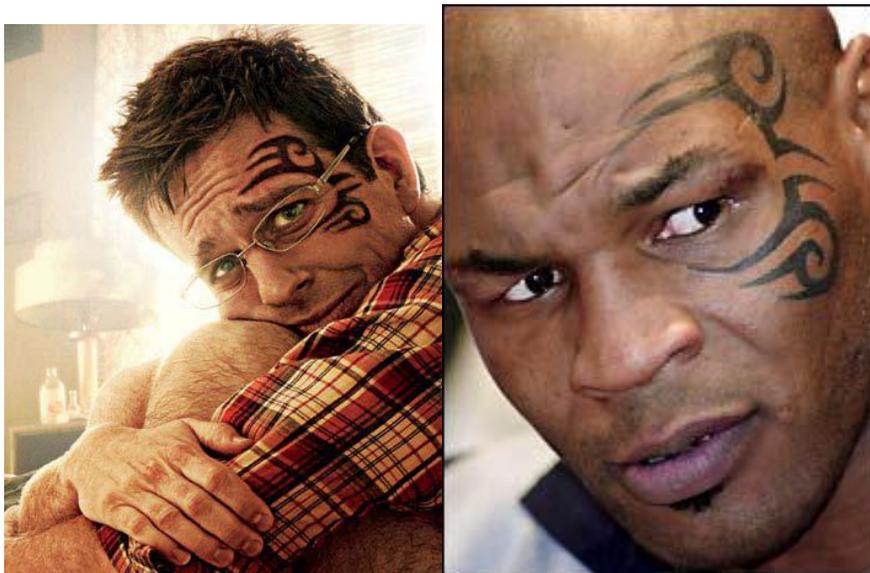


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[Tattoos & Hangovers: The Headache of Competing IP Rights](#)

Posted on June 2, 2011 by [Steve Baird](#)



A month ago the [hot news](#) was the federal [copyright infringement lawsuit](#) filed by Mike Tyson's facial tattoo artist S. Victor Whitmill against Warner Brothers Entertainment, and Whitmill's [attempt to block the Memorial Day release](#) of the highly anticipated blockbuster sequel movie [The Hangover Part II](#), based on the film maker's unauthorized reproduction and/or derivative of the tattoo design permanently inked on Tyson's face, but still owned by the artist and creator of the design.

[More recently](#), within the last week, the hot related news was [the federal court's decision to deny](#) Whitmill's [motion for a preliminary injunction](#) (brought to prevent the release of the film), but in reluctantly permitting the film's timely release Chief Judge Catherine D. Perry seemed to foreshadow the likelihood of Warner Brothers [paying dearly](#) for not inking and negotiating a copyright license in advance.



What I find most interesting about the fact pattern of this lawsuit and the many presently unknown facts is the all-too-common potential for overlapping and competing intellectual property rights to the underlying subject matter in question -- in this case, an artistic design that is copyrightable as an original work of authorship, and it also may function as a trademark or service mark, much like a logo or visual element of a brand. And, because the design now forms a permanent part of the visual appearance, persona, and likeness of a famous individual, it may also function as an element or aspect of Mike Tyson's right of publicity.

When all possible intellectual property rights are bundled together and neatly owned by one party it permits the single owner to fully exploit the subject matter in a variety of ways by relying on multiple and differing legal rights, theories, and remedies. It gets pretty interesting, however, when not all of the intellectual property rights are owned by the same party -- and, that's when talented IP lawyers are needed to sort it all out, hopefully well in advance of the need for any enforcement.

For example, had Mike Tyson obtained ownership of the copyright for the tattoo design from the artist -- legally possible either through a written assignment or a valid written work-for-hire agreement -- Tyson would most likely be in control of not only the design as a [trademark](#), and not only as an element of his right of publicity, but also as the separate and underlying copyright in the design. Making copyright ownership part of Tyson's bundle of intellectual property rights would make control and exploitation of the design easier since no likelihood of confusion is necessary to prove copyright infringement, as is the case when enforcing trademark rights against infringement.

In addition, one might wonder whether Tyson's failure to secure the copyright to the tattoo design will be a long-term, career-limiting move, with the prospect of Whitmill tagging along and having potential legal claims every time Tyson is engaged to make an appearance or public performance. Time will tell whether third parties will simply decide in favor of avoiding the risk of even bogus legal claims.

Similarly, tattoo artist Whitmill could have enhanced his bundle of intellectual property rights had he licensed the tattoo design to Tyson to use as a trademark and/or service mark, so that all use of the design by Tyson as a trademark and service mark and all associated goodwill would inure to the benefit of Whitmill, not Tyson. Then, Whitmill would only have to contend with Tyson's potentially conflicting right of publicity.

As it appears to stand, Whitmill owns the underlying copyright in the tattoo design, while Tyson clearly owns his right of publicity (which may include the facially-inked tattoo design as a visual element of his persona) and Tyson also appears poised to own the tattoo design as a trademark for a variety of goods and services. As a result, Tyson potentially may get into copyright trouble if he displays the copyrighted tattoo design in a way, manner, or context not contemplated by the parties when the design was applied to his face. While it seems likely there is an implied copyright license to Tyson, since it is now part of his face, the limits of any implied license and the details and reasonable scope of such a license remain unclear.



So, let's not forget that intellectual property rights can be complicated, restrained, and/or limited by contract. The contract could have both express and implied terms. For example, by applying the tattoo design to Tyson's face, even if it is not expressed in writing, Whitmill most likely has granted an implied and irrevocable license under the copyright to publicly display the tattoo design, at least, as it appears on Mike Tyson's face. Moreover, Whitmill could have considered extracting a promise from Tyson in a written agreement not to use or claim trademark rights in the design, [but that doesn't appear to have happened](#), and it is not the kind of term that ordinarily would be implied.

So, what about third-party photographers who have taken pictures of Mike Tyson's inked face? Absent a written assignment or a work-for-hire agreement, the photographer, as the legal author, automatically would own the copyright in his photos, but what can he do with them? Seems likely he or she can sell artistic prints of the photos, or perhaps, even publish an artistic book of the photos, probably without permission, but, as to selling merchandise bearing the photo -- that kind of use is likely to draw fire from Tyson's right of publicity and perhaps his trademark rights too.

What do you think of this potentially tangled web of competing intellectual property rights?

Does it give you a headache without the possible benefit of what might have preceded a well-earned hangover?

