

**EIP**



## Copyright wars over Stormtrooper helmet

The judgment of the Supreme Court in *Lucasfilm v Ainsworth* [2011] UKSC 39, has both confirmed earlier judgments as to when a three-dimensional item may not be protected by copyright as a work of sculpture, and also highlighted that a defendant resident in England or Wales may be sued in the English courts for infringement of foreign copyright.

The case related to the iconic stormtrooper helmet featured in the Star Wars films. These helmets were produced between 1974 and 1976, originally in design drawings, then in a clay model, and finally by producing several vacuum-moulded prototypes. Fifty helmets of the chosen prototype were then made for use in the film.

In 2004, the defendant, Ainsworth, who had been responsible for the original vacuum moulding, used his original tools to produce a number of stormtrooper helmets, some of which were sold for a value of between \$8,000 and \$30,000. Lucasfilm sued Ainsworth in the US courts and obtained a default judgment for \$20 million. This was never paid, and so Lucasfilm brought proceedings in the English court, which sought enforcement of the US judgment, as well as including claims for infringement of both the UK and US copyrights.

Both the High Court and Court of Appeal found the US judgment unenforceable as there was no personal jurisdiction in the US over Mr. Ainsworth. Both courts also rejected the claim for infringement of English copyright on the basis that the helmet was not a work of sculpture, and further Mr. Ainsworth had statutory defences. However, the courts disagreed on whether a claim for infringement of US copyright could be brought before the English courts, Mann J. in the High Court ruling that it could (and that those rights had been infringed), whilst the Court of Appeal decided that claims of infringement of US copyright were not justiciable in England.

The Supreme Court declined to overturn the finding on copyright, on the basis that the determination of whether an item was a work of sculpture (and would therefore attract copyright as an artistic work) was of the sort to which applied the well-established principle that the first instance judge's finding should not be interfered with unless the judge has erred in principle. The Supreme Court did not believe that to be the case here, and upheld Mann J's finding that the helmet was utilitarian in nature, being an element in the process of the production of a film.

In fact, the Supreme Court felt that Mann J's finding was supported by the emerging trend in UK legislation of protecting three dimensional objects in a graduated way, with artistic works of sculpture enjoying the longest period of protection, followed by "works with 'eye appeal'" (the Supreme Court using old terminology to presumably describe designs with individual character, i.e. those capable of being registered), and then purely functional objects for which design right is available. The Supreme Court noted that there were good policy reasons for the differences, and that the courts should not encourage the boundaries of full copyright to creep outwards.

Because the helmet itself was not a work of copyright, only the design drawings for the helmet would attract copyright, and it was accepted by the parties that Mr. Ainsworth had a defence to this on the basis that it is not an infringement of copyright in a design document for anything other than an artistic work to make an article to the design (s.51 CDDA 1988).

Consequently, the judges rejected the appeal on infringement of UK copyright. However, they allowed the appeal with regard to US copyright. It was held that provided there was in personam jurisdiction over the defendant, for example because the defendant is resident in England, then the English courts did have jurisdiction to hear matters relating to infringement of foreign copyright. They distinguished copyright in this regard from rights which must be registered (such as patents and trademarks) and where the validity of those registered rights is in dispute.

This judgment highlights the courts' unwillingness to allow copyright protection to be used to protect utilitarian three-dimensional articles, and the Supreme Court's view on this is likely to be repeatedly cited in future. The ruling that actions for infringement of foreign copyrights can be brought against UK residents in UK courts will also be of interest, particularly given the cross-border nature of the internet, and may well be applied by other common law jurisdictions.