

“I’ve Got This Great Idea for a Show…” – Copyright Protection for Television Show and Motion Picture Concepts and Proposals

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I. Introduction

While it may be trite to say that copyright does not protect ideas but only the expression thereof, it is nevertheless an axiom repeated as a mantra in Canadian jurisprudence and academic commentary.¹ Thorson P. gave a concise statement of the Canadian view when he stated “it is ... an elementary principle of copyright law that an author has no copyright in ideas but only in his expression of them. ... His copyright is confined to the literary work in which he has expressed them.”² In a world where the commercial value of intellectual property continues to become more fully appreciated and the enforcement of copyright is becoming increasingly vigorous, the distinction between idea and expression, the very contours of copyright protection, is being more carefully scrutinized. Canadian courts recently have been, and will undoubtedly continue to be, asked to address the “copyrightability” of “proposals”, “formats” and “concepts” in respect of television shows and movies. The inboxes of television and movie producers are regularly bombarded with proposals for television shows or movies (embodied, in industry parlance, in a number of guises, ranging from at the low end of length and descriptive depth a “synopsis” , “pitch”³, “treatment”⁴ or “outline” to, at the opposite end of the spectrum, full screenplays⁵). In addition, film and television producers cannot help but derive inspiration from the multitude of entertainment programming available. Producers, whether in their capacity as

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¹ See David Vaver, *Copyright Law* (Toronto: Irwin Law, 2000) at 30, 74; Sunny Handa, *Copyright Law in Canada* (Markham: Butterworths Canada Ltd., 2002) at 143.

² *Moreau v. St. Vincent*, [1950] Ex. C.R. 198, 3 D.L.R. 713 at 717.

³ A “synopsis” is typically described as the most basic distillation of a story or concept idea, a “brief, rough sketch of character and situation”, see J.D. Cohen, “Remedies for Misappropriation of Motion Picture and Television Story Ideas” (1985) 7 *Hastings Communications and Entertainment Law Journal* 85 at n. 5. The term “pitch” is often used as a verb to describe the act of verbally communicating the concept embodied in a synopsis or longer document, but can also be used as a synonym for a “synopsis”.

⁴ A “treatment” is a short-form document explicating the “adaptation of [an existing] story or literary material as a basis for a screenplay”; see M. Litwack, *Dealmaking in the Film & Television Industry* (Los Angeles: Silman-James Press, 1994) at 178.

recipients of submissions or viewers of extant copyrighted material, are well-advised to turn their mind to the range of protection (and attendant risk of litigation) which cloaks such submissions and pre-existing productions.⁶ With the rise of the phenomenon of “reality television” and game shows, a genre which has recently regained popularity, this question may be raised with more frequency: in the absence of pre-determined characters, plots or, in some cases, consistent settings, “reality” programming, especially at the submission stage, may consist of nothing more than a skeletal concept or format. Others have noted that the “literary content of a particular programme is perhaps no more important than the format or mode of presentation from which the series derives its basic structure.”⁷

The realities of commercial production of film and television programming require that the ideas developed by a single individual often must be disclosed to third parties in order to obtain the expertise, labour and financing necessary to turn “idea” into “production”. Those toiling at the opposite end of the process, whom for these purposes can be loosely termed “producers”, likewise rely on submissions from a large potential market in order to provide the raw material (a perhaps inelegant manner of referring to “intellectual property”) to be turned into productions. Once an “idea” has been rendered as a finished product and broadcast or exhibited to the wider world, the potential for unauthorized infringement is well known. Each party to the process of submission, development and production needs to be apprised of their rights with respect to “ideas”, “concepts” or “formats”.

⁵ A screenplay is a long-form “final script with scenes, dialogue and camera setups” (a “screenplay” for television production is sometimes referred to as a “teleplay”); see Litwack, *supra* note 4 at 178.

⁶ As reported by the Associated Press on March 28, 2003, a New York screenwriter sued, among others Walt Disney Co., and actress/producer Queen Latifah, alleging the movie “*Bringing Down the House*” infringed copyright in a script entitled “*Amoral Dilemma*”, with the screenwriter alleging that she had originally conceived of the idea of a lawyer meeting an inmate over the internet, and the inmate subsequently wreaking havoc in the lawyer’s life; see http://www.thestar.com/NASApp/cs/ContentServer?pagename=thestar/Layout/Article_Type1&c=Article&cid=1035780068659&call_pageid=968332188492&col=968705925735

The analysis and commentary contained in this paper focuses on the basis of copyright protection under Canadian law for “short-form” submissions of concepts for television and feature film productions. The general protection afforded to pre-existing “formats” (especially in the context of television shows), a tangential topic that shares space with the “submission of idea” scenario, will also be considered. Given the relative paucity of Canadian caselaw on the subject, a brief review of United States decisions is provided, as well as more detailed analysis of a set of New Zealand decisions which, in the fulsome discussion provided by the courts therein, offer some cautionary examples of judicial reasoning applied to the topic at hand.

II. Framework for Protection

a. The *Copyright Act*

Pursuant to section 5(1) of the *Copyright Act*,⁸ copyright subsists in “every original literary, dramatic, musical and artistic work”, provided that certain specified nationality and residency criteria are met.⁹ The type of written submission considered herein (the aforementioned written pitch, outline, treatment or screenplay) falls within the inclusive definition provided in the *Copyright Act* for “literary work”,¹⁰ as it has been held that the term covers “everything expressed in print or in writing”.¹¹ There is also Canadian authority holding that concepts and formats can qualify as “dramatic works”.¹² As submissions or “scripts” for existing television shows may be relatively abstract distillations of an “idea”, offering only

⁷ Robin Meadaw, “Television Formats – The Search for Protection” (1970) 58 California Law Review 1169 at 1170 cited in *Green v. Broadcasting Corporation of New Zealand*, [1988] 2 N.Z.L.R. 490 at 534 (C.A.).

⁸ *Copyright Act*, R.S.C. 1985, c. C-42, as amended.

⁹ See *Copyright Act*, s. 5(1). The broadest category of the residency/citizenship requirement, found in subsection 5(1)(a) of the *Copyright Act*, is that “the author was, at the date of the making of the work, a citizen or subject of, or a person ordinarily resident in, a treaty country”; “treaty country” is defined in section 2 to mean countries party to the Berne Convention, the Universal Copyright Convention or members of the World Trade Organization.

¹⁰ Section 2 of the *Copyright Act* provides that “‘literary work’ includes tables, computer programs, and compilations of literary works”.

¹¹ Vaver, *supra* note 1 at 33; see also *Apple Computer Inc. v. Mackintosh Computers Ltd.* (1987), [1988] 1 F.C. 673 (C.A.), *aff’d* [1990] 2 S.C.R. 209.

sketches of structure, character, setting or incident, it can be important to confirm that copyright protection is not predicated on the aesthetic qualities of the work. Considerations of literary or artistic merit are irrelevant for the purpose of determining whether copyright protection is afforded to the submission;¹³ as noted by the Federal Court of Appeal, “the sole distinguishing characteristic of a literary work ... [is] that it be in print or writing”.¹⁴

b. Fixation and Originality

The determination that a submission is afforded copyright protection is, however, merely a threshold determination: the more salient concern is the nature, or extent, of the protection. The concepts of “fixation” and “originality” are useful and necessary mechanisms for defining what is protected, or put another way, the extent to which the expression of an “idea” is protected. The “fixation” requirement for copyright protection is not an explicit general statutory requirement for protection,¹⁵ but is a judicially developed¹⁶ threshold criterion for determining the characteristics of the submission as a “work”, and hence forms the initial inquiry for ascertaining the scope of protection afforded thereto.¹⁷ The fixation principle requires expression “in some material form, capable of identification and having a more or less permanent endurance”.¹⁸ It is the material form of the work that forms the basis from which the range of protection is determined. It has been recognized that an element of substantiality also must attach to the work itself; hence, copyright protection is not conferred on single words,

¹² *Arbique v. Gabriele*, [1998] A.Q. no. 3794 at paras. 81, 83 (C.S. Civ.), aff'd [2003] J.Q. no. 85 (Que. C.A.).

¹³ See *University of London Press, Ltd. v. University Tutorial Press, Ltd.*, [1916] 2 Ch. 601 at 608 [*University of London Press*].

¹⁴ *Apple Computer Inc. v. Mackintosh Computers Ltd.* (1987), 44 D.L.R. (4th) 74 at 90 (C.A.), aff'd [1990] 2 S.C.R. 209.

¹⁵ For certain types of work, e.g., “dramatic work” and “computer program”, the “fixation” requirement is contained in the statutory definition thereof, see *Copyright Act*, s. 2.

¹⁶ See Vaver, *supra* note 1 at 63ff; Handa, *supra* note 1 at 234ff; and see *Canadian Admiral Corp. v. Rediffusion Inc.*, [1954] 20 C.P.R. 75, [1954] Ex. C.R. 382 [*Canadian Admiral* cited to C.P.R.].

names or titles.¹⁹ Since the circumstances of the submission of a television or movie concept under consideration herein consists of written material (and may include artistic works, *e.g.*, in the form of character designs in the case of an animated series), the obtaining of the fixation condition can be implied and assumed. The more important issue is the contours of the expression, that is, the level of detail about the features of the proposed show or movie incorporated in the submission. The more fully-developed the submission, the more plausible the argument becomes that the ephemeral “idea” has been “fixed” in some cognizable form and hence is the subject of an expansive copyright. A greater degree of specificity in a submission can serve a valuable evidentiary purpose in the event that allegations of infringement is raised: then nature of the work is more particularly defined, which can be helpful for courts in performing their infringement analysis, since, as will be seen, the analysis comprises a tabulation and comparison of “features”. Fixation acts together with the concept of “originality” to permit courts to describe the scope of protection afforded to a work.

Section 5 of the *Copyright Act* provides that “copyright shall subsist ... in every *original* literary, dramatic, musical and artistic work” [emphasis added]. The source of much jurisprudential and academic brow-furrowing, the state of the originality requirement is currently in flux, due to the potentially divergent standards found in the Federal Court of Appeal’s decisions in the *Tele-Direct (Publications) Inc. v. American Business Information, Inc.*²⁰ and *CCH Canadian Ltd. et al v. Law Society of Upper Canada*²¹ cases.²² The tension between the

¹⁷ As noted by Professor Vaver, the fixation requirement “add[s] some certainty to the law” (Vaver, *supra* note 1 at 65); in the case of submissions and formats, where the divide between idea and expression may be difficult to discern, mechanisms providing certainty are to be favoured.

¹⁸ *Canadian Admiral*, *supra* note 16 at 86.

¹⁹ See, *e.g.*, *Francis Day & Hunter Ltd. v. Twentieth Century Fox Corp.*, [1939] 4 D.L.R. 353 at 358-9 (P.C.) aff’d [1938] 3 D.L.R. 375 (Ont. C.A.).

²⁰ *Tele-Direct (Publications) Inc. v. American Business Information, Inc.* (1997), 76 C.P.R. (3d) 296, [1998] 2 F.C. 22 (F.C.A.), leave to appeal refused [1998] 1 S.C.R. xv [*Tele-Direct*].

²¹ *CCH Canadian Ltd. et al v. Law Society of Upper Canada*, [2002] 4 F.C. 213 (F.C.A.) [*CCH*].

two authorities lies in whether “originality” requires mere “effort” or “industriousness” (*i.e.*, the effort expended in creating the work) or whether “imagination or creative spark” is also a necessary component. The *Tele-Direct* decision appears to favour the latter, while the *CCH* decision indicates a preference for the former. The distinction between the two tests is not always clear, but can play a role in determining the scope of protection afforded to submissions and formats. If the “sweat of the brow” doctrine of *CCH* is adopted, the standard is very much lower, and becomes virtually indistinct from the fixation requirement; the words of Judson J. in *Kilvington Bros. Ltd. v Goldberg* are instructive: “novelty and inventiveness are not the tests of originality in the law of copyright. The test is whether ... it is the original expression of thought of its originator, that it originated from him and that he did not copy it”.²³ In short, so long as the “work” has not been copied and has been expressed in some tangible form (*i.e.*, “fixed”), the originality condition is met. This “sweat of the brow” doctrine was, until recently, accepted in large part in Canadian jurisprudence.²⁴ The introduction of uncertainty, both in which test is applicable and what precisely the distinction is between the two, has been reflected, though not expressly, in Canadian cases concerned with copyright in television show submissions and concepts. The *Arbique* decision, after setting out various authorities for the “sweat of the brow” doctrine, states that “[translation] the work of the plaintiffs complies with the originality criteria [of the *Copyright Act*] [...] [i]n effect, it is the result of their efforts”,²⁵ perhaps as concise an application of the doctrine as is possible. However, the subsequent sentence holds that various elements of the allegedly infringed television series concept (including the title, the didactic

²² The term “potentially” is used advisedly because it is unclear whether the *Tele-Direct* standard, *supra* note 20 and accompanying text, is limited to compilations of data, see *Hager v. ECW Press Ltd.* (1998), 85 C.P.R. (3d) 289 (F.C.T.D.).

²³ *Kilvington Bros. Ltd. v Goldberg* (1957), 16 Fox Pat. C. 164 at 167 (Ont. S.C.).

²⁴ See Handa, *supra* note 1 at 211ff.

objective, the use of a host, a panel of “experts” and viewer participation) of the show are sufficiently “distinctive” to ensure “originality”²⁶, which appears to import the requirement that each component of the concept exhibit the characteristic of “distinctiveness”, a holding which would append more to the “sweat of the brow” doctrine than has traditionally been required. The contrary, and more traditional, view was expressed in the trial and appellate decisions of *Hutton v. Canadian Broadcasting Corp.*,²⁷ which noted that, though the components of the allegedly infringed work were unoriginal, the mere arrangement of such components was sufficient to meet the “originality” requirements of the *Copyright Act*.²⁸ The New Zealand cases described below²⁹ also appear to prefer the “sweat of the brow” approach, deeming a production schedule to be sufficiently “original” to attract protection. Because submissions and formats of existing productions will be the result of creative activity (as distinguished from the potentially mechanical activities which may give rise to data compilations) the better position is to acknowledge the applicability of the “sweat of the brow” doctrine for purposes of ascertaining the “originality” of the work, and permit other mechanisms to perform the function of determining whether certain *components* of the format or proposal are unprotected (*e.g.*, the doctrine of *scènes a faire* or the “substantial similarity” component of the infringement analysis, both of which are discussed below).

c. Idea/Expression

The foregoing discussion of fixation and originality has not remarked upon an important element of copyright law, an element which in large part provides the dynamic informing the

²⁵ *Arbique*, *supra* note 12 at para. 84. The original text: “Le Tribunal est également d’avis que l’oeuvre des demandresses répond aux critères d’originalité requis par la Loi sur le droit d’auteur. En effet, elle est le resultat de leurs efforts.”

²⁶ *Ibid.*

²⁷ *Hutton v. Canadian Broadcasting Corp.* (1989), 29 C.P.R. (3d) 398 (Alta. Q.B.) [*Hutton (Trial)*], *aff’d* (1992), 41 C.P.R. (3d) 45 (Alta. C.A.) [*Hutton (Appeal)*].

²⁸ *Hutton (Trial)*, *supra* note 27 at 445; *Hutton (Appeal)*, *supra* note 27 at 47.

theory and application of fixation and originality. A fundamental animating principle of Canadian copyright law is that “ideas” are not proper subjects for legal protection;³⁰ in Canadian and English jurisprudence this is cast as a policy imperative, an expression of the negative economic, moral and creative results thought to obtain when an overly rigorous scheme of protection is applied to what is viewed as better available to all.³¹ It is difficult to stand on the shoulders of giants if those shoulders are clad by armoured spikes which discourage loitering. Hence, the words of Thorson P. in *Moreau v. St. Vincent* affirming that protection is conferred on “expression” only,³² words subsequently echoed (in tenor if not in particular) in intellectual property jurisprudence from Canada to New Zealand, through the United States and the United Kingdom. The shorthand description of this concept is the “idea/expression dichotomy”,³³ in its application a mechanism for balancing incentives to create/produce with the public interest writ large, by “distinguishing a private domain of copyright protection ... from a public domain in which there is an unfettered right to use the ideas contained in creative works”.³⁴ Considerable intellectual effort has been expended in attempting to define the component parts (idea and expression) of this debate and to define where the line is to be drawn between the two. As described above, this chronic question of copyright law becomes acute when dealing with television and film submissions, especially those exhibiting low levels of descriptive detail.

²⁹ See Part V herein.

³⁰ See *supra* notes 1 and 2 and accompanying text.

³¹ See *Sayre v. Moore* (1785), 102 E.R. 139 at 140: “We must take care to guard against two extremes equally prejudicial: the one that men of ability, who have employed their time for the service of the community may not be deprived of their just merits and reward for their ingenuity and labour; the other that the world may not be deprived of improvements nor the progress of the arts be retarded.”

³² *Supra* note 2.

³³ Handa, *supra* note 1 at 143.

³⁴ Allen Rosen, “Reconsidering the Idea/Expression Dichotomy” (1992) 26 U.B.C.L. Rev. 263 [Rosen, “Reconsidering”].

The idea/expression dichotomy is sometimes manifested as the fixation requirement discussed above;³⁵ that is to say, while the oral expression of an idea (*e.g.*, a show involving a camera following around a couple on a first date) will not attract copyright protection, a twelve-page written proposal outlining the same concept with proposed settings, scenarios, specific dialogue, an elaborate set for the show's host, *etc.*, will. However, the fixation criterion is binary (*i.e.*, either there is a fixed form, or there is not), and while it creates a threshold test for the question of whether copyright subsists, it fails to address the essential issue at question when dealing with submissions and show formats or concepts: *what*, exactly, is protected? In the argot of the dichotomy, what is unprotected "idea" and what is protected "expression"? Assuming all other criteria for a finding of infringement are met, a subsequent television show that contains reproductions of the exact dialogue, set, scenarios and even similar "intangible" elements such as lighting, music and tone, contained in an already existing television show may be found to be an infringement.³⁶ Results are more difficult to ascertain when the allegedly infringed work is, for example, a one-page synopsis.

d. The *Altai* Test

American intellectual property jurisprudence has long struggled with identifying the demarcation point between idea and expression, and Canadian courts have likewise averred to the problem; Learned Hand's conclusion that "[n]obody has ever been able to fix that boundary, and nobody ever can"³⁷ was sympathetically acknowledged in *Delrina Corp. v. Triolet Systems Inc.*³⁸ While perhaps no bright-line test is advisable or possible,³⁹ American courts have

³⁵ See *supra* note 15 and accompanying text.

³⁶ *Cf.* the decision in *Productions Avanti*, *infra* note 94 and accompanying text, where the court found that infringement had occurred based on even less material being copied.

³⁷ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930).

³⁸ *Delrina Corp. v. Triolet Systems Inc.* (1993), 47. C.P.R. (3d) 1 (Ont. Gen. Div) [*Delrina*].

³⁹ See, generally, Rosen, "Reconsidering", *supra* note 34 at Part D.

developed a useful three-stage test for discerning idea from expression: the abstraction/filtration/comparison test delineated in *Computer Associates International, Inc. v. Altai, Inc.* (referred to herein as the “*Altai* test”)⁴⁰ This involves analyzing the allegedly infringed work and determining its constituent parts, then “filtering” each identified part for public domain materials and *scènes a faire* to “sift out” non-protectable materials, and finally comparing the remaining “protected” expression with the allegedly infringing work.⁴¹ While the *Altai* test was developed in the context of alleged infringement of copyright in computer programs, and has only been explicitly adopted by Canadian courts in the same context,⁴² essentially the same analysis has been undertaken by Canadian courts where copyright in a television show concept has been allegedly infringed, as in the *Hutton*⁴³ and *Productions Avanti*⁴⁴ cases, discussed below, where the courts have tallied up the constituent parts of the infringed and infringing programs, set aside those which are unprotected, and proceeded to “score” the remaining comparisons. The *Altai* test, as shown by the courts use thereof, provides a useful and relatively predictable, or at least stable, mechanism for ascertaining the extent to which elements of a submission are the subject of copyright protection. At the very least, application of the test promotes a certain rigour in judgments by forcing courts to examine, component by component, the assumptions underlying the determination of whether or not copyright subsists. Given that judges, who may not have available to them refined or comprehensive criteria by which to judge whether allegedly copied elements should in fact be the subject of protection, the development of a corpus of decisions on the subject can offer predictive stability and hence guidance for those submitting proposals and

⁴⁰ *Computer Associates International, Inc. v. Altai, Inc.*, 23 U.S.P.Q.2d. 1241 (2d Cir. 1992) [*Altai*].

⁴¹ *Ibid.* at 1252-1253.

⁴² See e.g., *Delrina*, *supra* note 37.

⁴³ *Supra* note 27. See the discussion herein at Part IV.a., below.

⁴⁴ *Supra* note 12. See the discussion herein at Part IV.c., below

for those seeking to produce new works (*i.e.*, they will be able to determine whether what they are submitting or creating is the subject of protection or is potentially an infringement).

e. Merger and *Scènes a Faire*

Two closely-related doctrines deserve consideration for their potential relevance to the questions raised herein regarding “concepts” and “formats”: the doctrines of merger and of *scènes a faire*. The *scènes a faire* doctrine provides that “where elements of a work are necessarily incorporated into the expression of the work ... copyright protection will not be granted.”⁴⁵ In a U.S. case involving allegations of infringement of copyright in the film “*Star Wars*” by the television series “*Battlestar Galactica*”, the court explained the doctrine this way:

“A certain type of scene, or a certain situation of standard characters vis-à-vis each other becomes so commonplace, so customary, that it is almost always found – and the viewer or listener almost always may expect to see or hear it whenever the [work] deals with a given topic, or involves [a] certain genre ... a “*scènes a faire*” which is a standard, common, expectable treatment or happening is not protectable ... [i]t is in the public domain.”⁴⁶

In short, “*scènes a faire*” refers to incidents, characters or settings that are, as a practical matter, indispensable or standard in the treatment of a subject, setting or genre; *e.g.*, a “showdown” at high noon between gunfighters is not a protectable element of a western. While recognized in

⁴⁵ Handa, *supra* note 1 at 146.

⁴⁶ *Twentieth Century Fox Film Corp. v. MCA Inc.*, 209 U.S.P.Q. (BNA) 200 at 207 (C.D. Cal. 1980), quoting *Alexander v. Haley*, (1979) 460 F.Supp. 40 (S.D.N.Y.). In the recent case of *Sony Pictures Entertainment Inc v. Fireworks Entertainment Group Inc.* (CD Cal 04/05/2001), the court, applying the *scènes a faire* doctrine to dismiss an infringement claim brought in respect of a television series revolving around the “Zorro” concept and characters, held that many of the plotlines and incidents alleged to be infringing were unprotected: *e.g.*, one character’s arrival by ship was a necessity, given the historical fact that ship was the only method of intercontinental travel in the 19th century, and the “mood” and “pace” were adjuncts of the action/adventure genre.

U.S. copyright jurisprudence,⁴⁷ *scènes a faire* has found little traction in reported Canadian cases.

The doctrine of merger is applied to situations where it is said that a particular idea can only be expressed in a single manner, or an extremely limited number of forms. Allowing protection of the expression would effectively extend the copyright monopoly to the idea itself, a notion, as discussed previously, anathema to traditional copyright jurisprudence. The cases of *Morrissey v. Procter and Gamble*⁴⁸ and *Herbert Rosenthal Jewellery v. Kalpakian*⁴⁹ offer typical examples of the merger doctrine at work: in the former, the court concluded that written sweepstakes rules can only be expressed in a small number of forms, and hence are not subject to copyright protection; in the latter, the court rejected the plaintiff's allegations of infringement due to similarities between his and the defendant's jeweled bee pins. The merger doctrine has not been without criticism in the United States, and the Federal Court of Canada in *Apple Computer Inc. v. 115778 Canada Inc.*,⁵⁰ echoed this when it declined to apply the doctrine.

Both *scènes a faire* and merger are subsumed in the "filtration" step of the *Altai* test, offering a device to limit the scope of protected elements of a television or movie concept or submission. There has been trenchant criticism of both doctrines,⁵¹ primarily for being largely a mask for juridical predispositions, *i.e.*, for allowing courts to cloak in the trappings of a philosophically sound test their pre-determined conclusions as to whether or not to provide protection. To the extent this is true, it is a criticism that can be levied with equal effectiveness against a host of legal theories and tests, ranging from human rights jurisprudence to the

⁴⁷ See, *e.g.*, *Gates Rubber Co. v. Bando Chemical Industries, Ltd.*, 9 F.3d 823 (10th Cir. 1993); *Ets-Hokin v. Skyy Spirits, Inc.* No. 98-17072, 2000 U.S. App. LEXIS 20916 (9th Cir. Aug 18, 2000).

⁴⁸ *Morrissey v. Procter and Gamble*, 379 F.2d 675 (1st Cir. 1967).

⁴⁹ *Herbert Rosenthal Jewellery v. Kalpakian*, 446 F.2d 738 (9th Cir. 1977).

⁵⁰ *Apple Computer Inc. v. 115778 Canada Inc.*, [1987] 1 F.C. 173 (T.D.)

⁵¹ See, *e.g.*, Rosen, "Reconsidering", *supra* note 34.

intricacies of administrative law regarding judicial review. The better view, in light of the relative adolescence of Canadian copyright caselaw on the points under consideration herein, is to adapt, and adopt, from both doctrines those tools needed to permit courts the flexibility to determine whether infringement has occurred.⁵² There has also been criticism of the general trend of copyright law to be over-inclusive in according protection by means of lowering the threshold of the originality requirement.⁵³ As Professor Vaver has articulated the argument (for the purposes of critiquing it, as he is generally in favour of confining the scope of copyright protection), “overprotection” would be balanced by a “sliding scale of infringement”: the less fulsome the expression in the allegedly infringed work, the more exact the copying must be in order to support a finding of infringement.⁵⁴ The *Altai* test and the doctrines of merger and *scènes a faire* afford an articulated mechanism for achieving this. *Scènes a faire* and merger permit courts to restrict certain elements from protection, without the need to force a philosophically unwieldy apparatus onto the “originality” analysis, and without being forced to make the “fixation” requirement unintelligible by expanding it from a binary requirement into a more nuanced test. Undue emphasis on “fixation” can give rise to results such as that found in the Privy Council decision in *Green v. Broadcasting Corporation of New Zealand*, discussed in Part V.b. hereof, where the court deemed “fixed” expressions of ideas to in fact not be sufficiently “fixed” at all.

III. Infringement Analysis

Copyright is a creation of statute, and the *Copyright Act* delineates the core of the property right as “the sole right to produce or reproduce the work or any substantial part thereof

⁵² See Handa, *supra* note 1 at 150.

⁵³ See Vaver, *supra* note 1 at 60.

⁵⁴ Vaver, *supra* note 1 at 60.

in any material form whatever”.⁵⁵ Included in the bundle of rights comprising “copyright” is the sole right “in the case of any ... work, to reproduce, adapt and publicly present the work as a cinematographic work”.⁵⁶ If a submission forms the basis of an unauthorized television show or movie based thereon, the author’s exclusive right to adapt the work as a cinematographic work may be infringed;⁵⁷ if a completed production is the basis for an infringing production, the author’s right to authorize the reproduction of all or a substantial part of the work may be infringed.

As provided in the *Copyright Act*, the basic act of infringement (often referred to as “primary infringement”)⁵⁸ involves a person doing any activity, without the consent of the owner, which is within the ambit of the exclusive rights granted by the *Copyright Act* to the copyright owner.⁵⁹ The framework of the infringement analysis contains two conditions precedent: ownership of copyright by the plaintiff and unauthorized copying (or performing in public, communicating to the public or publishing) by the defendant.⁶⁰ A concise formulation of the infringement analysis was offered by the Alberta Court of Appeal in the *Hutton*⁶¹ case, a case concerning alleged infringement of copyright in a television show format: “To show infringement of these rights [referring to section 3(1) of the *Copyright Act*] there must be proof of substantial similarity and copying”.⁶² The “copying” element of the analysis requires

⁵⁵ *Copyright Act*, s. 3(1).

⁵⁶ *Ibid.*, s. 3(1)(e).

⁵⁷ The rights found in ss. 3(1)(d) (“... to make any ... cinematographic film or other contrivance by means of which the work may be mechanically reproduced or performed”) and 3(1)(f) (“to communicate the work to the public by telecommunication”) may also form the basis of an infringement claim in the scenario under consideration.

⁵⁸ As distinguished from the heads of “secondary infringement” found in s. 27(2) of the *Copyright Act*.

⁵⁹ *Copyright Act*, s. 27(1).

⁶⁰ See Handa, *supra* note 1 at 260; also see R.T. Hughes and S.J. Peacock, *Hughes on Copyright and Industrial Design*, 2003 Student Edition (Markham: Butterworths, 2003) §44.

⁶¹ *Supra* note 27.

⁶² *Hutton (Appeal)*, *supra* note 27 at 48, quoting *Francis Day & Hunter v. Bron*, [1963] 2 All E.R. 16 at 27 (H.L.) [*Francis Day*].

demonstration of a “causal connection” between the two works.⁶³ This connection is a factual determination proved by showing the defendant had “access” to the infringed work.⁶⁴ Upon proof of “substantial similarity” and access, copying is inferred; the inference of copying can be “rebutted by proof of independent creation”.⁶⁵

In the case of a written story idea or concept submission, the “ownership” question subsumes the issues of the copyrightability of the work (including the issues of its originality and fixation). Once the existence of copyright in the work is established, attention can turn to the question of whether there is “copying”, as described above, and whether such copying is unauthorized⁶⁶; the more problematic component of the test is that addressing whether the copying has been of a “substantial part”. While “literal” copying may be relatively easy to identify in certain circumstances (*e.g.*, the photocopying of a chapter from novel, or in the case of a screenplay, the word-for-word reproduction of an entire scene including dialogue, or the use of actual footage from a prior cinematographic work), certain types of submission may not lend themselves to such easy determination. As the point on the scale of idea/expression trends more towards “idea”, the quantitative analysis becomes more difficult. The question of what constitutes a “substantial part” is drawn in stark relief when dealing with submissions and show

⁶³ See Handa, *supra* note 1 at 262; also see *Francis Day*, *supra* note 62 at 27: “... the copyright work must be the source from which the infringing work is derived.”

⁶⁴ As will be shown in the discussion of the caselaw at Sections IV and VI of this paper, it is often the case that a plaintiff is unable to discharge their burden of proof on this point, and that infringement cases fail as a result.

⁶⁵ See Handa, *supra* note 1 at 262, and *Hutton (Appeal)*, *supra* note 27 at 48.

⁶⁶ Because there is perceived to be potential value in the exploitation of television and film productions, it can be generally assumed that no one submits a television show or movie idea without the implicit understanding that they will receive some form of remuneration in exchange for the granting of the right to adapt the submission into a film or television production. Certainly the mere act of submission cannot be taken as proof of consent to exercise the adaptation right, and courts have expressed the notion that the granting of consent requires a degree of formality and explicitness (see *Bishop v. Stevens* (1985), 4 C.P.R. (3d) 349 at 362, and *Blue Crest Music Inc. et al. v. Canusa Records Inc. et al.* (1974), 17 C.P.R. (2d) 149) Nevertheless, those submitting proposals would be well advised, in order to make clear the factual basis of any potential claim, to explicitly state (*e.g.*, in their covering letter) that no use of the submission may be made without their prior written consent (a common example: No part of this work may be reproduced or transmitted in any form or by any means, without the prior written permission of [the author].).

formats. The inherent lack of certainty regarding the application of the “substantial similarity” component of the infringement test was ruminated over by the trial court in *Preston v. 20th Century Fox Canada Ltd.*, noting that “there appears to be a dearth of Canadian jurisprudence on the test”.⁶⁷ The *Preston* court developed a description of the factors to be considered in the analysis, based partly on the earlier trial decision in *Hutton*, and also on United States caselaw; the use of these factors in cases regarding alleged infringement in formats and submissions was subsequently echoed in the appellate decision in *Hutton*⁶⁸ and confirmed by the Quebec Court of Appeal in *Arbique*.⁶⁹

Put simply, determining what constitutes “substantial” reproduction of a submission or format is both a qualitative and quantitative exercise.⁷⁰ It is an aggregate or *gestalt* assessment of the elements of the two works viewed both individually and as integral parts of a whole. The *Preston* factors include “plot, themes, dialogue, mood, setting or scenes, pace, sequence and characters”,⁷¹ and the standard to be applied is that “whether the average lay observer, at least one for whom the work is intended, would recognize the alleged copy as having been appropriated from the copyrighted work”.⁷² The analysis, such as it is (and must be), inevitably meanders into a qualitative exercise, and courts are forced to rely on largely inarticulable judgments about whether particular elements resemble each other, and whether such elements form a “substantial” part of the allegedly infringed work. Because of this lack of precision in the analysis, it is advisable for courts to use the *Altai* test, with the expanded components of merger and *scènes a faire*, as argued for herein, to at least provide some sense of discipline to what

⁶⁷ *Preston v. 20th Century Fox Canada Ltd.* (1990), 33 C.P.R. (3d) 242 at 273 (F.C.T.D.), aff’d 53 C.P.R. (3d) 407 [*Preston*].

⁶⁸ *Supra* note 27; see also discussion herein at Part IV.A.

⁶⁹ *Supra* note 12; see also discussion herein at Part IV.B.

⁷⁰ *Hutton (Appeal)*, *supra* note 27 at 50; see also *Hutton (Appeal)* at 48: “The requirement of substantial similarity must be apparent when viewing the works as a whole”.

⁷¹ *Supra* note 67 at 274.

otherwise could be an entirely subjective and unpredictable exercise. Canadian courts, as demonstrated in *Hutton*,⁷³ *Preston*,⁷⁴ *Productions Avanti*⁷⁵ and *Arbique*⁷⁶ have thus far done a commendable job in attempting to formalize their analysis by abstraction and comparison; this should be recognized, developed and encouraged.

IV. Canadian Case Law

a. *Hutton v. Canadian Broadcasting Corp.*

*Hutton v. Canadian Broadcasting Corp.*⁷⁷ provides one of the few examples in Canadian jurisprudence of alleged copyright infringement of a television show format being judicially considered. The plaintiff conceived of a half-hour television production entitled “*Star Chart*” which was submitted to and accepted by the Canadian Broadcasting Corporation (CBC). Nineteen episodes of the show were co-produced by the plaintiff and defendant, with the plaintiff retaining copyright in the program. “*Star Chart*” consisted of a “countdown” presentation of popular music videos. A major component of the “*Star Chart*” format consisted of a set described on-screen as “Music Central”, a “high tech” console covered with rows of switches, screens and flashing lights; the host, along with two female assistants, would be present at “Music Central”, and, over the course of the show, would “collect” incoming information regarding current music chart information which would in turn determine the videos to be played. Three years after the cancellation of “*Star Chart*”, the CBC produced and aired a series entitled “*Good Rockin’ Tonite*” (hereinafter “*GRT*”) consisting of one-hour episodes. The host of “*Star Chart*”, Terry David Mulligan, was recruited to be the host of “*GRT*”, which also had as

⁷² *Ibid.*

⁷³ *Supra* note 27; see also discussion herein at Part IV.a.

⁷⁴ *Supra* note 67.

⁷⁵ *Infra* note 94; see also discussion herein at Part IV.c.

⁷⁶ *Supra* note 12; see also discussion herein at Part IV.b.

⁷⁷ *Supra* note 27.

its primary element a “countdown” of popular music videos. Absent from “GRT” was the “Music Central” conceit and attendant activity; instead, the program contained, in addition to the “countdown” and playing of current videos, interviews with music celebrities, as well as trivia contests and on-air readings of letters received from viewers.

The plaintiff asserted that the CBC had infringed copyright in the format of his show by using the same “components”: including, *inter alia*, the same host, the notion of the host “introducing” videos with relevant patter, the concept of a “countdown” and the use of certain “devices” (such as certain types of on-screen effects and audio performances). There were no allegations that actual footage from “*Star Chart*” was used on “GRT”, nor that any actual “*Star Chart*” dialogue was copied. Instead, the alleged infringement arose purely from the “copying” of the show’s “format” or “concept”. In a manner similar to the *Altai* abstraction/ filtration/ comparison test,⁷⁸ the trial decision sets forth in considerable detail the “component” parts of “*Star Chart*”, extracts those elements that are not protected and finally engages in a qualitative and quantitative measuring of the amount of copying which occurred (including, noting that “numerically the similarities ... exceed the dissimilarities ... [however] the similarities [are] relatively unimportant in the context of copying”).⁷⁹ In describing the “structural” similarities between the programs, the *scènes a faire* doctrine is implicitly applied by the court, as MacCallum J. notes that the alleged structural similarities are “in the main, typical to the genre”, *i.e.*, unprotected expression necessarily resulting from the manifestation of the idea (being the notion of a musical “countdown” show, which the parties and the court acknowledged as having been used in a number of different programs over the years). The examples which MacCallum J. noted as being “unimportant” (with respect, more accurately “unprotected”) include: the number

⁷⁸ *Supra* note 40 and accompanying text.

⁷⁹ *Hutton (Trial)*, *supra* note 27 at 415.

and frequency of commercial breaks; the fact that both shows featured “countdowns”; the number of videos shown; the fact that the host displayed certain characteristics, including “[being] very knowledgeable about the music business ... introduc[ing] videos of pre-recorded musical performances ... [speaking] directly to the camera ... not perform[ing] the musical material himself”; that the tone of both programs was “lively, enthusiastic and ‘hip’”; the use of a screen behind the host on which the videos would appear; and the use of casual wardrobe by the host. In addition, certain technical aspects of the show were also deemed to be unprotected elements as “common constituent elements of any television program of the genre”:⁸⁰ these included certain mannerisms of the host (some mannerisms were explained as being idiosyncrasies of the particular individual who happened to host both shows, while others were deemed “stock-in-trade” of the television business, such as beginning with a wide shot of the host in order to capture as much of the set as possible);⁸¹ the use of an opening montage of images from videos to be shown on the show; the use of a “tease to commercial” (*i.e.*, giving a preview of what will be shown after the commercial before cutting away); “hitting the post” (*i.e.*, introducing a musical performance where the announcer’s voice is heard over an instrumental introduction and the announcer stops speaking just as the vocal performance in the song begins); and “infinity shots” (*i.e.*, a repetition of the same image on multiple screens).

The trial decision did include the finding that there were similarities in the format of the shows in terms of “those portions ... which occupied themselves with the presentation of videos”,⁸² however, these portions were deemed to form a significantly smaller aspect of “*GRT*” because “*GRT*” was found to have a “plastic” format which included the aforementioned

⁸⁰ *Ibid.* at 435.

⁸¹ *Ibid.* at 430.

⁸² *Ibid.* at 422.

segments of interviews, contests, *etc.*, whose placement was not pre-determined from episode to episode.

In determining whether infringement had occurred, the trial court stated “the similarity of ideas was overwhelming and at once apparent upon viewing [both programs] ... the idea of both being to show rock videos presented by a ... ‘video disc jockey’”.⁸³ Nevertheless, the trial court held that no infringement of copyright had occurred, finding that there was no substantial similarity between the two programs, a finding which appeared to have two bases: first, that the numerous alleged similarities were not protected elements and hence there was a lack of “substantial similarity” between the two productions, and second, that “*Star Chart*” contained “dramatic incidents” which “gave it its original character”, and these “dramatic incidents” (*i.e.*, the conceit of “Music Central” and the gathering and relaying by the host and his assistants of hitherto unavailable chart information) were completely absent from “*GRT*”.⁸⁴ The Alberta Court of Appeal affirmed the decision of the trial court, but sought to ground the finding of non-infringement more clearly in the lack of substantial similarity. The trial court decision included discourse on the nature of “*Star Chart*” as a “dramatic work” (based on the plaintiff’s registration of the work as such), and seemed to imply that because “*GRT*” had no story line or dramatic incidents, and hence was not a “dramatic work”, there was no way for the latter to infringe the copyright of the former; the Court of Appeal noted that the trial judge had “placed undue emphasis on the characterization of “*Star Chart*” as a dramatic work”⁸⁵ and noted further that the different natures of two works would not be sufficient to prevent a finding of infringement: the primary concern was whether there was substantial similarity between the protected expressions. In addition to the holding that the nature or medium of expression was

⁸³ *Ibid.* at 442.

⁸⁴ *Ibid.* at 447.

largely immaterial, the Alberta Court of Appeal confirmed that the determination of substantial similarity is to be a holistic qualitative exercise, not merely a rote tabulation of congruent elements, when it stated “the requirement of substantial similarity must be apparent when viewing the works as a whole”.⁸⁶ These aspects of the analysis (ignoring medium and confirming the qualitative approach) lend themselves to future analyses of situations involving not only similar finished productions, but also determination of whether a finished filmed production can infringe copyright in written material.

Without delving into any significant analysis of the point, the trial court, echoed by the appellate decision, also implied that neither the “arrangement” nor “the combination of incidents involved in the presentation of rock videos by a host” was “original” in the sense of being innovative, but were sufficiently “original” to meet the requirements of the *Copyright Act*. Though the *Hutton* decision did not find infringement to have occurred, the corollary to holding that the plaintiff’s format was protected by copyright is that copyright in a format can be infringed in a situation where substantial similarity arises, due to the copying of a sufficient number of protected elements. The merger doctrine, although not explicitly raised by either the trial or appellate decisions in *Hutton*, seemed to underpin many of the findings of the trial court with respect to which elements of “*Star Chart*” were protected: many of the similarities between the shows were set aside being “stock-in-trade” or “typical of the genre”. Similar to the finding of the *Morrisey* court,⁸⁷ both the trial and appellate decisions seemed to aver that there were only so many ways to express the idea of a countdown show. In the case of “*Star Chart*” and “*GRT*”,

⁸⁵ *Hutton (Appeal)*, *supra* note 27 at 49.

⁸⁶ *Ibid.* at 48; the court also noted at 50: “The works were not qualitatively similar. While there are some similarities at the component level, a more than casual comparison shows sufficient substantive difference to support the finding ... that the similarities were unsubstantial and largely unimportant. When both shows are viewed as a whole there is no substantial similarity in the mode of expression”.

⁸⁷ *Supra* note 48 and accompanying text.

there was, as a factual matter, an insufficient amount of copying of protected elements; where copying did occur, it was of “stock devices”. To propose a counterfactual, given the tenor of the trial decision, it is probable that had “GRT” contained some form of “headquarters” set from which breaking information on music chart movements was disseminated, the court would have found that infringement had occurred.

b. *Arbique v. Gabriele*

The case of *Arbique v. Gabriele*⁸⁸ provides a recent example of a Canadian court using broadly the same analysis as the *Hutton* court, also holding that copyright subsists in a television show concept, and also declining to find infringement, though for somewhat different reasons. The case revolved around a proposal and a subsequent television series both of which employed the reenactment of famous court trials. Similar to the facts in *Hutton*, the basic notion of judicial reenactments had been present in multiple guises in multiple jurisdictions. The plaintiffs, in developing their proposal, incorporated what they felt were “unique” elements which distinguished their proposal from prior examples: the use of a host (intended to be a well-known media personality); the use of a panel of experts to provide insight into the depictions; and the ability of viewers to vote via telephone to determine guilt or innocence.⁸⁹ The plaintiffs created a written proposal for the series using the “temporary title” of “*Les Grands Procès*”, and submitted it to a number of broadcasters and producers. Despite some initial interest, including options obtained by two producers and subsequently allowed to lapse, no substantive progress was made in the production of the proposal. After a number of years of the proposal being “shopped” for consideration, the plaintiffs were shocked to find a newspaper article announcing that the defendants had undertaken production of a television series depicting reenactments of

⁸⁸ [1998] A.Q. no. 3794 (Que. S.C.) [*Arbique*], aff’d by [2003] J.Q. no. 85 (Que. C.A.).

⁸⁹ *Arbique*, supra note 88 at para. 20.

famous trials, also entitled “*Les Grands Procès*”; shortly after the initial broadcast of the defendant’s program, the plaintiffs commenced an action alleging infringement of copyright.

In assessing the infringement claim, the trial court proceeded to identify the constituent elements of the proposal and the production, going so far as to provide a two-columned chart for ease of comparison. The court held that no infringement had occurred, concluding simply that there was no “substantial similarity” between the two works,⁹⁰ and that the plaintiffs had failed to discharge their burden of proof in respect of the defendant having access to the submission of the plaintiffs.⁹¹ The court confirmed that the *Preston* analysis was applicable, meaning that both quantity and quality of “reproduced elements” is to be assessed, together with intangible elements such as themes, atmosphere, setting and “rhythm”.⁹² Unfortunately, absent the provision of the chart, the court declined to provide details as to which elements were protected, which were not protected or even which elements had been copied (*i.e.*, there is no explicit application of the *Altai* test’s “filtration” step). Certain distinctions between the works can be drawn from the evidence presented in the decision: the series did not involve a “panel of experts” which participated in detailed dissections of the trials; the role of the host is (in the words of the court “markedly”) different, being far less “involved” in the series; the visual presentation and “tone” of the works was different, with the series placing a priority on the “dramatic” reenactment and the proposal focusing on stimulating discussion. The court’s analysis is largely abstract: while setting out a list of detailed elements, it does not examine each in turn. To a certain extent, the absence of a detailed analysis may betray a fundamental dissonance in the subject-matter, namely that of being asked to compare “similarities” across fundamentally different media (*i.e.*, comparing written descriptions on the page to audio-visual depictions on

⁹⁰ *Ibid.* at para. 88.

⁹¹ *Ibid.* at para. 93.

the screen); as the court states: “Contrary to [the plaintiff’s witnesses], the Court has heard all the evidence, has studied the documents provided as evidence and has viewed the videotapes of the four programs of the first season...”.⁹³ Asking courts to make these comparisons inevitably forces the decision-maker to rely on their faculties of aesthetic appreciation, which may be more or less fully-developed than those of an alternative decision-maker. Potential unfairness which may arise from relying on these decisions can be mitigated by the development and use of articulated tests, as found in the *Hutton* decision.

c. *Productions Avanti Ciné-Vidéo v. Favreau*

The Québec Court of Appeal in *Productions Avanti Ciné-Vidéo v. Favreau*⁹⁴ made cogent remarks which bear on the question of copyright in proposed formats and concepts. Addressing whether to grant a permanent injunction preventing distribution of an erotic film which appropriated, *inter alia*, the names, appearances and costumes of principal characters, as well as the set decor, of a popular Québec television series, the court cast the issue before it as “what constitutes a substantial element of a dramatic or cinematographic work”.⁹⁵ The court found that copyright subsisted not only in the characters found in the television series but also in the integrated expression of all elements comprising the show, and that infringement had occurred. The “copying” did not consist of reproductions of specific snippets of dialogue, but rather reproductions of visual and audio elements of the production, including “costumes and mannerisms ... the whole visual aspect of [the plaintiff’s] work... [including] the musical soundtrack, decors, opening presentations ... [and] all the quirks of language and characteristic

⁹² *Ibid.* at para. 87.

⁹³ *Ibid.* at para. 88.

⁹⁴ *Productions Avanti Ciné-Vidéo v. Favreau* (1999), 1 C.P.R. (4th) 129 (Que.C.A.) [*Productions Avanti*].

⁹⁵ *Ibid.*, at 141-42.

expressions.”⁹⁶ The reproduction of these elements, and the integrated expression thereof, was sufficient for the appellate court to conclude that a substantial portion of the original work had been copied, and thus that infringement had occurred. Since copyright can subsist in any mode of expression, and includes the exclusive right to adapt the work from medium to medium, it follows that if the “elements” described by the court had been manifested in a screenplay or series bible, instead of in a visual format, copyright should have attached thereto, and copying thereof would amount to infringement.

V. New Zealand Caselaw

a. *Wilson v Broadcasting Corporation of New Zealand*

In *Wilson v Broadcasting Corporation of New Zealand*,⁹⁷ the High Court of New Zealand considered, one of the few times in Commonwealth jurisprudence, a case which is almost a “pure” example of concept submission and alleged copyright infringement. The plaintiff developed a concept for an animated children’s television series entitled “*The Kiwi Kids*” wherein the main characters, a boy and a girl, were physically disabled and engaged in various heroic adventures against evil forces. The plaintiff originally submitted a nine-page document (which included sample drawings of the characters) to the New Zealand Crippled Children Society (NZCCS), who in turn forwarded the document to the defendant. Discussions in respect of the show proceeded between the plaintiff, the NZCCS and the defendant, and the plaintiff subsequently developed a fifty-seven page “feasibility study” which incorporated the original nine-page submission. It was not disputed that the plaintiff held all copyright in both the original submission and the feasibility study, nor was it disputed that the defendant had received and reviewed both documents. In July 1984 the defendant began broadcasting an animated program

⁹⁶ *Ibid.*, at 146-47.

⁹⁷ *Wilson v Broadcasting Corporation of New Zealand*, [1990] 2 N.Z.L.R. 565 [*Wilson*].

entitled “*The Kids from OWL*”, which told the story of a boy/girl duo of physically handicapped who engaged in fantastic crime-fighting adventures.

The High Court elected not to engage in a detailed account of the similarities between the written feasibility study and the episodes of “*The Kids from OWL*”, instead concluding from the evidence before the court that “the central features” of the plaintiff’s concept had “found their way in substance into” the television series, and that “[t]he identity of her idea was never lost”.⁹⁸ In deciding whether copyright subsisted in the work, the court framed the issue before it as being one of “copyright in a format”, holding that the written submission was a “dramatic work” within the meaning of section 7 of the *Copyright Act* (New Zealand).⁹⁹ In deciding that the feasibility study was protected by copyright the court briefly addressed the issue of the originality thereof, and, citing *University of London Press*¹⁰⁰ as authority for the fact that the expression need not possess “novelty”, held that the “format” was protected by copyright and not merely an unprotected idea. Based on the language used in the decision, what appears to have been protected (and infringed by the defendant) are the “key components” of the format: “two puberty aged disabled children using their stick and wheelchair as weapons to fight evil and do good.”¹⁰¹ The court held that infringement had occurred,¹⁰² and awarded damages to the plaintiff. Unfortunately, in the absence of a detailed accounting by the court of what common elements were present in the two works and the extent to which infringement had occurred, it is impossible to ascertain whether the decision trends to close to protecting the mere “idea” of the proposal. Explicit application of the *Altai* test would have assisted in providing a record for determining the scope of protection and infringement.

⁹⁸ *Ibid.* at 587.

⁹⁹ *Ibid.* at 590.

¹⁰⁰ *Supra* note 13.

¹⁰¹ *Wilson*, *supra* note 97 at page 591.

b. *Green v. Broadcasting Corporation of New Zealand*

In *Green v. Broadcasting Corporation of New Zealand*,¹⁰³ the plaintiff alleged that the defendant's television talent show "*Opportunity Knocks*" infringed the plaintiff's copyright in a television talent show of the same name broadcast in the United Kingdom; a passing off claim was also asserted. The two shows contained certain similar elements which provided the basis for the plaintiff's claim, namely, in addition to the title and the "talent show" concept of watching the performances of contestants, the use of a "clapometer" by which the audience's approval (or lack thereof) of a performance was measured, the use of certain catchphrases (*e.g.*, "For [contestant] opportunity knocks!" and "It's 'make up your mind time'!") and the use of commercial sponsors to introduce the contestants. The claims were dismissed at first instance, the trial court holding that no copyright had been shown to exist. While the decision was upheld on appeal, two decisions were rendered by the majority, arriving at the same conclusion by significantly different routes.

Based on somewhat scant oral evidence, it appeared that written documents which could be termed "scripts" existed for the plaintiff's version of "*Opportunity Knocks*"; these consisted of the title, written prompts regarding the timing of the use of the catchphrases and the use of the "clapometer", the names of the competitors and the nature of their performances and "the general order of appearances and happenings", including production details. During on-air time between these structural elements the verbal component of each episode (*i.e.*, the introduction of contestants, the performances of the contestants and small-talk between the host, the contestants

¹⁰² Together with a finding of breach on the alternative cause of action of breach of confidence.

and the sponsors) varied, and was largely ad-libbed. Somers J. stated that the “scripts” could not form the basis for a claim of copyright in a “dramatic work”, and that copyright law did not recognize a category of work called a “format” which was neither a dramatic or a literary work.¹⁰⁴ He then considered whether the scripts could attract copyright as “literary works”, and noted that while copyright does not protect a general idea or concept, such a general idea could be “delineated by or attended with detail or pattern or incidents sufficiently substantial to attract copyright in the whole”.¹⁰⁵ However, while noting that a sufficiently detailed outline would be protected as a literary work, he noted that if only the “general idea” that forms the basis of the work is copied, no infringement will be found to have occurred; this determination would be a question of “fact and degree”,¹⁰⁶ an echo of the quantitative and qualitative analysis mandated by Canadian court decisions in *Preston*¹⁰⁷ and *Hutton*.¹⁰⁸ As with so many other invocations of the idea/expression dichotomy, the inherent subjectivity of the determination is implicit, and no mechanism is provided to assess what is idea and what is expression. In the case of the dueling versions of “*Opportunity Knocks*”, Somers J. noted that the defendant had copied the title, the talent show concept, the catchphrases, the “clapometer” and the use of sponsors. However, each copied element was deemed by Somers J. to be an unprotected idea. Thus, while Somers J. seems to affirm that copyright subsists in the “format” (*i.e.*, the written outline for the show) as a literary work, there does not appear to be a way, short of use of actual footage from the first production, to infringe that copyright: the “format” is, after all, nothing more than the sum of the title, the talent show concept, the catchphrases, and the use of the “clapometer” and sponsors.

¹⁰³ *Green v. Broadcasting Corporation of New Zealand*, [1988] 2 N.Z.L.R. 490 (N.Z.C.A.) [*Green (Appeal)*], aff’d [1989] 2 All E.R. 1056 (P.C.) [*Green (PC)*].

¹⁰⁴ *Green (Appeal)* at 497.

¹⁰⁵ *Ibid.*

¹⁰⁶ *Ibid.* at 498.

¹⁰⁷ *Supra* note 67.

¹⁰⁸ *Supra* note 27.

Each of these elements was copied, but no infringement was found to have occurred and the appeal was dismissed.

The judgment of Casey J., likewise dismissing the appeal, rejected the notion that the “scripts” for the show, such as they were, could be the subject of copyright protection. Instead he determined that only the actual performance of the television show could attract copyright protection as a “dramatic work”; since there was no allegation that any copying of the shows themselves (apart from use of component parts such as the catch-phrases and the general “format”) had occurred, there could be no finding of infringement. Without explicitly referring to it as such, Casey J. also appeared to ground his reluctance to afford copyright to the “scripts” in reasoning resembling the merger doctrine. He opined that there were a number of features that “talent shows” necessarily have in common: these included a host, the introduction of the contestants; a method of judging; an announcement of the winner; and a formal closing of the show, possibly including the awarding of a prize.¹⁰⁹ Casey J.’s decision holds that the scope of expression capable in any “script” for talent shows is limited: “anybody writing a production schedule for a talent show would end up with a document having very much in common with similar documents produced for other talent shows”.¹¹⁰ The question of substantial similarity, though not properly an element of the analysis given that no copyright was held to exist in the “scripts”, was, according to Casey J., not established by the plaintiff by “pointing to ... use of a few words reflecting his own novel ideas, or to the similarities in their basic framework, to a large extent imposed by the nature of talent quests.”¹¹¹ Casey J. further expressed “strong reservations” on the question of whether copyright should be extended “to prevent piracy of the

¹⁰⁹ *Green (Appeal)*, *supra* note 103 at 501.

¹¹⁰ *Ibid.*

¹¹¹ *Ibid.* at 502.

basic concept underlying a series of changing dramatic works,”¹¹² preferring that such protection be sought in contract, fearing that the monopoly of copyright could infringe the societal interest in maintaining the “free exchange [in] and ability to develop ideas”.¹¹³ The prescription that parties rely on contract is somewhat unsatisfying in this case: this was not a submission case, wherein the parties had a course of dealing in which they could attempt to negotiate the terms of their relationship, but a case of alleged infringement of an existing work by a party with whom the plaintiff had never communicated.

The dissenting opinion of Gallen J., concluding that infringement had occurred, proffers the beginnings of a credible analysis for show formats. Framing the issue as whether an “idea developed into an original continuing or repeated dramatic format could be the subject of copyright protection”,¹¹⁴ Gallen J. held that a recognizable framework or structure sufficient to “impose a shape upon the other constituent parts of the show produced within it”¹¹⁵ could be regarded as an original dramatic literary work for purposes of the New Zealand *Copyright Act*. Gallen J. also noted that the primary constituent elements of the program (*i.e.*, the “talent show” concept, the title, the use of the sponsor and the “clapometer”) were not individually capable of copyright protection; but it was improper to consider them separately, rather the appropriate consideration was one *in toto*. Considered in that way, the mode of the expression, whether as a dramatic or literary work was largely inconsequential: rather the copying of a recognizable structure, itself comprised of elements occurring in a particular sequence, would violate copyright in the format.¹¹⁶ The reasoning seems to require as a prerequisite to protection that the “format” have been “repeated” sufficiently that it therefore be “recognizable” by viewers of both

¹¹² *Ibid.* at 503.

¹¹³ *Ibid.* at 504.

¹¹⁴ *Ibid.* at 509.

¹¹⁵ *Ibid.*

productions.¹¹⁷ This portion of the reasoning regrettably seems to conflate requirements for a passing off claim into the consideration of the copyright claim (the plaintiff having brought both causes of action). There should not be a requirement that a work be repeated or repetitive in nature in order to attract the protection of the Copyright Act; this requirement appears nowhere in the Copyright Act or in the jurisprudence, and no other “category” of protected work has this requirement imposed on it. However, the kernel of the dissenting decision should be retained: where identifiable features are sufficiently significant to be definitive of the television show or movie, the combination of such features forms a structure which, if fixed as a written work or cinematographic work, should be protected expression. The elements are capable of being copied, and the attention of courts should properly be focused on whether a substantial part of the expression has been copied.

To an extent, each of the judgments in *Green* are unsatisfactory: that of Somers J. argues for copyright in a format, but such copyright seems incapable of being protected in any meaningful manner; while that of Casey J. seems to conclude that certain types of “expressions” are not “expression” at all, but merely unprotected “ideas”; and that of Gallen J. seems to confuse the issue by incorporating considerations more appropriate to a passing off claim.

The decision of the Privy Council of the House of Lords in *Green*¹¹⁸ does not provide support for either the reasoning of Somers J. or Gallen J. Echoing the misplaced confusion in the lower court about the precise “nature” of the work under discussion found in the reasoning of Casey J., the Privy Council, relying on the decision in *Tate v. Fullbrook*,¹¹⁹ stated that the

¹¹⁶ *Ibid.* at 509-511.

¹¹⁷ *Ibid.* At 512: “[T]he appellant has prepared for each of the shows an outline script containing the repetitive structure of the show... ..in my view the appellant was entitled to copyright protection in respect of the repetitive structure of his show which made it recognizable”.

¹¹⁸ *Supra* note 103.

¹¹⁹ [1908] 1 K.B. 821 per Farwell LJ at 832-33.

“format” of *Opportunity Knocks*” was insufficiently “certain” for copyright to subsist, and lacked the “unity” to be capable of performance. Instead the “features” which allegedly comprised the “format” were “unrelated to each other except as accessories to be used in the presentation of some other dramatic or musical performance”.¹²⁰ The Privy Council’s analysis focuses on the “fixation” requirement identified earlier as a threshold question, and, determining the question in the negative, obviates the need to analyze the copyright question in more depth. It is difficult to accept the contention that a television show, available both on tape and reduced to a “script”, which contains phenomena which all observers, including the courts, have conceded are identifiable “features” of the work, is insufficiently “fixed” to warrant copyright protection. The analysis rightly should be focusing on whether infringement has occurred, *i.e.*, whether there is substantial similarity and access. The Privy Council holding appears to have been displaced in Canadian jurisprudence by the *Hutton*,¹²¹ *Productions Avanti*¹²² and *Arbique*¹²³ cases, wherein courts have seen fit to afford protection to formats.

VI. Recent United States Case Law

Despite the numerous allusions in the preceding discussion to United States caselaw, this paper does not canvass in detail those decisions, electing instead to focus on Canadian decisions, together with certain New Zealand decisions of particular relevance. The following descriptions of some general trends as evidenced by a sampling of recent cases will suffice to provide the general tenor of the jurisprudence. As indicated by the Supreme Court of Canada, Canadian courts must be “prudent” in applying American precedents, and exercise due consideration of the

¹²⁰ *Green (PC)*, *supra* note 103 at 1058.

¹²¹ *Supra* note 27.

¹²² *Supra* note 94.

¹²³ *Supra* note 88.

variances in the particular legal rules of each body of law.¹²⁴ While the sheer volume of American caselaw on the issue of television and movie formats and submissions may be helpful to future decisions, it must be noted that United States caselaw, by means of a vigorous application of the idea/expression dichotomy, has enlarged the “idea” component of copyright works resulting in “a narrowing of the scope of copyright protection”, whereas Canadian courts have been typically more willing to accord protection to what under the American analysis would be deemed an unprotectable “idea”.¹²⁵ Recent cases testify to the reliance of United States courts on the “idea” component of the idea/expression dichotomy,¹²⁶ and also on application of the *scènes a faire* doctrine in determining whether infringement has occurred, thus addressing concerns about “overprotection”.¹²⁷ The failure of the plaintiff to prove “access”, especially in the context of large entertainment conglomerates where proof of contact between employees of different divisions of the same corporate entity is haphazard at best, is often also determinative of the success of infringement claims.¹²⁸ In general terms, the analysis is *gestalt* in that it looks to

¹²⁴ *Morgentaler v. The Queen*, [1976] 1 S.C.R. 616 at 629; see also *CCH Canadian Ltd. v. Law Society of Upper Canada* (2002), 18 C.P.R. (4th) 161 (F.C.A.).

¹²⁵ *Delrina Corp. V. Triolet Systems Inc.* (2002), 58 O.R. (3d) 339 at 349(C.A.).

¹²⁶ See, e.g., *Rice v. Fox Broadcasting Co.*, 148 F.Supp.2d 1029 (C.D.Cal 2001) where the court held that Fox Television’s “*Breaking the Magician’s Code: Magic’s Biggest Secrets Finally Revealed*” did not violate copyright in a video entitled “*The Mystery Magician – He Dares to Expose the Secrets Behind Magic’s Most Mystifying Illusion*”, as it both productions centered around an unprotectable idea.

¹²⁷ See, e.g., *Sinicola v. Warner Bros., Inc.*, 948 F. Supp. 1176 (E.D.N.Y. 1996): the feature film “*Out for Justice*” starring Steven Seagal, about an Italian-American police detective who seeks revenge for a Mafia-related killing held not to infringe copyright in an unpublished manuscript submitted for consideration by the plaintiff. The court held that the two works were not substantially similar; most of the purported similarities in settings, event and characters were non-existent or insignificant, and the remaining ones were unprotected ideas and thematic concepts or *scènes a faire* and stock characters; see also *Madrid v. Chronicle Books*, 209 F.Supp.2d 1227 (D.Wyo. 2002) wherein the court granted the defendant’s motion for summary judgment in a case where the plaintiff alleged that the Disney animated movie “*Monsters, Inc.*” infringed copyright in a poem about a monster who is afraid of a boy in his closet, which had been submitted by the plaintiff for consideration for publication to a publisher later involved in books related to the movie; the court held that the similar elements relied upon by the plaintiff (*i.e.*, monsters, a child, the closet) were unprotected ideas, not protectable expression.

¹²⁸ See, e.g., *Robinson v. New Line Cinema Corp.*, 42 F.Supp.2d 578 (D. Md. 1999), relating to the movie “*Set It Off*”, wherein the defendant was granted dismissal of copyright infringement on summary application. The defendant had received and rejected a screenplay about six women (5 black) who commit robberies of small businesses; subsequently the defendant produced a movie about 4 black women who rob banks. While the court found that the plaintiff had not proved access to the screenplay (due to the lack of physical contact between the

not only identifiable “elements” of the works (such as plot occurrences) but also the “tone” or “mood” of the work, and in its particulars resembles the analysis found in *Hutton*¹²⁹ and *Productions Avanti*,¹³⁰ being essentially the *Altai* test of abstraction, filtration and comparison. The apparent doctrinal predisposition to not finding infringement is not, of course, absolute, and there have been a number of recent decisions finding for the plaintiff and in some cases awarding significant damages.¹³¹

VII. Conclusions

Canadian copyright law recognizes that copyright can subsist in concepts or formats for television and feature film productions, provided that the elements otherwise required for copyright protection are present. The availability of copyright protection is of potential benefit to those who submit proposals for television shows and movies and those who produce such productions and worry about third-party copying; this “property” right may be their only effective mechanism of relief since putting in place a contract to may not be available. The

“acquisitions” and “production” departments of the defendant), the decision offers a lengthy and detailed comparison of the two works, concluding that the proposal and the production were “similar only to the extent that both works describe a story about African American women committing crimes”, which is an idea not protected by copyright. The judge found no substantial similarity in the themes, settings, dialogue, mood and pace, and held that the characters not sufficiently developed to be protected by copyright. See also *Herzog v. Castle Rock Entertainment*, 193 F.3d 1241 (11th Cir. 1999) wherein the court held that the movie “*Lone Star*” did not infringe copyright to a screenplay submitted by the plaintiff to employees of the defendant. The defendant was unable to prove access by the defendant, but the court held that even if access had been proven, there was no substantial similarity. The court determined that the similarities asserted by the plaintiff consisted of non-copyrightable elements or elements that could not be considered similar. While the main characters shared broad similarity (both were law enforcement officers whose fathers were sheriffs, a non-copyrightable element), they were different in background story, personal attributes, and purpose. The plots involved murder investigations that reveal the corrupt past of small towns, also a non-copyrightable “idea”. In addition, the setting, mood and pace were different (the screenplay was action/adventure, whereas the movie involved “little action and/or adventure”).

¹²⁹ *Supra* note 27.

¹³⁰ *Supra* note 94.

¹³¹ See, e.g., *Zervitz v. Hollywood Pictures*, 995 F.Supp 596 (D. Md. 1996) where a screenwriter was awarded US\$1.23 million in a case asserting copyright infringement of a submitted six-page treatment by the feature film movie “*The Air Up There*”; see also *Metcalf v. Bochco*, 294 F.3d 1070 (9th Cir. 2002) where the Circuit court of appeal reversed a decision granting summary judgment to defendants, indicating that the similarities were “striking” between the television show “*City of Angels*” and scripts submitted to the producer of the show by the plaintiffs, because of several shared elements, including the fact that both are set in “overburdened county hospitals in inner-

handful of decisions to date reveal the use of an analytical framework for dealing with allegations of infringement of copyright in formats or concepts which is similar to that found in American jurisprudence, and which was given its most famous form in the *Altai* case. In the New Zealand cases we have seen courts unnecessarily delve into the taxonomy of television show formats and concepts, spending rather too much time deciding what has been created rather than whether it has been unlawfully copied, resulting in doctrinally unsound decisions. The *Hutton* appeal court rightly dismissed the concern regarding the “classification” of the work, preferring to concentrate on whether substantial similarity and causal connection, the necessary elements for an infringement action, had been shown. The use of the abstraction/ filtration/ comparison test enables courts to assess the infringement claim, without becoming bogged down in theoretical niceties regarding the “originality” or “fixation/certainty” of a work. Instead, it employs various devices to perform the policy objective of taming the spectre of “overprotection”: the doctrines of merger and scenes a faire; the need to prove “substantial similarity” (subsuming the requirements noted by Professor Vaver that a “substantial” portion be taken¹³² and that a “sliding scale” of infringement be employed (*i.e.*, “the less original the work, the more exact must be the copying for infringement to be found”)¹³³); and the need to prove access. Canadian decisions on point have reflected that courts have been honest about the vagaries of the task they must undertake in determining whether a “substantial similarity” exists, and they have been instrumental enough to permit the broad outlines of the analysis contained in the *Altai* test to guide their decision-making. A more explicit adoption of the *scènes a faire* doctrine, hopefully coupled with a vigorous assessment of its implications and limitations, would

city Los Angeles with mostly black staffs ... [dealing with] issues of poverty, race relations and urban blight.” The latter decision has occasioned criticism for purporting to grant copyright protection to ideas, not expression.

¹³² See Vaver, *supra* note 1 at 144.

¹³³ See Vaver, *supra* note 1 at 60; see note 54, *supra*, and accompanying text.

be welcomed in this context. It is better, ultimately, to have a test that is lenient enough to allow a surfeit of subjective analysis, rather than no test whatsoever and allow, in effect, subjectivity to run rampant.

On a practical level copyright is not the only, nor perhaps even the best, legal mechanism available to both submitters and producers to protect their interests. Other possibilities (some raised in the cases reviewed herein) include claims for passing off, breach of confidence, and breach of contract.¹³⁴ United States jurisprudence has even developed a fairly robust body of cases regarding breach of contract by misappropriating an “idea”.¹³⁵ Many production companies and studios, as described in *Preston*, have a strict “no unsolicited submissions” policy, meaning that they will return (or discard), unread, any submissions not received through a recognized intermediary such as an agent. This “gate-keeping” serves two functions: first, quality control, as it is assumed that submissions received via approved channels have already been vetted to a certain extent for potential value; second, it permits the recipient to construct, or at least inform, the legal framework in which they will be expected to handle the material (*e.g.*, by means of submission contracts which can limit liability or explicitly state confidentiality requirements). Many of those same studios and companies have standard form submission agreements which they require potential submitters to execute. Although these contracts do not appear to have been the subject of litigation in Canada, United States courts have recognized them as being valid and enforceable, despite unanswered questions as to whether they are “contracts of adhesion”.¹³⁶ Studios should continue to enforce such policies, should require

¹³⁴ See generally J.D. Cohen, “Remedies for Misappropriation of Motion Picture and Television Story Ideas” (1985) 7 *Hastings Communications and Entertainment Law Journal* 85; J. Stuckey-Clarke, “Remedies for the Misappropriation of Creative Ideas”, [1989] 9 *EIPR* 333.

¹³⁵ See M. Vahradian, “When Must Hollywood Pay for an Idea?”, 1992-1993 *Entertainment, Publishing and the Arts Handbook* 329.

¹³⁶ See, *e.g.*, *Entous v. Viacom International*, 151 F.Supp.2d 1150 (C.D.Cal. 2001), wherein the defendant successfully relied on a submission release contract to avoid liability for infringement. The plaintiff created a

submission releases as a matter of course when accepting submissions, and should log receipt and handling of all incoming proposals. A clear record, to the extent possible, should also be retained of the development of a project, including sources of inspiration, in order to be prepared for possible future infringement claims.

Those submitting concepts or ideas should make every effort to reduce their “ideas” or “concepts” into written form, with as much descriptive detail as possible, given the limitations of space and the time of both submitter and recipient. They should bear in mind the pronouncement of Learned Hand, stated in the context of copyrightability of literary characters, that “the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for making them too indistinct”.¹³⁷ A fully-developed submission should consist of both synopsis and background materials (perhaps as an appendix) consisting of detailed descriptions of characters, activities, sets, plotlines, *etc.* Where the proposed format is appropriate (*e.g.*, animated series, distinctive set or costuming), visual designs should be included. In order to provide appropriate documentary evidence in the event that the question of infringement becomes disputed, records should be maintained of when and to whom the submission was delivered or discussed, along with notes of discussions and copies of materials delivered.¹³⁸

proposed program called “*Music Videos: Uncut*” and alleged the show “*MTV: Making the Video*” infringed his copyright in the proposal. The plaintiff had submitted a written program treatment and video commercial to MTV, signing a submission release. The release provided that if any controversy later arose concerning his submissions, he would assert his claims not more than six months after he “first learned (or reasonably should have been aware) of [Viacom’s] use or intended use of [his submitted] material.” Entous agreed that the six month limit applied, but argued that it should only have begun running from Viacom’s first broadcast of its program. However, Entous had learned about Viacom’s program while it was still in development, more than six months before filing the lawsuit.

¹³⁷ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 at 121 (2d Cir. 1930).

¹³⁸ See T. Duarte, *Canadian Film & Television Business & Legal Practice* (Aurora: Canada Law Book, 2002) c. 5.