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# The Perils of Full Copyright Protection for Tattoos

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☞ Artistic works; Copyright; New Zealand; Non-surgical cosmetic procedures

*Drawings and paintings, which include tattoos, are protected by copyright, regardless of the medium to which they are applied. The full protection of tattoos raises troubling questions. Should tattoo artists or copyright owners be able to prevent changes to their tattoos or control how people are photographed or filmed? Limits on the extent of copyright protection for tattoos are required.*

## Introduction

Tattooing has moved from the shadows of society. Indeed, in the US tattooing was only legalised in Oklahoma in 2006.<sup>1</sup> Traditionally, even in jurisdictions such as New Zealand,<sup>2</sup> where tattooing was legal, tattoos operated in IP's negative space<sup>3</sup>: the tattooing industry was regulated by strong social norms.<sup>4</sup> For example, if a tattoo artist copied another's tattoo the copier would be ostracised by others in the tattoo industry.<sup>5</sup> In addition, tattoo artists traditionally recognised that their clients were free to do as they wished with their tattoos, for example, reproducing images of their tattooed bodies and making changes to the tattoos,<sup>6</sup> just so long as the design of the tattoo was not copied in another artwork.<sup>7</sup>

Now with increasing numbers of people choosing to adorn their body with tattoos and the mainstreaming of tattoo art,<sup>8</sup> the tattoo industry is increasing in value.<sup>9</sup> Nor are tattoo artists limited to the medium of skin; tattoo artists have licensed their tattoo designs for clothing and other merchandising.<sup>10</sup> Not surprisingly, tattoo artists are looking to copyright law and are attempting to fill yet another of IP's negative spaces.<sup>11</sup>

The question is not whether tattoos are protected by copyright, as it will be shown that tattoos are protected by copyright in New Zealand (as they would be in the UK); instead this article discusses the issues raised by the spectre of protecting tattoos just like any other artistic work. While prima facie a tattoo artist is entitled to the full benefits of copyright protection, the practical reality is that tattoos raise unique issues. For example, David Nimmer, a leading US copyright scholar, when writing his copyright treatise assumed in the abstract that tattoos were protected by copyright,<sup>12</sup> yet when faced with the consequences that such protection could cause, he reversed his position.<sup>13</sup>

The article argues that limits on the protection of tattoos are required. It must be noted, however, that the argument for limiting the copyright in tattoos is not making the argument that there is no copyright in tattoos; rather, the tattoo artist or copyright right owner or both<sup>14</sup> would not enjoy the full panoply of right and remedies that authors and copyright owners of other artistic works have.

Different solutions are possible to mitigate the deleterious and unfortunate consequences of protecting tattoos in the same way as any other artistic work. This article explores the possible solutions.

## Are tattoos protected by copyright?

It is clear that in New Zealand tattoos would be protected by copyright. Before a tattoo artist begins a tattoo the artist will use a pre-existing drawing (a flash) or will create a new drawing (a custom tattoo). Provided the drawing is original,<sup>15</sup> it will be protected as an artistic work under the Copyright Act 1994.<sup>16</sup> In addition, or in

<sup>1</sup> A. Perzanowski, "Tattoos and IP Norms" (2013–14) 98 Minn. L. Rev. 511, 572.

<sup>2</sup> There are issues surrounding the use of Māori designs or Māori-inspired designs for tattoos, but these are not covered in this article.

<sup>3</sup> See, for example, R. Merges, "What Can We Learn from IP's 'Negative Spaces'?" (9 December 2013), [http://www.mediainstitute.org/IPI/2013/120913.php#\\_ftn4](http://www.mediainstitute.org/IPI/2013/120913.php#_ftn4) [Accessed 29 June 2016]; and E. Rosenblatt, "A Theory of IP's Negative Space" (2011) 34 *Columbia Journal of Law & the Arts* 317, 332.

<sup>4</sup> See generally, Perzanowski, "Tattoos and IP Norms" (2013–14) 98 Minn. L. Rev. 511; M. Beasley, "Who owns your skin: Intellectual Property Law and norms among tattoo artists" (2011–12) 85 *Southern Californian Law Review* 1137.

<sup>5</sup> See Perzanowski, "Tattoos and IP Norms" (2013–14) 98 Minn. L. Rev. 511, 344.

<sup>6</sup> Perzanowski, "Tattoos and IP Norms" (2013–14) 98 Minn. L. Rev. 511, 536–538.

<sup>7</sup> Perzanowski, "Tattoos and IP Norms" (2013–14) 98 Minn. L. Rev. 511, 538.

<sup>8</sup> See, for example, C. Lesicko, "Tattoos as visual art: How the body fits into the Visual Artists Rights Act" (2013) 53 *IDEA* 39, 43.

<sup>9</sup> In September 2015 it was estimated that in Australia the tattoo industry had revenues of \$100m (Australian), <http://www.ibisworld.com.au/industry/tattoo-studios.html> [Accessed 29 June 2016].

<sup>10</sup> See Beasley, "Who owns your skin" (2011–12) 85 *Southern Californian Law Review* 1137, 1139–1140.

<sup>11</sup> See Merges, "What Can We Learn from IP's 'Negative Spaces'?" (9 December 2013), [http://www.mediainstitute.org/IPI/2013/120913.php#\\_ftn4](http://www.mediainstitute.org/IPI/2013/120913.php#_ftn4) [Accessed 29 June 2016]; and E. Rosenblatt, "A Theory of IP's Negative Space" (2011) 34 *Columbia Journal of Law & the Arts* 317, 332.

<sup>12</sup> M. Nimmer and D. Nimmer, *Nimmer on Copyright* (New York: Matthew Bender, 1999), §1.01[B][1][i] n.392.

<sup>13</sup> See Declaration of David Nimmer in *Whitmill v Warner Bros Entertainment Inc*, No. 4:11-cv-00752 (ED Mo May 20, 2011), filed May 30, 2011, at [15]–[17], <http://documents.mx/documents/whitmill-v-warner-bros-declaration-of-david-nimmer.html> [Accessed at on 27 May 2016].

<sup>14</sup> The tattoo artist will often be the copyright owner of the tattoo, but not always (see below). However, even if the tattoo artist does not own the copyright, the tattoo artist will normally have moral rights over the tattoo (see below).

<sup>15</sup> New Zealand's (and also the UK's) required level of originality is low. However, the lower the level of originality, the lower the level of protection: see *Henkel KGaA v Holdfast New Zealand Ltd* [2006] NZSC 102; [2007] 1 N.Z.L.R. 57 at [38].

<sup>16</sup> Copyright Act 1994 s.14(1)(a).

the rare case where the tattoo is not drawn (or recorded in some way) before the tattoo is inked on to the client's skin,<sup>17</sup> the tattoo itself could be regarded as a drawing or painting. To be sure, the courts have not decided definitively as to whether a tattoo on skin satisfies the fixation requirement. For example, face paint applied to the singer Adam Ant in *Merchandising Corp of America Inc v Harpbond Ltd*<sup>18</sup> was found not capable of being an artistic work. That case is distinguished easily. A tattoo—as many people find out to their chagrin—is more permanent than a line drawing by pencil on paper. While a tattoo can be removed by laser surgery or even a skin graft, pencil marks can be rubbed out.

### Who owns the copyright in tattoos created by tattoo artists?

As indicated above, tattoos fall into two main types, flashes and custom tattoos. Flashes are tattoos that are drawn or printed on paper or cardboard by a tattoo artist. The tattoo artist can display them in his or her shop for potential clients to choose from or draw inspiration from when designing a new tattoo. Tattoo artists often sell flashes to other tattoo artists to use. The ownership of copyright in flashes depends on the circumstances in which the drawing was made. While the general rule is that the author of the drawing will be the owner of the copyright in it,<sup>19</sup> if the tattoo artist was an employee of a tattoo parlour, the employer will be the copyright owner of the tattoo,<sup>20</sup> unless there was an agreement to the contrary in the contract between employer and the tattoo artist that provided that the tattoo artist would be the copyright owner of drawings that he or she made.<sup>21</sup>

Custom tattoos are tattoos designed specifically for the client and raise different issues of ownership. If there is no clause in the contract between tattoo artist and client setting out the ownership of the copyright in the tattoo, the client may be found to be a joint author of the copyright as it is common for the tattoo artist and client to collaborate in the design of a custom tattoo.<sup>22</sup> Often the tattoo artist will provide initial sketches to the client, the

client will suggest changes, and the design will be refined through an iterative approach.<sup>23</sup> However, even if there is joint authorship, again the contract between tattoo artist and client can provide that the tattoo artist (or employer) owns the copyright in the tattoo. Of course, if the client had no or very limited input into the final design of the tattoo, the tattoo artist (or his or her employer) would be the sole author of the copyright in the tattoo.

Notwithstanding the above, ownership of custom tattoos becomes more complicated in New Zealand because the commissioning rule reverses the normal rule that the author is the first owner of copyright.<sup>24</sup> Under the commissioning rule the client, as the commissioner, owns the copyright in the work,<sup>25</sup> unless, of course, this default rule is contracted out of.<sup>26</sup> Thus in New Zealand the client will be the copyright owner, unless the tattoo artist (or the tattoo artist's employer) states in its contract with the client that the tattoo artist (or employer) owns the copyright in the tattoo. In contrast, in the UK, the Copyright, Designs and Patents Act 1988 contains no commissioning rule.<sup>27</sup>

### Moral rights

If an original tattoo has been created, as an artistic work—whether it is a drawing or painting—the tattoo artist as the author will have moral rights over the tattoo regardless of the ownership of the copyright in the tattoo.<sup>28</sup> The key moral rights in this context are the right of integrity,<sup>29</sup> the right of attribution<sup>30</sup> and to a lesser extent the right not to be falsely attributed as the author.<sup>31</sup> The tattoo artist can agree to waive her rights<sup>32</sup>; however, given that clients will sign contracts prepared by the tattoo artist (or her employer) and not by the client, it is unlikely that such contracts will contain clauses waiving moral rights. In addition, if the client had more than minimal input into the tattoo's design so that she was a joint author, both the tattoo artist and client will hold moral rights.<sup>33</sup> Again the contract can provide that the client waives her moral rights.

<sup>17</sup> See Perzanowski, "Tattoos and IP Norms" (2013) 14 Minn. L. Rev. 511, 526, who notes that while tattooing directly on to a client without producing a drawing before is rare, it does happen.

<sup>18</sup> *Merchandising Corp of America Inc v Harpbond Ltd* [1983] F.S.R. 32 CA (Civ Div).

<sup>19</sup> Copyright Act 1994 s.21(1); Copyright, Designs and Patents Act 1988 s.11(1).

<sup>20</sup> Copyright Act 1994 s.21(2); Copyright, Designs and Patents Act 1988 s.11(2).

<sup>21</sup> Copyright Act 1994 s.21(4); Copyright, Designs and Patents Act 1988 s.11(2)—this is an unlikely state of affairs, but not impossible.

<sup>22</sup> See <http://www.tattoo.com/blog/artist-process-custom-tattoo-designs> [Accessed 29 June 2016].

<sup>23</sup> See for example, Christopher A. Harkins, "Tattoos and Copyright Infringement: Celebrities, Marketers, and Businesses Beware of the Ink" (2006) 10 *Lewis & Clark Law Review* 313, 315.

<sup>24</sup> Copyright Act 1994 s.21(3).

<sup>25</sup> Copyright Act 1994 s.21(3). The commissioning rule also covers other works which are not relevant to this article, such as computer programs, diagrams, maps, charts, engravings, models, sculptures, films and sound recordings.

<sup>26</sup> Copyright Act 1994 s.21(4). The continuation of the commissioning rule in New Zealand was explored in 2006 and 2007 with the Ministry of Economic Development releasing a Discussion Paper, "The Commissioning Rule, Contracts and the Copyright Act 1994" (Ministry of Economic Development, March 2006). The resulting Bill, the Copyright (Commissioning Rule) Amendment Bill, proposed removing the commissioning rule so that the author was the owner of the copyright in the work. The Bill was withdrawn on 16 April 2009.

<sup>27</sup> There was a partial commissioning rule in s.4(3) of the Copyright Act 1956 (UK); however, this was not carried over to the Copyright, Designs and Patents Act 1988 (UK).

<sup>28</sup> See Copyright Act 1994 Pt 4.

<sup>29</sup> Copyright Act 1994 s.98; Copyright, Designs and Patents Act 1988 s.80.

<sup>30</sup> Copyright Act 1994 s.94; Copyright, Designs and Patents Act 1988 s.77.

<sup>31</sup> Copyright Act 1994 s.102; Copyright, Designs and Patents Act 1988 s.84.

<sup>32</sup> Copyright Act 1994 s.107; Copyright, Designs and Patents Act 1988 s.87.

<sup>33</sup> See, for example, Copyright Act 1994 s.108(4) "The right conferred by section 98 [the right of integrity] is, in the case of a work of joint authorship, a right of each joint author" (see also Copyright, Designs and Patents Act 1988 s.88(1)). See also Copyright Act 1994 s.108(2): "A consent or waiver under section 107 by one joint author does not affect the rights of the other joint authors"; and Copyright, Designs and Patents Act 1988 s.88(3).

## Examples of tattoo artists attempting to sue

The possibility of tattoo artists suing for copyright infringement is not theoretical. Tattoo artists have threatened to sue and some have commenced legal proceedings. The tattoo artist who created a number of tattoos for the footballer David Beckham threatened to sue Beckham if he went ahead with his plans of featuring his guardian angel tattoo in a promotional campaign.<sup>34</sup> The case did not go to court, and was presumably settled.<sup>35</sup>

In *Allen v Electronic Arts Inc.*,<sup>36</sup> a former Maimi Dolphins running back, Ricky Williams, had a tattoo created by Stephen Allen on his bicep. The cover of the video game maker's "NFL Street" video game depicted Williams running while holding a football with his tattoo visible, and the tattoo was also depicted clearly on his character in the game. Similarly, a tattoo artist complained about the use of a lion tattooed on the welterweight fighter Carlos Condit in a video game.<sup>37</sup>

In *Reed v Nike*,<sup>38</sup> Reed's tattoo on the former NBA player Rasheed Wallace was featured in an advertisement for Nike.<sup>39</sup> A computerised simulation showed the tattoo being created, with Wallace describing and explaining the tattoo's meaning.<sup>40</sup> The case was subsequently settled out of court.

In *Whitmill v Warner Bros Entertainment Inc.*,<sup>41</sup> a depiction of Whitmill's tattoo he had created for Mike Tyson was used on an actor's face in the movie *The Hangover Part II*. The tattoo on the actor's face was a reference to the earlier movie *The Hangover*, in which Tyson had appeared with his distinctive facial tattoo. Whitmill sought an injunction to prevent the release of the film as well as damages of \$US30 million. The court refused to grant an injunction as the defendant had spent a considerable amount advertising the movie and the movie theatres were relying on its stated release date.<sup>42</sup>

## Potential issues with affording full protection to tattoos

If tattoo artists have the normal bundle of copyright rights, the use of the tattoos in all the above examples would have infringed copyright. While it is difficult to defend the use of the tattoo in the Tyson case, the remaining scenarios, with the possible exception of the Nike advertisement in *Reed v Nike*, should be considered

clearly non-infringing. As the examples of the sporting stars show, the ability for them to be able to portray their bodies, or have others portray them, would be limited.

Although none of the scenarios outlined above concerned moral rights,<sup>43</sup> moral rights are the low hanging fruit as to why tattoo artists cannot be afforded full protection under copyright law. Even if the client owns the copyright in the tattoo or jointly owns copyright in the tattoo, the tattoo artist's enforcement of her moral rights could result in the client being limited as to what she wished to do with her tattoo. Unless the tattoo artist has waived her moral rights, the right of integrity may come into play if the client decides to make changes or additions or even touch-ups to her tattoo. If the tattoo artist has a reputation, as many tattoo artists do, and the change or addition damages the reputation of that tattoo artist, the original tattoo artist could sue for a breach of their right of integrity. The remedies for breach of the right of integrity are problematic. In *Snow v Eaton Centre Ltd*<sup>44</sup> the aggrieved author was granted an injunction, in that case removing Christmas decorations that adorned his majestic flying geese sculptures. Removing an alteration to a tattoo would be rather more invasive: it is not a simple procedure to remove alterations to tattoos.

Moral rights are not the only occasion when remedies raise concerns. A normal remedy for copyright infringement is for delivery up of infringing copies. If a tattoo artist tattooed a client without the copyright owner's permission and that tattoo artist was sued successfully by the copyright owner, what would delivery up look like? It is difficult to see the offending body part (or the skin from the offending body part) or the client in full being delivered to the copyright owner.<sup>45</sup> Even a lesser order of a skin graft or laser surgery would be unpalatable.

## Arguments for and against limiting the protection of tattoos

The argument for limiting the protection of tattoos is because tattoos are inked permanently on a person's skin. Thus tattoos are fundamentally different from other types of artistic work. If the tattoo artists identified above were successful in copyright infringement actions, it would have the effect of preventing tattooed people from having their tattoos visible when photographed, filmed, drawn or used when their likenesses are used in games or on

<sup>34</sup> See "I Own the Beck's Tattoo ... and I'll Sue" (27 June 2005, updated 8 March 2012), *Mirror*, <http://www.mirror.co.uk/3am/celebrity-news/exclusive-i-own-becks-tattooand-ill-sue-548295> [Accessed 29 June 2016].

<sup>35</sup> See <http://www.inkedmag.com/articles/who-owns-your-tattoo/> [Accessed 29 June 2016].

<sup>36</sup> *Allen v Electronic Arts Inc* No.5:12-V-3172 (W.D. La filed 31 December 2012).

<sup>37</sup> See <http://www.polygon.com/2012/11/17/3658658/tattoo-artist-sues-thq-over-ufc-undisputed-3> [Accessed 29 June 2016].

<sup>38</sup> *Reed v Nike* 2005 WL 1182840, No.CV-00198, (D. Or. 10 February 2005) (dismissed October 19, 2003).

<sup>39</sup> For a detailed discussion of the litigation in *Reed v Nike* see Harkins, "Tattoos and Copyright Infringement" (2006) 10 *Lewis & Clark Law Review* 313. For the advertisement, see <https://www.youtube.com/watch?v=RqmRu34PXrU> [Accessed 29 June 2016].

<sup>40</sup> Harkins, "Tattoos and Copyright Infringement" (2006) 10 *Lewis & Clark Law Review* 313, 316.

<sup>41</sup> *Whitmill v Warner Bros Entertainment Inc* 2011 WL 2038147 (E.D. Mo. 28 April 2011), dismissed, No.4:11-CV-752 CDP (E.D. Mo. June 22, 2011).

<sup>42</sup> See Noam Cohen, "Citing Public Interest, Judge Rules for 'Hangover II'", *New York Times*, 24 May 2011; see <http://www.iposgoode.ca/2011/05/legal-hangover-for-warner-bros-over-mike-tyson-tattoo/> [Accessed 29 June 2016].

<sup>43</sup> While the US generally does not grant moral rights to its authors, some authors can obtain moral rights under the Visual Artists Rights Act 1990 and it is arguable that tattoo artists are protected under this Act; see, for example, Lesicko, "Tattoos as visual art" (2013) 53 *IDEA* 39, 43, 53–56.

<sup>44</sup> *Snow v Eaton Centre Ltd* (1982) 70 C.P.R. (2d) 105.

<sup>45</sup> See Annisley Merelle Ward, "Letter from AmeriKat: Happy Cinco de Mayo!" (5 May 2011), *IPKat*, <http://ipkitten.blogspot.com/nz/2011/05/letter-from-amerikat-happy-cinco-de.html> [Accessed 29 June 2016].

figurines—not to mention the resulting invasive medical treatment if orders were made to remove or alter the tattoo.

Indeed, as the examples of the sports people above exemplify, the value of the tattoo is not dependent solely on the genius and fame of the tattoo artist; rather the value of the tattoo often depends on the canvas to which it is applied. In *Reed v Nike*, the tattoo artist accepted a low price for the tattoo because he calculated that as the tattoo artist of a prominent tattoo on an NBA player he would receive considerable exposure and recognition.<sup>46</sup> The tattoo artist's expectation and desire was precisely that the tattoo on his client's arm would be displayed publicly. Indeed, the point for most people now in getting a tattoo is that other people can see it, and people with tattoos are offended when they are forced to cover their tattoos.<sup>47</sup> Moreover, as we have seen, often custom tattoos are the product of input from both tattoo artist and client.

No doubt some will respond and argue that contract is the answer. If the clients want to flaunt their tattoos they must secure such rights through contract.<sup>48</sup> It is difficult to have any sympathy for wealthy sports stars and other celebrities who fail to receive accurate professional advice before entering into transactions. However, leaving private ordering to resolve the problem is an impoverished means of resolving the issue.<sup>49</sup> Private ordering presupposes the client was a rational actor fully aware of all the implications of copyright and contract law, which will rarely be the case for the average person who should not require legal advice to enter into what is now a commonplace transaction. If the client failed to secure the necessary rights at the outset, a tattoo artist may refuse to assign the copyright to the client at a later stage, let alone waive some of her rights. Such a refusal is more likely to occur if the client obtained the tattoo at a time they were unknown and subsequently became well known. Alternatively, even if the tattoo artist was prepared to waive some or all of her rights, the price for doing so may be so high that the client is forced to cover their body in certain situations or to go through painful surgery to remove the tattoos. Finally, and more concerning, private ordering would also mean that a client who had created the drawing for the design inked on to

her skin without any authorial input from the tattoo artist could also be stripped unknowingly of her copyright by a clause in the contract to that effect.<sup>50</sup>

Another argument against treating tattoos differently is that all artistic works should be treated the same: authors of certain kinds of artistic works should not be discriminated against. For example, the Act does not draw distinctions between different types of drawings or paintings: oil paintings are not accorded any more protection than water colours or pencil drawings. Yet, as we have seen, there are justifiable reasons why tattoos must be treated differently from other forms artistic works. Indeed, it is not a case that all works within the same categories are treated the same. While authors of literary works enjoy the right of attribution<sup>51</sup> and the right of integrity,<sup>52</sup> computer programmers do not.<sup>53</sup> Other differences in the treatment of works abound. For example, s.73 specifically limits the rights of copyright owners in sculptures. Under s.73, if a sculpture is in a public place, copyright is not infringed if two-dimensional copies of the work are made.<sup>54</sup>

The potentially strongest argument against limiting the rights of tattoo artists is that it would contravene the three-step Berne test.<sup>55</sup> Exceptions are permitted to allow for the reproduction of works in certain special cases, if the reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author. The hurdle of the three-step test is not insurmountable. A number of new exceptions in copyright legislation which are arguably broader than an exception for tattoos have been created in recent years. For example, in New Zealand sound recordings can be copied for personal use,<sup>56</sup> and an express defence for parody and satire has been created in both Australia<sup>57</sup> and the UK.<sup>58</sup>

The Berne three-step test would be met easily for tattoos. The exception would be limited to tattoos and not all artistic works. The copyright owner of a tattoo continues to be permitted to prevent others from reproducing the tattoo as artwork. Thus the tattoo artist (or the copyright owner) retains the sole right to dictate and benefit from the sales of merchandising bearing her design. In addition, the tattoo artist (or copyright owner) can sue if another tattoos or reproduces the design on

<sup>46</sup> See Harkins, "Tattoos and Copyright Infringement" (2006) 10 *Lewis & Clark Law Review* 313, 316.

<sup>47</sup> See, for example, [http://www.huffingtonpost.com/sandy-malone/the-body-art-dilemma\\_b\\_4168831.html](http://www.huffingtonpost.com/sandy-malone/the-body-art-dilemma_b_4168831.html) [Accessed 29 June 2016].

<sup>48</sup> See, for example, Harkins, "Tattoos and Copyright Infringement" (2006) 10 *Lewis & Clark Law Review* 313, 328–329. Indeed, in a presentation of this article at a conference, the author was challenged by a member of the audience who had no sympathy for David Beckham.

<sup>49</sup> See <http://iampariah.com/blog/creative-pro/tattoo-artist-vs-nike-a-really-bad-idea.php> [Accessed 29 June 2016].

<sup>50</sup> Provided, of course, that the client signed a contract that assigned the copyright to the tattoo artist. Copyright Act 1994 s.114: "An assignment of copyright is not effective unless it is in writing signed by or on behalf of the assignor"; see Copyright, Designs and Patents Act 1988 s.90(3).

<sup>51</sup> Copyright Act 1994 s.94(1)(a); Copyright, Designs and Patents Act 1988 s.77(1).

<sup>52</sup> Copyright Act 1994 s.98(2)(a); Copyright, Designs and Patents Act 1988 s.80(1).

<sup>53</sup> Copyright Act 1994 ss.97(2)(a) and 100(2)(a), see Copyright, Designs and Patents Act 1988 ss.98(2)(a) and 81(2).

<sup>54</sup> Copyright Act 1994 s.73; Copyright, Designs and Patents Act 1988 s.62. The exception also covers buildings and models for buildings and works of artistic craftsmanship that are permanently situated in a public place or in premises open to the public. See *Radford v Hallensteins Bros Ltd*, High Court, Auckland, CIV 2006-404-004881 (Unreported, Keane J, 22 February 2007) where the defendant had reproduced a photograph of the plaintiff's sculpture in a park on tee shirts that were sold to the public. For a discussion of the defence under s.71, see Anna Kingsbury, "Copyright Law, Designs Law, and the Protection of Public Art and Works on Public Display" (2007) 15 *Waikato Law Review* 79.

<sup>55</sup> Berne Convention for the Protection of Literary and Artistic Works, 9 September 1886, amended 28 September 1979 art.9(2).

<sup>56</sup> Copyright Act 1994 s.81A, copying sound recordings for personal use, inserted by s.44 of the Copyright (New Technologies) Amendment Act 2008.

<sup>57</sup> Copyright Act 1968 (Cth) s.41A. Inserted by Sch.6 to the Copyright Amendment Act 2006 (Cth).

<sup>58</sup> Copyright, Designs and Patents Act 1998 s.30A in inserted by the Copyright and Rights in Performances (Quotation and Parody) Regulations 2014.

another person<sup>59</sup> (unless the person to whom the tattoo was applied was an actor playing the tattoo artist's client in a documentary or biographical movie), albeit the tattoo artist's or copyright owner's rights do not extend to the person to whom the tattoo was wrongfully applied. Finally, the legitimate interests of the tattoo artist are not prejudiced as it is difficult to see how a tattoo artist has a legitimate interest in preventing the realistic depictions and portrayals of her clients or the likenesses of her clients or others who have been wrongfully inked by a tattoo artist. As Kal Raustiala and Christopher Sprigman have argued,

“people with tattoos will move around, appear in public and maybe star in a video game. Copyright law should not provide a way for tattoo artists to restrain the freedom of their clients”.<sup>60</sup>

## The solution

If we accept that it is not desirable for tattoo artists to dictate the manner in which their clients can present themselves or be presented by others to the world, the rights of tattoo artists must be limited. The question is how should this limitation be achieved? A number of different avenues are possible; they are: using the exception of incidental copying; implied licence; public policy or the creation of a statutory exception.

### Incidental copying

The Copyright Act 1994 contains an exception for incidental copying<sup>61</sup>:

“Copyright in a work is not infringed by—

- (a) the incidental copying of the work in an artistic work, a sound recording, a film, or a communication work; or
- (b) the issue to the public of copies of an artistic work, the playing of a sound recording, the showing of a film, or the communication of a work to the public, in which a copyright work has been incidentally copied; or

- (c) the issue to the public of copies of a sound recording, film, or communication work to which paragraph (a) or (b) applies.”

The Act provides no definition of “incidental”. *The Modern Law of Copyright and Designs* notes that “what is ‘incidental’ is a question of fact and degree”.<sup>62</sup> However, the book goes on to note more usefully that

“an important consideration would appear to be whether what has been copied enables the work in which it is included to compete with or act as a substitute for the work that is included”.<sup>63</sup>

The courts have not shed much light on the meaning of incidental.<sup>64</sup> In *Football Association Premier League v Panini UK Ltd*<sup>65</sup> the court resorted to the dictionary definition provided in the *Shorter Oxford English Dictionary*, “occurring as something casual or of secondary importance; not directly relevant to; following as a subordinate circumstance”.<sup>66</sup> While the litigation in *Football Association Premier League* did not deal with tattoos, it did deal with the depiction of football stars on collectable stickers, approximately 2.5 inches by 2 inches, in their playing strip so that their club crests and other works (logos) protected by copyright were often clearly visible. Both the High Court<sup>67</sup> and Court of Appeal<sup>68</sup> were clear that the use of the logos was not incidental. As the High Court observed:

“[The depiction of the logos] is an integral part of the artistic work comprised of the photograph of the professional footballer in his present-day kit. That is the intent behind the reproduction of the photograph. That is what the Defendant intended, and without the badge they would not have the complete picture which they wish to produce, which is, as I say, the footballer as he plays now.”<sup>69</sup>

Applying that reasoning to sports stars who are shown with their tattoos, which their fans and others recognise as being part of the sports stars’ “outfit”, it is difficult to see the tattoo as being viewed as something casual. Moreover, with tattoos on players depicted in video games it would be hard, if not impossible, to convince a court that it was incidental use. Certainly, applying makeup to

<sup>59</sup> The copyright owner of a tattoo could successfully sue for copyright infringement if a television show replicated a tattoo using makeup on an actor in a drama. For an example of makeup being used on an actor to copy a tattoo, see <http://www.hollywoodreporter.com/thr-esq/foxs-american-horror-story-zombie-379219> [Accessed 29 June 2016].

<sup>60</sup> Kal Raustiala and Christopher Sprigman, “Whose tattoo is it anyway” (6 October 2013), Los Angeles Times, <http://www.latimes.com/opinion/op-ed/la-oe-raustiala-tattoo-copyright-20131006-story.html> [Accessed 29 June 2016].

<sup>61</sup> Copyright Act 1994 s. 41(1). The Copyright, Designs and Patents Act 1988 s.31 in relation to the question of tattoos for all intents and purposes is the same as the New Zealand exception, albeit the words “incidental inclusion” are used instead of “incidental copying”. Note, however, that in other situations the difference between “inclusion” and “copying” can result in large differences: see Ian Eagles, “Incidental Copying: The Forgotten Defence to Copyright Infringement” (2004) 10 *New Zealand Business Law Quarterly* 236, 237–238.

<sup>62</sup> Laddie, Prescott and Vitoria: *The Modern Law of Copyright and Designs*, 4th edn (London, LexisNexis, 2011), para.21.57.

<sup>63</sup> Laddie, Prescott and Vitoria: *The Modern Law of Copyright and Designs* (2011), para.21.57.

<sup>64</sup> The cases are thin on the ground: *IPC Magazines Ltd v MGN Ltd* [1998] F.S.R. 431 Ch D; *Thompson v Eagle Boys Dial-A-Pizza Australia Pty Ltd* [2001] FCA 741; *Football Association Premier League v Panini UK Ltd* [2003] F.S.R. 38 Ch D; *Football Association Premier League Ltd v Panini UK Ltd* [2003] EWCA Civ 995, [2004] F.S.R. 1; and *Fraser-Woodward Ltd v BBC* [2005] F.S.R. 36 Ch D. For a discussion of the defence see Eagles, “Incidental Copying” (2004) 10 *New Zealand Business Law Quarterly* 236.

<sup>65</sup> *FAPL v Panini* [2003] F.S.R. 38.

<sup>66</sup> *FAPL v Panini* [2003] F.S.R. 38 at [12].

<sup>67</sup> *FAPL v Panini* [2003] F.S.R. 38.

<sup>68</sup> *FAPL v Panini* [2003] EWCA Civ 995; [2004] F.S.R. 1.

<sup>69</sup> *FAPL v Panini* [2003] F.S.R. 38 at [19].

an actor to replicate a tattoo if the actor was playing the tattoo artist's client in a documentary or movie would not amount to incidental use.

### *Implied licences*

Professor David Vaver, in addressing the facts of the Tyson case, has argued that the courts should use implied licences to mitigate the rigours of copyright law:

“Mr Tyson expected he would have the right to allow people to photograph him without expecting them to have to pay a further fee to the tattooist.”<sup>70</sup>

Vaver goes on to say that it should make no difference whether a photographer paid Mr Tyson for the privilege of photographing him and his tattoo.<sup>71</sup> Thus the implied licence would cover sub-licences.<sup>72</sup> In addition, Vaver observed that the implied licences would also apply to the right of integrity: there would be an implied waiver that would allow the tattoo's wearer to modify or remove the tattoos as he or she thought fit.<sup>73</sup> Vaver, not surprisingly, is just one of a number of advocates for the use of implied licences to limit the rights of tattoo artists.<sup>74</sup>

Even if the courts were prepared to find that implied licences operated, implied licences will not cover all the situations which might reasonably be assumed to be non-infringing. For example, Vaver conceded that implied licences break down if, for example, a movie company wished to make a movie about Mike Tyson without asking his permission.<sup>75</sup> If copyright applied strictly, the movie company, while not having to ask Mike Tyson for his permission to make the movie portraying him, would have to ask the tattoo artist for permission.

Finally, the Achilles' heel with implied licences is that the scope of implied licences will be limited because they can be defeated through contract. If the tattoo artist includes a term that states that the tattoo cannot be reproduced in any medium, the courts will be powerless to find that an implied licence applies. The same argument will apply for moral rights.

### *Public policy*

The courts have an ability not to apply the Copyright Act indiscriminately. Section 225(3) provides that “Nothing in this Act affects any rule of law preventing or restricting

the enforcement of copyright, on the grounds of public interest or otherwise”.<sup>76</sup> The ostensible use of the public policy defence has been used rarely, *Lion Laboratories Ltd v Evans*<sup>77</sup> being a rare exception. The limitation of attempting to use this exception is that, notwithstanding the extreme reluctance of the courts to invoke it,<sup>78</sup> the exception's gravamen is that the plaintiff must have been implicated in wrongdoing, either directly, for example, the work is obscene or unlawful, or the enforcement of copyright would result, as in the case of *Lion Laboratories Ltd v Evans* with potentially innocent people being incarcerated in prison.

### *The New Zealand Bill of Rights Act 1990*

Section 11 of the New Zealand Bill of Rights Act 1990 provides that “Everyone has the right to refuse to undergo medical treatment”. It could be therefore argued that ordering a person to have a tattoo or part of a tattoo removed, for example, by laser surgery or even skin grafts would not be permissible in New Zealand. However, s.11, as with the other rights under the Act, are not absolute. The right under s.11 can be limited “as can be demonstrably justified in a free and democratic society”.<sup>79</sup> There is no certainty therefore that the courts in New Zealand would allow the New Zealand Bill of Rights Act to trump the rights of a copyright owner under the Copyright Act 1994. Even if the New Zealand Bill of Rights Act did trump the Copyright Act it would be limited solely to preventing an order for laser or other surgery.

### *Legislation*

The strength of a legislative solution is that it would remove much of the uncertainty and limitations of implied licences. As we have seen, creating a specific narrow defence for certain reproductions of a tattoo will not conflict with the Berne three-step test. One possible drawback would be the slight lengthening of the Copyright Act. The strength of New Zealand's Copyright Act is its relative brevity, unlike, for example, Australia's Copyright Act.<sup>80</sup> However, the effect of not legislating to prevent the unintended consequences of affording full copyright protection to tattoos outweighs any lengthening of the Act.

<sup>70</sup> See Professor Vaver's comments on <http://www.iposgoode.ca/2011/05/legal-hangover-for-warner-bros-over-mike-tyson-tattoo/> [Accessed 29 June 2016].

<sup>71</sup> See <http://www.iposgoode.ca/2011/05/legal-hangover-for-warner-bros-over-mike-tyson-tattoo/> [Accessed 29 June 2016].

<sup>72</sup> See <http://www.iposgoode.ca/2011/05/legal-hangover-for-warner-bros-over-mike-tyson-tattoo/> [Accessed 29 June 2016].

<sup>73</sup> See <http://www.iposgoode.ca/2011/05/legal-hangover-for-warner-bros-over-mike-tyson-tattoo/> [Accessed 29 June 2016].

<sup>74</sup> See, for example, Lesicko, “Tattoos as visual art” (2013) 53 *IDEA* 39, 43, 49–50, citing Timothy C. Bradley “The Copyright Implications of Tattoos: Why Getting Inked Can Get You into Court” (2011) 29 *Entertainment & Sports Lawyer* 27, 29.

<sup>75</sup> See <http://www.iposgoode.ca/2011/05/legal-hangover-for-warner-bros-over-mike-tyson-tattoo/> [Accessed 29 June 2016].

<sup>76</sup> See, also Copyright, Designs and Patents Act 1988 s.171(3).

<sup>77</sup> *Lion Laboratories Ltd v Evans* [1985] Q.B. 526 CA (Civ Div).

<sup>78</sup> For a general discussion on the public policy exception, see Alexandra Sims, “The Denial of Copyright Protection on Public Policy Grounds” [2008] E.I.P.R. 189.

<sup>79</sup> New Zealand Bill of Rights Act 1990 s.5.

<sup>80</sup> Copyright Act 1962 (Cth). Australia's Act is just over 178,000 words in length excluding schedules. New Zealand's Act excluding schedules is a sprightly 83,700 words. Moreover, New Zealand's statute is even shorter considering that each section is cross-referenced to New Zealand's earlier 1962 Act, plus there are references to the Copyright, Designs and Patents Act 1988, not to mention details of all the amendments to the Act since it came into force over 20 years ago.

The following legislative wording is proposed for New Zealand's Copyright Act. The definition of artistic work would be altered so that "tattoo" would be added to the definition of an artistic work.<sup>81</sup> Secondly, the term tattoo would be defined in s.2 as follows: "tattoo means the insertion of indelible ink into the skin of a person and includes any drawings<sup>82</sup> that underlie the tattoo." The following wording of a new exception would be<sup>83</sup>:

- "(1) Nothing in this Act shall prevent the right of a person (person A)<sup>84</sup> to depict, change, alter or remove a tattoo applied to the skin of person A. Depict means the depiction of the tattoo on person A in any medium or any other person (person B), regardless of whether person A agreed to that depiction or not.
- (2) A person who is tattooed with a tattoo that infringes copyright shall not infringe copyright.
- (3) For the avoidance of doubt, no remedies shall be awarded for any depiction, change, alteration or removal of the tattoo under subsection (1) or against a person under subsection (2).

- (4) A term or condition in an agreement concerning a tattoo has no effect in so far as it prohibits or restricts any activity undertaken in accordance with subsection (1).
- (5) Nothing in this section limits the right of an author under section 94."<sup>85</sup>

## Conclusion

The unfettered protection of tattoos by copyright raises a number of issues that existing copyright law and other legal fictions, such as the use of implied licences, fail to remedy. Legislation is seemingly the best solution. The creation of a specific exception would delineate the rights of the tattoo artist, on the one hand, and on the other the client and others wishing to depict the client accurately. Not to address the issues raised by the unfettered application of copyright law to tattoos risks falling down the rabbit hole.

<sup>81</sup> Copyright Act 1994: "s 2 artistic work—

(a) means—  
 (i) a graphic work, photograph, sculpture, collage, or model, irrespective of artistic quality; or  
 (ii) a work of architecture, being a building or a model for a building; or  
 (iii) a work of artistic craftsmanship, not falling within subparagraph (i) or subparagraph (ii);  
 [(iv) a tattoo]."

<sup>82</sup> In *Radford v Hallensteins* High Court, Auckland, CIV 2006-404-004881 (2007), the plaintiff attempted to argue that s.73 of the Copyright Act, which allows two dimensional copies of sculptures that are situated in public places, does not make any express statement that the exception extends to any drawings that underlie the sculpture, thus as drawings underlay the sculpture the defendant was unable to come within the exception. The High Court, sensibly found that to take the plaintiff's interpretation was not practical and defied logic: at [37]–[38].

<sup>83</sup> The logical place for the defence would be the creation of a s.73A, 74A, or s74A as all those sections relate to specific narrow defences.

<sup>84</sup> In New Zealand it is becoming increasingly common in legislation to clearly delineate between people. For example, s.10 of the Accident Compensation Act 2001 refers to person A and person B.

<sup>85</sup> This would allow for the tattoo's author to be identified as the author of the tattoo, provided, of course, that the author had asserted her rights under s.96.