The Star Wars Copyright Claim: An Ambivalent View of the Empire

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THE “STAR WARS” COPYRIGHT CLAIM: AN AMBIVALENT VIEW OF THE EMPIRE

The first Supreme Court decision on intellectual property (IP)—*Lucasfilm Ltd v Ainsworth* [2011] UKSC 39; [2011] 3 W.L.R. 487—presents an ambivalent image of the impact of Europeanisation on British sovereignty. In the first part of its Opinion, the court relies on the development of English IP legislation from the Statute of Anne 1710 to support a restrictive reading of the scope of artistic
copyright. In combination with its failure to refer to EU jurisprudence, it is tempting to read this as a rebuff to the European project, including the recent foray of the Court of Justice of the European Union (CJEU) into the realm of copyright subsistence (e.g. Bezpečnostní softwarová asociace—Svaz softwarové ochrany v Ministerstvo kultury (C-393/09) OJ C063/8). The second part of the Opinion, however, strikes a markedly different note. Relying largely on a “trend” set by EU legislation and the American Law and Max Planck Institutes, it supports an expansive reading of common law principles of justiciability as accommodating non-EU copyright claims, while also implying that the CJEU will determine when, if ever, English courts may decline to adjudicate such claims. The result is contradictory messages regarding the role of domestic courts, law and policy in the increasingly Europeanised field of IP.

*Lucasfilm* involved the reproduction for sale of objects created for use in the *Star Wars* films. The focus of the appeal was the Stormtrooper helmet: part of the “fascist white-armoured suits” for which (inter alia) the films’ costume designer won an Oscar award. Conceived by George Lucas, the helmet was given visual expression by various people, including Andrew Ainsworth, who was engaged to make vacuum-moulded prototypes of it in 1976. In 2004, Mr Ainsworth used his original tools to make versions of the helmet, which he offered for sale to the public over the internet. He sold between US$8,000 and $30,000 worth to American customers, and was sued by Lucasfilm in the Californian District Court. The court awarded a default judgment against him for $20 million, $5 million of which was for breach of copyright. Lucasfilm then sued him in England, seeking enforcement of its US judgment and copyright, and claiming infringement of various UK IP rights. In a decision by Mann J., the High Court ([2008] EWHC 1878 (Ch.); [2009] F.S.R. 103)(a) rejected its UK copyright claim on the ground that the Stormtrooper helmet was not an “artistic work” within the meaning of the Copyright, Designs and Patents Act 1988 (CDPA); (b) refused to enforce the Californian judgment on the ground that Mr Ainsworth’s internet trade did not give him a sufficient presence in the United States; and (c) held that English courts could adjudicate Lucasfilm’s US copyright claim. The Court of Appeal ([2009] EWCA Civ 1328, [2010] Ch. 503) affirmed (a) and (b) but overruled (c), prompting an appeal on (a) and (c) to the Supreme Court.

Under the CDPA, artistic copyright subsists in various categories of work, including “sculptures”, which include casts and models made for purposes of sculpture, and exist irrespective of artistic quality (CDPA s.4). An issue in recent cases has been whether sculptures thus defined include all hand-made three-dimensional objects, such as plastic toaster moulds and dental impression trays. In *Davis v Wright* [1988] R.P.C. 403 (Ch.) Whitford J. broke with authority to decide that they do not. In his judgment, sculptures are created with the intent that they exist as such, rather than as a step in a production process. In *Metix v Maugham* [1997] F.S.R. 718 (Ch.) Laddie J. agreed, accepting as a sculpture any object “made by an artist’s hand”. So too Mann J. in *Lucasfilm*, who derived from these judgments a multi-factor test focused on the ordinary meaning of “sculpture”, unconstrained by one’s view of artistic worth or of what one might expect to find in an art gallery (at [118]). Following the lead of the Court of Appeal, the Supreme Court affirmed this test, emphasising its fact-specific nature and the deference it
requires to the trial judge (at [45]–[47]). Consistent with this, it dismissed the first aspect of the appeal, agreeing with Mann J. (and the Court of Appeal) that “it would not accord with the normal use of language to apply the term ‘sculpture’ to a 20th century military helmet used in the making of a film” (at [44]).

The Supreme Court was right to approve the Davis/Metix conception of “sculpture”. The reason is its premise in a view of artistic works as constituted in part by their form and in part by the history of their individual creation, viz, the intent of their creator and view of society with respect to their nature (see J. Pila, “Copyright and its Categories of Original Works” (2010) 30 O.J.L.S. 229). On the other hand, its interpretation of that conception as excluding objects created as a step in any production process, including a creative or authorial process, may be criticised, as may its failure to clarify that objects are capable of manifesting the relevant intent even after the realisation of their formal properties. As it stands, the court’s Opinion could lead future courts to deny artistic copyright to design drawings and such objets trouvés as the “pile of bricks temporarily on display at the Tate Modern” considered at first instance by Mann J. (and affirmed by his Lordship to be a “sculpture” (at [118])).

The court’s copyright analysis may also be criticised on other grounds, including its extensive reliance on a particular interpretation of a complex period of English legal history, and its distinction between artistic and literary copyright.

According to the court, literary copyright and design right were introduced and developed in the 18th and 19th centuries to protect the commercial interests of stationers, booksellers, industrial designers and manufacturers, rather than in vindication of authors’ legal or moral rights (at [14], [16]). While artistic copyright was also introduced in the 18th century, it was limited and sometimes ineffectual, consistent with the law’s “principal concern” before 1911 with “the protection of printed words — published literary works” (at [14]). In combination with post-1911 developments, these factors were said to demonstrate “an emerging legislative purpose” of “graduated” protection for three-dimensional works, “quite unlike the protection afforded by the indiscriminate protection of literary copyright” (at [14]).

This analysis may be questioned on several grounds. First, it ignores that prior to 1911 literary copyright subsisted in “books”, which could include more than “printed words”. Secondly, it ignores the Statute of Anne’s own reference to encouraging “learned men to compose and write useful books” and protecting authors from ruinous piracy, as well as its effect in ending the stationers’ printing monopoly, divorcing “copy-right” from its censorial roots, and introducing the idea of modern “copyright” as a limited, transferrable, exclusionary right conferred on authors in respect of their published works. And finally, it ignores that literary authors were assumed from the 18th century (at least) to have common law rights in respect of their unpublished works (see W.R. Cornish, The Oxford History of the Laws of England Volume XIII (Oxford: Oxford University Press, 2010), p.884).

The Statute of Anne is a philosophically ambivalent piece of legislation that has been interpreted differently by different people since its enactment; its provenance has often featured in legal and policy debates, frequently in the service of contradictory ends. For example, and contrasting with the analysis above, in 2009 the High Court of Australia described it as having envisaged a “social contract” between authors and the public whereby the former “could obtain a monopoly” in
return for publication of their works (IceTV Pty v Nine Network Pty Ltd [2009] HCA 14; (2009) 239 C.L.R. 458 at [25]). In the High Court’s judgment, this supported a view of modern copyright legislation as having the same “utilitarian” basis, and a restrictive interpretation of literary (compilation) copyright.

The ambivalence of the provenance of English copyright makes it a contentious basis for contemporary decision-making. In *Lucasfilm*, reliance on such provenance and the early development of IP was also unnecessary given the decision which was reached. In essence, that decision was that “sculpture” for copyright purposes ought not to be treated as a legal term of art, lest copyright be permitted to protect non-authorial works. That copyright is appropriately confined to authorial works is right, but is a conclusion the court might more easily (and perhaps, more convincingly) have reached from analysis of the CDPA and European law (e.g. *Infopaq International A/S v Danske Dagblades Forening* (C-5/08) [2009] E.C.D.R. 16 (at [40]), interpreting Directive 2001/29/EC, art.2(a)).

Had the Supreme Court not relied so extensively on history, it is also unlikely to have contrasted artistic and literary copyright. That contrast is regrettable, as it implies a more expansive conception of literary (than of artistic) works, including, perhaps, a formalistic conception of such works. In fact, it was precisely this conception which the Court of Appeal adopted in *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890—published the same day as *Lucasfilm*—where it decided that a headline is “plainly” a literary work as “it consists of words” (at [19]).

Further difficulties arise from the Supreme Court’s resolution of the second issue on appeal. That issue was narrowly defined, as whether claims that a person over whom English courts have in personam jurisdiction has committed acts in a non-EU country that infringe the copyright laws of that country are justiciable in those courts (at [50]). The Court of Appeal had answered “no” in a judgment heavily influenced by its view of the constitutional remit of judges “to interpret the law, not to legislate” (at [129]). It is not for courts, their Lordships held, to re-fashion themselves “as some kind of non-exclusive world tribunals”: “That is the sort of thing that is done reciprocally and by an international Convention” (at [129]).

The Supreme Court paid short shrift to this finding. In its Opinion, any basis for denying the justiciability of foreign IP claims in the rules regarding torts (*Phillips v Eyre* (1870) L.R. 6 Q.B. 1) or immovable property rights (*British South Africa v Companhia de Moçambique* [1893] A.C. 602) has “disappeared” (at [80]) or “been fatally undermined” (at [71]) by subsequent legislation. *Tyburn Productions Ltd v Conan Doyle* [1991] Ch. 75 CA is thus overruled on this point. Nor, the court held, does the act of state doctrine provide an alternative basis for non-justiciability, by reason of its restrictive interpretation by the English courts (at [86]; but see at [115]). On the other hand, it discerned a “modern trend” in Regulations 44/2001/EC and 864/2007/EC, and reports of the American Law and Max Planck Institutes, “in favour of the enforcement of foreign [IP] rights” (at [108]), consistent with the interest of all states “in the international recognition and enforcement of their copyrights” (at [109]).

The court’s reasoning on justiciability is bold; less for its rejection of previous legal rules (which have long been criticised), than for its reliance on a “modern
trend” and the “interest of states”. This is particularly so given the concerns expressed previously by IP judges. They include the importance that IP decisions “command the respect of the public” in the jurisdiction in which they are enforced because of the public interest aspect which they involve (see Plaustis Kreativ AB v Minnesota Mining and Manufacturing Co [1995] R.P.C. 438 at 447, discussing patents), especially in a field such as copyright which is widely perceived to be “over-strength, over-regulated, and over-rated” (see H. Laddie, “Copyright: Over-Strength, Over-Regulated, Over-Rated” [1996] E.I.P.R. 253).

The Supreme Court’s decision regarding justiciability has evident doctrinal significance for and beyond IP. It also raises difficult questions regarding the boundaries of (and distinction between) substantive and procedural law, and the principles to be applied in determining remedies. For example, will the UK courts be required to award damages in the order of US $5 million for breach of US copyright? The question raises a further issue, which is when English courts ought to enforce foreign copyright claims (now that it has been established that they may) (see R. Fentiman, “Intellectual Property and the Brussels Convention” [1997] C.L.J. 503 at 506), and when they must do so. Consistent with this, the most important aspect of Lucasfilm may be the court’s willingness to countenance a direction from the CJEU to accept jurisdiction in any case involving a non-EU claim against a person in respect of whom it has in personam jurisdiction under EU legislation (at [113]). In this respect it again contradicts the Court of Appeal, which had refused to support a referral to the CJEU on this matter because of its view that EU legislation cannot create “extra-EU jurisdiction” (at [129]), whatever the CJEU may have suggested in Owusu v Jackson (C-281/02) [2005] E.C.R. I-1383.

In conclusion, it seems settled that responsibility for deciding when English courts may decline to enforce non-EU claims will be accepted in the future as residing with the CJEU, which, given that court’s civilian orientation and distaste for common law rules and discretion, may be reluctant to accept anti-suit injunctions, forum non conveniens, and other English measures for declining jurisdiction in individual cases. The result of Lucasfilm is therefore likely to be a further dismantling of the common law of conflict of laws, and indeed of the common law itself (see T.C. Hartley, “The European Union and the Systematic Dismantling of the Common Law of Conflict of Laws” (2005) 54 I.C.L.Q. 813; also KN v JCN [2010] EWHC 843 (Fam) at [65]). That the decision may also require English courts to adjudicate conflicting European and international legal obligations in this area is another possibility to which the Supreme Court alluded (at [112]), and is an eventuality that should further clarify the role of domestic courts in fashioning the principles around which—in this era beyond the sovereign state—legal and political communities are increasingly being re-organised (see N. MacCormick, “Beyond the Sovereign State” (1993) 56 M.L.R. 1).\footnote{Copyright; Films; Foreign copyright protection; Infringement; Sculptures}

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