

## High Court confirms TV formats can be protected as dramatic works

The High Court has confirmed that TV formats are arguably capable of being protected as dramatic works, as long as they contain, as a minimum, a sufficient number of distinguishing features connected in a coherent framework that can be repeatedly applied, so as to enable the TV show to be reproduced in recognisable form.<sup>1</sup> On the facts of this case, the features of the format for the game show *Minute Winner*, in which members of the public were to be chosen at random and given the chance to win a prize, were found to be commonplace and indistinguishable from the features of many other game shows. Accordingly, the claim of copyright infringement was dismissed at summary judgment.

### Background

The game-show format in this case was called *Minute Winner* and was developed and written by Derek Banner. The claimant, Banner Universal Motion Pictures Limited, an English company, was set up by Mr Banner in July 2015, and it was entitled to bring the claim as the assignee of the rights in the format.

The claimant contended that the document setting out the *Minute Winner* format was an original dramatic work within the meaning of sections 1(1)(a) and 3(1) of the Copyright, Designs and Patents Act 1988 (**CDPA**), in which copyright subsisted. It claimed that Mr Banner disclosed the information in the format document to one of the defendants, Swedish company Friday TV, at a meeting in 2005 in Stockholm, and in circumstances that gave rise to an obligation of confidence. The claimant alleged that, following the meeting, the defendants copied the format of *Minute Winner* and misused it worldwide, making specific reference to a similar show called *Minute To Win It*, which was broadcast by ITV2 in 2011 with the defendants' involvement.

The claimant alleged infringement of copyright, breach of confidence and passing-off. At a case management conference, the claimant applied to substitute three new defendants. Those three defendants applied for summary determination of the claim and/or for it to be struck out or stayed on the grounds that:

- (a) the format document did not qualify for protection as a copyright work;
- (b) the claimant was estopped from bringing the claim for breach of confidence, as the Swedish courts had already finally determined the matter; and
- (c) the claim for passing-off must fail because Mr Banner had no goodwill in the *Minute Winner* format in the UK.

### *Minute Winner* format

The title page of the format document described *Minute Winner* as a “Mini-format Game show” that could be a “Daily or weekly show” running for “one minute, or 30 minutes with several winnings”. The document described the show as a television programme in which “people are given one minute to win something” with the prizes to be “sponsored by firms/companies in exchange with advertisements” during the programme. Four examples were given under the heading “EXAMPLES OF WHAT PEOPLE CAN WIN”, such as:

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<sup>1</sup> *Banner Universal Motion Pictures Ltd v Endemol Shine Group Ltd* [2017] EWHC 2600.

## “ON THE STREET

A brand new car is parked on the street. The host randomly stops a by-passer and gives her/him a set of car keys. Within one minute the by-passer has to find the right key and open the car. The by-passer wins the brand new car if she/he succeeds before one minute is gone.”

Among the reasons why people might want to see the programme, the document referred to a “combination of luck and pure coincidence”.

### Decision

Mr Justice Snowden allowed the defendants’ application for summary judgment and dismissed all three claims.

#### Copyright claim

Snowden J first looked at the minimum requirements that must be met in order for copyright protection to subsist in a TV format as a dramatic work. Under UK copyright law, the requirement of originality is that the work must be an expression of the author’s own intellectual creation.<sup>2</sup> This does not mean that every constituent aspect of a work must be original, but the work must be taken as a whole, and can include parts that are neither novel nor ingenious. The expression “dramatic work” is not defined in the CDPA, but in the *Norowzian* case<sup>3</sup> the court held that it should be given its natural and ordinary meaning as “a work of action, with or without words or music, which is capable of being performed before an audience”. No episodes of *Minute Winner* were ever produced, and the issue was whether the “format” of a television game show or quiz show is capable of being protected by the law of copyright in the form of a format document in its own right, rather than by means of an actual recorded episode.

With few existing decisions relating to copyright in game-show formats, Snowden J referred to the Privy Council decision in *Green v Broadcasting Corporation of New Zealand*,<sup>4</sup> in which a claim to the copyright in the format for the *Opportunity Knocks* television talent show failed. In that case, the Privy Council held 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”. Snowden J also considered the opinion of the dissenting judge in the Court of Appeal in *Green*, who was of the opinion that, if material has recognisable structure or framework that imposes a shape on the constituent parts of the show, then it may qualify as an original literary or dramatic work.

While any genuine game show will always have some elements of spontaneity, Snowden J did think that it was arguable that the format of a television game show could, in theory, attract copyright protection as a dramatic work, provided that:

- (a) there are a number of clearly identified features which, taken together, distinguish the show in question from others of a similar type; and
- (b) those distinguishing features are connected with each other in a coherent framework that can be repeatedly applied so as to enable the show to be reproduced in recognisable form.

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<sup>2</sup> See, for example, *SAS Institute Inc. v World Programming Ltd* [2014] RPC 8.

<sup>3</sup> *Norowzian v Arks Ltd (No. 2)* [2000] EMLR 67.

<sup>4</sup> *Green v Broadcasting Corporation of New Zealand* [1989] RPC 700.

The format document, however, did not meet the required standards as it "did not identify or prescribe anything resembling a coherent framework or structure which could be relied upon to reproduce a distinctive game show in a recognisable form". The *Minute Winner* features were "commonplace and indistinguishable from the features of many other game shows". The concept of giving members of the public a chance to win a prize and to record their reactions "was entirely non-specific, inherent in the very nature of a television game show and entirely banal", and there was no realistic prospect that the claimant would persuade a court that the contents of the format document qualified for copyright protection. In any case, for Snowden J, it was clear that the claimant could not argue that a substantial part of its *Minute Winner* concept had been copied, as the two were different in every material respect.

#### Claim for breach of confidence

The claim for breach of confidence was based on the argument that the information contained in the format document was of a confidential nature, and that it was communicated to Friday TV by Mr Banner at the meeting in 2005. The defendants argued that the claimant (as successor in title) is barred from bringing this claim, as a decision was already made in Swedish proceedings between Mr Banner and Friday TV.

The claimant argued that the Swedish claim and the English claim were sufficiently dissimilar that cause-of-action estoppel could not operate. In the judge's view, while the claim for breach of confidence was not expressed in the exact same way as the claim brought under section 6 of the Swedish Trade Secrets Act, they were in substance the same claim and, as the Swedish courts already decided on the merits of Mr Banner's claim, he, and the claimant as his assignee, were barred by cause-of-action estoppel from pursuing a claim on the same facts for breach of confidence in England. Even if the claimant was not barred from bringing this claim, Snowden J considered the information in the format document too vague and insufficiently developed to qualify for protection as confidential information under English law.

#### Passing-off claim

As to the passing-off claim, the claimant argued that the *Minute To Win It* game shows were deceptively similar in their title and format to *Minute Winner*. The judge noted that, in order for a claim of passing-off to subsist in England, goodwill in the sense of actual clients or customers for the product in question must exist.<sup>5</sup> There was no evidence that Mr Banner ever made any sales of the *Minute Winner* concept to any customers in England, and the mention of *Minute Winner* on his website amounted at most to advertisement of *Minute Winner* as an available format. The suggestion by the claimant that Mr Banner had a reputation, never mind goodwill, in relation to the *Minute Winner* name or format was far-fetched in Snowden J's opinion.

#### **Comment**

Given the lack of case law on copyright subsistence in television formats, the main significance of this case is the High Court's acceptance that a format for a TV show is arguably capable of copyright protection as a dramatic work, to the extent that it is based on a written script and other documents recording its features as opposed to a recording of an episode of the format.

In the *Ukulele Orchestra* case,<sup>6</sup> in which copyright as a dramatic work was held not to arise in relation to elements of the way in which a ukulele orchestra presented itself and its performance, the court stated that, while not impossible, claiming any kind of copyright work as a format is difficult, and that

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<sup>5</sup> See *Starbucks (HK) Ltd v British Sky Broadcasting Group (No. 2)* [2015] 1 WLR 2628.

<sup>6</sup> *The Ukulele Orchestra of Great Britain v Clausen* [2015] EWHC 1772 (IPEC).

to succeed a claimant must base its case on particular copyright works – “in the case of dramatic works, fixed by some means of recording the performances”. If, however, no episodes of a show format have ever been recorded, such as in the case of *Minute Winner*, that presents a challenging problem for a claimant.

The test that Snowden J adopted for determining whether a TV format is capable of attracting copyright protection was whether its “distinguishing features are connected with each other in a coherent framework which can be repeatedly applied so as to enable the show to be reproduced in recognisable form”. This is similar to the commentary in *Copinger and Skone James on Copyright*,<sup>7</sup> as cited by the defendants, that: “There is no reason in principle ... why a format should not be protectable as a dramatic work if it contains sufficient record of how the show is to be presented ... A useful test ... is to ask whether, using the written script or other record as a basis, it is possible to present a coherent and meaningful show which is capable of being performed.”

The decision provides some much needed clarity and guidance on the protection of TV formats under English copyright law. In particular, the judge’s summary of the aspects that the format document was lacking to qualify for copyright protection serve as a useful pointer for format creators and owners of the level of detail that should be contained in any format bible. Production companies and format creators should develop as much of their format as possible and set this out in writing, such as in a detailed production bible along the lines of the document produced as evidence for the *Minute to Win It* programmes, which contained hundreds of contestant games presented and explained using stylised graphics.

The more detailed a format document is, the more likely it is to attract copyright protection as a dramatic work. This means that format creators should make sure to include the title, any catchphrases to be used, drawings of any visual props, and the running order of the programme, as well as any principal characters and suitable candidates to take part in the show.

Once a detailed format is created, format owners should aim to protect and register their format as far as possible. This may involve registering a copy of the detailed format at the Format Recognition and Protection Association (FRAPA), along with registering any titles, catchphrases and logos as trade marks and registering the relevant domain names.

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<sup>7</sup> *Copinger and Skone James on Copyright* (17th edn) at paragraph 3-93.