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Foreign copyright claims can be heard in the UK

All is not lost for the Stormtroopers

The Supreme Court (the UK's highest appellate Court) has today given its much awaited judgment in the case of Lucasfilm Limited v Ainsworth. The dispute concerns the famous Imperial Stormtrooper helmets used in the Star Wars films and whether they are protected by UK copyright laws. Most of the headlines surrounding this decision will focus on the fact that the Supreme Court held that the helmets are not works of sculpture and therefore not protected by UK copyright law. More importantly in an unexpected move the Supreme Court decided that cases of foreign copyright infringement can be brought in the English Courts. This is a major change in policy by the Courts.

The Claimants were the companies behind the Star Wars films. The Defendant, Mr Ainsworth, manufactured the original Stormtrooper helmets for the first Star Wars film in 1976. In 2004 Mr Ainsworth started to produce and sell replica Imperial Stormtrooper helmets using the original tools and moulds. Some of the replicas were sold in the US and in 2006 Lucasfilm obtained judgment in default through the US Courts. The issues before the UK Supreme Courts were:

- Do the Stormtrooper helmets qualify for copyright protection under UK law?
- Could a claim for infringement of the US copyright of Lucasfilm be heard by English Courts?

Copyright Protection?

The Supreme Court held unanimously that the helmets do not attract copyright protection in the UK. Unless a design is for an artistic work it is not an infringement of copyright to make an article to that design. The reasoning for this is to exclude functional designs from the scope of copyright protection - functional designs are protected by more limited unregistered design rights. Lucasfilms therefore had to argue that the helmets were sculptures so that they would be classed as artistic works and protected by copyright.

The Court held that in accordance with the normal use of language the helmets were not sculptures – they were essentially utilitarian in character. This is not a surprising decision on the basis of current copyright legislation.

Enforcement of Foreign Copyright

There has been to date very little case law on the subject of enforceability of foreign intellectual property by the English Courts. Distinguished English judges had previously expressed the view that they could not exercise jurisdiction over foreign intellectual property rights. Departing from conventional wisdom the Supreme Court has held that proceedings can be brought in the UK

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Courts for infringement of foreign copyright. They did not however make any comment on the enforceability of other intellectual property rights.

Mr Ainsworth can therefore continue to sell his replica helmets in the UK but may well face a claim in the English Courts for infringement of US copyright. No doubt this will lead to claims that the English Courts need to do more to protect copyright as US copyright does protect the helmet. The decision does however provide greater protection for foreign copyright owners wishing to assert their overseas rights against UK defendants. It is likely to have a big impact on the copyright enforcement strategies of foreign companies and lead to an increase in forum shopping.

To discuss this case or any other copyright issues contact Martyn Fish on 0113 233 0148 or mfish@hgf-law.com



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