

Note: The Evolving Law of Ideas in *Girl Friends Productions, Inc. v. ABC, Inc.*

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I. Introduction

This Note discusses recent developments in the law of protection of ideas. The present law of protection of ideas differs from state to state. The range in protection theories results from the conflicting goal of protecting one's "property" from theft and the belief that ideas should be in the public domain.<sup>1</sup> Courts have vied with these competing interests, and have used different methods to expand and to limit the protection of ideas.

The recent case of *Girl Friends Productions, Inc. v. ABC, Inc.*<sup>2</sup> shows the trend in seeking to protect ideas under federal unfair competition laws, and represents a challenge to the popular talk show, "The View." In *Girl Friends Productions, Inc.*, the court relied on Section 43(a) of the Lanham Act, which provides a civil action for false designation of origin in

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<sup>1</sup> This conflict is best summarized in *Desny v. Wilder*, where Judge Schauer stated that "ideas are as free as the air," but recognized that "there can be circumstances when neither air nor ideas may be acquired without cost." *Desny v. Wilder*, 299 P.2d 257, 265 (Cal. 1956).

<sup>2</sup> *Girl Friends Prods., Inc. v. ABC, Inc.*, 56 U.S.P.Q.2d 1692 (S.D.N.Y. 2000).

connection with goods and services.<sup>3</sup> This Note also reviews the other prevailing theories for legal protection of ideas and examines the possible future of the law in light of this decision.

## II. Statement of the Case: *Girl Friends Productions, Inc. v. ABC, Inc.*

The plaintiffs in this case were Sandra Fulton Gabriel, a television producer and program developer, and Girl Friends Productions, Inc., the production company she and a colleague formed in 1993.<sup>4</sup> Plaintiff Gabriel conceived the idea for a talk show format, to be called "Girl Friends," featuring three female non-celebrity co-hosts, representing different generations and ethnicities.<sup>5</sup> During each installment the co-hosts would discuss a controversial topic with their audience members and guests.<sup>6</sup>

Plaintiffs entered into a contract with defendant Greengrass Productions, Inc. ("Greengrass")<sup>7</sup> on August 11, 1994, whereby Greengrass would fund production of three pilot episodes of "Girl Friends" in exchange for all copyrights in the pilots and an exclusive right to option the series for one year after delivery of the pilot episodes.<sup>8</sup> According to the contract,

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<sup>3</sup> 15 U.S.C. § 1125(a) is usually referred to as Section 43(a), its number in the bill which later became The Trademark Act. This Note will adhere to the usual practice of referring to it as Section 43(a).

<sup>4</sup> *Girl Friends Prods., Inc.*, 56 U.S.P.Q.2d at 1693.

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

<sup>7</sup> Defendant Greengrass Productions, Inc. is a subsidiary of defendant ABC, Inc., which is in turn a subsidiary of defendant American Broadcast Companies. *Id.* at 1693.

<sup>8</sup> *Id.*

plaintiffs would receive additional compensation if Greengrass chose to exercise the option, and if Greengrass chose not to exercise the option, plaintiffs could license the pilot back from Greengrass for one year in order to market it to other networks.<sup>9</sup> After viewing the pilot episodes, Greengrass chose not to exercise its option, which then expired in 1995.<sup>10</sup> Plaintiffs did not license the pilot episodes, and their licensing period expired in 1995 as well.<sup>11</sup>

In 1997 ABC began airing the talk show "The View," produced by defendant Barwall Productions, Inc.<sup>12</sup> "The View" stars defendant Barbara Walters and four other female professional television personalities.<sup>13</sup> The format of "The View" features celebrity guests, multiple topics per installment, and discussions of current news events and current films.<sup>14</sup>

Plaintiffs sued in the United States District Court for the Southern District of New York claiming that "The View" was based on and substantially similar to "Girl Friends."<sup>15</sup> This suit alleged breach of contract violation of Section 43(a) of the Lanham Act,<sup>16</sup> which prohibits false designation of origin and false description; breach of implied covenant of good faith and fair dealing; abuse of contractual relationship; unfair

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<sup>9</sup> *Id.*

<sup>10</sup> *Id.*

<sup>11</sup> *Id.*

<sup>12</sup> *Id.*

<sup>13</sup> As well as Barbara Walters, the original cast of "The View" also included Meredith Vieira, formerly of CBS news, CBS's "60 Minutes," and ABC's "Turning Point"; Star Jones, formerly of "Jones and Jury" and "Inside Edition"; Joy Behar, stand-up comedienne and formerly of "Queens"; and Debbie Matenoupolis, a less established television correspondent. *Id.* at 1694.

<sup>14</sup> *Id.* at 1694-95.

<sup>15</sup> *Id.* at 1693.

<sup>16</sup> 15 U.S.C. § 1125(a) (1994).

competition; tortious interference with contract; tortious interference with economic opportunity; and recovery on a theory of quantum meruit.<sup>17</sup>

Defendants moved for summary judgment and the court granted that motion in respect to all of plaintiff's claims.<sup>18</sup> The court engaged in a substantial similarity analysis, finding that "The View" was not "based on" "Girl Friends" under any reasonable interpretation of that phrase from the plaintiff's contract.<sup>19</sup>

The evidence of the lack of similarity came from four main points. First, the essence of "Girl Friends" was that the hosts would be neither celebrities nor professional television personalities so that the discussions would be candid and authentic.<sup>20</sup> In contrast, each host of "The View" had prior television or journalism experience.<sup>21</sup> Second, the format of "Girl Friends" did not include celebrity guests, while "The View" was specifically designed to attract celebrities for guest spots.<sup>22</sup> Third, the "Girl Friends" hosts would represent different generations and different races or ethnicities in order to "ignite conflict, inspire compassion and help bridge the age and ethnic gaps with humor and explosive debates."<sup>23</sup> "The View's" five hosts necessarily represented different age groups, but there was no individual representative for any generation, and their casting focus was on personal chemistry, not ethnic or

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<sup>17</sup> *Girl Friends Prods., Inc.*, 56 U.S.P.Q.2d at 1693.

<sup>18</sup> *Id.* at 1693.

<sup>19</sup> *Id.* at 1694.

<sup>20</sup> *Id.* at 1695.

<sup>21</sup> *Id.*; see also note 13.

<sup>22</sup> *Girl Friends Prods., Inc.*, 56 U.S.P.Q.2d at 1694.

<sup>23</sup> *Id.*

racial diversity.<sup>24</sup> Fourth, each episode of "Girl Friends" would be devoted to a single, long-range topic that was not time-sensitive in order to allow for "stacked" production of several episodes for later broadcast.<sup>25</sup> "The View" was broadcast live or with a slight delay in order to include time-sensitive material and multiple short-range topics.<sup>26</sup> The court also found sufficient evidence of Barbara Walters's independent creation of the idea to support Defendants' summary judgment motion.<sup>27</sup>

The court concluded that no reasonable interpretation of "based on" would support the plaintiffs' contract claim, and the same analysis defeated the other claims as well.<sup>28</sup> The lack of substantial similarity between the two television shows defeated the claim under Section 43(a) of the Lanham Act for false designation of origin and false description, relying on *Attia v. Society of the New York Hospital*<sup>29</sup> and *Waldman Publishing Corp. v. Landoll, Inc.*<sup>30</sup> for extending the substantial similarity analysis from copyright law to this provision of the Lanham Act.<sup>31</sup> The claim under quantum meruit was precluded because an express contract governed the dispute.<sup>32</sup> The lack of similarity and the

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<sup>24</sup> Barbara Walters testified that, "If we can get somebody with a specific ethnicity, that was great. If we didn't it was fine. We ended up with four white women and one African-American woman. I mean we didn't end up with the rainbow coalition here." *Id.*

<sup>25</sup> *Id.*

<sup>26</sup> *Id.* at 1695.

<sup>27</sup> *Id.*

<sup>28</sup> *Id.* at 1696.

<sup>29</sup> *Attia v. Soc'y of the N.Y. Hosp.*, 201 F.3d 50 (2d Cir. 1999).

<sup>30</sup> *Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775 (2d Cir. 1994).

<sup>31</sup> *Girl Friends Prods., Inc.*, 56 U.S.P.Q.2d at 1696.

<sup>32</sup> *Id.*

evidence of independent creation also defeated the other claims.<sup>33</sup>

### III. Background Law

While legal protection of ideas is expanding, historically their protection has been strongly disfavored. Ideas and concepts do not merit protection under any of the traditional areas of federal intellectual property law (copyright, patent, trademark and trade secret law), so potential plaintiffs must look to state law for protection. Traditional theories for protecting ideas under state law include property, express contract, implied-in-fact contract, quasi contract (or unjust enrichment), or confidential relationship.<sup>34</sup>

Because of the entertainment industry, New York and California are the states with the most opportunity to consider the protection of ideas;<sup>35</sup> however, the two states take different approaches. California favors the contract approach, finding protection of ideas only when there is either an express or an implied-in-fact contract, because the disclosure of an idea can be valid consideration.<sup>36</sup> New York also recognizes the contract theories, but it has traditionally looked to property law to

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<sup>33</sup> *Id.*

<sup>34</sup> Camilla M. Jackson, "I've Got This Great Idea for a Movie!" *A Comparison of the Laws in California and New York That Protect Idea Submissions*, 21 COLUM.-VLA J. L. & ARTS 47, 50 (1996).

<sup>35</sup> Influential law of ideas cases also come from other jurisdictions. For example, *Reeves v. Alyeska Pipeline Service Company*, a case decided by the Supreme Court of Alaska, has been frequently cited and followed by other jurisdictions. *Reeves v. Alyeska Pipeline Serv. Co.*, 926 P.2d 1130 (Alaska 1996).

<sup>36</sup> *Whitfield v. Lear*, 751 F.2d 90, 92 (2d Cir. 1984).

protect ideas only when they are novel and concrete.<sup>37</sup> As this Note shows, New York law is in the process of adding another method of protecting ideas.

### A. *The Requirement of Novelty*

The seminal case discussing the novelty issue under New York law is *Murray v. National Broadcasting Company, Inc.*<sup>38</sup> Plaintiff proposed an idea for a situation comedy television show starring Bill Cosby in a non-stereotypical role, to be called "Father's Day."<sup>39</sup> Four years later defendants began airing "The Cosby Show," a family situation comedy starring Bill Cosby.<sup>40</sup> Plaintiff sued claiming racial discrimination; false designation of origin under Lanham Act Section 43(a); and state law misappropriation, conversion, breach of implied contract, unjust enrichment, and fraud.<sup>41</sup> The court determined that there was not a legally protectible property interest because plaintiff's ideas lacked novelty, and that finding was fatal to all of plaintiff's claims.<sup>42</sup>

The court in *Murray* followed the precedent established in the 1970 case of *Bram v. Dannon Milk Products, Inc.*,<sup>43</sup> which stated the proposition that "[l]ack of novelty in an idea is fatal to any cause of action for its unlawful use."<sup>44</sup> The later case of

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<sup>37</sup> *Murray v. Nat'l Broad. Co.*, 844 F.2d 988 (2d Cir.1988).

<sup>38</sup> *Id.*

<sup>39</sup> *Id.* at 990.

<sup>40</sup> *Id.*

<sup>41</sup> *Id.* at 991.

<sup>42</sup> *Id.* at 990.

<sup>43</sup> *Bram v. Dannon Milk Prods., Inc.*, 33 A.D.2d 1010, 1010 (1970).

<sup>44</sup> *Murray*, 844 F.2d at 991.

*Nadel v. Play-by-Play Toys & Novelty*<sup>45</sup> limited that result, and found that only novelty to the buyer was necessary for a contract claim, not absolute novelty.<sup>46</sup>

B. *The Waldman Cases*

1. *Waldman Publishing Corp. v. Landoll, Inc.*

In *Waldman Publishing Corp. v. Landoll, Inc.*,<sup>47</sup> the Second Circuit used Section 43(a) of the Lanham Act to provide protection for ideas that, while they consisted of copyrightable matter, were not in fact copyrighted. The court found that the prohibition of false designation of origin under Section 43(a) applied to misattribution of authorship of a written work.<sup>48</sup> Plaintiffs published a series of illustrated children's books adapted from stories in the public domain, such as *Black Beauty*, *The Swiss Family Robinson*, and *Oliver Twist*.<sup>49</sup> Three years later, defendants began publishing illustrated versions of six of the same stories.<sup>50</sup> The district court found, and the 2nd Circuit agreed, that while defendants' books were not exact copies of plaintiffs', the arrangement of the chapters mirrored plaintiffs', the text closely followed it, and the illustrations depicted the same events as plaintiffs' books.<sup>51</sup> In order to succeed on the Lanham Act claim, plaintiffs had to prove that (1) defendants affixed a false designation of origin to

<sup>45</sup> *Nadel v. Play-by-Play Toys & Novelties, Inc.*, 208 F.3d 368 (2d Cir. 2000).

<sup>46</sup> *Id.* at 376.

<sup>47</sup> *Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775 (2d Cir. 1994).

<sup>48</sup> *Id.* at 778.

<sup>49</sup> *Id.*

<sup>50</sup> *Id.* at 779.

<sup>51</sup> *Id.*



their books, (2) defendants used the false designation of origin in commerce, (3) the false designation of origin was likely to cause consumer confusion, and (4) plaintiffs were likely to be damaged by the false designation of origin.<sup>52</sup> A false designation of origin typically comes from false advertising; "passing off," where one sells its product under another's name; or "reverse passing off," where one sells another's product under its own name.<sup>53</sup> While reverse passing off usually involves a manufactured product, the court applied that test to the written works in this case, stating that "[t]he misappropriation is of the artistic talent required to create the work, not of the manufacturing talent required for publication."<sup>54</sup>

While a written work is ordinarily copyrightable,<sup>55</sup> plaintiffs did not raise the copyright issue until after the appeal of the district court decision, and so the Second Circuit could not consider that claim on the appeal and therefore treated it as a law of ideas case.<sup>56</sup> Defendants argued that because plaintiffs had not registered for copyright protection before the commencement of the action, they could not be liable under Section 43(a).<sup>57</sup> The court noted that the Copyright Act and the Lanham Act address different harms; the Copyright Act protects the author's right to control who publishes, sells or otherwise uses a work, and the Lanham Act protects the author's

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<sup>52</sup> *Id.* at 780.

<sup>53</sup> *Id.*, (referencing *Roho, Inc. v. Marquis*, 902 F.2d 356 (5th Cir. 1990)); Restatement (Third) of Unfair Competition, § 5 (Tentative Draft No. 1 1988).

<sup>54</sup> *Waldman Publ'g Corp.*, 43 F.3d at 781.

<sup>55</sup> 17 U.S.C. § 102(b) (1994).

<sup>56</sup> *Waldman Publ'g Corp.*, 43 F.3d at 778 n.1.

<sup>57</sup> *Id.* at 781.

right to ensure his or her name is associated with a work when the work is used.<sup>58</sup>

To find a false designation of origin since the underlying works were in the public domain and the books were not identical, the court looked to copyright law for help.<sup>59</sup> Although the underlying works were in the public domain, the material added to the underlying works could be protected under copyright law, and the court found this additional material from plaintiffs' works original enough to merit copyright protection.<sup>60</sup>

Then the court proceeded to a "substantial similarity" analysis of copyright infringement to determine that defendants' books were similar enough to plaintiffs' to mean that defendants' failure to credit plaintiffs was a false designation of origin.<sup>61</sup> In order to prove copyright infringement, one must show that the defendant had access to the copyrighted work and that the protectible material is substantially the same in the two works.<sup>62</sup> The court found access because plaintiffs' books had been available in publication for several years, and it found substantial similarity in the protected material including the structure of the chapters and the illustrations.<sup>63</sup> Since there was no showing of independent creation, the court found a false designation of origin.<sup>64</sup> The court went on to find likely

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<sup>58</sup> *Id.*

<sup>59</sup> *Id.*

<sup>60</sup> *Id.* at 782.

<sup>61</sup> *Id.* at 782-84.

<sup>62</sup> *Id.* at 781 (quoting *Kregos v. Associated Press*, 3 F.3d 656, 662 (2d Cir. 1993), *cert. denied*, 114 S. Ct. 1056 (1994)).

<sup>63</sup> *Id.* at 783.

<sup>64</sup> *Id.*

consumer confusion and harm to the plaintiffs as a result of the false designation of origin.<sup>65</sup>

## 2. *Attia v. Society of the New York Hospital*

In *Attia v. Society of the New York Hospital*<sup>66</sup> the plaintiff alleged that defendants copied his drawings for the New York Hospital renovation project by falsely designating themselves as the origin of the design, thus violating both the Copyright Act and the Lanham Act, and resulting in defendants' unjust enrichment.<sup>67</sup> The Court of Appeals for the Second Circuit upheld the district court's summary judgment in defendants' favor, agreeing that the key issue to both claims was whether or not the parties' plans were substantially similar.<sup>68</sup> The Second Circuit first found no copyright infringement of plaintiff's design drawings because the similar elements were merely ideas and concepts, and therefore outside the scope of copyright protection,<sup>69</sup> even from intentional copying.<sup>70</sup>

Plaintiff then argued, relying on *Waldman*, that his Lanham Act claim for false designation of origin, committed by reverse passing off, could proceed even though his copyright

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<sup>65</sup> *Id.* at 784-85. The parties did not contest that the designation was used in commerce, so the court did not need to reach that issue. *Id.* at 780.

<sup>66</sup> *Attia v. Soc'y of the N.Y. Hosp.*, 201 F.3d 50 (2d Cir. 1999).

<sup>67</sup> *Id.* at 51.

<sup>68</sup> *Id.* at 53.

<sup>69</sup> 17 U.S.C. § 102(b) (1994) provides, "In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."

<sup>70</sup> *Attia*, 201 F.3d at 54.

claim failed.<sup>71</sup> The court explained that *Waldman* allowed a Section 43(a) claim when a copyright claim fails only when the plaintiff can satisfy the same standard of substantial similarity required in copyright cases.<sup>72</sup> Because the similarity in the parties' drawings here was only in ideas and concepts, which are expressly excluded from copyright protection,<sup>73</sup> plaintiff's Lanham Act claim failed as well.<sup>74</sup> The court concluded by noting that,

[I]f *Waldman's* adoption of the 'substantial similarity' test in the context of reverse passing off were not the rule, the principle of copyright that denies protection to ideas, concepts, and processes would become a dead letter. A plaintiff unable to prevail under the laws of copyright could simply restate his claim as one of unfair competition for reverse passing off. Ideas would no longer be in the public domain.<sup>75</sup>

#### IV. Significance of the Case

The *Waldman* line of cases is not the first application of the unfair competition provision of the Lanham Act to reach beyond the typical purview of federal trademark law. For example, in *N.S. Meyer, Inc. v. Ira Green, Inc.*<sup>76</sup> the Second Circuit interpreted the threshold for Section 43(a) as requiring

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<sup>71</sup> *Id.* at 59

<sup>72</sup> *Id.*

<sup>73</sup> 17 U.S.C. § 102(b) (1994).

<sup>74</sup> *Attia*, 201 F.3d at 59-60.

<sup>75</sup> *Id.* at 60.

<sup>76</sup> *N. S. Meyer, Inc. v. Ira Green, Inc.*, 326 F. Supp. 338 (S.D.N.Y. 1971).

only that goods or services be involved, and so found protection under the provision for catalogs referencing military glove numbers.<sup>77</sup> In *Bogene Inc. v. Whit-Mor Manufacturing Co., Inc.*<sup>78</sup> the same court found protection under Section 43(a) for brochure sheets for garment bags.<sup>79</sup>

The importance of *Waldman, Attia, and Girl Friends Productions, Inc.* is the extension of Section 43(a) into a truly generalized federal unfair competition law by broadening the scope of its protection. The New York courts have accomplished this result by not expressly requiring novelty for Lanham Act Section 43(a) claims, which would otherwise be requisite to legal protection of ideas. New York law has extended the lead introduced in *Nadel*<sup>80</sup> and found novelty to be unnecessary in a federal unfair competition claim.

But is this as big a reversal as it seems? Time will tell if more plaintiffs succeed in protecting their ideas in court by claiming unfair competition rather than property rights. The answer might be that the change is not as significant at second glance.

For example, if plaintiffs in *Girl Friends Productions, Inc.* relied on a property rights theory of recovery instead, it is unlikely that they would have survived the novelty scrutiny and therefore still would have lost on defendants' summary judgment motion. Under *Murray*,<sup>81</sup> plaintiffs' idea for a female panel talk show format is not novel. It is comprised of "known ingredients" and is merely an "adaptation of existing

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<sup>77</sup> *Id.* at 341.

<sup>78</sup> *Bogene Inc. v. Whit-Mor Mfg. Co.*, 253 F. Supp. 126 (S.D.N.Y. 1966).

<sup>79</sup> *Id.* at 127.

<sup>80</sup> *Nadel*, 208 F.3d at 376.

<sup>81</sup> *Murray v. Nat'l Broad. Co., Inc.*, 844 F.2d 988 (2d Cir.1988).

knowledge,” which is precisely what failed in *Murray*.<sup>82</sup> As a result, the court would have decided *Girl Friends Productions, Inc.* the same way whether plaintiffs relied on property rights or unfair competition theories.

The same result occurs when analyzing *Murray* under the new unfair competition standard of substantial similarity. When the *Attia* court explained the holding of *Waldman*, it made clear that for a Section 43(a) claim to succeed where the copyright claim failed, plaintiff must satisfy the same standard of substantial similarity required in copyright cases, and ideas and concepts are expressly excluded from copyright protection.<sup>83</sup> In *Murray* the claimed similarities were in ideas and concepts for a television show, and so that plaintiff too would have failed under either test.

## V. Conclusion

Perhaps the only potential plaintiff to benefit after the *Waldman* line of cases is one with an otherwise successful copyright claim that is defeated on a technicality. The plaintiff in *Waldman* succeeded on the federal unfair competition because his ideas were expressed in a form that was entitled to federal copyright protection, although he did not register his copyright in time to raise that issue in court.<sup>84</sup> It appears that the ultimate significance of this case is not as a new avenue for idea protection, but as a way of circumventing compliance with the federal copyright laws. For now, at the least, plaintiffs have another hope for protecting their ideas from misappropriation.

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<sup>82</sup> *Id.* at 992.

<sup>83</sup> *Attia*, 201 F.3d at 59.

<sup>84</sup> *Waldman Pub'g Corp.*, 43 F.3d at 778 n.1.