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Rush Prudential HMO v. Moran: Federal Intervention Looms as Supreme Court Rules that ERISA Does Not Preempt State Laws Requiring Independent Review of Medical Necessity Decisions and Lays Groundwork for Different Independent Review Provisions from All Fifty States

Lindsey G. Churchill

THE WIND DONE GONE: PARODY OR PIRACY? A COMMENT ON SUNTRUST BANK V. HOUGHTON MIFFLIN COMPANY

INTRODUCTION

The recent publication of Alice Randall's *The Wind Done Gone* (*TWDG*)[1] created more of a stir in legal circles than in literary ones.[2] Alice Randall used elements from *Gone with the Wind* (*GWTW*)[3] to "retell" Margaret Mitchell's famous tale, this time from the perspective of Cynara, a newly imagined mulatto half-sister of Scarlett (named "Other" in *TWDG*).[4] The Mitchell Trusts, who own the *GWTW* copyright, sought to enjoin further publication and distribution of *TWDG*.[5] The conflict that followed centered on the "blurry boundary between unlawful plagiarism and legitimate critical reinterpretation."[6] For the U.S. District Court for the Northern District of Georgia and the United States Court of Appeals for the Eleventh Circuit, the case presented an opportunity to revisit an issue

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1. ALICE RANDALL, THE WIND DONE GONE (2001).

2. Megan Harlan, *Books in Brief: Fiction, The Wind Done Gone, By Alice Randall*, N.Y. TIMES, July 1, 2001, § 7, at 16 ("Alas, the legal battle surrounding this first novel is more interesting than the book itself").

3. MARGARET MITCHELL, GONE WITH THE WIND, (Warner Books 1993) (1936).

4. The names of the original characters are changed in *TWDG*. Cynara's mother is the same Mammy from *GWTW*, but her father, Gerald O'Hara in *GWTW*, is "Planter" in *TWDG*. Rhett Butler is "R.B.," "R.," or "Debt Chauffeur," Bonnie Butler becomes "Precious," Melanie becomes "Mealy Mouth," Ashley Wilkes becomes "Dreamy Gentleman," and so on. For a complete name comparison chart, see Affidavit of Jessie Beeber, *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701) (*Suntrust I*), *vacated by* 268 F.3d 1257 (11th Cir. 2001) (*Suntrust II*).

5. *See Suntrust I*, 136 F. Supp. 2d at 1363. Margaret Mitchell's nephews inherited the *GWTW* copyright after the successive deaths of Mitchell, her husband, and Mitchell's brother, their father. Suntrust is the trustee of the Mitchell Trusts. Jill Vejnoska, *Guardians of the 'Wind': Scarlett O'Hara's Fight for Tara May Pale in Comparison to the All-Out Legal Battle Erupting Over Who Can 'Exploit' the Characters in an American Classic*, ATLANTA J. & CONST., Apr. 8, 2001, at F1.

6. David D. Kirkpatrick, *Court Halts Book Based on 'Gone With The Wind'*, N.Y. TIMES, April 21, 2001, at A1.

Learned Hand called "the most troublesome in the whole law of copyright"—fair use.[7]

The fair use doctrine has always protected commentary, criticism, and scholarly appropriation of copyrighted materials from claims of copyright infringement.[8] Since the Supreme Court decided in *Campbell v. Acuff-Rose Music, Inc.*,[9] that 2 Live Crew's rap version of "Oh, Pretty Woman" could claim fair use as a parody, the fair use doctrine has protected parody as well.[10] Although both the district court and the circuit court agreed that *TWDG* borrows extensively from *GWTW,* whether it did so solely in the pursuit of parody became the ultimate question in the case.[11] The district court found that *TWDG* was primarily a sequel; the circuit court, in reversing the lower court's decision, said the book was primarily a parody.[12] Both courts relied heavily on the *Campbell* decision to arrive at opposite conclusions.[13]

In *Campbell*, although the Court confirmed that parody could be a legitimate fair use defense to infringement, some questions remained unresolved.[14] For example, courts still differ on a legal definition of parody for the purposes of fair use defense analysis.[15] Some courts

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7. Dellar v. Samuel Goldwyn, Inc., 104 F.2d 661, 662 (S.D.N.Y. 1939).

8. *See* 17 U.S.C. § 107 (1976); *infra* Part II.

9. 510 U.S. 569 (1994).

10. *Id.* Before the *Campbell* decision, courts generally focused on the degree of similarity between a parody and its object, ignoring the rationale of fair use. *See* Sheldon N. Light, *Parody, Burlesque, and the Economic Rationale of Copyright*, 11 CONN. L. REV. 615, 626 (1979).

11. *Suntrust II*, 268 F.3d 1257, 1266-67 (11th Cir. 2001) (noting that seventeen renamed *GWTW* characters appear in *TWDG*, along with the renamed plantation home and memorable scenes such as Scarlett killing a Union soldier and Rhett burning candles for hours in a room with his deceased daughter Bonnie); Declaration of Barbara McCaskill at 1, ¶ 3, *Suntrust I.*, 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701-CAP) ("*TWDG* is a parody of *GWTW* because it ridicules *GWTW* and the Southern aristocracy that the book mythologizes, as well as the novel's portrayal of the social and political climates of slavery, the Civil War, and Reconstruction"). *Contra* Affidavit of Gabriel Motola, at 3, ¶ 7, *Suntrust I*, 136 F. Supp. 2d 1357 (No. 1:01 CV-701-CAP) ("[In *TWDG*] the line between parody and plagiarism has been breached . . . . The reader therefore sees the latter work [*TWDG*] as a sequel to the original.").

12. *Suntrust II*, 268 F.3d at 1271.

13. *Suntrust I*, 136 F. Supp. 2d at 1372-83; *Suntrust II*, 268 F.3d at 1271.

14. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

15. *See* Note, *The Parody Defense to Copyright Infringement: Productive Fair Use After Betamax*, 97 HARV. L. REV. 1395, 1401-07 (1984) [hereinafter *The Parody Defense*] (discussing the varying

state that a true parody must target the original work from which it borrows, while others say it may use the borrowed work as a weapon to comment on or ridicule something else.[16] Additionally, courts still disagree on whether, even if a work is found to be a parody, the law limits how much it may take from the original.[17]

This Comment reviews how the courts dealt with these questions in the case of *Suntrust Bank v. Houghton Mifflin Co.,* and whether that decision advances the goal of copyright law in general and the fair use doctrine in particular. This Comment also proposes that further broadening the definition of parody beyond the definition in *Campbell*, although in line with the goal of copyright law to have the freest possible access to and dissemination of knowledge, could weaken the incentive offered to those who create and develop the knowledge. By lowering the threshold to allow more allegedly infringing works the opportunity to claim fair use as a defense, the court not only departs from *Campbell*'s guidelines, but fails to recognize that the granted term of copyright well exceeds the purpose it is intended to serve.

Part I provides a brief overview of the history and scope of copyright protection. Part II explains the fair use doctrine and how it applies to parody, including a brief description of the leading parody

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parody doctrines of the Ninth and Second Circuits). The *Campbell* decision itself provided more than one definition of parody. *Campbell*, 510 U.S. at 580-82.

16. *See Campbell*, 510 U.S. at 580-82 (stating that parody must at least in part, comment on the original); MCA, Inc. v. Wilson, 677 F.2d 180, 185 (2d Cir. 1981) (stating that permissible parody should target the original, but may also reflect on life in general). For a more strict limitation on the definition of parody see *Dr. Seuss Enter. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400 (9th Cir. 1997), which identifies the distinguishing factor between parody and satire as the fact that parody must target the original, while satire may use the original to poke fun at another target. *But see* Elsmere Music, Inc. v. Nat'l Broad. Co., 482 F. Supp. 741, 746 (S.D.N.Y. 1980) (disagreeing with the requirement that there be an identity between the work copied and the subject of the parody).

17. *See Campbell*, 510 U.S. at 589 (remanding on the issue for the lower court to reconsider whether it contained no more than necessary to conjure up the original, in relation to the parodic purpose); *see also* Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 757 (9th Cir. 1978) (holding that parodists could take no more than necessary to conjure up the originals). *But see Elsmere Music, Inc.*, 482 F. Supp at 747 (finding it acceptable, in order to further the parodic purpose, to repeat the borrowed material, even after enough of the original was conjured up); Leibovitz v. Paramount Pictures Corp., 137 F.3d 109, 116 (2d Cir. 1998) (stating that taking more of an original than is minimally necessary to conjure it up will not weigh against fair use).

case, *Campbell v. Acuff-Rose Music, Inc.*[18] Part III relates the background of the *Suntrust Bank v. Houghton Mifflin Co.* case. The first section of Part IV discusses the district court opinion, followed by the circuit court opinion on the prima facie case of infringement, where the courts agreed. The second section of Part IV relates the courts' differing opinions on the fair use defense analysis. This Comment concludes that although the circuit court's decision reaffirms *Campbell*'s central holding that copyright law sufficiently protects parody, the circuit court's fair use analysis departs from *Campbell* in significant ways that add confusion, not clarity, to this area of the law.

I. BRIEF OVERVIEW OF COPYRIGHT PROTECTION

A. History of Copyright

English common law held that one had a property right to the product of his intellectual labor.[19] The Statute of Anne[20] first codified the recognized rights of authors and granted "authors and their assigns" the sole right of publication for a renewable term of years.[21] The basis for the law was to compensate an author by granting him a limited monopoly, but the government retained the right to lower unfairly high book prices upon the public's petition.[22] Thus, from the beginning of copyright law, the government sought to promote public access to new ideas while simultaneously encouraging authors to create them. Much of continental Europe took a different route, treating an author's right in his work as a fundamental "moral right."[23] French law, in particular, recognized

18. 510 U.S. 569 (1994).
19. *See* WILLIAM F. PATRY, LATMAN'S THE COPYRIGHT LAW 4-6 (6th ed. 1986).
20. *Id.* at 4 (citing 8 Ann. c. 19 (1710)(Eng.)).
21. *Id.* at 4-6.
22. *Id.* at 4.
23. *See* Brian T. McCartney, *Creepings and Glimmers of the Moral Rights of Artists in American Copyright Law*, 6 UCLA ENT. L. REV. 35, 36 (1998).

and sought to protect the "intimate bond" between an author's personality and his work.[24] This view of copyright established the author's control over his work as paramount—beyond a limited property right and superceding society's right of access to it.[25]

U.S. copyright law derives from the English, utilitarian theme by proposing to advance creative expression for the benefit of the public at large by granting a copyright to the individual author as both an economic incentive and a reward.[26] Article I, § 8, cl. 8 of the U.S. Constitution granted the power to Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Respective Writings and Discoveries."[27] The ultimate aim was to promote broad public availability of literature, music, and the arts for the public good.[28] The copyright granted a limited monopoly as an incentive to encourage authors to create.[29] The competing claims of the public interest were to be balanced by the time limit imposed on the right.[30] The public would have complete access to the work after the term of protection expired, when it entered the public domain.[31]

Authorized by the Constitution, with an eye toward resolving conflicting state copyright laws, Congress passed the first national

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24. *See id.* at 36 (explaining the extent of integrity and paternity rights recognized in Europe that afford the author much greater and longer lasting control over an original work).

25. *See* Jane C. Ginsberg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 TUL. L. REV. 991, 993 (1990). U.S. law does not explicitly recognize "moral rights" of authors of original works. *See* Gilliam v. American Broad. Co., 538 F.2d 14, 24 (2d Cir. 1976); *see also* Choe v. Fordham Univ. Sch. of Law, 920 F. Supp. 44 (S.D.N.Y. 1995) (finding author of law review article had no protection under copyright law from alleged "mutilation" of his article under a claim of "moral right").

26. Ginsberg, *supra* note 25, at 1000; ROBERT P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE, at 351 (2d ed. 2000).

27. U.S. CONST. art. I, § 8, cl. 8.

28. MERGES ET AL., *supra* note 26, at 351.

29. *Id.* at 351.

30. *Id.* at 351; *see* Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984) ("[This] limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.").

31. MERGES, *supra* note 26, at 352.

copyright law, the Copyright Act of 1790,[32] with very little debate.[33] The law granted an author the exclusive right to "print, reprint, publish, or vend" the work, limited to books, for fourteen years with an additional fourteen year renewal.[34] The Copyright Act of 1909[35] significantly expanded the scope of protection from books to "all writings," and extended the length of protection to twenty-eight years, with an additional twenty-eight years upon renewal.[36] The Copyright Act of 1976[37] (the Copyright Act) also expanded the scope of copyright law to include unpublished writing, codified the judicially created "fair use" doctrine, and preempted much state and common copyright law.[38] The Copyright Act again expanded the term of copyright to the life of the author plus fifty years, among other provisions.[39] In 1998, Congress extended the term to the life of the author plus seventy years, under the terms of the Sonny Bono Copyright Term Extension Act (CTEA).[40]

Critics have called these continual congressional extensions of the protected term of years unwise and even unconstitutional.[41] But

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32. *See id.* at 347 (citing 1 Stat. 124 (1790)).

33. *Id.*

34. *See* PATRY, *supra* note 19, at 4-6. Subsequent amendments expanded the scope to include prints, musical compositions, dramatic works, photographs, artistic works and, sculpture. *See* MERGES, *supra* note 29, at 347.

35. *See* PATRY, *supra* note 19, at 9, n.34.

36. *See* MERGES, *supra* note 26, at 347.

37. 17 U.S.C. § 102 (1994).

38. MERGES, *supra* note 26, at 348.

39. Congress modified the Copyright Act in 1980 to expressly incorporate computer programs into the Copyright Act for the first time. MERGES, *supra* note 26, at 348.

40. 17 U.S.C. § 302(a) (1994).

41. *See* Stephen Breyer, *The Uneasy Case For Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs,* 84 HARV. L. REV. 281, 323-29 (1970) (arguing against extending the term of protection under the 1976 Copyright Act to the life of the author plus fifty years, citing the lack of a "single interest group" advocating for dissemination to counter the strong interest group of copyright holders having a vested financial interest in pressing Congress to extend protection); *see also* Dan Gillmor, *Copyright Tempest Over "The Wind Done Gone" Is Outrageous*, SAN JOSE MERCURY NEWS, Apr. 25, 2001, at 1C ("Margaret Mitchell, who is dead, doesn't need any further incentive to write 'Gone With The Wind.'"); Lawrence Lessig, *Let the Stories Go,* N.Y. TIMES, Apr. 30, 2001 (pointing out that absent the CTEA extension, the copyright on *Gone With The Wind* would have, and should have expired in 1992); William Safire, *Essay: Frankly, My Dear . . .*, N.Y. TIMES, May 14, 2001, at A15 (acknowledging that, as a writer, he appreciates that copyright protection secures reward for himself and his heirs for the "sweat of [his] brain," yet calling the CTEA extension

courts have consistently held that the Constitution grants to Congress, not the courts, the right to decide the term of copyright.[42] In addition, the Copyright Act's idea/expression dichotomy and the latitude the Act affords through fair use adequately protects First Amendment free speech guarantees.[43]

B. Scope of Copyright Protection

The Copyright Act codifies the requirements of copyrightable subject matter: "Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . ."[44] The Copyright Act limits copyright protection to an author's expression, not his idea(s): "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."[45] As the Supreme Court emphasized in *Harper & Row v. Nation Enterprises*:[46] "No author may copyright his ideas or the facts he narrates."[47] By protecting only a particular expression of an idea, the idea/expression dichotomy helps to ensure free access to ideas, and thus avoids confrontation with the First Amendment guarantee of free speech.[48]

"unconscionable"); James Surowiecki, *The Financial Page: Righting Copywrongs*, THE NEW YORKER, Jan. 21, 2002, at 27. One group has sued, claiming that CTEA is unconstitutional because it expands the "limited time" provision of the Constitutional article beyond the time needed to further the objective of "promot[ing] the . . . useful [a]rts." *See* Eldred v. Reno, 239 F.3d 372, 374 (D.C. Cir. 2001), *petition for reh'g denied sub nom,* Eldred v. Ashcroft, 255 F.3d 849 (D.C. Cir. 2001) (challenging as unconstitutional the right of Congress to continue to extend copyright protection); *see also Copyright Craziness,* THE WASHINGTON POST, Aug. 17, 2001, at A22; *Drawing a Line on Copyright*, ST. PETERSBURG TIMES, Aug. 21, 2001, (Opinion) at 6A.

42. *See Eldred*, 239 F.3d at 380.

43. *Id.* at 375.

44. 17 U.S.C. § 102(a) (2000).

45. *Id.* § 102(b).

46. 471 U.S. 539 (1985).

47. *Id.* at 556.

48. *See* Janice E. Oakes, *Copyright and The First Amendment: Where Lies the Public Interest?*, 59 TUL. L. REV. 135, 137 (1984).

C. Infringement of Copyright

To show a prima facie case of infringement in a copyright action, the copyright holder must show (1) that he owns the copyright, and (2) that the defendant copied the original so that (3) it constituted an unlawful appropriation.[49] If no direct proof of copying exists, the plaintiff may prove copying by demonstrating that (1) the defendant had access to the original, and (2) substantial similarity exists between the alleged infringement and the original.[50] Substantial similarity requires that the copying be both "quantitatively *and* qualitatively sufficient to support the legal conclusion that infringement (*actionable* copying) has occurred. The qualitative component concerns the copying of expression, rather than ideas . . . . The quantitative component generally concerns the amount of the copyrighted work that is copied . . . ."[51] Courts have applied various tests, such as the "ordinary observer"[52] test, the "total concept and feel"[53] test, the "fragmented literal similarity"[54] test, or the "comprehensive nonliteral similarity"[55] test to determine whether works are substantially similar.[56]

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49. PATRY, *supra* note 19, at 191.

50. *Id.*

51. *See* Castle Rock Entm't, Inc. v. Carol Pub. Group, Inc., 150 F.3d 132, 138 (2d Cir. 1998) (citing Ringgold v. Black Entm't Television, Inc., 126 F.3d 70, 75 (2d Cir. 1997)).

52. *See* 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03 [E][1][b] 13-79 (1963). Also called the "audience test," the ordinary observer test determines whether an ordinary reasonable man perceiving both works would be able to detect piracy without the aid of suggestion or critical analysis by others. *Id.*

53. *Id.* § 13.03 [A][1](c) 13-36. Courts have applied the total concept and feel test when considering works that are less complex, such as children's books and greeting cards, to determine whether a "remarkable resemblance" exists. *Id.*

54. *Id.* § 13.03 [A](2) 13-45. Fragmented literal similarity can be found when a work literally copies part, but not all of an original, and the court must make a value judgment of the qualitative importance of the amount copied, be it one line or four hundred words. *See id.*

55. *Id.* § 13.03 [A][1] 13-29 to 30. Comprehensive nonliteral similarity can be found when a work does not literally duplicate an original's fundamental essence or structure, but paraphrases it, and therefore can still be found to be substantially similar. *Id.*

56. *See Castle Rock Entm't, Inc.*, 150 F.3d at 139-40.

II. THE FAIR USE DOCTRINE

A. The Source of the Fair Use Doctrine

Tension exists between the dual guiding principles in copyright law.[57] The desire to have the freest possible access to and dissemination of knowledge directly competes with the need to restrict that access as an incentive to those who create and develop the knowledge.[58] Fair use is an affirmative defense to copyright infringement, which limits the temporary monopoly granted by copyright "in furtherance of its utilitarian objective" by allowing use of copyrighted material for "criticism, comment, news reporting, teaching, . . . scholarship, or research."[59] In other words, use of copyrighted material without permission is fair when public policy demands that the public interest is greater than the private interest of the copyright holder.[60]

The fair use doctrine was first articulated by Justice Story in *Folsom v. Marsh.*[61] In *Folsom*, the defendant copied letters of George Washington from a copyrighted twelve-volume work to create an 866-page autobiography, 388 pages of which were copied verbatim.[62] The letters were of great public interest and the secondary book was a short book, which would have increased the public's access to the letters.[63] Nevertheless, the court found the letters were proper subjects of copyright, and the copyright was infringed.[64] Justice Story stated that to find fair use one could "look to the nature and objects of the selections made, the quantity and

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57. LEON E. SELTZER, EXEMPTIONS AND FAIR USE IN COPYRIGHT 3 (1978).

58. *Id.*

59. Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1110 (1990); 17 U.S.C. § 107 (1976).

60. *See* Light, *supra* note 10, at 623.

61. 9 F. Cas. 342 (C.C. Mass. 1841) (No. 4901).

62. *Id.* at 343.

63. *Id.* at 349.

64. *Id.* Justice Story related his reluctance to find infringement and thus limit the dissemination of the material, underscoring once again the difficulty inherent in balancing the competing interests underlying copyright law. *Id.*

value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work."[65]

Judges continued to apply fair use as an equitable rule of reason until 1976, when the Copyright Act codified both the types of works that trigger a consideration of fair use and the four factors to be balanced, including:

> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.[66]

As codified, fair use still operates as a "vague" doctrine.[67] The use of the words "such as" and "including" continues the common-law tradition of fair use adjudication that requires a case-by-case analysis rather than bright-line rules.[68] If there is a bright-line rule in fair use analysis, it is that each case must be decided on its own facts.[69] Thus, when an alleged infringer asserts fair use in his defense of an unenumerated use, such as parody, the fair use factors are applied, and "are all to be explored, and the results weighed together, in light of the purposes of copyright."[70]

B. Parody —A Fair Use Defense to Infringement

Parody, by its very nature, is in direct conflict with copyright.[71] Because parody derives its usually humorous purpose from mocking

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65. *Id.* at 348.
66. 17 U.S.C. § 107 (1976). *Compare* 17 U.S.C. § 107 *with* PATRY, *supra* note 19, at 239-41.
67. *See* Light, *supra* note 10, at 623.
68. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 577 (1994).
69. *Id.*
70. *Campbell*, 510 U.S. at 578.
71. *See* Light, *supra* note 10, at 616.

another, usually serious work, its very existence rests upon the opportunity to copy the existing work.[72] "Parody is imitation. And imitation, when it is of an expressive work such as a novel or play or movie, is a taking."[73] Thus, in many parody cases, prima facie infringement is easily found.[74]

Although not enumerated in 17 U.S.C. § 107, courts have long recognized that the fair use provision in the Copyright Act protects parody.[75] Because copyright law seeks to promote broad public availability of literature, music, and the arts for the public good, recognizing a fair use defense for parody in copyright infringement cases allows society to realize the benefit of this socially useful literary genre.[76]

Before the *Campbell* decision, application of the four fair use factors in parody cases led to varying results, even in similar cases, usually because the courts focused "on the degree of similarity between the parody and its object, . . . ignor[ing] the rationale of the fair use doctrine."[77] In *Benny v. Loew's Inc.*,[78] the Ninth Circuit affirmed a lower court decision that "Autolight," a televised takeoff that followed the story line of the film "Gaslight," was not a fair use because it took too much from the original.[79] In *Columbia Pictures Corp. v. National Broadcasting. Co.*,[80] on virtually the same facts, the same court found that Sid Caesar's televised "From Here to Obscurity," which lampooned the film "From Here to Eternity," was

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72. *Id.*

73. Richard A. Posner, *When Is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 67 (1992).

74. *Id.* at 69.

75. *See* Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 1034 (11th Cir. 1986); *see also* Rogers v. Koons, 960 F.2d 301, 310 (2d Cir. 1992) ("Under our cases parody and satire are valued forms of criticism, encouraged because this sort of criticism itself fosters the creativity protected by the copyright law."). The fair use provision (17 U.S.C. § 107) protects parody as an essential part of copyright law and constitutes one of the built-in safeguards (the other being the idea/expression dichotomy) for First Amendment free speech guarantees, promoting maximum free flow of ideas and stimulating literary and artistic expression. *See generally* Leval, *supra* note 59.

76. *See* MERGES, *supra* note 26, at 351; 4 NIMMER, *supra* note 52, at 13-203.

77. Light, *supra* note 10, at 625.

78. 239 F.2d 532 (9th Cir. 1956).

79. *Id.*

80. 137 F. Supp. 348 (S.D. Cal. 1955).

fair use, because some limited taking should be permitted for parody to "conjure up" the original.[81] Similarly, the Second Circuit ruled that a parody of a television jingle that mocked "I Love New York," by substituting "I Love Sodom" to the same tune, was fair use, yet "The Cunnilingus Champion of Company C" sung in a racy musical to the tune of "The Boogie Woogie Bugle Boy of Company B," was not.[82] Although the Copyright Act is content neutral, judges can "manipulate" the flexible statutory fair use factors to effectively censor parodies "because they [find] them immoral or personally distasteful."[83]

In 1994, the Supreme Court heard *Campbell v. Acuff-Rose Music, Inc.*,[84] the Court's first decision on whether and to what extent a parody could claim the fair use defense.[85] The rap group 2 Live Crew used the name, the opening bass riff, and one verse of the original rock and roll classic "Oh, Pretty Woman" to create their own rap version of the song, a claimed parody.[86] "The words of 2 Live Crew's song copy the original's first line, but then 'quickly degenerat[e] into a play on words, substituting predictable lyrics with shocking ones . . . [that] derisively demonstrat[e] how bland and banal the Orbison song seems to them.'"[87] The specific issue before

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81. *The Parody Defense, supra* note 15, at 1401-02. The "conjure up" test, as later refined and applied, limited the parodist to taking no more from the original than is necessary to conjure up the original. Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 758 (9th Cir. 1978).

82. *Compare* Elsmere Music, Inc. v. Nat'l Broad. Co., 482 F. Supp. 741 (S.D.N.Y. 1980) *with* MCA, Inc. v. Wilson, 677 F.2d 180, 184-85 (2d Cir. 1981).

83. 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, 462-63 (1994); *see, e.g., MCA, Inc.*, 677 F.2d at 185 (finding no fair use where "a commercial composer can plagiarize a competitor's copyrighted song, substitute dirty lyrics of his own, . . . then escape liability by calling [it] a parody"); *Walt Disney Prods.*, 581 F.2d at 753, 758 (finding that where infringers portrayed famously recognizable Disney characters engaged in drug-taking and sexual activities, the infringers, publishers of a counter-culture comic magazine, were found to have taken more than necessary to conjure up the subjects of their intended parody).

84. 510 U.S. 569 (1994).

85. *See* 4 NIMMER, *supra* note 52, at 13-204, n.340. The Gaslight case had reached the Supreme Court but produced no guiding opinion. *Id.*

86. *See Campbell*, 510 U.S. at 588, 594-96.

87. *Id.* at 582 (quoting the District Court's description of 2 Live Crew's version of "Oh, Pretty Woman"). Entire lyrics of both songs are reprinted in Appendix A to the opinion of the Court. *Id.* at 594-96.

the court was whether 2 Live Crew's commercial parody could claim fair use as a defense to a charge of copyright infringement.[88]

In addressing the first factor, the purpose and character of the use, the Court found that although commercial use could weigh against a fair use finding, it should not create an evidentiary presumption against alleged infringers in parody cases.[89] In accord with the goal of copyright law to promote science and the arts, the Court broadened the first factor inquiry to consider whether the parody merely superceded the original, or whether it "add[ed] something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it ask[ed], in other words, whether and to what extent the new work is 'transformative.'"[90] According to the court, "[p]arody needs to mimic [the] original to make its point."[91] Therefore, in order to claim fair use of original material, the parodist must use the material to create something new that, at least in part, comments on the original. If the alleged infringer does not target the original, but "merely uses [it] to get attention or to avoid the drudgery in working up something fresh, the claim to [fair use] . . . diminishes."[92] The Court did not evaluate the quality of the parody to determine whether a fair use defense should apply in a particular case: "[t]he threshold question when fair use is raised in defense of parody is whether a parodic character may reasonably be perceived."[93] The Court resolved that 2 Live Crew's song intended to ridicule the original, and the end product was transformative.[94] Therefore, the lower court erred in finding that the song's commercial purpose alone disqualified its use of the original as fair.[95]

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88. *See id.* at 571-72.

89. *Id.* at 585. Congress could not have intended to exclude from the fair use defense works that are for profit, as even the enumerated uses such as news reporting, comment, criticism and teaching are conducted for profit. *Id.* at 584.

90. Campbell v. Accuff-Rose Music, Inc., 510 U.S. 569, 579 (1994).

91. *Id.* at 580-81.

92. *Id.* at 580.

93. *Id.* at 582.

94. *Id.* at 583.

95. *See id.* at 583, 585.

Finding 2 Live Crew's song to be a parody altered the analysis of the remaining three fair use factors into a "more liberal formulation" that applies only when the work in question has been found to be a true parody.[96] Considering the second factor, the nature of the copyrighted work, the Court reiterated that copyright affords expressive, creative, original works more protection against copying than it does factual works.[97] However, because parodies almost invariably utilize such works, the character of the original "is not much help" in fair use balancing.[98]

The Court then considered the third factor: "'the amount and substantiality of the portion used in relation to the copyrighted work as a whole.'"[99] The Court referred back to the first factor, because parody itself "springs from recognizable allusion to its object" and therefore necessitates taking enough to "conjure up" that original.[100] 2 Live Crew copied the first line of the lyrics and the opening bass riff and arguably took from the "heart" of the original.[101] The Court disagreed with a finding that this taking was "unreasonable as a matter of law," and remanded so the lower court could reevaluate the reasonableness of the taking in relation to "the extent to which the song's overriding purpose and character [was] to parody the original."[102]

The Court recognized that as "parody pure and simple . . . the new work will not affect the market for the original . . . by acting as a substitute for it . . . because the parody and the original usually serve different market functions."[103] However, the new work may have a more complex character beyond parody, and may affect protectable

96. Lehr, *supra* note 83, at 465.
97. *Campbell*, 510 U.S. at 586.
98. *Id.* at 586.
99. *Id.*
100. *Id.* at 588.
101. *See id.* at 588, 594-96.
102. *Campbell*, 510 U.S. at 588-89 (expressing no opinion on whether more of the music was taken than necessary, and remanding to the lower court on the issue).
103. *Id.* at 591-92.

markets for derivative works of the copyrighted original.[104] The Court also remanded so that 2 Live Crew could present evidence that its rap version would not adversely affect the market for a "nonparody, rap version of 'Oh, Pretty Woman.'"[105]

The Court emphasized that, although parody is entitled to the fair use defense, it enjoys no more of a presumptive justification than any other use, such as news reporting. Parody must still "work its way through the relevant [fair use] factors, and be judged case by case, in light of the ends of the copyright law."[106]

The *Campbell* decision liberalized the statutory factor analysis of fair use in parody cases and provided some guidance for future cases, where the finding of parody is clear.[107] "[L]ower courts [may] no longer dismiss the parody as a non-fair use simply because it is commercial, or because it copied the heart of an original creative work."[108] However, by requiring the lower courts to discern whether the alleged infringing work is a true parody or merely a satire, the Court forces judges to critique what a work means—whether the secondary work criticizes the original (true parody), or society in general (satire).[109] Justice Kennedy's concurrence warns that courts "must take care to ensure that not just any commercial takeoff is rationalized *post hoc* as a parody."[110]

Post-*Campbell* decisions where parody was raised as a fair use defense of infringement include, most notably, a Ninth Circuit decision which held that "The Cat NOT in the Hat!," a retelling of the Simpson murder trial in the style of Dr. Seuss' *The Cat in the Hat*! was not a parody, but a satire.[111] The book "broadly mimic[s] Dr. Seuss' characteristic style, [but] it does not hold *his style* up to

104. *See id.* at 592-93.
105. *See id.* at 593.
106. *See id.* at 581.
107. *See generally Campbell*, 510 U.S. 569.
108. Lehr, *supra* note 83 at 469.
109. *Id.* at 470.
110. *Campbell*, 510 U.S. at 600.
111. Dr. Seuss Enter. v. Penguin Books, Inc., 109 F.3d 1394, 1401 (9th Cir. 1997).

ridicule." [112] The Second Circuit found that copying a famous photograph of a naked, pregnant, very serious Demi Moore, and superimposing upon it the head of a smirking Leslie Nielsen was a valid parody, even though as an advertisement its use was highly commercial.[113] According to the court, the ad could "reasonably be perceived as commenting on the seriousness, even the pretentiousness, of the original."[114] In another case, an author failed to convince the court that *The Joy of Trek*, a book intended to "explain the Star Trek phenomenon to the non-Trekker," was entitled to the fair use defense as a parody.[115] The court found that although *The Joy of Trek* "poke[d] fun at Star Trek," the overall purpose was not to mock Star Trek, therefore it was not entitled to the fair use defense of parody.[116] None of these cases seriously challenged courts' abilities to distinguish true parody based on the guidelines set forth in *Campbell*. *TWDG* presented a tougher case.

III. BACKGROUND OF *SUNTRUST BANK*

In 1936, Margaret Mitchell penned the epic *Gone With The Wind* (*GWTW*).[117] The love story of Scarlett O'Hara and Rhett Butler, set in the Civil War South, became one of the best-selling books in the world, and spawned one of the most popular movies of our time.[118] Sixty-five years later, in 2001, Alice Randall wrote the novel *The Wind Done Gone* (*TWDG*).[119] The tale's narrator, Cynara, the beautiful mulatto slave woman, wins the love of R.B. (Rhett Butler) from her half-sister Other (Scarlett), only to summarily dump him later for a dashing young black politician.[120] One critic hailed the

112. *Id.*
113. Leibovitz v. Paramount Pictures Corp., 137 F.3d 109, 114 (2d. Cir. 1998).
114. *Id.*
115. Paramount Pictures Corp. v. Carol Publ'g Group, 11 F. Supp. 2d 329, 332 (S.D.N.Y. 1998).
116. *Id.* at 335.
117. *See* MITCHELL, *supra* note 3.
118. *See* MITCHELL, *supra* note 3, at back cover.
119. *See* RANDALL, *supra* note 1.
120. Michiko Kakutani, *CRITIC'S NOTEBOOK: Within Its Genre, A Takeoff on Tara Gropes for a Place*, N.Y. TIMES, May 5, 2001, § B, *available at* 2001 WL 20058785.

book as "a sleek tale, a mystery novel . . . a palimpsest, a bodice-ripper, a meditation, a confession. . . . Randall has crafted a gleaming pendant to [*GWTW*]."[121] Another critic wrote: "[Randall's] plot is exiguous, her prose stiff and unsure . . . . Nor is she any kind of parodist. The only funny thing about [*TWDG*] . . . is the fawning press it's been getting."[122] Notified of the impending publication of *TWDG*, Suntrust Bank, the trustee for the Mitchell estate, sued Randall's publisher, Houghton Mifflin, on March 16, 2001, for copyright infringement.[123]

Seeking a temporary restraining order to halt the book's publication, the complaint identified *TWDG* as "a blatant and wholesale theft of [*GWTW*]" and an "unauthorized derivative work which incorporates and infringes upon the fully developed characters, settings, plot lines and other copyrighted elements of [*GWTW*]."[124] The *GWTW* copyright expires in 2031.[125] Houghton Mifflin, publisher of *TWDG*, responded that the book borrowed *ideas* from *GWTW*, but was not "substantially similar" to and thus did not infringe upon *GWTW*.[126] Houghton Mifflin also asserted a fair use defense of the borrowing[127] and characterized the book as a parody intended to ridicule the racist depictions of African–Americans in a popular American icon.[128]

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121. D.J. Carlile, *Book Review: Mammy Dearest*, L.A. TIMES, June 24, 2001 at 1-C.

122. Terry Teachout, *Entitlement Publishing*, NAT'L REV., Aug. 20, 2001, at 44. The critic comments that "the most efficient way to publicize bad art is to hire a lawyer and try to suppress it." *Id.*

123. Bill Rankin & Jill Vejnoska, *Fiddle-de-dee! What Would Scarlett Think of "TWDG"?*, ATLANTA J. & CONST., Mar. 28, 2001, at A1.

124. Complaint, Suntrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357, at 2, ¶ 3. (N.D. Ga. 2001) (No. 1:01 CV-701) (*Suntrust I*), *vacated by* Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001) (*Suntrust II*).

125. *See* Jill Vejnoska, *Guardians of the "Wind" Scarlett O'Hara's Fight for Tara May Pale in Comparison to the All-Out Legal Battle Erupting over Who Can "Exploit" the Characters in an American Classic*, ATLANTA J. & CONST., Apr. 8, 2001, at F1.

126. *Suntrust I*, 136 F. Supp. 2d at 1366.

127. *See* discussion *supra* Part II B.

128. *Suntrust Bank*, 136 F. Supp. 2d at 1373.

Of her motivation to write *TWDG*, Ms. Randall declared:

> [*GWTW*] . . . more than any other work I know, has presented and helped perpetuate an image of the South that I, as an African-American woman living in the South, felt compelled to comment upon and criticize. It is an image of a world in which blacks are buffoonish, lazy, drunk and physically disgusting, and in which they are routinely compared to 'apes,' 'gorillas' and 'naked savages.'[129]

On April 20, 2001, the United States District Court for the Northern District of Georgia issued a preliminary injunction barring the release of *TWDG*.[130] Houghton Mifflin appealed the decision, and on May 25, 2001, a three-judge panel of the Eleventh Circuit Court of Appeals vacated the preliminary injunction as an unlawful prior restraint in violation of the First Amendment.[131] *TWDG* was published and began selling in bookstores by early June 2001.[132]

The Eleventh Circuit denied a rehearing before the full court.[133] An appeal to the U. S. Supreme Court was possible, as was a full trial on the merits in district court.[134] On May 10, 2002, however, the Mitchell Trusts released a joint statement with Houghton Mifflin announcing "an agreement to drop its copyright infringement

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129. *See* Declaration of Alice Randall, at 1, *Suntrust I*, 136 F. Supp. 2d 1357. In her declaration, the author lists several offensive direct quotes from *GWTW* including: "How stupid negroes were!;" "Mammy . . . her kind black face sad with the uncomprehending sadness of a monkey's face;" "The faint niggery smell . . . increased her nausea;" "[D]arkies . . . are like children and must be guarded from themselves like children." *Id.* at 1-2.

130. *Suntrust I*, 136 F. Supp. 2d at 1386.

131. Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1277 (11th Cir. 2001) (*Suntrust II*).

132. *See* Don O'Briant, *"Wind" Blows in "GWTW" Parody "Done Gone" Hits Bookstores, Sells Briskly as Legal Wrangling Continues*, ATLANTA J.& CONST., June 13, 2001, at C1. As of May 10, 2002, Houghton Mifflin had sold 150,000 hard copies of the book and 60,000 copies in paper. *See* David D. Kirkpatrick, *Mitchell Estate Settles "Gone With the Wind" Suit*, N.Y. TIMES, May 10, 2002, at C6.

133. Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001) (TABLE, NO. 01-12200-HH).

134. *See* Bill Rankin, Features, *Mitchell Estate to Continue 'Gone' Battle*, ATLANTA J.& CONST., Oct. 12, 2001, at E.3, *available at* 2001 WL 3694669; David D. Kirkpatrick, *'Wind' Book Wins Ruling in U.S.*, N.Y. TIMES, May 26, 2001, § C, *available at* 2001 WL 21731176.

[law]suit against the book in return for an undisclosed charitable contribution to" Morehouse College, a "historically black Atlanta [c]ollege."[135]

The original action against Houghton Mifflin sought a temporary restraining order and preliminary injunction.[136] Therefore no court decided the full case on its merits.[137] However, in seeking a preliminary injunction, a plaintiff must establish that: (1) there is a substantial likelihood that the plaintiff will prevail on the merits;[138] (2) the moving party will suffer irreparable injury if the injunction is not granted;[139] (3) the threatened injury to the moving party outweighs the threatened harm the proposed injunction may cause the opposing party;[140] and (4) the injunction, if issued, would not be adverse to the public interest.[141] The first element, by its very definition, required thorough presentation and consideration of the

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135. Don O'Briant, *"Wind" Finale: Morehouse to Benefit from Suit Settlement*, ATLANTA J. & CONST., May 10, 2002, at E1.

136. The Copyright Act grants copyright holders the right to seek an injunction as an equitable remedy for infringement. 17 U.S.C. § 502 (a) (1982). Many argue against the customary bias in favor of automatically granting an injunction due to the presumption of irreparable injury stemming from the immediate destruction of the exclusivity of the author's rights. *See* Leval, *supra* note 59, at 1133-34 (arguing that in an infringement case where the fair use defense is raised but fails, courts should not grant injunctions as a "mechanical reflex," but only when the plaintiff can show that the compensation damages would be inadequate). For a discussion on the judicially crafted compulsory license created by denial of injunction in copyright cases, see generally Timothy J. McClimon, *Denial of Preliminary Injunction in Copyright Infringement Cases: An Emerging Judicially Crafted Compulsory License*, 10 COLUM.-VLA J.L. & ARTS 277, 286-307 (identifying that the long-accepted practice of presuming irreparable injury and granting preliminary injunctions is losing its force, especially where "big money" is involved and where the plaintiff can be adequately paid off by the defendant).

137. *See Suntrust II*, 268 F.3d at 1260.

138. The plaintiff must not only demonstrate a likelihood of success on the elements of its prima facie case but also as to the asserted defenses by the defendant, such as the fair use doctrine. *See* Metro-Goldwyn Mayer, Inc. v. Showcase Atlanta Coop. Prod., Inc., 479 F. Supp. 351, 352 (N.D. Ga. 1979).

139. *See* PATRY, *supra* note 19, at 278 (noting that in copyright cases, upon showing a likelihood of success on the merits, the courts may presume the second factor, irreparable harm to the plaintiff); *see also* 4 NIMMER, *supra* note 52, at § 14.06, 14-103 (stating that this factor should not be invoked, because irreparable harm is presumed in copyright cases where the plaintiff has demonstrated likely success on the merits).

140. *See* 4 NIMMER, *supra* note 52, at § 14.06, 14-103 (disfavoring the application of this factor, lest an infringer conducts his business around his infringement).

141. *See Suntrust I*, 136 F. Supp. 2d at 1364. *But see* 4 NIMMER, *supra* note 52, at § 14.06, 14-104 (arguing that the public interest is implicitly safeguarded by copyright law itself, so there is no necessity to apply a public interest test, but noting that the Fifth Circuit applies all four factors).

merits of Suntrust's copyright infringement claim as well as Houghton Mifflin's fair use defense claim.[142]

IV. SUNTRUST V. HOUGHTON MIFFLIN CO.

A. The Wind Done Gone *Infringed on the Copyright of* Gone With The Wind.

In *Suntrust Bank v. Houghton Mifflin Company,*[143] (*Suntrust I*) the district court, holding for the plaintiffs, found that *TWDG* infringed on the *GWTW* copyright as protected under copyright law and granted a preliminary injunction.[144] The district court found that the Mitchell Trusts own a valid existing copyright in *GWTW*, including the exclusive right to prepare derivative works, and to prevent any unauthorized musical arrangement, dramatization, or any other form in which the work may be recast, transformed, or adapted.[145] Absent direct proof of copying by Randall, Suntrust had to show that *TWDG*'s author had access to *GWTW* and that the two works were "substantially similar."[146] Randall admittedly read *GWTW* twice, and in her own words "fell in love with the novel," despite the offensive racial stereotyping. She later realized she had to tell the "story that hadn't been told."[147]

The district court found substantial similarity between *TWDG* and *GWTW* because an average lay observer would recognize the characters, character traits, scenes, settings, physical descriptions,

142. *Suntrust I*, 136 F. Supp. 2d at 1357.

143. 136 F. Supp. 2d 1357.

144. *Id.* at 1386.

145. *See* 17 U.S.C. § 106(2)(2000); *see also* Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Coop. Prods., Inc., 479 F. Supp. 351, 355-56 (N.D. Ga. 1979) (finding "Scarlett Fever," a play touted as a spoof or parody of *GWTW*, to be predominantly a derivative or adaptive use of the copyrighted *GWTW*, thereby infringing on the holder's copyright to control derivative works).

146. *Suntrust I*, 136 F. Supp. 2d at 1365; *see also* Dr. Seuss Enter. v. Penguin Books USA, Inc., 109 F.3d 1394, 1398 (9th Cir. 1997). *See generally* PATRY, *supra* note 19, at 191.

147. *Suntrust I.*, 136 F. Supp. 2d at 1365 n.4.

and plot as those of *GWTW*.[148] The district court also found fragmented literal similarity and comprehensive non-literal similarity.[149]

The circuit court, in *Suntrust Bank v. Houghton Mifflin Company*[150] *(Suntrust II)*, agreed that *TWDG* was substantially similar, particularly in its first half, which it found was largely "'an encapsulation' of [*GWTW*] [that] exploit[s] 'its copyrighted characters, story lines, an settings as the palette for the new story.'"[151] Both the district court and the circuit court found that Alice Randall "copied" *GWTW*.[152] However, the courts disagreed on whether she was justified in doing so.

B. The Wind Done Gone – *Unauthorized Sequel or Unauthorized Parody?*

The fair use provision in the Copyright Act protects parody.[153] Parody is commonly understood to constitute a "literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule."[154] In *Campbell*, the Court stated that for the purposes of copyright law, a "[p]arody needs to mimic an original to make its point."[155] The Court refined the definition of parody as a type of satire that "use[s] . . . some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works."[156] Although debate still surrounds the meaning of parody,[157] *Campbell* made clear that the fair use analysis is altered

148. *Id.* at 1368. *See* Affidavit of Jessie Beeber, *Suntrust I*, 136 F. Supp. 2d at 1-33 (No. 1:01 CV-701). A comprehensive chart submitted by the plaintiffs compared the characters, their personality traits, plot summaries, scenes and literal quotes from the two books. *Id.*

149. *Id.* at 1369-70; *see* 4 NIMMER, *supra* note 52.

150. 268 F.3d 1257, 1267 (11th Cir. 2001) (*Suntrust II*).

151. *Id.* at 1267 (quoting *Suntrust I*, 136 F. Supp. 2d at 1367).

152. *Suntrust Bank, 268* F.3d at 8; *Suntrust I*, 136 F. Supp. 2d at 1370 .

153. *See supra* Part I.

154. THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1317 (3rd ed. 1992).

155. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 580-81 (1994).

156. *Id.* at 580 (citing Fisher v. Dees, 794 F.2d 432, 437 (9th Cir. 1986)).

157. *See* Dr. Seuss Enter. v. Penguin Books USA, Inc., 109 F.3d 1394, 1400 & n.7 (S.D. Cal. 1997) (noting that after *Campbell*, debate still surrounds the meaning of parody).

when parody is found during the first factor analysis of the purpose and character of the use.[158] Thus, in *Suntrust I* and *Suntrust II*, the application of the fair use factors depended on whether or not *TWDG* was found to be a parody.[159]

C. The Fair Use Analysis in Suntrust I.

The first factor in a fair use inquiry is 17 U.S.C. § 107(1): "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes."[160] Following *Campbell v. Acuff-Rose Music, Inc.*,[161] the district court considered whether *TWDG* "add[ed] something new, with a further purpose or different character" and was thus "transformative."[162] The district court stated that because parody is obviously transformative, it was necessary to decide whether *TWDG* was a parody in order to weigh that factor in light of others, like commercialism.[163] If *TWDG* used *GWTW* merely to "get attention" or to "avoid the drudgery in working up something fresh," the claim of fair use would be diminished.[164] In this balancing test, if the court found *TWDG* to be a parody, the transformative value would outweigh the commercial use.[165]

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158. *See supra* discussion Part II B.

159. Suntrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357, 1370 (N.D. Ga. 2001) (*Suntrust I*), *vacated by* Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001) (*Suntrust II*); *Suntrust II*, 268 F.3d at 1268.

160. 17 U.S.C. § 107(1)(1976).

161. 510 U.S. 569 (1994). Significantly, the holding of *Campbell* is not that parody is fair use, but that the commercial nature of a song parody did not create a presumption against fair use. *Id.* at 569.

162. *Suntrust I*, 136 F. Supp. 2d at 1372. (quoting *Campbell*, 510 U.S. at 579).

163. *Id.* at 1372-73; *see also supra* Section II (stating that the purpose and character of the use includes whether the use is for commercial or non-profit educational purposes); Harper & Row Publ'g Inc. v. Nation Enter., 471 U.S. 539, 562 (1985) (stating that the crux of the profit/nonprofit distinction is whether the user stands to profit from his use of the copyrighted material without paying the customary price).

164. *See Campbell*, 510 U.S. at 580.

165. *See Suntrust I*, 136 F. Supp. 2d at 1372.

Suntrust maintained that *TWDG* was an unauthorized sequel.[166] Because Suntrust alone has control over derivative works, including sequels,[167] finding that *TWDG* was a sequel would tilt the scales from highly transformative toward commercial, and thus against a finding of fair use.[168]

Parody must target the original, not just use it as a weapon to target something else.[169] The district court found that *TWDG* did criticize *GWTW*'s one-sided view, but also used the original expression of *GWTW* to facilitate the author's social commentary on Southern history in general.[170] For example, in *TWDG* the slave Garlic (originally the obedient and loyal Pork in *GWTW*[171]) controls his master so thoroughly that when "Garlic pull[s] the string[s], . . . Planter [the master] dance[s] like a bandy-legged Irish marionette."[172] The district court observed that the scene could be perceived as funny and ironic, but because the scene essentially

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166. *See Suntrust I*, 136 F. Supp. 2d at 1364. A sequel is "a literary work continuing the course of a narrative begun in a preceding one." *Id.* at 1375 (quoting WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (1993)); *see also* THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1646 (3d ed. 1992) (defining a sequel as "[a] literary work complete in itself but continuing the narrative of an earlier work").

167. *See* 17 U.S.C. § 101 (2000). A "derivative work" is one "based upon one or more preexisting works, such as . . . [an] abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted." *Id.*

168. *See Suntrust I*, 136 F. Supp. 2d at 1372.

169. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 597 (1994) (Kennedy, J., concurring) ("The parody must target the original, and not just its general style, the genre of art to which it belongs, or society as a whole."); Dr. Seuss Enter. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir. 1997) (finding *The Cat NOT In the Hat* by Dr. Juice, which poked fun at the O.J. Simpson murder case using the characteristic style and verse of Dr. Seuss's *The Cat In The Hat,* was not parody of the source because it did not ridicule Dr. Seuss's expression, but used it as a vehicle to lampoon a particular event); Rogers v. Koons, 960 F.2d 301, 310 (2d Cir. 1992) (finding that while a sculptural copy of a puppy photo could be perceived as a satirical critique of materialistic society, it was difficult to discern any parody of a puppy photograph itself, therefore the copying was done primarily for profit-making motives, and did not constitute a parody of the original work). For a three-fold definition of parody for copyright cases, see Posner, *supra* note 73, at 71-74 (suggesting, as one of three criteria, that parody only be allowed to claim a fair use defense if it targets the original, not if it used the original as a weapon, because there is no compelling reason to subsidize social criticism by allowing writers to use copyrighted materials without compensating the copyright holder). Posner points out "it is possible to parody an author, a genre, even an individual work without taking any copyrighted materials at all." *Id.*

170. *See Suntrust I*, 136 F. Supp. 2d at 1374, 1377-78.

171. *See* Affidavit of Jessie Beeber, Esq. at 4, *Suntrust I*, 136 F. Supp. 2d 1375 (No. 1:01 CV-701).

172. RANDALL, *supra* note 1, at 63.

"further elaborate[d] upon an extant character from [*GWTW*]" it more closely resembled a sequel (albeit with a political message) than a parody.[173]

Asa the district court pointed out, the new book does not borrow the characters merely to mimic them, but uses them established characters from *GWTW* to tell the new story.[174] *TWDG*'s Other (Scarlett in *GWTW*) is a powerful character who demands attention.[175] Similarly, R. (Rhett Butler) is a major complex character in *TWDG* and plays a "key role" in the new tale.[176] The district court noted that the pre-lawsuit book cover described *TWDG* as:

> an inspired act of literary invention [that] supplies the story that has been missing from the work that more than any other has defined our image of the antebellum South, Margaret Mitchell's [*GWTW*]. Imagine . . . the black characters in Mitchell's tale were other than one-dimensional stereotypes . . . that Scarlett O'Hara had an illegitimate mulatto sister, and this sister, Cynara, Cinnamon, or Cindy – beautiful and brown – gets to tell her story.[177]

The district court observed that if the "work is intended to supply the missing story of the earlier work and takes up where the former work left off, then it is a sequel."[178] The court compared the original jacket copy to the new, revised book jacket, which added the phrase: "A provocative literary *parody* that explodes the mythology

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173. *Suntrust I*, 136 F. Supp. 2d at 1374.

174. *Suntrust I*, 136 F. Supp. 2d at 1369-70.

175. *Id.* at 1369. In *TWDG*, Cynara's jealousy of Other is the cornerstone of her relationships with the other characters. For example, Cynara's jealosuy of Other cements her relationship to R: "I didn't want to lose him [R], but I wanted someone who loved her to love me more than her." RANDALL, *supra* note 1, at 47.

176. *Suntrust I*, 136 F. Supp. 2d at 1370. R. (Rhett) is ever-present in *TWDG* as Cynara's lover, teacher, and husband. *See generally* RANDALL, *supra* note 1.

177. *See* Complaint, Ex. A., *Suntrust I*, 136 F. Supp. 2d 1357.

178. *Suntrust I*, 136 F. Supp. 2d. at 1377.

perpetrated by a Southern classic."[179] In addition, the revised inside jacket cover copy now states: "[*TWDG*] allude[s] to events in Mitchell's novel but ingeniously and ironically *transform*[s] them . . . ."[180] Despite these attempts to recast the work as transformative parody, the district court found *TWDG* to be "exactly what it bills itself as, a sequel to [*GWTW*], told from the perspective of Scarlett's mulatto half-sister, Cynara."[181]

The district court found that *TWDG* is transformative to the extent that its structure and style differ dramatically from *GWTW*.[182] Ms. Randall added the missing miscegenation, whippings, families sold apart, and free blacks striving for their education into the story, as well as telling the new story from a different perspective in the form of a first person narrative.[183] The court concluded that *TWDG* "contains transformative parody that criticizes the earlier work," but transforms it "no more than any other sequel to an original work."[184] Therefore, the court found the commercial purpose of *TWDG* weighed strongly in favor of the plaintiff, but the finding that *TWDG* was transformative served to temper that weight.[185]

Under the second factor—the nature of the copyrighted work—the more creative a work, the more protection it should be accorded from copying.[186] When a work is found to be a parody, this second statutory factor "is not much help."[187] Because the district court had found that *TWDG* was not a parody and that *GWTW* was a highly

179. *Id.* at 1376 (quoting new cover to ALICE RANDALL, THE WIND DONE GONE, (Houghton Mifflin Company 2001)) (emphasis added).

180. RANDALL, *supra* note 1, at inside jacket cover (emphasis added).

181. *Suntrust I*, 136 F. Supp. 2d. at 1377.

182. *Id.* at 1378.

183. *Id.* at 1375, 1378.

184. *Id.* at 1378.

185. *Id.* at 1379. *See also* Campbell v. Acuff-Rose Music, Inc. 510 U.S. 569, 579 (1994) (discussing the effect of transformative use on the consideration of other factors).

186. *See, e.g.*, Dr. Seuss Enter. v. Penguin Books USA, Inc., 109 F.3d at 1394, 1402 (finding that the creative, imaginative, and original nature of *The Cat in the Hat* tilted the scale against fair use); 4 NIMMER, *supra* note 52, at §13.05[A][2][a], p. 13-170.

187. *Campbell*, 510 U.S. at 586.

original creative and imaginative work, the second factor militated against a finding of fair use.[188]

Assessing the third factor, the amount and substantiality of the portion used, required the court to judge the quality and quantity of the amount of *GWTW* taken by *TWDG*.[189] The district court again looked to *Campbell*, where the Supreme Court urged that when gauging whether the amount taken is fair, a court should give special consideration to an alleged infringer who asserts a parody defense.[190] Because *TWDG* depended for its very effectiveness upon recognition of the elements of *GWTW*, it needed to take enough to "conjure up" the original "to make the object of its critical wit recognizable."[191] The court found that the quantitative taking was excessive, even granting the parodic use: "Her use does not merely 'conjure up' the earlier work, but rather has made a wholesale encapsulation of [*GWTW*], copied its more famous and compelling fictional scenes . . . and [employed its] most notable characters."[192] The qualitative taking was substantial as well; *TWDG* copied the "plot, themes, characters, character traits, settings, scenes, descriptive phrases, and verbatim quotes."[193] Essentially, the court found that Ms. Randall could have achieved a parodic result using substantially less than she did, and thus, "the third factor militate[d] against a finding of fair use."[194]

The fourth factor, the effect of the use on the market value of the original, measures the degree "to which the parody may serve as a market substitute for the original or potentially licensed

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188. *See Suntrust I*, 136 F. Supp. 2d at 1380.

189. *Id.*; *see also* Harper & Row v. Nation Enter., 471 U.S. 539, 565 (1985) (holding that where an infringer took verbatim quotes from a forthcoming memoir of President Ford, although the amount taken was small, it was excessive taking because it comprised "the heart of the book").

190. *See Suntrust I*, 136 F. Supp. 2d at 1380; *see also Campbell*, 510 U.S. at 586-87 ("[T]he extent of permissible copying varies with the purpose and character of the use.").

191. *Suntrust I*, 136 F. Supp. 2d at 1380.

192. *Id.* at 1381.

193. *Id.*

194. *Suntrust I*, 136 F. Supp. 2d at 1381; *see also, e.g.*, Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 758 (9th Cir. 1978) ("[W]hen persons are parodying a copyrighted work, the constraints of the existing precedent do not permit them to take as much . . . as they need to make the 'best parody.'"); Rogers v. Koons, 960 F.2d 301, 311 (2d Cir. 1992) ("It is not fair use when more of the original is copied than necessary.").

derivatives."[195] A "derivative work" is one "based upon one or more preexisting works, such as . . . an abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted."[196] In *Campbell*, where rap musicians substantially copied "Oh, Pretty Woman" to create a parody, the Court commented that the musicians, in asserting the affirmative defense of fair use, bore the burden to show the lack of an adverse effect upon the market for rap derivatives of the original.[197] The Court predicted that the "evidentiary hole [would] doubtless be plugged on remand."[198]

The derivative market for *GWTW*, however, is well established and has generated millions of dollars for the Mitchell Trusts.[199] The court pointed out that by "killing two core characters from [*GWTW*] and marrying off another, [*TWDG*] has the immediate effect of damaging or even precluding the Mitchell Trusts' ability to continue to tell the love story of Scarlett and Rhett."[200] The defendant argued that because *TWDG* is a stinging criticism of *GWTW*, there would be little chance that the plaintiff would ever license such a work.[201] The court agreed that harm is less certain where the use is parodic, but even if *TWDG*'s parodic intent was substantial, its parodic effect is slight in comparison to the extensive copying.[202] Therefore, the district court concluded that *TWDG*'s market harm to *GWTW* was in its "market substitution" as a sequel, not due to the "effectiveness of its critical commentary."[203] The district court found that the "instant

195. *Suntrust I*, 136 F. Supp. 2d at 1381 (quoting Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 588 (1994)).

196. 17 U.S.C. § 101 (2000).

197. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 590 (1994).

198. *Id.* at 594.

199. *See Suntrust I*, 136 F. Supp. 2d at 1363-64 (detailing the derivative market for *GWTW*, including the success of the licensed first sequel, and the entering into a lucrative contract for a licensed second sequel).

200. *Id.* at 1382.

201. *See id.*; *see also Campbell*, 510 U.S. at 593 ("The market for potential derivative[s] includes only those that creators of original works would in general develop.").

202. *See Suntrust I*, 136 F. Supp. 2d AT 1383.

203. *Id.* at 1383.

harm of market substitution weigh[ed] against a finding of fair use under the fourth factor."[204]

D. The Fair Use Analysis in Suntrust II.

The circuit court, like the district court, first had to decide whether or not *TWDG* was a parody.[205] To do so, it redefined parody by eliminating any requirement that parody include humor and broadened the definition of parody beyond that provided in *Campbell*.[206] "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 appropriating elements of the original in creating a new *artistic*, as opposed to scholarly or journalistic, work."[207] Because *TWDG* is "a specific criticism of and rejoinder to the depiction of

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204. *Id.*

205. Suntrust Bank v. Houghton Mifflin Company, 268 F.3d 1257, 1268 (11th Cir. 2001) (*Suntrust II*). *See* Note, *Gone with the Wind Done Gone: "Re-Writing" and Fair Use*, 115 HARV. L. REV. 1193, 1209 (2002) (calling *TWDG* a re-writing, and suggesting that in such "re-writing" cases, especially considering alleged infringement of a cultural icon such as *GWTW*, courts should consider two additional factors: (1) at what point the copyright stands when the original work's author asserts his right, and (2) how much the author has already reaped from the work).

206. *Suntrust* II, 268 F.3d at 1268-69 (acknowledging the court's reluctance to attempt to reconcile the plaintiff's position, offered through *The New York Times* book critic Michiko Kakutani, that the work was "decidedly unfunny" with the defendant's position, by strong implication, that non-African American judges could not evaluate the book's humor without assistance from "experts").

207. *Id.* at 1268-69 (emphasis added). For a similar view advocating a broad legal definition of parody see Note, *The Parody Defense*, *supra* note 15, *at* 1410 (proposing that a definition of parody that included all colorable attempts to alter the function of an original for humorous effect would better serve the goals of both the First Amendment and copyright law). S*ee also* Light, *supra* note 10, at 634 (advocating that a broader definition of parody would advance a public interest limitation on the scope of copyright protection: "if the taking is for the purpose of humor or criticism, and it makes some alteration in the original to that end, then it is a parody."). *But see* Posner, *supra* note 73, at 67 (offering an economic analysis of parody fair use that advocates a very narrow definition for parody, requiring that it closely target the subject of its criticism or ridicule); Leval, *supra* note 59, at 1112 (stating that courts must consider the question of fair use for each challenged passage and not merely for the secondary work overall). For an opinion on this court's broadening the definition of parody, see Veronica Soto, *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.*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 405, 415-15 (May, 2002) (applauding the "broader definition of parody" as a probable aid for courts to more objectively judge whether a work is a parody, therefore avoiding the possibility that "distasteful parodies" would be censored based on subjective reasoning). Distasteful parodies have been "censored" by subjective judgment, not because they were not humorous. *See* discussion *supra* Part II.B.

slavery and the relationships between blacks and whites in *GWTW*," albeit in the form of a novel, the court concluded that the "parodic character of *TWDG* is clear."[208]

In analyzing the first factor, the purpose and character of the work, the circuit court found *TWDG* to be a legitimate parody, because its use was highly transformative, outweighing the book's commercial, for-profit nature.[209] Thus, the court found that the first factor tipped in the defendant's favor.[210] The court recognized that *TWDG* is a novel that depends heavily on copyrighted elements to carry its story forward, but found that *TWDG*'s principal parodic nature is a critical statement of *GWTW*.[211] Where the district court used an example from *TWDG* to support its characterization of the book, the circuit court instead drew from Ms. Randall's description of her intent to "explode" *GWTW*'s version of the antebellum South.[212] Further, the circuit court quoted, at length, several of the racially offensive quotes from *GWTW* as sources for legitimate political comment that inspired the writing of TWDG.[213]

The circuit court agreed with the district court that the very style of the first-person narrative shortened and significantly transformed the borrowed copyrighted elements of *GWTW*.[214] The circuit court maintained that *TWDG* only borrowed elements to further the "general attack" on *GWTW*.[215] Reasserting the finding that *TWDG* is a parody, thus highly transformative, and that *TWDG* can provide a social benefit by shedding light on an earlier work, the circuit court

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208. *Suntrust II*, 268 F.3d at 1269.

209. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 ("[T]he 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.").

210. *Suntrust II*, 268 F.3d at 1271.

211. *Id.* at 1269.

212. *Id.* at 1270; *see also* David D. Kirkpatrick, *A Writer's Tough Lesson in Birthin' a Parody*, N.Y. TIMES, Apr. 26, 2001 (quoting *TWDG*'s author: "I did not seek to exploit [*GWTW*]. I wanted to explode it.").

213. *See Suntrust II*, 268 F.3d at 1270. *See generally* Declaration of Alice Randall, at 1, Suntrust Bank v. Houghton-Mifflin Co., 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701-CAP) (Suntrust I), *vacated by* 268 F.3d 1257 (11th Cir. 2001) (*Suntrust II*).

214. *See Suntrust II*, 268 F.3d at 1270.

215. *Id.*

found that the facts in this case militated in favor of finding fair use.[216]

In factoring the weight of the nature of the copyrighted work, the second factor, the circuit court acknowledged that copyright affords the highest protection to original works of fiction, such as *GWTW*.[217] Because the circuit court had found *TWDG* was a parody of *GWTW*, the original expressive nature of *GWTW* carried little weight, and the second factor favored fair use.[218]

In the third factor analysis of the amount and substantiality of the portion used, the circuit court first commented that *GWTW*, merely because it is famous, deserves neither more nor less protection from copyright law.[219] The court extended the transformative function, identified in discussion of the first factor, to justify *TWDG*'s substantial borrowing from *GWTW*.[220] Thus, the court excused taking where *TWDG* altered the meaning of the borrowed elements, characters, quotes, and scenes from *GWTW* for the purpose of critical commentary.[221] In response to the plaintiff's charge that the defendant took many elements that had no discernable parodic function, the court declined to enter into a "highly subjective [literary] analysis ill-suited for judicial inquiry," and thus did not decide whether those takings were necessary.[222] The court decided that any "extraneous" material taken would be suspect only if it would negatively affect the potential market for or value of the

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216. *See id.* at 1271; *see also* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994) (elaborating on the virtue of the social benefit of parody).

217. *Id.* at 1271.

218. *Suntrust II*, 268 F.3d at 1271 (11th Cir. 2001) (*Suntrust II*).

219. *See id.* at 1272; *see also* Harper & Rowe, Publ'g Inc. v. Nation Enter., 471 U.S. 539, 560 (1985) (declining to extend a public figure exception to copyright). *But see* Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 757-58 (9th Cir. 1978) (commenting that when a work is so famously recognizable as the Disney characters, less is needed to "conjure up" the original).

220. *See Suntrust II*, 268 F.3d at 1272.

221. *Id.* (offering as an example Rhett's quip "My dear, I don't give a damn," as paraphrased in *TWDG*, which "changes the reader's perception of Rhett/R.B. – and of black-white relations – because he has left Scarlett/Other for Cynara, a former slave").

222. *Id.* at 1273. For example: "Melanie/Mealy Mouth is flat chested, Mammy is described as being like an elephant and is proud of Scarlett/Other's small waist, Gerald/Planter has been run out of Ireland for committing murder and is an excellent horseman," etc. *Id.*

original copyright.[223] Because the court had not yet addressed the market value factor, it could not yet determine whether the quantity and quality of the materials used were reasonable.[224]

The circuit court, like the district court, considered whether *TWDG* would cause potential harm to the market for derivative works of *GWTW* through its analysis of the fourth factor.[225] The circuit court, however, found the plaintiff's proffer of relevant evidence of potential market harm was insufficient, and concluded that the fourth factor also favored the defendant.[226] The circuit court stated that the plaintiff should have focused on whether and to what degree *TWDG* would have supplanted demand for *GWTW*'s licensed derivatives, instead of on the value of *GWTW* and its derivatives.[227]

Because the circuit court found that Suntrust had not established the likelihood of its success on the merits, nor shown irreparable injury, the court vacated the district court's injunction and remanded the case to the district court.[228]

CONCLUSION

The *Suntrust II* decision continues the tradition of fair use adjudication that requires a case-by-case analysis rather than bright-

223. *Suntrust II*, 268 F.3d at 1273-74.

224. *See id.*; *see also* Folsom v. Marsh, 489 F. Cas. 342, 348 (C.C. Mass. 1841)(No. 4901) (emphasizing that it is important to relate the quantity and quality of the materials used to the purpose for which they are used when judging whether too much was taken).

225. *See Suntrust II*, 268 F.3d at 1274.

226. *See Suntrust II*, 268 F.3d 1257 at 1274-76 (placing the burden of proof of proving market harm on the plaintiff, because the original action sought injunctive relief). *But see* Dr. Seuss Enter. v. Penguin Books USA, Inc., 109 F.3d 1394, 1403 (9th Cir. 1997) ("Since fair use is an affirmative defense, [the defendant] must bring forward favorable evidence about relevant markets."); 4 NIMMER, *supra* note 52, at § 13.05[A][4], 13-185 (stating that the defendant bears the burden of proof in a fair use affirmative defense). The author of the circuit court opinion, Judge Stanley Birch, noted that he believes fair use should be considered an affirmative right, rather than an affirmative defense. *Suntrust II*, 268 F.3d at 1260, n.3.

227. *Suntrust II*, 268 F.3d at 1275. Suntrust proffered evidence of the value of the derivative market for the *GWTW* copyright, the millions it has already generated, including the contract for the upcoming authorized sequel, a contract worth "well into seven figures." *Id.* at 1274.

228. *Id.* at 1276-77.

line rules.[229] The opinion may "become 'very influential' in future copyright litigation."[230] One who seeks to contribute to the wealth of knowledge and artistic ideas through a secondary fictional work by borrowing from a copyright-protected cultural icon (or just an ordinary work) may more easily succeed on a claim of fair use—even when the secondary work is merely critical. However, expanding the parameters of acceptable fair use seems to be an end-run around the fact that the copyright term is much longer than it needs to be (ninety-five years, in the case of *GWTW*) to serve as an incentive to create new, original works.[231]

Broadening the meaning of parody to accommodate a work that is arguably not a true parody weakens copyright protection for any work that might be copied, regardless of how long it has been protected.[232] Suggestions to add more fair use factors to protect works that have not yet reaped "enough" substantial profits would inject even more subjectivity into fair use analysis.[233] Cases have shown that the flexibility of the fair use doctrine has allowed courts to censor "distasteful" parodies.[234]

By both reaffirming *Campbell* and departing from it, the circuit court's decision added more confusion than clarity to those questions *Campbell* left unanswered. The circuit court faced a dilemma because *TWDG* did not fit neatly into any of the existing legal parody definitions. *TWDG* arguably lacks humor, promotes a political statement critical of the fictional *GWTW*, but does not "lampoon

229. *See* discussion *supra* Part II.

230. R. Robin McDonald, *UGA Prof: 'Wind' Decision is 'Supreme Court Quality Ruling'*, FULTON COUNTY DAILY REP., Oct. 12, 2001, (quoting L. Ray Patterson, professor at the University of Georgia Law School).

231. *See* discussion *supra* Part I.A.

232. *See* Thomas D. Selz Letter to the Editor, N.Y. TIMES, May 7, 2001 (positing that "[o]ne could present the Harry Potter books from the Muggles' viewpoint, arguing that wizardry, seen in a positive light, is harmful to children").

233. *See* Note, *Gone With the Wind Done Gone: "Re-Writing" and Fair Use*, 115 HARV. L. REV. 1193, 1209 (Feb. 2002) (suggesting additional factors to judge whether a work should still be protected depending on how long it has been protected, and how much money it has made).

234. *See, e.g., supra* note 82 and accompanying text.

Mitchell's prose or the narrative devices of *GWTW*."[235] Yet, the circuit court recognized the value of the critical message Ms. Randall sought to convey[236] and that its perceived political nature concerned the type of speech that triggers heightened First Amendment protection.[237] By lowering the threshold for *TWDG*, however, the circuit court ignored the *Campbell* Court's warning to "keep[] the definition of parody within proper limits," lest doubts about "whether a given use is fair . . . be resolved in favor of the self-proclaimed parodist."[238]

The circuit court's opinion departed from *Campbell* in other respects. In analyzing the third fair use factor, the circuit court could not ignore the extensive borrowed elements that seemed to have no parodic purpose at all.[239] Instead of considering whether TWDG took more than was necessary, (the standard "conjure up" test),[240] the court stated that any material that "is 'extraneous' to the parody is unlawful only if it negatively effects the potential market."[241] If by extraneous the circuit court meant unnecessary to further the effectiveness of the parody, or conjure up the original, the analysis is inconsistent with that of the Court in *Campbell*. In *Campbell*, the Court expressed that even granting the parodic purpose and the probable lack of market harm, whether the taking in that case was "excessive" was still open to determination on remand.[242] In other words, determination of "excessive taking" was a contextual question tied to the first and fourth factors.[243]

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235. *See* Paul Gray, *The Birth of a Novel*, TIME, May 7, 2001, *available at* 2001 WL 17216057.

236. *See supra* Part IV.D (discussing the primary critical function of *TWDG* – to "explode" the romantic idealized portrait of *GWTW*'s antebellum South).

237. "[TWDG is] a specific criticism of and rejoinder to the depiction of slavery and the relationships between blacks and whites in *GWTW*." Suntrust Bank v. Houghton Miffton Co., 268 F.3d 1257, 1269 (11th Cir. 2001) (*Suntrust II*).

238. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 599 (1994) (Kennedy, J., concurring).

239. *See supra* note 219 and accompanying text.

240. *See* discussion *supra* Part II.B; *see also supra* note 16 and accompanying text.

241. *Campbell*, 510 U.S. at 1274. *See* discussion *supra* Part IV.D.

242. *See* discussion *supra* Part II.B.

243. *See* discussion *supra* Part II.B.

As stated in *Campbell*, a parody would not likely supplant the demand for an original or its derivatives, as each serves a different market function.[244] The original author presumably would have no interest, and thus suffer no harm, in the market for a parody of his own work. Also, as the Court stated in *Campbell*, copyright law does not protect an original from harm when a lethal parody, such as a scathing review, kills the market demand for an original.[245] Under a limited definition of parody, this viewpoint makes sense. However, if the definition of parody is broadened to include "artistic, as opposed to scholarly or journalistic"[246] works, the presumption is weakened. An "artistic" work with parodic elements might very well compete in the same market, and thereby cause harm. Moreover, as the Court in *Campbell* pointed out, especially when a work is not pure parody, the secondary work could harm the potential derivative market for the original.[247]

Finally, by eliminating any requirement that the "parody" target the original, the court opens up the category beyond what is needed to protect the freedom to make critical comments on expressive works, which is already well protected by copyright law.[248] As an enumerated fair use, critical commentary has been specifically protected since Congress passed the Copyright Act of 1976.[249] For Ms. Randall's commentary, "[t]he device [she] chose was to create, *in a work of fiction*, a literary parody of *Gone With The Wind*."[250] The district court compared the *contents* of the two novels to conclude that *TWDG* was more like a sequel to *GWTW*.[251] The circuit court based its analysis most heavily upon *TWDG*'s author's

244. *See* discussion *supra* Part II.B.

245. *See* discussion *supra* Part II.B; *see generally* discussion of fair use doctrine, Part II.A.

246. *See* discussion *supra* Part IV.D.

247. *See* discussion *supra* Part II.B.

248. *See* discussion *supra* Part I (stating that political statements of criticism are already protected under the copyright act via the idea/expression dichotomy: ideas are not copyrightable).

249. *See* discussion *supra* Part I.A.

250. *See* Declaration of Alice Randall, at 3, Suntrust Bank v. Houghton Miffton Co., 136 F. Supp. 2d 1352 (N.D. Ga. 2001)(No. 1:01 CV-701-CAP) (Suntrust I).

251. *See supra* notes 174-76 and accompanying text.

expressed intent in writing it and thus found it to be a parody.[252] Regardless of the label, "The Unauthorized Parody," belatedly stuck to *TWDG*'s cover, one can't tell a book by its cover. Alice Randall's declaration, which lists the offensive, racist ideas and language in *GWTW* in detail, is a more compelling indictment of *GWTW* (and the society that elevated it to a classic) than is her book.[253] The fact remains that Ms. Randall could have criticized *GWTW*, perhaps more effectively, without using any copyrighted materials at all.[254]

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252. *See supra* note 212 and accompanying text.

253. *See id.*

254. *See* Posner, *supra* note 73, at 73 ("Recall in this connection that it is possible to parody an author, a genre, even an individual work without taking any copyrighted materials at all.").