



LUCASFILM V AINSWORTH

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SIMMONSCOOPERANDREW LLP

The prop designer who made the Stormtrooper helmets and armour for the 1977 Star Wars film has won his High Court battle against George Lucas after the English High Court dismissed Lucasfilm's claims for infringement of English copyright, passing off, breach of confidence, and breach of contract.

Lucasfilm also sought to enforce \$10 million out of a \$20 million Californian default judgment obtained in 2005 in Mr Ainsworth's absence. The High Court refused to enforce the US judgment.

Lucasfilm succeeded only in persuading the Judge that minor sales to the US were in breach of US (but not English) copyright law. Mr Ainsworth's admitted sales into the US were only £25,000 - £30,000.

Ainsworth was defended in the UK by international litigation specialists SimmonsCooperAndrew LLP, who instructed George Hamer and Alistair Wilson QC for the four week trial. Lucasfilm was represented by Harbottle & Lewis, who instructed Alan Bryson and Michael Bloch QC.

Mr Justice Mann said that Lucasfilm had adopted a "*sledgehammer or steamroller approach*". He went on to say "*what is quite clear is that Lucas is determined to stop Mr Ainsworth by whatever legitimate legal means are open to it, including the threat of a \$10m judgment hanging over him. Whether or not it is entitled to do that is, of course, a matter for this court.*"

For the copyright claim, Lucasfilm relied on 32 copyright works including the Ralph McQuarrie drawings, clay models and some of the helmets actually used in the film. Mr Ainsworth accepted that in making his replicas he was copying from those items, but subject to statutory defences.

Seamus Andrew, Managing Partner of SimmonsCooperAndrew LLP, who represented Mr Ainsworth, said "*Lucasfilm's suit against Mr Ainsworth was simply unsustainable as a matter of English IP law. It is not possible to tie up the creative efforts of a craftsman in the film industry indefinitely, no matter how much the film production companies would like to achieve this. The law has moved on, and now so can Mr Ainsworth.*"

In an important intellectual property decision, Mr Justice Mann cleared Mr Ainsworth of all counts of UK copyright infringement. A number of important legal findings will fall to be analysed by academic commentators as a result of the judgment. These include:

1. The definitions of "*sculpture*" and "*work of artistic craftsmanship*" under the Copyright, Designs and Patents Act 1988 ("the 1988 Act") have been tightened up somewhat. Mr Justice Mann found that the helmets were not sculptures, or works of *artistic* craftsmanship. This was not because they lacked artistic or aesthetic merit, but because they lacked artistic *purpose*. They were created in order to portray a character in a film, rather than as traditional works of art.
2. The effect of this tightening up of these definitions is to restrict the extent to which a film company can ring fence the copyright in costumes and props used for a film. Section 51 of the 1988 Act extinguishes copyright in items reproduced from industrial design drawings, and Section 52 of the 1988 Act reduces the period of copyright to 15 years from the first time the work is exploited by an industrial process. Section 51 cannot apply to either a sculpture or a work of artistic craftsmanship, and Section 52 cannot apply to a sculpture.
3. The Judge decided that Section 52 of the 1988 Act can apply regardless of the geographical location of the exploitation. The place of manufacture is irrelevant, contrary to the argument put forward by Lucasfilm, who argued that the relevant manufacturing process had taken place outside the UK.
4. The Judge took a broad view of the circumstances in which a prop maker can be deemed to have assigned any copyright to the commissioner of the work. Mr Ainsworth was not employed by Lucasfilm, nor did he agree to assign any copyright in the items. Nevertheless the Judge held that such copyright as might have existed in the items was ultimately the property of Lucasfilm, because Mr Ainsworth at least appreciated that the item he was being asked to produce was for a dramatic production.
5. Although Mr Ainsworth expressly marketed his products as "Star Wars" paraphernalia, made by the same person who made the original costumes for the Star Wars film, the Judge found that Mr Ainsworth was not guilty of "passing off", because he had not represented that he was *licensed* by Lucasfilm.

6. The Judge declined to enforce the prior US judgment (or any part of it) against Mr Ainsworth. Mr Ainsworth's US activities were not sufficient to render him susceptible to US jurisdiction in the eyes of the English High Court. In particular, it was not enough that he advertised for US customers via a website which was accessed by customers in the US (www.sdsprops.com). The English Judge rejected the US Court's exorbitant exercise of "long-arm" jurisdiction over Mr Ainsworth.

Various high profile witnesses gave evidence for Lucasfilm including academy award winner Norman Reynolds (the Art Director for Episode IV), Gary Kurtz (the producer for Episodes IV and V), Ralph McQuarrie (who created the original concept drawings) and Alex Tavoularis (who created the storyboards), as well as a professor of US law.

The effect of the judgment means that Mr Ainsworth can now make and sell his high quality, authentic replicas throughout most of the world.

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Notes to Editor:

SimmonsCooperAndrew LLP (www.scandrew.com) is a specialist dispute resolution firm with offices in the City of London and the British Virgin Islands.

Alistair Wilson QC is the head of Hogarth Chambers, and is one of the UK's foremost intellectual property lawyers.

George Hamer is a leading intellectual property junior at 8 New Square chambers.