

Article

The Emperor's New Clothes? The Way Forward: TV Format Protection under Unfair Competition Law in the United States, United Kingdom and France: Part I

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LT Broadcasting; Comparative law; Format rights; Television; Unfair competition; United States

Introduction

"Under the present legal framework the business is generally run as a series of gentlemen's agreements. Sadly, many people don't act like gentlemen . . . formats are bought and sold, licence fees are paid. . . However, this assumed security is largely illusory. It is as tangible as the emperor's new clothes. . ."¹

The global format market was worth €6.4 billion between 2002 and 2004.² Recent hit shows with underlying formats are *Survivor*, *Big Brother*, *Who Wants to be a Millionaire*, *Wife Swap*, *The Apprentice* and *Pop Idol*. In 2003, UK producers exported the greatest share with a dominant 45 per cent share of the international market. US producers came second with a 20 per cent share by hours. *American Idol* alone is valued at \$2.5 billion.³

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1. David Lyle, Chairman of the Format Recognition and Protection Association 2003. T. Colwell and D. Price, *Rights of Passage, British Television in the Global Market*, A Report by the TV Research Partnership (February 2005) UK Trade and Investment, p.40.
2. FRAPA/Screen Digest Report *The Global Trade in Television Formats* (2005) (Screen Digest).
3. Colwell and Price, *Rights of Passage, British Television in the Global Market*, A Report by the TV Research Partnership (February 2005) UK Trade and Investment, p.3.

Many commentators have reviewed the complex position under copyright and called for a recognised format right.⁴ In 1994–1996 there was consultation in the United Kingdom over further copyright protection for TV formats by extending "copying" to include borrowing "format" elements.⁵ This did not lead to any changes to existing legislation.⁶

There has been little focus on the protection of TV format rights via unfair competition law internationally. It is proposed that due to the divergence of approaches to originality under copyright law, it is more suitable to protect TV formats under unfair competition laws as opposed to copyright or the creation of another sui generis right.

Limitation of the area of research

This article focuses on unfair competition in the United States, United Kingdom and France, limited to areas of unfair competition that relate to TV format rights: unlawful imitation by misrepresentation/confusion and misappropriation/parasitism. In respect of copyright protection, the issues of originality are used to illustrate the problem of the international copyright protection of TV formats.

In this article, a TV format means the central idea of a TV programme as expressed in a skeleton structure with some or all of the following: a storyline, a sequence of events or elements, defined characters, name, special set/props, catchphrase or other repeated elements.

4. U. Klement, "Protecting TV show formats under copyright law: new developments in common law and civil law countries" [2007] E.I.P.R. 60.
5. P. Kamina, *Film Copyright in the EU* (CUP, 2002), p.82.
6. S. Lane and R. Bridge, "Programme formats: the write-in vote" [1996] E.L.R. 212.

Unfair competition—International

Under art.10bis of the Paris Convention 1883 countries are bound to provide protection against unfair competition. Article 10bis (2) provides a broad definition:

“Any act of competition contrary to honest practices in ... commercial matters constitutes an act of unfair competition.”

This relates to commercial matters although the parties do not need to be in a competitive relationship. “Honest practices” are not defined.⁷

Unfair competition that creates confusion with a competitor

Article 10bis (3) prohibits three types of unfair competition including acts which create confusion with the goods of a competitor. This type of unfair competition is protected in the United States, United Kingdom and France, e.g. §43(a) of the Lanham Act (United States), passing off (United Kingdom) and disloyal competition (France). TV format actions may fail due to the difficulty in proving confusion under this type of protection.

Misappropriation

Misappropriation is a form of unfair competition when a party “exploits another’s valuable commercial achievements, independently of showing risk of confusion”.⁸ Also known as free-riding and parasitic behaviour, it is the broadest form of competition by imitation.⁹ It is different from monopolistic intellectual property rights in that it aims to protect against a method of competition.¹⁰

Member countries are free to provide redress against misappropriation. Although, not all countries provide protection beyond art.10bis (3). The United Kingdom is more restrictive and does not have any form of unfair competition law. Whilst, the United States and France allow forms of redress for misappropriation (United States) and parasitism (France).

United States

Unfair competition

In the United States, unfair competition is a common law tort partially developed via case law in State courts, partially codified in State Statute and partially codified by Federal Statute.¹¹

7. WIPO, *Protection against Unfair Competition* (Geneva, 1994), p.18; Xiao Yi chen, “The status of International Protection Against Unfair competition” [1997] E.I.P.R. 422.

8. Henning-Bodewig and Schriker, “New Initiatives for the harmonisation of unfair competition in Europe” [2002] E.I.P.R. 274.

9. WIPO, *Protection against Unfair Competition* (Geneva, 1994), p.55.

10. A. Kamperman Sanders, *Unfair Competition Law, the Protection of Intellectual and Industrial Creativity* (Clarendon Press, 1997), p.113.

11. *Fashion Two Twenty Inc v Steinberg* 339 F Supp 836 (E.D.N.Y. 1971).

Federal law—Lanham Act

Under §43(a), the Lanham Act seeks to prevent any person who uses in commerce:

“... any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact ... which is likely to cause confusion ... as to the connection with another person”.¹²

It provides protection against many forms of confusion and misrepresentation like the law of passing off in England. To bring a successful action under §43(a) requires: (1) a valid mark; (2) ownership of the mark; and (3) likelihood of confusion.¹³ Actual confusion and intent to confuse are not required.¹⁴ However, in relation to TV formats, like in UK passing-off actions, it may still be difficult to establish that there is a protectable mark or any likely confusion.

Under §43(a) a TV format could be argued to fit into the categories of mark covered by device or false designations of origin. First, a protectable mark must be capable of distinguishing the claimant’s goods from others and for a product to be entitled to protection (like a TV format) it must be non-functional.¹⁵ A clip from a short film in the film “*The Long Kiss Goodnight*” was held not to contain elements that serve as trade marks.¹⁶ Trade dress can be distinctive if an owner can show that the trade dress has acquired secondary meaning.¹⁷ By analogy to TV formats if a programme has been broadcast, its format may be a device or designation of origin that has developed secondary meaning, i.e. viewers may recognise the format as identifying the format creator and not just the programme itself. However, it may be difficult to prove that a TV format is operating as a mark.

In determining likelihood of confusion the *Polaroid* eight-step test is often referred to including one or more of: (1) strength of mark; (2) similarity of mark; (3) proximity of products; (4) likelihood prior owner will bridge the gap; (5) actual confusion; (6) defendant’s bad or good faith; (7) quality of defendant’s product; and (8) sophistication of buyers.¹⁸ In relation to TV formats, factors 1, 2, 3, 5, 6 and 8 are most relevant.

Factor 1 is the extent to which a mark has come to identify a source of origin.¹⁹ Query whether an audience will be at all confused as to the origin of a TV format? Origin was narrowly construed in *Dastar Corp v Twentieth Century Fox Film Corp.*²⁰ where the Supreme Court held there was no confusion as to origin by copying a videotape of a work out of copyright.

12. Lanham (Trademark) Act (15 U.S.C.).

13. *Polaroid Corp v Polarad Electronics Corp* 287 F2d 492 (2d Cir 1961).

14. *Century 21 Real Estate Corp v Sandlin* (1988, CA9 Cal).

15. *Two Pesos v Taco Cabana* (1992) 112 S Ct 2757.

16. *Comedy III Prods Inc v New Line Cinema* 200 F3d 593 (9th Cir 2000).

17. *A. Daley* (2000); *Wal-Mart Stores Inc v Samara Brothers Inc* 529 U.S. 205 (2000).

18. *Polaroid Corp* 287 F2d 492 (2d Cir 1961).

19. S.W. Halpern, C.A. Nard and K.L. Port, *Fundamentals of United States Intellectual Property Law: Copyright, Patent, and Trademark* (Kluwer Law, 2006), p.389.

20. *Dastar Corp v Twentieth Century Fox Film Corp* 123 S Ct 2041.

Considering factor 2, makers of similar TV formats are only likely to be ok if the total concept and feel of the formats are different like in *Harvey Cartoons v Columbia Pictures*²¹ where there was no confusion between the parties' ghosts. A disclaimer will not help a defendant to avoid likelihood of confusion.²² So, referring to the original format owner in credits and using a similar title would not be acceptable.

If the parties are competitors (factor 3), less evidence is required to find likelihood of confusion.²³ So, competing formats, broadcast to identical audiences at the same time are more likely to confuse.

Courts almost unanimously presume a likelihood of confusion based on showing intentional copying (factor 6).²⁴ In *Sears, Roebuck and Co*²⁵ the court held a defendant must have intended to confuse customers. Since TV formats are often intentionally copied, this will assist in proving confusion.

As for factor 8, US case law places great relevance in assessing confusion on the intelligence, discrimination and sophistication of consumers.²⁶ Certain TV audiences will be more discerning than others. Perhaps it is easier under US law to establish likelihood of confusion under factor 8 for TV format copies aimed at less educated viewers? Surely it is unreasonable for the effect of this test to distinguish protection of low and high brow TV programmes?

Misappropriation INS case

The first time unfair competition became an autonomous doctrine was the case of *INS v Associated Press (AP)*.²⁷ The Supreme Court granted a quasi-property right in respect of AP's news because: (1) the plaintiff had invested time, effort and money in creating hot news; (2) hot news was appropriated by the defendant at little or no cost; and (3) there was damage to the plaintiff who was losing subscriptions.

Analysis

Cases in the 1950s/1960s extended misappropriation to intangible property that Congress had not deliberately excluded from copyright protection. *Goldstein v California*²⁸ and *Kewanee Oil v Bicorn Corp*²⁹ dealt with recorded materials and trade secrets respectively. Neither were pre-empted by federal copyright law and Supreme Court upheld state law rights in intangibles. Similarly, misappropriation of news facts was prevented in *Pottstown Daily News Publishing v Pottstown Broadcasting*³⁰

since Congress had never dealt with news per se in copyright laws so it was not pre-empted.

The latest case of *NBA v Motorola*³¹ requires restrictive additional factors to be satisfied in a misappropriation action: (1) plaintiff collects information at some costs; (2) the information is time sensitive; (3) the defendant's use of the information is free-riding; (4) the defendant's use is in direct competition; and (5) free-riding would reduce the incentive to produce substantially threatening the existence of the product/service. The court found no misappropriation under factor 5 because NBA was not going to stop sponsoring/broadcasting games merely because a few people would be deflected from watching by Motorola's service (Motorola paged summary facts from basketball broadcasts to its users).

In respect of TV formats, factors 1 and 2 should be satisfied: a format is usually created at some cost and until broadcast in a version in the territory is time sensitive so "hot property" as opposed to "hot news". Regarding factor 3, imitation of the format would be free-riding if taken without any effort and investment. However, it is harder to satisfy factors 4 and 5: sometimes parties will not be in direct competition, e.g. broadcasters in different genres or sellers of ancillary products (computer games based on a format would not be in direct competition with a format creator). Further, free-riding of a TV format may not substantially threaten the future creation of other TV formats.³²

The later cases rejecting misappropriation have also fallen at the hurdle of the competitor not being in the same market (*Dow Jones*)³³ or the need to threaten the existence of the original product/service (*Data Max*).³⁴ It is proposed that such factors are too restrictive and would exclude most cases of misappropriation. Also, *Motorola* factors 4 and 5 go against any underlying economic or unjust enrichment justifications for the protection of intangibles.

Kamperman Sanders argues that the ruling of the US Supreme Court in *Bonito Boats Inc v Thunder Craft Boats Inc*³⁵ has an overruling effect on all US unfair competition law making it impossible to create quasi-property rights following *INS*.³⁶ Certainly, the only exceptions seem to be *Capitol*,³⁷ *Goldstein* and *Kewanee* dealing with recorded materials and trade secrets. It is arguable that *Bonito Boats* only restricts patent and design right misappropriation cases since it is a case that deals with pre-emption rights and patent/design rights not copyright. Therefore it is contended that the *INS* case is not reduced to cases where only hot news is misappropriated. In respect of TV format rights, since the failure of Congress to include TV format rights in the Federal Copyright Act does not indicate an intention to leave TV format rights in the public domain (like *Goldstein*), then the pre-emption

21. *Harvey Cartoons v Columbia Pictures* 645 F.Supp. 1564 (S.D.N.Y. 1986).

22. *Horn Abbot v Sarsaparilla Ltd* 601 F supp 366.

23. Halpern, Nard and Port, *Fundamentals of United States Intellectual Property Law* (2006), p.389.

24. Fremlin, *Entertainment Law* (CBC, 1990), s.6:7.

25. *Sears, Roebuck and Co* (1981 CA9 Cal) 645 F2d 788,791.

26. Fremlin, *Entertainment Law* (CBC, 1990) s.6:10.

27. *INS v Associated Press* 248 U.S. 215 (1918).

28. *Goldstein v California* 412 U.S. (1973).

29. *Kewanee Oil v Bicorn Corp* 416 U.S. (1974).

30. *Pottstown Daily News Publishing v Pottstown Broadcasting* 147 U.S.P.Q. 414.

31. *NBA v Motorola* 105 F 3d 841 (2nd Cir 1997).

32. *NBA v Motorola* 105 F 3d 841 (2nd Cir 1997).

33. *Board of Trade v Dow Jones* 456 NE 2d 84 (1983).

34. *US Golf Assn v St. Andrews Sys Data Max inc* 749 F 2d 1028 (3rd Cir 1984).

35. *Bonito Boats Inc v Thunder Craft Boats Inc* 489 U.S. 141 (1989).

36. Kamperman Sanders, *Unfair Competition Law* (1997), p.19.

37. *Capitol Records v Mercury Records* 105 USPQ 163 (2nd Cir 1955).

doctrine should not apply. State courts should be able to rule in respect of unfair competition in TV format right cases.

Copyright

In the United States, TV formats may be protected under copyright; however, the position is unclear. TV formats are not specifically mentioned as a category in s.102 of the Copyright Act.

Following *Feist Publications Inc v Rural Telephone Service Co*³⁸ the test for originality has moved from a broader "sweat of the brow test" and a work is now required to have been: (1) independently created, i.e. not copied; with (2) minimal creativity. The level of creativity threshold is low, e.g. if they possess a creative spark no matter how crude, humble or obvious.

Gorman argues decisions regarding literary, musical or artistic imagination should not be down to the judiciary.³⁹ Certainly it could be problematic to leave a decision regarding creativity in TV formats to a court.

In *CBS v ABC*⁴⁰ (*Survivor*) (alleging *I'm A Celebrity Get Me Out Of Here* copied *Survivor*, reality shows set in the jungle and a desert island respectively), Preska D.J. considered a TV format to be a compilation of ideas and analogous to the situation in *Feist*. In *Feist* for a compilation to be protected under copyright, only its selection or arrangement is protected, the facts are free for the taking. Preska noted that so long as a copy does not feature the same selection/arrangement then the ideas are free for the taking.⁴¹ In this case it was held the formats were not similar. Regrettably the court failed to assess copyrightability of the *Survivor* format in detail so we have no precedents to assist with what "minimal creativity" in respect of TV formats means.

Ginsberg notes *Feist* offers a thin veil of copyright protection to verbatim copying. This is because only exact copies of the same selection and arrangement are protected. In relation to TV formats, the problem is few copies will repeat the selection and arrangement so closely as to amount to infringement. Whereas misappropriation may provide wider protection if it protects the copying of the investment/effort. Further misappropriation could cover elements that go beyond selection, e.g. defined characters, name, special set/props and catchphrases.

Gorman notes *Feist* left the door open for *INS*-type misappropriation claims.⁴² The challenge with TV formats would be to present a misappropriation claim that would withstand any copyright pre-emption claims. *Endemol v Twentieth TV*⁴³ held that if the TV format is recorded in a tangible medium, e.g. videotape or written treatment, then the subject matter is covered by copyright and would be pre-empted. Further, ideas are within the subject matter of copyright and therefore a claim is pre-empted. Rubin argues that *Endemol's* wide remit prevents any TV format that

does not meet copyright criteria being protected by State law since it covers all idea submissions except for those given orally in meetings. This may prevent a misappropriation claim.⁴⁴

However, the *Endemol* case can be distinguished from *Pottstown* since Congress has never dealt with TV formats in copyright laws so a case may not be pre-empted.

What is at issue is whether the United States is right to deny protection of investment under pre-emption principles in certain intangible products just because such products are not covered by copyright/patent. It would be better for there to be a clear Federal law against misappropriation.

United Kingdom

There is no law of unfair competition recognised in the United Kingdom.⁴⁵ Instead, to satisfy the provisions of the Paris Convention art.10bis, the United Kingdom has a closed list of specific torts, passing off being most relevant to TV format rights.⁴⁶

Passing off

The essential elements of the action

An action in passing off classically requires proof of three things: (1) goodwill; (2) misrepresentation; and (3) damage.⁴⁷ Whilst this was extended to a five-step test in the *Advocaat* case,⁴⁸ more recent judgments have applied the classic trinity test.⁴⁹ See below in relation to TV format disputes.

Goodwill

Goodwill may be established in not just a mark or name but in other distinctive material. In a series of cases the action for passing off has extended to products such as in the drink "advocaat".⁵⁰ The test is whether the product has derived a distinctive character which the market recognises.⁵¹ Furthermore goodwill has been extended to authorised dealerships.⁵²

Whilst there has not been a TV format decision in the United Kingdom dealing with this point yet (several have settled), a TV format could have goodwill as per the product goodwill cases if sufficiently developed with a distinctive character. Furthermore, if

38. *Feist Publications Inc v Rural Telephone Service Co* (1991) 499 U.S. 340.

39. R. Gorman, "FEIST Case: Reflections on a Pathbreaking Copyright Decision" (1992) 18 Rutgers Computer & Tech. L.J. 731.

40. *CBS v ABC* O2 Civ. 8813 (LAP) January 13, 2003.

41. *CBS v ABC* O2 Civ. 8813 (LAP) January 13, 2003 p.512.

42. R. Gorman, "FEIST Case" (1992) 18 Rutgers Computer & Tech. L.J. 784.

43. *Endemol v Twentieth TV* 1998 US Dist Lexis 19049.

44. J. Rubin, "Television Formats: Caught in the Abyss of the Idea/Expression Dichotomy" (2005–2006) 16 Fordham Intell. Prop. Media & Ent. L.J. 667.

45. A. Horton and A. Robertson, "Does the United Kingdom or the European Community need an unfair competition law?" [1995] E.I.P.R. 568.

46. C. Wadlow, *The Law of Passing Off* (Sweet & Maxwell, 1995), p.22–31.

47. *H.P. Bulmer Ltd and Showerings Ltd v J. Bollinger S.A. and Champagne Lanson Pere et Fils* [1978] R.P.C. 79.

48. *Erven Warnick BV v J Townend and Sons (Hull)* [1980] R.P.C. 31 HL.

49. *Reckitt & Colman Products v Borden Inc* [1990] R.P.C. 341 HL; *Consorzio Del Prosciutto Di Parma v M and S Plc* [1991] R.P.C. 351 CA.

50. *Erven Warnick BV v J Townend and Sons (Hull)* [1980] R.P.C. 31 HL.

51. *AG Spalding & Bros v AW Gamage Ltd (Taxation)* (1915) 84 L.J. Ch. 449 HL; *Reddaway v Banham* [1896] A.C. 199 HL.

52. *Sony KK v Saray Electronics (London) Ltd* [1983] F.S.R. 302 CA (Civ Div).

the claimant was an exclusive licensee perhaps goodwill could be claimed like in the *Sony KK v Saray Electronics*⁵³ authorised dealer case.

Territoriality

Goodwill needs to be established by actual trading in the territory.⁵⁴ For TV formats not yet broadcast in the United Kingdom, the *Budweiser* decision is an obstacle. The claimants did not succeed because their beer was not yet available in England other than in US air force bases and the US embassy. The court held any presence in the United Kingdom was an extension of the US market and did not form goodwill in the United Kingdom.

The court's decision in *Budweiser*⁵⁵ that any overspill was an extension of the US market would also prevent any argument of goodwill in TV formats being established from unintentional overspill via satellite of a TV format programme from another country before it is broadcast in the United Kingdom.

The New Zealand *Opportunity Knocks* case came to the same conclusion that the plaintiff had failed to establish goodwill since the TV format for *Opportunity Knocks* had not been seen in New Zealand and was only known to a small group of English expats and New Zealanders who had been to the United Kingdom.⁵⁶ The New Zealand court (prior to the Privy Council) held such people amounted to too small a group to enable the court to find the establishment of goodwill in New Zealand.⁵⁷ However, on appeal, Gallen J. did note that goodwill existed in:

"... the overall production comprising as it did, elements which included the name, certain catchphrases, the personality of the appellant and the recognisable format of the show."

However, he emphasised that this was not enough and goodwill requires a public which is aware of and influenced by it. He recognised that businesses are now international in reputation and goodwill may extend internationally with the business with which it is associated.⁵⁸

Bridge and Lane argue that the *Opportunity Knocks* programme at the time was a good example of a reputation of international stature and express surprise at the New Zealand court's decision.⁵⁹ However, it is noted that the original trial judge limited such international goodwill in relation to TV broadcasts "to the area where it is both broadcast and received".⁶⁰ Perhaps this decision would have been different today? Goodwill could be more easily established in a TV programme that is first broadcast in another territory and not received in another territory via cable, satellite or terrestrial transmissions but accessible via the internet.

53. *Sony* [1983] F.S.R. 302 CA (Civ Div).

54. *Anheuser-Busch Inc v Budejovicky Budvar NP (t/a Budweiser Budvar Brewery)* [1984] F.S.R. 413 CA (Civ Div).

55. *Budweiser* [1984] F.S.R. 413 CA (Civ Div).

56. *Green v Broadcasting Corp of New Zealand* [1989] R.P.C. 469 CA (NZ).

57. *Green* [1989] R.P.C. 469 CA (NZ) at 480.

58. Graham J. in *Baskin-Robbins Ice Cream Co v Gutman* [1976] F.S.R. 545.

59. R. Bridge and S. Lane, "The protection of formats under English law" (1990) 3 E.L.R. 96.

60. *Green* [1989] R.P.C. 469 CA (NZ) at 489.

Misrepresentation

To establish misrepresentation, evidence of confusion is not sufficient on its own, there must also be a representation by the defendant that its business is that of, or connected with, the claimants.⁶¹

Bridge and Lane illustrate how it may be difficult to establish misrepresentation in TV format passing off since it may be difficult to establish the connection between the defendant's TV production and that of the claimant. They note "connected with" is usually taken to mean a TV programme that is a version of the copied programme format.⁶² Certainly, audiences do not necessarily see any link between the makers of similar programmes especially if they are on different channels via different broadcast media. Unless as in the *Heroes' Night*⁶³ case in France, the same presenter is used and the programme is a copycat with few if any differences other than title. Of course, it would depend upon the facts of the case concerned.

Other types of association may be misrepresented, such as perhaps that the original producer has authorised or licensed the production. Bridge and Lane believe cases involving authorisation are hampered by the fact that the licensor often operates in a field of expertise widely separated from the defendant and so it is unlikely a consumer would see any connection between the two.⁶⁴ However, the courts have pushed the boundaries of what connections a consumer may make. In *Mirage Studios v Counter-Feat Clothing Co Ltd*,⁶⁵ inducing customers to believe that clothes featuring cartoon characters were produced under a genuine licence was misrepresentation. Similarly, a court may decide it is misrepresentation by a producer of a copycat format to induce a viewer to believe their programme was made with a format licence.

Confusion

In establishing likelihood of confusion, the question is what impact would the defendant's mark/product be likely to have on probable customers given the expectations they have and the amount of attention that they will pay?⁶⁶ A case will fail if "only a moron in a hurry would be misled".⁶⁷ Probable customers are assumed to be "reasonably well informed and reasonably observant and circumspect".⁶⁸ The defendant's state of mind is irrelevant.⁶⁹ The claimant does not need to show actual deception in order to

61. Kerly, *Kerly's Law of Trade Marks and Trade Names*, 14th edn (2005), p.15.

62. Bridge and Lane, "The protection of formats under English law" (1990) 3 E.L.R. 96.

63. Cour d'Appel de Versailles (123th chamber) 11 March 1993; (1993) Ent. LR E-63.

64. Bridge and Lane, "The protection of formats under English law" (1990) 3 E.L.R. 96.

65. *Mirage Studios v Counter-Feat Clothing Co Ltd* [1991] F.S.R. 145 Ch D.

66. W. Cornish and D. Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (Sweet & Maxwell, 2007), p.643.

67. *Morning Star Cooperative Society Ltd v Express Newspapers Ltd* [1979] F.S.R. 113 Ch D at 117.

68. *BACH and BACH FLOWER REMEDIES Trade Marks* [2000] R.P.C. 513 CA (Civ Div).

69. *Gillette (UK) Ltd v Edenwest* [1994] R.P.C. 279 Ch D.

succeed.⁷⁰ There has been no little consideration in the United Kingdom of how many people should be deceived, it seems the number must be substantial and more than de minimis.⁷¹

In the *Opportunity Knocks* case, Casey J. concluded that even with the similarities grafted on to the basic pattern of a talent quest, the separate identity of the two shows would be unmistakable to the average viewer. The dominant feature was Hughie Green's personality and the judge did not think viewers familiar with his work would assume that a similar local show was an adaptation.⁷² Bridge and Lane note that viewers may fail to associate any programme however closely copied if the presenter is not present nor in the credits.⁷³ However, a producer cannot rely upon the audience noticing programme credits if they are likely to be deceived by the programme as a whole (as per the *Jif Lemon*⁷⁴ case where it was held a competitor who deliberately adopted leading features must take adequate steps to differentiate their get-up so that consumers will not be deceived).

Damage

If not actual injury then a claimant has to show some likelihood of injury.⁷⁵ Damage is more easily proven in TV format cases such as loss of licence fees in the territory, loss of programme sales of the original programme in the new territory and/or loss of advertising.

However, the claimant may come unstuck if it cannot prove an intention to licence. In *Stringfellow v McCain Foods (GB) Ltd*⁷⁶ the lack of intention to licence affected whether damage was likely. Although in *Lego Systems A/S v Lego M Lemelstrich Ltd*,⁷⁷ it was sufficient if it was reasonably foreseeable that the claimant might expand into the new field. So long as a TV format creator tries to establish international licensing then any sale to any territory in any media is foreseeable. However, it may be harder to prove foreseeability for ancillary products akin to restrictions seen in US misappropriation cases.

Pub Squash case

The Privy Council in the Australian *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd*⁷⁸ case failed to extend the law of passing off into a broader law of misappropriation. However, the appellants restricted themselves to a case based on confusion.⁷⁹

70. Kerly, *Kerly's Law of Trade Marks and Trade Names*, 14th edn (2005), pp.15–192.

71. per Jacob J., *Neutrogena v Golden* [1974] R.P.C. 603.

72. *Green* [1989] R.P.C. 469 CA (NZ) at 481.

73. Bridge and Lane "The protection of formats under English law" (1990) 3 E.L.R. 96.

74. *Jif Lemon* [1990] 1 W.L.R. 491 HL at 518.

75. Cornish and Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (Sweet & Maxwell, 2007), pp.17–29.

76. *Stringfellow v McCain Foods (GB) Ltd* [1984] F.S.R. 175 Ch D.

77. *Lego Systems A/S v Lego M Lemelstrich Ltd* [1983] F.S.R. 155 Ch D.

78. R.W. de Very, *Towards a European Unfair Competition Law: a clash between legal families. A comparative study of English, German and Dutch law in light of existing European and international legal instruments* (Leiden/Boston: Martinus Nijhoff Publishers, 2005), p.256.

79. *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] 1 W.L.R. 193 PC (Aus) at 490.

The defendant copied the successful sales formula for the claimant's lemon drink including the yellow colour of the container and the theme of the advertising that it was manly to drink the lemon squash. On dismissing the appeal, it was held that descriptive material such as slogans and visual images used in an advertising campaign could amount to product goodwill but a deliberate imitation of another's goods or trading style did not in itself amount to a deception sufficient to constitute passing off. It was necessary to show that the defendant had confused or misled the market. Since there was no misrepresentation between the get-up of the lemon drink products nor the advertising campaign, there was no passing off.⁸⁰

Although, Lord Scarman did note, "[a] Defendant . . . does no wrong by entering a market created by another and competing with its creator". He went on to accept the line was drawn by inquiring whether the consuming public was confused or misled.⁸¹

Further, the tone of the defendant's television advertising campaign was like the claimant's; its tone was masculine and the audio nostalgic.⁸² However, it was held that the two themes of manliness and nostalgia were descriptive of the product but they never became a distinguishing feature to amount to goodwill. Since, generic themes in an advertising campaign could as easily apply to generic ideas in a TV programme it is submitted that such generic forms should not gain any greater protection.

Summary

What is at issue here is whether it would be appropriate for the United Kingdom to extend the restrictions on a free market to types of unfair behaviour that go beyond areas covered by passing off. Dworkin argues in favour of Parliament legislating for an action of unfair competition to promote honest behaviour in the marketplace.⁸³ Since the courts make use of unfair competition principles in existing intellectual property law, Ricketson considers it is natural to extend this to explicitly acknowledge an unfair competition law.⁸⁴ Cornish on the other hand fears the introduction of unfair competition in the United Kingdom would place further impediment in the way of competition by imitation.⁸⁵

In comparison to the United States and France, the United Kingdom is arguably the most restrictive in its protection for TV format rights since it has no law akin to misappropriation. A TV format is hard to protect under passing off due to the difficulty in proving misrepresentation, confusion and territoriality. Gowers's Review did not mention TV format rights notwithstanding the

80. *Cadbury Schweppes* [1981] 1 W.L.R. 193 PC (Aus).

81. *Cadbury Schweppes* [1981] 1 W.L.R. 193 PC (Aus) at 491.

82. *Cadbury Schweppes* [1981] 1 W.L.R. 193 PC (Aus) at 489.

83. G. Dworkin, "Unfair competition: is the common law developing a new tort?" [1979] E.I.P.R. 295.

84. Ricketson, "Reaping without sowing: unfair competition law and IP rights in Anglo-Australian law" [1984] U.S.V. L.J. 1, 30.

85. Cornish and Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (Sweet & Maxwell, 2007), pp.1–17.

United Kingdom's dominant share of the international market.⁸⁶ In the call for evidence TV format protection did not form a specific question posed by Gowers's review team. It is unclear whether any submissions covered TV formats.⁸⁷ However, with no mention in Gowers's Review it is unlikely that any sui generis legislation is forthcoming to protect TV formats. Furthermore, sui generis

protection would lead to a list basis of protection of particular rights and a more general form of protection would be more flexible. It is submitted that Parliament should legislate to protect unfair competition. This could then be used to protect TV formats in the United Kingdom.

86. A. Gowers, *Gowers Review on Intellectual Property* (HMSO, 2006).

87. On searching the HM Treasury website the links to submissions for relevant TV companies and broadcasters are irretrievable.