UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK
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SOLID OAK SKETCHES, LLC,

Plaintiff-
Counterdefendant,

-v- No. 16-CV-724-LTS-SDA

2K GAMES, INC. and TAKE-TWO INTERACTIVE SOFTWARE, INC.,

Defendants-
Counterclaimants.

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MEMORANDUM OPINION AND ORDER

Solid Oak Sketches, LLC ("Solid Oak" or "Plaintiff"), brings this action against Defendants 2K Games, Inc., and Take-Two Interactive Software, Inc. (collectively, "Take Two" or "Defendants"), asserting a claim of copyright infringement pursuant to the Copyright Act of 1976, 17 U.S.C. § 101 et seq. (the "Copyright Act"). Following this Court's granting of Defendants' motion to dismiss Plaintiff's claims for statutory damages and attorneys' fees on August 2, 2016, Plaintiff filed a Second Amended Complaint ("SAC") on October 24, 2016. (Docket Entry No. 55.) On August 16, 2016, Defendants filed counterclaims for declaratory judgment pursuant to the Copyright Act and the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202 ("Def. Countercl."). (Docket Entry No. 47.) The Court denied Plaintiff's motion to dismiss the counterclaims on May 16, 2017 (docket entry no. 64) and, on March 30, 2018, denied Defendants' motion for judgment on the pleadings ("March Op.," docket entry no. 117).

The Court has jurisdiction of this action pursuant to 28 U.S.C. §§ 1331 and 1338.

Defendants now move for summary judgment pursuant to Federal Rule of Civil Procedure 56, requesting (i) an order dismissing Plaintiff's copyright infringement claim and (ii) entry of declaratory judgment in Defendants' favor on their de minimis use and fair use counterclaims.[1] (Docket Entry No. 127.) Plaintiff has cross moved to exclude the four expert declarations filed in support of Defendants' summary judgment motion. (Docket Entry No. 147.) The Court has considered carefully the parties' submissions in connection with the motions. For the following reasons, Defendants' motion for summary judgment is granted and Plaintiff's cross motion to exclude is denied.

BACKGROUND

Familiarity with the facts underlying this case, which have been detailed in prior decisions of the Court, including the August 2, 2016, Memorandum Opinion and Order, the May 16, 2017, Memorandum Order, and the March 30, 2018, Memorandum Opinion and Order, is presumed. (See Docket Entry Nos. 44, 64, and 117.) The following summary focuses on facts that are pertinent to the question of whether Defendants are entitled to summary judgment. Except as otherwise noted, the following material facts are undisputed.[2]

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[1] Defendants have moved for summary judgment as to their first and second counterclaims only. Defendants' third counterclaim for "declaratory judgment of fraud on the Copyright Office" remains pending. (Def. Countercl. ¶¶ 228-35.)

[2] The facts presented or recited as undisputed are drawn from the parties' statements pursuant to S.D.N.Y. Local Civil Rule 56.1, or from evidence as to which there is no non-conclusory factual proffer. Citations to Defendants' Local Civil Rule 56.1 Statement (Defendants-Counterclaimants 2K Games, Inc. and Take-Two Interactive Software, Inc.'s Rule 56.1 Statement of Undisputed Facts in Support of Their Motion for Summary Judgment ("Def. 56.1"), Docket Entry No. 129) and Plaintiff's Counterstatement (Response to Defendants' Rule 56.1 Statement of Purportedly Undisputed Facts ("Pl. 56.1"), Docket Entry No. 146) incorporate by reference citations to the underlying evidentiary submissions. Plaintiff proffered no citations to record evidence to the extent it purported to dispute Defendants' documented proffers of undisputed facts in Defendants' 56.1 statement. Where Plaintiff purported to deny or dispute particular

Take-Two is a major developer, publisher, and marketer of interactive entertainment and video games that develops and publishes products through its wholly-owned subsidiaries, 2K and Rockstar Games. (SAC ¶¶ 17-18.) Defendants annually release an updated basketball simulation video game that depicts basketball with realistic renderings of different National Basketball Association ("NBA") teams, including lifelike depictions of NBA players and their tattoos. (Def. Countercl. ¶¶ 8, 141.) Plaintiff alleges that Defendants have infringed its copyrights by publicly displaying works for which Plaintiff owns copyrights—five tattoos (the "Tattoos") that are depicted on NBA players Eric Bledsoe, LeBron James, and Kenyon Martin (the "Players")—in versions 2K14, 2K15, and 2K16 (released in 2013, 2014, and 2015, respectively) of Defendants' basketball simulation video game. (SAC ¶¶ 9-11.)

Tattoos

According to Defendants' expert, Nina Jablonski, "[t]attoos have been a part of human expression for thousands of years." (Def. 56.1 ¶ 1.) In modern day, tattoos like the Tattoos at issue in this litigation "reflect the personal expression of the person bearing the tattoo and are created for that purpose." (Def. 56.1 ¶¶ 2-3.) The Tattoos reflect the Players' personal expression. (Def. 56.1 ¶ 3.)

Solid Oak holds an exclusive license to each of the Tattoos. (See Declaration in Opposition to Defendants' Motion and in Support of Cross-Motion ("Haberman Decl."), Docket Entry No. 149.) However, Solid Oak is not licensed to apply the tattoos to a person's skin, and Solid Oak does not hold any publicity or trademark rights to the Players' likenesses. (Def. 56.1 ¶¶ 101-02.) The Players "have given the NBA the right to license [their] likeness to third-parties," and the NBA has granted such a license to Take-Two. (Def. 56.1 ¶¶ 103-04.) The

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statements, Plaintiff made arguments regarding relevance or other legal issues or, as addressed infra, challenged the relevance or basis of proffered expert testimony.

Players also granted Take-Two permission to use their likenesses. (Declaration of LeBron James ("James Decl."), Docket Entry No. 134, ¶ 13; Declaration of Kenyon Martin ("Martin Decl."), Docket Entry No. 135, ¶ 15.)

Child Portrait Tattoo

LeBron James's "Child Portrait" tattoo was inked by tattooist Justin Wright, and was copied from a baby picture provided by Mr. James. (Def. 56.1 ¶¶ 5-10.) Mr. Wright "knew and intended that when [Mr. James] appeared in public, on television, in commercials, or in other forms of media, he would display the Child Portrait Tattoo." (Def. 56.1 ¶ 11.) It was Mr. Wright's intention that the "Child Portrait" Tattoo "become a part of Mr. James's likeness," which, according to Mr. Wright, "Mr. James was and is free to use . . . as he desire[d], including allowing others to depict it, such as in advertisements and video games." (Def. 56.1 ¶¶ 11-13.)

330 and Flames Tattoo

LeBron James's "330 and Flames" tattoo was inked by tattooist Deshawn Morris, also known as Shawn Rome ("Mr. Rome"). (Def. 56.1 ¶¶ 14-15.) At Mr. James's request, Mr. Rome created the tattoo by shading in the outline of, and adding flames to, the number "330," which had already been inked on Mr. James's arm. (Def. 56.1 ¶¶ 16-19.) The number "330" represents the area code of Akron, Ohio. (Def. 56.1 ¶ 16.) According to Defendants' expert, Dr. Nina Jablonski, flames are a common motif used for tattoos. (Def. 56.1 ¶ 20.)

Mr. Rome stated that, "[a]t the time that [he] inked [the '330 and Flames' tattoo] on Mr. James, [he] knew that Mr. James was a professional basketball player with the [NBA]," and that "it was likely that Mr. James was going to appear in public, on television, in commercials, or in other forms of media, like video games." (Declaration of Deshawn Morris ("Morris Decl."), Docket Entry No. 132, ¶ 9.) Mr. Rome also stated that, "[w]hen [he] inked [the

'330 and Flames' tattoo] on Mr. James according to his requests, [he] knew and intended that [Mr. James] would display [the '330 and Flames' tattoo] whenever he appeared in public," and that he "intended that [the '330 and Flames' tattoo] become a part of Mr. James's likeness and part of his image." (Morris Decl. ¶ 10.)

Script with a Scroll, Clouds and Doves Tattoo

Shawn Rome also inked LeBron James's "Script with a Scroll, Clouds and Doves" tattoo. (Def. 56.1 ¶ 21.) The "Script" tattoo was copied from a design in Mr. Rome's sketchbook. (Def. 56.1 ¶ 22.) Solid Oak did not license the drawing used to create the "Script" tattoo. (Def. 56.1 ¶ 23.) According to Dr. Jablonski, birds, such as doves, "have been a popular subject of tattoos since ancient times." (Def. 56.1 ¶ 24.)

As with the "330 and Flames" tattoo, Mr. Rome "intended that [the 'Script' tattoo] become a part of Mr. James's likeness and part of his image," knowing that (i) Mr. James was a professional basketball player with the NBA and that (ii) it was "likely that Mr. James was going to appear in public, on television, in commercials, or in other forms of media, like video games." (Morris Decl. ¶¶ 9-10.)

Wizard Tattoo

Kenyon Martin's "Wizard" tattoo was inked by Thomas Ray Cornett, and was "copied . . . directly from the pre-existing design" that Mr. Martin chose from designs featured on the walls and in books at Mr. Cornett's parlor. (Def. 56.1 ¶¶ 25, 27-28.) Mr. Cornett did not design the tattoo. (Declaration of Thomas Ray Cornett ("Cornett Decl."), Docket Entry No. 131, ¶ 13.) The "Wizard" tattoo appears as a grim reaper holding a basketball. (Def. 56.1 ¶ 26.) Both basketballs and "depictions of death or the grim reaper" are common tattoo motifs. (Def. 56.1 ¶¶ 30-31.)

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