

# Television format law in Australia

by

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Success stories in protecting television formats in the Australian courts are few and far between. There is no specific law aimed at protecting television formats and there is no plan to provide such protection. Notwithstanding, the courts have recognized the value of protecting a format as a form of intellectual property. That was done in spectacular fashion in the 1970's in *Talbot v General Television Corp Pty Ltd*<sup>1</sup> when Australia's major commercial television network, Channel 9, ignored a court injunction and broadcast on *A Current Affair* a television format that was subject to a duty of confidence.

*Talbot* stands as an important milestone in Australian intellectual property law. The notion that television formats are capable of being protected was also accepted by Gummow J in *Concept Television Productions Pty Ltd v Australian Broadcasting Corporation*<sup>2</sup>, although his Honour denied protection to the particular television format in issue.

Television formats are also a recognized form of intellectual property under the Australian law of trade marks and there are now many, many television productions that seek to protect elements of their format under the *Trade Marks Act 1995* (Cth). While confidential information and trade mark infringement have not been the only causes of action employed to protect a television format, they have certainly been the most successful.

## Confidential Information

The leading Australian case on defining a confidential television format is *Talbot v General Television Corp Pty Ltd*<sup>3</sup>. The plaintiff producer, Bob Talbot, aged 32, created a format for a television series entitled *To Make a Million*. The series would tell the stories of successful millionaires and contained segments with specific advice from the millionaires on how viewers could 'make a million' themselves. The producer prepared a detailed written submission on the concept which was introduced as follows:

Everyone has the desire to become a millionaire, few of us make it. This program is about those who have ... how they did it and how it has affected them. How does it affect a man when he goes from selling oranges door to door to millionaire six times over all in the space of seven years. What is the key to his success and what can we learn from it. How can we make a million. The desire and question is in the minds of everyone ...

The written submission continued with several quotes, sample stories, the 'Program Philosophy' and there was also a heading 'Program Format' which stated:

The program can be constructed in one of two ways. Ideally it will be a thirty minute show containing two case histories in each. However if it is desirable from a programming standpoint it could be produced as a one hour with three participants in each show. Initially the subject will be introduced by way of location interview. We will then retrace his or her path to fortune, perhaps including key figures who have played a part along the way, i.e. parents, school teachers, employers, employees, etc. We will then discuss the effect wealth has had on their lives, examine their current lifestyle, their homes and families, their sports and hobbies. Finally, we will extract advice for the would-be millionaires in the audience to follow.

There were further details on 'Specials' and the submission also contained a budget. In October 1976, the producer, Bob Talbot, met with various representatives from the Channel 9 network, including Sam Chisholm, the Chief Executive, Michael Schildberger the producer of *A Current Affair* and Gordon French, the Programme Manager. A copy of Talbot's written submission was left with them as well as other Channel 9 executives. Later that year, a pilot entitled *How to Make a Million* was produced by Talbot and it told the story of one man (Alex Classou) and how he made his millions. The pilot and its script together with another copy of the submission were given to Mr French at Channel 9 in January 1977.

Mr Talbot heard nothing further for several months and then on Saturday 23 April 1977 he became aware that Channel 9 had televised a promotion for *A Current Affair* which said:

Keith Williams, King of the Gold Coast, John and Merrivale Hermes, fashion tycoons, Tony Fisher, airplane and property dealer, John Nevin, super-salesman and racehorse owner – all millionaires through their own efforts. Could you be a millionaire too. Some of Australia's biggest money makers spell out their recipes for success in a special series starting on 'A Current Affair.'

On Sunday, 24 April 1977, Talbot sent telegrams to key executives at Channel 9 – including Kerry Packer and Sam Chisholm – stating that the inclusion of the proposed segment on millionaires in *A Current Affair* directly pirated his idea. He demanded that the network cease transmission of the promotion and delete the relevant segments. The network refused claiming that the story was a 'fresh idea' of its own.<sup>4</sup> Talbot's solicitors threatened to seek an injunction and late on the Monday afternoon Brooking J in the Victorian Supreme Court heard the application. At 6.15 pm his Honour granted the injunction. At 6.20 pm Talbot's solicitor informed Channel 9's Vice President of Programming of the terms of the injunction, but Channel 9 ignored this and televised the program on *A Current Affair* at 7 pm.

Not surprisingly, when the matter again came before the court on 5 May 1977, Harris J said it was regrettable that Channel 9 chose 'not to obey an order of the Court, presumably because it found it inconvenient to do so.'<sup>5</sup> His Honour then noted that Mr Talbot gained from the defendant's breach of the injunction 'because he viewed the programme, took a transcript of it and has been able to use that in support of his case.'<sup>6</sup>

While the two causes of action relied on by Talbot were breach of confidence and copyright infringement, the main focus at the hearing was on the former. Harris J found that Channel 9 had breached the equitable duty of confidence that it owed Talbot in relation to his television format. Channel 9's submission that the

television format was only an idea not protected by a duty of confidentiality was rejected. His Honour explained, at 231:

The real problem ... was to decide whether the idea, or concept, had been sufficiently developed. Where it had been developed to the point of setting out a format in which it could be presented, so that it was apparent that the concept could be carried into effect, then ... it was something that is capable of being the subject of a confidence. Without deciding that it is always necessary for a plaintiff to go that far, I am satisfied that where a concept or idea has been developed to the stage where [Mr Talbot] had developed his concept, it is capable of being the subject of a confidential communication. [Mr Talbot] had developed his concept so that it would be seen to be a concept which had at least some attractiveness as a television programme and to be something which was capable of being realized as an actuality.

Harris J ordered both a perpetual injunction and an enquiry into damages. Channel 9's appeal to the full Supreme Court (Gillard, McInerney and Murphy JJ) was unsuccessful, although the perpetual injunction was varied so as to end on 31 December 1979.

At the enquiry into damages Marks J held that equitable damages were available to Talbot under Victoria's then equivalent of *Lord Cairns' Act*.<sup>7</sup> These were to be assessed by reference to the diminished value of the concept in Talbot's hands after the breach of confidence. Even though the precise worth of the format was difficult to assess - because it was based on 'many contingencies which are incalculable' - this did not relieve the court of its duty to assess damages.<sup>8</sup> Marks J awarded \$15,000 in damages, plus interest and costs. For its time, this was a significant sum.

Channel 9's appeal to the full Supreme Court (Young CJ, Lush and Beach JJ) against the damages award was unsuccessful. Young CJ added that the confidential information in issue, namely, the television format or concept 'was rightly regarded as the property' of Talbot.<sup>9</sup>

### ***Concept Television v ABC***

*Talbot* is significant not only because a television format is defined and recognized as intellectual property (indeed, nine Victorian Supreme Court judges unanimously accepted this) but also because both an injunction and damages were awarded. The injunction was even extended to a third party.<sup>10</sup>

The basis for awarding damages for a breach of confidence in *Talbot*, however, was disapproved by Gummow J in the interlocutory decision, *Concept Television Productions Pty Ltd v Australian Broadcasting Corporation*<sup>11</sup>. His Honour did not agree that the source of the court's jurisdiction to award damages lay in *Lord Cairns' Act*, although he did accept that equitable compensation is available. More importantly, for present purposes, is the fact that Gummow J accepted that a television format was capable of protection from a pirate or imitator provided there is 'sufficient coincidence' between the television formats.

In the case before Gummow J the plaintiff, Concept Television, developed quiz and game shows for television. It knew of a board game called *Oz Quiz* developed by an associated company called Cartoon Concepts. Concept Television wrote and developed a television adaptation of the *Oz Quiz* game in an 8 page document headed 'Oz Quiz written as a television format.' This dealt with

comedy performance, contestants (who were juveniles), quest participation, prizes, staging and questions. In July 1987 Concept Television met with the ABC's head of television features, Scowcroft, and handed him a copy of the document containing the format. There were several further meetings, but all dealings came to an end on 4 May 1988 when Scowcroft told Concept Television that "Oz Quiz is cancelled."

The ABC had been concurrently co-producing with another company, Taffner Ramsay Productions, a television quiz game entitled *The Oz Game* which contained 65 x 28 minutes episodes. Various newspaper reports, including the *Australian Financial Review*, contained detailed accounts of the format of *The Oz Game*. The contestants were to be families rather than children, the teams interacted with each other rather than a simple question/answer style and the prizes were travel within Australia. The newspaper reports came to the attention of Concept Television, which immediately sought a *Talbot* type injunction to restrain the ABC's proposed broadcast.

Concept Television's action was based on three claims: contract, breach of confidence and misleading conduct under s 52 of the Trade Practices Act 1974 (Cth). But each claim failed for one main reason. As explained by Gummow J:

My conclusion at this stage on the material before me is that the applicants have not shown, on the confidential information branch of their case, that there is a serious question to be tried. I say this because even if on 22 July 1987 an obligation of confidence did arise as alleged in the statement of claim, there was insufficient coincidence between that information as claimed and the format eventually used for the Oz Game...

I should also add that whilst the authorities collected by Mr Gurry in his work *Breach of Confidence*, pp 125–6, including as they do the Victorian decision in *Talbot v General Television Corp Pty Ltd* ... (applied in *Fraser v Thames Television Ltd*<sup>12</sup>), show that there may be an obligation of confidence arising in such situations, nevertheless it is essential for an applicant clearly to identify that 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 ... When that is done in the present case, then, on the present evidence, the result is as I have indicated.

Of course, it is clear that Gummow J accepts here that a television format can be protected from a pirate or an imitator provided there is 'sufficient coincidence' between the formats. That phrase has become the touchstone of liability in this area of the law. In a typical action the plaintiff will file a list of similarities while the defendant will file a list of dissimilarities.<sup>13</sup>

## **Breach of contract and restitution**

Licensing television formats is a common and essential means of achieving protection, although it is rare that a pirate or imitator will be a party to an authorized format licence. In both the *Talbot* and *Concept Television* cases there was no contract to rely on. In *Concept Television* Gummow J found that there was not a serious question to be tried as to the existence of a contract. The situation was 'in a fluid state of negotiations.' The plaintiff faced the additional hurdle that

it was seeking to rely on an *implied* negative covenant stated by counsel as follows:

... that the ABC is not to produce a TV programme with the same format as that proposed by the applicant, this negative obligation to last for five years or such other period being the reasonable commercial life of the programme.

His Honour found, however, that the plaintiffs had not satisfied the tests for the implication of such a broad term. Further, even if there was a contract and such a term was to be implied there was, as mentioned above, ‘insufficient coincidence’ between the formats.

Still the lessons from *Concept Television* are valuable. A producer pitching a new format should move from the ‘fluid state of negotiations’ to a contract at the earliest possibility. If a long form contract cannot be agreed, a short form agreement containing an *express* negative stipulation against reproducing or copying the format should be obtained.

The difficulty for the producer is that during the pitch there is often a concern to avoid excessive legalese for fear of scaring off the buyer. If that is the case, Gummow J alluded to another remedy in *Concept Television*. Even though there was no contract between the parties his Honour held that the law of restitution may provide relief:

That is not to say that the efforts of [Concept Television] ... were performed gratuitously and without any obligation of restitution imposed by law on the ABC; see the authorities collected and discussed by Sheppard J in *Sabemo Pty Ltd v North Sydney Municipal Council* ... by Robert Goff J in *British Steel Corp v Cleveland Bridge and Engineering Co Ltd* .... But that is not how the present proceedings seem to be framed ...

The law of restitution could prove valuable, not only where there is no contract, but also where the format is no longer confidential. But while restitution may provide an obligation on the imitator to pay for the copied format, it will not protect the format itself. As we have seen, the action for breach of confidence is capable of doing that in Australian law, but once the format is no longer confidential the owner must turn to other areas of law to seek protection, most notably, copyright, trade mark infringement and passing off.

## Copyright infringement

Protecting a television format containing large amounts of unscripted dialogue (such as reality television formats) is virtually impossible under copyright law. The leading decision in the United Kingdom and New Zealand is *Green v Broadcasting Corporation of New Zealand*.<sup>14</sup> For many years the English television presenter Hughie Green produced and presented a televised talent quest in the United Kingdom known as *Opportunity Knocks*. The defendant also produced and televised in New Zealand a talent quest known as *Opportunity Knocks*. Claims were brought in both passing off and copyright. The former failed because Hughie Green’s original UK version of *Opportunity Knocks* had never been shown in New Zealand and therefore it lacked a reputation in New Zealand.

The copyright claim failed because there was a paucity of evidence directed at establishing that the format had been reduced to writing and was not a mere idea. As noted by Lord Bridge ‘no script was ever produced in evidence’.<sup>15</sup> His Lordship concluded:

On the basis of this evidence Somers J concluded (16 IPR at 8) that: ‘... the scripts as they are inferred to be from the description given in evidence did not themselves do more than express a general idea or concept for a talent quest and hence were not the subject of copyright.’

In the absence of precise evidence as to what the scripts contained, their Lordships are quite unable to dissent from this view.

Green also argued that the ‘dramatic format’ of *Opportunity Knocks* should be protected by copyright. But this failed too, because it lacked certainty as to subject matter. Lord Bridge explained the plaintiff’s difficulty as follows:

The alternative formulation of the appellant’s claim relies upon the “dramatic format” of “Opportunity Knocks”, by which their Lordships understand is meant those characteristic features of the show which were repeated in each performance. These features were, in addition to the title, the use of the catch phrases “For [name of competitor] Opportunity Knocks”, “This is your show, folks, and I do mean you”, and “Make up your mind time”, the use of a device called a clapometer to measure audience reaction to competitors’ performances and the use of sponsors to introduce competitors. It was this formulation which found favour with Gallen J.

It is stretching the original use of the word “format” a long way to use it metaphorically to describe the features of a television series such as a talent, quiz or game show which is presented in a particular way, with repeated but unconnected use of set phrases and with the aid of particular accessories. Alternative terms suggested in the course of argument were “structure” or “package”. This difficulty in finding an appropriate term to describe the nature of the “work” in which the copyright subsists reflects the difficulty of the concept that a number of allegedly distinctive features of a television series can be isolated from the changing material presented in each separate performance (the acts of the performers in the talent show, the questions and answers in the quiz show etc) and identified as an “original dramatic work”. No case was cited to their Lordships in which copyright of the kind claimed had been established.

The protection which copyright gives creates a monopoly and “there must be certainty in the subject matter of such monopoly in order to avoid injustice to the rest of the world”<sup>16</sup> ... The subject matter of the copyright claimed for the “dramatic format” of “Opportunity Knocks” is conspicuously lacking in certainty. Moreover, it seems to their Lordships that a dramatic work must have sufficient unity to be capable of performance and that the features claimed as constituting the “format” of a television show, being unrelated to each other except as accessories to be used in the presentation of some other dramatic or musical performance, lack that essential characteristic.<sup>17</sup>

In Australian law the Privy Council’s decision in *Green v Broadcasting Corporation of New Zealand* is persuasive authority, but it is not binding on Australian courts. The Victorian full Supreme Court decision in *Talbot* does not seem to have been referred to in *Green*, perhaps because *Talbot* was predominantly concerned with the protection of a television format through confidentiality rather than copyright. Copyright infringement was only ‘faintly argued’ in *Talbot*.<sup>18</sup> There is, however, no real conflict between *Talbot* and *Green*. On the facts it is clear that *Talbot* was able to do what *Green* could not: define the television format with certainty. While copyright infringement and confidential

information are clearly different causes of action they do share the ingredient that the subject matter needs to be precisely defined or identified.

In *Australia Green* was cited with approval by Tamberlin J in the Federal Court in *Nine Films & Television Pty Ltd v Ninox Television Ltd* [2005] FCA 1404 (*The Block*). In 1999 Ninox, created a reality television format known as *Dream Home* where two families engaged in a DIY home renovation competition. It was subsequently shown on New Zealand television and was a huge success. The format was then licensed in Australia to Nine Films & Television (Nine), which aired its own version in 2000 known as *Australian Dream Home*. Nine exercised its option to produce a second series, but it never eventuated. But, between 2002 and 2005, Nine developed another television show known as *The Block*. This focused on the ‘drama’ of four couples engaged in a home renovation competition taking place in a single ‘block’ of apartments. The first series was set in Bondi in 2003 and the second in Manly in 2004. Both were a huge success.

Ninox complained that Nine had infringed its copyright in the *Dream Home* format by producing and screening *The Block*. This was rejected by Tamberlin J who then upheld Nine’s application for a declaration that Ninox had made unjustifiable threats of copyright infringement under s 202 of the *Copyright Act* 1968 (Cth). While Tamberlin J did not find as a matter of law that television format rights are incapable of copyright protection,<sup>19</sup> he did conclude in relation to the reality television formats in issue before the court that in his view:

... simply by reason of the fact that there are large elements of unscripted dialogue and interaction within the overall framework of the programs, there cannot be any substantial reproduction.

... I have set out the particulars of the *Dream Home* format as pleaded by Ninox in the Amended Cross Claim. These include events and characters and emotional elements. I have considered each of these elements and, having regard to my viewing of the complete episodes of the programs, I am not persuaded that these aspects, as portrayed in the productions of the two programs, are at the necessary level of detail or bear any sufficient resemblance in mood, tone, portrayal, structure, visual and aural impact, or by way of general impression from content, to support a conclusion that there has been any substantial reproduction of the *Dream Home* format as submitted by Ninox in this case.<sup>20</sup>

### ***Zeccola v Universal City Studios Inc***

*Zeccola v Universal City Studios Inc*<sup>21</sup> is an interesting case to compare with *Green* and *The Block*. *Zeccola* concerned the 1975 and 1977 films *Jaws* and *Jaws II* and, like *Green*, it demonstrates the need to define with certainty the audio-visual subject matter that is to be protected.

In 1980 Italian filmmakers made a film called *Great White* but in May 1980 *Weekly Variety* reported that the film was to be called *The Last Jaws*. When the film was shown in Italy later that year it was called *La Ultimo Squalo* which translates to *The Last Shark*. After seeing the *Weekly Variety* article Universal sued in several countries where the screening of the film was imminent including Italy and Australia. After watching the films Gray J in the Victorian Supreme Court granted an injunction restraining the Italian filmmakers from infringing Universal’s copyright in the *Jaws* novel, screenplay and film and from infringing Universal’s registered trademark *Jaws*. His Honour was of the view that ‘there

was such a marked degree of similarity between the two films that there was an inescapable inference of copying.’<sup>22</sup>

The Italian filmmakers appeal to the full Federal Court of Australia (Lockhart, Fitzgerald and Jenkinson JJ) was unanimously dismissed. The Italian filmmakers submitted:

... that both films, “Jaws” and “Great White” are genre films based upon the idea of a savage monster menacing a community. Each is a film about a killer shark terrorizing human beings and it was said that neither film was entitled to protection as there is no copyright in that general idea.<sup>23</sup>

In rejecting this argument Lockhart and Fitzgerald JJ said:

The difficulties involved in severing films into parts which are capable of characterization as original works and other parts that are not is obvious. Indeed, it is the subject of only limited exploration by the laws of this country and the United Kingdom. We were referred to certain decisions of United States courts where this question has been considered from time-to-time and we have found those cases helpful in resolving the questions before us. *In general, there is no copyright in the central idea or theme of a story or play, however original it may be; copyright subsists in the combination of situations, events and scenes which constitute the particular working out or expression of the idea or theme.* If these are totally different the taking of the idea or theme does not constitute an infringement of copyright.

Of necessity certain events, incidents or characters are found in many books and plays. Originality, when dealing with incidents and characters familiar in life or fiction, lies in the association, grouping and arrangement of those incidents and characters in such a manner that presents a new concept or a novel arrangement of those events and characters. We accept that where a story is written based on various incidents which, in themselves, are commonplace, a claim for copyright must be confined closely to the story which has been composed by the author. Another author who materially varies the incidents and characters and materially changes the story is not an infringer of the copyright. If a literary or dramatic work is not wholly original there is no copyright in the unoriginal part so as to prevent its use. Additional factors may fall for consideration where the alleged infringement is by cinematograph film.

The primary judge closely analysed the two films “Jaws” and “Great White”. Notwithstanding that the subject-matter of the film “Jaws” was not particularly striking his Honour held the view, in essence, that the combination of the principal situations, singular events and basic characters was sufficient to constitute an original work that was susceptible of protection under the law of copyright in this country. In our opinion his Honour’s finding has not been shown to be in error.<sup>24</sup> (italics added)

*Zeccola* is not a television format case like *Talbot*, *Green* or *The Block* because Universal based its claim on the separate copyrights it held in a novel, screenplay and film as well as a registered trade mark. Nonetheless, it contains a valuable lesson for those seeking to protect a television format. The evidence presented on claiming copyright ownership under the *Copyright Act 1968* (Cth) at the interlocutory hearing was substantial. The hearing before Gray J ‘occupied several days, many affidavits were read and most of the deponents were cross-examined’ and the case ‘rapidly developed into a proceeding more akin to the final hearing of the action.’<sup>25</sup> On appeal Lockhart J said:

A problem in these proceedings is that the parties tended to blur the distinction between final and interlocutory proceedings and the problem was exacerbated by the different copyrights asserted by the respondent as the basis of its claim. Many questions have been raised, some of which were dealt with by the learned primary

judge, which may be of importance at the trial but do not fall for present decision and indeed are best left open at this juncture for later determination.<sup>26</sup>

Still, Universal succeeded due to the time and effort it put into establishing ownership and infringement of its copyright.

## Passing off

Australian law explicitly preserves the common law action for the tort of passing off in s 230 of the *Trade Marks Act 1995* (Cth). Still this tort has not been a successful way of protecting television formats. It failed in *Green* and in Australia it failed in *TV-am plc v Amalgamated Television Services Pty Ltd*<sup>27</sup>. Since 1983 TVam plc had broadcast throughout the United Kingdom between 6 am and 9.25 am daily a programme called *Good Morning Britain* that was used in conjunction with the caption *TV-am*. On May 2 1988 Channel 7 Australia commenced broadcasting 6 days a week a morning programme called *TVAM*. TVam plc sued Channel 7 for misleading or deceptive conduct under the *Trade Practices Act 1974* (Cth) (the Act) and for passing off its television programme as one associated or connected with the applicant. TV-am plc submitted that not only were the names similar, but so were the formats.

Both actions failed for an identical reason given in *Green*: the plaintiff could not establish a reputation for its United Kingdom television programme in Australia. Still, Einfeld J in the Federal Court of Australia stopped short of saying that such an action was incapable of succeeding. His Honour held that in determining whether there was a misrepresentation for the purposes of passing off and statutory misleading or deceptive conduct it was relevant to consider ‘the style and content of the respondent’s programme compared with the programme broadcast by the applicant’ and ‘the publicity generated by the respondent in relation to its programme.’<sup>28</sup> Einfeld J concluded that ‘[a]lthough the types of programme broadcast by the applicant and the respondent are both early morning breakfast shows, their content and target audience vary considerably’ and the ‘sets and mode of delivery of the on-air presenters are significantly different.’<sup>29</sup>

## Misleading and deceptive conduct

A further consideration under Australian law when considering the protection of television formats is s 52(1) of the *Trade Practices Act 1974* (Cth) which provides:

A corporation shall not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive.

There is a huge body of case law on this section concerning actions that are analogous with passing off and there is a wide variety of remedies available under the Act including damages, injunctions and declarations.<sup>30</sup> However, in common with passing off and copyright, it has not been a successful way of protecting television formats. It failed in the Federal Court in both the *Concept Television*

and the *TV-am* cases. Still, it was successful in protecting a magazine format in *Pacific Publications Pty Ltd v IPC Media Pty Ltd* where the applicant had for many years published the *Home Beautiful* magazine and the respondent proposed to publish a magazine called *25 Beautiful Homes*. While Beaumont J dismissed the trade mark infringement claim his Honour, nonetheless, upheld the applicant's claim under s 52 because this required 'the court to consider objectively the whole of the conduct of the respondent in all of the surrounding circumstances.'<sup>31</sup> When that task was carried out Beaumont J noted:

Here, the evidence demonstrates that in the only edition published thus far, the respondent has included a significant proportion (20%) of photographs previously included in the applicant's publication.

In my opinion, given the other common features involved, especially the same target readership (homemakers), the use of the same words in their respective titles (albeit in reverse order) and the respondent's instructions to newsagents to locate its product near the applicant's, the respondent's use of the applicant's photographs, and the failure to mention the respondent's connection with the UK magazine in the editorial, is likely to create an impression in the minds of consumers that, contrary to the fact, there is some connection between the respondent's magazine and the applicant's, which, unless corrected (and it was not corrected in the November 2002 edition), would thus be likely to mislead or deceive, in contravention of s 52.<sup>32</sup>

In granting the injunction his Honour expressly referred to the 'format' of the magazines:

It follows, in my view, that the court should restrain the future publication by the respondent of a magazine using the format of the November 2002 edition (that is, utilising photographs which had previously appeared in the applicant's magazine and failing to mention that the respondent's magazine is a local version of its UK magazine) without clearly distinguishing its magazine from the applicant's: see, eg *Parker-Knoll Ltd v Knoll International Britain (Furniture & Textiles) Ltd* [1961] RPC 346 at 362.<sup>33</sup>

## **Trade mark infringement**

The case law shows that this is an area of television format protection that is often overlooked. There is the straight forward issue of registering the title of a proposed television format as a trade mark or service mark under the *Trade Marks Act 1995* (Cth). In the *Zeccola* case, for example, it was found that there was an infringement of the plaintiff's registered trade mark for the title of the film *Jaws*. There was no need to rely on the tort of passing off. By contrast, in the *Green* and *TV-am* cases there was no registered trade mark and the plaintiff faced the difficulty of establishing reputation in the local market place.

Further, trade marks identifying services, including television production services have been registrable in Australia since 1978.<sup>34</sup> While a trade mark registration cannot protect a television format *per se*, in many cases it can offer protection for other elements including the characters. The trade marks register contains many examples of television shows where the title has been registered. For example, Endemol Nederland BV the producers of *Big Brother* have registered this as a trade mark (numbered 811800) for the following goods and services:

- Class: 9** Magnetic data carriers and recording discs, all relating only to the applicant's television program on which the trade mark is used; none of the foregoing for use in respect of karaoke activities.
- Class: 16** Paper, cardboard and goods made from these materials; printed matter; photographs; printers' type; all relating only to the applicant's television program on which the trade mark is used.
- Class: 25** Clothing, footwear, headgear; all relating only to the applicant's television program on which the trade mark is used.
- Class: 28** Games and playthings; gymnastic and sporting articles not included in other classes; all relating only to the applicant's television program on which the trade mark is used.
- Class: 41** Education and entertainment, namely production of the television program on which the trade mark is used.

Those classes should be the minimum applied for and obviously the broader the protection the better. Similarly, there are several registrations for *Backyard Blitz* and six different trade marks for *Who Wants To Be A Millionaire* in classes 9, 16, 25, 28, 30, 38 and 41 owned by Celador International Ltd. *I'm A Celebrity Get Me Out Of Here* is trade mark registration number 932957 for the following services:

- Class: 41** Entertainment and education services in all media; television entertainment; television programs; production of television and radio programs; film production; organisation of competitions (education or entertainment); productions of video tapes and video discs; publication of information on the Internet.

If producers wish to go that step further, they should also consider lodging trade marks for elements in the format including the characters and catch phrases. Examples include several children's shows such as *Thomas the Tank* and *Bananas in Pyjamas*. Of course Disney is an old hand at this as shown by its voluminous trade mark registrations throughout the world for its various characters and shows. While registering trade marks in several countries can be expensive, at the very least the producer should register in their home market and then expand the registrations as soon as possible to incorporate prospective broadcast markets.

## Conclusion

While Australia lacks specific intellectual property legislation aimed at protecting television formats at least in the *Talbot* case the court was prepared to protect a format and define it as intellectual property. All of the nine judges that heard the case accepted this. Apart from confidential information, it is trade mark registration and licensing that have become the accepted legal means of protecting the title and the format. Actions for passing off, copyright infringement and deceptive conduct usually fail, although the courts have stopped short of saying that these actions are incapable of protecting television formats.

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- <sup>1</sup> [1980] VR 224; [1981] RPC 1.
- <sup>2</sup> (1988) 12 IPR 129 at 134 (Fed C of A).
- <sup>3</sup> [1980] VR 224; [1981] RPC 1.
- <sup>4</sup> [1980] VR 224 at 229.
- <sup>5</sup> [1980] VR 224 at 226.
- <sup>6</sup> [1980] VR 224 at 226.
- <sup>7</sup> Section 62(3) of the *Supreme Court Act* 1958. This has now been repealed and replaced by s 38 of the *Supreme Court Act* 1986 (Vic).
- <sup>8</sup> [1980] VR 224 at 249 citing in support *Chaplin v Hicks* [1911] 2 KB 786.
- <sup>9</sup> [1980] VR 224 at 250.
- <sup>10</sup> See also Dean, *The Law of Trade Secrets*, LBC 1990, p 272.
- <sup>11</sup> (1988) 12 IPR 129 (Fed C of A).
- <sup>12</sup> [1984] QB 44.
- <sup>13</sup> Compare the comments of Mr Justice Laddie in *IPC Media v Highbury-SPL Publishing* [2004].
- <sup>14</sup> (1989) 16 IPR 1 (Privy Council).
- <sup>15</sup> 16 IPR 1 at 24-5.
- <sup>16</sup> *Tate v Fullbrook* [1908] 1 KB 821 at 832 per Farwell LJ.
- <sup>17</sup> 16 IPR 1 at 25-6.
- <sup>18</sup> [1980] VR 224 at 241 per Harris J
- <sup>19</sup> Indeed his Honour held at [40] that “One question to be addressed is whether any of the episodes use a substantial part of the incidents, plot, images or sounds presented in *Dream Home* or colourable imitations thereof. In order to succeed, Ninox must show that the combination or series of dramatic events in *The Block* reproduce in a substantial way any of the situations or incidents in the *Dream Home* format or production: see *Bagge v Miller* [1917-1923] MacG Cop Cas 179 at 186-188; *Kelly v Cinema Houses, Ltd* [1928-35] MacG Cop Cas 362 at 370; *Dagnall v British & Dominion Film Corporation Ltd* [1928-35] MacG Cop Cas 391 at 394-5; *Poznanski v London Film Production Ltd* [1936-45] MacG Cop Cas 107 at 109.”
- <sup>20</sup> [2005] FCA 1404 at [74]-[75].
- <sup>21</sup> (1982) 46 ALR 189.
- <sup>22</sup> 46 ALR 189 at 194.
- <sup>23</sup> 46 ALR 189 at 192.
- <sup>24</sup> 46 ALR 189 at 192-3.
- <sup>25</sup> 46 ALR 189 at 190.
- <sup>26</sup> 46 ALR 189 at 189-190
- <sup>27</sup> (1988) 12 IPR 85.
- <sup>28</sup> 12 IPR 85 at 93.
- <sup>29</sup> 12 IPR 85 at 93.
- <sup>30</sup> See Covell & Lupton, *Principles of Remedies*, LexisNexis, 2005, Chapter 14.
- <sup>31</sup> (2003) 57 IPR 28 at [110].
- <sup>32</sup> (2003) 57 IPR 28 at [111]-[112].
- <sup>33</sup> (2003) 57 IPR 28 at [113].
- <sup>34</sup> *Trade Marks Amendment Act* 1978 (Cth).