



## PRESS SUMMARY

27 July 2011

### **Lucasfilm Limited and others (Appellants) v Ainsworth and another (Respondents) [2011] UKSC 39**

*On appeal from the Court of Appeal [2009] EWCA Civ 1328*

**JUSTICES:** Lord Phillips (President), Lord Walker, Lady Hale, Lord Mance, Lord Collins

### **BACKGROUND TO THE APPEAL**

The appeal raises two distinct legal issues:

- (1) The definition of “sculpture” in the Copyright, Designs and Patents Act 1988, and, in particular, the correct approach to three-dimensional objects that have both an artistic purpose and a utilitarian function;
- (2) Whether an English court may exercise jurisdiction in a claim against persons domiciled in England for infringement of copyright committed outside the European Union in breach of the copyright law of that country?

This appeal is concerned with intellectual property rights in various artefacts made for use in the first Star Wars film, “Star Wars Episode IV – A New Hope”. The most important was the Imperial Stormtrooper helmet. It has been treated as decisive for the outcome of the case. As the trial judge put it, “one of the most abiding images in the film was that of the Imperial Stormtroopers.” The film’s story-line and characters were conceived by George Lucas. Between 1974 and 1976 his concept of the Imperial Stormtroopers as threatening characters in “fascist white armoured suits” was given visual expression in drawings and paintings by an artist, Mr Ralph McQuarrie, and eventually three-dimensional form by Mr Andrew Ainsworth. He produced several prototype vacuum-moulded helmets. Once Mr Lucas had approved the final version, Mr Ainsworth made 50 helmets for use in the film.

The Appellants (here referred to collectively as Lucasfilm) own copyrights in the artistic works created for the Star Wars films. They have built up a successful licensing business, including licensing models of Imperial Stormtroopers. In 2004 Mr Ainsworth used his original tools to make versions of the Imperial Stormtrooper helmet and armour for sale to the public. (The second respondent is a company owned by Mr Ainsworth; for practical purposes, he can be treated as the sole respondent). He sold between \$8,000 and \$30,000 of the goods in the United States. Lucasfilm obtained judgment against him in the United States. It also commenced proceedings in the English High Court, including claims for infringement of English copyright and claims under US copyright law.

By the time of the Supreme Court hearing, Lucasfilm claimed only that the helmets qualified for copyright protection under English law as “sculptures” and not as “works of artistic craftsmanship”. In terms of section 4 of the Copyright Designs and Patents Act 1988, copyright subsists in, amongst other things, original “artistic works”, which includes a “sculpture”, irrespective of artistic quality. Whether a helmet was a “sculpture” is significant for two reasons. If it is, any copying of the helmets which Mr Ainsworth had originally produced would infringe Lucasfilm’s copyright. It is also relevant for the defences which are available. To produce a helmet by working from a drawing of it infringes copyright in the drawing. However, it is not an infringement of any copyright in a design document which records a design for anything other than an artistic work to make an article to the design or to copy an article made to the design: section 51 1988 Act. If the helmet did not qualify as sculpture, and was therefore not an artistic work, Mr Ainsworth had a defence to an English copyright action based on infringement of Mr McQuarrie’s graphics.

The High Court dismissed the claims for infringement of English copyright: the helmet was not a work of sculpture and therefore Mr Ainsworth had a defence under section 51. It held, however, that the United States' copyright claims were justiciable and that US copyright had been infringed. The Court of Appeal allowed Mr Ainsworth's appeal. It agreed that the helmet was not a work of sculpture but held that the US copyright claims were not justiciable. Lucasfilm appealed to the Supreme Court.

## **JUDGMENT**

The Supreme Court unanimously allows the appeal. It holds that the helmets were not sculptures but that the US copyright claims were justiciable in English proceedings. Lord Walker and Lord Collins give a joint opinion, with which the other members of the Court agree.

## **REASONS FOR THE JUDGMENT**

### *Sculpture issue*

The court reviews the legislative history of the current statutory provisions and previous authorities as to the meaning of “sculpture”: [14] – [35]. In the High Court, the judge had formulated various “guidelines” as to the meaning of sculpture. For example, some regard must be had to the normal use of the word “sculpture”. The concept can apply to things going beyond what one would normally expect to be art, but it is inappropriate to stray too far from what would normally be regarded as sculpture. Not every three dimensional representation of a concept qualifies: [36] – [37]. Lucasfilm contended that the helmet was sculpture as it had no practical function at all. Its purpose was wholly artistic, to make a visual impression on the filmgoer. That was not, however, how the trial judge and the Court of Appeal had viewed matters. Mann J found the helmets to be a mixture of costume and prop and that their primary function was utilitarian, namely to express an idea as part of character portrayal in the film. He held that this lacked the necessary quality of artistic creation required of a sculpture. This type of judgmental conclusion was one with which appellate courts should be slow to interfere, as Lord Hoffmann observed in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416: [40] – [45]. The judge did not err in law or reach an obviously untenable conclusion: [46]. It would not accord with the normal use of language to apply the term “sculpture” to, for example, a 20th century military helmet used in the making of a film, however great its contribution to the artistic effect of the finished film. The argument for applying the term to an Imperial Stormtrooper helmet was stronger, because of the imagination that went into the concept of the Stormtroopers. But it remained the Star Wars film itself that was the work of art. The helmet was utilitarian in the sense that it was an element in the process of production of the film: [44]. The Court noted that the law did not apply an “elephant test”, but instead a multi-factoral approach: [47].

### *Justiciability of foreign copyright claim*

The Court of Appeal had held that the common law rule in *British South Africa Co v Companhia de Moçambique* [1893] AC 602 that an English court had no jurisdiction to entertain an action for the determination of title to, or the right of possession of, foreign land, or the recovery of damages for trespass to such land, was an example of a general principle which applied to claims for infringement of foreign intellectual property rights. The Supreme Court concludes that, provided there is a basis for *in personam* jurisdiction over the defendant, an English court does have jurisdiction to try a claim for infringement of copyright of the kind involved in the present action: [105].

## **NOTE**

**This summary is provided to assist in understanding the Court's decision. It does not form part of the reasons for that decision. The full opinion of the Court is the only authoritative document. Judgments are public documents and are available at:**

[www.supremecourt.gov.uk/decided-cases/index.html](http://www.supremecourt.gov.uk/decided-cases/index.html)