

Neutral Citation Number: [2008] EWHC 1878 (Ch)

Case No: HC06C03813

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
INTELLECTUAL PROPERTY

Royal Courts of Justice
Strand, London, WC2A 2LL

Date: 31/07/2008

Before :

MR JUSTICE MANN

Between :

(1) LUCASFILM LIMITED
(2) STAR WARS PRODUCTIONS LIMITED
(3) LUCASFILM ENTERTAINMENT
COMPANY LIMITED

Claimants

- and -

(1) ANDREW AINSWORTH
(2) SHEPPERTON DESIGN STUDIOS
LIMITED

Defendants

MR. M. BLOCH Q.C. and MR. A. BRYSON (instructed by **Harbottle & Lewis LLP**) for the
Claimants.

MR. A. WILSON Q.C. and MR. G. HAMER (instructed by **SimmonsCooperAndrew LLP**)
for the **Defendants.**

Hearing dates: 8th, 9th, 10th, 11th, 14th, 15th, 16th, 17th, 18th, 21st, 22nd, 24th, 25th, 29th, 30th April and
1st and 2nd May 2008

Judgment

Mr Justice Mann :

Introduction

1. This is a case about the reproduction of replicas of various props used in the first Star Wars film. The Star Wars films are a series of science fiction films set at some different time and in another part of the Universe, and which feature the struggle between good and evil. They contain a heavy militaristic element, and that in turn requires uniforms. This case concerns the production of uniforms for the first of the films in the series, which is known as “Star Wars IV – A New Hope” and which was first shown in 1977. It bears the number IV, even though it was the first in the series to be produced, so as to leave room for expansion backwards in time, as it were, or “prequels”. I shall simply call it “Star Wars”, or “the film”. The second claimant was the English production company for the film; all the claimant companies are, taken together, the producing or licensing companies, and it is accepted that between them they have the necessary rights (if anyone has) to bring the claims made in this action. It is therefore largely unnecessary to distinguish between them; I can call them corporately “Lucas”.
2. One of the most abiding images in the film was that of the Imperial Stormtroopers. These were soldiers clad in white armour, including a white helmet which left no part of the face uncovered. The second defendant (Mr Ainsworth) made that armour for the film in vacuum-moulded plastic. He has recently started selling versions to members of the public, both in the form of a complete set and the helmet alone. That is said to infringe the copyright of the claimants. He also sells replicas of other helmets. These again are said to infringe. He is able to make these things because he made the originals for the film, and has kept the tools or moulds on which they are made. This action seeks to enforce the intellectual property rights of the claimants. It is based on copyright infringement and passing off. There is also a contractual claim, allied to a claim based in confidence. They all seek essentially the same thing in relation to all the helmets and armour. In addition there was, until its abandonment at the trial, a trade mark claim in relation to one of the adornments of two of the helmets. There are two more limbs in relation to US-centred activities. First, there is a claim to enforce a Californian default judgment which the first claimant obtained against Mr Ainsworth, and second (as an alternative) there is a claim to enforce an American copyright claim itself. At the trial Mr Michael Bloch QC led for the claimants; Mr Alastair Wilson QC led for the defendants.

Claimants’ witnesses

3. I heard from the following witnesses on behalf of the claimant.

Mr Norman Reynolds

4. At the relevant time he was an Art Director engaged to work on the film. He gave some general evidence about the process of creating some of the relevant parts of armour and headgear, and in particular the Stormtrooper helmet. His recollection of the matters that he could recollect was, in my view, generally reliable. He was a careful witness.

Mr Brian Muir

5. Mr Muir is a sculptor and described how he contributed to the making of the armour for the Stormtrooper. He is plainly a skilled man, and has a good general recollection of the events at the time. He has been in the film industry since 1968 and was able to bring considerable experience to bear. His job, in relation to the armour, was to create a clay version on a model of an average size actor, and then to carve or sculpt a plaster version of the armour which was taken from that. Further details of this process are given below in the narrative of fact. I was able to accept his evidence, including important evidence of timing.

Mr Roffman

6. Mr Roffman is a vice-president of the first claimant, and is in charge of the licensing of Lucas products. He gave some uncontested evidence about the significance of licensing, and a small amount of uncontested detail about licensees. He was, however, cross-examined at some length about his honesty, because the defendants were alleging that he gave some dishonest evidence in the application on which the US default judgment was based. He gave his evidence very carefully, as one would expect of someone in his position accused of dishonesty (an accusation which, if true, could have attracted criminal sanctions in the US). This allegation was unreservedly abandoned after some 2½ hours of cross-examination, and in my view rightly so. He stands entirely acquitted of dishonesty. His evidence can be accepted.

Mr Mollo

7. Mr John Mollo was in charge of the costume department for the film. He was responsible for detailed costume design and ended up having dealings with Mr Ainsworth over the design and procurement of the armour and helmets, and gave evidence of those dealings. He had a particular expertise in military uniforms, which is one of the reasons that he was hired. His evidence is important because it is the foundation of a large part of the genesis of the actual designs relied on by the claimants. He is clearly a skilled designer with a great eye for meticulous detail. Unfortunately his oral evidence did not demonstrate the same care. While he was plainly a witness who came to tell the truth, and to be straightforward, he was also an unfocussed and sometimes careless one. His demeanour demonstrated that often he did not concentrate fully on the question, and would often carelessly respond with a “Yes” which his demeanour suggested might be merely an indication of his understanding of the matter being referred to in the question or suggestion rather than an intended affirmation of the substance of the question. When combined with a cross-examination that was sometimes less than focussed, it means that his evidence has to be approached with some care – not, I stress again, because he was an untruthful one, but because he sometimes lacked care.

Mr Gary Kurtz

8. He has many years in the film industry and was the producer on the film (and the next one in the series as well). He gave careful albeit limited evidence of the background to the production and his involvement in it, and in particular how it moved from the conception in the mind of Mr Lucas, through sketches and into production. He

described his understanding of how Mr Ainsworth came to be involved. He gave his evidence in a careful and measured fashion, and in the main I can rely on what he said, though he did give some evidence about Mr Mollo's detailed involvement which did not coincide with Mr Mollo's.

Mr John Richardson

9. He was called to give evidence as to the genesis of a particular clay model of the Stormtrooper helmet. His witness statement deposed to its having been made by a Liz Moore. From an undisputed photograph it appeared that the model was made in red, and not grey, clay. In cross-examination he said that she worked only in grey clay. As a result of his evidence the claimants abandoned their contention that she had made the model. As a result I need say no more about his evidence.

Professor Peter Menell

10. He was called to give expert evidence on US intellectual property law so far as relevant to the attempts in this case to enforce infringements of that law in this jurisdiction. His written evidence was extremely thorough; it was like reading a large section of a basic textbook with copious citations. I am satisfied that he was a reliable witness who gave his honest opinions in compliance with English requirements applying to experts.

Professor Roger Fenner

11. He was called to give rebuttal evidence as to the materials used in certain helmets. In the end his evidence was not controverted and did not go to as central issue in the case. I do not need to say anything more about him.

Written evidence

12. The claimants also put in evidence from Mr Ralph McQuarrie, who made important early drawings and paintings. He lives in California and his written evidence was submitted unchallenged under the Civil Evidence Act because he is too elderly and physically unable to travel to London. The written evidence of Mr Alex Tavoularis was also admitted under that Act. He drew some story boards for the development of the film's ideas, some of which contained characters and designs relevant to this case. His evidence was, however, relatively peripheral to the issues in the case.
13. Witness statements were provided by four other witnesses, who were not called for cross-examination. They were:
 - (i) Mr Mark Owen, a solicitor from Messrs Harbottle & Lewis, who provided evidence relating to the US proceedings.
 - (ii) A Mr Stephen Sansweet, who provided peripheral evidence as to whether the disputed helmets were ever manufactured in the UK (other than by Mr Ainsworth)
 - (iii) A Mr Peter Anderson, a Californian attorney who gave evidence about the availability of set-off in California. This was only ever relevant to an application for security for costs made by Mr Ainsworth shortly before the trial, and which

was made again at the trial. It was dealt with without any need for me to make a ruling.

- (iv) Mr David Anderman, who gave formal evidence as to the current ownership of copyrights as between the various claimants.

Defendants' witnesses

- 14. The following gave evidence for the defendants.

Mr Ainsworth

- 15. He was, of course, the principal defence witness. He is the sole director of the second defendant. He did a diploma course in engineering and is extremely interested in making things. For a time he produced small cars, and he has a great interest in vacuum moulding plastics, which process he has used for making many things. He is clearly a gifted man in terms of his design ability, his fabrication skills and related vision. However, in his evidence he betrayed that he has become somewhat obsessed with the present dispute, and that has led him to put forward versions of events which are reconstructions designed, wittingly or unwittingly, to support his case. His evidence on the events of 1976 changed on a number of occasions. In one sense that is not surprising. Having a detailed recollection of events which took place over 30 years ago is difficult if not impossible, and any purported recollection of detail (and indeed of general patterns) must be viewed with caution. In some cases it will reflect well on a witness's credibility and honesty that he or she is prepared to accept that an initial recollection is wrong in the light of evidence given by others, or of material which can be extracted from genuine contemporaneous documents. However, Mr Ainsworth's changes of evidence sometimes went beyond that. He provided an initial long witness statement. (Although it was described as his second witness statement, presumably because there was a prior one which was not used at the trial, I shall refer to it hereafter as his first, renumbering the subsequent ones as well.) Then, when witness statements were provided by the other side, and when he had further studied documents, he supplemented that with a further witness statement which sought to indulge in a process of amendment and reconstruction. At this stage most of his corrections are fair enough – they are the kind of corrections which many honest witnesses, reflecting on their witness statements, are minded to make because they are doing their honest best. His process of reconstruction, however, betrays a vigour in his approach which puts him more in the role of advocate than witness. In these two witness statements he went so far as to suggest that certain drawings which appeared in Mr Mollo's notebook, and which Mr Mollo's evidence stated to be his (Mr Mollo's) looked as though they could be in another hand. That was always an implausible allegation, and by the time of the cross-examination of Mr Mollo it had been abandoned. This was reflected by an express abandonment in his fourth witness statement. This incident, and others, demonstrates that Mr Ainsworth is always looking for a gloss on, or analysis of, evidence which will favour his case.
- 16. Another example concerns his evidence about a space helmet that he helped to design and which he fabricated for a later film called Outland. He discussed this with Mr Mollo before producing it. Until a short time into his cross-examination, he stoutly maintained that Mr Mollo never showed him any drawings in relation to his (Mr Mollo's) requirements. In cross-examination he was forced to admit that he did get

drawings from Mr Mollo. His attempts to play up his part, and to play down Mr Mollo's part, in the creation of this helmet is a good example of his viewing events through his own Ainsworth-tinted spectacles.

17. He also demonstrated a tendency to take credit for things that he was not entitled to in other ways. In his first witness statement (and not corrected by any subsequent witness statement) he said that he created a costume and a particular artefact for a later film called "Alien". His witness statement clearly stated that they were used in the film, and the purpose of the evidence was to establish his credentials as an important prop maker. In fact the position was that the costume was not used at all (and he was aware at the time of the making of the film that it would not be) and the artefact was not used in the final cut of the film (which he realised when he saw the film at the time). His statement was therefore untrue, and plainly so. Furthermore, he did not acknowledge that there was anything wrong with his witness statement in this respect. He was either being dishonest about that, or he has a strange subjective view of the truth which calls into question his reliability as a witness in relation to such matters.
18. Again, he claimed to have "designed" in 1977 certain Martian characters used in a well-known advertisement for Cadbury's mashed potato. While he was able to produce an invoice for the fabrication of some characters in 1977, which might have been similar characters, the original advertisements went out 2 or 3 years before that. He said that he did not know that there were prior adverts or prior characters, and no-one had shown him any designs at the time he was instructed in 1977. Nevertheless, he said that his designs were the same or virtually the same as those in the prior advertisements. In my view that can only have happened if he saw those prior designs, which would in fact make sense – if (as I find) in 1977 the producers (or their agency) wanted more of the same characters, why would they not demonstrate what they wanted reproductions of?
19. These particular points are not just general credibility points. They are credibility points going to a central issue in this case, namely the reliability of Mr Ainsworth's evidence as to his alleged design of some of the relevant material in this case. He has clearly demonstrated that he is prepared to claim more than he is entitled to in other contexts. I have to bear that firmly in mind in considering his claims in relation to the designs in issue in this case.
20. Immediately before he went in the witness box, he produced more evidence in the form of a marked up version of his first witness statement, showing deletions and additions that he wished to make. Some of them were minor; many of them were not. They amounted to very material variations from the first witness statement, for whose truth he had vouched in his statement of truth. That, of itself, might not be a factor going to credibility, but the number and nature of the changes means that in the present case it is.
21. All these factors, and other challenges made to his credibility during the case, make me approach Mr Ainsworth's evidence with a great deal of caution.

Miss Bernadette Pitfield

22. Miss Pitfield is the partner of Mr Ainsworth. She gave short evidence in chief about Mr Ainsworth's fabrication of two of the more minor helmets which are the subject of this

action. Her evidence was relatively slight. She was an honest witness, but cannot be expected to have a relevantly detailed recollection of events in 1976.

Mr Clive Payne

23. He was called to give evidence of how Mr Ainsworth made two of the more minor helmets and of how they were named. He is a long time friend of Mr Ainsworth. He came over as slightly glib and careless in his recollection. I do not think that he gave dishonest evidence, but in matters of detail I do not think I can rely much on his evidence.

Mr Nick Pemberton

24. Mr Pemberton is now retired, but for the whole of his working life he was a freelance scenic artist and prop maker. It was to him that Lucas turned when they wanted the assistance which underlies this case, and it was he who was engaged, at least initially. He created a clay model of the Stormtrooper head which ultimately went to Mr Ainsworth, and Mr Ainsworth was his subcontractor in the early phases of the relationships. He was a good, careful and reliable witness. He was never afraid to say he could not remember, and did not seek to fill in the gaps with uncalled-for reconstruction or speculation.

Ms Nicola Howard-Jones

25. At the time of the events in question she lived with Mr Pemberton. She is, amongst other things, a sculptress, and helped to make models and prototypes of two of the helmets. Her witness statement came in late – towards the end of the claimant's evidence. The decision to approach her was apparently a late decision. Quite understandably, she had difficulty in dredging up these 1976 events from her memory, particularly at short notice. She did her best, and was plainly honest and trying to help, but her recollection of the detail which she was asked to recall was understandably poor.

The facts

26. In the narrative that follows, any recitation of fact should be treated as a finding of fact unless the contrary appears.
27. The events in question took place over 30 years ago. There was an understandable failure of memory of a lot of detail on the part of a number of witnesses. None of the witnesses can be criticised for that. Some memories seem to have been slightly surprisingly strong, but that is doubtless explained because the project that the witnesses were involved in was a striking one. Some reconstruction of precise (or more or less precise) dates has proved possible because of two contemporaneous documents which have survived. The first is Mr Pemberton's diary, which records not only his activities (in general terms) but also some of Mr Ainsworth's. It was not explained how Mr Pemberton's diary came to record the latter, but its accuracy in this respect was not challenged.

28. The second document (more precisely, a set of separate documents) is a bound up version of notebooks kept by Mr Mollo at the time. Mr Mollo had notebooks in which he did various relevant things. First, he did sketches of proposed costumes and other artefacts that he was expected to produce. Second, he noted things that he need to do, or things that happened at meetings. And third, he experimented with a diary system, mapping out a week or month ahead in box form and inserting forthcoming events and short records of past events (and things such as travel expense information). Not every page is dated, and some reconstruction of the dates of some important drawings has to be done by reference to other dated pages, but the notebook is nonetheless an important contemporaneous record which assists with the dating and recollection (and reconstruction) of events.
29. The history of the matter is most conveniently pursued in three principal strands, in the interests of intelligibility. The first convenient strand is the Stormtrooper helmet; the second is the Stormtrooper armour; and the third is the other items (mainly other helmets). Then I shall turn briefly to the subsequent events that give rise to this action, as to which there is no real dispute in relation to the main steps in the story.

The conception of the film; the design control of Mr Lucas; and the creation of the Stormtrooper helmet

30. The original conception of the Star Wars films was that of the producer and director, George Lucas. He plainly had many, and clear, views of how he wanted the film and its characters to look. He worked with many people in order to achieve that. One of those people was Mr McQuarrie. Mr McQuarrie drew many designs. They included two important paintings, one called "Cantina" and the other called "Imperial Troopers confronting Hans Solo, Luke Starkiller and Chewbacca the Wookiee". The importance of those paintings is that each contains a depiction of a Stormtrooper and each was provided to those who were charged with producing the props to make Stormtroopers for the film. The drawings show a figure in white or silver armour (the intention was white, but Mr Ainsworth accurately pointed out that it might be taken to be silver). Those figures are shown in the drawings annexed to this judgment. They were arrived at after various drafts, and after careful consultation with Mr Lucas; and they embodied what Mr Lucas wanted so far as the appearance of the characters went (and indeed other matters). He specified the general look and approved the final drawings; it was he who specified that the armour and helmets should be white.
31. The design control by Mr Lucas was an important factor in the conception and production of the film. Mr Tavoularis explained that his storyboards were important in assisting the director and others in visualising the script. He worked from drawings and paintings prepared by Mr McQuarrie though he never met him. When he prepared drawings he submitted them to Mr Lucas. The latter gave his views and further requirements, and by this process storyboards emerged which reflected Mr Lucas's vision. Mr Reynolds confirmed that the characters as depicted in the film had to be as Mr Lucas visualised them; Mr Lucas's overall involvement in set, props and costume design was, in his experience unusual. Other witnesses testified to the close involvement of Mr Lucas in design matters. This film was encapsulating his vision, and ideas were submitted to him for approval as they evolved. Thus Mr Mollo told me (and I accept) that all the helmets that are in issue in this case were submitted to him for approval. Mr Muir told me that he approved the final sculpt of the Stormtrooper

armour created by Mr Muir. I am satisfied that at all times those entrusted with creating the film had to base themselves firmly on Mr Lucas's perceptions, and had to seek his approval on a considerable amount of detail, including the detail of the material that is the subject of this action. One of his concerns was to try to create a greater impression of practicality in the uniforms and weapons than existed in other science fiction productions, and as a result many of the uniforms and weapons were to have, and had, a World War II resonance.

32. I have already described how Mr McQuarrie and Mr Tavoularis created designs and drawings. I have seen many of them. They formed an important part of the background as to how the film was to look. This work was going on in 1974 and 1975. By the middle of 1975 pre-production work was being set up and certain areas of work commenced in England, in North London. An Art Department was set up, and (among other people) Mr Reynolds was recruited, along with Mr John Barry, a production designer. Mr Mollo was engaged as costume designer; as his job title suggests, it was his job to come up with costume designs. By September 1975 the production work had migrated to Elstree Studios; Mr Lucas and Mr Reynolds came over from the US to live here for a time, in order to be close to the production. Set building began at the beginning of 1976; preliminary shooting of some desert scenes was to take place in mid-March, which meant that deadlines and time limits became more important. In particular, a limited number of some helmets (including Stormtrooper helmets) and some armour needed to be ready by then. Although the production had a lot of in-house expertise, these deadlines meant that they had to turn to out-of-house people.
33. One of the people to whom they turned was Mr Pemberton. He was asked to go to the studios to meet Mr Lucas, probably on 6th January 1976. Mr Lucas showed him the two Mr McQuarrie paintings referred to above and asked him if he could produce the Stormtrooper helmet shown there. He went away in order to do so and started to sculpt a clay head, basing himself on the Mr McQuarrie paintings. He showed his first attempt to Mr Lucas a few days later, and Mr Lucas made certain observations on it. Amendments were carried out and another version was shown to Mr Lucas, of which he approved at a third meeting between the two men. In the evidence there is a photograph of what is probably Mr Pemberton's clay head, with Mr Lucas studying it from behind. It has some of the general shape, but not the sort of "facial" detail that one sees in the final version of the helmet. It is not clear at what stage of the sculpting that photograph was taken, or what extra detail was subsequently added, but it is plain that Mr Pemberton was following pretty closely the design of the helmet as shown in the two paintings. It is also plain that Mr Lucas had to be satisfied about the appearance of the helmets.
34. At the third meeting Mr Lucas asked Mr Pemberton to produce a quantity (probably 50) of the helmets. Mr Pemberton did not have the time or, more significantly, the expertise to manufacture a real version himself, so he turned to Mr Ainsworth, who worked and lived 2 doors away and with whom he had had some prior dealings. He respected Mr Ainsworth's ability to work with plastics. Mr Lucas was told by him that he would be able to arrange for the helmets to be made, but Mr Ainsworth was not identified to him.
35. On or about 20th January Mr Pemberton spoke to Mr Ainsworth about the making of the helmet. He explained that he had a customer who wanted a helmet as a prop, and

showed him, and provided him with, good reproductions of the two Mr McQuarrie pictures and his clay model. Mr Ainsworth says that the clay head did not have much detail on it – it did not have eyes, or ears, or any indication of surface finish. Mr Pemberton was unable to say precisely what his head looked like when he handed it over, in terms of the details conveyed. I am, however, satisfied on the probabilities that it was a reasonable 3D rendition of the Stormtrooper in the Mr McQuarrie paintings. The Stormtrooper was a key character in the film, and Mr Lucas is likely to have wanted to see some significant level of detail in its realisation before approving the clay head. Mr Ainsworth was asked if he could produce a helmet in accordance with the drawings and clay head, and he agreed he would produce something. Mr Ainsworth says that the customer was not identified at that time, and he did not even know it was being produced for a film. He thought that it would be used in a play. This was not materially challenged, but the significant thing is that he appreciated that it was a thing for a dramatic production by a customer of Mr Pemberton.

36. Mr Ainsworth spent a couple of days producing a prototype. He worked from the material he had been given by Pemberton, but added some detail of his own. He had to consider the practicalities of production. The helmet was produced in five parts – the face, the back/crown, an ear piece on each side and an insert piece for the eyes. One of the functions of the separate ear pieces was to cover the join of the other principal parts. They were one aspect of detail where he did not reproduce what was apparent from the McQuarrie drawings. He added his own refinements of precisely how the facial detail was to look – he produced the precise detail of the “frown” (the apparent nasal region), decided how precisely to produce the effect at the “mouth” and on each side (for the latter he used microphone ends) and he decided to use a black rubber moulding (from a car part) above the eyes (the drawings did not contain a black feature there). His initial evidence sought to portray him as being the person who “convinced” Lucas to use white for the helmet (and the armour). He said that he had thought the drawings portrayed silver armour. Whatever he may have perceived as the colour in the drawings, it is quite clear from the evidence that Lucas had already decided to use white. Lucas therefore needed no persuading or convincing, and in his cross-examination he very much toned down the statements in his witness statements about this. I think that this is another example of Mr Ainsworth’s propensity to claim authorship of ideas with no real justification for doing so.
37. Be that as it may, Mr Wilson, on behalf of Mr Ainsworth, did not dispute that the helmet thus produced (and the final version) was a substantial reproduction of the McQuarrie material for copyright purposes; and Lucas did not dispute that some of the detail on the prototype and the final version was created by Mr Ainsworth. I received a lot of evidence from Mr Ainsworth as to how precisely he first produced his own version of the helmet, and how he then went on to make the various moulds which he used for vacuum-forming the five parts which made up the whole. In the end little of that detail mattered, in relation to the Stormtrooper helmet. What is important is the source of its design. During the process of making the prototype Mr Pemberton’s clay head was destroyed in some sort of accident. Again, nothing now turns on this, since on any footing the Mr Ainsworth helmets were substantial copies of the McQuarrie drawings.
38. As part of the evidence I was provided with a DVD film of Mr Ainsworth in his workshop, demonstrating his techniques. Vacuum-forming involves the making of a

tool or mould which represents the shape of the finished item and over which plastic is forced in order to produce that shape. A sheet of plastic is heated so as to make it malleable, and the tool is forced up into the softened sheet, while a vacuum is formed under the tool. The vacuum helps to force the plastic around the shape of the tool. The word “tool” is probably a slightly better word than “mould”, but I shall use both indiscriminately in this judgment.

39. Mr Ainsworth made several prototypes as he tried to get to a satisfactory design. In his first witness statement he suggested that he gave a prototype to Mr Pemberton at the beginning of February, and the latter in turn showed it to Mr Lucas. However, having studied Mr Pemberton’s diary closely, along with Mr Mollo’s diary entries, Mr Ainsworth changed the chronology and participation of the parties significantly. Having originally portrayed the situation as one in which he did not know who the end user was, and in which he did not meet Mr Mollo until mid-February, he then suggested that he met Mr Mollo as early as 23rd January. He also materially shifted the date on which he said he was asked to create other helmets from March to this January date. Whether he was right about that, I think it likely that he did meet Mr Mollo before mid-February. They probably met in the last week of January, either at Mr Ainsworth’s premises or at Mr Pemberton’s, and that enabled them to have a discussion about the then form of the prototype helmet. There was discussion about further modifications to the design – Mr Mollo accepted, and indeed asserted, that there were changes which were discussed between him and Mr Ainsworth. There was an exchange of ideas, probably over the next week or two, leading to the presentation of what seems to have been a final prototype to Mr Lucas on 17th February. There was a dispute as to the date when the first prototype was handed over, but the precise date does not matter; it was at some point within the last 10 days of January 2006. There may have been a little discussion over the modification of detail. Mr Lucas, who was still exercising the close and detailed control that he had hitherto exercised, approved the helmet by 19th February and he and Mr Mollo said that they wanted 50 of them. They dealt with Mr Pemberton in relation to that. Mr Pemberton told Mr Ainsworth that he wanted 50 helmets and Mr Ainsworth quoted £20 per helmet. Mr Pemberton said he would have to get back to his customer about that and a couple of days later the price was approved. Mr Ainsworth set about making the 50 using his moulds and vacuum moulding machinery. Some were made in a khaki plastic and painted white, but that was less than satisfactory because the paint tended to come off, so he made most in white ABS. They were delivered to the studio during March and Mr Ainsworth invoiced Mr Pemberton for them. He was duly paid. More were produced later.

The Stormtrooper armour

40. The Stormtrooper armour is another detail conceived by Mr Lucas. Mr Muir told me how his conception was embodied, in its early stages. The armour was the first project he worked on in the film. He worked from the two McQuarrie drawings given to Mr Pemberton and Mr Ainsworth. A plaster cast of an average-sized actor was taken, and used as a sort of tailor’s dummy on which armour was modelled using clay. During the modelling phase changes were made as required by those involved in design, which must have included Mr Lucas. The final sculpt was approved by both Mr Lucas and Mr Barry. That approval having been given, the model was broken down into sections and a rubber mould was taken (within a fibreglass case). From that rubber mould a plaster cast was made, giving the same shape as the original sculpture. Mr Muir then worked

on the plaster by carving to produce a more refined version of the original clay shapes. Again, Mr Lucas was involved in approving detail at this phase of the operation. The detail was sharper so that when (as would happen later) moulds were produced, the detail would survive through the ensuing process into the final shapes. This phase, Mr Muir said, took him about 4-5 weeks and was finished by the end of January 2006.

41. That completed his direct involvement in the process. He said that what happened next was that another rubber mould was taken from those plaster works, and from those moulds fibreglass tools were produced on which the armour was to be vacuum moulded. I can see from the armour displayed during the trial that the full armour set involved a number of pieces – back plate, two front pieces, shoulder pieces for joining the back and upper front piece, a belt, shoulder, upper arm and lower arm pieces, pieces for the back of the hands, upper and lower leg pieces and different pieces for each knee.
42. Mr Muir believed that the fibreglass tools were supplied to Mr Ainsworth so that he could make armour. The precise circumstances in which Mr Ainsworth, rather than the studio workshops, came to be asked to make the armour (which he undoubtedly was) was the subject of some dispute on the evidence. It was suggested by Mr Wilson that the studio vacuum production facility, which might have been expected to be made available for producing the armour, would have been used for this process, but in fact it was not. Whether this was because it was not up to the job, or whether time did not permit it to do it along with all its other commitments, is not something that I have to determine, and I do not do so. Mr Muir says that he saw the final fibreglass tools, though he did not see them used.
43. On about 17th February, on the occasion when Mr Pemberton took the prototype helmet to the studio for Mr Lucas's approval, he was told that Lucas was having trouble making the armour. He believes that he was told that the vacuum forming machine could not handle the heavy gauge material required. He suggested that he knew someone (meaning Mr Ainsworth) who could make the armour if the studio could not cope. Lucas were interested and a few days later (on about 26th February), on a visit to the studio at Elstree, Mr Ainsworth was asked if he could produce some armour. A deadline was looming, because in mid-March filming was due to begin in Tunisia, and several sets of armour were required for that. Mr Ainsworth agreed to attempt to produce armour. Over the following weeks he did so, both for the initial filming and for subsequent studio production. He also modified the armour in order to make it more wearable, based on the experience of actors on the Tunisia shoot, and produced modified tools to produce it. The armour that one sees in the 1977 film was all made by him. He made 50 sets. In relation to the armour, Mr Ainsworth contracted directly with Lucas. His invoices were drawn on the instructions of Mr Mollo. He did not have an order number before the Tunisia shoot, but he obtained one afterwards. His first invoice was for 50 sets of armour at £385 per set, and his invoice for new tools, including some for additions, apparently, was for 12 sets of tools at £200 per unit.
44. There is a dispute as to what Mr Ainsworth was provided with for that purpose. At the beginning of the trial that was of great significance, because Lucas claimed that Mr Ainsworth had been provided with all the fibreglass moulds that it had created, and that Mr Ainsworth had created the armour from those moulds either directly or indirectly, thereby copying. Mr Ainsworth denied being provided with those moulds. According to him, not only did he not get them, but they would have been useless to him (if they

existed, which he was not in a position to admit) because for technical reasons fibreglass moulds could not be used on vacuum forming processes because of the heat involved. He said that he was provided with what he described as some plaster casts on sticks, reinforced with hessian. These were for the chest, abdomen and forearms only, but they were of no use to him. He was also given some sort of additional drawing, and he already had the two McQuarrie paintings. From this material he produced the armour. If the casts were of no use to him, then he must have been working just from the drawings.

45. A little way into the trial Mr Wilson largely removed the importance of this factual issue by accepting that Mr Ainsworth's factual case on the point still involved copying one of the claimants' admittedly copyright works because the armour was a substantial reproduction of the armour as shown in the McQuarrie paintings. Mr Bloch then contributed further to a narrowing of the issues by saying that his side did not consider that it made any difference whether what they handed over, and what was therefore copied, was three-dimensional or two dimensional. It might therefore be thought to be unnecessary to make a further factual finding about what Mr Ainsworth received by way of prior works for the armour, but there was a significant amount of cross-examination on the point and it does go to credibility in relation to a directly relevant issue, namely what did Mr Ainsworth have when he came to make the other helmets. I shall therefore deal with it.
46. I do not accept Mr Ainsworth's evidence on this point. I think that his factual case is born of a combination of loss of recollection over time, and his propensity to claim credit for greater creativity than he in fact demonstrated. I find that Mr Muir's evidence is correct in relation to the design of the armour. That means that many man hours, over several weeks, were spent producing a design for the armour. That design was approved by Mr Lucas. Even if it could not be reproduced in-house, the fruits of the design exercise (plaster casts and fibreglass tools) were available. It is inconceivable that that would not be provided to any contractor charged with fabricating the armour. It would otherwise have represented wasted effort, and there is no reason why it would not naturally be provided. Furthermore, there were positive reasons why it would be. The whole design and appearance of the film was closely controlled and supervised by Mr Lucas. He had approved the armour as finalised by Mr Muir. Anything new would have to obtain fresh approval, and there was no point in seeking that when approved designs were to hand. The idea that Mr Mollo and others would hand over the armour project to a third party (even one with Mr Ainsworth's capabilities) and invite them to start again (albeit from drawings) strikes me as being faintly absurd. If that were done, one would have expected a series of prototypes, and a pattern of discussions, approval and modification, taking (probably) weeks. It is highly unlikely that Lucas would have just taken and approved whatever Mr Ainsworth produced. There is no evidence of any such course. Mr Ainsworth said that he had made about 14 sets of armour by 5th March. That left nothing like enough time for him to make up some sets and have the sort of discussion that the design values of the film would require. He cannot have just worked up some immediately acceptable armour from the McQuarrie paintings. He must have had some real designs to duplicate. He was unable to give a convincing description of what the extra drawing with which he said he was provided (the only descriptions he was able to give did not demonstrate it to add anything useful to the McQuarrie drawings, leaving one wondering why he would have been provided with it). I find that he was provided with the Lucas tools, or useful casts, from which he

made his own tools (I accept he did that) which produced copies corresponding to what Mr Lucas had approved (the clay originals) and ultimately the McQuarrie drawings.

The other helmets and subsidiary items

47. The Stormtrooper helmet and armour are the most important items in respect of which the present claim is brought, but there are other helmets as well. Like the Stormtrooper helmet and armour, they were all made by Mr Ainsworth for the film, but their origins are rather more vague. It will be useful to describe them shortly here, using nicknames by which they were known at the time:
- (i) The “cheesegrater”. This is a helmet worn by some Imperial troops. Its nickname comes from two outer plates on the front and rear of an underhelmet which have large holes in them. It features a notional radio-like earpiece, and a deep rear neck covering, reminiscent of some samurai designs. A photograph of one appears in Appendix 5.
 - (ii) The “jawbone”. This is a helmet worn by Imperial gunners. It takes its name from a protruding element which sticks out in front of a thin visor. A photograph appears in Appendix 6.
 - (iii) The X-wing fighter pilot helmet. This was worn by the rebel fighter pilots. A photograph appears in Appendix 10.
 - (iv) The rebel troop helmet. Its name is self-explanatory. It had various versions; some had visors, some did not. A photograph of one version appears in Appendix 11.
 - (v) The Tie fighter pilot helmet. This is a helmet and face mask worn in the film by Imperial fighter pilots. The helmet had some sort of origin in another drawing. The mask is a reproduction, in black, of the Stormtrooper face. Because of the face element, it is accepted that this is a substantial copy of the McQuarrie drawings, so there is no dispute about copying. As a result of that concession by Mr Ainsworth, the sometimes extensive evidence and submissions as to this go to credibility only, though on the facts this credibility point is closely related to the liability points in relation to the other helmets.
 - (vi) A “chest box” worn by the Tie fighter pilots. This was a mock chest-pack connected by gas tubes to a helmet and face mask, and bearing (non-functional) buttons and switches. I need say little about this because it is in substance no longer a disputed item.
48. The main issues in the case about these other helmets relate to the manner in which they were designed and produced, and in the light of concessions those issues arise only in relation to the first four helmets listed above. I shall therefore focus on those.
49. Mr Ainsworth’s original case was that towards the end of March 1976 (he put the date at 22nd March in his first witness statement) he was asked by Mr Lucas if he could produce the back of a black helmet for an Imperial fighter pilot, and he was shown another McQuarrie painting which demonstrated that. Mr Ainsworth decided to do that by using the X-wing helmet which he was working on, modifying the crest, and adding a face from the Stormtrooper as a contribution of his own. The resultant creation was then used in the film, front and back.
50. He then went on to say that in April 1996 Mr Mollo asked him to produce 2 other types of black helmet for the Imperial forces and three types of white helmet for the rebels.

The chronology of this is confused in the witness statement. It suggests that the request was made in March, or even in April, yet it refers to Mr Ainsworth's being given helmets on which they were to be based in February. As a result of the request he produced the cheese grater, jawbone and various rebel troop helmets referred to above. He said he never saw sketches, and the helmets were not based on any sketches provided by Mr Mollo. Mr Mollo did say that for one of the black helmets he wanted something like a Japanese samurai helmet, but that is about the only guidance that Mr Ainsworth says that he got. He was given a US army helmet on which to base the shape, but his first witness statement denied any further guidance. Mr Ainsworth said that he formed the helmets by a process of "free-forming". He made a tool based on the helmet he was given, and then played around with shapes based on that until he came up with the final shapes of the helmets. Mr Mollo's work book contains drawings which reflect a lot of elements of the final products. Mr Ainsworth says that he never saw those, or any similar, drawings at the time, and originally stated that Mr Mollo must have created his drawings from Mr Ainsworth's final product rather than the other way round.

51. Mr Mollo's evidence was that the helmets other than the X-Wing and TIE fighter helmets were based on a World War II US marine helmet called a "Talker". His notebook records the need to get such a helmet from the US. This was a particularly wide helmet designed to accommodate headphones. This helmet was provided to Mr Ainsworth. He was also provided with sketches for the various helmets that he was asked to produce. He was not simply left to develop helmets with only the broadest guidance as to colour and party. Mr Mollo has sketches for most of the helmets in his notebook. He says that other drawings were provided to Mr Ainsworth so that he could make these helmets, but Mr Mollo did not ask to have them back and therefore no longer has them.
52. In a later witness statement Mr Ainsworth significantly adjusted his chronology in relation to these items. Having looked at diary entries, Mr Ainsworth came to the conclusion that he was asked to make the other helmets on a much earlier date – 23rd January, the date when he says he showed the prototype helmet to Mr Pemberton and Mr Mollo. He went back and reported to Mr Payne and Miss Pitfield that that is what he had been asked to do. He had made prototypes within 6 days, and showed them to Mr Mollo on 29th January. The prototypes were photographed on that day before being handed over to Mr Mollo – a photograph of a man wearing a prototype cheese grater was produced at the trial. He was given some form of approval on this date, though not a firm order, and on the basis of that Mr Ainsworth says he placed an order for grey material for the production runs of these helmets and some clear acrylic for visors. He claims to be able to identify these orders from his books. His next statement modifies the chronology again, saying that his order books reflect a delivery of black material for the cheese grater and jawbone helmets on 17th February. His invoice shows that he did not get an order for jawbones, cheese graters, or rebel helmets until 30th April 1996.
53. These discrepancies in the chronology only matter so far as they increase or decrease the likelihood of drawings being made available to Mr Ainsworth. Lucas's first line case on these helmets is that they were substantial reproductions of drawings showing Mr Mollo's intentions, and that Lucas has copyright in those drawings. Reproduction of helmets by Mr Ainsworth is said to be an infringement of that copyright in the same way as the reproduction of the Stormtrooper helmet and armour infringe copyright in

the McQuarrie drawings. Mr Mollo has drawings in his notebooks. If the dates of first production by Mr Ainsworth precede those drawings, he cannot have copied them, and further reproductions of helmets cannot infringe copyright in those drawings. If the notebook drawings came after the first production of helmets, it also makes it less likely that those helmets were based on any other drawings provided to Mr Ainsworth and now lost. Although these other helmets are not very important in the scheme of things, they are part of the subject of this action, and it is therefore necessary to make some findings about this.

54. The first observation I would make is that Mr Ainsworth's version of events is intrinsically unlikely. As I have had occasion to observe more than once already, this was a closely controlled film in terms of design, and the idea that Mr Ainsworth would have been given a generalised brief to come up with helmets with no guidance at all except as to colour and party (Imperial or rebel) is inconsistent with that. It is not really plausible. On his case, he knew next to nothing about the film and its characters. In that context a request of the kind that he says Mr Mollo made would be largely meaningless. He must have had some guidance, in my view, and Mr Mollo is the only man who can have given it to him. Mr Mollo was a man who drew experimentally in order to arrive at designs that were acceptable. He was going to have to get approval of designs by Mr Lucas. He knew what the film required. It is highly unlikely that he would have sought to convey his idea for designs without some visual indication in the form of drawings of some sort. For those reasons alone, therefore, I think that Mr Ainsworth's version of events is not probable. However, it becomes even less probable when one sees that in Mollo's notebooks there are drawings which are plainly intended to represent at least some of these subsidiary helmets. There is no reason why he would be drawing helmets after he had finalised a design with Mr Ainsworth by other means, and some of his drawings plainly show he was playing with ideas for helmets. So if he was putting ideas on paper, it makes no sense that he would not have shown them, and/or some others, to Mr Ainsworth. In those circumstances it is plain that he must have conveyed his ideas via the medium of some drawings. In the context of the Outland space helmet, Mr Ainsworth was forced to concede that Mr Mollo must naturally have conveyed his ideas by some drawing, and although he did not admit that in relation to these other helmets, it is in my view equally likely, and indeed inevitable, that Mr Mollo would use the same mechanism.
55. A point of timing arose in relation to this. On Mr Ainsworth's original evidence, a lot if not all of Mr Mollo's relevant sketches could have been drawn before the date when Mr Ainsworth says that he was instructed to produce helmets. However, once he put the date of the instruction as early as 23rd January, he was able to raise a question-mark about which came first. In particular, there are drawings of what appears to be the cheese-grater helmet from about this time, and an attempt was made to establish that they must have come after, and not before, Mr Mollo's instruction on 23rd January. Furthermore there was also a point of timing in relation to the provision of sample helmets from the United States. Lucas's case is that they were getting these, and that the instructions for producing helmets were not given until they were in this country, which was some time after 23rd January. This, if true, enabled more drawings in the notebooks clearly to have been created before the instruction was given.
56. I do not rely much on these particular timing points. Mr Ainsworth's putting the timing as early as 23rd January is a matter of reconstruction from other matters, principally

from his records of ordering material. It is not at all convincing. If he is right that he met Mr Mollo as early as that then it would have been their first meeting, at which the prototype Stormtrooper helmet was made available. Although Mr Ainsworth's doing that was a significant step, it said nothing about his creativity or his ability to deliver. It is fundamentally implausible that at such a meeting, with no background or other knowledge of Mr Ainsworth, Mr Mollo should have made the request that Mr Ainsworth said he made. That is another reason for not accepting Mr Ainsworth's version of events about this. I consider that his claims to authorship of these helmets is yet another example of his propensity to make excessive authorship claims.

57. Witnesses, and in particular Mr Payne, claimed to have seen Mr Ainsworth making helmets without the assistance of drawings. Mr Payne sought to support Mr Ainsworth's account of free-forming helmets. I consider that the passage of time, and perhaps subsequent discussion with Mr Ainsworth, has clouded his recollection. He may have seen the creation of helmets; I do not consider that he can have seen the free-forming of helmets without prior guidance from Mr Mollo, for the reasons given above.
58. The question of whether the helmets were based on the "Talker" helmet or not is basically a matter of chronology. I do not think that I need to decide whether it was used or when it arrived. The important finding, which I make, is that Mr Mollo showed Mr Ainsworth some drawings in order to guide him in the creation of these other helmets. That is overwhelmingly likely, and nothing in the chronology demonstrated by Mr Mollo's books gainsays it.
59. If there were prior drawings then there is no dispute about the copyright in them – it is vested in Lucas. But it does not follow that the final helmets were reproductions of a substantial part of any of those drawings, so as make future reproductions of the same helmet a potential infringement of copyright in the drawings. In order to establish that one needs to ascertain the content of the drawings shown, and here there is an evidential problem. Mr Mollo, understandably, cannot recall any detail as to what drawings were shown or handed over. The most he could say is that he probably did use drawings to convey what was required, and I have found that that is the most likely method of communication of what was required. But those drawings cannot be plainly identified. There are some drawings in his book, but not for all the detail of all the helmets. Furthermore, any other drawings that were handed over have not survived, so one does not know their contents precisely.
60. The inability to identify the drawings is not fatal to a claim to copyright and a claim of infringement. In *Lucas v Williams & Sons* [1892] 2 QB 113 it was held that a copyright action in relation to an original painting could be maintained notwithstanding that the original painting was not produced. All three judges held that the likeness to the original could be proved by a witness stating that he had seen the original and that the infringing item was like it. In *Wham-O Manufacturing Co v Lincoln Industries Ltd* [1985] RPC 127 the New Zealand Court of Appeal declined to adopt the position that in the absence of the original "the most rigorous evidence is necessary". They adopted the position of the trial judge that where the original could not be produced to the court, establishing what it looked like was "in each case ... a matter of degree dictated by its own circumstances" (see age 145). It is therefore clearly not necessary to produce an original, and it is a matter of inference what the contents of the original were.

61. However, I bear in mind that there are material differences between the present case on the one hand and the two cases just cited on the other. In each of those cases the claimant was able to produce clear evidence from someone who had seen the original, and in one of them (*Wham-O*) the witness was closely associated with the production of the prior items. Furthermore, in the *Wham-O* case the witness was able to establish a clear progression of the design through paper designs, to models, to machine drawings, to moulds, to final model. In relation to some of the models the evidence was that stage C (say, drawings) was an embodiment of stage B (a prior model). Where such evidence is accepted, one can work out what was in prior drawings B by notional reverse engineering from stage C. That sort of evidence is not available in the case before me. Mr Mollo accepted, in my view realistically, that there was give and take and discussion in the evolution of the final design, not all of which was embodied in a drawing. So one can be reasonably confident that a final stage did not precisely embody a prior drawing. This, and the absence of evidence of a chain such as that in *Wham-O* (a case about Frisbees), means that one cannot reconstruct the original from the final form. No-one can prove from recollection what the prior drawings were, where they are not in Mr Mollo's sketchbook, so this case is somewhat removed from the two authorities just referred to. Particular care is therefore required in determining what was in any provided drawings and the extent of copying. I bear firmly in mind that Lucas has the burden of proof in relation to this.
62. It will be convenient to take each of the helmets separately, starting with the cheese grater.

The cheese grater

63. There are several pages in Mr Mollo's notebook with what seem to be prototype cheese grater drawings. The pages were numbered at the bottom, probably for future reference (and possibly for the purposes of this action – it does not matter), and I shall use those numbers. The final form of helmet had a reference to Samurai ideas (it was one of the few areas of common ground between Mr Mollo's evidence about helmets and Mr Ainsworth's evidence that Mr Mollo expressed the idea of a Samurai influence) and one can see some sketches of a helmet with a samurai influence (in the form of a neck drape) at page 221. However, a clearer picture emerges by page 228, where one can see sketches of several helmets with holes in the upper parts – see Appendix 1 to this judgment. They seem to reflect a method of construction as well as a design (and Mr Mollo's evidence was that the drawings showed how things might work when connected together) because one can see that underneath some of them there is the outline of a US army helmet (which may or may not be the Talker helmet), with the "holed" pieces mounted on top. At the top of the page there is apparently a picture of what the two "holed" pieces would look like. The helmets have a neck drape, which is probably not quite as deep or wide as the final form but which is clearly the same sort of thing. This drawing can be approximately dated, if that matters. On p 215 there is a manually drawn box with space for putting events in for five days from Monday 19th January to Friday 23rd (morning and afternoon). This is plainly a prospective diary box, rather than one recording events which have happened (contrary to what Mr Mollo said about these boxes on one occasion – on that occasion he said he thought they were looking backwards in time, not forwards, which is plainly not the case), because on page 218 (ie 3 pages further on) there is a note of or for a meeting on 16th January, demonstrating that the box must have been drawn before the week in question. The

page with the cheese grater sketches comes some 10 pages after that. On the next page (page 229) is a diary box for matters to be done in the week beginning 26th May. So it looks as though the drawings were done in the latter half of the preceding week – on Thursday 22nd or Friday 23rd January. This means that they could have been available to show to Mr Ainsworth on 23rd January if the two men met then, but in any event I think that they probably first met afterwards. The thinking was developing, because on the same page as the later diary box there is another drawing of a helmet with a neck drape and with holes in an upper part. There is a diary “entry” for 29th January which reads “Imperialist & Rebel helmets”, underneath a reference to Mr Pemberton, so it may just be that there was discussion about that date. However, the important point is that on any footing these drawings could have been available to Mr Ainsworth as a matter of chronology. What is quite incredible is that they could be developing as a matter of independent coincidence, parallel to Mr Ainsworth’s own development; nor is it credible, as a matter of chronology or otherwise, that they were copies of what Mr Ainsworth had already produced.

64. Whatever the date of that drawing may be, there is a clearer indication that the basics of the cheese grater were in Mr Mollo’s mind by 23d January, because there is a drawing of an “Imperial Crewman” wearing a holed helmet and bearing that date – see Appendix 2. That drawing was done by Mr Mollo, but is not in his notebook – it is now stored in the Lucas archives. It is not precisely the same as the final form, but clearly contains much of the essence.
65. Other drawings of cheese grater-type helmets exist, including one of a dressed crewman which is somewhat closer to the final form but which is probably not relevant to the question of copying because it is probably a late drawing; Mr Mollo described it as being for the wardrobe department so that they knew how to dress the characters. That probably comes too late to be a candidate for provision to Mr Ainsworth. One other drawing is said by Mr Mollo to be “early”; it appears as Appendix 3. One more needs to be dealt with. At Appendix 4 is another drawing by Mr Mollo which does not appear in his notebook (again, it is taken from the Lucas archives). Again, it shows a drawing for what is apparently the cheese grater. Mr Mollo said that it was the sort of drawing that he would have provided to Mr Ainsworth, but was unable to say that he provided that actual one.
66. In the case of the cheese grater we have an indication of what Mr Ainsworth actually did with his instructions before the design was finalised. There is a photograph of a man wearing an earlier prototype version. It shows an underlying helmet shape, like the final version, with a front holed plate very similar to the final version. There is an ear-piece whose overall shape is the same as the final version, but whose surface detail differs. At the rear the helmet has further differences. The neck drape is much longer and goes straighter down. The rear “holed” part overlaps it on top, not underneath. In overall shape at the rear, it is not as close to the drawings to which I have referred as the final shape is. Mr Wilson relied on this as demonstrating that the process of working from drawings was not as Lucas says it was. If Mr Ainsworth had been working from drawings such as those referred to above, he would not have produced the prototype shown in the photograph. That, says Mr Wilson, shows that he cannot have been working from drawings, or at least not those drawings.

67. No-one has a particularly clear recollection of any detail relating to this helmet. When he did his first witness statement Mr Ainsworth had apparently forgotten that he ever made prototypes at all. Working out what happened is therefore a question of ascertaining the probabilities, with such assistance as the contemporaneous documents provide. I have already found that Mr Mollo used drawings to communicate what he wanted to Mr Ainsworth. Since he had drawings already, then it is likely that he used those drawings, or sketches which reproduced the essential parts of them – sketches like that in Appendix 4. Mr Ainsworth worked from those sketches. To some extent he was constrained by the techniques that he was adopting – no doubt some points of detail were easier to achieve than others – but he was nonetheless working to what Mr Mollo required. The fact that he produced the prototype shown in the photograph may be down to what could be more easily achieved, or perhaps a first attempt, or even demonstrate some creativity on the part of Mr Ainsworth himself (rejected by Mr Mollo). But at the end of the day the final form of the helmet contains large numbers of the essential elements of the drawings. It is true that it differs to some extent – particularly the shapes of the holed plates, and the depth and splay of the neck drape, but nonetheless the elements are there. It is inconceivable that Mr Ainsworth was not working from drawings very like those, if not those actual drawings.
68. Comparing those drawings with the final form, I also find that he copied substantial parts of those drawings. That, after all, is what they were likely to be for. If he was working from reproductions of the drawings that I have seen, then I consider that he copied substantial parts of them – the overall shape, and a substantial part of the two hole plates. If he was working from other drawings provided to him, then again his job was to reproduce them or copy substantial parts of them, and I find that he did. What he is producing now is the same thing, subject to a point about the earpiece which I refer to below.
69. There is one last thing to be said in relation to the cheese grater. For the purposes and duration of the trial, various helmets were made available to me and to the other participants at the trial. They included all the disputed helmets, and there were examples of both originals and Mr Ainsworth's modern copies. As the trial progressed Mr Ainsworth claimed that the cheese grater in court which was said to have been the original made by him was not made by him. He said that the earpiece was different and was not that originally used in the film, that the plastic material was not the same as he used, and that it demonstrated methods of construction or alteration that he would not have used. That challenge largely evaporated when it was demonstrated (by carefully playing parts of the film almost frame by frame) that the earpiece was indeed the original (and that the one used on his modern reproduction is not the same), and that scientific tests demonstrated that the material used was indeed the material used by him (and he retracted his allegation to the contrary). At the end of the day this somewhat expensive side-show did not go directly to any of the issues in the action, but it did demonstrate the inappropriate vigour with which Mr Ainsworth pursued allegations on the basis of imperfect (or non-existent) recollection. He even went so far as to suggest that parts of the film had been digitally remastered or had been re-shot using different cheese graters (with nothing but guesswork to go on) or that the studio had changed just the earpieces on the helmets (which was implausible in the extreme). All this demonstrates the great care which has to be brought to bear in considering his evidence and his reconstructions. It also demonstrates his unwillingness to accept he has been mistaken. The earpiece of the helmet used in the film differs in detail from that on the

prototype, as I have mentioned above. Mr Ainsworth's modern helmet uses the prototype version, not the final one. Mr Ainsworth insists to his public that he is faithfully using the original moulds as used on the film version. That cannot be the case in respect of this piece of detail; but he was reluctant to admit it. All that is detail, but it is detail going to Mr Ainsworth's credibility in important areas.

The jawbone

70. I turn next to the jawbone helmet. The final form of the jawbone appears at appendix 6. There are fewer extant drawings relating to this helmet. There are two early drawings made by Mr Mollo of a full length soldier wearing a helmet which was said by him to be the fore-runner of the jawbone. They differ materially, however, from the final style. The face opening is much wider, and there is no apparent visor. The back and sides are materially splayed out. Since they are largely full face and not profile it is not apparent how much the lower "chin" element protrudes, but while there is some protrusion on at least one it does not appear to be very exaggerated. Mr Mollo told me that Mr Lucas was particularly interested in one of those, and that being the case it becomes apparent that this was the inspiration of the general style of this helmet. There appears to be no question of these particular drawings being provided to Mr Ainsworth. There are then three more extant drawings – Appendices 7, 8 and 9. It seems to me to me to be likely that they were created in that order.
71. Appendix 7 (which is the same as Appendix 3, but which is reproduced again for ease of reference) is a page which contains various drawings. The two in the top left are precursors of the final jawbone. The drawing and most of the writing is Mr Mollo's. The crudely written words "Jaw Bone Gunners" are not in his hand. This drawing is not in his notebook – it has been preserved in the Lucas archives. It should be noted that the word "cheesegrater" has been added to the cheesegrater design – it had clearly been called that by the time that this drawing had been done. However, Mr Mollo has not called the jawbone "jawbone".
72. The next drawing (Appendix 8) appears on page 253 of Mr Mollo's notebooks. It is positioned one page after a note of a wardrobe meeting with Mr Lucas on 5th February, so it was plainly drawn at about that time. On page 254 Mr Mollo lists numbers of helmets to be required. He identifies the cheesegrater by name, but not the jawbone – he describes "Imperial Troops Mk II (with face visor)", which is presumably a reference to the jawbone – it is much the same designation as that shown on Appendix 7. The eventual jawbone is much closer to the Appendix 8 sketch. The first reference in his book to "jawbone" is on a page bearing the date 23rd February 1996.
73. The last drawing is Appendix 9. This is a more careful drawing. Mr Mollo's initial reaction to being asked about that drawing (which is not in his notebooks) was that it was to help the wardrobe department dress the characters, though he then demonstrated misgivings about that. I think that his first reaction was probably the correct one. Clearly it demonstrates late development of the jawbone design. The jaw now protrudes very significantly and there is a transparent visor. It does not show the radio box on the side of the head (or at least not in the final position) but it is plainly the last in the series.

74. That material enables one to place the drawings in order. The order must be that in which I have listed them above. The first two (not reproduced) are plainly early ideas, not literally pursued. Appendix 7 is apparently based on them, with the flare at the back and sides. The protruding jaw is not so plain on those drawings but there might be an attempt to portray something like it. The two protuberances on the top of the helmet are not seen anywhere else. The description there, omitting the word “jawbone”, puts it prior to February 23rd, and its design concept puts it prior to 5th February. It therefore existed in time for Mr Ainsworth to see it, but if he did then he did not reproduce any substantial part of it. Then there is the small drawing on or about 5th February. This shows Mr Mollo was thinking about a design with obvious similarities to the jawbone helmet at that time. It is likely to have been a date after that drawing when he asked Mr Ainsworth to produce the extra helmets. Given that he had by now had these ideas, and given that he would want to communicate them to Mr Ainsworth, and given that sketching would be a natural method of communication, why would he not show or provide sketches? It seems to me probable that he did. If this was the only sketch that he had, he would have shown this one; the drawing in appendix 9 probably comes too late to have been shown. If he did not show this one, he will have shown or provided another one communicating the relevant ideas.
75. If he showed the one in Appendix 8, then there are plainly differences between what Mr Ainsworth produced and that drawing. The drawing does not show the fully protruding jaw; it is not plain that a visor is shown; the drawing is not based on a central helmet to which parts are added; and the drawing shows a sort of hinged effect which is not in the final version. Nevertheless, there is enough there to mean that if Mr Ainsworth used this drawing to make his helmet, he copied a substantial part of it. The overall shape and concept is there – a top curve with an extended back, a narrow slit for eyes and a pronounced jaw-like effect. Mr Ainsworth’s evidence is that he free-formed this helmet, albeit with an explanation from Mr Mollo that he wanted an extended protruding jaw-line which he demonstrated with his hand – this, said Mr Ainsworth, came to him at the trial when he was listening to the evidence. He said he drew inspiration from a character in a Bosch painting which shows a stunted person with a helmet which has a similar idea. He produced a copy of the picture. I do not accept this evidence, which I consider smacks of ex post facto justification and the sort of reconstructive wishful thinking that litigants sometimes indulge in without actually meaning to tell an untruth. This version of events did not figure in his witness statements. He says he was reminded of it during the trial when he saw Mr Mollo make a hand gesture. While such things happen, I do not think that it happened in this case. It may be that in the course of explaining what he wanted, Mr Mollo made the hand gesture referred to by Mr Ainsworth, but if he did (and it does not matter) then it is more likely that he did it in the context of having presented sketches. Mr Mollo would not let a hand gesture suffice if a sketch would be better (which it was). I do not see realistically how he can have conveyed what he wanted for this helmet without showing a sketch or sketches. Of course, it is possible, and indeed I would say likely, that Mr Ainsworth was given something better than the small sketch to work on. If so, then Mr Ainsworth substantially copied that even if he did not faithfully reproduce it. Again, the constraints imposed by the manufacturing process might have required modifications, but nonetheless I am satisfied that he will have been working to realise the overall impressions conveyed by sketches. That, again, was his function.

The X-Wing pilot helmet

76. This helmet is shown in Appendix 10. It was to be worn by rebel fighter pilots. Although not shown in the photograph in Appendix 10, it also had a yellow faceted visor, which Mr Mollo accepted Mr Ainsworth devised by himself without copying from anything that Mr Mollo did.
77. Mr Mollo's evidence, which I accept, was that it was intended to base the X-wing pilot helmet on a particular type of US army helicopter pilot helmet used in the Vietnam war. Mr Lucas provided a version of the helmet. His notebooks contain drawings of various aspects of that helmet, and of similar helmets. As well as designs of the helmet (or an equivalent) there is also a drawing of a pilot wearing one, in the Lucas archives.
78. However, in the case of this helmet it is apparent that the drawings played a far less direct part in the creation or construction of the helmet by Mr Ainsworth. Mr Mollo's notebooks demonstrate that Lucas was expecting to send, and he was expecting to receive, a helicopter helmet, coming over from the US. A note made in mid-January says: "Helicopter helmet and Talker helmet – get samples from States". A note of 2nd February records that for rebels they were still "awaiting sample helmets from US?" There are drawings of what appear to be parts of the helicopter helmet on two sheets preceding the one which records a wardrobe meeting on 5th February. It looks as though Mr Mollo might have had the helmet before him at that point, because it contains a reference to a wing-nut which controlled the movement of a visor and to which Mr Ainsworth referred in his evidence, though Mr Mollo was not asked in terms about that. The original helmet seems to have had a rounded dome. Mr Mollo's drawings showed an intention to have a raised strip a few centimetres wide running backwards from the centre at the front down to the bottom of the back. This was called a "mohawk" in the parlance of the case. Other than some drawings of a rebel pilot helmet which occur on the same piece of paper as Appendix 3, and which do not particularly resemble the final product or the other Mollo drawings, no other drawings were in evidence.
79. Lucas's case is that Mr Ainsworth had drawings to work from in relation to the X-wing helmet just as he had drawings of other helmets, though it also accepts that he had a helicopter helmet to work from too. Mr Ainsworth's evidence was that, again, he did not have drawings to work from. He was given the helmet. He took a cast from each side, manufactured a corresponding tool and then created duplicates of each half in plastic via his vacuum moulding process. That gave him two plastic halves of the original whole. He then had to decide how to join them together, and they needed to be spaced a little apart in order to accommodate the faceted visor that he had created. He achieved the join, and the necessary spacing, via the means of the mohawk – in essence it covered the join and provided extra lateral spacing. In his evidence Mr Mollo accepted that this was essentially the method of construction. It, and the final detail (such as the width of the mohawk) evolved as a matter of discussion between them during the manufacturing phase. There is in fact a photograph of a prototype which has a face mask which did not survive into the final version, so there was plainly a process of evolution.
80. I accept Mr Ainsworth's evidence as to how he went about the creation in the case of this helmet. I also find that drawings played little part in it. It may be that some

drawings were shown to him in order to give some vague idea of the intended mohawk, but there would be no reason to show him drawings of the physical thing (the helicopter helmet) when he was being given the physical helmet to work from, and then expect him to refer to those drawings. Mr Ainsworth's creativity in relation to the visor was accepted. The only reason that he can have been given the helmet is because his product was to be based on it; the helmet replaced the drawings of the other helmets in this respect. It would not be necessary to provide drawings to describe the mohawk – that is something that is more likely to have come out of discussion. Even if a drawing was shown, all that Mr Ainsworth will have taken from it is the idea of the Mohawk, and not its substance.

81. I therefore find that the X-wing helmet was not created by copying drawings or a substantial part of them.

The rebel troop helmets

82. The basic rebel troop helmet appears in Appendix 11. The need to design and cater for rebel troop uniform is apparent from Mr Mollo's notebook at an early stage, and it continues throughout the book. Mr Mollo's evidence was that the design was based on the "Talker" helmet, but it was plainly intended to have extra bits and pieces on it. He identified early drawings in his notebook, and they appear at a position which puts them at about 20th January. I accept his identification of those drawings. The precise date does not matter; nor does the precise sketching at that time. What does matter is that he was concerned with design at an early stage of his thought processes. That, again, makes it fundamentally unlikely that he would leave Mr Ainsworth to free-form these helmets without any form of guidance. Further early ideas appear in Appendix 3. One can see there the idea of a helmet radio emerging. The design for a radio box appears at Appendix 12. It is positioned at the beginning of February; but it does not reflect the extended shape or the added plates. Those appear clearly in the drawing at Appendix 13, which bears the date 10th February 1976 and which was produced from the archives, not the notebook. This is early enough for it, or something similar, to have been provided to Mr Ainsworth. Since, once again, Mr Mollo is likely to have communicated by drawing rather than by explanation, I find that he is likely to have supplied drawings. There was no positive evidence that Appendix 14 was provided to him but since drawings of this kind were available it is likely that something similar was provided. From those drawings Mr Ainsworth produced the final version. That version uses elements similar to other helmets, and no doubt that emerged as part of the development discussions and as a convenient method of proceedings, but in my view Mr Ainsworth was still proceeding from, and copying, drawings. Although the precise drawings cannot be identified, he must have taken a substantial part from them, and I so find.

Other items

83. Other items were made by Mr Ainsworth, but one way or another they have been removed from the fray (or at least the factual part of the dispute) by agreement between the parties. I therefore do not need to deal with the details of their conception and manufacture.

Subsequent events and the US proceedings

84. The film was duly made, and its success is a matter of film history. It spawned sequels and “prequels”. Marketing opportunities were thoroughly exploited by Lucas, yielding many billions of dollars. Mr Mollo had asked Mr Ainsworth to return the McQuarrie drawings that he had been given, and Mr Ainsworth did so. He was not asked to return such other drawings as he was given. He was also not asked to return any other material, including the tools that he had made. In 1997 he found them and wrote to Lucas suggesting they might be exploited, but nothing came of that. He still kept them. He sold some items he had kept at a Christie’s auction in 2000. Nothing turns on all that.
85. In 2004 Mr Ainsworth set up a website (www.sdsprops.com) and started to sell products in a concerted manner. There is a significant market for such products amongst aficionados of the Star War films all over the world, some of whom organise themselves into “Garrisons”. They were the products that are the subject of this action. His website emphasises that Mr Ainsworth made the original helmets and armour and that his helmets were produced from the original moulds used to make the helmets seen on the screen. That he using the original moulds was also emphasised by a website called www.firebox.com, to whose proprietors Mr Ainsworth supplied his goods. Mr Ainsworth also advertised on one occasion in the US. Some of his products were sold and delivered to US customers.
86. Those activities attracted the attention of Lucas. Proceedings were commenced against him in the US District Court, Central District of California, Western Division in 2005. The action claimed relief in respect of copyright infringement, unfair competition, and trade mark infringement. Mr Ainsworth challenged the court’s jurisdiction but that challenge failed. Having limited his participation in the action to that extent, Mr Ainsworth then took no further part, and on 26th September 2006 judgment was ordered against him in the sum of \$5m for copyright infringement, \$5m for trade mark (Lanham Act) infringement and unfair competition, and an additional \$10m to treble the Lanham Act damages. Mr Ainsworth’s admitted sales in the US were about \$14,500. The large sums awarded under the copyright head were based on the notional costs of a reasonable licence fee for the licence which Mr Ainsworth was treated as having appropriated to himself. So far as the Lanham Act damages are concerned, the loss is based on what was said to be the value of the rights appropriated to himself by Mr Ainsworth. There was also injunctive relief, but that does not impact on the present proceedings.
87. In the present action Lucas seeks to enforce that judgment in this jurisdiction to the extent of those damages, but without the trebling element; that is to say it confines its claim on the judgment to \$10m. If there is a problem about enforcing that judgment then Lucas seeks to claim in this jurisdiction in respect of infringements of US copyright. Mr Bloch told me that his clients do not seek to have both the US judgment and a UK judgment on the US copyright claims. If there is a UK judgment on the US copyright, then the judgment in the US would fall away (so far as otherwise enforceable). Furthermore, were this court to find that the US copyright claim was bad on its own merits, his clients would not seek to enforce the US judgment anywhere. And furthermore, as a matter of reality, his clients realised that Mr Ainsworth was not good for \$10m and were not looking to bankrupt him on it. What I think all that

probably demonstrates is that Lucas is understandably sensitive to the impression that its apparent sledgehammer or steamroller approach might portray to this court, and to others, and is anxious to mitigate that impression, at least as far as this court is concerned. 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.

Issues

88. Based on that history, Lucas brings the following claims, so far as still extant at the end of the trial:
- (i) A claim for infringement of copyright.
 - (ii) A claim in passing off.
 - (iii) A claim to such copyrights as Mr Ainsworth might himself have acquired.
 - (iv) A claim in confidence to restrain Mr Ainsworth from making his helmets and armour.
 - (v) A claim to enforce the US monetary judgment.
 - (vi) A claim to enforce US copyright (but no other US rights).
- Mr Ainsworth counterclaims to enforce his own alleged copyright in the helmets.
89. Some of what otherwise might have been issues of subsistence and infringement of copyright have been removed by concessions between the parties. Thus Mr Ainsworth accepts that the McQuarrie paintings are graphic works for the purposes of the Copyright Designs and Patents Act 1988 (“the 1988 Act”), as was the sketch of armour that he says he was provided with by Mr Mollo. It was accepted by him that English copyright in those works vests in one or more of the claimants (it matters not which). He also accepts that he took substantial parts of what was depicted there when he came to create the Stormtrooper helmet and armour. He therefore accepts that if and insofar as he continues to reproduce the helmet, he is copying from those drawings and infringes so far as copyright is enforceable, but subject to statutory defences. It was also not disputed that so far as there were other drawings from which he prepared his works, then copyright in those drawings is in one or more of the claimants. I therefore do not have to make any determination as to the ownership of such copyrights as might exist. Other objects have been taken out of the claim by agreement between the parties – for example the “Tusken Raider” and one of the chest boxes. In relation to another chestbox Mr Ainsworth is willing to submit to an injunction on the footing that he does not intend to make one anyway. A trade mark claim in relation to certain insignia has also been dealt with.
90. However, despite the various concessions, the facts still give rise to a potentially complex series of interlocking issues. They are in summary as follows:
- (i) Are any of the helmets artistic works within the 1988 Act, so as to attract copyright in themselves? This involves a consideration of whether they are either sculptures or works of artistic craftsmanship.
 - (ii) If there is copyright in the helmets, is that copyright owned by Mr Ainsworth, either because he was the author himself, or because he contributed his own elements to those which he took from the claimants.
 - (iii) If Mr Ainsworth is otherwise entitled to the copyright, is he obliged to hold it for, and assign it to, the claimants?

- (iv) If Mr Ainsworth is otherwise entitled to use his moulds, is he nonetheless restricted from doing so by duties of, or akin to, confidentiality?
- (v) If and insofar as Lucas was or is entitled to any of the copyrights in drawings that it asserts against Mr Ainsworth, does he have a defence under section 51 of the 1988 Act?
- (vi) If and insofar as Lucas was or is entitled to any of the copyrights that it asserts against Mr Ainsworth, does he have a defence under section 52 of the 1988 Act?
- (vii) Is there a claim in passing off?
- (viii) Are the claimants entitled to enforce the US judgment?
- (ix) Are the claimants entitled bring an action in this jurisdiction claiming infringement of US copyright? If so, have they made out such a claim?

91. That is a large number of issues, some of them of some complexity. In relation to the English copyright issues, the most important are those concerning section 51 and 52. It will not be convenient to tackle the points in that order, and one of the points (the issue of whether products are sculptures or works of artistic craftsmanship) arises in relation to more than one point. It will therefore be convenient to tackle that point first, and then take the other issues in an order which seems convenient. I shall leave the US-related issues until near to the end. The factual issues relating to what was and was not copied when Mr Ainsworth made the helmet and armour have been dealt with above in the course of the factual narrative.

Are the helmets and other reproductions sculptures or works of artistic craftsmanship?

92. This has a relevance to two particular areas of dispute. So far as the major items in dispute are concerned (the Stormtrooper helmet and armour) it is conceded by Mr Ainsworth that what he did amounted to copying from a copyright work (the McQuarrie drawings). It follows, and he accepts, that if he reproduced them now, then, subject to special defences, he infringes the claimants' copyright in those drawings. The same would apply so far as he substantially copied any prior drawing of the other helmets. However, if he did not do that, then the claimants claim that the helmets that Mr Ainsworth produced are themselves copyright items (as being sculptures or works of artistic craftsmanship), and that they are entitled to that copyright. Mr Ainsworth himself claims copyright in the helmets and armour that he produced, and he can only do so if they are one or other of those two things.
93. The question of whether an item is a sculpture also arises in relation to some of the defences. Section 52 operates to restrict copyright where there has been industrial exploitation. Mr Ainsworth relies on the section because over the years Lucas has sold a large number of copy items which equate to the subject matter of this action. It does not apply if what has been made and sold, or perhaps copied, are sculptures, via some subordinate legislation to which I shall have to come. Lucas seeks to say that all of what it sold were sculptures for these purposes. In order to avoid a detailed investigation as to what was sold, where they were made, and in what numbers (all of which would theoretically be in issue) it has been agreed between the parties that I can take a sort of test item. One of the things sold is a toy model of a Stormtrooper. It exhibits what can be treated as a reproduction of the armour and the helmet (some of the surface decoration might not be precisely the same, but it is agreed that that does not matter). I was invited to consider whether this was a sculpture for the purposes of section 52 (or the preceding legislation). If it was not then there have been enough

sales of a non-sculpture for Mr Ainsworth's purposes in relation to this section. I therefore have to consider the sculpture question for that purpose too. Furthermore, for the purposes of section 51 it will be necessary to consider whether the helmets and armour are sculptures.

Sculpture

94. Technically the meaning of sculpture arises under various different statutory provisions. They are identified hereafter in later sections of this judgment. I am satisfied that it must have the same meaning in relation to all of them.

95. A sculpture is an artistic work under the 1988 Act. There is no statutory definition of "sculpture" for the purposes of this area of legislation. The only statutory assistance one has in relation to this question is a somewhat circular indication of what is included:

"sculpture" includes a cast or model made for purposes of sculpture"
(section 4(1)(2)(b)."

In addition there is the provision of section 4(1)(a) which provides that something can be a sculpture "irrespective of [its] artistic quality".

96. That does not help much in the present circumstances. Nor do the cases in the area provide many guidelines for determining whether something is a sculpture or not. What they provide is a series of examples, with some of the factors (explicit and implicit) taken into account by the judges deciding the cases. The authorities are as follows.

97. In *Caproni v Alberti* (1891) 65 LT 785 the item at issue was a cast made by a firm of modellers comprising a depiction of fruit and leaves. Protection was claimed under the Sculpture Copyright Act 1814; the defendant claimed that the cast was not something which fell within the wording of the Act, which was "any subject being the matter of intention in sculpture". There is no indication in the report of why that submission was made, and Mathew J made short work of it:

"Having heard the evidence in the case, I am clearly of opinion that the productions in question come within the words 'any subject being the matter of intention in sculpture' ... I am not going to defend the phraseology of the section, which is verbose, inaccurate and troublesome; but I think the words of the section which I have quoted do not need any interpretation but leave the matter free from doubt."

He went on to find that the cast had "artistic taste, judgment and arrangement"; that is no longer a requirement of a "sculpture" under the 1988 Act.

98. There is no material assistance to be gleaned from that case. It dealt with something which could perfectly fairly be called a sculpture in everyday parlance, but it did not elucidate the concept of "sculpture".

99. *Britain v Hanks* (1902) 86 LT 765 concerned a claim to copyright under the 1814 Act in a model soldier cast in metal. The defendant argued that the statute was intended to

apply only to substantial works of art, such as busts, large sculptures and casts of copies of works recognised as works of art, and there was no artistic merit in the model soldiers in the sense contemplated by the Act. Wright J held that the first question was whether the toy representation was “an artistic thing – an artistic production within the meaning of the [1814 Act]”. He went on:

“It is tolerably certain that some toys would not fall within the protection of the Act; and the question whether this soldier’s or mounted yeoman’s figure comes within it must be decided upon evidence as to its artistic character. The evidence before me is all one way. A war correspondent has been called who is at the same time an artist and has shown several of these figures to be artistic productions, in that the anatomy is good, and that the modelling shows both technical knowledge and skill. I see nothing to quarrel with in that statement. On the whole, therefore, although I have great doubt as to the meaning of the Act, I am prepared to hold that the production of a metal figure of a mounted yeoman such as this is good enough to be protected by the provisions of the Act if [certain other provisions] are complied with.” (Those other provisions are not relevant to the point I have to consider.)

100. The fact that it was a toy was not conclusive against its being a sculpture. It seems that what ultimately weighed with Wright J was the fact that the model had some artistic “character”. Like Mathew J, he implicitly assumed that a sculpture within the Act had to have some such quality. The thing before him was not merely a toy; there was more to it than that. I think that he was trying to convey two things. One is actual artistic merit. If that was a requirement then, it is no longer a requirement now, under the 1988 Act. The other is an artistic character. This is probably a slightly different quality. It is something which elevated it above being a mere toy. The distinguishing feature is probably that it had a purpose in that (if you liked that sort of thing, which is an artistic merit point) then one could be content just looking at it. Mr Wilson said that the model had no purpose other than being intended to be looked at. I do not think that is true of that case on the facts – there was an element of toy about the model, which suggests an additional purpose that did not disqualify it from being a sculpture – but it also had some pure eye appeal for which some might buy it. That is, of course, not spelled out by Wright J, but it seems to be something that one can take from this case.
101. In *Pytram Ltd v Models (Leicester) Ltd* [1930] 1 Ch 39 a question arose as to the copyright status of a model of a wolf-cub’s head, which was intended to be (and which was) reproduced in papier maché from a mould for display on poles as a totem by Boy Scouts. Copyright was claimed in the original model, and a claim for infringement was brought. The claim failed for various reasons concerning the interaction between the Copyright Act 1911 and the Patents and Designs Act 1907; that does not matter for present purposes. Of more relevance is the fact that Clauson J seems to have considered, without giving any reasons, that the head was a sculpture (see page 645). This is no more than an example of what has been found to be a sculpture, and it is not really controversial. The copyright was maintained in an original plaster model, which was itself reproduced from casting from a mould based on an original hand-fashioned clay version. While not high art, that model is plainly fairly treated as a sculpture.

102. Moving into a more industrial application area produces potentially greater problems. In *Breville Europe plc v Thorn EMI Domestic Appliances Ltd* [1995] FSR 77 the claimants produced a sandwich toaster. In order to produce the heating plates they produced plaster shapes as a sort of target food product so that moulds could be produced for the heated plates which would, when used in the finished machine, produce sandwiches which would (naturally) correspond to the shape of those plaster shapes. The claimants claimed (inter alia) copyright in the plaster shapes. For various reasons not material to this judgment, Falconer J held that there was no infringement. He did, however, hold that the plaster shapes were sculptures. He said:

“I do not see why the word ‘sculpture’ in s.3 of the Copyright Act 1956 should not receive its ordinary dictionary meaning except insofar as the scope of the word is extended by s.48(1) which provides that “‘sculpture’ includes any cast or model made for the purposes of sculpture.’ The Concise Oxford Dictionary defines ‘sculpture’ as the

‘art of forming representations of objects etc or abstract designs in the round or in relief by chiselling stone, carving wood, modelling clay, casting metal, or similar processes; a work of sculpture,’

a definition forming the basis of paragraph 3.15 on ‘sculptures’ in [Laddie, Prescott and Vitoria’s *Modern Law of Copyright*] where it is suggested that:

“Since copyright may subsist irrespective of artistic quality it would seem that, for example, carved wooden patterns intended for the purpose of casting mechanical parts in metal or plastic might well be susceptible of protection, although the point has not yet received much attention from practitioners.””

Falconer J then went on to refer to *Wham-O Manufacturing Co v Lincoln Industries Ltd* [1985] RPC 127 (see below) and said:

“In my view the plaster shapes...were sculptures and as such attracted copyright.”

103. This approach concentrates on the method of production of the item in question rather than its purpose. The application of this approach would assist Lucas, because of the method of construction of the helmet. It also suggests that art plays no part in the determination. A purely functional article with no artistic pretensions whatsoever can, on this approach, be a sculpture. Mr Wilson pointed out that this decision on the point is strictly obiter. I am not sure that that is correct, but even if it is the view of a judge of the experience of Falconer J is entitled to particular respect. He also said that the case reflected a tendency of the courts to provide protection by forcing notions such as “sculpture”, which is no longer appropriate because sections 51 and 52 demonstrate a more modern intention to cut down protection. I do not accept this submission either, or at least not in relation to sections 51 and 52. Those sections are predicated on a degree of protection existing, and cut it down in their respective manners. They do not say anything about the appropriateness of any particular original level of protection.

104. The *Wham-O* case referred to by Falconer J is another example of a purely functional, and indeed industrial, object being held to be a sculpture. It was a case in the New Zealand Court of Appeal in which copyright in various elements of Frisbee (the plastic flying disk) production were in issue. After initial drawings were made, a wooden model was produced, presumably by carving or turning. From that model detailed drawings were prepared which enabled an engineer to produce a metal mould, and from the metal mould the final plastic product was produced by a process of injection. Copyright was claimed in, inter alia, the wooden model and in the final plastic form, on the footing that they were sculptures. The Court of Appeal upheld a claim to copyright in the former (as a sculpture), but not in the latter. The wording of the New Zealand statute was the same as the English 1988 Act.
105. The New Zealand Court of Appeal had to consider whether certain items were engravings, as well as the question of sculptures. In that context, they made remarks which are of assistance in relation to both enquiries. At page 150 they referred to the need to look to the ordinary meaning of words:

“Insofar therefore as those definitions are merely inclusive and are not exhaustive of the original meanings of ‘engraving’ and ‘sculpture’, the court can have regard to the ordinary meaning of such words as ascertained from various sources.”

They then set out various dictionary definitions relating to engraving, which I do not need to deal with, and they dealt with a particular authority on the point. At page 153 they dealt with a point about visual appreciation:

“Mr Hillyer submitted that an engraving in the form of a mould or dye could not be an engraving as protected by the Act because it is not meant to be appreciated visually but rather is merely a device used to create an end product, namely the finished plastic disc. This submission cannot be upheld, particularly in view of the developing nature of the law of copyright. The requirement for works to be of artistic quality has been removed from the definition “artistic work” in s.2 of the Act so far as the items referred to in clause (a) of that definition are concerned, and so long as the dye or mould falls within the words of the definition to which we have referred, then it may be the subject of copyright protection.” (page 153)

This, if followed, is an answer to one of Mr Wilson’s submissions, which is that it is of the essence of a sculpture that it should be intended to appeal to the eye and to be enjoyed for its appearance, whether or not it had an additional function. That seems to be a point which the Court of Appeal did not accept.

106. Having reached certain conclusions about engravings, Davison CJ then turned to deal with questions of sculpture. At page 155 he sets out various dictionary definitions and stated as follows:

“The Shorter Oxford English Dictionary defines ‘sculpture’ as:
‘Originally the process or art of carving or engraving a hard material so as to produce designs or figures in relief, or in intaglio, or in the round. In

modern use, that branch of fine art which is concerned with producing figures in the round or in relief, either by carving, by fashioning some plastic substance, or by making a mould for casting in metal.'

Although that definition refers to sculpture as a branch of fine art, for the purposes of copyright, sculpture is classed as an artistic work, 'irrespective of artistic quality.'

"Webster's Third New International Dictionary defines 'sculpture' as:

'1. The act, process or art of carving, cutting, hewing, moulding, welding or constructing materials into statues, ornaments or figures.

2. The act, process or art of producing figures or groups in plastic or hard materials.'

.....

'In the New Encyclopaedia Britannica, vol. 16, p.421 there appears an article on 'Art of sculpture'. The following passages are of some interest:

'Sculpture is not a fixed term that applies to a permanently circumscribed category of objects or sets of activities. It is, rather, the name of an art that grows and changes and is continually extending the range of its activities and evolving new kinds of objects. The scope of the term is much wider in the second half of the 20th century than it was only two or three decades ago, and in the present fluid state of the visual arts, nobody can predict what its future extensions are likely to be.

Certain features, which in previous centuries were considered essential to the art of sculpture, are not present in a great deal of modern sculpture and can no longer form part of its definition. One of the most important of these is representation. Before the 20th century, sculpture was considered a representational art; but its scope has now been extended to include non-representational forms. It has long been accepted that the forms of such functional three-dimensional objects as furniture, props and buildings may be expressive and beautiful without being in any way representational, but it is only in the 20th century that non-functional, non-representational, three-dimensional works of art have been produced.

.....

20th century sculpture is not confined to the two traditional forming processes of carving and modelling or to such traditional natural materials as stone, metal, wood, ivory, bone and clay. Because present-day sculptors use any materials and methods of manufacture that will serve their purposes, the art of sculpture can no longer be identified with any special materials or techniques. Through all of these changes there is probably only one thing that has remained constant in the art of sculpture, and it is this that emerges as the central and abiding concern of sculptors:

The art of sculpture is the branch of the visual arts that is especially concerned with the creation of expressive form in three dimensions.”

107. Davison CJ then records the finding of the judge at first instance that the wooden models were “as far as its basic nature is concerned a sculpture”. Having set out a sentence from Laddie, Prescott and Vitoria (1980 edition page 107) he then turns to consider the final plastic product which emerges from the injection moulding process. While he accepted that articles produced from a mould, which was in turn produced from an original sculpture, could be classified as sculptures, he did not accept that that was the case in respect of the final plastic articles.

“But it appears to us to be straining the meaning of the word ‘sculpture’ to apply it to the discs produced by the injection moulding process used in the present case when the moulds concerned have simply been created by a process of engraving and no original model has been created.”

108. With respect, I find that distinction somewhat arbitrary. It was certainly true on the facts of that case that the moulds were produced by a process of carving out an appropriate shape in the mould (held to be engraving). The result was a reproduction of the original wooden model (which, as will become apparent, was held to be a sculpture). It is to be inferred from what Davison CJ said that, had there been a method of forming a mould by reason of direct contact with the original sculpture, then the final product would have been a sculpture, at least at this stage of the reasoning. It seems to be to generate an arbitrary distinction to say that the position is different where the mould is produced by a separate ‘carving’ activity based on drawings which are themselves based on the original sculpture. Such a process of reasoning seems to vest the process of manufacture with too much significance.

109. That was not the only basis on which the Court of Appeal determined that the final product was not a sculpture. The court also relied on what might be described on certain artistic, as opposed to utilitarian, qualities in the product. At page 157 Davison CJ said:

“Furthermore, it appears to be implicit in the definitions of sculpture to which we have already referred and from the article in the New Encyclopaedia Britannica, particularly the passage reading:

‘The art of sculpture is the branch of the visual arts that is especially concerned with the creation of expressive form in three dimensions.’

That sculpture should in some way express in three-dimensional form an idea of the sculptor. It seems to us inappropriate to regard utilitarian objects such as plastic flying discs, manufactured as toys, by an injection moulding process, as items of sculpture for the purposes of the Copyright Act. They lack any expressive form of a creator and any idea which the creator seeks to convey.

In the result, we are unable to hold that the final plastic product – the discs – are sculptures in terms of the Act and entitled to copyright protection as sculptures.”

110. So the court was relying on the purely utilitarian nature of a frisbee, and what might be regarded as the complete absence of any artistic quality. This is despite the fact that, so far as one can tell from the report, some of the features of the Frisbee (in the form of rings) were purely decorative, and to that extent might be said to represent an element of creativity. What this aspect of the decision probably demonstrates is that, while the boundaries of what is a sculpture have been pushed way beyond traditional notions, one cannot push them, and the logic of some of the previous cases, too far. There comes a point where the court is entitled to say that what is produced simply cannot fairly be regarded as a sculpture.
111. Having dealt with the final product, the court then turned to deal with the wooden model. At page 157, in relation to this, Davison CJ said:

“All that is required therefore is that the work in question shall be a sculpture in the ordinary sense of that term or as included in the extended definition of sculpture contained in the Act.

We think that the wooden models of the Frisbees, which were prepared for the various models, do fall within the definition of sculpture, and are thus properly the subject of copyright protection. We agree with Moller J on this point.”

The report of Moller J’s judgment at first instance [1982] RPC 281 does not fully reveal his process of reasoning in arriving at this conclusion. It refers to the definitions and citations which he had read, and then simply expresses the conclusion that the models were sculptures. However he, like the Court of Appeal, held that they were engravings, and thus “artistic works” within the Act.

112. It seems to me that this case can be relied on for the following:
- (a) It is another example of something which had an ultimate utilitarian function as being a sculpture (the wooden model);
 - (b) Not every three-dimensional object produced as a result of a human design is capable of being a sculpture. While a utilitarian or other function does not, by itself, exclude, there must nevertheless be some element of artistic expression, however unsuccessful.
 - (c) It is appropriate to start with what is the normal understanding of the expression “sculpture”, though in my view the case demonstrates that that is a pretty loose boundary because many people would be surprised to find that the wooden model was considered to be a sculpture.
113. In *J & S Davis (Holdings) Ltd v Wright Health Group Ltd* [1988] RPC 403 the relevant subject matter was a model of a dental impression tray in modelling material. A cast was prepared from the model, and a final form prepared from the cast. Whitford J rejected the claim that the model was a sculpture. At page 410 he observed how the notion of sculpture, and other artistic works, had been extended to a point where:

“their meaning bears very little relation to the meaning which those not familiar with the law would give to those words.”

He referred to (but did not set out) dictionary definitions which accorded with his view that the models and casts were not sculpture. The only reason given is this (at p 410):

“The models and casts ... were no more than steps in the production first of the prototype, later in the manufacture of the tooling from which the plaintiffs’ production was secured. They were never made for the purposes of sculpture, and it was never intended that they should have any continuing existence.”

He distinguished the wooden model in *Wham-O* by saying:

“A carved wooden model is one thing. A model fashioned in plasticine or some other suitable modelling material, which it was never intended should have any permanent existence, being no more than a stage in production, is another. The claim based on either the models or casts as being sculptures must, in my judgment, fail.”

114. With respect, I am not sure that Whitford J’s reason for distinguishing the two cases is really sustainable. In each case there was a model on which a final product was based. Neither model had any function other than to embody the design so that it could be furthered. One happened to be made of more enduring material than another, but I do not see why that should make a difference. Once the necessary steps had been taken to produce the final tooling the original model, whatever it was made of, loses its purpose. There was even material for inferring that the *Wham-O* model was indeed not intended to have any continuing existence, because the original models were not available to the court by the time of the trial. Having said that, it seems to me that Whitford J’s decision is correct, and what it does is to indicate that *Wham-O* may well not be. The purpose of a creation ought to be a relevant consideration, and in Whitford J’s case that pointed to the conclusion that it was not a sculpture. Longevity, of course, while relevant to purpose, cannot be conclusive, as Laddie J pointed out in *Metix* (see below) – an ice sculpture would be likely to have a shorter existence than the Davis trays, but it is nonetheless a sculpture, because its whole ethos and purpose are to gratify the eye in exactly the same way as Henry Moore’s sculptures.
115. *Metix (UK) Ltd v G H Maugham (Plastics) Ltd* [1997] FSR 718 was another unsuccessful attempt to claim copyright in relation to an industrial article, this time in moulds made for making industrial products (twin cartridges like a double-barrelled syringe, which held products prior to their being mixed) The plaintiff claimed that the moulds were works of sculpture. The issue arose on an amendment application, so the point in issue was whether the plaintiff’s claim was arguable. Laddie J held it was not. His reasoning was based firmly on the function of the moulds.

“The law has been bedevilled by attempts to widen out the field covered by the copyright acts. It is not possible to say with precision what is and what is not sculpture, but I think Mr Meade was close to the heart of the issue. He suggested that a sculpture is a three-dimensional work made by an artist’s hand. It appears to me that 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. There is nothing in the particulars in this case which suggests that the manufacturers of these

moulds considered themselves, or were considered by anybody else, to be artists when they designed the moulds or that they were concerned in any way with the shape or appearance of what they were making, save for the purpose of achieving a precise functional effect. Nothing in the particulars given here suggests that any consideration of appeal to anything other than functional criteria was in mind or achieved. In these circumstances, it appears to me that there is no arguable case pleaded for the existence of sculpture copyright in the moulds for these products, and I will not allow the statement of claim containing such a claim to be served on [a defendant].”

116. It appears from this that Laddie J was proposing, without completely defining, certain limits to the extension of the concept of sculpture:
- (a) It should not go way beyond what ordinary members of the public would consider to be a sculpture. It might be said by cynics that that comes a little late, but it is nevertheless, in my view, a valuable limit.
 - (b) The object has to have a function beyond the merely utilitarian.
 - (c) It has to be made by “an artist’s hand”. This seems to me to be another way of requiring something more than the utilitarian; there has to be an appeal to something other than the utilitarian. One can express that other thing as an appeal to the artistic sensibilities. I agree with that too. It does not conflict with the fact that artistic quality is irrelevant. That provision of the statute means that one does not have to make a judgment about the quality of the art, or the level of artistic achievement. But there must be something which of its nature is capable of appealing to artistic sensibilities, whether or not it succeeds in doing so, and that must to some extent be the purpose of the creation of the article.

117. *Wildash v Klein* (2004) 61 IPR 324 is an Australian case concerning “Critters”, depictions of animals made with adorned wire. Angel J set out Australian authority indicating that the word “sculpture” must be given its ordinary meaning, and cited Laddie J in *Metix* where he referred to the need not to extend the meaning of the word beyond the ordinary public’s perception and the reference to the artist’s hand. He also cited from other Australian authority which held that:

“a sculpture should in some way express in three-dimensional form an idea of the sculptor”,

repeating Laddie Js’ theme. He held that the works in his case expressed such an idea. They were “designed to have aesthetic appeal to potential purchasers”. This again, in my view, distinguishes the purely functional, and introduces the idea which I have described as appealing to artistic sensibilities.

118. From those authorities, and those approaches, a number of guidance factors can be extracted. I call them guidance rather than points of principle, because that gives them the right emphasis. The judges deciding the cases have not sought to lay down hard and fast rules in an area where subjective considerations are likely to intrude, and I will not attempt to do so either. However, I do think the following points emerge from the cases or from the concepts involved:

- (i) Some regard has to be had to the normal use of the word.
- (ii) Nevertheless, the concept can be applicable to things going beyond what one would normally expect to be art in the sense of the sort of things that one would expect to find in art galleries.
- (iii) It is inappropriate to stray too far from what would normally be regarded as sculpture.
- (iv) No judgment is to be made about artistic worth.
- (v) Not every three dimensional representation of a concept can be regarded as a sculpture. Otherwise every three dimensional construction or fabrication would be a sculpture, and that cannot be right.
- (vi) It is of the essence of a sculpture that it should have, as part of its purpose, a visual appeal in the sense that it might be enjoyed for that purpose alone, whether or not it might have another purpose as well. The purpose is that of the creator. This reflects the reference to “artist’s hand” in the judgment of Laddie J in *Metix*, with which I respectfully agree. An artist (in the realm of the visual arts) creates something because it has visual appeal which he wishes to be enjoyed as such. He may fail, but that does not matter (no judgments are to be made about artistic merit). It is the underlying purpose that is important. I think that this encapsulates the ideas set out in the reference works referred to in *Wham-O* and set out above (and in particular the Encyclopaedia Britannica).
- (vii) The fact that the object has some other use does not necessarily disqualify it from being a sculpture, but it still has to have the intrinsic quality of being intended to be enjoyed as a visual thing. Thus the model soldier in *Britain* might be played with, but it still, apparently, had strong purely visual appeal which might be enjoyed as such. Similarly, the Critters in *Wildash* had other functions, but they still had strong purely visual appeal. It explains why the Frisbee itself should be excluded from the category, along with the moulds in *Metix* and *Davis*. It would also exclude the wooden model in *Wham-O* and the plaster casts in *Breville*, and I would respectfully disagree with the conclusions reached by the judges in those cases that those things were sculptures. Those decisions, in my view, would not accord with the ordinary view of what a sculpture is, and if one asks why then I think that the answer is that the products fail this requirement and the preceding one – there is no intention that the object itself should have visual appeal for its own sake, and every intention that it be purely functional.
- (viii) I support this analysis with an example. A pile of bricks, temporarily on display at the Tate Modern for 2 weeks, is plainly capable of being a sculpture. The identical pile of bricks dumped at the end of my driveway for 2 weeks preparatory to a building project is equally plainly not. One asks why there is that difference, and the answer lies, in my view, in having regard to its purpose. One is created by the hand of an artist, for artistic purposes, and the other is created by a builder, for building purposes. I appreciate that this example might be criticised for building in assumptions relating to what it seeks to demonstrate, and then extracting, or justifying, a test from that, but in the heavily subjective realms of definition in the artistic field one has to start somewhere.
- (ix) The process of fabrication is relevant but not determinative. I do not see why a purely functional item, not intended to be at all decorative, should be treated as a sculpture simply because it is (for example) carved out of wood or stone.

119. Those factors are guidelines, not rigid requirements. The question: “What is a sculpture?” has some of the elements about it of the unanswerable question: “What is

Art?” However, they do, in my view, represent what one can extract from the cases, definitions and statutes in order to assist in answering the question whether any particular article is a sculpture or not. They are an attempt to extract elements from what plainly are sculptures, to distinguish what makes something plainly not a sculpture, and to arrive at some factors which result from that exercise. I would no more attempt a definition than any of the judges in the other authorities.

120. I turn, therefore, to consider whether the relevant articles in the present case are sculptures or not.
121. First, the original Stormtrooper helmet. This has, as its genesis, the McQuarrie drawings. 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. But its primary function is utilitarian. While it was intended to express something, that was for utilitarian purposes. While it has an interest as an object, and while it was intended to express an idea, it was not conceived, or created, with the intention that it should do so other than as part of character portrayal in the film. That, in my view, does not give it the necessary quality of artistic creation inherent in the test suggested by Laddie J. Not everything which has design appeal is necessarily a sculpture. I think that the ordinary perception of what is a sculpture would be over-stretched by including this helmet within it, and when rationalised the reasons are those just given. It is not that it lacks artistic merit; it lacks artistic purpose. I therefore find that the Stormtrooper helmet is not a sculpture.
122. The same reasoning applies to the armour, and to the other helmets. They all shared the same sort of original purpose.
123. Next, it is necessary to consider the toy Stormtroopers, and other characters, which are taken as being reproductions of the armour and helmets for the purposes of section 52. These are, as already described, articulated models which are sold as toys and which are intended for the purposes of play. Play is their primary, if not sole, purpose. While their appearance is obviously highly important (if they did not look like the original, the child would not be so interested) they are not made for the purposes of their visual appearance as such. While there is no accounting for taste, it is highly unlikely that they would be placed on display and periodically admired as such. The child is intended to use them in a (literally) hands-on way, in a form of delegated role play, and that is doubtless how they are actually used. That means, in my view, they are not sculptures. They can be distinguished from the model in *Britain* which apparently had a significant element of being admirable for its own visual sake. That does not apply to the Stormtrooper, whose only real purpose is play. In reaching this conclusion I am not saying that the *Britain* model is better at what it portrays than the Stormtrooper model. That would be to make judgments about artistic quality, which the statute understandably forbids. It is making a judgment about whether there is anything in the model which has an artistic essence, in the sense identified above. I conclude that there is not.

Works of artistic craftsmanship

124. This is the other difficult concept with which I have to grapple in terms of whether things are artistic works. It is necessary to do so for much the same reasons as arise in relation to the question of sculpture – it is claimed that the helmets and armour are works of artistic craftsmanship for the purpose of the subsistence of copyright, and for the purposes of taking them out of the clutches of section 51, but the question has no relevance to section 52.
125. Section 4(1) of the 1988 Act includes, as an “artistic work” afforded the protection of copyright

“(c) a work of artistic craftsmanship”

No definition or elaboration of that term is provided for by the Act. The leading House of Lords authority on the point, *George Hensher Ltd v Restawhile Upholstery (Lancs) Ltd* [1976] AC 64 contained 5 differing forms of elaboration. It was conceded in that case that the work (a prototype piece of furniture) was a work of craftsmanship so the debate focussed on the “artistic” requirement.

Lord Reid explained the significance of the intention of the maker or designer as follows:

“It is I think of importance that the maker or designer of a thing should have intended that it should have an artistic appeal but I would not regard that as either necessary or conclusive. If any substantial section of the public genuinely admires and values a thing for its appearance and gets pleasure or satisfaction, whether emotional or intellectual, from looking at it, I would accept that it is artistic although many others may think it meaningless or common or vulgar. [page 78]

....

During last century there was a movement to bring art to the people. I doubt whether the craftsmen who set out with that intention would have regarded all their products as works of art, but they were certainly works of artistic craftsmanship whether or not they were useful as well as having an artistic appeal. [pp 78-9]

....

In the present case I find no evidence at all that anyone regarded the appellants’ furniture as artistic. The appellants’ object was to produce something which would sell...no doubt many customers bought the furniture because they thought it looked nice as well as being comfortable, but looking nice appears to me to fall considerably short of having artistic appeal. I can find no evidence that anyone felt or thought that the furniture was artistic in the sense which I have tried to explain.” [page 79]

126. Lord Morris suggested some form of minimum standards before something could be called “artistic”, but did not elaborate on what was necessary to exceed them. At page 81 he said:

“If it is asked whether works which possess distinctive features of design and skill in workmanship or works which possessed distinctive characteristics of shape, form and finish or qualify to be called artistic, I would say that the word ‘artistic’ calls for something additional and different. If it is asked whether there is artistry if there is an appeal to the eye, I would say that something more is needed. In any event, and apart from this, such questions would tend to suggest or to impose a clamp of rigidity and restriction in definition where none is needed.

In deciding whether a work is one of artistic craftsmanship, I consider that the work must be viewed and judged in an attached and objective way. The aim and purpose of its author may provide a pointer, but the thing produced must itself be assessed without giving decisive weight to the author’s scheme of things.....

So I would say that the object under consideration must be judged as a thing in itself. Does it have the character or virtue of being artistic?”

127. Viscount Dilhorne expressed views about what was required before a work could be one-off craftsmanship. At page 84 he said:

“A work of craftsmanship is, in my opinion, something made by hand and not something mass produced.”

He went on to differ from the trial judge as to whether the work, which was conceded to be one of craftsmanship, was artistic. At page 84 he said:

“I do not think that the presence of distinctive features of shape, form and finish suffices to make a work artistic.”

differing in that respect from the trial judge who had found to the contrary. He then went on to consider what did make a work artistic, and he rejected the suggestion that that depended on whether or not the primary inducement for its creation was its functional character (if any). He also rejected the notion that it was determinative whether or not the object was intended to have eye appeal. Further, he rejected other alternative tests put forward by counsel. He said that at the end of the day point was a question of fact on which evidence, including expert evidence, might be given.

128. Lord Simon resisted any idea that the relevant expression should be used in an “artificially extended sense”.

“The words can bear their natural and ordinary meaning.” [page 89]

He pointed out the origin of the words in the legislation, which was to give copyright protection to the product of the Arts and Crafts movement with emphasis on the applied or decorative arts. At page 91 he drew attention to the fact that the relevant phrase “works of artistic craftsmanship” was a composite phrase to be construed as a whole.

“A work of craftsmanship, even though it cannot be confined to handicraft, at least presupposes special training, skill and knowledge for its

production...“craftsmanship”, particularly when considered in its historical context, implies a manifestation of pride in sound workmanship – a rejection of the shoddy, the meretricious, the facile. But the craftsmanship – not the work itself – must in addition be artistic.”

He then gave examples of craftsmanship which was not artistic – a cobbler, a dental mechanic, a pattern-maker, a boilermaker, a plumber, a wheelwright and a thatcher. He contrasted that with the maker of hand-painted tiles. At page 94 he proposed a test. In that context he said:

“I start by re-emphasising that the statutory phrase is not ‘artistic work of craftsmanship’ but ‘work of artistic craftsmanship’ and that this distinction accords with the social situation in which Parliament was providing a remedy. It is therefore misleading to ask, first, is this a work produced by a craftsman, and secondly, is it a work of art? It is more pertinent to ask is this the work of one who was in this respect an artistic-craftsman. It follows that the artistic merit of the work is irrelevant...not only is artistic merit irrelevant as a matter of statutory construction, a valuation of artistic merit is not a task for which judges have any training or general aptitude...since the Tribunal will not attempt a personal aesthetic judgment...it follows, again, that whether the subject matter is or is not a work of artistic craftsmanship is a matter of evidence; and the most cogent evidence is likely to be from those who are either themselves acknowledged artists-craftsmen or concerned with the training of artists-craftsmen – in other words, expert evidence. In evaluating the evidence, the court will endeavour not to be tied to a particular metaphysics of art, partly because the courts are not naturally fitted to weigh such matters, partly because Parliament can hardly have intended the construction of its statutory phrase should turn on some recondite theory of aesthetics...it is probably enough the common experience tells us that artists have vocationally an aim and impact which differ from those of the ordinary run of humankind.”

129. Lord Kilbrandon considered that the craftsman’s intention was the primary test:

“The conscious intention of the craftsman will be the primary test of whether his product is artistic or not; the fact that many of us like looking at a piece of honest work, especially in the traditional trades, is not enough to make it a work of art.”

He disclaimed the possibility of arriving at a comprehensive definition of the word “artistic”. He thought that expert evidence would not help:

“Since the word [artistic] is a word of common speech, it requires, and permits of, no interpretation by experts. It is for the judge to determine whether the object falls within the scope of the common meaning of the word.” [page 97]

In the next paragraph of his judgment Lord Kilbrandon referred to the evidence given by the makers of the subject item as to what they thought they were doing. He observes that:

“No-one thought he was assisting at the delivery of a work of art.”

He said they threw a light on the process which was taking place. It seems to follow that he gave great weight to the purpose of the creation. Other than that, his judgment sheds no further light on what meaning should be given to the word “artistic”.

130. It is, with respect, not easy to obtain much general guidance from this case, but what I take from it for present purposes is as follows:

- (i) In *Merlet v Mothercare plc* [1986] RPC 115, as recorded by Tipping J in *Bonz* (referred to below), Walton J carried out a headcount and came to the reluctant conclusion that the majority concluded that the work in question had to be a work of art. That interpretation was not urged on me by either party and I do not adopt it.
- (ii) The intention of the creator has some real relevance.
- (iii) The composite phrase is important and has to be borne in mind.
- (iv) At least some of their lordships clearly contemplated that expert evidence would be necessary. Others did not. I do not find that it is in fact necessary, and indeed, so far as one can tell, in subsequent cases the question was determined without it.

131. In *Bonz Group (Pty) Ltd v Cooke* [1994] 3 NZLR 216 the New Zealand High Court had to consider “artistic craftsmanship” in the context of woollen sweaters. Tipping J considered *Hensher* and other authorities and concluded that:

“for a work to be to be regarded as one of artistic craftsmanship it must be possible fairly to say that the author was both a craftsman and an artist. A craftsman is a person who makes something in a skilful way and takes justified pride in their workmanship. An artist is a person with creative ability who produces something which has aesthetic appeal.”

I find that helpful. Having said that, he was prepared to combine the artistry of the designer and the craftsmanship of the knitters and conclude that the sweaters fell within the description, rejecting authorities which tended to suggest that they had to be the same person. That seems to me to be a sensible approach, at least where there is a proper nexus between the two people. If William Morris conceived a design, but it was actually given form by others working (as he intended) from those designs, I do not see why it should be disqualified from being a work of artistic craftsmanship when, if he had made it himself, it would have qualified. Mr Wilson was disposed to accept that, but said it did not apply where there was no connection between the two. I do not need to investigate whether his limitation is right, because it is plain enough in the present case that wherever Mr Ainsworth was working to a design, he was intended to do so, and there was a clear nexus if the works would otherwise qualify.

132. I was shown *Vermaat & Powell v Boncrest Ltd* [2001] FSR 5 in which Evans Lombe J considered an artistic craftsmanship claim in relation to bedspread designs. He adopted the analysis of Tipping J and found that the result was not sufficiently artistic to come within the description. He did not reason his conclusion; it was plainly a matter of judicial judgment.

133. With those authorities in mind, I turn to the question of whether the Stormtrooper helmets and armour are works of artistic craftsmanship. I am prepared to assume that

the ultimate production of these articles was an act of craftsmanship. Mr Ainsworth can fairly be called a craftsman – he produces high quality products and has a justifiable pride in his work. He is not a slavish copier, or a jobbing tradesman. The production of the helmets and armour required the activity of a craftsman to realise the vision of the creators of the film in this respect.

134. However, I do not consider that they are works of artistic craftsmanship. So far as their conception is concerned, they plainly were not. Their purpose was not to appeal to the aesthetic at all. It was to give a particular impression in a film. That was what Mr Lucas and Mr McQuarrie set out to do. It was no part of their purpose that it should in any way appeal as a piece of art; or that it should be admired for any aspect of its appearance as such; or that it should do anything more than what was necessary to give the correct impression of the character inside (and perhaps an environment) when used in a film (with all the assistance that the techniques of filming can do to enhance an impression). If one takes products of the Arts and Crafts movement as an exemplar, the helmet and armour share nothing of the conceptual purpose of such products. A work of artistic craftsmanship does not have to be something of which William Morris would have been proud, but it is a not wholly irrelevant test in a case like the present to consider whether he would recognise it as having anything at all with what his movement was seeking to do. I do not think he would. (I stress that I do not propose that as a general test. It is I who has to decide this case, not the ghost of William Morris. It is merely a way of making a point in a case as striking as the present). That was not changed when the conception was put into operation. The purpose remained the same. Unlike a work of artistic craftsmanship, they were not intended to sustain close scrutiny. They carried their own acts of deception – what look like corrugations of a gas tube are in fact painted on, as are some apparent vents.
135. That deals with the Stormtrooper helmets. The same applies to the armour. Its origins, and purpose in conception, were in substance the same as the helmet, and its ultimate purpose as used was also the same. It fails to be a work of artistic craftsmanship for the same reason. So far as necessary, I determine the same in relation to the other helmets and associated items, again for the same reasons. In the case of some of those, they also carry their own cinematic trompe d'oeuils in the form of radio boxes, which are merely pressed plastic which look like precisely that in the flesh.

Section 51

136. Section 51 is primarily intended to deal with the situation of the reproduction of a drawing by means of a 3 dimensional object. The genesis of it lay in the desire to allow generic industrial spare parts to be made by third party suppliers without their being accused of infringement of copyright in underlying drawings which usually preceded the manufacturer's "original" spare part, though its text is not confined to that situation. So far as material, it reads:

“51 Design documents and models

(1) It is not an infringement of any copyright in a design document or model recording or embodying a design for anything other than an artistic work or a typeface to make an article to the design or to copy an article made to the design.

....

(3) In this section-
'design' means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article, other than surface decoration
'design document' means any record of a design, whether in the form of a drawing, a written description, a photograph, data stored in a computer or otherwise."

137. In the present case this section arises so far as the copyright claim has its origins in drawings or prior models which they all do, and where those drawings or models are the basis of the copyright claim, which in large measure it is. Thus it arises where the disputed items have their origins in the McQuarrie drawings, the Mollo drawings or where there was a preceding model (the Stormtrooper clay model, and possibly the Stormtrooper armour). Mr Ainsworth says that he comes within the section because he has made articles to the design.
138. Two questions potentially arise in relation to this section:
- (i) Whether the preceding drawings were "design documents". If they were not design documents the section cannot apply.
 - (ii) Whether the items for which the documents in question are design works are themselves artistic works. If they were artistic works then the section does not apply and the copyright in the design drawings can be enforced. This comes down to the question of whether those of the helmets and other items which were made from drawings were sculptures or works of artistic craftsmanship.
139. It is plain that all the items in this case which are in issue, apart from the X-wing pilot helmet, had their origins (in a loose sense) in drawings or models. The Stormtrooper helmet and armour had their origins in the McQuarrie drawings, and they each had part of their origin in a mould as well. That is, after all, how Lucas makes its infringement claim. However, a point arises as to the purpose of the drawings. Lucas says that the McQuarrie drawings did not contain designs "for" the Stormtrooper helmet or armour because the purpose of those drawings, when they were created, was not to provide for the ultimate design of those things. Mr Bloch submitted that where a drawing was created for an original purpose which did not involve the creation of 3D articles from it, and then subsequently it was used in order to stand as a design for such articles, it was not a design drawing. In other words, its purpose had to be tested as at the date of the drawing, and not by reference to what it was used for afterwards. In this connection he relied on *King Features Syndicate Inc v O & M Kleeman Ltd* [1941] AC 417. That was a case which turned on different legislation. A cartoon strip character (Popeye) was created just as a cartoon, with no intention to make articles from the design. When articles were in fact made corresponding to the original strip, it was held that that new intention did not cause a forfeiture of copyright by reference to a cross-reference to the Registered Designs Act 1949. The intention had to be judged by reference to the original creation date. Mr Bloch said that the same applied to section 51, even though section 51 cannot realistically be viewed as successor legislation to the legislation in the Popeye case. Mr Wilson shifted his ground on this. He first invited me not to follow *King* in terms of the timing of the intention; then he suggested it was in fact good law not only in relation to its own legislation, but also in relation to section 51,

notwithstanding the intervening terms of section 10 of the Copyright Act 1956 (which was closer to section 51 than the *King* legislation).

140. All this potentially raises some difficult questions of timing, notwithstanding the apparent agreement between the leaders in this case on the point, but it is not a point that I have to address when one looks at the facts. The purpose of the McQuarrie drawings was to provide designs for the film. There was a certain amount of look and feel, but the design of the elements shown in them was very much part of its central purpose. The drawings of the Stormtroopers were not intended to be the definitive design to which the ultimate product must be made, in the sense that a car part will be made from an exactly corresponding drawing, but it is plain that the intention was that it be followed as closely as possible. It was not some vague idea, some elements of which, or ideas from which might be adopted in the future. It was in a very real sense a design for the costume/prop that was to appear in the film. In those circumstances I am satisfied that it was a design “for” the helmet and armour and therefore a design document in relation to them. The same applies even more clearly to the other drawings which I find to have been copied.
141. The section is therefore capable of barring a copyright claim in relation to the design document if it is for “anything other than an artistic work”. If the items were not artistic works, the section works in Mr Ainsworth’s favour and prevents his acts being infringements. The designs could only be for artistic works in this case if they were for a sculpture or a work of artistic craftsmanship. I have held that they were not artistic works in either of the two candidate senses. Therefore the designs were for something other than an artistic work and section 51 operates in Mr Ainsworth’s favour to prevent his copying of the work being an infringement of copyright. Arguments of some sophistication were advanced before me as to what Mr McQuarrie might have had to have intended in terms of creating sculptures or works of artistic craftsmanship. I do not think the link is that difficult. He was designing what he was designing. The part that intention plays in determining whether something is a sculpture or work of artistic craftsmanship has already been dealt with in relation to those concepts. I do not consider that any further refinement is required here.
142. The clay Stormtrooper head and the original clay armour are “models” within section 51, so the same conclusion applies to a claim for infringement in relation to them.

Section 52

143. Section 52 of the 1988 Act provides another potential defence to Mr Ainsworth. He does not need it if he wins on section 51, which I have held he does, but I will nonetheless consider it.
144. Section 52 operates to shorten the copyright period applicable to some copyright items which are reproduced industrially and then sold, to a period of 25 years from the date when they were first marketed. It reads as follows:

“52. Effect of exploitation of design derived from artistic work

- (1) This section applies where an artistic work has been exploited, by or with the licence of the copyright owner, by –

- (a) making by an industrial process articles falling to be treated for the purposes of this part as copies of the work, and
 - (b) marketing such articles, in the United Kingdom or elsewhere.
- (2) After the end of the period of 25 years from the end of the calendar year in which such articles are first marketed, the work may be copied by making articles of any description, or doing anything for the purpose of making articles of any description, and anything may be done in relation to articles so made, without infringing copyright in the work.
- (3)
- (4) The Secretary of State may by order make provision –
- (a) as to the circumstances in which an article, or any description of article, is to be regarded for the purpose of this section as made by an industrial process;
 - (b) excluding from the operation of this section such articles of a primarily literary or artistic character as he thinks fit.
- (5)
- (6) In this section –
- (a)
 - (b) References to the making of an article are to its being sold or let for hire or offered or exposed for sale or hire.

145. As appears above, subsection (4) enables subordinated legislation to exclude items from the operation of the section, and as to the circumstances in which an article is to be regarded as made by an industrial process. The section has been invoked to define articles made by an industrial process, and to exclude sculptures from the operation of the section. The Copyright (Industrial Processes and Excluded Articles) (No 2) order 1989 (SI 1989 No 1070) does some of this. Article 2 provides:

“2. An article is to be regarded for the purposes of s.52 of the Act (limitation of copyright protection for design derived from artistic work) as made by an industrial process if –

- (a) it is one of more than 50 articles which –
 - (i) all fall to be treated for the purposes of Part I of the Act as copies of a particular artistic work, but
 - (ii) do not all together constitute a single set of articles as defined in s.44(1) of the Registered Designs Act 1949; or
- (b) it consists of goods manufactured in lengths or pieces, not being hand made goods.

3. (1) There are excluded from the operation of s.52 of the Act –
 - (a) works of sculpture, other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process;
 - (b) wall plaques, medals and medallions; and
 - (c) printed matter primarily of a literary or artistic character, including book jackets, calendars, certificates, coupons, dress-making patterns, greetings cards, labels, leaflets, maps, plans, playing cards, postcards, stamps, trade advertisements, trade forms and cards, transfers and similar articles.
- (2) Nothing in article 2 of this Order shall be taken to limit the meaning of “industrial process” in paragraph (1)(a) of this article.”

146. The paper-chase then takes one to the (now repealed) section 44 of the Registered Designs Act 1949, where “set of articles” was defined as follows:

“‘set of articles’ means a number of articles of the same general character ordinarily on sale or intended to be used together, to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied.”

147. The defendants rely heavily on this section. They say that the designs of the Stormtrooper helmet and armour have been reproduced industrially within the meaning of the section, and that it has been going on for more than 25 years. The precise level of manufacture and sales was not the subject of detailed evidence, and in order to avoid unnecessary and potentially difficult disclosure the claimants conceded that the following factual basis could be taken as being true for the purposes of this section and section 10 of the Copyright Act 1956. First, that the relevant artistic work was exploited by the making of articles by an industrial process; second, that more than 50 were made and sold (ie the numerical condition should be treated as fulfilled); third, that the manufacture took place outside the UK; and fourth, that that exploitation took place both before and after the coming into force of the 1988 Act on 1st August 1989. As a paradigm of the things that were made I have taken the model Stormtrooper, referred to above. On the basis of that concession further disclosure was not sought. What was not the subject of agreement or concession was the time when manufacture actually started – in particular whether it started 25 years or more before Mr Ainsworth started his own manufacture. However, as will appear, in the events that happened that does not matter. If it had mattered I would have been minded to order further disclosure in order to clarify the starting date point.

148. Unfortunately, the passage through this already difficult legislation is made more tortuous by the need to look back to section 10 of the 1956 Act. That Act had a similar provision but with a 15 year period in place of the 25 year period in the 1988 Act – if an artistic work was exploited by 15 years of manufacture, then the copyright period was truncated. One has to look back to the 1956 Act because of one of the transitional provisions of the 1988 Act. Paragraph 20 of Schedule 1 to the 1988 Act contains transitional provisions relating to this area :

“20(1) Where section 10 of the 1956 Act ... applied in relation an artistic work at any time before commencement, section 52(2) of this Act applies

with the substitution for the period of 25 years mentioned there of the relevant period of 15 years as defined in section 10(3) of the 1956 Act.

(2) Except as provided in sub-paragraph (1), section 52 applies only where articles are marketed as mentioned in subsection (1)(b) after commencement.”

149. Section 10 of the 1956 Act was replaced by section 52 of the 1988 Act. The effect of paragraph 1 can be summarised as follows. If the clock had started running under the 1956 Act, and had not run down by the time the 1956 expired (as it were) and the 1988 Act came into force (ie by 1st August 1989), then the provisions of section 52 operated but with a shorter period of 15 years. So any items whose exploitation spanned the two Acts (where copyright had not already been cut down by virtue of the expiry of 15 years) could be qualifying if it satisfied the provisions of the 1956 Act to start the clock running, and then satisfied the provisions of the 1988 Act, but only for 15 years.
150. Mr Wilson submitted that in addition to those transitional provisions, the Act had a form of retrospective effect in that, even if the 1956 Act did not apply to pre-1988 Act exploitation (ie the clock had not started running under the 1956 Act), nevertheless section 52 itself could look back 25 years into the earlier period if its requirements were fulfilled. I doubt whether that is correct. The effect of such retrospectivity would be to deprive a copyright owner of his copyright by virtue of acts which were, when they were done, incapable of affecting him adversely. He would then suddenly find he had been acting dangerously (as it were) for a number of years. Thus a copyright owner who had allowed exploitation by licence for, say, 24 years up to August 1989, in a manner which had not started the clock running under section 10 of the then extant legislation, and who could not terminate his awarded licenses for a year or more, might suddenly find his copyright cut down after another year by legislation he could not have foreseen and which he could not avoid when section 52 bit. Such a serious potential consequence reinforces the normal interpretation presumption against retrospectivity in legislation. Mr Wilson claims to get retrospectivity out of paragraph 20(2). I do not think that the wording really bears that interpretation. If it had been intended to give rise to retrospectivity, it would have said something else. What it is apparently intended to do is to limit section 52 to cases where acts of exploitation took place on and after 1st August 1989, except where the clock had started running under the earlier legislation. In my view it should read as if it said “only to acts of marketing” in place of “only where articles are marketed”. However, as will appear below, I do not need to decide this point because I think that the clock had started running under the 1956 Act and had run down by the time Mr Ainsworth started his activities. Furthermore, it is not easy to imagine circumstances in which section 52 applied when section 10 did not.

151. I therefore need to set out section 10 of the 1956 Act:

“10. Special exception in respect of industrial designs

(2) Where copyright subsists in an artistic work, and –

(a) a corresponding design is applied industrially by or with the licence of the owner of the copyright in the work, and

(b) articles to which the design has been so applied are sold, let for hire, or offered for sale or hire [whether in the United Kingdom or elsewhere]

The following provisions of this section shall apply.

(3) Subject to the next following subsection, after the end of the relevant period of 15 years it shall not be an infringement of the copyright in the work to do anything which at the time when it was done would, if a corresponding design had been registered under the Registered Design Act 1949 ... immediately before that time have been within the scope of the copyright in the design as extended to all associated designs and articles. In this subsection 'the relevant period of 15 years' means the period of 15 years beginning with the date on which the articles ... were first sold, let for hire or offered for sale or hire, whether in the United Kingdom or elsewhere.

.....

(4) For the purposes of subsections (2) and (3) of this section, no account shall be taken of any articles in respect of which, at the time when they were sold, let for hire, or offered for sale or hire, the design in question was excluded from registration under the Act of 1949 by rules made under subsection (4) of section 1 of that Act (which relates to the exclusion of designs for articles which are primarily literary or artistic in character) and for the purposes of any proceedings under this Act a design shall be conclusively presumed to have been so excluded."

152. When combined with subsection (6), the effect of those provisions is to cut back the copyright period to 15 years. I do not at this stage need to deal with the potentially complex interaction with the registered design legislation; that is a sufficient summary for these purposes.
153. Items excluded from registration under the Registered Design Act 1949 do not count for the purposes of the operation of section 10. The Designs Rules 1949 (which operate under that Act) exclude:

“designs to be applied to ... works of sculpture other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process”.

Thus if the manufactured things are sculptures, their sale does not start the clock running under section 10.

154. Thus the logical starting point is section 10, to see if the clock started running.
155. I have already held that the helmets themselves are not sculptures applies to both the 1988 and the 1956 Acts; it was not suggested that there was any difference. Accordingly, the helmets themselves were not artistic works within the meaning of that Act (see section 3). So the relevant artistic works, for the purposes of section, must be the drawings.
156. Next is the possibility of the exclusion of the section because what was produced was a sculpture. The industrial application and sale has been admitted. However, no admission was made as to the legal nature of what was manufactured. The paradigm case was the model or toy, and Lucas said it was a sculpture. If it was, its manufacture did not count and the clock had not started running. It is therefore necessary to consider whether or not such an item is a sculpture. I have already held it was not – see above.

Accordingly, that is no bar to the Act applying and the clock running. The exploitation by sale of these items is capable of being within section 10.

157. Mr Wilson also argued that the sale of Stormtrooper helmets by Mr Ainsworth to Lucas was capable of falling within the statute. The short answer to this is that the sale, as a result of a manufacturing commission, does not fall within the concept of sale contained in section 10(2). That section contemplates a more general marketing, in my view – making the thing available to members of the public. A sale by a manufacturer, manufacturing to the copyright owner’s design and instructions, for the purposes of sale to the owner, is not such a sale.
158. So far, therefore, Mr Ainsworth can say that the requirements of section 10 have been fulfilled. However, Lucas raise a territoriality point. They say that for the section to apply manufacture (industrial application) has to take place within the UK. Since there is no evidence of manufacture here, the section is said not to apply. The same point is said to arise in relation to section 52. It is correct to say that the only evidence (in the form of a concession or admission) is in terms of foreign manufacture, so the point arises on the evidence.
159. There is no express territorial limitation with respect to industrial application in either statute, but the limitation is said to come from a combination of two things – the normal territorial limitation of copyright to this jurisdiction, and the express reference to the place of sales to “the United Kingdom or elsewhere” in section 10(2)(b) of the 1956 Act and section 52(1)(b) of the 1988 Act. The claimants rely on those words (originally introduced into the 1956 Act by the Design Copyright Act 1968) as demonstrating that the express provision for sales to be outside the UK means that only manufacture *within* the UK was intended to be within it.
160. In support of their case in this respect the claimants rely on the present and a past edition of Copinger and Skone-James on copyright. In the current (15th) edition the editors refer to section 10 and say (in paragraph 13-334):

“It should be noted that when section 10(2) was amended by the Design Copyright Act 1968, the words “whether in the United Kingdom or elsewhere” were added to section 10(2)(b) but not to section 10(2)(a). This suggests that, whilst the marketing of articles may take place anywhere, the actual process of industrially applying the design to articles must have taken place within the United Kingdom.”
161. The 12th edition was more forthright. In paragraph 229, dealing with section 10, the editors say:

“It is to be noted that these three conditions were cumulative. If, therefore, one condition was not satisfied it would seem that section 10(2) would not have applied. This could have occurred, it is submitted, if, for instance, the industrial application took place in America and the relevant articles were sold in America and this country. That is to say, neither condition relating to the industrial application, nor the condition relating to sale specified where that activity had to take place for the condition to be satisfied. It is submitted that, in the circumstances, both were confined to this country since it would seem surprising if, by reason of industrial application and

sale in, for instance, America alone, there should be a limitation on the English artistic copyright. Some support for this submission is to be found in the Design Copyright Act 1968 which, in amending s.10, inserts the words ‘whether in the United Kingdom or elsewhere’ at the end of a condition relating to sale, but makes no similar provision in relation to the conditions relating to industrial application.”

162. I do not agree with either set of editors. I start with the manifest purpose of the sections. It is to restrict copyright where there has been an exploitation in the form of multiple production and sale. In those circumstances the copyright term is cut down. Bearing in mind that purpose, it is not obvious why there should be any territorial limitation on the place of production. If the principle is that industrial exploitation plus sales should diminish the period of protection, why should the place where manufacture happens to be done matter? If any case can be made for saying that territoriality might matter, it would be in relation to the place of sale, but that matter has been put beyond doubt by the words originally introduced into the 1956 Act by the 1968 Act, and which have survived into the 1988 Act – sales can be in the UK or elsewhere, so there is no territorial limitation in respect of them. The place of manufacture seems to me to be supremely irrelevant to the question – I can detect no point of principle which would indicate that it should matter whether the articles were made in the UK as opposed to elsewhere. Such a distinction would be arbitrary.
163. The case of the claimants on this point requires the implication of words of restriction in section 10(2)(a) of the 1956 Act and section 52(1)(a) of the 1988 Act. Creating an arbitrary and pointless distinction is a highly unpromising starting point for such an implication. I can see no positive reason why such words should be implied, and therefore decline to make the implication. I do not think that the claimants (or the editors of Copinger) can gain any support for the implication from the presence of the words “in the United Kingdom or elsewhere” in the two statutory provisions in relation to sales. Those words may have been inserted to put beyond doubt the question of where the sales can take place. They do not create doubt as to where the manufacture can take place. When one asks why the legislature should have wanted to restrict the place of manufacture while broadening the place of sales, one cannot, in my view, come up with any sensible answer. Accordingly it is not possible to imply the sort of territorial implication propounded by the claimants and suggested by Copinger. I find that it does not exist.
164. Mr Wilson had an alternative argument based on the words “articles falling to be treated for the purposes of this Part as copies of the work”. He pointed out that provisions of that Part of the Act were capable of applying to copies wherever created, and he pointed to sections 27(3)(a), 155 and 175(1)(a) in this respect. These points merely reinforce the conclusion that no implication is appropriate.
165. We are therefore in the position that acts occurred which were capable of starting the clock running under the 1956 Act. There was industrial application of an artistic work; there were sales of articles to which the design was applied; and what was made (and, if it matters, the artistic work which was applied) was not excluded as being a sculpture. The clock therefore started running. The point was considered principally by reference to the Stormtrooper helmet and armour, and I took the toy as a paradigm application.

There was little investigation in relation to the other designs (for helmets), but Lucas did not seek to assert any different application of sections 10 and 52 in relation to them.

166. The clock having started running, then if the provisions of section 52 applied to the situation on and after 1st August 1989, then after 15 years Mr Ainsworth can copy without infringing copyright. It is therefore necessary to turn to consider whether the requirements of section 52 are fulfilled. Again, it is conceded there was industrial application (outside the UK), and sales and marketing in numbers greater than 50. The reasons put forward for the section not applying were the territoriality point in relation to the place of manufacture (industrial application) and the sculpture point. So far as the territoriality point is concerned, I have dealt with that. There was some dispute as to whether the reference to sculpture in Article 3 of the order applied to the original artistic work, or to what was produced industrially, but since neither the helmet and armour nor the toy qualify (again, see above) this is not a point that assists Lucas. Accordingly, there has been activity falling with section 52.
167. The only remaining point is whether there had been 15 years' worth of activity before Mr Ainsworth started his reproduction in 2004. If there had not been appropriate concessions on timing by Lucas, this might have required some further disclosure. On its face the concession by Lucas led to some tight timing. The only express concession was that there had been industrial application and sales before the coming into force of the 1988 Act, ie pre-1st August 1989. 15 years from then took one to, say, the end of July 2004, which might have led to some of Mr Ainsworth's earlier activities falling just within the 15 years. However, Mr Bloch said that he did not seek to say that the application and sales activities should be taken as taking place only in the latter part of 1989. In substance he was accepting that they could be taken as happening in the early part. That means that the 15 years expired before Mr Ainsworth started his activities, and he can have the benefit of section 52.
168. Had Mr Wilson lost on the "place of manufacture" point he would have wanted to rely on the sales by Mr Ainsworth to Lucas of at least 50 Stormtrooper helmets as amounting to an industrial application and a sale. I have already said that I do not consider that that was a sale for the purposes of section 10. Questions were also argued as to whether such items were a "set" for the purposes of the 1989 Order. These questions do not in fact arise, and I do not intend to deal with them. I also record that Mr Wilson developed extensive arguments based on the interaction of the copyright legislation with the registered designs legislation. A limited amount of interaction is identified above. I did not in the end consider that I was assisted by any attempt to penetrate further into this very dense legal thicket, save to say that if copyright protection for these articles is not available, then Lucas, or someone in its position, is not totally without protection for its ideas. The registered design legislation provides its own regime of protection.
169. It follows, therefore, that, were it necessary for him to do so, Mr Ainsworth can rely on section 52 so that his activities in copying the drawings in this case (or the clay head, or the clay armour) was not an infringement of Lucas's copyright.

Passing off

170. The claimants rely on both classic passing off and reverse passing off. The material on which they rely is as follows.
171. Lucas starts by relying on its goodwill and reputation in the film. It is claimed that this goodwill and reputation extends into its extensive business of licensing toys, models and other items reproducing facets of the film. This includes the fictional characters and their garb.
172. The offending activities of Mr Ainsworth are said to come from what he says in his publicity. On his website Mr Ainsworth stresses the authenticity of his products. Lucas relies on the following words:

“Andrew Ainsworth and Shepperton Design Studios created the original helmets and armour for the greatest sci-fi fantasy film of all time. Now, almost 30 years on and for the FIRST time ever, YOU can own an exclusive 1:1 collectible replica of the original movie helmets.
Made by the original prop-maker from the original moulds. [The emboldening is in the original.]
Produced and endorsed by Andrew Ainsworth at Shepperton Design Studios, these unique props offer collectors a rare opportunity of owning some of the most iconic designs of modern cinema.

These unique collectibles are the ONLY helmets ever produced from the original moulds used to create the screen-used helmets....”

173. Lucas also relies, to a more limited extent, on other statements made in third party websites about Mr Ainsworth in which the authenticity of the helmets was stressed in that he was using the original moulds. On one website, Mr Ainsworth is described as being the man who “created the original iconic white outfit”. The accuracy of the products is also stressed. It is said that by using the product, a purchaser can “transform [himself or herself] into a genuine Imperial Stormtrooper. And when we say genuine we really mean it, because almost 30 years after prop-maker Andrew Ainsworth of Shepperton Design Studios created the original iconic white outfit, you can own a ludicrously collectible 1:1 replica, including a helmet that has been made using the original 1976 movie moulds! Yes, the actual moulds!”
174. The pleaded claim in relation to that material is as follows:
- (1) The material is calculated to lead and likely to lead members of the public to believe, contrary to the fact, that Lucas Licensing has licensed and/or endorsed and/or approved the manufacture and sale of the Ainsworth helmets and armour, or has otherwise been involved in some commercial arrangement with the defendants concerning such products.
 - (2) Alternatively, the acts of the defendants were calculated to lead and likely to lead members of the public to believe, contrary to the fact, that Mr Ainsworth was the creator or designer, alternatively the principal creator or designer, of the helmets and body armour.

175. It is said that, short of counterfeiting, it is hard to think of a context in which there might be a stronger case than the present one – Mr Ainsworth has gone as close to claiming to be licensed as he could without doing so expressly.
176. There is also a claim for reverse passing off. It is said that the claims made in those extracts have the effect that Mr Ainsworth was passing off Lucas's work as his own.
177. There was no dispute as to the basic elements of a passing off case – goodwill, a misrepresentation that the defendant's goods are those of the claimants, and damage (see *Reckitt & Colman v Borden* [1990] 1 WLR 491). The goodwill was not really disputed in the present case. The debate was about the extent of the misrepresentation.
178. It will be noted that Lucas did not claim that Mr Ainsworth was actually claiming his work as Lucas's. It is said that he was misrepresenting his work to be licensed by Lucas. It seems to me that such a mis-statement, if made, would be capable of amounting to passing off. However, I do not consider that it was made in the present case. The website makes some wrongful claims. It claims that Mr Ainsworth was the creator of the original helmets and armour (see the extract above, repeated later on the website when it says he "created the original Stormtrooper") when that does not correctly describe the situation. The word "created" in that context suggests design creativity, and he did not contribute that (or not much of it) – he made the Stormtrooper helmet and armour to someone else's design. However, that does not amount to any misrepresentation about licensing. I have looked at the entire website. It certainly puffs the alleged originality of the products (in that they were derived from the same moulds) but the emphasis is on Mr Ainsworth and his acts. Neither the extracts referred to above, nor anything else in the website, expressly or impliedly suggests that what he was doing was with Lucas's consent or licence. The references to authenticity are all references to the fidelity of the product to the original design, having been made on the same moulds or tools as the film's originals. That may or may not be true, but it is not suggestive of any licence (particularly when looked at in the round) and I do not consider that there to have been the misrepresentation alleged. This part of the claim therefore fails.
179. The "reverse passing-off" claim derives from *Bristol Conservatories Ltd v Conservatories Custom Built Ltd* [1989] RPC 455. In that case salesmen for the defendant company allegedly showed prospective customers pictures of the claimant's conservatories as if they were samples of the defendant's products and workmanship. It was held that those facts would, if proved, be capable of amounting to passing off. The thrust of the representation was that if the customers purchased from the salesmen, they would be getting the conservatory which had been designed and made by the people who had earned the goodwill in the products shown in the photographs. Ralph Gibson LJ cited the decision of Lord Greene in *Plomien Fuel Economiser Co Ltd v National School of Salesmanship Ltd* (1943) 60 RPC 209:

"It is quite sufficient, in my opinion, to constitute passing off in fact, if a person being minded to obtain goods which are identified in his mind with a definite commercial source is led by false statements to accept goods coming from a different commercial source."

180. Neither that, nor anything else in *Bristol Conservatories*, describes what Mr Ainsworth has done in the present case. He has not pretended that Lucas's goods are his; nor has he pretended that the goods that he was selling, which were in fact his own, were Lucas's. He says what he is selling are his own, and he is proud of them. What he says is true so far as the origin of the goods is concerned. It might be false so far as the creation of the original design is concerned but that is not misappropriating Lucas's goodwill in the manner required in passing off. What he has done is different – he has described himself as the original creator of the original goods. That may be untrue, and it may amount to one or more other civil wrongs (as to which there was no argument and there is no claim), but it does not amount to passing off. It is a (mis)statement about him, not about the goods he is selling. He does not sell his goods by reference to someone else's goods or someone else's goodwill.

181. Accordingly, the passing off claim fails.

Contractual claims relating to copyright

182. Lucas claimed that if, which it denied, Mr Ainsworth had acquired copyright in any of the props that he made, he was contractually obliged to assign those copyrights to Lucas. This point does not arise if I am correct in saying that the helmets and other props were not sculptures or works of artistic craftsmanship, because in that event they are not artistic works in which copyright can be claimed by anyone, but the point was argued and I will deal with it on the assumption that my determination on that point is wrong.

183. Mr Ainsworth was not an employee of Lucas, so any copyright in his creations would not vest in Lucas via section 11 of the 1988 Act. He was commissioned to produce the props as an independent contractor and he did not enter into any express obligations in relation to the copyright. That does not, however, necessarily mean that he is entitled to the copyright in that which he produces. At paragraph 6.62 of *Laddie, Prescott & Vitoria* the editors consider the position if a manufacturer commissions an outside designer to design a new or modified product to the manufacturer's specifications. They conclude:

“Where the outside draftsman was merely commissioned to produce engineering or production drawings from rough sketches supplied by the manufacturer the case for saying that the manufacturer is the owner in equity is very strong indeed. The principle in operation in all these cases is that both parties intended that the manufacturer or commissioner should have the rights necessary for him to protect the property he has purchased and the enterprise for which the drawings were intended to be used.”

Where that is the case, the law will consider the commissioner to be entitled to the copyright in equity, and the author to be under an obligation to assign it.

184. The position has been conveniently summarised by Lightman J in *Robin Ray v Classic FM* [1998] FSR 622, approved in *R Griggs Group Ltd v Evans* [2005] EWCA Civ 11. He was considering the question of the relationship between the commissioner and the contractor who is engaged to produce a copyright work and pointed out that if the contractor was to be deprived of the copyright (absent an express agreement to that

effect) it must be because of an implied term in the relationship. Having set out some basic law about the implication of terms he went on to say:

“(5) Where (as in the present case) it is necessary to imply the grant of some right to fill a lacuna in the contract and the question arises how this lacuna is to be filled, guidance is again to be found in *Liverpool*. The principle is clearly stated that in deciding which of the various alternatives should constitute the contents of the term to be implied, the choice must be that which does not exceed what is necessary in the circumstances (see Lord Wilberforce at p.245 F-G). In short a minimalist approach is called for. An implication may only be made if this is necessary, and then only of what is necessary and no more;

(6) Accordingly if it is necessary to imply some grant of rights in respect of a copyright work, and the need could be satisfied by the grant of a licence or an assignment of the copyright, the implication will be of the grant of a licence only;

(7) Circumstances may exist when the necessity for an assignment of copyright may be established. As Mr Howe has submitted, these circumstances are, however, only likely to arise if the client needs in addition to the right to use the copyright works the right to exclude the contractor from using the work and the ability to enforce the copyright against third parties. Examples of when this situation may arise include: (a) where the purpose in commissioning the work is for the client to multiply and sell copies on the market for which the work was created free from the sale of copies in competition with the client by the contractor or third parties; (b) where the contractor creates a work which is derivative from a pre-existing work of the client, e.g. when a draughtsman is engaged to turn designs of an article in sketch form by the client into formal manufacturing drawings, and the draughtsman could not use the drawings himself without infringing the underlying rights of the client; (c) where the contractor is engaged as part of a team with employees of the client to produce a composite or joint work and he is unable or cannot have been intended to be able to exploit for his own benefit the joint work or indeed any distinct contribution of his own created in the course of his engagement: see *Nichols Advanced Vehicle Systems Inc v Rees* [1979] RPC 127 at 139 and consider *Sofia Bogrich v Shape Machines* unreported, 4th November 1994 and in particular page 15 of the transcript of the judgment of Aldous J. In each case it is necessary to consider the price paid, the impact on the contractor of assignment of copyright and whether it can sensibly have been intended that the contractor should retain any copyright as a separate item of property.”

Paragraph (7) is the significant one. Lucas says that the circumstances of the present case fall within the sort of conditions that require the assignment of copyright.

185. I agree with and accept that submission. So far as the Stormtrooper helmet was concerned Mr Pemberton was working from careful drawings provided to him so that he could design a helmet. Mr Ainsworth was doing the same, and he had the

Pemberton model for a time too. In the initial stages Mr Ainsworth did not know precisely for what he was being asked to provide his prototype, but there came a time when he did. I do not consider that, at the time, the prospect of exploitation via future licensing was in the minds of both parties (and particularly Mr Ainsworth), because no-one anticipated the success of the film and licensing activities were not then what they have since become. However, Mr Ainsworth was working to render into 3D form the copyright designs of others. He could not himself make further copies without infringing that copyright. If he had produced the drawing exactly, then he would not have produced an original work, and could not have claimed copyright. He did not do that, and contributed his own bits and pieces, but in doing so he was getting as close as he conveniently could, bearing in mind technical requirements, to the client's design. He must have known that the client would expect full exploitation rights in the future for the purposes of its dramatic offering and cannot realistically have expected to have retained any for himself. If the officious bystander had asked the required question (suggesting that Lucas would have all the rights and that Mr Ainsworth would not be entitled to exploit them without Lucas's licence) then the required testy suppression would have been forthcoming. I think that this is a classic case for saying that there is an implication that the commissioner would have the copyright in the helmet (if any).

186. There was evidence that employees of Lucas signed terms of their contracts vesting copyright in their works (created in the course of their employment) in their employer, and some evidence that terms requiring others such as contractors to sign them were common in the film world. I do not rely on any trade custom in reaching the decision that I have reached in the preceding paragraph. If there was such a custom, then Mr Ainsworth was not within the scope of people who operated under it. He had not hitherto worked in the film world, and cannot be taken (at least at that stage) to have agreed to have been bound by any of its customary terms (assuming there were some).
187. The conclusion that I have reached applies not only to the Stormtrooper helmet but to all other items created by Mr Ainsworth for Lucas. In the case of the X-wing helmet, there were no prior drawings from which he worked, and for all the items other than the armour the drawings from which he worked were not of the same detail as the McQuarrie drawings. However, he was still working to commission, producing things for which the client had provided clear specifications, and it was implicit in the relationship that he would not retain copyright.
188. There is one quirk in relation to the first batch of Stormtrooper helmets. Apart from that batch, there was a direct contractual relationship between Lucas and Mr Ainsworth into which the necessary implied term can be inserted. However, in relation to the first Stormtrooper helmets Mr Ainsworth was in a contractual relationship with Mr Pemberton and not with Lucas. Terms have to be implied into that relationship for Lucas's argument to get anywhere. In my view there is no difficulty in implying that term into the Pemberton/Ainsworth contract, and no difficulty in implying a similar term into the Lucas/Pemberton contract from which the other contract flowed. There is thus a chain which can be enforced by which the copyright can and should be vested in Lucas. If one analyses the facts, the same point arose in the *Griggs* case referred to below (in the context of enforcement of US copyright) – the author was a contractor of an advertising agency which was the contractor of the commissioning client. The existence of such a chain, as opposed to a single commissioner/contractor relationship, does not seem to have troubled the Court of Appeal or the judge at first instance. It

does not trouble me either. The problem (if there would otherwise have been one) does not arise in relation to later orders.

189. Mr Wilson sought to say that any implication should go no further than is necessary, and what was necessary in this case was no more than a licence from Mr Ainsworth to Lucas. That would enable Lucas to make as many more helmets as it needed for its films, and indeed to exploit the helmets otherwise as well, and that was sufficient to make the relationship work. It was not necessary for Lucas to have the copyright as well. I consider that Mr Wilson is right in applying the test of necessity, but wrong in his suggested result. Lucas was not commissioning something relatively everyday. Even if the licensing prospects could not have been foreseen, the whole appearance and “feel” of the film was central to its operation, and it cannot have been the intention of either party that there could be parallel exploitation of the props so that, for example, Mr Ainsworth could make more and sell them to other film-makers. The only thing that makes sense is an obligation to assign copyright. Mr Wilson also sought to say that no term other than a licence should be supplied because Mr Ainsworth was not paid enough to require him to surrender all rights. He was not specifically paid for his tooling or design. He was basically just paid for manufacture. I reject this argument too. He is right, by and large to say that he was not paid for the tooling. He charged for some wasted tooling for the armour, and he says he was paid specifically for some tooling for making a particular batch of Stormtrooper helmets, but the basic regime was not one in which he was specifically paid to produce moulds, or indeed even prototypes. However, Mr Ainsworth was paid a fee which the parties agreed was right for the job. Mr Ainsworth wanted the work, and in the end he made a lot out of his Star Wars activities – some £30,000. Lucas wanted props, and once they were approved and ordered Mr Ainsworth agreed to do what was necessary to provide them. Fees were agreed. The size of the fee does not assist the debate. It was not plainly of such a sum which must inevitably have meant that he retained some of the intellectual property rights.

Contractual claims relating to tools

190. In addition to claims relating to copyright, Lucas also claimed that there was an implied agreement that Mr Ainsworth held the moulds or tools that he made in order to produce the helmets and armour for Lucas, or alternatively that he was not entitled to use them otherwise than for making props for Lucas at Lucas’s request. These implied terms are said to flow from the same considerations as led to the conclusions expressed above in relation to the holding of copyright.
191. This time I consider that Lucas’s claim fails. It is important in relation to this claim to identify the arrangements between the parties, and in particular to identify the contracts into which the relevant implied terms are said to have been implied. In all relevant cases, Mr Ainsworth produced moulds as a result of being asked, or invited, to produce prototypes. He was not paid to produce the moulds; he did not engage to do anything at this stage. So when he produced the moulds there was no contract. The moulds were tools that he produced so that he could produce something which he hoped would be acceptable to Lucas and which would lead to an order. Lucas knew little about the precise methods used by Mr Ainsworth, and are unlikely to have cared much either. At this stage there was no contract into which the relevant terms could be implied.

192. In due course there was a contract, when the relevant parts were ordered but of course by this time the tools had been produced. If terms are to be implied, they must be implied into these contracts, and since by this time the tools existed, any implied term must relate to existing tools. The implication that the existing tools should pass to Lucas in my view fails to satisfy any of the relevant tests for implying terms. The officious bystander would not be suppressed, testily or otherwise, had he asked the relevant question, and business efficacy does not require the implication of the term. If it had existed, Lucas could have ordered a batch of helmets and then demanded the handing over of the tools so that they could make some more themselves. That would not have been a necessary part of the relationship between the parties, and would in my view have astonished the officious bystander.
193. The same applies to the suggestion that it was an implied term that Mr Ainsworth would not use the tools for any purpose other than the production of helmets for Lucas. Again, there was no term in the arrangements (such as they were) which applied when the tools were produced. The term must have arisen, if at all, when an order was placed. But why should it arise then? If Lucas had had the helmets made by someone else, there would have been no contract, and Mr Ainsworth would not be bound in relation to his use of the tooling. Why does he become bound when he is the chosen manufacturer? The basis of implied terms is necessity, and I can see no necessity for implying this term.
194. Mr Bloch made the point that it could not have been open to Mr Ainsworth to run off a second set of helmets for a rival film company. That, I suppose, is a test of necessity. But this same point demonstrates why it was not necessary to imply a term. The foundation of the relationship between the parties was the fact that Mr Ainsworth was working to designs provided by Lucas. They provided him with designs, and he was not free to reproduce those designs without Lucas's consent. But the reason for that is not any implied term in the contract of manufacture; it is because of the laws of copyright and conceivably (at the outset) confidence while the details of the project were not publicly known. Those laws protected what really needed protecting and what was entitled to protection – the reproduction of the designs, whether by means of the tooling that Mr Ainsworth made or not. It is unnecessary to imply any further term into the contract of manufacture, and inappropriate to do so.

Confidence Claims

195. Lucas next turned to the laws of confidence in order to prevent Mr Ainsworth from doing what he seeks to do. It was said that the material provided to Mr Ainsworth for the purposes of his making props, was provided to him for a limited purpose, namely so that he could make props for the film. It was not given to him to use as he saw fit, and any reasonable man would have appreciated that. The same man would have appreciated that his possession of the moulds, and his commission to manufacture props afforded him privileged and confidential access to the dimensions and detailed design, and that his access to that information was for a limited purpose only, namely the manufacture of props for Lucas. He is not entitled to use it for any other purpose. To do so would be a misuse of the information that he acquired arising out of his work, and would be a breach of confidence.

196. Lucas relied on various authorities, but before turning to them it will be useful to set out some of the limiting features that will apply to this way of putting the case. It is now well established (and not contested by Mr Wilson) that the provision of information which is of its nature confidential, in circumstances in which the confidence is not removed, imposes duties on the recipient to respect that confidence. It seems to me to be likely, and I am prepared to assume for these purposes, that when Mr Ainsworth was shown the various drawings that he was shown, and when he was told about the film and its characters, he was being provided with confidential information which he was entitled to use for strictly limited purposes only. I am also prepared to assume that his final creations (which all differed to some extent from the drawings he was shown) were also confidential at the time they were made. He was plainly not entitled to tout the Stormtrooper helmet around in the film world and announce that this was what Lucas was going to use in its forthcoming film. However, all that confidentiality disappeared when the material was put in the public domain, which it was when the film was publicised and then shown. If there is some form of residual confidentiality in the drawings themselves then that is not subverted by what Mr Ainsworth is doing now. So *prima facie*, and looking no further than that, Mr Ainsworth is no longer using any material which has retained its confidentiality.
197. However, Lucas invites a more sophisticated analysis. It relies on the provision of material to Mr Ainsworth and points to cases which restrict the use of material provided for a limited purpose even though the same information was ascertainable from publicly available material. In *Merryweather v Moore* [1892] 2 Ch 518 a clerk, who was about to leave his employer, compiled a table of useful data about this employer's engines. That material might have been obtained from elsewhere, by inspecting the machines themselves, given time and labour, but it did not exist in the convenient form of the clerk's table other than in that table itself. On motion, Kekewich J held that that was an "abuse of confidence". This is a case about what information is confidential. It is in line with cases which provide that a written compilation of information which is available elsewhere, but not in that particular form, is capable of being confidential. It does not seem to me to assist in the present case.
198. In *Saltman Engineering Co Ltd v Campbell Engineering Co Ltd* [1948] RPC 203 the plaintiffs provided the defendants with drawings of a leather punch so that the defendants could manufacture a number of them for the plaintiffs. The defendants used the drawings to make tooling so that they could make punches for their own purposes. It was held by the Court of Appeal that this activity misused confidential information in the drawings. Lord Greene MR held that the drawings amounted to confidential information notwithstanding the fact that the defendants (and indeed anyone else) could have produced equivalent drawings by taking the punch which was produced by the tooling and working back from those drawings. What made the drawings confidential:
- "is the fact that the maker of the document has used his brain and thus produced a result which can only be produced by somebody who goes through the same process."
199. So this again was a case in which information was confidential despite the fact that it could have been reconstructed from other material which was publicly available, because labour was necessary to create it in the first place. It was a misuse of that information to use it for a purpose different from that for which it was provided. The

circumstances in which it was imparted were those in respect of which confidentiality could arise. Of itself it assists Lucas only insofar as it demonstrates that confidence can (if the circumstances justify it) exist in information despite the material being available elsewhere. It does not assist them in saying that there is some sort of remaining confidentiality in the tools.

200. In *Ackroyds (London) Ltd v Islington Plastics Ltd* [1962] RPC 97 the plaintiffs supplied the defendants with a tool (the ownership of which remained with the plaintiffs) so that the latter could use it to make swizzle sticks for reward. The plaintiffs also provided information about colour and the nature and quality of the plastic used to make them. The defendants used that information to make their own tool and to manufacture and supply sticks themselves. Having set out the law relating to confidential information, Havers J said:

“The plaintiffs’ tool was entrusted to the defendants for the manufacture of swizzle sticks for the plaintiffs for reward and for no other purpose. In those circumstances, it seems to me that in equity there was an obligation on the defendants to use the tool solely for the purposes of the plaintiffs, and not to use it for the purposes of the defendants or for any other purpose. Similarly, all information directly or indirectly obtained by the defendants from the plaintiffs from the operation of the tool, or from the swizzle sticks themselves, or, in my view, obtained by the defendants in circumstances which made that information confidential.”

201. It was contended by the defendants that the relevant information had been made public because the swizzle sticks had been used and distributed. In relation to that Havers J said:

“No doubt a time may come when information is generally available for the public. But the mere publication of an article by manufacturing it and placing it upon the market, whether by means of work done in it or calculation or measurement which would enable information to be gained, is not necessarily sufficient to make such information available to the public. The question in each case is: Is such information available to the public? It is not, in my view, if work would have to be done upon it to make it available.”

202. Mr Bloch relies on this on the footing that materials provided to Mr Ainsworth embodied aspects of the design of the props in question, and gives the provision of the armour moulds as an example. Mr Ainsworth thereby had privileged access to the dimensions and detailed design, for a limited purpose only, like the defendants in *Ackroyds*. He is not entitled to use that privileged access by using the tools to produce replica props for his own purposes now.

203. The first step in any confidentiality case is always to identify the confidential information. The pleaded case starts by pleading that the various helmets and armour “embodied” or “contained” information of a confidential character, namely the precise dimensions and character of the items or, in some cases, the design and appearance of them. The precise dimensions and the detailed design is described as “the Confidential Information” or “the Additional Confidential Information”. The various moulds (or

tools) are also said to “embody” the confidential information. The information is said to have been “imparted” to Mr Ainsworth in the circumstances referred to above, in which Mr Ainsworth was provided with the sketches, armour material and information about the film that Mr Mollo provided him with. It is pleaded that any reasonable person in Mr Ainsworth’s shoes would have realised that the designs were confidential, that he was given access to them for the purpose of producing props for the film, that the designs would become valuable in their own right through the success of the film and that Lucas would expect to have the right to control all exploitation of the film, including merchandising and similar activities. Mr Ainsworth is pleaded as infringing these rights by using the confidential information by using the moulds to produce helmets and armour.

204. This analysis, so far as it seeks to bring the case within the principles appearing in the three cited cases, falls short of doing so. There are a number of reasons why this is the case.
205. First, it seeks to equate the moulds with the tooling or drawings provided by the claimants in those cases, and which contained the valuable information, with the moulds (or tools) used by Mr Ainsworth. There is a fundamental difference in the source of those items. In the cited cases the tooling, or drawings for tooling, came from the claimants. In the present case the tools were produced by Mr Ainsworth, and he did not produce them by relying solely on drawings. The drawings (and instructions from Lucas) provided guidance, but they did not precisely define the end product.
206. Second, and related to the first, Lucas did not “impart” the precise dimensions of the helmets and armour to Mr Ainsworth. The process of design and fabrication is set out above. General designs, and design ideas, were imparted to him, but the precise dimensions emerged from the finished products as a result of prototyping, trial, error and approval. For that reason, the moulds (tools) do not embody this sort of information “imparted” by the claimants.
207. Accordingly, this is not a case where precise manufacturing details were provided, under a cloak of confidence, to a manufacturer, and where those details can be treated as being confidential on the basis that, although they might be reproducible from information gathered from elsewhere, they nonetheless represent the fruits of labour which makes the results of the effort confidential. Lucas cannot put its case on that basis.
208. That does not mean that there was no confidential information provided. I accept that when information was given to Mr Ainsworth about the film, and about the characters in it, so that he could produce proposed designs and then actual props, he was being given confidential information which he could not use for any purpose other than that for which it was imparted. For example, having made a Stormtrooper helmet, he was probably not, for a time, at liberty to show it to whomsoever he pleased and tell them what Lucas was proposing and what the Stormtroopers would look like. However, that level of confidentiality passed away when the publicity for, or knowledge of, the film reached an appropriate level. It is unnecessary for me to decide when that was, but it was plainly reached when deliberate publicity to those features of the film was given, which was a very long time ago. Accordingly, reproducing those features of the characters of the film cannot, of itself, now be a misuse of confidential information.

209. Was there any further element of the information about the props that is capable of qualifying as confidential information? It can probably fairly be said that the exact dimensions of the props would not become generally known, because that level of detail was not published, and there was no evidence that actual props were made available to someone who could measure them and ascertain their precise dimensions. There may be circumstances in which someone who is directly engaged as Mr Ainsworth was generates information which can properly be characterised as confidential and whose confidentiality rests with the commissioner/employer. However, I do not think that, looking at the matter realistically, that confidential information existed in this case. While the designs might actually have been regarded as confidential, I do not accept that at the time the precise dimensions, of themselves, would have been viewed as confidential information at all, had the parties been asked. Lucas would have objected to copying, not on the basis that someone was infringing confidentiality, but on the basis of copying a protected design. The actual dimensions do not have the quality of confidentiality necessary to come within the laws of confidence.
210. That being the case, there is nothing left in the confidentiality point. Any confidential information has long since been made public. When that is stripped away, this becomes another way of putting the case that Mr Ainsworth should not be allowed to use the original tools for his own purposes. That in turn comes down to the suggested implied term which I have already dealt with and rejected above.

The claim on the US judgment

211. I have outlined above the circumstances in which Lucas obtained a judgment in the US. Lucas claims to sue on that judgment in this jurisdiction. There are two asserted defences to this claim:
- (a) That Mr Ainsworth did not submit to the jurisdiction of the US courts, and did not have a sufficient presence in the US, so as to enable Lucas to rely on the judgment in an English action.
 - (b) If he is liable to be sued on that judgment, the Lanham Act element (\$5m of the \$10m sued for) cannot be relied on because of the Protection of Trading Interests Act 1980 (“PTIA”).
212. There is no suggestion that Mr Ainsworth actually submitted to the jurisdiction in the US. He sought to challenge the jurisdiction there, but that by itself is not sufficient to amount to a submission because of the terms of section 33 of the Civil Judgments and Jurisdiction Act 1982. Mr Bloch did not contend otherwise. He relied on other acts as amounting to sufficient presence in the US as to make the judgment enforceable here.
213. At no time has Mr Ainsworth lived in the US, or traded there in the sense of having premises in the US from which trading was carried out. He certainly sought to trade, and actually traded, with people in the US, and it is primarily these acts which are relied on by Lucas as amounting to a sufficient presence in the US for the purposes of the English rules about the enforceability of foreign judgments. The acts relied on (most of which were not disputed as acts) can be summarised as follows:
- (i) He advertised his goods on his website, which was obviously available to US customers. Lucas said that it was particularly targeted or directed at US customers.

The only reason for supposing that that is the case is that the price of the helmets advertised there was expressed in US dollars immediately before it was expressed in pounds sterling, no other currency is referred to and shipping charges for the US and Canada are specified before shipping charges to the UK and the rest of the world. If it matters (and I doubt if it does) then it seems to me that the conclusion is not justified by the material relied on. Mr Ainsworth was doubtless acknowledging that the US would be a material market, but to say that this website was directed to it is to give the matter an emphasis that is not warranted.

(ii) He advertised in the United States. One advertisement of his appeared in three issues of a magazine called *Star Log* magazine, which is distributed primarily in the United States. E-mail advertisements were sent to existing customers there (as well as elsewhere in the world).

(iii) He sold a significant number of items to customers in the United States, and had them delivered there. They were, so far as I know, all or mainly internet sales; that is to say, they were effected by customers in the US sitting in front of their computers and going through the ordering routine on screen which is familiar in the modern world. The goods were despatched from the UK. There is a dispute as to the amount actually sold – at the hearing Mr Ainsworth admitted to £8,000; his pleadings admitted to approximately £25-30,000. That dispute does not matter – the sales were material though not great.

214. Lucas maintains that this activity is sufficient to give rise to the sort of connection with the US which is required before an English court will enforce a US judgment. Mr Ainsworth says it is not.

215. The principal authority on the point is *Adams v Cape Industries plc* [1990] Ch 43. That case concerned a judgment against a company, not an individual, but in order to consider that point the Court of Appeal considered the position in relation to an individual. The defendants in the present case, and in the US proceedings, were both Mr Ainsworth and his company, the second defendant. It is therefore necessary for me to consider both, and I can take *Adams* as the starting point.

216. The following points were clearly reflected in, or decided by, the court in that case:

(i) “Where a court of competent jurisdiction has adjudicated a certain sum to be due from one person to another, a legal obligation arises to pay that sum, on which an action for debt to enforce the judgment may be obtained.” (Parke B in *Williams v Jones* (1845) 13 M & W 633.

(ii) The point which arises for the English courts is its view of “competent jurisdiction” in this context. This is a question for the English court, deciding it on English rules of private international law.

(iii) So far as an individual is concerned, a foreign judgment against that individual will be enforced if:

- (a) He was voluntarily present in that country when the action began, or perhaps when the process was served (a distinction of no relevance to the present case).
- (b) Where he has selected a forum as plaintiff in which he is subsequently sued.
- (c) Where he has voluntarily appeared.
- (d) Where he has contracted to submit himself to the forum.

(iv) The basis of the territorial judgment of the foreign court over an individual, which gives rise to (a), is:

“[the defendant’s] obligation for the time being to abide by [the foreign country’s laws] and accept the jurisdiction of its courts while present in its territory. So long as he remains physically present in that country, he has the benefit of its laws, and must take the rough with the smooth, by accepting his amenability to the process of its courts. ... we would conclude that the voluntary presence of an individual in a foreign country, whether permanent or temporary and whether or not accompanied by residence, is sufficient to give the courts of that country territorial jurisdiction over him under rules of private international law.” (p 519 B-C)

(v) In the case of a corporation, it is necessary to apply the same concepts (residence or presence) but appropriately adjusted to reflect the fact that corporations cannot reside and can only do things via agents. The question is: “Was the corporation present in the relevant jurisdiction at the relevant time?” (p528D)

(vi) A corporation can be present if it has a fixed place of business, or if it conducts business through an agent with a fixed place of business. See the principles extracted at p 530C-F.

217. Neither residence nor any of those indicia of presence exist in the present case, but Mr Bloch says that nevertheless presence should be found. He points to the widespread nature of internet trading which enable transactions to take place between a person in one country and a person in another, with payment being easily made by electronic means, all of which can take place without the sort of physical presence which is referred to in *Cape*. He relied on the underlying concept of allegiance, and said presence was a factor which manifested an allegiance; there are other ways in which it can be said that a person or company owes temporary allegiance and therefore is properly treated as being the subject of a country’s courts and legal process. He also pointed to *Euromarket Designs Inc v Peters and Crate and Barrel Ltd* [2001] FSR 288.
218. In *Crate & Barrell* the question was whether a trade mark was used by an Irish shop “in the course of trade” in the UK when the use was one appearance in a magazine with a UK and Irish circulation, and on an Irish website. The advertisement referred to the Irish shop, and the website described the Irish business of its proprietor. Jacob J held that those activities did not amount to the mark’s use in trade in this jurisdiction. To that extent the case does not help Mr Bloch. However, Mr Bloch drew comfort from the fact that Jacob J indicated that the Irish company might have been using the mark for the purpose of trade in the UK if it had been apparently intended to drum up business in the UK.

“Thus if a trader from state X is trying to sell goods or services *into* state Y, most people would regard that as having a sufficient link with state Y to be ‘in the course of trade’ there.” (Paragraph 19; Jacob J’s emphasis)

He also relied on what Jacob J said about websites in paragraph 21:

“[Amazon.com, which is] based in the US ... has actively gone out to seek world-wide trade, not just by use of the name on the Internet but by

advertising its business here, and offering and operating a real service of supply of books to this country.”

Mr Bloch suggests that that means that a person could be taken to be using a mark in the course of business carried on in another country by targeting sales in that other country via a website. That is what Mr Ainsworth is said to have done. At the end of the day, Mr Bloch accepted that he was arguing for a far-reaching finding or conclusion in relation to this aspect of the case, but said that developments in modern trading methods justified it.

219. Mr Bloch’s submission would indeed require a radical departure from the decision in *Cape*. That case is based on territoriality, and is firmly rooted in the notion of some form of physical presence there. The debate was what minimum form that presence had to take. Some forms of physical presence would not suffice – the presence of an agent without any power to contract business might well not be enough. But the key is that there has to be some. The required presence is a reason for saying that the individual or company had done enough to render himself or itself amenable to the local courts, or to owe some form of allegiance necessary to make it right that he be treated as so amenable. “Allegiance” is not itself some form of touchstone which can be ported into modern trading conditions. The acts of Mr Ainsworth, as described above, plainly do not amount to any form of presence, or anything analogous to presence.
220. One could ask the question: Suppose that Mr Ainsworth confined himself to advertising in US magazines, and thereafter accepted offers made in writing, and then supplied into the US as a result – would that give him the relevant degree of presence? The answer from *Cape* is plainly: No. There is no physical presence, and it is apparent that where contracts are reached as a result of correspondence then there is no equivalent notion. That appears from the court’s reliance on *Vogel v R & A Hohnstamm Ltd* [1973] QB 133, referred to in *Cape* at page 521G. In that case there were contracts by correspondence, and no relevant presence. There were no advertisements, but that does not seem to me to make any relevant difference, particularly since there was something potentially stronger than advertisements, namely a man with an office in Tel Aviv, and even that was not enough. That means that the single advert (or 3 adverts) placed by Mr Ainsworth are not enough, and it provides strong guidance as to the effect of the internet. Various analogies can be deployed in relation to the internet (not tentacles, but perhaps telescopes – see *Barrel & Crate* at para 21), but for present purposes it can be likened to an advert, and then a form of contract by correspondence. It certainly does not introduce any degree of presence.
221. There is therefore no natural application of *Cape* which would assist Mr Bloch. Nor is he assisted by *Crate & Barrell*. That involved a different question – what was use in the course of trade in a given jurisdiction for the purposes of trade mark legislation. If one asked the question whether Mr Ainsworth was trading in the US one might come up with a different answer (I do not say one necessarily would – it all depends on why one is asking), but that is because one is asking a different question for different purposes.
222. A proper application of *Cape* as it stands therefore means that neither Mr Ainsworth nor his company was sufficiently present in the United States at the date of the commencement (or service) of the US proceedings (or at any time) to allow the US

judgment to be enforced here. But it remains to be considered whether it is now necessary or appropriate to extend *Cape* to apply to cases such as the present, of which there must be many in the light of the explosion of internet trading in the years since *Cape*. That is really what Mr Bloch was urging on me. It is an invitation which I have no difficulty in resisting. The first reason is that *Cape* is clear authority for requiring a relevant degree of literal and physical presence, and it is binding on me. If there is to be a change from that state of the law then it cannot be achieved by this court. Second, modern methods of internet trading do not seem to me inevitably to require a change in the law in this area anyway. The *Cape* principles were established at a time when trade between countries could take place by telephone, letter and telex. It was not sufficient to establish the enforceability of a foreign judgment that there be trading into that foreign country by those means, no matter how extensive the trading. Internet trading is not materially different for these purposes. It just makes the establishing of contracts easier – advertising is easier, placing an order is easier and quicker, and payment is more easily (and usually more quickly) achieved. It does not make the seller more present in the buyer’s country. If Mr Ainsworth were present in the US by means of his internet trading, why is he not present in every country into which he sells goods by means of an internet deal? That would be a very far-reaching conclusion, and one which would not be justified by any underlying principle, or at least not by any principle underpinning *Cape*.

223. Accordingly the conditions required by *Cape* are not fulfilled and the US judgment is not enforceable against Mr Ainsworth.
224. That conclusion makes it unnecessary for me to consider the PTIA point, but yet again I will express my views on the point since I heard full argument on it. It arises because that Act bars (inter alia) the recovery by action of a foreign judgment where the damages in question arise by virtue of a multiplication. The question that arises is whether that bar applies to the whole of that element of the damages (the basic compensatory element plus the further sum added as a result of the multiplication), or whether it only bars the element arising out of the multiplication. The relevant part of the formal US judgment was in the following terms:

- “1. On the First Claim for Relief for copyright infringement, actual damages and profits in the amount of \$5,000,000.
2. On the Second, Third and Fourth Claims for unfair competition under the Lanham Act, trademark infringement and unfair competition under State law, \$5,000,000 in compensatory damages.
3. On the Second and Third Claims for unfair competition and trademark infringement under the Lanham Act, an additional \$10,000,000 to treble the compensatory damages awarded on those claims.”

Reading the issue into the US judgment in the present case, it is this: Does the multiplication in paragraph 3 mean that not only is the paragraph 3 sum irrecoverable, but also the paragraph 2 sum? There is no dispute under this head about the copyright sum in paragraph 1. Mr Wilson did not dispute the severability of the copyright damages for these purposes, but claimed that the bar on recovery of multiple damages contained in the PTIA meant that not only the trebling element of the judgment (the \$10m in paragraph 3) was barred, but also the amount expressed as being compensatory was barred too.

225. Section 5 of the PTIA contains limits on recovery in this jurisdiction of “multiple damages”, that is to say damages obtained by multiplying another sum. It provides:

“5 Restriction on enforcement of certain overseas judgments

(1) A judgment to which this section applies shall not be registered under Part II of the Administration of Justice Act 1920 or Part I of the Foreign Judgments (Reciprocal Enforcement) Act 1933 and no court in the United Kingdom shall entertain proceedings at common law for the recovery of any sum payable under such a judgment.

(2) This section applies to any judgment given by a court of an overseas country, being:

(a) a judgment for multiple damages within the meaning of subsection (3) below;

...

(3) In subsection (2)(a) above a judgment for multiple damages means a judgment for an amount arrived at by doubling, trebling or otherwise multiplying a sum assessed as compensation for the loss or damage sustained by the person in whose favour the judgment is given.”

226. Multiple damages were considered in *Lewis v Eliades (No 3)* [2004] 1 WLR 692, but the point now taken was not clearly decided in it. That case was a judgment registration case, not an action on a judgment case, but that is an immaterial distinction for present purposes. It concerned the extent to which it was permissible to separate out parts of a foreign judgment which were severable and not subject to multiplication from those that were. It was held that it was permissible. There was no attempt by the claimant to claim any part of the US judgment which was subject to or the result of multiplication. The point that arises in this case was expressly left open in that case, at least by Jacob LJ – see paragraph 62 of his judgment. However, it seems that Potter LJ might have been minded to decide the point against the claimant. At paragraph 41 he said:

“... I accept, and indeed it is not in issue between the parties, that the 1980 Act makes clear its hostility to awards of damages by barring enforcement in the United Kingdom of any part of such award including the basic compensatory award to which a multiple element has been applied and superadded. The wording of the definition in section 5(3) makes that clear.”

227. The relevant award with which the court was concerned in that case was one in which there was no separation out of the compensatory element (our paragraph 2) and the additional sum arising from the multiplication (paragraph 3), but Potter LJ’s remarks might be thought of being as capable of being applied to both situations. Carnwarth LJ agreed with both judgments.

228. Since it is plain that the point with which I am now concerned was not actually decided in that case, there is nothing in it by which I am bound. It is therefore open to me to reach my own conclusion on it. However, the case nonetheless provides significant

guidance. Both Potter LJ and Jacob LJ adopted a purposive approach. They determined that form did not govern the matter – the fact that the overall judgment was a wrapped up sum which included entirely compensatory elements (not subject to multiplication) did not mean that one had to take the whole sum as falling within that expression and bar enforcement. As Potter LJ said:

“In my view it is both desirable and appropriate that enforcement of [the untainted compensatory elements] should be open to the claimant unless plainly precluded by the terms of the 1980 Act, and the approach to the construction of the Act should be based upon that premise.” (paragraph 51)

229. In that case the disregard for pure form meant that the wrapping up of the sums did not prevent separating out. In the present case it means that I am not automatically bound to decide the case the other way (in favour of the claimant) because the compensatory and penal elements of the Lanham Act damages are in fact separated out in the US judgment. However, equally importantly, the Court considered that there was no reason in policy why the untainted compensatory elements should be rendered irrecoverable, and good reasons in policy why they should be recoverable.
230. I would respectfully agree with that, and would go further. I think that the same purposive reasoning leads to the conclusion that the genuinely compensatory elements of an award subject to multiplication should be equally recoverable. I struggle to find a reason why they should not be. Imagine a case where the damages are subject to trebling but the claimant chooses not to avail himself of that option. There is no way in which the judgment in that case would fall within section 5. Then take a case like the present, where the claimant chooses to claim the benefits of multiplication. Why should that fact now deprive him of enforcing the genuinely compensatory element? The only reason for doing so would be to express disapproval, to the extent of removing what was otherwise a plain entitlement. That would in my view smack of a penalty, and would require clearer words than appear in the statute to justify its imposition. I do not think that the wording is sufficiently clear. The purpose of the Act is plainly to prevent something in the nature of a penalty (the multiple damages); it is not at all plain that that should be at the expense of imposing another one. I hold that it does not do so. This is plainly in line with paragraph 61 of Jacob LJ’s judgment:

“purely compensatory awards can be enforced, multiplied awards not. ... It is true that it involves reading in the words “to the extent” but ... one must read something in and the only sensible choice is [that the words refer only to the extent to which the overall sum includes a multiplied amount]”.

I think, with respect, that one cannot quite read precisely those words into the Act anywhere and achieve the result he reaches; one is really reading in the concept. But if one does that then one arrives, without difficulty, at the result that I favour. If it be said that that is contrary to the words from paragraph 41 of Potter LJ’s judgment set out above, then I would say that I am not convinced that Potter LJ really intended to rule against the arguments set out above, and they are plainly not a finding in any event – they were not necessary for his decision.

231. In this context the split of the actual judgment contained in paragraphs 2 and 3 acquires significance. It makes it plain that the relevant head of damages does have a

compensatory element and identifies it. There is a real sense in which this part of the judgment contains two separate and severable elements – the compensatory and the punitive, or exaggerated (or whatever adjective one chooses to apply to the multiplied damages). The paragraph 2 damages are not barred by the Act; only the paragraph 3 damages are.

The US copyright claims — general

232. As if were not bad enough having to decide some difficult points of UK copyright law, Lucas also invokes US copyright law claims in this court in respect of infringement in the US in respect of US copyrights. It is said to be accepted by Lucas that it cannot obtain double recovery by getting a judgment on the US copyright judgment and then suing again here. Since I have held that it cannot enforce that judgment then the claim for direct enforcement of the US copyright infringement is propounded.
233. At the outset of the trial the issues raised in relation to the US copyright claim were potentially very wide ranging. There were extensive reports from 2 US attorneys, and volumes of authorities supporting them. It was a bit like being presented with a US copyright book and being told that that was the law, without much of a clue as to what the real issues were. The pleadings revealed that many things were not admitted by the defendants and were apparently going to have to be gone into. The proposed debate seemed very unfocused. Fortunately the issues reduced considerably by the end of the trial. There were factual issues which were essentially the same as those that I have had to decide for the purposes of the English claim – what drawings existed, who copied them, and so on. Then any issue there might have been as to entitlement went away – no-one suggested that there was any difference between the English and US copyright positions. Other than the inevitable factual differences, the only live legal issue seemed to be whether actual items were to be regarded as “functional” or “utilitarian” within the American legal provisions. If and to the extent that they were then copyright or infringement could not be claimed. There was also an issue as to whether the functionality/utilitarian test was one going to subsistence of copyright or to infringement. That becomes relevant for the purposes appearing below.
234. Before the merits of that claim are reached, there is a prior question as to whether such claims are justiciable at all in these courts. Mr Wilson submits they are not – they are territorial claims which are only justiciable in the courts of the country in question (ie the US). It is therefore necessary to deal with that prior claim first.

US copyrights – justiciability

235. The questions as to whether either or both of subsistence and infringement of foreign copyright are justiciable in this jurisdiction have been referred to in various authorities, and have been the subject of various observations, but have not plainly been the subject of a binding decision. The story starts with the *Moçambique* rule from *British South Africa Co v Companhia De Moçambique* [1893] AC 602. In that case the House of Lords held that the English courts had no jurisdiction to entertain an action to recover damages for trespass to land situated abroad. Lord Hershell LC accepted a distinction between matters which are “transitory or personal” in their nature and matters which are “local” in their nature and held that the English courts would not exercise jurisdiction in relation to the latter where the matters occurred outside the territorial

limits of the English courts. A trespass to foreign land was local for these purposes and was not justiciable in these courts.

236. The House of Lords was invited to depart from this principle in *Hesperides Hotels Limited v Muftizade* [1979] AC 508, to the extent of drawing a distinction between cases where title was in issue (submitted to be non-justiciable) and cases where it was not (submitted to be justiciable) and to the extent of allowing an action for conspiracy to trespass. It declined to accede to this invitation. The first distinction was said by Lord Wilberforce to be not justified by the *Moçambique* decision itself. While he said that there might be something to be said for this distinction, and while he acknowledged an academic hostility to the rule, he observed that it was a widely imposed rule in common law jurisdictions (page 536F), that the prospect of conflict with foreign jurisdictions meant that legislation, rather than judicial decision, was the appropriate mechanism for any change (page 537A) and that any change in the rule might or would require consequential changes in other areas of the law (page 537E-F). Lord Fraser did not find the theoretical justifications for the rule particularly persuasive, and found the distinction between title and non-title cases attractive, but again held that a departure from the long-established rule, and the possible repercussions, required legislation, not judicial decision making (page 544D-H).
237. In fact, there is a legislative end to that part of the story because the Civil Jurisdiction and Judgments Act 1982 s.30 removed from the rule actions for trespass to, or torts affecting, land outside the jurisdiction save where the proceedings concerned, or principally concerned, questions as to title to the property. Although that statute was confined to questions relating to land, it is at least potentially a pointer to the sort of dividing lines that might be drawn between the sort of questions with which the rule purports to deal.
238. The principles underlying the *Moçambique* case were extended to patent cases in *Potter v Broken Hill Pty Co Ltd* [1906] 3CLR 479. A patent was granted in and by the state of New South Wales, and an action was brought in the state of Victoria against a Victoria company claiming infringement of that patent in New South Wales. The defendant claimed that the patent was invalid on various grounds. The High Court of Australia held that it was not competent for the courts of one state to examine the question of the validity of a patent granted by another. The grant of a patent was a sovereign act, and must be regarded as an act of the state itself. The court referred to the *Moçambique* case, and acknowledged the principles applied there, and at page 499 Griffiths CJ held:
- “...the same rule must be applied to foreign patents that is applied to foreign lands. The reasons upon which the rule in the one case are founded are, I think, equally applicable to the other.”
239. While some judges in that case expressed similar views in relation to all issues that might arise in relation to the patent (whether or not they involved questions as to validity) and the expressions used by other judges seemed to confine themselves to validity questions only, the general thrust of the case was to hold that all aspects of an action relating to a foreign patent had to be brought in the state which granted the patent. The only exception which some members of the court were minded to treat differently was one where the question of validity arose merely incidentally in the

course of an action otherwise within the jurisdiction of the court – there is an obvious resonance there with the 1982 Act.

240. The grant of a patent involves a positive act by an organ of the State. A copyright can arise without that, at least in this jurisdiction and in the United States. It might be thought to be distinguishable for that reason. However, that distinction was not relied on in a copyright case, *Tyburn Productions Ltd v Conan Doyle* [1991] Ch 75. In that case the claimant applied for a declaration that the defendant would not be entitled to assert that the use of certain characters in a film in the United State would be (inter alia) a breach of U.S. copyright. The defendant applied to strike out the claim. Vinelott J considered the relevant question to be whether the distinction between transitory and local actions applied to intellectual property rights, or whether it was merely a “historical prologue” which founded a narrower rule about actions for trespass to land. He referred to *Moçambique* and its application to infringement and validity of patents as demonstrated by *Potter*. At page 84D he records a concession by counsel for the plaintiff that there was no material distinction between the various intellectual property rights, and plainly proceeded on the footing of that concession thereafter. He indicated his reluctance to depart from the Australian decision (and another one in the same vein) and found that the authority of *Def Lepp Music v Stuart-Brown* [1986] RPC 273:

“...is authority for the proposition that a claim that acts done outside the United Kingdom constitute an infringement of the copyright law of a foreign country is not justiciable in English courts.” (page 87B)

And at page 88D he seems to have come close to that conclusion himself:

“In my judgment therefore the question whether the defendant is entitled to copyright under the law of the United States of America or of any of the states of the United States of America is not justiciable in the English court.”

241. This case, and *Coin Controls Ltd v Suzo International (UK) Ltd* [1999] Ch 33 mark the high point of judicial utterances as far as Mr Wilson’s submissions are concerned. He says that *Tyburn* demonstrates what the rule is and should be – all questions of breach of U.S. copyright must be dealt with in the U.S. court. That, he said, is what Vinelott J in essence held. He maintained there were good reasons for this. It would not leave a gap in most cases, because copyright exists everywhere and can be sued on in each country. In the present case the claimants could get the relief they sought by suing here on English copyright. Any gaps should be filled by legislation – as had occurred in relation to the *Moçambique* rule. Any attempt to distinguish subsistence on the one hand and infringement on the other introduced a very unsatisfactory distinction with no principle underlying it.
242. As will appear shortly, the Court of Appeal expressed a clear view as to what it was that Vinelott J should be taken as having decided, or not decided, in *Tyburn* but the next case chronologically is the *Coin Controls* case.
243. That case was decided before the Court of Appeal in the *Ove Arup* case below, but after the first instance decision in that case. The claimant in the *Coin Controls* case brought an action in this country on three identical European patents – UK, German and

Spanish. The actual infringement of the foreign patents was said to have taken place in the countries of those patents. An application was made for interlocutory relief and the defendants took the point that an action could not be brought in this jurisdiction in respect of an infringement of a foreign patent in the jurisdiction of that patent. Laddie J held that there was an extant rule of English law which prevented English courts from accepting jurisdiction over suits relating to foreign intellectual property rights. He said that it arose out of the *Moçambique* case, and said that:

“The principles which applied to land in the *Moçambique* case apply equally well to attempts to litigate foreign intellectual property rights in English courts. Those rights give rise to monopolies or quasi monopolies which are strictly territorial in nature.”

244. He went on to cite the decision of Aldous J in *Plastus Kreativ AB v Minnesota Mining and Manufacturing Co* [1995] RPC 438 at 447 in which Aldous J said the same sort of thing and declined to draw a distinction between validity and infringement:

“Also a conclusion that a patent is infringed or not infringed involves in this country a decision on validity as in this country no man can infringe an invalid patent. In the present case the plaintiffs admit the validity of the patent and therefore there is no dispute upon the matter. However, it will be implicit in the judgment of this court that there has been infringement and that, between the parties, the patent is valid. Thus, I believe it is at least convenient that infringement, like validity, is decided in the state in which it arises.”

245. The *Moçambique* rule was said by Laddie J to have:

“Nothing to do with actionability. It is a principle of public policy based on the undesirability of our courts adjudicating on issues which are essentially foreign and local.” [page 43H]

Having rejected an argument that intellectual property rights fall within the concept of “immovable” in s.30 of the 1982 Act, he held that, subject to the Brussels Convention, the proceedings in respect of infringements of foreign patents ought to be struck out.

246. That case, of course, involved patents and not copyright, but it is quite clear that Laddie J drew no distinction between those two rights.

247. Shortly afterwards the Court of Appeal heard the case of *Pearce v Ove Arup Partnership Limited* [2000] Ch403. This case concerned copyright. *Coin Control* was apparently cited but not referred to in the judgment. So far as relevant, the case involved a claim brought in this country for breach of Dutch copyright committed in Holland. The defendant sought to strike out the claim on the footing that a breach of Dutch copyright was not justiciable in the English courts (and on other grounds which are not material). At first instance Lloyd J accepted that the Brussels Convention gave jurisdiction, but he struck the claim out on the merits. The Court of Appeal overruled him on that second point. It decided the first point the same way. In the course of delivering the judgment of the court, Roche LJ considered the justiciability question. He considered the *Moçambique* decision at length, and referred to the *Hesperedis Hotel*

decision. Then at page 47 he turned to *Tyburn Productions v Conan Doyle* and acknowledged that it was a case which provided:

“Direct support for the proposition that a claim for breach, outside England, of a foreign intellectual property right cannot be entertained by an English court....”

248. He accepted that the test in *Moçambique* was one of justiciability and that the English courts should not determine matters which were “local” to a foreign court:

“The English courts should not claim jurisdiction to adjudicate upon matters which, under generally accepted principles of private international law, were within the particular province and competence of another state.”
[page 431F)

249. At page 433 Roche LJ embarked on a consideration of the extension of the *Moçambique* rule to intellectual property disputes. He considered the *Potter* case in depth and page 435H referred to “the principle that courts of another contracting state should not make enquiries into the validity of a patent – or into the registration or validity of similar intellectual property rights” which he said was recognised and preserved by article 16(4) of the Brussels Convention. He noted that the local court had exclusive jurisdiction where proceedings were concerned with the registration of or validity of patents, trade marks, designs or other similar rights required to be deposited or registered, but:

“Where the action is not concerned with the registration or validity, the Convention gives jurisdiction to the courts of the defendant’s domicile....”
[my emphasis]

On the footing of that, he held that there was nothing in *Potter* which required an English court to refuse jurisdiction in those cases in the light of what the Convention said.

250. He then turned to the English cases, *Def Lepp* and *Tyburn*. He got no material assistance from *Def Lepp* and at page 439F said:

“We do not find it necessary to decide whether Vinelott J was correct to take the view (if he did) that an action for alleged infringement of a foreign copyright by acts done outside the United Kingdom in a state not a party to the Brussels Convention, in a case where no question as to the validity or registration of the right was in issue, was not justiciable in an English court.”

The Court of Appeal could:

“derive little or no assistance from the decision in the *Tyburn Productions* case....on the question whether an action for alleged infringement of a foreign copyright by acts done outside the United Kingdom in a case where the existence and validity of the of the right is not in issue is justiciable in

an English court; and no assistance from that case where the question arises in the context of acts done in a contracting state.” [page 440B my emphasis]

251. The court then went on to consider various other European-related points and the effect of the old requirement of double-actionability (the rule in *Phillips v Eyre*) and at page 445 concluded that the *Moçambique* rule did not require the English court to refuse to entertain a claim in respect of the alleged infringement of Dutch copyright.
252. As I have said, the Court of Appeal in this case did not have to consider the very question which arises in the present case, because whatever the position might be so far as the English enforcement of US copyright is concerned, the Brussels Convention operated in that case. However, it can certainly be said that the case, in its tenor and expression, does not provide a lot of support for deriving from *Tyburn* the principle that Mr Wilson invites me to extract, namely that such an infringement claim is simply not justiciable here at all.
253. The point next surfaced in *R Griggs Group Limited v Evans* [2004] EWHC 108 (Ch), a decision of Mr Peter Prescott QC sitting as a deputy judge of the High Court. The case concerned the question whether or not an English court could make orders to assign foreign copyrights where an agreement to assign them had not been complied with and where there had been an assignment to a third party with notice. The point troubled Mr Prescott because he took the view that there was a question as to whether or not an order that the foreign copyright be assigned would be regarded as a breach of comity according to English case law. He was also concerned that the order might be viewed elsewhere as an enforcement of a right in rem even though the right which was sought to be enforced was the right to have an English court of equity act in personam against a defendant (see paragraph 61). At paragraph 62 he embarked on a short consideration of the *Moçambique* case and at paragraph 72 set out what he considered to be the rationale of the *Moçambique* rule:
- “In my judgment, the only rationale which survives today (apart from the court’s possible incapacity to execute its order abroad, which is not applicable in our case) is that it would be a breach of international comity to try questions of title to foreign rights in rem, save incidentally: see, for example, the judgment of the Court of Appeal of *Pearce v Ove Arup Partnership Limited*.... But we still have to consider precisely why it would be considered a breach of comity.”
254. He then goes on, at some length, to consider that and other points. He came to the conclusion that where the subject matter of the action is land (an immovable) and not copyright, even then there is no reason in principle why the English court would not enforce the obligation. So that dealt with the relevant point. He therefore did not need to go on to consider the next step in the argument advanced by the defendant, namely the very point which arises in the present case “viz that the *Moçambique* decision has been extended from land to intellectual property”. However, he was prepared to assume he was wrong and went on to consider that very point.
255. At paragraph 121, having previously just referred to *Tyburn Productions v Conan Doyle*, he observed that on one view the dispute in that case called into question the

existence of intellectual property rights said to have been granted by a foreign sovereign. He declined to adopt that view:

“I doubt that the sovereign could be assumed to be asserting a prerogative right to have claims of that sort decided exclusively in its own court.”

Nevertheless he considered that the claim was a “pure matter in rem”. I am not sure that I agree with that; whether or not that is right will probably depend how technical one is going to be about that concept. However, I do not think that that matters for present purposes.

256. At paragraph 133 he observed that in one sense it has always been possible to call into question both the validity and the scope of a foreign intellectual property right in this jurisdiction, for example where a defendant has agreed to pay royalties to the claimant on a product covered by a valid claim of a foreign patent and the agreement is governed by English law and confers jurisdiction upon the English court. In that case, in truth, the English court is:

“not purporting to tell the American public say that one of their patents is invalid or that the scope of its claims is not what it might appear to be. They are merely settling the rights of two private litigants who have chosen to submit their dispute to the adjudication of our courts. Once again, rights in personam, not rights in rem.”

He then went on to dissect various principles out of Vinelott J’s decision and to make observations on them. So far as Vinelott J’s reliance on *Potter* is concerned, he observes that in the *Potter* case the defendant:

“...was contending that the authorities of [New South Wales] had been wrong to grant the patent, or had been wrong to grant it in that form. This could not be allowed. But that, of itself, in no way establishes that an action for infringement could not have been entertained if the validity of the patent had not been in question. See the analysis of the case by the Court of Appeal in the *Ove Arup* case.....”

He also commented on the concession by counsel in *Tyburn Productions v Conan Doyle* to the effect that the *Moçambique* rule applies to copyrights so far as it applies to patents. On that, Mr Prescott observed:

“It does not follow. Unlike patents, copyrights are not registered. Compare Art. 16(4) of the Brussels and Lugano conventions. Hence the Court of Appeal in the *Ove Arup* case held that an action lay in England for infringement of Dutch copyright.”

257. So far as it was urged on him that he should follow the High Court of Australia in *Potter*, he said that he had already pointed out that times had changed and that now, to some extent, actions were entertained for infringement of foreign copyright. In the light of all that, he did not consider that there was a rule of English law which prevented him from granting the relief that was sought in that case.

258. Yet again, the very point that I have to decide did not arise for decision. However, yet again, an English court has strongly indicated that there is and should be no absolute bar on an English court enforcing a foreign copyright in respect of infringements which took place abroad. The case also supports the drawing of a distinction between actions which go to the validity of the foreign right as opposed to actions which assume its validity and are merely for appropriate relief – the sort of distinction drawn by s.30 of the 1992 Act. Mr Prescott, like me, drew attention to the words from *Ove Arup* that appear emphasised above.
259. One further English court has come to a decision which supports that distinction. In *Satyam Computer Services Ltd v Upaid Systems Ltd* [2008] EWHC 31 Flaux J had to consider various jurisdictional issues arising out of a series of agreements. One of the parties had certain foreign intellectual property claims against the other. Had he decided that an English choice of jurisdiction clause had applied, he would have had to decide whether certain claims were nonetheless non-justiciable here because they were claims in relation to foreign intellectual property. The claims seem to have been declarations as to the validity of certain US patents, and other claims in respect of which the damages reflected, in part, some sort of damage to the patent. In the event Flaux J held that the jurisdiction clause did not require the proceedings to be brought in this jurisdiction, so the question of justiciability of foreign intellectual rights here did not arise. However, he did in any event go on to consider the question of justiciability.
260. Flaux J acknowledged that his task involved considering the *Mocambique* rule as it applied to land, and then considering whether the common law rule was equally applicable to claims affecting foreign intellectual property. He seemed to consider intellectual property generally, without distinguishing between the various types. Having considered the rule, its consideration in *Hesperides* and its modification by statute, he said:

“94. As to the application of the common law rule to claims in respect of foreign intellectual property, I have considerable doubts whether the rule in its wider form developed in the *Hesperides Hotels* case ever applied to intellectual property and I agree with Mr Boswood that a now abrogated rule at common law is a somewhat shaky basis for such a wide proposition of law as that advanced by Upaid”

The wide proposition advanced by Upaid was the proposition that English law does not have subject matter jurisdiction over foreign intellectual property rights.

261. Having considered *Potter*, Flaux J did not consider that it supported any wider principle than that:

“the English courts should not make inquiry into the validity of a foreign patent or similar foreign intellectual property rights”. (para 95)

262. In relation to *Ove Arup* and *Tyburn Productions* he said:

“Although the Court of Appeal fell short of saying *Tyburn Productions* was wrongly decided, they clearly thought its application should be limited to cases where the existence or validity of the foreign patent was in issue. They did not consider it to be authority for the proposition that a claim for

infringement of a foreign patent was not justiciable in England if the validity of the patent was not in issue.”

In fact the Court of Appeal in *Ove Arup* was not considering a patent at all; it was considering copyright, but with that amendment it is clear what Flaux J was saying.

263. Having then considered *Coin Controls*, he considered that *Ove Arup* cast doubt on the broad propositions as to non-justiciability that might be deducible from it. *Griggs* was a case which he considered cast doubt on the applicability of the rule to intellectual property at all, a view which he considered was shared by the editors of *Dicey & Morris* (see para 100).

264. His conclusions came in paragraphs 101 and 102:

“101. I would be reluctant to go [as far as saying that the rule did not apply at all to foreign intellectual property rights], not least because the Court of Appeal did not do so in *Ove Arup* despite the opportunity to do so. However, in my judgment, the *Mocambique* rule as it applies to foreign intellectual property rights should be limited to those cases where the existence or validity of such rights are in issue and it is only in such cases that a claim for infringement of the rights should be justiciable in England if English jurisdiction can otherwise be established. I believe that is the clear thrust (even if not spelt out directly) of the passage in the decision of the Court of Appeal in *Ove Arup* which I quoted above.

102. It is only where the English court is being asked to adjudicate on the existence or validity of the foreign patent that, as I see it, the rationale of the *Mocambique* rule comes into play, namely the public policy that it is undesirable that English courts should adjudicate on issues which are essentially foreign and local ... Where all that is in issue is the infringement of the relevant intellectual property right and the damage suffered by the claimant as a consequence, why should the English courts not assume jurisdiction which they otherwise have in respect of the relevant foreign tort? Why impose some self-denying ordinance merely because foreign intellectual property rights are involved? There is no sense in doing so, *a fortiori*, where there is no longer any such restriction in relation to torts involving foreign land where no issue of title arises.”

265. The following points seem to me to emerge from all that:

- (i) The discussion reveals a tendency to move away from a strict and absolute application of the *Mocambique* rule to all intellectual property cases, and in particular copyright cases.
- (ii) The statutory modification of the *Mocambique* rule itself, and the principles of the Brussels and Lugano conventions that between them draw a distinction between title (for land) and validity and registration aspects (for registrable intellectual property rights) on the one hand and trespass/infringement on the other, justify the conclusion that at least infringement of foreign copyright should be justiciable here, whether or not subsistence is also justiciable.
- (iii) There is nothing in the cases which binds me to a contrary conclusion.

(iv) The rule (if any) which underpins the extent to which an English court should not embark on a consideration of aspects of intellectual property rights is a public policy rule, not an actionability rule – see *Coin Controls*.

266. I am therefore prepared to conclude that an English court can, and in an appropriate case should, determine at least questions of infringement of foreign copyright cases. Those cases will include cases where subsistence is not in issue. I would not, however, hold that questions of subsistence can never be decided here. In land cases incidental questions of title can apparently now be considered. I can see no reason why the same should not apply to copyright.
267. In fact there is a strong case for going further, at least in relation to copyright. It is not plain to me, as it was not plain to Mr Prescott in *Griggs*, why copyright should necessarily be treated in the same way as patents and trademarks. The Brussels and Lugano Conventions separate out validity/registration questions from other questions in respect of patents, trade marks, designs “or other similar rights required to be deposited or registered”. That does not apply to copyright, which does not require those formalities. Thus under the Conventions it is not plain that all intellectual property rights are treated the same. One can see why that is. It is entirely logical that the Conventions, and the English courts in terms of non-Convention countries, should treat the courts of the registration jurisdiction as having sole jurisdiction over validity in such cases, whether under the Conventions or under the reasoning in *Potter*. The creation of the rights is effected by the registration process, and to that extent is an act of the state in question. It is entirely appropriate that that state should have sole jurisdiction in respect of its own acts. In addition, an English court would have no jurisdiction to revoke, or otherwise affect, a foreign registration, and the concept of an English court determining that a foreign patent was invalid but having no power to revoke it is a very strange one with its own internal inconsistencies. That is the sort of concept that underlay the reasoning of at least some of the judges in *Potter*.
268. The same sort of considerations do not arise in relation to copyright so far as it does not require registration. Copyright (at least US and English copyright) is not created by such acts. It arises by virtue of local legislation, but then so do a lot of other rights which, in an appropriate case, the English courts are prepared to enforce on receipt of proof of the relevant foreign law. It is true that unlike many other local rights, it gives rights in the nature of property rights, and in particular gives a local monopoly, and that may, to an extent, make it less appropriate for a non-local court to rule on various issues (see Laddie J in *Coin Controls*) but that certainly does not make it inappropriate for an English court to address *all* issues relating to it, or even some fundamental issues if there are good reasons for dealing with them. The dividing line which puts subsistence or validity on the one side and infringement on the other is not logically sustainable in many cases. What of the patent case where validity is not in issue, but construction is? Which side of the line should that go? That is not a point I have to deal with, and the answer to that particular point (so far as Convention countries are concerned) lies in the correct interpretation of the Conventions, but analogous points arise in relation to copyrights. What if the only “subsistence” issue is a factual point as to whether a particular drawing existed, as in the present case? That is a subsistence point, but it does not depend on anything particularly linked to the US in the same way as a registered right would be linked.

269. In all the circumstances, and at least in relation to copyright, I think that the answer lies in acknowledging the basis on which it may be fundamentally undesirable for an English court to decide certain foreign intellectual property issues, but equally to acknowledge that the reasoning lies in public policy, as Laddie J said, and that the application of public policy might vary from case to case. The appropriate vehicle for dealing with this, in the absence of inter-state conventions (or statute, in the case of land), is to my mind the modern doctrine of *forum conveniens*, which was not such a mature doctrine at the time of *Mocambique* and *Hesperides*. It will generally not be appropriate, within that doctrine, for an English court to have to consider the sort of validity and registration issues identified in *Potter*, for the reasons given above. The application of the doctrine will therefore make sure that such cases are not heard in the wrong place, and in terms of real validity points it is likely that any court other than the courts of the territory of registration will be the wrong place. Apart from anything else, and as I have already observed, only the courts of the registering jurisdiction can make relevant and effective revocation orders. The same result might well apply to copyright cases, for (inter alia) the reasons given by Laddie J in *Coin Controls*, but since they do not involve registration it might be slightly easier to argue that they can be determined other than in the country of the right. Infringement can more easily be dealt with in another jurisdiction where subsistence is not in issue, a factor which was plainly recognised in *Ove Arup*, and, perhaps, even by Aldous J in *Minnesota Mining* in the passage referred to in *Coin Controls*, where he said it was “at least convenient” to try infringement in the copyrighting country.
270. Some of the reasons for adopting a more flexible approach are demonstrated by the facts of the present case. Mr Ainsworth has committed acts which are said to be an infringement of US copyright. There is a judgment about that in the US which, so far as it goes, and so far as it is useful, will operate there. However, he has chosen not to submit himself to the US jurisdiction, and under present English conflicts rules the US judgment cannot be enforced against him where he currently is (in this jurisdiction). If he were to be allowed to say that the US copyright claims cannot be enforced against him here at all, the consequences of what is said to be a wrong in the US would not be brought home to him in any practical sense, other than that importing into the US will now be difficult because of the possible intervention of US Customs. He would not be able to escape the consequences of other wrongs so lightly. The position is more rational if he can be sued here. If he wished to take the point that the US courts are the more appropriate courts for enforcing US copyright claims, he might well be right, and the more technical the points that arise the truer that may be. However, I do not see why he should be able to assert that as a reason for not being sued here while at the same time saying that he cannot be effectively sued there (in the sense of getting a judgment which can be enforced here) because he has not submitted to that jurisdiction.
271. Logically this approach means that, at least so far as copyright is concerned, the whole of a foreign copyright claim, no matter how fundamental the points, might be capable of being litigated here. While I do not think I would shrink from that conclusion if it was necessary to reach it, I do not believe I have to go that far. What I need to consider is whether, in the light of my conclusions (which I reach) that infringement issues are certainly justiciable here in an appropriate case, and that at least other incidental issues are as well, the actual claims that are made can be brought here and, if so, whether they are made out. That involves considering what those claims are, what the issues are, and

what reasons there are for litigating here as opposed to the US. I deal with those points in the next section.

US copyright – the claims made and the issues arising

272. In the light of that I turn to the substance of the US copyright claims. The issues arising (and not arising) can be broken down as follows:

(i) The subsistence of copyright and ownership (by one or more of the claimants) of all drawings (so far as they are found to exist) was accepted by Mr Ainsworth. The existence of some drawings was disputed (see the factual narrative above). So far as factual issues arise, they are no different from those that I have had to decide for English copyright purposes.

(ii) Infringement is denied so far as some drawings are concerned, on the footing that they were not copied, or not copied closely enough. By the end of the trial it was not suggested that any different factual or assessment issues arise in relation to these points over and above those that I have already decided for English copyright purposes.

(iii) Because 3D items were produced, it was argued that there was no infringement because copyright in the drawings would not be infringed by the production of a utilitarian or functional device. That is said to be a principle of US copyright law. The helmets and armour were said to be functional or utilitarian for these purposes. Mr Wilson accepted that this was an infringement point (not a subsistence point).

(iv) The claimants claimed copyright in physical helmets and armour. The existence of copyright in these was disputed by Mr Ainsworth because they were said to be functional or utilitarian. This was said to be a subsistence point, though clearly related to the same point arising in relation to infringement. At one stage it was also suggested that if there was copyright it was vested in Mr Ainsworth and not in the claimants, but this was point was not pursued into final speeches.

273. Thus the issues in relation to US copyright can be boiled down further. There are factual issues, which are essentially the same as those arising in the UK claim (or at least it was not suggested at the end of the day that there would be any material difference in the outcome) and the US “functionality” or “utilitarian” point. The factual issues have to be decided anyway. That leaves only the functionality/utilitarian point as being in issue as a special US copyright point.

274. In line with the previous section of this judgment, I therefore have to consider whether it is right for this court to consider the US claims. I approach the point on the footing that it is open to me to do so, but I nevertheless have to consider whether it is appropriate, in forum conveniens terms, to do so. I have no hesitation in saying that it is. Since I have to decide the factual points, it is plainly sensible and right that I should decide those points for both claims. So far as the functionality/utilitarian point is concerned, then it is a sufficiently small area (in legal terms) that is also appropriate and convenient for me to decide it (especially bearing in mind the level of dispute on it, which is not significant – see below). If it is more appropriate to consider infringement points than subsistence points (per *Ove Arup*), then part of it falls within that category anyway, so my hearing it can be justified on that basis; though in truth the fact that this issue is capable of falling both under infringement and subsistence shows the difficulty of taking that division as a clear border between the permissible and impermissible. It

would be strange if I could consider it under one head but not the other. I consider it proper to consider it under both.

275. However, the most compelling point in favour of this court determining the US copyright claim is that referred to in the preceding section, namely that Mr Ainsworth has not fully accepted that the US court should do so, in a manner which is capable of bringing the claim home to him. He did not actually accept the jurisdiction of the US courts, with the effects referred to elsewhere in this judgment, namely that the US judgment cannot be enforced against him. In the light of that it would be strange for this court to accede to a submission that the claim should not be brought here because the US is the only appropriate place to bring it. In those circumstances it is appropriate that the claim be brought here. I so determine.
276. The parties' final submissions on the merits of the US claim were light in absolute terms, and very light indeed when compared with the considerable volume of their submissions on the rest of the issues in this action. The factual issues arising can be taken to be decided by my findings above on the English claim. I do not believe that there are any more for me to decide. So that leaves the functionality point. I am spared a detailed consideration of the US legal issues and evidence by Mr Wilson's approach to this in his final written and oral submissions. Mr Tashman, who was Mr Ainsworth's expert on US law, was not called to give evidence, but his report did not come to any particular conclusion on this point anyway. Professor Menell, for Lucas, was called. That poses immediate difficulties for Mr Ainsworth. Professor Menell was cross-examined at length on the utilitarian question. If I had to analyse my way to a final conclusion it would be a lengthy exercise. Fortunately Mr Wilson's position in his final speech did not require me to do so. Mr Bloch had set out a certain amount of chapter and verse. All Mr Wilson said in his written submissions on the merits of the US claim was that "it has to be conceded that the Claimants got the better of the evidence". At the same time he said that there appeared to be:

"an arguable defence to infringement (on the basis of the US rule denying copyright protection to functional objects, including clothing, and even including wedding dresses). But the Claimants' witness was able to refer to principles and recent cases which he said would ensure success for the Claimants in this case. One is left with an uneasy feeling that if advocates well-versed in US law had been in a position to argue the case, the position could have been different."

His oral submissions effectively took the same stance, that (given the facts were against him) the only defence he would have in the US was the utilitarian defence. In relation to articles made from drawings he expressly conceded "that on the basis of the evidence given we would be likely to lose those issues in the United States on the basis that those matters are to be regarded as functional objects or utilitarian objects within the American jurisprudence". Having heard the evidence, and in the light of those concessions, it seems to me, and I find, that so far as these English courts are concerned the position is clear enough and it is possible to make a clear finding against Mr Ainsworth on the utilitarianism point; that is to say, that Mr Ainsworth cannot successfully raise a utilitarianism point against the copyright asserted in this claim (for the items where the issue is still live). The claimants "having the best of the evidence", with no attempt at analysis or arguing why the defendant might still be right, is a

euphemistic concession that the defendant does not have a winning case on the point. Accordingly, on the evidence, I find that the relevant 3D articles were not utilitarian or functional for the purposes of the relevant infringement or subsistence tests, and that therefore copyright exists, or is infringed, as the case may be.

277. The consequences of this determination will have to be followed through in a further hearing. The parties (sensibly) did not seek to take the US proceedings any further. Questions of relief will have to be decided at a further hearing, for which directions can be given if necessary. I am not aware of any other outstanding issues that arise in relation to the US claims; if there are then again it might be appropriate to have further argument on them. The parties acted sensibly in this action by limiting issues where they could. If apparently cutting back on them in their submissions leaves some potential loose ends, I will consider how those loose ends are to be dealt with.

Mr Ainsworth's own copyright claims

278. Mr Ainsworth had his own copyright claims, though they were only faintly argued. If it was possible to have copyright in the helmets then he claimed copyright in what he actually produced, on the footing that nothing of what he actually produced was an exact reproduction of a prior rendition, and he could claim copyright in what amounted to a fresh creation. There are two short answers to this (in the light of my previous conclusions). First, what he produced were not artistic works (they were not sculptures or works of artistic craftsmanship), and second, even if that is wrong, then he was and is obliged to transfer any copyright to the claimants.

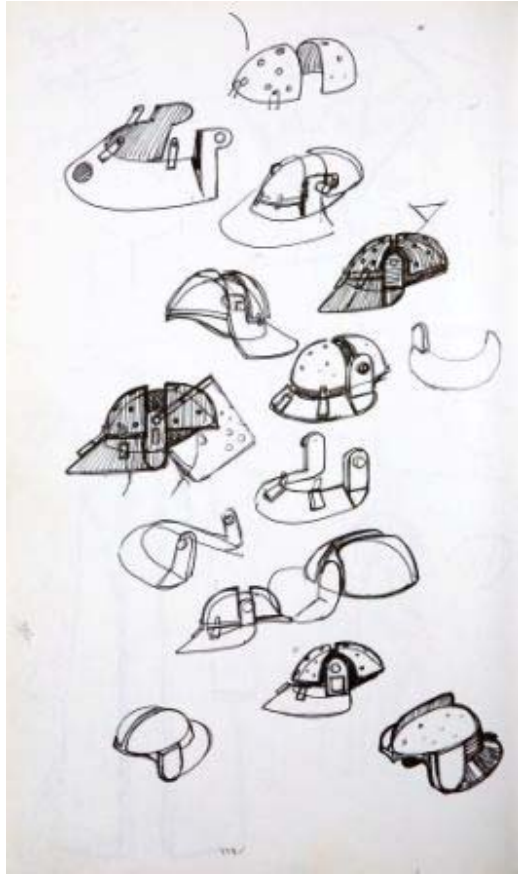
279. Accordingly, this claim fails.

Conclusions

280. I therefore conclude as follows:

- (i) The claim of the claimants based on an infringement of US copyright succeeds.
- (ii) All other claims of the claimants fail.
- (iii) The counterclaim of Mr Ainsworth fails.

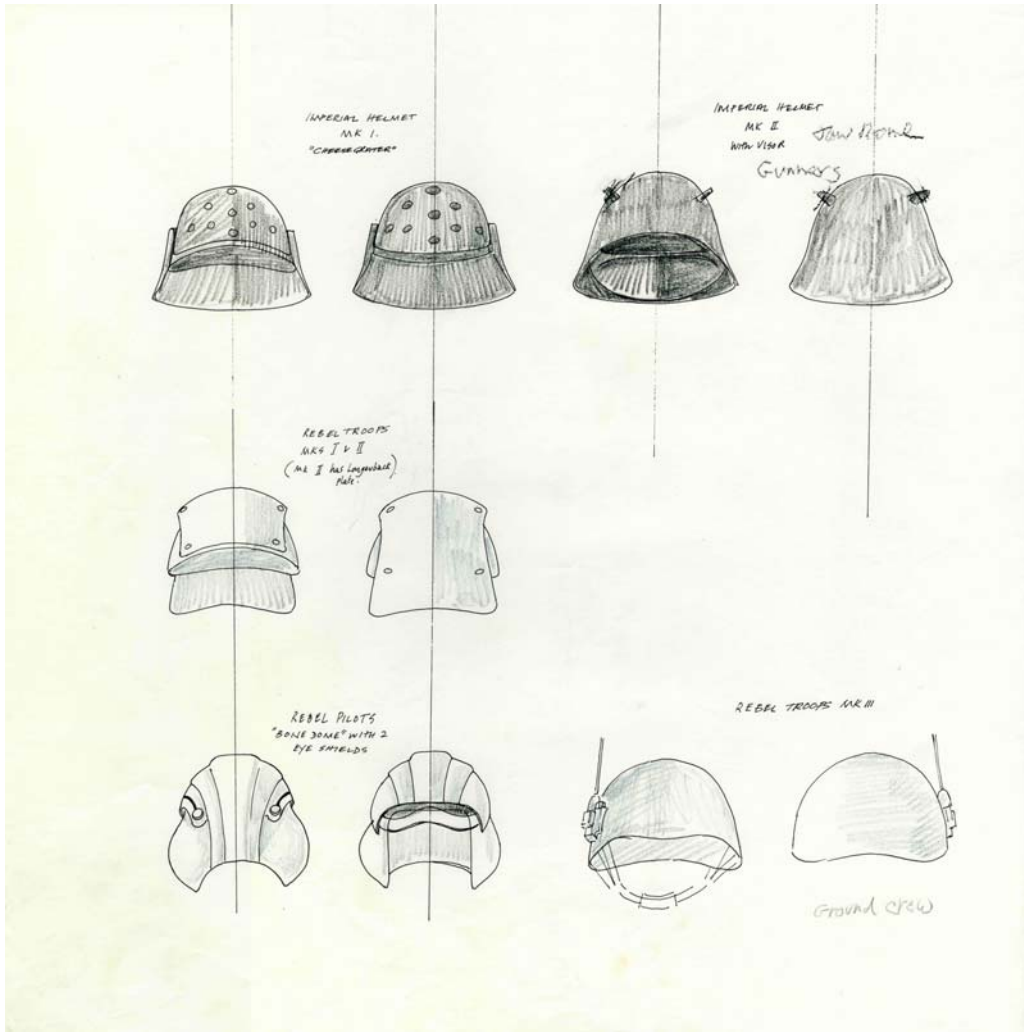
Appendix



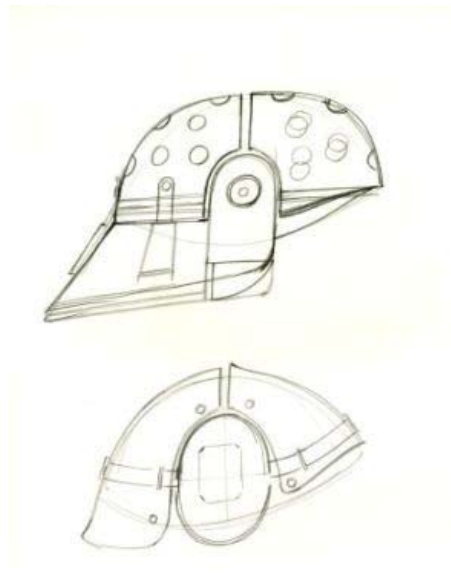
Appendix 1



Appendix 2



Appendix 3



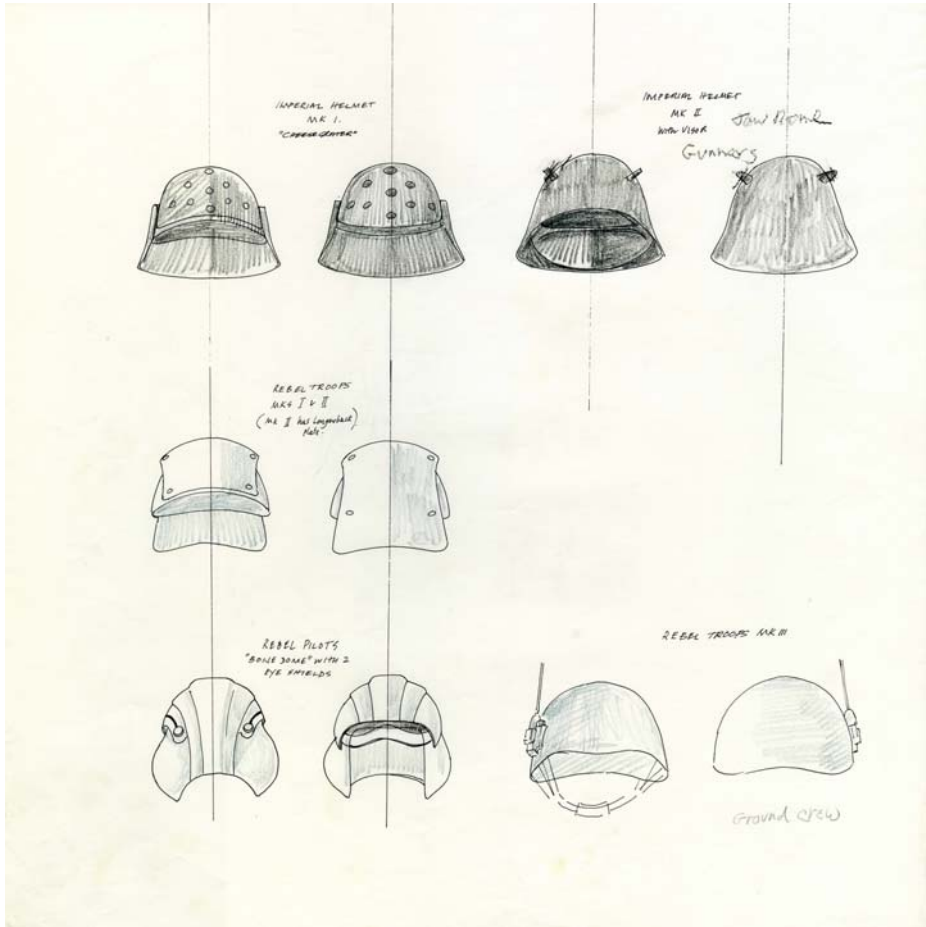
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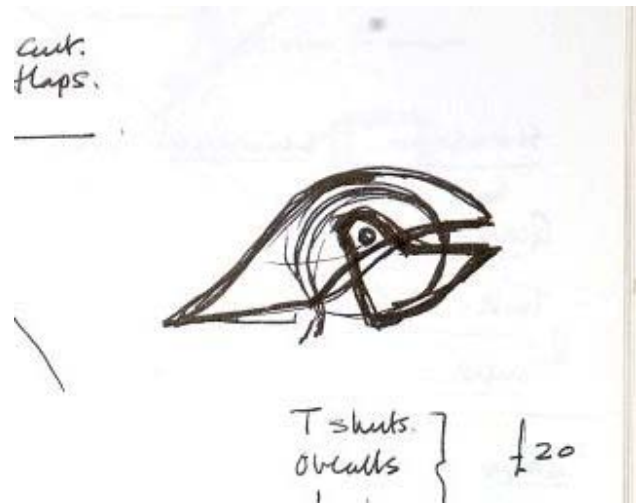
Appendix 5



Appendix 6



Appendix 7



Appendix 8



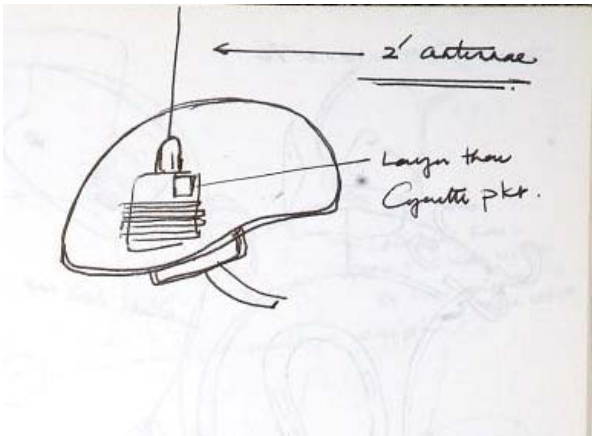
Appendix 9



Appendix 10



Appendix 11



Appendix 12



Appendix 13

Appendix 14 [not supplied]