed together, in light of the purposes of copyright.'³²

Defendants argue that their use of the copyrighted tattoos is fair use because:

1. the tattoos are used for a different, transformative purpose of realistically depicting individual NBA players;
2. the creative nature of the works must be weighed against the fact that the works had already been published and defendants use them to accurately depict real-world subject matter;
3. the reproduction of the works in their entirety was reasonable given the purpose to accurately depict the world and the substantiality of the use is diminished by the minimal size of the tattoos in the NBA 2K games; and

4. defendants cannot harm plaintiff's market due to plaintiff's express disclaimer of the right to tattoo the works onto a person's skin and a nonexistent market for depicting real people's tattoos in video games.³³

Plaintiff responds that defendants' use of the copyrighted tattoos is not fair use because:

1. the video games' commercial use of the original works does not transform the works so they convey a new message;
2. the copyrighted tattoos are creative, expressive works entitled to greater protection and their published nature does not fully withdraw them from protection;
3. reproduction of the works in their entirety is not material for the alleged purpose of the game and the alleged minimal use begs the questions as to why defendants did not alter the tattoos to avoid improper use; and
4. defendants' use diminishes the commercial value of the copyrighted tattoos' potential licensing markets.³⁴

The first factor is '[t]he heart of the fair use inquiry.'³⁵ The Supreme Court observed:

The central purpose of this investigation is to see, in Justice Story's words, whether the new work merely 'supersede[s] the objects' of the original creation ... ('supplanting' the original), or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is 'transformative.'³⁶

The defendants appear to be using the copyrighted tattoos for the – same purpose and function as the original creations – to adorn the bodies of individual NBA players – albeit in the different context of the virtual world, instead of the real one. Merely changing a work from one medium to another is not sufficiently transformative under the first use factor.³⁷

The second factor, the nature of the copyrighted work, weighs against a finding of fair use because the tattoos are expressive and creative. However, this factor often is not accorded much weight in the overall fair use determination.³⁸

The fair use determination should not be decided on defendants' motion. The third and fourth factors necessitate the discovery of further facts, namely, more information about defendants' use and evidence of plaintiff's

30 17 U.S.C. § 107.

31 Ibid.

32 *Campbell v. Acuff-Rose, Music, Inc.*, 510 U.S. 569, 577–78 (1994).

33 Defendant's Memorandum in Support of Motion for Judgment on the Pleadings, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

34 Plaintiff's Response to Defendant's Memorandum in Support of Motion for Judgment on the Pleadings, Defendant's Memorandum in Support

of Motion for Judgment on the Pleadings, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

35 *On Davis v. The Gap, Inc.*, 246 F.3d 152, 174 (2d Cir. 2001).

36 *Campbell*, 510 U.S. at 579.

37 *Penguin Random House LLC v. Colting*, 270 F.Supp.3d 736, 747 (S.D.N.Y. 2017).

38 *Authors Guild v. Google, Inc.*, 804 F.3d 202, 222 (2d Cir. 2015).

potential markets, before fair use of the copyrighted works can be fully and accurately assessed.

In the court's March 30, 2018 order, which denied the defendants' motion for judgment on the pleadings as to fair use, the court reached a similar conclusion to the author, stating:

Because of the difficulties inherent in conducting a side-by-side comparison of the video game and the Tattoos, further evidence must be considered in connection with the fact-intensive question of the applicability of the fair use defense.³⁹

3.3. Implied licence

The *Solid Oak* defendants have not raised an implied licence defence. However, it should at least be considered in the context of the *Solid Oak* and *Hayden* lawsuits.

While the Copyright Act requires that a transfer of copyright ownership,⁴⁰ be in writing, there is no writing requirement for an implied nonexclusive licence.⁴¹ An implied licence 'may be granted orally, or may even be implied from conduct.'⁴² '[A]n implied non-exclusive license will only be found when a copyright owner creates a work at the request of the licensee and with the intention that the licensee exploit it.'⁴³

As observed by *Solid Oak* in its response to defendants' motion for judgment on the pleadings:

Plaintiff is not arguing that NBA players must seek Plaintiff's permission every time that they appear in public. Rather,

Plaintiff is arguing that corporate entities that purposefully seek to commercially benefit from the use of the Tattoos be held accountable for their actions and pay a royalty to the rightful owner of the intellectual property.⁴⁴

Solid Oak's goes to the intent of the licensor and the scope of the implied licence. One could reasonably conclude that the tattoo artists expected and impliedly licensed their clients – Eric Bledsoe, LeBron James, and Kenyon Martin – to publicly display their tattoos, including appearances in the media. However, it is unlikely that these tattoo artists intended to license the reproduction and display of their works for third-party (parties outside of the artist-client relationship) commercialization at the time when these works were delivered to their clients.⁴⁵

Similarly, while James Hayden impliedly licensed LeBron James, Danny Green, Tristan Thompson, and Kyrie Irving to display their tattoos in public, he did not expect a third party outside of the artist-client relationship to reproduce and display the works for monetization in a series of video games.

4. Conclusion

In *Solid Oak*, defendants' use of the copyrighted tattoos exceeds the quantitative threshold for *de minimis* use, it is premature to assess defendants' fair use of the tattoos, and any implied licence to use the works would not cover the use by defendants in the NBA 2K video games.

39 Memorandum Opinion and Order, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

40 A 'transfer of copyright ownership' is defined, in the Copyright Act, as 'an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright...' 17 U.S.C. § 101. The definition expressly excludes a non-exclusive licence. 17 U.S.C. § 101.

41 Ibid § 204.

42 *Psihoyos v. Pearson Educ., Inc.*, 855 F.Supp.2d 103, 120 (S.D.N.Y. 2012).

43 *Weinstein Co. v. Smokewood Entertainment Group, LLC*, 664 F. Supp. 2d 232 (S.D.N.Y. 2009).

44 Plaintiff's Response to Defendant's Memorandum in Support of Motion for Judgment on the Pleadings, Defendant's Memorandum in Support of Motion for Judgment on the Pleadings, *Solid Oak Sketches, LLC v. 2k Games, Inc. et al*, No. 1:16-CV-00724 (S.D.N.Y. February 1, 2016).

45 Yolanda M. King, 'The Enforcement Challenges for Tattoo Copyrights' (2014–2015) 22 J. Intell. Prop. L. 29, 50–51.