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THE SCALE TIPS IN FAVOR OF PARODISTS AND FREEDOM OF SPEECH ADVOCATES, AS “OTHER” VERSION OF GONE WITH THE WIND HELD FAIR USE UNDER COPYRIGHT LAW: SUNTRUST BANK V. HOUGHTON MIFFLIN CO.

Veronica Soto†

I. INTRODUCTION

Balancing the competing interests of the First Amendment and copyright continues to be a challenge for courts when dealing with copyright issues. “On the copyright side, economic encouragement for creators must be preserved and the privacy of unpublished works recognized”,¹ on the First Amendment side, “[f]reedom of speech requires the preservation of a meaningful public or democratic dialogue . . . .”² Attempts to strike such a balance have been made, in part, through the idea/expression dichotomy and the doctrine of fair use. Under the idea/expression dichotomy, “copyright assures authors the right to their original expression, but encourages others to build freely upon ideas and information conveyed in their work.”³ Authors and speakers are invited to convey the ideas and facts contained within the copyright holder’s work—so long as they do so using their own original expression.⁴

First Amendment privileges have also been preserved through the doctrine of fair use.⁵ Prior to federal legislation, courts applied the fair use doctrine without any bright lines to follow. Then in 1976, Congress codified the fair use doctrine, in an effort to preserve the

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¹. MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.10[B][1] (2001) [hereinafter NIMMER].

². Id.


⁴. See NIMMER, supra note 2.

doctrine's historical purpose of promoting creativity.\textsuperscript{6} The exceptions carved out in the statute allow later authors to use a previous author's copyrighted work to introduce new ideas or concepts to the public.\textsuperscript{7}

Some commentators, however, suggest that the idea/expression dichotomy and the fair use doctrine do not continue to protect free speech adequately.\textsuperscript{8} For instance, there are times when speech will be less convincing, understandable, or believable if the speaker cannot copy existing expression.\textsuperscript{9} Thus, the idea/expression dichotomy may fall short in truly protecting freedom of expression. In addition, because the fair use doctrine is applied on a case-by-case basis, judges are permitted, and in fact, in many circumstances, are required to critique the artistic meaning of a particular work in order to determine whether it merits fair use protection. That subjective determination and broad discretion have allowed some courts to deny fair use in certain cases merely where judges find the work to be distasteful.\textsuperscript{10}

\begin{itemize}
\item[6.] Section 107 of the Copyright Act provides:
Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
\begin{enumerate}
\item the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
\item the nature of the copyrighted work;
\item the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
\item the effect of the use upon the potential market for or value of the copyrighted work.
\end{enumerate}
\item[7.] See SunTrust Bank, 268 F.3d at 1264.
\item[8.] See generally Neil Weinstock Netanel, Locating Copyright Within the First Amendment Skein, 54 STAN. L. REV. 1 (2001) (arguing that Copyright law should be subject to heightened First Amendment judicial scrutiny)
\item[9.] See generally Time Inc. v. Bernard Geis Assoc., 293 F. Supp. 130, 146 (S.D.N.Y. 1968) (holding that the author, publisher, and distributor fairly used various frames of plaintiff's copyrighted motion picture film of the assassination of President Kennedy in their book about the same in view of the public interest in having the fullest information available on the assassination).
\item[10.] See generally Paul Tager Lehr, The Fair-Use Doctrine Before and After "Pretty Woman's" Unworkable Framework: The Adjustable Tool For Censoring Distasteful Parody, 46 FLA. L. REV. 443 (1994) (arguing that in Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 753 (1978), the Ninth Circuit Court of Appeals found that even though Air Pirates did not copy any specific illustrations or literary representations of Disney characters, Air Pirates' copying of the actual design of the characters was so substantial as to preclude fair use, mostly because of the sexual nature of the parody. "[I]n light of the court's negative characterization of Air Pirates'
Although the debate surrounding copyright and the First Amendment continues, the Eleventh Circuit's decision in *SunTrust Bank v. Houghton Mifflin Co.*\(^{11}\) tipped the scale in favor of the First Amendment and its advocates when it adopted a broader definition of parody, as developed in the landmark case, *Campbell v. Acuff-Rose Music, Inc.*\(^{12}\) The circuit court's fair use analysis as to parodies also clarified some ambiguities that had remained unclear after *Campbell* and provided good illustrations for other courts in future cases. This Case Note reviews the decision, explores the court's rationale, and examines the decision's impact on copyright fair use jurisprudence.

II. *SunTrust Bank v. Houghton Mifflin Co.: Factual and Procedural Background*

The Mitchell Trust is the copyright owner of the novel *Gone With The Wind*, (GWTW) by Margaret Mitchell.\(^{13}\) Over the years, the Mitchell Trust has authorized derivative works of *GWTW*, as well as the use of certain elements of *GWTW* in a wide variety of commercial contexts.\(^{14}\) After discovering similarities between *GWTW* and a novel by the name of *The Wind Done Gone* (TWDG), SunTrust, the trustee of the Mitchell Trust, asked publisher Houghton Mifflin to refrain from publication and distribution of TWDG, which, according to SunTrust, was an unauthorized sequel to GWTW.\(^{15}\)

*TWDG*, a novel by Alice Randall, revisits the setting and characters of Margaret Mitchell's classic civil war saga from the viewpoint of a slave.\(^{16}\) It chronicles the diary of a woman named Cynara, the illegitimate daughter of Planter, a plantation owner, and Mammy, a slave who cared for Planter’s children.\(^{17}\) Cynara, who is of mixed race, is also the half-sister of “Other” (Randall’s version of Scarlett O’Hara).\(^{18}\) The novel recounts Cynara’s youth on a plantation named “Tata” (a slight alteration from GWTW’s Tara), her

14. *See id.*
16. *See Note, Gone With The Wind Done Gone: “Re-Writing” and Fair Use, 115 HARV. L. REV. 1193, 1194 (2002).*
17. *See id.*
18. *See id.*
marriage and divorce from "R.B." (TWDG’s version of Rhett Butler), her travels in Europe, and her eventual inheritance of Tata.19

SunTrust argued that TWDG copied characters, character traits and relationships, settings, and situations of GWTW, impermissibly summarized its plot, and copied verbatim certain dialogues and passages.20 Although Houghton Mifflin conceded that Randall appropriated the characters, plot, and major scenes in the first half of the book, it refused to refrain from publishing the novel, arguing that the two works lacked any substantial similarity because TWDG was a lawful critique of GWTW’s depiction of slavery and the civil era American south, or, in the alternative, that the doctrine of fair use protects TWDG because it is primarily a parody of GWTW.21

Subsequently, SunTrust initiated an action against Houghton Mifflin, alleging copyright infringement, violation of the Lanham Act, and deceptive trade practices.22 SunTrust also moved for a preliminary injunction to stay the publication of TWDG.23 The district court granted SunTrust the preliminary injunction, enjoining Houghton Mifflin from further production, display, distribution, advertising, sale, or offer for sale of TWDG.24 It found that TWDG was substantially similar to GWTW, that TWDG was a sequel and not a parody, and thus it was unlikely that Houghton Mifflin would prevail on a fair use defense.25 The district court further held that the effect of the allegedly infringing use on the market value of GWTW weighed in favor of SunTrust, and Houghton Mifflin did not rebut the presumption of irreparable injury to SunTrust.26 Houghton Mifflin appealed this decision to the Eleventh Circuit Court of Appeals.

19. See id.
20. See SunTrust Bank, 268 F.3d at 1259.
21. See id.
22. See id.
23. See id.
25. See id. at 1385–86 (holding that the TWDG consisted of actionable copying because of the substantial similarity in both quantitative and qualitative terms and that defendant’s use of GWTW was both excessive and went well beyond what was necessary to create a parody).
26. See id. at 1384, 1386. In balancing the respective interests of the parties, Judge Panelli concluded that any harm to Houghton Mifflin in delaying publication was outweighed by the potential harm to SunTrust, in ways that would be difficult to compensate with money damages.
III. THE ELEVENTH CIRCUIT’S DECISION AND ANALYSIS

On appeal, the circuit court had to decide whether the injunctive relief granted by the district court was appropriate.\(^\text{27}\) SunTrust therefore had to prove there was a substantial likelihood of success on the merits and it would likely suffer irreparable injury were the injunction not granted.\(^\text{28}\)

\textit{A. SunTrust Established Prima Facie Copyright Infringement}

Initially, the circuit court upheld the district court’s finding that SunTrust had established the prima facie elements of a copyright infringement claim.\(^\text{29}\) Specifically, the court determined that SunTrust owns a valid copyright in \textit{GWTW} and that Randall copied original elements of \textit{GWTW} in \textit{TWDG}.\(^\text{30}\)

Houghton Mifflin did not contest that SunTrust owns a valid copyright in \textit{TWDG}.\(^\text{31}\) Instead, it argued that there is no substantial similarity between the two works, or in the alternative, that the doctrine of fair use protects \textit{TWDG} because it is primarily a parody of \textit{GWTW}.\(^\text{32}\) After careful examination of both books, the circuit court found that, indeed, \textit{TWDG} had substantially appropriated numerous characters, settings, and plot twists from \textit{GWTW}, even though they were “vested with a new significance” in \textit{TWDG}.\(^\text{33}\)

\textit{B. The Fair Use Factors Weighed In Favor of Houghton Mifflin}

The fact that there is substantial similarity between the two works does not end the circuit court’s inquiry. In fact, “Randall’s appropriation of elements of \textit{GWTW} in \textit{TWDG} may nevertheless not constitute infringement of SunTrust’s copyright if the taking is protected as a ‘fair use.’”\(^\text{34}\)

\begin{itemize}
\item \(^\text{27}\) See SunTrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1260 (11th Cir. 2001).
\item \(^\text{28}\) See id. at 1265.
\item \(^\text{29}\) See id. at 126–67.
\item \(^\text{30}\) See id.
\item \(^\text{31}\) See id. at 1266.
\item \(^\text{32}\) See id. at 1259.
\item \(^\text{33}\) See SunTrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1267 (11th Cir. 2001). The circuit court found that, although the author used different names, \textit{TWDG} appropriated many of the characters of \textit{GWTW}. \textit{Id.} For example, Scarlett becomes “Other,” Rhett Butler becomes “R.B.,” Pork becomes “Garlic,” Prissy becomes “Miss Priss,” Philippe becomes “Feleepe,” Aunt Pittypat becomes “Aunt Pattypitt,” etc. \textit{Id.} \textit{TWDG} also appropriates many aspects of \textit{GWTW}’s plot, such as the scenes in which Scarlett kills a Union soldier and the scene in which Rhett stays in the room with his dead daughter Bonnie, burning candles. \textit{Id.}
\item \(^\text{34}\) \textit{Id.}
\end{itemize}
To claim the protection of the fair use doctrine, Houghton Mifflin argued that *TWDG* is a parody of *GWTW*. In *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court held that parody is "a form of comment and criticism that may constitute a fair use of the copyrighted work being parodied." Moreover, the Supreme Court held that parody needs to copy elements from the original work in order to "conjure up" that original work in a reader's mind. Therefore, the first task for the circuit court before applying the fair use factors was to determine whether *TWDG* is a parody entitled to the fair use defense.

In defining "parody," the circuit court adopted the broader view developed under *Campbell*. In the court's opinion, the definition of "comic effect or ridicule" in *Campbell* was too narrow and subjective. It thus derived a broader definition from the Supreme Court's discussion in that case in terms of the parody's "'commentary' on the original." The circuit court declared:

In light of the admonition in *Campbell* that courts should not judge the quality of the work or the success of the attempted humor in discerning its parodic character, we chose to take the broader view. For purposes of our fair use analysis, we will treat a work as a parody if its aim is to comment upon or criticize a prior work by

35. See id. at 1268.
36. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994). In *Campbell*, Acuff-Rose Music sued members of the rap music group 2 Live Crew and their record company, claiming that 2 Live Crew's song "Pretty Woman" infringed Acuff-Rose's copyright in Roy Orbison's rock ballad, "Oh, Pretty Woman." Id. at 571. The Supreme Court held that the commercial character of a song parody did not in itself create a presumption against fair use. Id. at 594. Furthermore, the Court explained, a true parody has transformative value. In order for the use to be transformative, the copyrighted material must be used for a purpose different from the purpose of the original work, or must be used in a different manner, altering the original with new impression, meaning, or message. Id. at 579–80. Therefore, the Court reasoned, "the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding against fair use." Id. at 578.
37. See id. at 587 (quoting Elsmere Music, 623 F.2d at 253 n.1 and Fisher v. Dees, 794 F.2d. at 438–39). The Supreme Court also distinguished parodies from other forms of commentary, specifically satire, and found that a parody is entitled to a fair use analysis because a parody needs to mimic an original to make its point, whereas a satire can stand on its own two feet. It does not need to borrow from the original, thus requiring justification for the very act of borrowing. Id. at 580–81.
38. See SunTrust Bank, 268 F.3d at 1268.
39. See SunTrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1268–69 (11th Cir. 2001). The circuit court believed the narrow definition of parody would result in wholly subjective inquiries into whether or not a work is "humorous." See id. at 1269 n.23.
40. Id. at 1268.
appropriating elements of the original in creating a new artistic, as opposed to scholarly or journalistic, work.\textsuperscript{41}

Under this broader definition of parody, the court found that the "parodic character" of \textit{TWDG} was clear.\textsuperscript{42} \textit{TWDG} is not a general commentary upon Civil-War era American South, but specifically criticizes the depiction of slavery and the relationship between blacks and whites in \textit{GWTW}.\textsuperscript{43} It provides a different viewpoint by flipping \textit{GWTW}'s traditional race roles and subsequently tells a completely new story that features plot elements unique to \textit{TWDG}.\textsuperscript{44}

After determining \textit{TWDG} is a parody under \textit{Campbell}, the circuit court proceeded to analyze \textit{TWDG} under the four fair use factors as applied to parodies.

1. Purpose and Character of the Work

The first factor, the purpose and character of the allegedly infringing work, has several facets. The circuit court first examined whether \textit{TWDG} serves a commercial purpose or nonprofit educational purpose.\textsuperscript{45} Because \textit{TWDG} is undoubtedly a commercial product, the court found this particular factor weighs against a finding of fair use.\textsuperscript{46} However, the transformative value of the new work can overcome the fact that the new work is published for profit.\textsuperscript{47} Moreover, the Supreme Court in \textit{Campbell} held that "the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use."\textsuperscript{48}

The circuit court therefore had to determine to what extent \textit{TWDG}'s use of copyrighted elements of \textit{GWTW} is transformative.\textsuperscript{49} Under this factor, a work is transformative if it "adds something new, with a further purpose or different character", and if it does not simply try to "avoid the drudgery in working up something fresh."\textsuperscript{50} Judging from this standard, the circuit court concluded \textit{TWDG}'s use

\begin{itemize}
\item \textsuperscript{41} \textit{Id.} at 1268–69.
\item \textsuperscript{42} \textit{See id.} at 1269.
\item \textsuperscript{43} \textit{See id.}
\item \textsuperscript{44} \textit{See id.} at 1270.
\item \textsuperscript{45} \textit{See SunTrust Bank v. Houghton Mifflin Co.}, 268 F.3d 1257, 1269 (11th Cir. 2001).
\item \textsuperscript{46} \textit{See id.}
\item \textsuperscript{47} \textit{See id.}
\item \textsuperscript{48} \textit{Id.} (quoting \textit{Campbell} v. Acuff-Rose Music Inc., 510 U.S. 569, 579 (1994)).
\item \textsuperscript{49} \textit{See id.}
\item \textsuperscript{50} \textit{Id.} at 1271 (quoting \textit{Campbell}, 510 U.S. at 579).
\end{itemize}
of the original elements of *GWTW* was highly transformative.\(^5\) *TWDG* is told from a different viewpoint, a different perspective, and tells a completely new story.\(^2\) In addition, *TWDG* is "more than an abstract, pure fictional work. It is principally and purposefully a critical statement that seeks to rebut and destroy the perspective, judgments, and mythology of *GWTW*."\(^5\) To achieve this goal, *TWDG* had to rely heavily on the copyrighted material in *GWTW* to attack that book effectively.\(^4\) The commercial purpose of *TWDG* is therefore strongly "overshadowed and outweighed" in view of *TWDG*’s highly transformative use of *GWTW*’s copyrighted elements.\(^5\) Accordingly, the first factor of fair use was held in favor of Houghton Mifflin.\(^6\)

### 2. Nature of the Copyrighted Work

Because *GWTW* is an original work of fiction, it is generally afforded the greatest degree of protection.\(^5\) However, in parody cases, this factor is no longer decisive because parodies are more likely based on publicly known and creative works.\(^8\)

### 3. Amount and Substantiality of the Portion Used

In analyzing this factor, the circuit court first noted that *TWDG* appropriated a substantial portion of the protected elements of *GWTW*.\(^5\) However, this does not necessarily weigh against a finding of fair use. Taking the language in *Campbell*, the circuit court interpreted the Supreme Court’s decision as *not* requiring that parodists "take the bare minimum amount of copyright material necessary to conjure up the original work."\(^6\)

When the use does more than conjure up the original work, two factors are important in determining whether the more extensive use

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52. See id. at 1270–71.
53. Id. at 1270.
54. See id. at 1271.
55. Id. at 1269.
56. See id. at 1271.
58. See id.
59. See id. at 1272.
60. Id. at 1273. The court went on to state that "parody ‘must be able to conjure up at least enough of [the] original to make the object of its critical wit recognizable.’” Id. (emphasis added) (quoting Campbell v. Acuff-Rose Music Inc., 510 U.S. 569, 588 (1994)).
is reasonable and thus still qualifies as fair use. First, the court had to consider “the extent to which the [work’s] *overriding purpose and character is to parody* the original.” The second factor, in contrast, looks to “the likelihood that the parody may serve as a *market substitute* for the original.” The circuit court was unable to reach a conclusion at this preliminary injunction stage as to whether the quantity and quality of copying by *TWDG* were reasonable in relation to the purpose of the copying, given the amount of evidence on the record. Therefore, this fair use factor favored neither party.

### 4. Effect on the Market Value of the Original

Under the final fair use factor, the circuit court had to look at the effect that the publication of *TWDG* would have on *GWTW*’s market value. According to *Campbell*, the court not only must consider “the extent of market harm caused by the particular actions of the alleged infringer, but also whether unrestricted and widespread conduct of the sort engaged in by the defendant would result in a substantially adverse impact on the potential market” for the original.

The circuit court found that the evidence proffered by SunTrust merely focused on the value of its copyright in *GWTW* and the profit-making power of its authorized derivatives. Consequently, SunTrust did not establish that *TWDG* acted as a market substitute nor did it prove that *TWDG* would significantly harm its derivatives. In contrast, Houghton Mifflin was able to demonstrate why *TWDG* was unlikely to displace sales of *GWTW*, in light of the appeal to different readers other than *GWTW* fans. The Court thus held that the fourth factor weighed in favor of fair use.

### C. SunTrust was Not Entitled to the Preliminary Injunction

After concluding that SunTrust had not established its likelihood of success on the merits, the court further held that SunTrust failed to show irreparable injury for the injunctive relief as well. Moreover, the circuit court held that it was unnecessary to address the remaining

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61. *See id.* at 1273.
62. *Id.*
64. *See id.* at 1274.
65. *Id.* at 1274 (quoting *Campbell*, 510 U.S. at 590).
66. *See id.* at 1274–75.
67. *See id.* at 1275. The Court opined that *TWDG* would have “little to no appeal to the fans of *GWTW*.” *Id.* at 1276.
factors except to stress that "public interest is always served in promoting First Amendment values and in preserving the public domain from encroachment." 68 Thus, the court vacated the district court's injunction and remanded the case for further proceedings.

IV. CONCLUSION

Parody has been a subject of controversy in the copyright field since the turn of the century. Although it may at times be considered "parasitic" art or be written with malice, parody is as "fundamental to literature as is laughter to health."69 Initially, federal courts found parody to be a copyright infringement.70 Throughout the twentieth century, especially in the wake of the First Amendment rights, courts have been struggling with the proper balance. The Supreme Court's decision in Campbell tipped that balance in favor of First Amendment advocates and proved to be a win for parodists.

The decision of the Eleventh Circuit Court of Appeals in the SunTrust case is significant to the fair use doctrine jurisprudence in several aspects. First, it adopted a broader definition of parody derived from the Campbell case in an effort to make the definitional battle a more objective inquiry. In Campbell, the Supreme Court announced that parodies are afforded the fair use protection against infringement claims.71 However, how to determine whether a particular work falls within the protected arena proves to be a somewhat difficult task for courts. After Campbell, the results have been inconsistent among the circuit courts in determining whether or not a particular work may be labeled as a parody.72 The Eleventh Circuit believed that, by focusing on whether parodies "comment

68. Id. at 1276.
69. Lehr, supra note 10, at 448 (quoting Randall B. Hicks, Note, Requiem for a Parody, 8 Hastings Comm. & Ent. L.J. 55, 58-59 (Fall 1985)).
72. See generally Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir. 1997) (holding that defendant's poetic account of the O.J. Simpson double murder trial, entitled The Cat NOT in the Hat! A Parody by Dr. Juice did not constitute fair use of plaintiff's copyrighted work, The Cat in the Hat, on the grounds that although the defendant's work "broadly mimicked" the original style, it did not "hold his style up to ridicule," and had "no critical bearing on the substance or style of The Cat in the Hat." Id. at 1001). Cf. Leibovitz v. Paramount Pictures Corp., 948 F. Supp. 1214, 1218 (S.D.N.Y. 1996) (rejecting plaintiff's claim that defendant's use of a movie poster depicting Leslie Nielsen, the star of the marketed movie, NAKED GUN 33 1/3, in the same pose as Leibovitz's copyrighted image of naked and pregnant film star, Demi Moore, did not amount to fair use on the grounds that defendant's poster, in addition be being sufficiently transformative, did indeed provide social commentary).
upon or criticize a prior work” and not if “a work is humorous,” courts will avoid “censoring distasteful parodies based on their subjective interpretation of a parody’s true meaning.”\textsuperscript{73}

The circuit court’s lenient treatment of the amount of the copyrighted material that can be appropriated by parodists is also noteworthy. Under the court’s analysis, more extensive use of original elements of the copyrighted work can still qualify as fair use depending on the purpose of the parody or the market impact on the copyrighted work as a substitute.\textsuperscript{74} This “reasonable amount” approach therefore gives parodists more room to do more than merely conjure up another work.

The circuit court’s interpretation of the definition of parody and of how to apply the four fair use factors have made it more likely for parodists to defend their works successfully against copyright infringement actions. Consequently, this decision has the effect of tipping the scale toward the First Amendment rights over copyright owners’ interests. It will be noteworthy to see if this more “First-Amendment-protective position” will be followed by the rest of the circuit courts.

\textsuperscript{73} SunTrust Bank, 268 F.3d at 1268–69.
\textsuperscript{74} Id. at 1273.