

# Communication **LAW**



THE OFFICIAL PUBLICATION OF THE COMMUNICATIONS AND MEDIA LAW ASSOCIATION INCORPORATED

**B•U•L•L•E•T•I•N**

Print Post Approved PP: 234093/00011

EDITED BY NIRANJAN ARASARATNAM AND SHANE BARBER

Vol 20 No 3 2001

## **TV Formats: Still the Weakest Link?**

**Jerry Dohnal examines the emerging phenomenon of television programming with apparently similar formats. Does a breach of copyright exist?**

With the advent of reality-based television programming, television formats, once regarded by entertainment lawyers, whether rightly or wrongly, with some degree of cynicism, are now enjoying newfound popularity and success. Some of Australia's biggest rating programs for 2001 are based on television formats, including "Big Brother", "Who Wants To Be a Millionaire", "Survivor", "The Weakest Link" and "The Mole". These formats are appearing in local versions the world over and are performing surprisingly well.

"Popstars", the cult program produced by Australian company Screentime and based on a New Zealand format acquired by Screentime, has now been produced under licence in the US, Germany, Italy, Canada, Australia and New Zealand, and has been sold to Brazil, Argentina, Portugal, Denmark, Norway and Belgium. Screentime is in the process of developing other formats for overseas exploitation, including "Strip Search", and has itself acquired rights to a format called "Crossfire".<sup>1</sup>

### **WHAT IS FORMAT LICENSING?**

Format licensing, or "re-versioning" as it is also known, differs to program licensing in that it does not involve the acquisition of a finished program that has been produced elsewhere, and which may require dubbing or captioning in another language. Format licensing involves

local production of television programs based on a format or concept for a television program that may have been produced elsewhere, and which is reversioned using local talent.

Distraction Formats, a UK company, offers formats across a variety of genres including game shows (e.g. "Strip", which as the name suggests involves contestants who are willing to strip), comedy/sitcom (e.g. "Girl Talk", about "4 thirtysomething females who know they can count on each other - come hell or high water"), drama ("Virginie", a daily soap which touches on different social subjects such as racism, violence, family difficulties etc), entertainment ("The Big Bluff", where celebrity guests attempt to drive ordinary people crazy with their obnoxious behaviour), magazine ("The Feeling is Mutual", which "takes viewers on a 90 minute adventure into [a particular] celebrity's passion for the arts") and kids ("The

Lunch Box", where a 5-year-old girl discusses the contents of her lunch box with her 3 year-old pal, Charlie).<sup>2</sup>

### **A RECENT TREND?**

Whilst format licensing may seem like a relatively new trend, Australian production companies such as Grundy and Becker have long been licensing drama and gameshow formats internationally. Grundy has been producing overseas versions of its local Australian hits since the early 80s. In 1982 Grundy produced a US version of 'Sale of the Century' for NBC, becoming the first Australian producer to produce a series for a U.S. Network. Other Grundy program formats that have been successfully produced overseas, in a variety of countries from Germany to Paraguay, include "The Restless Years", "Sons and Daughters", "Prisoner", "Mother and Son", "Family Feud" and

### **INSIDE THIS ISSUE**

**TV Formats: Still the Weakest Link?**

**Fair or Foul Dealing:  
The Panel and Copyright**

**M Commerce and Wireless Advertising -  
Legal Challenges for Carriers**

**Mobile Number Portability -  
Will You Be Getting Around?**

**Dispute Resolution Under Part XIC of the  
Trade Practices Act - The Problems and the Cure**

**Cancelled Datacasting Transmission  
Licences Auction - Will the Red Faces Recover?**

**Teen Rebel Napster Faces the Music -  
Will it Be a Swansong?**

## CONTENTS

### **TV Formats: Still the Weakest Link?**

Jerry Dohnal examines the emerging phenomenon of television programming with apparently similar formats. Does a breach of copyright exist?

### **Fair or Foul Dealing: The Panel and Copyright**

Tim Golder and Teresa Ward examine the Federal Court decision dealing with allegations of copyright infringement by Channel Nine against Channel Ten over humorous rebroadcasts by The Panel.

### **M-Commerce and Wireless Advertising – Legal Challenges for Carriers**

Buying a coke with your mobile phone is just the beginning for mobile commerce. Niranjana Arasaratnam and Joanna Davidson discard the hype to assess this new service.

### **Mobile Number Portability – Will You Be Getting Around?**

Brenton Yates explores the regulation surrounding, and expected implications of, the recent introduction of mobile number portability.

### **Dispute Resolution Under Part XIC of the Trade Practices Act - The Problems and the Cure**

Michael Bray analyses these controversial provisions and gets to the bottom of current issues being confronted by industry participants, the ACCC and the Federal Government.

### **Cancelled Datacasting Transmission Licences Auction - Will the Red Faces Recover?**

The embarrassing cancellation of the datacasting transmission licence auction in May could cause ongoing damage to government revenue from the communications sector, Robert Gibson explains.

### **Teen Rebel Napster Faces the Music - Will it Be a Swansong?**

Mia Garlick reviews the practical impact for Napster of the Appeal Court's decision.

"Police Rescue". The German version of "The Restless Years" has, in fact, become Germany's most successful drama serial since its launch on commercial channel RTL in 1992.<sup>3</sup>

### **GREEN V BROADCASTING CORPORATION OF NEW ZEALAND**

In terms of intellectual property law, protecting a television format has always been a somewhat shaky proposition. A format is, after all, basically the idea for a television program. It is trite law to say that copyright subsists not in the idea itself, but in the form of the expression. So much was decided by the Privy Council in *Green v Broadcasting Corporation of New Zealand*, the leading case dealing with infringement of a television format.

Green was the author, producer and compere of a television talent show, "Opportunity Knocks", produced and broadcast in the United Kingdom from the early 1960s until 1978. Between 1975 and 1978 the Broadcasting Corporation

of New Zealand produced and broadcast a television talent show with the same title. Apart from the title, the New Zealand show included assorted features of the UK show, including the use of various catchphrases, the use of sponsors to introduce contestants and the use of a "clapometer". Green brought an action against the Corporation for passing off and infringement of copyright in the scripts and dramatic format for the program.

The New Zealand Court of Appeal, subsequently affirmed by the Privy Council, held that the scripts described by Green were no more than the skeleton outline or framework of the manner in which the television show would be conducted. Somers J said that the scripts did no more than express the general idea or concept for the show, and as such did not attract copyright protection. He cited *Tate v Thomas* [1921] 1 Ch 503 in which the author of a synopsis of a play was declined copyright protection. He did note, however, that it was possible for the abstraction implicit in a general idea or concept to be "delineated by or attended

with detail or pattern or incidents sufficiently substantial to attract copyright in the whole"<sup>4</sup>, i.e. an idea will be afforded copyright protection if it is expressed in sufficient detail so as to constitute a work protected by copyright. This suggests that if the concept for a television program is sufficiently elaborated in writing it will be afforded copyright protection.

Even so, whether or not a copyright work is infringed will depend upon the nature and quality of what is taken and whether or not it constitutes a substantial part of that work. For example, the use of elements from a television program will only constitute infringement of copyright if a court can find that the use of those elements constitutes a reproduction of a substantial part of the work in which copyright is claimed. The court will need to determine the extent to which the features which have been copied are more than mere ideas or concepts. What matters is the degree of particularity or generality of the idea which is taken. "If the general idea which underlies or forms the basis of the work has alone been taken

there will be no infringement. If more than that it will be a question of fact and degree whether there is an infringement."<sup>3</sup> Whether or not a substantial part has been copied will depend more on the quality of what has been copied rather than the quantity.

*"It is not now suggested that there was copyright in the title nor could it be suggested that the idea of a talent quest could obtain a monopoly. I think the Judge was right to hold that the use of sponsors in the way they were used by Mr Green was an idea not capable itself of being protected by the Copyright Act. The same position applies in my view to the clapometer... These features indicate the difficulties of Mr Green's case. Not surprisingly he feels his ideas have been appropriated. But that I am afraid is all that has happened. Whether taken item by item or as a whole I am of the opinion that the scripts... did not themselves do more than express a general idea or concept for a talent quest and hence were not the subject of copyright."*

#### **"BOOT CAMP"**

Notwithstanding the difficulties in pursuing an action for infringement of a television format, litigation remains a real option for an aggrieved party. Much will depend on the circumstances of the particular case. A United States judge recently refused to dismiss a copyright infringement lawsuit brought by CBS, the US producer of "Survivor", against rival broadcaster, the Fox Broadcasting Corporation, and production company LMNO Distribution, the producer of "Boot Camp". "Boot Camp" is a program which, like "Survivor", involves 16 contestants competing against each other for a cash prize who are required to complete challenges and vote members out at the end of each episode. CBS alleges "Boot Camp" copied significant copyright elements from "Survivor".

LMNO Distribution apparently pitched the idea for "Boot Camp" to CBS as a program which CBS could use to capitalise on the success of "Survivor". Fox lawyers used allegations by "Survivor" contestant Stacey Stillman,

that votes were rigged on "Survivor", to differentiate "Boot Camp" as a true reality program. In a ruling released 16 June 2001, the Judge indicated that even if the outcome of "Survivor" is proven to have been manipulated, CBS is still entitled to protect its show against copyright infringement, which the judge identified as the core issue of the case.<sup>6</sup>

Interestingly, Fox had previously filed a lawsuit against CBS in relation to the format for a reality program entitled "Race Around the World", which is currently in production, alleging that CBS stole the format from a Fox employee who created it in 1998.<sup>7</sup>

#### **FORMATS ADD VALUE**

If Green confirms that there is no copyright in a television format *per se*, and that the idea for a television program is not really capable of copyright protection, why are formats such hot property, being bought and sold worldwide for large sums of money? To some extent it's because companies like to be seen to be doing the right thing, and want to avoid expensive lawsuits, but perhaps more so because of the value-add that a format licensor has to offer.

A format does not merely consist of the idea for a television program. After all, ideas for television programs are perhaps even more prolific than unfinished novels and film scripts. A television format is a package of materials and information which a licensee can use to create a successful program. Action Time International, a UK company that has licensing and co-production arrangements in over 30 countries, has pioneered a 'one stop' service to its clients which can include comprehensive production support, including music, computer software and producers to consult on productions on-site.<sup>8</sup>

In the case of programs which have been successfully produced elsewhere, such packages, known in the TV industry as television program formats, can include a format guide and production bible, scripts, original episodes of the program as produced in other countries, questions (in the case of game shows), blue prints of sets, know-how needed to produce the program, unique software which may have been developed specifically for the

program, original music, graphics, titles, international rating figures for use by sales executives. A format licensor is basically offering licensees "all the inside knowledge that makes the format 'work'".<sup>9</sup> This represents a significant saving to the licensee on development and production costs. Even though it may not be possible to protect the basic program idea, each individual element of the package may be capable of separate intellectual property protection, whether by way of copyright, trade mark, confidentiality or contract.

Of course, where a format is yet to be produced, it will usually consist of only a relatively short document, a so-called "paper format" because it only exists on paper, setting out the basic concept or idea for a particular program. This is then shopped to potential production companies and broadcasters. Protecting a paper format presents a far greater problem for producers than a television program format, because it will be more difficult, in instances of infringement, for a court to draw a conclusion that one program is a copy of another.

#### **CONCEPT TELEVISION PRODUCTIONS PTY LIMITED AND CARTOON CONCEPTS PTY LIMITED V THE AUSTRALIAN BROADCASTING CORPORATION**

Issues relating to the protection of a paper format were considered by the Federal Court of Australia in *Concept Television Productions Pty Limited and Cartoon Concepts Pty Limited v the Australian Broadcasting Corporation* (1988). Concept Television alleged that the ABC had stolen the format for a television quiz show entitled "The Oz Game" from a format developed by Concept. Concept sought interlocutory relief to prevent the ABC from broadcasting the program on the night of its premier. Interestingly, the three causes of action upon which Concept Television sought to rely, being breach of contract, breach of confidence and contravention of section 52 of the Trade Practices Act 1974, did not include a claim in copyright, presumably because of the difficulty in proving that a substantial part of the paper format had been reproduced.

The ABC and Concept had originally intended to jointly produce a quiz show based on a box-board game developed by Cartoon Concepts. The program was subsequently cancelled by the ABC, which then commissioned another producer, Taffner Ramsay Productions, to produce "The Oz Game" based on a concept independently developed by Taffner. Finding for the ABC, Gummow J held that there was insufficient coincidence between the information claimed as confidential by Concept Television and the format eventually used for the Oz Game. Gummow J indicated that case law relating to breach of confidence requires an applicant to clearly identify the information which is said to constitute the subject matter of the confidence so that it may then be measured against the alleged breach or threatened breach.

In relation to the issue of contract, wherein Concept claimed that there was an implied negative covenant on the ABC not to produce a TV program as the same format as that proposed by Concept, Gummow J was of the view that the parties were yet to enter into a contract, and that even if they had, and even if there had been an express term of the type claimed by Concept, the program produced by the ABC did not bear such a relationship to the format offered by Concept as to infringe the implied term on which Concept sought to rely. In essence, the Court used the same sort of reasoning that it would have applied to an action in copyright, i.e. the program produced by the ABC did not constitute a substantial infringement of Concept's format.

---

### **STRATEGIES FOR PROTECTING A FORMAT**

---

Both *Green* and *Concept Television* provide useful clues as to the strategies that can be employed to protect a television format

**Express your format:** If your television format is yet to be produced, try to express the format in as much detail as possible to attract copyright protection. Until an idea is reduced to paper and elaborated in some way, it is very difficult to protect. The more detail in which your format is expressed, the more difficult it will be for

a third party to exactly copy that format. Be aware, however, that you can only protect your expression of the idea, and not the underlying idea itself. Although not strictly necessary, you should also mark all your documents with a copyright notice, and include the names and contact details for the authors of the document.

**Consider all forms of IP protection:** Pursue separate intellectual property protection for those elements of your format which qualify for that protection, e.g. trade mark protection for titles, slogans and catchphrases. Consider registering or depositing your format with a literary registry, or with the Format Recognition and Protection Society (FRAPA) which operates a free International Television Format Registry, first launched in February 2001 (<http://www.frapa.org/>). The idea of format registration is to provide evidence of the existence of a format at a certain date, and to whom it belongs.

**Confidentiality:** Program ideas and formats should only ever be disclosed to potential licensees or partners in the strictest confidence. You need a good pro forma confidentiality deed that protects you from a wide range of unauthorised use of your idea. Your documents should be marked "confidential", and any presentations of your idea should be clearly identified by you as being made "in confidence".

**Contract protection:** Ensure that you have the protection of a contract before developing or producing your idea with a third party. The contract should include restrictions on the party's ability to independently produce a television program that is based on or has a similar theme to the format in question. In addition to covering ownership of the intellectual property rights in the program, the contract should also cover ownership of the format, and any enhancements to the format (where joint or individual).

---

### **CONCLUSION**

---

Producers are increasingly becoming aware of the value of their television formats, and the need to protect those formats from misuse. FRAPA, which aims to promote to producers, broadcasters and the law, the concept of

formats as unique, intellectual properties, is backed by a range of format creators and providers such as Pearson, King World, Action Time, Endemol, Talkback and MTV Production. David Lyle, Pearson Television's head of light entertainment and a principal FRAPA organiser, believes that the escalating global trade in formats, plus the rise of the Internet and the "tremendous challenges" that that has posed for intellectual copyright protection, have hastened the need for an organisation like FRAPA.

A UK company called [tvformats.com](http://www.tvformats.com), a division of Group Media Ltd., is also dedicated to the recognition and protection of format rights. The members of Group Media Limited have particular experience in the international format business, and the development and production of television formats. There have also been calls for stronger legislation in Europe to protect the copyright of TV formats. These and other initiatives indicate that format rights, once regarded in the entertainment industry with a certain level of contempt and cynicism, essentially "the weakest link", may prove to be a much stronger link than anyone ever imagined.

1 <http://www.screentime.tv/formats/formats.html>

2 <http://www.distract.com/>

3 [http://www.afters.edu.au/Reports/industry\\_overview.html](http://www.afters.edu.au/Reports/industry_overview.html), <http://www.smh.com.au/news/0003/27/features/features20.html>

4 *Green v Broadcasting Corporation of New Zealand* [1988] 2 NZLR 490, at 497.

5 *Ibid* at 498.

6 <http://tv.yahoo.com/tvnews>

7 <http://www.encoremagazine.com.au>

8 <http://www.netsitepro.com/actiontime/>

9 <http://www.tvformats.com>

*The views expressed in this article are those of the author and not necessarily those of the firm or its clients.*

*Jerry Dohnal is a lawyer with the Sydney office of Gilbert & Tobin.*