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Face-Off! Tattoo Artist Sues Studio For Copyright Infringement To Knock Out Boxer’s Tattoo In Movie

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By David R. Ellis, Attorney at Law
Largo, Florida

In May, a tattoo artist sued Warner Brothers studio for copyright infringement over the use of his copyrighted tattoo design in the movie “The Hangover Part II.”

The case was brought by an artist who had drawn a distinctive tattoo on the face of the former boxer Mike Tyson, who appears in both the original film and the sequel. In the movie, one of the principal characters wakes up with a permanent tattoo bracketing his left eye, which is clearly the same as Tyson’s.

The artist, S. Victor Whitmill, formerly of Las Vegas but now of Missouri, designed the tattoo for Tyson based on Maori themes and called it “tribal tattoo.” Tyson had agreed that all rights to the design would belong to the artist.

Whitmill sued in U.S. District Court in St. Louis for an injunction barring the studio from using the tattoo in the movie and in its posters, and also asked for monetary damages for what he claimed was “reckless copyright infringement.” If the court had issued the injunction, it would have prevented the initial release of the movie which was due out the following weekend.

The case raised some interesting issues in copyright law.

First is the threshold question whether a tattoo design is protected by copyright. Under the U.S. Copyright Act, copyright protects “original works of authorship fixed in any tangible medium of expression.” 17 U.S.C. §102. Is Mike Tyson’s face a “tangible medium of expression? Since copyright gives the owner of the copyright a set of exclusive rights, including copying, adapting (making derivative works), distribution, and public display and performance, §106, it would seem that an original art design in the form of a tattoo drawn on the skin of a person could qualify.

Second is the question whether the film’s use of the tattoo on an actor in the movie might be considered a fair use. While the Copyright Act grants the copyright owner the exclusive rights noted above, the Act also establishes a number of limitations on the owner’s exclusive rights, the most important of which is the doctrine of fair use.

Section 107 of the Act provides that the “fair use” of a copyrighted work for purposes such as criticism, comment, news reporting, teaching, scholarship or research is not an infringement, and sets out a number of factors for courts to consider. These factors include the purpose and character of the use; the nature of the copyrighted work; the amount and substantiality of the portion used; and the effect of the use upon the potential market for or value of the copyrighted work.

One type of use that has been considered fair in certain circumstances is parody. In the case of Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994), which involved a parody of Roy Orbison’s 1960s song “O Pretty Woman” by the rap group Two Live Crew, the Supreme Court held that parody may constitute a fair use if its aim is to comment on or criticize a prior work by appropriating elements of the original in creating a new artistic and transformative work. The studio’s argument was that its use of Tyson’s tattoo was a parodic transformation of the original tattoo, giving it new expression, meaning and message in a broad comedy movie, and is therefore a fair use of the design.

Finally, even if the studio’s use of the tattoo is held to infringe the artist’s copyright and not be a fair use, is an injunction stopping release of the movie an appropriate remedy? Under the Copyright Act, the copyright owner is entitled to various remedies including injunctive relief, both preliminary and permanent, and monetary damages that can be measured by the owner’s actual damages or the infringer’s profit. In the latter case, the damage is apportioned according to the relative value of the infringed work in the overall work.

While an injunction is often appropriate, the courts also weigh the equities and decide whether the harm to the defendant in issuing an injunction would outweigh the plaintiff’s interest, and whether the plaintiff can reasonably be compensated in money damages.

Here the judge refused to issue a preliminary injunction, finding that enjoining the use of the design and preventing the release of the picture just before its scheduled opening would seriously damage Warner and others (in fact the picture grossed \$150 million at the box office in the first week of its release, one of the top grosses ever).

While the judge denied preliminary relief, she also expressed her belief that the plaintiff had a strong likelihood of prevailing on the merits and being compensated by money damages. She said that tattoos clearly can be copyrighted and rejected Warner’s argument that the plaintiff was trying to copyright Tyson’s face or restricting his use of his own face, or preventing others from removing or changing their tattoos.

As for the studio’s claim of fair use, the judge rejected the defense, saying that the tattoo in the movie was an exact copy, not a parody of the plaintiff’s design, and did not comment on or criticize the artist’s work. There was no change in the tattoo or any parody of the tattoo itself, and so it was not transformative -- any other facial tattoo would have worked just as well to advance the plot of the movie.

Despite not getting a preliminariny injunction, all may not be lost for the artist given the judge’s statement that he has a strong case on the merits. By allowing the picture to open as scheduled, the artist may ultimately benefit because if he wins his suit, he may get a small percentage of the earnings of the picture, as contrasted to a lesser amount he might have gotten as a license fee if the picture had not opened or been delayed.

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David R. Ellis is an attorney in Largo practicing trademarks, copyrights, patents, trade secrets, and intellectual property law; computer and cyberspace law; business, entertainment and arts law; and franchise, licensing and contract law. A graduate of M.I.T. and Harvard Law School, he is a registered patent attorney and Board Certified in Intellectual Property Law by the Florida Bar. He is the author of the book, A Computer Law Primer, and has taught Intellectual Property and Computer Law as an Adjunct Professor at the law schools of the University of Florida and Stetson University.

For more information, see www.davidellislaw.com or contact the author at ellislaw@alum.mit.edu

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