

***Whitmill v Warner Bros.* and the Visibility of Cultural Appropriation Claims in Copyright Law**

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The Māori-inspired tattoo at the heart of the copyright infringement case of Whitmill v Warner Bros. has attracted allegations of cultural appropriation in Aotearoa/New Zealand. An examination of the Māori cultural appropriation claim that surrounds the tattoo and its invisibility throughout the Whitmill v Warner Bros. legal proceedings, shows how the legal system does not receive Indigenous cultural claims over the cultural imagery and arts styles that inspires outsider imagery as an intellectual property interest.

Introduction

The United States case of *Whitmill v Warner Bros.*¹ is one of a few litigated examples of tattoo copyright infringement in the western world. While *Whitmill* settled prior to a full trial, recent academic commentary has discussed its relevance for tattoos as copyrightable subject matter and the unique challenges that tattoos raise for copyright doctrine because of their position on the human body.² Largely unexplored, however, has been the relevance of the case for Indigenous cultural and intellectual property claims.³ The tattoo at the heart of the *Whitmill* litigation is a Māori-inspired, tribal tattoo design. It has been reported as the cultural appropriation of Māori cultural tattoos known as “moko” in news media in Oceania since it was first inked in 2003.⁴ This article explores the social and legal narratives that surround this

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¹ *Whitmill v Warner Bros. Entertainment* (ED Mo, No. 4:11-CV-752, complaint dismissed 22 June 2011). Hereafter “*Whitmill*”.

² See, e.g. Y. King, “The Challenges “Facing” Copyright Protection for Tattoos” (2013) 92 OLR 129-162; Y. King, “The Enforcement Challenges For Tattoo Copyrights” (2014) 22(1) J Intell Prop L 29-42; Y. King, “The Right-Of-Publicity Challenges For Tattoo Copyrights” (2016) 16(2) Nev LJ 441-466; A. Sims, “The perils of full copyright protection for tattoos” (2016) 38(9) E.I.P.R. 570-576; D. Cummings, “Creative Expression and the Human Canvas: An Examination of Tattoos as a Copyrightable Art Form” (2013) (Winter) U Ill L Rev 279-318; M. Hatic, “Who Owns Your Body Art?: The Copyright and Constitutional Implications of Tattoos” (2013) 23 Fordham Intell Prop Media & Ent LJ 396-435; T. Bradley, “The Copyright Implications of Tattoos” (2012) 29(5) GP Solo 68-69.

³ A notable exception is L. Tan, “Intellectual Property Law and the Globalization of Indigenous Cultural Expressions: Māori Tattoo and the Whitmill versus Warner Bros. Case” (2013) 30(3) Theory Cult Soc 61-81.

⁴ See, e.g., “Concern over ignorant use of Maori moko” (27 February 2003), *New Zealand Herald*, https://www.nzherald.co.nz/nz/news/article.cfm?c_id=1&objectid=3198136 [Accessed 24 July 2019]; “Celebrity tattoos rile Maoris” (28 February 2003), *The Age*, <https://www.theage.com.au/articles/2003/02/27/1046064152066.html> [Accessed 24 July 2019]; “Tyson tat criticised” (27 February 2003), *Sydney Morning Herald*, <https://www.smh.com.au/articles/2003/02/27/1046064156056.html> [Accessed 24 July 2019]; “Iron Mike Riles Maoris” (28 February 2003), *Daily Telegraph*, p.23; “Maori Academics Take Exception to Mike Tyson’s New Facial Tattoo” (27 February 2003), *Agence France-Presse*; “Maori Counter” (22 February 2003), *Daily Post*,

tattoo as an unauthorised use of Māori culture and as a legal object that is protected by copyright. It considers what copyright law sees, or more accurately does not see, of Indigenous rights claims over the cultural motifs and arts styles that are used as reference material by outsider artists.

This article will outline the controversy that surrounds the Whitmill tattoo, before discussing the property rights framework deployed throughout the *Whitmill v Warner Bros.* legal proceedings. The article will then discuss how the formal legal system entrenches the marginalisation of cultural claimants as a class of potential property owners in Indigenous-inspired imagery.

Whitmill tattoo

In the lead up to a highly anticipated world title fight with Lennox Lewis in 2002, boxer Mike Tyson was asked if he planned to do anything differently if he won his third title. He responded, “Oh, God, if I win the title, I might tattoo my face.”⁵ While Tyson was ultimately defeated via knockout in the eighth round,⁶ eight months later he proceeded with his tattoo plan. Las Vegas tattooist S Victor Whitmill designed and tattooed Tyson with an abstract curvilinear “warrior” design.⁷ According to Whitmill, the design is an “American tribal” tattoo “inspired by some of the movement that you would see in a Māori piece”.⁸ The completed design wraps around Tyson’s left eye, utilises a collection of curvilinear lines, and features two spiral shapes in the negative space between the pigmented lines. At the point of sale, Tyson signed a “Tattoo Release” document confirming Whitmill’s copyright ownership of the image.⁹

On February 22, 2003, Tyson’s facial tattoo was unveiled to the public during a fight against Clifford “The Black Rhino” Etienne.¹⁰ Within the week, the design was reported to be misappropriative of tā moko;¹¹ the cultural tattooing practices of the Māori people of

p.4; “Tyson’s moko draws fire from Maori” (25 May 2011), *New Zealand Herald*, https://www.nzherald.co.nz/nz/news/article.cfm?c_id=1&objectid=10727836 [Accessed 24 July 2019].

⁵ B. Pennington, “As Bout Nears, Tyson Displays Charming Side” (6 June 2002), *New York Times*, <http://www.nytimes.com/2002/06/06/sports/boxing-as-bout-nears-tyson-displays-charming-side.html?mcubz=0> [Accessed 24 July 2019]. See also J. Saraceno, “Tyson shows good-guy side with lids” (6 June 2002), *USA Today*, <https://usatoday30.usatoday.com/sports/comment/saraceno/2002-06-06-saraceno.htm> [Accessed 24 July 2019].

⁶ P. Connor, “June 8, 2002: Lewis vs Tyson” (8 June 2018), *The Fight City*, <https://www.thefightcity.com/june-8-2002-lewis-vs-tyson-mike-tyson-lennox-lewis-muhammad-ali-george-foreman-evander-holyfield-heavyweight-championship/> [Accessed 24 July 2019].

⁷ Transcript of Proceedings, *Whitmill v Warner Bros. Entertainment* (Eastern District Court of Missouri, Perry J, 23 May 2011) document 55, 14 (S.V. Whitmill); “Mike Tyson: The Real Story Behind My Tattoo” (1 December 2012) *Indepth with Graham Bensinger*, <https://screen.yahoo.com/mike-tyson-real-story-behind-190521076.html> [Accessed 10 April 2013].

⁸ Transcript of Proceedings (2011), document 55, 17 (S.V. Whitmill).

⁹ This document does not specifically mention the words “copyright” or “intellectual property” however its purpose to confirm Whitmill’s ownership of intellectual property rights is clear: see “Paradox- Studio of Dermagraphics: Tattoo Release Form” in S.V. Whitmill, “Verified Complaint for Injunctive and Other Relief” in *Whitmill v Warner Bros. Entertainment* (ED Mo, No. 4:11-CV-752, 28 April 2011), Exhibit 3.

¹⁰ To give an indication of the degree of exposure of the viewing public to the tattoo’s first public appearance, the fight was purchased by 100,000 viewers on pay-per-view. As at July 2017, one upload of the fight had been viewed on YouTube 4.5 million times.

¹¹ See, e.g., “Concern over ignorant use of Maori moko” (27 February 2003), *New Zealand Herald*, https://www.nzherald.co.nz/nz/news/article.cfm?c_id=1&objectid=3198136 [Accessed 24 July 2019]; “Celebrity tattoos rile Maoris” (28 February 2003), *The Age*, <https://www.theage.com.au/articles/2003/02/27/1046064152066.html> [Accessed 24 July 2019]; “Tyson tat

Aotearoa/New Zealand. Māori cultural tattoos, known as moko, are abstract, typically curvilinear designs that incorporate spiral motifs called korus, flow around the contours of the body, and make use of both positive and negative space.¹²

Tyson's identity as a controversial public figure was initially objected to as much as the tattoo's composition as an unauthorised and illegitimate use of Māori culture. For example, Māori politician and academic Dr Pita Sharples stated that he did not like seeing a design similar to moko on Tyson because of his "criminal past".¹³ In the years that followed, the tattoo, alongside others such as the moko worn by British performer Robbie Williams, became emblematic of the global pillaging of Māori culture.¹⁴ Thus, when Whitmill lodged his copyright infringement claim against Warner Bros. in 2011 a month prior to the scheduled release of the film "The Hangover Part II", cultural appropriation discourse again loomed large, with frustration expressed in news media that a foreigner could hold copyright in an image that owed a debt to Māori culture. Māori arts expert Ngahua Te Awekotuku in particular was scathing in her critique of the litigation:

"It is astounding that a Pakeha tattooist who inscribes an African American's flesh with what he considers to be a Māori design has the gall to claim ... that design as his intellectual property...

The tattooist has never consulted with Maori, has never had experience of Maori and originally and obviously stole the design that he put on Tyson.

The tattooist has an incredible arrogance to assume he has the intellectual right to claim the design form of an indigenous culture that is not his."¹⁵

This critique implies that Whitmill copied an existing moko design, yet no source image has ever been identified. This article proceeds on the basis that the theft referred to in the appropriation allegations is the unauthorised adoption of a recognisably Māori design form.¹⁶

criticised"(27 February 2003), *Sydney Morning Herald*, <https://www.smh.com.au/articles/2003/02/27/1046064156056.html> [Accessed 24 July 2019]; "Iron Mike Riles Maoris" (28 February 2003), *Daily Telegraph*, p.23; "Maori Academics Take Exception to Mike Tyson's New Facial Tattoo" (27 February 2003), *Agence France-Presse*; "Maori Counter" (22 February 2003), *Daily Post*, p.4.

¹² See generally the leading contemporary study of moko N.T. Awekotuku and L.W. Nikora, *Mau Moko: The World of Māori Tattoo* (Auckland: Penguin, 2011).

¹³ "Concern over ignorant use of Maori moko" (27 February 2003), *New Zealand Herald*, https://www.nzherald.co.nz/nz/news/article.cfm?c_id=1&objectid=3198136 [Accessed 24 July 2019]; "Celebrity tattoos rile Maoris" (28 February 2003), *The Age*, <https://www.theage.com.au/articles/2003/02/27/1046064152066.html> [Accessed 24 July 2019]; "Tyson tat criticised"(27 February 2003), *Sydney Morning Herald*, <https://www.smh.com.au/articles/2003/02/27/1046064156056.html> [Accessed 24 July 2019]. Tyson has a documented history of violent behavior in his personal life. For example, in 1988 his ex-wife actress Robyn Givens accused Tyson of spousal abuse in a television interview, in 1992 he was convicted of sexually assaulting teenager Desiree Washington, and in 1998 he was convicted of assaulting two motorists after a traffic accident.

¹⁴ See, e.g., the discussion of both tattoos during the third reading of the Protected Objects Amendment Bill 2005 (NZ) by Pita Sharples: New Zealand, *Parliamentary Debates*, House of Representatives, 2 August 2006, 4654 (Pita Sharples), http://www.parliament.nz/en-nz/pb/debates/debates/48HansD_20060802_00001323/protected-objects-amendment-bill---third-reading.

¹⁵ "Tyson's moko draws fire from Maori" (25 May 2011), *New Zealand Herald*, https://www.nzherald.co.nz/nz/news/article.cfm?c_id=1&objectid=10727836 [Accessed 24 July 2019].

¹⁶ For contested perspectives on the Whitmill tattoo as cultural appropriation see M. Hadley, "Mike Tyson Tattoo" in C. Op Den Kamp and D. Hunter (eds), *A History of Intellectual Property in 50 Objects* (Cambridge: Cambridge University Press, 2019), pp.401-405.

The visual similarity between Whitmill's tattoo and moko motifs supports this inference, as does its position on the face. As United States tattooist Vince Hemingson explains:

“Within Tyson’s facial tattoo it is possible to discern two spiral patterns very similar to the fern frond, or koru, that is a repeating motif common to Maori art, including tattooing or “moko”, painting, and carving, in both wood, bone and greenstone. A traditional Maori tattoo artist - - the tohunga ta moko - - could produce two different types of pattern: that based on a pigmented line, and another, the puhoro, based on darkening the background and leaving the pattern unpigmented as clear skin.

Tyson’s facial “tribal tattoo” generally follows the Maori rules laid out for facial “moko” or tattoos. Tyson’s tattoo follows the contours of his face, enhancing the contours of his face and tracing the natural “geography”, for example lines along the brow ridge; the major design motifs are symmetrically placed within opposed design fields: lines are used in certain areas where spirals are not used; two types of spirals are used - - the koru which is not rolled up and has a “clubbed” end, and the rolled spiral ... Tyson’s tattoo appears to be based around a pair of puhoro koru.”¹⁷

The property framings that characterise the *Whitmill v Warner Bros.* proceedings will now be considered, to contextualise the relevance of cultural interests in motifs and arts styles to the legal rights that are conferred and protected within the formal legal sphere.

Tattoos in the domain of copyright law

Whitmill’s Claim

On the 28 April 2011, Nevada tattooist S Victor Whitmill commenced a copyright infringement action against Warner Bros. for their unauthorised use of the tattoo design he created for Tyson, in the film “The Hangover Part II.”¹⁸ In *The Hangover*, a plot device sees character Stu Price, played by actor Ed Helms, receiving a facial tattoo during a wild night of partying prior to his wedding.¹⁹ Whitmill’s claim alleges that Warner Bros. used an almost “exact reproduction”²⁰ of the design on the face of Helms and in the film’s marketing and promotional materials without an express or implied license to do so, infringing his exclusive right to authorise derivative works.²¹ Whitmill sought a preliminary and permanent injunction to restrain Warner Bros. from making any use of the tattoo, compensatory damages, an award of profits, and costs.²²

In his claim, Whitmill provides supporting evidence that he is the author and copyright owner of the tattoo design as an original work of authorship. In copyright legislation an original work of authorship fixed in a tangible medium of expression is a form of personal property that provides the owner with certain exclusive rights, including the right to reproduce the

¹⁷ V. Hemingson, “Mike Tyson's Facial Tattoo – A Maori Inspiration?” *Vanishing Tattoo*, <http://www.vanishingtattoo.com/tattoo/celeb-tyson.htm> [Accessed 24 July 2019]. Punctuation in original. See also Tan, “Intellectual Property Law and the Globalization of Indigenous Cultural Expressions: *Māori* Tattoo and the Whitmill versus Warner Bros. Case” (2013) p.64.

¹⁸ “The Hangover Part II” (Warner Bros. Pictures, 2011). Hereafter “The Hangover”.

¹⁹ This plot device deliberately capitalises on Tyson’s links to The Hangover franchise. Tyson appeared in the first Hangover film, “The Hangover”, released in 2009, and in the second instalment, “The Hangover Part II” that attracted Whitmill’s copyright infringement claim.

²⁰ Whitmill, “Verified Complaint for Injunctive and Other Relief” (2011), p.4. Both literal and non-literal copying is prohibited in the United States. See Copyright Act of 1976, 17 USC § 501; *Nichols v Universal Pictures*, 45 F 2d 119, 121 (2nd Cir, 1930).

²¹ Whitmill, “Verified Complaint for Injunctive and Other Relief” (2011), p.4-5, 7.

²² Whitmill, “Verified Complaint for Injunctive and Other Relief” (2011), p.7-8.

copyrighted work, and to licence these rights.²³ In Whitmill’s case, he drew the tattoo design on Tyson’s face with a marker, before tattooing it.²⁴ Line drawings in ink fall within the definition of “pictorial, graphic, and sculptural” works, protected as subject matter of copyright.²⁵ Whitmill’s claim asserts that the final tattoo, as applied to Tyson, is an original work of authorship because it is a drawing fixed in a tangible medium of expression on Tyson’s face and meets the requisite (“extremely low”²⁶) level of creativity to qualify for copyright protection. Photographs documenting the tattoo’s application are included in his originating process showing its original creation, as is the “Tattoo Release” document signed by Tyson that acknowledges that the tattoo and related drawings are the property of Whitmill’s tattoo studio.²⁷

As Tyson is a renowned public figure and holds publicity rights in his image which would conceivably include permanent tattoo markings, Whitmill’s complaint seeks to avoid discourse around the relevance of the drawing as a tattoo. The complaint specifically rejects the relevance of Tyson’s identity to his copyright claim, “... [t]his case is not about Mike Tyson, Mike Tyson’s likeness, or Mike Tyson’s right to use or control his identity. This case is about Warner Bros. appropriation of Mr Whitmill’s art and Warner Bros’ unauthorized use of that art, separate and apart from Mr. Tyson.”²⁸ In any case, the fact the drawing is a tattoo on skin is presumably irrelevant to the subsistence of copyright, as copyright legislation encompasses a broad scope of mediums of expression. Drawing is defined without reference to the medium of expression beyond its first instantiation in a tangible form for “more than transitory duration.”²⁹ The legal point of origin of Whitmill’s property right was the moment he reduced the design to a tangible form. As he did not copy the image and added some of his own expression to the work it meets the minimum degree of creativity required for copyright to subsist. In the United States, originality requires independent creation – that the work originated from the author – plus a “minimal degree of creativity”.³⁰ Whitmill’s artistic inspiration in originating the tattoo and the artistic merit of the resultant work is irrelevant to this test.

As the author and copyright owner of an original artistic work, Whitmill’s rights to prevent reproduction of the image are presented as straightforward in Whitmill’s originating process. The remainder of the claim stresses the likelihood of copyright infringement. It argues that Warner Bros. had access to Tyson’s tattoo at all relevant times, and that at no time had Whitmill himself reproduced the design nor permitted anybody else to license the image or otherwise copy the image.³¹ Warner Bros.’ conduct is infringing and unauthorised.

Warner Bros. defence

²³ Copyright Act of 1976, 17 USC §§ 102, 106. Copyright ownership can also be transferred in whole or in part. See § 201(d)(1).

²⁴ Transcript of Proceedings (2011), document 55, p.17 (S.V. Whitmill). Texta markings on Tyson’s face can be seen in one of the photographs accompanying his originating claim: Whitmill, “Verified Complaint for Injunctive and Other Relief” (2011), p.3.

²⁵ See the Copyright Act of 1976, 17 USC §101 that includes two and three dimensional works of “fine, graphic, and applied art”. See also §102(a)(5) that confirms that pictorial, graphic and sculptural works are subject matter of copyright.

²⁶ *Feist Publications v Rural Telephone Service*, 499 U.S. 340, 345 (1991) (hereinafter “*Feist*”).

²⁷ See Whitmill, “Verified Complaint for Injunctive and Other Relief” (2011), Exhibits 1-3.

²⁸ Whitmill, “Verified Complaint for Injunctive and Other Relief” (2011), p.1.

²⁹ See the definition of a work “fixed” in a tangible medium of expression: Copyright Act of 1976, 17 USC § 101.

³⁰ *Feist* 499 U.S. 340, 345 (1991).

³¹ Whitmill, “Verified Complaint for Injunctive and Other Relief” (2011), pp.4, 6-7.

Warner Bros. led a number of defences in opposition to Whitmill's claim including an estoppel and fair use parody argument.³² However, the primary defence was that tattoos do not, and cannot, subsist in copyright and that therefore there was no copyrightable expression in Whitmill's tattoo design.³³ In their defence filing, Warner Bros. argued that copyright in tattoo imagery is a novel legal issue as there is no legal precedent for ownership of a tattoo design.³⁴ As Whitmill did not cite any authorities supporting the assumption that tattoos are protected by copyright, copyright protection of the image is erroneously assumed. Warner Bros. argued that skin cannot support a copyright in any event because rights subsistence is tantamount to granting ownership over the human body.³⁵ Thus, the relevant property and point of legal origin referenced by Warner Bros. was not the drawing of the design in the abstract, but the tattoo as worn by Mike Tyson. For Warner Bros.' it was pivotal that Whitmill had not sketched or stenciled the design on paper prior to applying it to Tyson's skin. The design in the abstract simply did not exist prior to its instantiation as a tattoo.³⁶

In support of their position that tattoos do not subsist in copyright, Warner Bros. led expert testimony by legal scholar David Nimmer that an otherwise copyright image loses protection once it becomes a tattoo because live bodies do not qualify as a medium of expression. He compared skin to a frosty window pane or wet sand as the tide approaches because it changes over time.³⁷ According to this argument, even if Whitmill had first sketched the design "the image would give the tattooist no right to control the application of that same image to other individuals"³⁸ because of its transitory nature on the body.

In addition to the skin not qualifying as a tangible medium of expression, Nimmer's testimony also asserts that extending copyright protection to tattoo works is unjustifiable because it would lead to a suite of troubling results under the *Copyright Act*, amounting to the conferral of control over another's body.³⁹ In Whitmill's case, recognising copyright subsistence would mean that he owned "a copyright in Tyson's face."⁴⁰ Tyson would infringe Whitmill's right to derivative works if he chose to add to the tattoo, potentially resulting in him being ordered to remove the offending addition, and any time pictures of Tyson's face were

³² These defences are outside the scope of consideration in this article.

³³ Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" in *Whitmill v Warner Bros. Entertainment* (ED Mo, No. 4:11-CV-752, 20 May 2011) pp.13-18.

³⁴ Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011) pp.2, 13.

³⁵ Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011) p.13.

³⁶ The fact there were no preliminary drawings upon which the tattoo was based is key to this defence argument, as a distinction is made between a tattoo and the preliminary works on which it is based. See M. Minahan, "Copyright Protection for Tattoos: Are Tattoos Copies?" (2015) 90(4) *NDLR* 1713, pp.1728-1729.

³⁷ "Declaration of David Nimmer" in Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011), Exhibit 6, p.4. Note that the view that skin is not a tangible medium of expression is atypical in academic commentary, particularly because copyright has been found to subsist in makeup designs: *Carell v Shubert*, 104 F Supp 2d 236 (SDNY, 2000). See the criticism of Nimmer's position in D. Lichtman, "Are Tattoos Eligible for Copyright Protection" (15 June 2011), *The Media Institute*, <https://www.mediainstitute.org/2011/06/15/are-tattoos-eligible-for-copyright-protection/>.

³⁸ "Declaration of David Nimmer" in Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011), p.13.

³⁹ "Declaration of David Nimmer" in Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011), p.5-6. See also Warner Bros.' defence filing assertion that recognising copyright would "permit one person (or entity) to own a physical attribute of another person": Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011), p.12.

⁴⁰ "Declaration of David Nimmer" in Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011), p.13.

published or broadcast, a violation of Whitmill's right to display the work would occur thus making Tyson a contributory infringer of Whitmill's rights.⁴¹ Warner Bros. argued that these results were untenable.

In the event that Whitmill's design subsisted in copyright, Warner Bros. contended in the alternative that their use of the imagery was authorised by their publicity rights contract with Tyson and his implied license as the tattoo-wearer to exploit the design as part of his image.⁴² A term in Warner Bros. contract with Tyson for the Hangover films states that Tyson gives his express permission for Warner Bros. to use his "likeness ... in connection with the distribution, exhibition, advertising and other exploitation of the Picture."⁴³ As such, Warner Bros. argued that Tyson held an implied licence from Whitmill that extended to him permitting the copying of the tattoo onto another actor's face, and that they acted within the scope of this licence when using the tattoo in *The Hangover* because Tyson's likeness includes his facial tattoo.⁴⁴ Their infringing behaviour was thus excused by a combination of Tyson's underlying implied licence as a tattoo wearer to display and exploit his tattoo and their subsequent licensing of Tyson's publicity rights.

Preliminary injunction hearing: oral judgment

The case subsequently proceeded to a preliminary injunction hearing. Whitmill's motion to have Nimmer's expert testimony excluded as it constituted a thinly disguised "legal argument" was sustained by Judge Perry.⁴⁵ Judge Perry agreed that Nimmer's deposition on the inability of tattoos to subsist in copyright is a legal opinion "on what copyright law should be" rather than expert testimony. She stated that she did not think that Whitmill's claim raised any novel or complex legal issues justifying the testimony's inclusion.⁴⁶ That is, there was no complexity or novelty to the property claim over the tattoo as a drawing. In copyright, property exists in the right to control reproduction. The legal property protected is the right to determine whether, and under what circumstances, the original work may be used by others.⁴⁷ As Warner Bros. did not seek Whitmill's approval to use the tattoo before the film, Judge Perry considered the legal issues straightforward.⁴⁸ In focusing on the property claim rather than subsistence, Judge Perry conflates expression of the design in the abstract with its application on Mike Tyson's body. Thereafter, she refers to protection of the tattoo in lieu of or alongside the copyright in the artistic work, neatly avoiding discussion of the origin of the creation except in a reductionist manner.

In considering whether the circumstances warranted the granting of a preliminary injunction to prevent the release of *The Hangover*, Judge Perry held that while Whitmill had a high

⁴¹ Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011), p.15; "Declaration of David Nimmer" in Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011), p.5-6.

⁴² Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011), p.25-28.

⁴³ Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011), p.27.

⁴⁴ Warner Bros., "Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction" (2011), p.27.

⁴⁵ Transcript of Proceedings, *Whitmill v Warner Bros. Entertainment* (Eastern District Court of Missouri, Perry J, 24 May 2011) document 57, p.59 (Perry J).

⁴⁶ Transcript of Proceedings (2011), document 55; "Courtroom Minute Sheet" in *Whitmill v Warner Bros. Entertainment* (ED D Mo, 4:11-cv-752, 23 May 2011).

⁴⁷ See the exclusive rights held by the copyright owner: Copyright Act of 1976, 17 USC § 106.

⁴⁸ See Judge Perry's summary of the case: Transcript of Proceedings, *Whitmill v Warner Bros. Entertainment* (Eastern District Court of Missouri, Perry J, 24 May 2011) document 56, p.2 (Perry J).

likelihood of success on the merits of his case and had suffered irreparable harm, the balance of hardships and public interest favoured Warner Bros.⁴⁹ To be successful in receiving a preliminary injunction, a plaintiff must establish the likelihood of success on the merits of the case, that they are threatened with irreparable harm, that the balance of hardships between the parties favours their case, and that the public interest is served by the granting of relief.⁵⁰ Preliminary injunctions are available to prohibit the committing (or the continuation of the committing) of copyright infringement and require the balancing of competing arguments for or against protection, including consideration of the public interest.⁵¹ Injunctive relief is a dominant form of redress for breaches of property rights in intellectual property disputes.⁵² In denying Whitmill's preliminary injunction request, Judge Perry stymied Whitmill's right to control reproduction before the case was heard at a full trial.

Yet overall, Judge Perry was quite supportive of the strength of Whitmill's copyright infringement claim. In addressing Whitmill's likelihood of success on the merits, Judge Perry agreed that Whitmill had a "strong" likelihood of prevailing against Warner Bros.⁵³ She described the legal arguments put forward by Warner Bros. on copyright subsistence as "silly"⁵⁴ and expressly rejected Warner Bros.' argument that skin is incapable of supporting a copyright:

"Of course tattoos can be copyrighted. I don't think there is any reasonable dispute about that. They are not copyrighting Mr. Tyson's face, or restricting Mr. Tyson's use of his own face, as the defendant argues, or saying that someone who has a tattoo can't remove the tattoo or change it, but the tattoo itself and the design itself can be copyrighted, and I think it's entirely consistent with the copyright law ..."⁵⁵

Accordingly, she did not attend to the publicity rights issue and framed Whitmill's property claim narrowly:

"it's clear that Whitmill created this tattoo as an original piece for Mr. Tyson, and when he did it, Tyson signed a document saying that Mr. Whitmill kept the rights. Neither Tyson nor Warner Brothers sought approval from Whitmill before either [Hangover] movie ... Then of course the second movie does use the tattoo on another character's face. It's the same tattoo."⁵⁶

⁴⁹ Transcript of Proceedings (2011), document 56, p.6-8 (Perry J).

⁵⁰ *Dataphase Systems v C L Systems*, 640 F 2d 109 (8th Cir, 1981). See also *eBay v MercExchange*, 547 U.S. 388, 391-392 (2006). While *eBay* arose in the context of patents, the court noted that its treatment of injunctions is consistent with the Copyright Act of 1976: at 392.

⁵¹ Both temporary and final injunctions are available in copyright infringement actions: Copyright Act of 1976, 17 USC § 502. The granting of an injunction often induces parties to settle. See, e.g., A. Stewart et al, *Intellectual Property in Australia* (Chatswood: Lexis Nexis, 2017) p.58.

⁵² This remedy is not automatic on the finding of likelihood on the success of copyright infringement. See, eg, Transcript of Proceedings (2011), document 56, p.5 (Perry J). However, injunctions are frequently awarded in copyright infringement disputes (following consideration of the relevant legal principles) due to the inadequacy of legal remedies in cases involving copyright infringement: at p.5. See generally H.T. Gomez-Arostegui, "What History Teaches Us About Copyright Injunctions and the Inadequate-Remedy-at-Law Requirement" (2008) 81(6) S Cal L Rev 1197-1280.

⁵³ Transcript of Proceedings (2011), document 56, p.3 (Perry J).

⁵⁴ Transcript of Proceedings (2011), document 56, p.3 (Perry J).

⁵⁵ Transcript of Proceedings (2011), document 56, p.3 (Perry J).

⁵⁶ Transcript of Proceedings (2011), document 56, p.2 (Perry J).

As “there is no evidence at all that Warner Bros. had any kind of license implied or otherwise to use the tattoo”⁵⁷ and there was no parody of the tattoo itself,⁵⁸ Perry J held that Whitmill had a strong likelihood of prevailing on the merits for copyright infringement.⁵⁹

Judge Perry also agreed that irreparable harm was shown.⁶⁰ In addressing the question of whether Whitmill had shown that he would suffer irreparable harm from the failure to issue the injunction, Judge Perry agreed with Whitmill’s submissions that if the film was released he “will continue to lose control” over the right to control the work’s reproduction, and that this harm is difficult to quantify with money damages.⁶¹ However, in assessing whether the balance of hardships favoured the granting of the injunction, Judge Perry decided against Whitmill.⁶² She considered that the millions of dollars that Warner Bros. had invested into marketing, advertising and distributing the film and the “very large” harm they would suffer if the injunction was granted weighed more heavily than Whitmill’s substantially less serious hardship; Warner Bros. appropriated only one tattoo design and its use in *The Hangover* did not affect the subsistence of Whitmill’s business.⁶³ Moreover, that the public interest in consumers seeing the film and in protecting non-parties from losing money from the film’s enjoyment weighed more heavily than the public interest in protecting copyrights:

“The public interest does favor protecting the thousands of other business people in the country as well as Warner Brothers, and not causing those nonparties to lose money, and I think it would be significant, and I think it would be disruptive. I think that tilts the public interest in favor of Warner Brothers on this because all over the country people would be losing money if I were to enjoin this movie.”⁶⁴

For these hardship and public interest reasons, Judge Perry denied Whitmill’s request for an injunction to enjoin the release of the film despite the strength of his copyright infringement case and the existence of irreparable harm. Given that by the time of the trial the film would already be showing in theatres, this decision effectively confined Whitmill to a pecuniary remedy at trial. As noted in the next section, the case settled soon after.

Post-hearing developments

After the preliminary injunction hearing, Whitmill lodged an emergency motion for an expedited scheduling conference. In response, Warner Bros. indicated that they would be pursuing expert discovery on the issue of whether Tyson’s tattoo “is derivative of pre-existing Maori designs.”⁶⁵ This was the only time throughout the litigation proceedings that one of the parties noted that a connection with Māori cultural content might be relevant to the legal issues in the case. This line of inquiry was not pursued further, however, as

⁵⁷ Transcript of Proceedings (2011), document 56, p.4 (Perry J).

⁵⁸ For a discussion of the fair use parody arguments in this case see Y. King, “The Enforcement Challenges for Tattoo Copyrights” (2014) pp.57-63.

⁵⁹ Transcript of Proceedings (2011), document 56, p.3 (Perry J).

⁶⁰ Transcript of Proceedings (2011), document 56, p.6 (Perry J).

⁶¹ Transcript of Proceedings (2011), document 56, p.6 (Perry J).

⁶² Transcript of Proceedings (2011), document 56, p.7 (Perry J).

⁶³ Transcript of Proceedings (2011), document 56, p.6 (Perry J). See also: at p.7.

⁶⁴ Transcript of Proceedings (2011), document 56, p.8 (Perry J).

⁶⁵ Warner Bros., “Memorandum in Opposition to Plaintiff’s Proposed Scheduling Plan” in *Whitmill v Warner Bros. Entertainment* (ED Mo, No. 4:11-CV-752, 6 June 2011) document 51, p.6.

approximately three weeks later the case settled for an undisclosed amount prior to trial.⁶⁶ The film was not subsequently digitally altered for the cinema or DVD release.

The significance of the abovementioned property framework for the contested cultural content of the Whitmill tattoo will now be considered.

Visibility of the Māori cultural claim

From the filing of Whitmill's claim to the case's settlement, both parties to the action and the judge who ran the preliminary proceedings managed the evidence in such a way that avoided having to discuss the cultural implications of a competing Māori copyright claim being asserted from the other side of the Pacific. The origins and signification of the image could have been discussed by the plaintiff in the originating process. However, the originality threshold means that Whitmill was able to simply state that the tattoo was original because he created it and show two photographs documenting its application to Tyson's face. An objective analysis of the work and the process by which it was created shows some creativity on behalf of Whitmill.⁶⁷ The tattoo is not comparable to a pre-existing, unchanged image of a common symbol that is not copyrightable because the creative spark is utterly lacking.⁶⁸ Whitmill's artistic inspirations were not relevant to the origination of the work of authorship.

In their defence filings, Warner Bros. could have questioned the derivative nature of the tattoo. However, they too accepted that it met the originality threshold and chose to instead question the subsistence of copyright in tattoos generally. During the preliminary hearing, Whitmill disclosed that he was inspired by moko in creating the tattoo, yet Warner Bros. chose not to cross-examine him on the cultural content of the image or his creative process, but rather his purported reason for seeking the injunction. Their cross-examination refuted that Whitmill was concerned with losing control over the image, and asserted that his desire was simply to extract a large settlement.⁶⁹ For the defence too, the Māori cultural content was irrelevant.

In her preliminary judgement, Judge Perry could have addressed concerns around ownership when assessing the likelihood of Whitmill's claim's success on the merits. However, she simply accepted that "Whitmill created this tattoo as an original piece for Mr. Tyson", that the Tattoo Release document confirms Whitmill's intellectual property rights, and that neither Tyson nor Warner Bros. sought approval from Whitmill before the film.⁷⁰ To Judge Perry, Whitmill's authorship and ownership of the tattoo was straightforward, as was Warner Bros.' infringement of Whitmill's copyright.

At each stage of the proceedings, including its preliminary adjudication, no reasons were given for failing to provide salient evidence that touched on the aesthetics of the tattoo itself. The fact that the design was Indigenous-inspired was not directly raised as potentially limiting Whitmill's rights during the proceedings. The Māori claim to own the artform that inspired the tattoo's distinctive features was neither tendered in evidence nor raised as potentially bearing on the issues at trial. Even if it had of been – copyright can subsist in

⁶⁶ The parties participated in a settlement conference on the 17 June 2011. The case was dismissed on the 22 June 2011: "Whitmill v. Warner Bros. Entertainment Inc.", *Justia Dockets & Filings*, <https://dockets.justia.com/docket/missouri/moedce/4:2011cv00752/113287/> [Accessed 24 July 2019].

⁶⁷ *Feist* 499 U.S. 340, 346-347 (1991).

⁶⁸ *Feist* 499 U.S. 340, 359 (1991).

⁶⁹ Transcript of Proceedings (2011), document 55, p.37-38 (F.J. Sperling).

⁷⁰ Transcript of Proceedings (2011), document 56, p.2 (Perry J).

infringing imagery,⁷¹ meaning that the case between Whitmill and Warner Bros. would not have been disrupted.

Throughout *Whitmill v Warner Bros.*, the Whitmill tattoo's construction as a legal object was disconnected from the broader social narratives that query the cultural content and ownership of imagery. This is not, however, surprising given that courts distance themselves "from the appearance of aesthetic subjectivity",⁷² and copyright principles present as culturally neutral.⁷³ Although different Anglo-derived jurisdictions have different technical formulations, there is a similar lack of interest in engaging in aesthetic judgment within the law. The definition of pictorial, graphic and sculptural works does not connote any implied criterion of qualitative value.⁷⁴ The lowest common denominator approach to originality invokes a relatively straightforward factual determination around whether a work is the product of independent origination rather than a value judgment,⁷⁵ and few independently created works fail to qualify as original.⁷⁶ Determining copyright infringement inevitably has evaluative dimensions,⁷⁷ yet the legal frame in this regard, like with subsistence, presents as quite closed to normative discussion. As intellectual property law scholar Rebecca Tushnet observes, "courts are not supposed to be art critics."⁷⁸

For the *Whitmill* proceedings, judicial disavowal of aesthetics within copyright law means that because the Warner Bros. reproduction is a literal copy of Whitmill's tattoo, the primary inquiries are factual: whether the work originated from Whitmill so that he is recognisable as

⁷¹ See the Copyright Act of 1976, 17 USC § 103 provides that copyright subsists in "derivative works", that is, in works that use pre-existing material in which copyright subsists. The copyright in the infringing work will, however, only extend to the new material contributed by the author to the work, and not "to any part of the work in which such material has been used unlawfully". See also *American Greetings v Kleinfab*, 400 F Supp 228, 232-233 (1975), discussing *Nimmer on Copyright*.

⁷² J. Fowles, "The Utility of a Bright-Line Rule in Copyright Law: Freeing Judges from Aesthetic Controversy and Conceptual Separability in *Leicester v Warner Bros.*" (2005) 12(2) UCLA Ent L Rev, p.304. See also the discussion of "avoidance techniques" in C.H. Farley, "Judging Art" (2005) 79(4) TLR, pp.836-839.

⁷³ Note that while copyright jurisprudence may present in this way, critical scholarship suggests that the influence of aesthetics and subconscious aesthetic choices upon decision-making is inevitable, in particular when assessing substantive part copyright infringement, fair use, and joint authorship. See, e.g., Fowles, "The Utility of a Bright-Line Rule in Copyright Law: Freeing Judges from Aesthetic Controversy and Conceptual Separability in *Leicester v Warner Bros.*" (2005), pp.307-308; Farley, "Judging Art" (2005), pp.833-836; A. Yen, "Copyright Opinions and Aesthetic Theory" (1998) 71(2) S Cal L Rev, pp. 247-302, particularly 249-250, 298, 301; B. Soucek, "Aesthetic Judgment in Law" (2018) 69(2) Ala LR, pp. 428-437; J. Pila, "Copyright and its Categories of Original Works" (2010) 30(2) OJLS, pp.241-242; R. Gorman, "Copyright Courts and Aesthetic Judgments: Abuse or Necessity?"(2001) 25(1) Colum JL & The Arts, pp.12-19; R. Walker and B. Depoorter, "Unavoidable Aesthetic Judgements in Copyright Law: A Community of Practice Standard" (2015) 109(2) N W L Rev. pp. 344-347, 367-368.

⁷⁴ *Feist* 499 U.S. 340, 345 (1991); A. Cohen, "Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments" (1990) 66(1) *Indiana Law Journal*, p.179-184; Soucek, "Aesthetic Judgment in Law" (2018), p.427.

⁷⁵ Gorman, "Copyright Courts and Aesthetic Judgments: Abuse or Necessity?"(2001), p.2.

⁷⁶ Soucek, "Aesthetic Judgment in Law" (2018) p.427.

⁷⁷ Cohen, "Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments" (1990) p.178; S. Balganesch, "The Normativity of Copying in Copyright Law" (2012) 62(2) *Duke LJ*, pp.206, 215-221.

⁷⁸ R. Tushnet, "Judges as Bad Reviewers: Fair Use and Epistemological Humility" (2013) 25(1) *Law & Literature* 20, p.29. See also Justice Holmes' oft-cited caution against judging artistic merit in *Bleistein v Donaldson Lithographing*, 188 U.S. 239, 251 (1903): "[i]t would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits". *Bleistein* concerned whether advertisements could be considered "art" in which copyright subsists. For a discussion of this proposition and how it is used by judges to avoid engaging with aesthetic questions, see generally Farley, "Judging Art" (2005), pp. 815-819.

its owner, and whether Warner Bros. had access to the tattoo and actually copied it. Neither of these inquiries directs attention to the cultural content of the source work. Moral questions around the ethics of seeking inspiration from Indigenous cultural imagery and arts styles in settler states are therefore irrelevant to the legal criteria and hence not permitted to influence judicial interpretation and determination. As a result, the social narratives that criticised the cultural content of the Whitmill tattoo were not received within the formal legal sphere. The cultural claims that could have challenged Whitmill's copyright ownership of Indigenous-inspired imagery were rendered invisible.

Conclusion

For more than 15 years, the tattoo that S Victor Whitmill created for boxer Mike Tyson has been criticised as an inappropriate and unauthorised appropriation of Māori moko. A strong narrative of cultural appropriation sits behind Whitmill's recent assertion of copyright in the design against Warner Bros. Nevertheless, an examination of how *Whitmill v Warner Bros* was litigated, defended, and adjudicated shows that this narrative was repeatedly rendered invisible during the legal proceedings. As the Whitmill tattoo did not copy an existing moko, the Māori cultural appropriation claimants had no status as a class of potential property owners whose rights could disrupt the assertion and defence of legal rights by Whitmill and Warner Bros. Their cultural interests in the source material that inspired the creation of Whitmill's "original" imagery were irrelevant.

The marginalisation of Indigenous cultural and intellectual property in intellectual property law runs deep. For cultural appropriation discourse to carry weight in shaping legal narratives around Indigenous-inspired imagery, a radical rethinking of the relationship between copyright and aesthetics is needed.