

How to protect your format



► **Inside**

The huge commercial value of Television formats

Why should you implement safeguards now?

Practical advice to protect your format

Good housekeeping - the Do's and Don'ts

Media and Entertainment at Lewis Silkin



Introduction

This paper is based on that extensive experience, and sets out a number of practical steps that you can take to make the protection of television formats easier for those that have invested substantial time and money in their creation. It is aimed not only to aid you in providing protection for your valuable creative output, but should you find yourself at the receiving end of a claim, then you will save a great deal of time, not to mention money on lawyers fees, by having all the relevant information to hand. This should also enable you to convince the other side early on that you will win any legal dispute which will hopefully shorten it. If not it should at least place you in the strongest possible position to win any legal proceedings.

The huge commercial value of Television formats

Several of the leading television formats have now grossed well over \$1million each, the American Idol format alone being valued at \$2.5 billion. There have been a number of estimates as the value of the global format business which show it is worth several billion dollars. These figures however represent only the income from the licensing of formats. It does not represent income from the broadcast of unlicensed copycat versionxs of original television formats.

Television formats are perceived as enjoying varying degrees of protection worldwide, partly because there is no specific statutory reference to television formats in any country that we know of. There is, however, a growing body of case law based on national copyright legislation which strongly indicates that a format will enjoy legal protection if it is both sufficiently original and has been developed into a detailed documentary form, which a court will then treat as a copyright work.

We have learned how to maximise your chances of your format gaining recognition by a court as a copyright work by advising clients in the television industry and conducting format rights litigation. This knowledge comes also through conducting format rights litigation, and in particular the disclosure process, we learn important lessons about what systems to have in place to ensure the best prospect of protecting your format.

Why should you implement safeguards now?

The success rate in legal actions brought against perceived format plagiarism on the grounds of copyright infringement is increasingly good, but those that have failed tend to be through a lack of evidence of an original creative process. This brings home the importance of implementing systems to protect your format early on in its development. This is vital because your commercial strength to exploit your format is directly proportional to your capacity to protect it.

To be in the strongest position either to prove that you were the originator and creator of a format so as to prevent copying by another, or to resist any claim by someone else that the rights in your

format belong to them, you need firstly to be able to show convincing evidence of how you created it. You need to be able to prove when the original idea began its journey to broadcast (or to whatever stage it has reached), and then evidence all the stages whereby it has become a fully fledged, and therefore protectable, television format.

By the same process, even if the format has some similarities with a rival format, if, rather than being a copy it can be shown to be the product of a genuine creative process then a copyright claim against it should fail. Without such evidence the court is likely to presume that copying has taken place. The time to start putting yourself in the strongest position to protect your hard work and investment is actually during the creative process.

Practical advice to protect your format

Put it in writing

Many ideas start life as a few spoken words, the orator of which goes un-noted, and then feels hard done by a year or so down the line. Put your idea in writing and develop all aspects of it as much as possible before giving, or showing it, to anyone.

Date and identify

Whether it is conception, modification, updating or adding ideas, make sure that the date, author and those responsible for the ideas being recorded (and which idea should be attributed to who) are noted every time.

Brand it

Develop a well defined brand identity for your format and reinforce it, where appropriate, with registered rights; titles and catchphrases may be registrable as word marks, and logos as figurative marks. In addition to trade marks, consider the registration of two-dimensional and/or even three-dimensional designs (in, for example, a set). Give thought as to the territories in which you intend to register your marks and/or designs, as this can prove to be expensive and practically, there may be no point in such registrations if you do not intend to enforce the resulting rights.



The key benefits of registration are:

- Carries with it the presumption of ownership.
- Creates a 'public' date fixing the creation of the work.
- Acts as a deterrent to potential imitators.
- Is an asset of the business.
- May give greater leverage over other partners.

If you have a format that you wish to protect then we can help advise you on the suitability and scope of protection offered by trade marks and/or registered designs.

Register it

You can deposit and register a copy of the format with an association such as FRAPA (see the link on the IFLA website at www.ifla.tv) with the date of receipt confirmed. Although this will not guarantee any copyright protection, if there is a dispute, it provides evidence of the date of the concept of the idea. It is also worth noting that FRAPA has also recently joined forces with the WIPO's Arbitration and Mediation Centre in providing alternative dispute resolution services in the television format sector.

Paint a picture

For game shows, chat shows and reality shows in particular, it is often the visual props and set that provide the attraction. For example, the set of "Who Wants to Be a Millionaire" is reproduced the world over and assists in creating the tension of the amphitheatre, as does the unmistakable "Countdown" clock. These should be reduced to a detailed illustration (if possible 3D) and include as many original elements to the design as possible to try to protect the look of the show as an artistic work under copyright.

Create a paper or e-trail

The creation of a format can be a long and complicated process. Often teams of individuals develop the format to fit, for example, network or budgetary requirements. Detailed and exact specifications of the elements of the format during the entire development process should be recorded for the best possible protection.

Make it

If the necessary funds exist, make a pilot for the programme incorporating all the essential elements of the theme and design as detailed above.

Keep it confidential

If you can, request that anyone who is to receive the format proposal signs a non-disclosure or confidentiality agreement before viewing the idea. If this proves impractical, make it clear at every opportunity that the information they are receiving is confidential and is not to be used without your authorisation. Marking your format bible with a "confidential" notice its cover and in headers on each page will emphasise the confidential nature of the work to readers.

Innovate it

Continual innovation of a branded format can keep it one step in front of imitators and maintain a loyal audience. It is not unusual for formats to continue to be developed even when they have aired successfully in one territory, for example because of cultural differences between territories or because the relevant television network in another territory demands it.

We know of a format that went from idea in the UK to production in the US so quickly (within 4 weeks) that had no ending. That was going to be dreamt up by any one, or combination of, the format creators, the producers, the production team or even the network, the UK owners were not sure. Although this is an extreme example, it is imperative that whoever adds an element to your format licences that element back to you so that you have the right to exploit the format in its entirety.

You should also consider extending in to other markets by developing format-related spin-offs such as mobile phone based applications and board games which in turn assist in reinforcing your format's presence. It will also reduce the danger of your format appearing as (for example) an iPhone App produced by a third party; something that happened to one of our clients until with our assistance the infringer was persuaded to desist.

Network it

As well as providing valuable feedback, viral marketing by the use of social networking sites can be a valuable way increasing the profile of, and goodwill in, your format (which in turn, will assist establishing one of the constituent elements in an action for passing-off). Negative feedback from "fans" on a copycat format may not only ultimately contribute to an imitator's failure, but is also useful in establishing damage to your format by an imitation in the event that legal proceedings ensue. However, ensure that marketing of your format only takes place once it has been broadcast, as disclosure before that stage is likely to lead to a loss of any confidentiality you may have had in it (see Keep it Confidential above).

Domain name it

If you have thought of a snappy title for your new programme, then register the corresponding generic and country code top level domains (such as ".com" and ".co.uk" respectively). Also, consider whether an unconventional use of a country code top level domain name could be appropriate. Examples include the widespread adoption in the industry of island of Tuvalu's country code top level domain ".tv", or, more creatively, Apple's registration of <http://www.itun.es>, using the Spanish country code top level domain, ".es".

Consider also registering relevant usernames on social networking sites (see Network it above). Prebroadcast registration of domain names and usernames can often be a pre-emptive measure to prevent squatting, but equally, make sure that you do not become a squatter.

Licence it

A format contract will provide better protection than the laws of intellectual property although this will only be binding between the contracting parties, not a third party. However, more importantly, the contract will give the buyer access to "know-how", that is the knowledge and expertise required to produce the programme.

A contract will also provide you with the opportunity to consider whether to incorporate various clauses, including those providing for the reference of all disputes under that contract to one of the WIPO dispute resolution procedures.



WIPO's Arbitration and Mediation Center may, in certain circumstances, be the appropriate forum to resolve disputes, thereby avoiding the delay, uncertainty and expense of legal proceedings, particularly in an international context. For existing disputes, parties may conclude a submission agreement providing for the reference of the dispute to WIPO.

Move it!

Once broadcast, the reality is that your format is likely to be immediately disseminated across the world via the internet, whether by legitimate or illegitimate means. Therefore, once a format has been aired in a given territory, do not give competitors an opportunity to copy it – take a proactive approach to getting your format to other territories as quickly as possible. Attendance at international trade fairs (such as MIPTV) may also assist in legitimising the originator of the format, and may well as providing a further opportunity to establish that an imitator had “direct access” to your format when seeking to establish that copying has taken place.

Make your creative team exclusive

Often it is the know-how that buyers of formats are after and they will pay more to work with the original team that created it. It is therefore advisable to sign exclusive agreements with the people who can provide that know-how.

Keep your house in good order

Keep a format bible containing as much detail and know-how as possible. Some format rights litigation has been based on the format bible, and starting from it as a literary work, seeks to bring an action on a rival format on the basis that it is an infringement of that copyright work. The kind of detail you should consider including is highlighted in the next point.

Details, details, details

The more information about the programme that you can reduce to written form the greater your chances of protecting the format as a literary work. Give a clear and detailed description of the show and its constituent elements during the entire development process.

The following information would be useful:-

- the title;
- sample scripts;
- principal characters, names, details of character, suitable candidates to play them;
- the set, setting or settings;
- the principal stage properties;
- the role of the presenter;
- any catchphrases that are intended to be used;
- the role of any participating professionals (e.g. psychologists, fitness experts, survival experts and a description of their role e.g. will they be seen on screen or will they just be commenting? If you have anybody suitable in mind note it);
- the role of any participating members of the public;
- the role of any celebrities;
- the notional “type” of celebrity e.g. political, mother figure, lothario; and,
- the order in which different parts or sections of the programmes are to run.

Good housekeeping - the Do's and Don'ts

Do

- Create a directory for the proposed programme that can be accessed by all the creative who are working on it.
- Structure the directory with relevant sub directories e.g. Format; Location; Games; Health & Safety; Scripts; Design etc.
- Save all the documents containing ideas regarding the format into the communal directory.
- Try to create in words, designs, diagrams, charts etc as expressions of your creative ideas – as the law protects the expression of ideas but not ideas themselves.

- Save/archive all emails referring to the format or programme, however tenuous the link, in the central directory.
- Date and identify the author of every single document.
- Record minutes of all format/“ideas” meetings and where possible make a note of how these have informed the development of the format.
- Number and date the format documents at every single stage of development.
- Track the changes to the original format and keep a record of what has changed, when it changed, why it changed and who was responsible.
- Keep a record whether a proposal to modify an idea has come from an internal or external (e.g. a network department) source.
- Keep an orderly hard copy file of all format proposals that have been submitted noting to whom and when; check they are dated correctly and that credit has been given.
- If you do not intend to look at a format proposal that has been submitted by post, do not open it – simply return to sender and make a record of the same.
- If you do intend to review it at a later stage (perhaps because of a back log), then leave it unopened in its sealed envelope and make a record of the date of receipt. Once opened, make a record of this date too.

Don't

- Delete any emails that are relevant to, refer to or could in any way be related to the format.
- Draw too many comparisons between your new format idea and formats that are already well known and established. Although it is useful to give potential purchasers an idea as to what type of programme to expect, it may aid an action against you for passing off. It is not an answer to a claim for copyright infringement to say that what has been copied is not unique to the Claimant, in considering whether there are similarities which support



the inference of copying, the fact that the similarities not only exist only at a high level of generality, but are also shared by works which preceded the copyright works relied upon, is a material factor that will be taken into account by the Court. If you need to draw comparisons, do it with as many programmes as possible rather than just one or two.

- Save new formats over old. Every time the document is amended (with the exception of e.g. spelling and grammar amendments) it should be given a new version number, dated and the author identified.

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Media and Entertainment at Lewis Silkin

For decades, Lewis Silkin has been one of the top advertising and marketing law firms in the country. We have unrivalled strength and depth within our team. We also have unparalleled experience of all aspects of advertising, marketing and brand work.

But we are not content with that. We are now on our way to becoming the top converged media practice in the country. Building on our traditional areas of strength, we have brought in experts in mobile, music, television, theatre, radio and other digital platforms, so that we can provide our 'converged' clients with a seamless 'one stop shop' for all their legal needs.

We have extensive experience of dealing with advertising and media industry regulatory bodies, including assisting clients with making or defending complaints and challenging regulatory decisions through their own appeal procedures or, when necessary, through litigation.

