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May the farce be with you: confusing sculptures post-*Lucasfilm*

Elinor Coombs

Abstract

This paper examines the copyright law relating to sculptures, particularly focusing on the UK's decision in *Lucasfilm v Ainsworth*, which concerns Stormtrooper helmets from the Star Wars franchise, and whether they constituted sculptures under the Copyright, Designs and Patents Act 1988. The UK Supreme Court ruled the helmets not to be sculptures because of their utilitarian purpose as props in a film, meaning the helmets were unprotected by copyright law. This was a high-profile case for intellectual property law, but it unfortunately failed to clarify the already confused area. This paper discusses the statute and case law surrounding sculptures, and to what extent the UK courts successfully applied the law. It is concluded that whilst a great attempt was made to untangle the previously inconsistent case law, the *Lucasfilm* decision failed to do so.

1 Introduction

*Lucasfilm v Ainsworth*¹ is an exceptionally significant intellectual property (IP) case, not only because of UK precedent and the impact it will have on future copyright cases,² but also because it had an opportunity to clarify a substantially confused area of law. There were two core matters at issue in *Lucasfilm*, the first being whether the UK

¹ [2011] UKSC 39.

² Henry Lydiate, 'What is Art: A Brief Review of International Judicial Interpretations of Art in the Light of the UK Supreme Court's 2011 Judgment in the Star Wars Case: *Lucasfilm Limited v. Ainsworth*' (2012) 4 *Journal of International Media and Entertainment Law* 111, 135.

had jurisdictional claim to hear the case, considering its origin was the US. However, substantial work has been undertaken in this area, and this paper shall therefore make no further comment on this. Instead, it analyses the second issue – the ruling and judgments of the case, and its consequences for the law of copyright concerning sculptures. The first part of the paper addresses the relevant statute concerning copyright law, before chronologically examining the history of cases related to sculptures specifically. The second part then discusses the facts of *Lucasfilm*, with an analysis of its judgment, before concluding that *Lucasfilm* had an ideal opportunity to clarify an already confused area of law, but failed to do so comprehensively.

2 Copyright, Designs and Patents Act 1988

The main question arising from *Lucasfilm* was whether the Stormtrooper helmets from the Star Wars franchise constituted sculptures. Sculptures are a sub-category of copyright-protectable work, and it is therefore necessary to examine the law of copyright in the UK, which currently subsists in the Copyright, Designs and Patents Act 1988 (CDPA). Section 1 outlines the different types of protectable work, with Section 1(a) including artistic works. Section 4 defines what constitutes an artistic work, with (1)(a) including sculptures. Section 2(b) vaguely defines a sculpture in the inclusive sense – it ‘includes a cast or model made for purposes of sculpture’ – but the definition does not extend beyond this. What is equally important to note is that section 4(1)(a) states these works obtain protection ‘irrespective of artistic quality’, which was originally brought into copyright law by the Copyright Act 1956.³ In other words, a judgment cannot be passed on the artistic quality of the piece in question, for that is an irrelevant factor in the enquiry of whether it constitutes copyright-protectable art.

Sections 51 and 52 are also essential when discussing copyright protection.⁴ Section 51 provides a defence for copyright infringement

³ Copyright Act 1956, s 3(1)(a).

⁴ Copyright, Designs and Patents Act 1988, ss 51, 55.

if the end result of a design document was not an artistic work. Section 51(3) defines a design document as ‘any record of a design, whether in the form of a drawing, a written description, a photograph, data stored in a computer or otherwise.’ The reference to a design document in this provision simply indicates the document containing the original industrial design of an article, and is included within the Act to ensure that a drawing is not subject to both copyright protection and design right protection. In *Lucasfilm*, the design document would therefore refer to the original documents containing the drawings of the Stormtrooper helmets. Section 52 reduces the length of copyright protection to a mere 25 years if items of the copyright-protectable material were mass produced and available for the public to purchase. These sections will be integral to the analysis of *Lucasfilm* later in the paper.

3 Case law

Identifying artistic works of literature, music or dance under the CDPA is relatively unproblematic, but recognising sculptures is far more troublesome.⁵ There have been numerous cases concerning copyright protection of sculptures, and it is rather challenging to detect a consistent logical trend in the judgments. This being said, there seems to be an increasing number of rulings indicating that the visual appeal, or the artistic significance of the item in question, holds weight in whether an item is deemed a sculpture, subsequently raising the bar for obtaining copyright protection, contrary to the CDPA.⁶

One of the earliest decisions regarding the definition of a sculpture rests with *Britain v Hanks*, which concerned hand-painted toy soldiers.⁷ They were held to be artistic objects, and were thus protected under the Sculpture Copyright Act 1814. This seems a sensible and rational

⁵ Lydiate (n 2) 111.

⁶ David Langwallner, ‘Copyright Protection for Works of Sculpture and Artistic Craftsmanship: Recent Developments in Australia and the United Kingdom’ (2009) 3 Irish Business Law Quarterly 13, 13.

⁷ [1902] 86 LT 765.

decision, with no clouding of the term ‘sculpture’.⁸ However, in subsequent cases, this logical position was increasingly obscured and the case law repeatedly unsettled.

The Court of Appeal in New Zealand ruled in *Wham-O*⁹ that the wooden models used to make the moulds of Frisbees constituted sculptures under the Copyright Act 1962, which is exceedingly similar to the CDPA. An interesting distinction was made between the Frisbee discs themselves and the moulds that produced them. The Court of Appeal rightly decided that it would stretch the definition of sculpture too far to rule the Frisbees themselves as sculptures, but this was made on the basis that they were manufactured by an injection moulding process.¹⁰ This has been deemed an odd distinction to make, because the Court ruled against Frisbees constituting sculptures purely based on the manufacturing process, which is not a statutory requirement in need of consideration.¹¹ Additionally, in spite of the Court of Appeal not wanting to stretch the definition too far beyond its original meaning, it still ruled that moulds for the Frisbees constituted sculptures, even though moulds designed for industrial purposes would not traditionally be viewed as artistic sculptures considering the ordinary use of the term. Therefore, the Court of Appeal may still have inadvertently widened the definition of a sculpture in spite of their intentions not to do so. This ruling clearly displays, however, the Court’s lack of judgment on the artistic quality of the objects in question, which aligns with the required statutory criteria.

After the decision in *Wham-O*, *J & S Davis* attempted to rationalise domestic copyright law by ruling that dental impression trays cannot constitute a sculpture.¹² Initially, this decision appears logical: to ensure

⁸ Langwallner (n 6).

⁹ *Wham-O Manufacturing v Lincoln Industries Ltd* [1985] RPC 127 (NZ CoA).

¹⁰ *ibid.*

¹¹ Anthony Misquitta, ‘What Is Art: Artistic Craftsmanship Revisited *Lucasfilm Ltd. v Ainsworth*’ (2009) 14 *Art Antiquity and Law* 281, 282.

¹² *J & S Davis (Holdings) Ltd v Wright Health Group Ltd* [1988] RPC 403.

the definition of sculptures is not construed too broadly, it sensibly ruled that dental impression trays cannot constitute artistic works. The decision in *J & S Davis* subsequently appears more coherent than *Wham-O's* decision to rule Frisbee moulds as sculptures, which broadened the definition. However, an issue arises from *J & S Davis*. The judgment is incompatible with the CDPA, because the main justification for the decision concerned the manufacturing process and the fact that the trays were temporary. These considerations are not a requirement of the Act.¹³ Thus, as with the *Wham-O* judgment, the judges were focusing on unnecessary factors in determining whether an object constitutes a copyright-protectable work. Therefore, even though *J & S Davis* ruled correctly in judging dental impression trays not to be sculptures, so that its definition remains rightly narrow, their justification was still flawed.

Next came *Breville*, and its judgment resembles *Wham-O* more so than *J & S Davis* in its ruling that plaster shapes for sandwich-maker appliances constituted sculptures.¹⁴ The similarities between *Breville* and *Wham-O* arise from the decision to label items as sculptures, despite them falling outside of the common use of the term, thus broadening its definition, whereas *J & S Davis* attempted to narrow it. Plus, despite the intuitively outlandish nature of these decisions, these two cases were decided in accordance with the historical and doctrinal view that artistic quality is irrelevant in determining artistic work, as it is clear that the judges were not making a judgment on the artistic nature of these 'sculptures' in accordance with statutory requirements.¹⁵

Just two years later, IP law was called to the stand again in *Metix*,¹⁶ in which Laddie J found that the moulds of cartridges used to mix chemicals did not constitute sculptures, contrasting the decisions of *Wham-O* and *Breville*, and following *J & S Davis*. It was ruled that,

¹³ Misquitta (n 11) 283.

¹⁴ *Breville Europe plc v Thorn EMI Domestic Appliances Ltd* [1995] FSR 77.

¹⁵ Langwallner (n 6) 13.

¹⁶ *Metix (UK) Ltd v GH Maughan (Plastics) Ltd* [1997] FSR 718.

‘there is no reason why the word “sculpture” in the 1988 Act should be extended far beyond the meaning which that word has to ordinary members of the public,’¹⁷ and the term should therefore be construed narrowly. A similar approach was taken in *Wildash v Klein*,¹⁸ in which it was ruled that craftworks made of out of wire, glass rods, glass nuggets, copper foil and other materials did constitute sculptures. Angel J cited Laddie J in *Metix*, arguing once again that the term ‘sculpture’ should not be stretched too far past its original meaning.

This diverse understanding of sculptures presented by recent case law still leaves the definitional issue unresolved. In *Metix*, Laddie J asserted the impossibility of specifically defining whether an item constitutes a sculpture.¹⁹ Although, he simultaneously found that a sculpture must be created by the hand of an artist, which significantly raises the standard for obtaining copyright protection. Such a narrowing of the meaning of a sculpture appears unjust when a comprehensive definition of a sculpture is not yet to be provided by the courts.

4 *Lucasfilm v Ainsworth*

Lucasfilm concerns the Stormtrooper helmets designed and produced for the first Star Wars film released in 1977, renamed as Star Wars Episode IV: A New Hope. George Lucas created the plotline and the characters, and Ralph McQuarrie designed two-dimensional versions of the costumes he envisaged for the Stormtroopers, including their armour and a helmet. Andrew Ainsworth then produced the three-dimensional vacuum moulds for the helmets that were used in the films. The issue arose in 2004, when Ainsworth started reproducing the helmets using his original tools and selling them to the public. In doing so, he made at least US\$8,000 but no more than US\$30,000. Upon discovering Ainsworth’s business venture, Lucas sued him in the US District Court in California for breach of copyright of the helmets. The

¹⁷ *ibid* 722.

¹⁸ (2004) 61 IPR 324.

¹⁹ *Metix* (n 16).

Court ruled in Lucas's favour, granting him US\$20 million in damages, but with Ainsworth's lack of assets in the US, three claims were initiated in the UK – one to enforce the US ruling, one under US copyright law, and a final one for UK infringement of copyright.²⁰

The debate in the UK over whether the Stormtrooper helmets constituted sculptures was important in relation to sections 51 and 52 of the CDPA. It was in Lucasfilm's interest to prove that the helmets were artistic works, specifically sculptures, because then the helmets would be exempt from the section 51 defence. As mentioned previously, section 51 provides that copyright is not infringed if one copies a design document, unless the copied design documents lead to artistic works, such as sculptures. Therefore, if Lucasfilm successfully argued that the helmets constituted sculptures, Ainsworth would have been unable to access the section 51 defence, and thus would have been infringing Lucasfilm's copyright by copying the original design documents of the helmets to recreate and sell them. Then, under section 52, Lucasfilm would also wish to prove that the helmets constituted sculptures, because otherwise the mass production and selling of the Stormtrooper merchandise would have invalidated the entire period of protection of their copyright; it would only last 25 years as opposed to the whole life of the author plus 70 years, and would therefore have expired by the time the case was heard, meaning Ainsworth would not be in breach of any copyright.²¹ It was therefore of paramount importance for Lucasfilm to prove that the helmets constituted sculptures.

In the UK High Court, Mann J dismissed the enforceability of the US judgment, and also ruled the helmets were not sculptures under the CDPA because of their utilitarian purpose, and therefore no copyright protection applied. In his judgment, Mann J disagreed with the rulings

²⁰ Kristen Elisabeth Bollinger, 'A New Hope for Copyright: The U.K. Supreme Court Ruling in *Lucasfilm Ltd. v. Ainsworth* and Why Congress Should Follow Suit' (2012) 20 *Journal of Intellectual Property Law* 87, 90.

²¹ Copyright Act, s 12(3)(a).

in *Wham-O* and *Breville*, instead agreeing with *Metix*'s narrow reading of the CDPA, and therefore argued that the helmets were not sculptures based on the fact that, '[i]t would not accord with the normal use of language to apply the term "sculpture"' to the items.²² However, the High Court did rule that the US copyright law claims were justiciable in the UK, and therefore Ainsworth was in breach of Lucas's copyright when the relevant US copyright legislation was applied.²³ The Court of Appeal subsequently agreed that the helmets could not be protected under UK copyright law, and similarly asserted that the rulings of *Wham-O* and *Breville* produced 'a result which offends common sense and in our view is wrong'.²⁴ The Court of Appeal also agreed with Mann J in that the US judgment was unenforceable, but overturned the decision that the US copyright claim could succeed, ruling that the enforcement of a foreign copyright claim was not within an English Court's power.²⁵ The UK Supreme Court (UKSC) agreed with the Court of Appeal, and therefore Lucas lost to Ainsworth, and was left with no way to recover any damages.²⁶

5 Analysis of the judgments

In *Lucasfilm*, the UK courts were faced yet again with the awkward question of 'what is an artistic work?' Or, more specifically, 'what is a sculpture?'²⁷ This raises a challenging point of law, as the CDPA is extremely clear that no judgment should be passed on the artistic quality of the pieces in question, so any judgment on the Stormtrooper helmets must be made on a purely objective level.

²² *Lucasfilm Ltd and Others (Appellants) v Ainsworth and Another (Respondents)* [2011] UKSC 39.

²³ *Bollinger* (n 20).

²⁴ *Lucasfilm Ltd and Others (Appellants) v Ainsworth and Another (Respondents)* [2009] EWCA Civ 1328, [2010] Ch 503 [66].

²⁵ *Bollinger* (n 20).

²⁶ *ibid.*

²⁷ Ron Moscona, 'Stormtroopers Suffer Crushing Defeat in English Court: Star Wars Copyright Decision Serves as a Reminder to the Creative Industries' (2010) 22(6) *Intellectual Property & Technology Law Journal* 19, 19.

Mann J described the Stormtrooper helmets as:

one of the most abiding images in the film ... The purpose of the helmet was that it was to be worn as an item of costume in a film, to identify a character, but in addition to portray something about that character – its allegiance, force, menace, purpose and, to some extent, probably its anonymity. It was a mixture of costume and prop.²⁸

Mann J used this definition to establish that the helmets were utilitarian and functional only as props within the film, but his in-depth, descriptive summary implies the opposite – that the helmets were works of art that had a visual appeal and an effect on the audience, and therefore cannot be confined to functional use as props. It also reveals that, whether consciously or not, a judgment was being made upon their artistic quality. These descriptive statements should be irrelevant to the argument that they are not sculptures because they have a utilitarian purpose as costumes. Instead one is left feeling that, if Mann J is capable of offering such an artistic description of the helmets, surely they are sculptures.

Mann J went on to list nine guidelines to consider when identifying whether an object constitutes a sculpture, as follows:²⁹

1. the normal use of the word sculpture has to be considered;
2. the concept could extend beyond what would normally be understood as a sculpture in the sense of a work in an art gallery;
3. it would be inappropriate to stray too far from normal considerations of what is a sculpture;
4. no judgment may be made about artistic merits;
5. not every three-dimensional representation of a concept is a

²⁸ *Lucasfilm Ltd and Others (Appellants) v Ainsworth and Another (Respondents)* [2008] EWHC 1878 (Ch), [2009] FSR 103, [2] and [121].

²⁹ *ibid* [118].

- sculpture;
6. a sculpture has visual appeal as part of its purpose;
 7. an object having an additional use may also qualify as a sculpture but it must still have a visual appeal to qualify;
 8. the purpose for which the object was created should be considered; and
 9. the process of fabrication is relevant but not determinative.³⁰

Some of these criteria seem very reasonable and reflect previous judgments handed down by Laddie J and Angel J, such as the first three requiring the use of the word ‘sculpture’ not to be stretched too far from its original meaning,³¹ and the fourth requiring that no judgment be made on the artistic quality of the piece.³² However, some criteria appear to overstep the judiciary’s legitimate role in applying IP law, delimiting its scope in a manner potentially incompatible with the CDPA. For example, criterion six requiring that a sculpture must have some visual appeal as part of its purpose necessitates an assessment of aesthetic quality of the item. This criterion is controversial because it could encourage a judgment upon artistic quality, which is strictly prohibited under the CDPA, and which is in direct contrast to Mann J’s fourth criterion.³³ Thus, if a court were to deem an item as too visually unattractive, they would consequently be denying it the status of sculpture based on a judgment of its artistic quality, contrary to the statutory requirements.

However, even if these requirements are not overstepping the mark and one believes Mann J is not suggesting a judgment on artistic quality, it seems the Stormtrooper helmets could meet these guidelines regardless. As *Lucasfilm* argued:

in the present case, the question of functionality does not arise,

³⁰ *ibid.*

³¹ *Metix* (n 16).

³² *Breville* (n 14).

³³ CDPA, s 4(1)(a).

because the articles in question have no functional purpose whatever. The Stormtroopers' helmets and armour did not exist in order to keep their wearers warm or decent or to protect them from injury in an inter-planetary war. Their sole purpose was to make a visual impression on the filmgoer. They are therefore artistic works.³⁴

Thus, the purpose of the helmets was artistic, as they were designed for the purpose of visual appeal. It therefore seems unjust for the UKSC to agree with Mann J in that the helmets cannot constitute sculptures based on the idea that, '[I]t was the Star Wars film that was the work of art that Lucas and his companies created. The helmet was utilitarian in the sense that it was an element in the process of production of the film.'³⁵ The UKSC admits that the film is clearly a work of art, but deem the helmets themselves as simply a process within the creation of the artistic film. This reverts back to cases such as *Wham-O*³⁶ and *J & S Davis*³⁷ which controversially argued for or against sculptures based on the manufacturing processes. The nature of this reasoning is dangerously close to the UKSC's ruling, as it takes into account unnecessary factors which are risking overly ambitious judicial interpretation that is incompatible with the CDPA.

Ultimately, copyright is primarily concerned with balancing the exclusive protection of the proprietor of the copyright, and allowing others to reproduce the works under fair dealing or another statutory defence outlined in the CDPA. Within that balance, both parties' financial interests are held in tension.³⁸ It therefore seems *Lucasfilm*

³⁴ *Lucasfilm* (n 22) [39].

³⁵ *ibid* [44].

³⁶ *Wham-O Manufacturing* (n 9).

³⁷ *J & S Davis* (n 12).

³⁸ Tim Vollans, 'Empire Strikes Back: Lessons from the Supreme Court's Judgment in *Lucasfilm Limited and Others (Appellants) v. Ainsworth and Another (Respondents)* [2011] UKSC 39, July 2011' (2012) 7 *International Journal of Law and Information Technology* 276, 277.

was less concerned about the issue of art, and much more about the issue of finances, given Lucas wanted to claim his US\$20 million in damages for Ainsworth's profit making of up to US\$30,000.³⁹

Considering the parties' drastically unequal financial situations, it is entirely possible that upon the case reaching the UK, Mann J in the High Court, the Court of Appeal, and the UKSC all recognised the economic weight of the proceedings and deemed it an extremely harsh judgment for Ainsworth to have been found guilty of infringing UK copyright law. One is therefore forced to ask: did the judges sympathise with Ainsworth, who would have owed substantial sums to the Lucasfilm corporation, so altered their interpretation of the statute to reach a just outcome in order to restrict the severe effects of a formalistic interpretation of the CDPA? This appears plausible, given a logical application of the CDPA would result in finding in favour of Lucasfilm. While a desire to protect an individual from substantial liability to a corporation would be understandable, this decision has come at the expense of a sensible application of legislation, compounding the confused and unsettled status of IP law in this area.

6 Conclusion

It seems clear that the ruling in *Lucasfilm* fails to clarify, and may further obscure, an already muddled area of IP law. Mann J was faced with a very difficult task of assessing all the previous case law concerning copyright and sculptures, which have been shown to be inconsistent and confusing, and his attempt to resolve the issues of IP law must be commended. Unfortunately, not only is the conclusion of the case logically suspect, with the Stormtrooper helmets ruled not to be sculptures, but the added element of considerable financial gains for Lucasfilm and an almost incomprehensible loss for Ainsworth creates an atmosphere of uncertainty surrounding the rationale of the decision. The UKSC has paved the way for future copyright claims, but it is unfortunate that *Lucasfilm* was unable to clearly provide the long-

³⁹ Misquitta (n 11) 289.

awaited answer to the question of ‘what is a sculpture?’ It is inevitable that the issue will arise again, and one must simply hope that the next occasion results in a comprehensive and satisfactory ruling resolving this lengthy discussion of copyright law and sculptures, although the case law’s history indicates this is unlikely.