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ON THE FAIR USE FENCE BETWEEN DERIVATIVE  
WORKS AND ALLEGEDLY INFRINGING  
CREATIONS: A PROPOSAL FOR A  
MIDDLE GROUND

*Erin E. Gallagher\**

INTRODUCTION

In the Copyright Act of 1976, Congress codified the doctrine of fair use<sup>1</sup> that the lower federal courts had developed to realize the Copyright Clause's stated purpose: "To promote the Progress of Science and useful Arts."<sup>2</sup> The common law fair use doctrine balanced "the level of copyright protection that would provide authors and publishers with a sufficient economic incentive to create new works, on the one hand, while permitting sufficient freedom to those authors to draw upon the works of others in creating new works, on the other."<sup>3</sup> To preserve the right of authors to use some portions of copyrighted

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1 See 17 U.S.C. § 107 (2000).

2 U.S. CONST. art. I, § 8, cl. 8. "From the infancy of copyright protection, some opportunity for fair use of copyrighted materials has been thought necessary to fulfill copyright's very purpose, '[t]o promote the Progress of Science and useful Arts . . .'" *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994) (citation and footnote omitted).

3 Tyler T. Ochoa, *Dr. Seuss, The Juice and Fair Use: How the Grinch Silenced a Parody*, 45 J. COPYRIGHT SOC'Y U.S.A. 546, 566 (1998). "Lord Ellenborough expressed the inherent tension in the need simultaneously to protect copyrighted material and to allow others to build upon it when he wrote, 'while I shall think myself bound to secure every man in the enjoyment of his copy-right, one must not put manacles upon science.'" *Campbell*, 510 U.S. at 575 (citing *Carey v. Kearsley*, 170 Eng. Rep. 679, 681 (K.B. 1803)).

works in their own creations, § 107 provides the “fair use of a copyrighted work . . . is not an infringement of copyright.”<sup>4</sup> Moreover, § 106 makes the copyright holder’s “exclusive rights” in his or her work subject to § 107’s fair uses.<sup>5</sup> Among the § 106 rights limited in this way by fair use, the Act exclusively reserves to the owner of a copyright the right to “prepare derivative works based upon the copyrighted work.”<sup>6</sup>

Yet despite the Act’s explicit exception for fair use, contemporary copyright law takes an unfortunate dichotomous view of the rights associated with derivative works. This view frames derivative works litigation as presenting courts with only two options. In the usual lawsuit between a plaintiff copyright holder and a defendant accused of violating that copyright, a court can either: (1) deem the allegedly infringing work changes or adds enough new material to the copyright holder’s original work to create a new work that rightfully belongs to the alleged infringer (i.e., is “transformative”), or (2) it can chastise the defendant for trespassing too far into the plaintiff’s exclusive domain over his or her work. I deliberately analogize to the real property concept of trespass here because I believe courts have imported such a physical concept into their intellectual property law jurisprudence. Like a fence between the plaintiff’s and the defendant’s land, the line drawn by fair use between derivative works and allegedly infringing ones appears to leave courts no choice but to place the case before them squarely into either the plaintiff’s or the defendant’s territory.

Instead, we should replace this “either (mine)/or (yours)” approach with one that recognizes a third choice: “neither (mine nor yours).” This change to the physical understanding of the plaintiff’s and the defendant’s rights looks like a Venn diagram where the outer edges of all copyright holders’ works overlap in the middle, creating what we should recognize as the public domain: a commons that simultaneously belongs to everyone and no one.

In this Note, I argue we should interpret the Copyright Act and Copyright Clause to see the middle ground of the public domain as a space with content, instead of merely as a fair use fence. In Part I, I describe how the current fence framework inappropriately influences legal decisions, and suggest the middle ground reconceptualization will properly frame the issues in derivative works cases. I identify two middle ground categories of intellectual property to which courts should

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4 17 U.S.C. § 107.

5 *Id.* § 106.

6 *Id.*

give space within the public domain and illustrate their function in two leading derivative works cases. Next, in Part II, I show that by unpacking these two decisions, we discover a subtle, perhaps unconscious, accommodation of moral rights in the jurisprudence. Finally, I discuss in Part III the appropriate steps to take in recognition of this middle ground proposal and the moral rights influence in light of policy concerns regarding copyright and communication in contemporary society.

## I. THE FAIR USE FENCE

I argue courts should reconceptualize fair use, transforming it from a mere line to an actual area: expanding the fence to become a space with content. In so doing, I employ a metaphor involving physical notions of space to illustrate my argument. Of course, this territorial approach to intellectual property is itself problematic in some ways. Courts cannot divide artistic qualities like architectural style, literary plots, dramatic characters, lighting, and music neatly into groups that we can identify and attribute definitely to certain categories (as we can with real property or chattels). Nevertheless, I start here because I believe the current copyright law is mired in this kind of physical understanding of intellectual property rights. Although the physical approach is limited in some aspects, those limits do not undermine the present project. The metaphor is helpful as an analytical device because it represents the way in which we commonly think about derivative works disputes. Adopting what I believe to be the current cognitive framework and explaining how to adjust it is the first step towards reforming our approach. If we reconceptualize our copyright framework to include the third choice of a commonly-held middle ground, it becomes easier to discern which uses should be fair for anyone (and everyone) to adopt and adapt to their own purposes.

Of course, fair uses do not comprise the entire universe of the public domain; the idea/expression dichotomy, for example, mandates copyright extends only to the expression of ideas, but not to the underlying facts or ideas themselves.<sup>7</sup> But while most courts preserve real room in the commons for uncopyrightable facts and ideas,<sup>8</sup>

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7 See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991).

8 See, e.g., *id.*; *Baker v. Selden*, 101 U.S. 99, 100–01 (1879); *Metcalf v. Bochco*, 294 F.3d 1069, 1074 (9th Cir. 2002); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 31–37 (1st Cir. 2001); *MiTek Holdings v. Arce Eng'g Co.*, 89 F.3d 1548, 1556 n.19 (11th Cir. 1996); *BellSouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g*, 999 F.2d 1436, 1445 (11th Cir. 1993).

courts often reduce the fair use portion of the commons to a mere fence, denying space for it within the public domain.

Under the middle ground approach, the public domain should include two categories of intellectual property relevant to derivative works litigation: what I term a “derivative exceptions” category and a “fringe elements” category.

### A. *Derivative Exceptions Category*

The derivative exceptions category I propose contains the portions of a work the fair use doctrine withholds from the copyright holder’s exclusive rights. This is a shifting category; elements that constitute fair use for one allegedly infringing work may not necessarily be available for use in another. This is because the fair use test looks not just to the original copyrighted work, but also to aspects of the allegedly infringing work.<sup>9</sup> Thus, while the Supreme Court determined that the rap music group 2 Live Crew might fairly use some lyrics and a distinctive bass riff from Roy Orbison’s well known song *Oh, Pretty Woman* in their rap song *Pretty Woman* because “parody, like other comment or criticism, may claim fair use under § 107,”<sup>10</sup> courts might correctly hold another work incorporating those same elements *without* parodic purpose an infringement.

When courts see fair use only as a fence, they have trouble giving content to the derivative exceptions category. The either/or choice presented under that framework skews the decision. When faced with a defendant’s work that arguably benefited by using some of a plaintiff’s creation, courts are too vulnerable to mischaracterizing the situation and may act on a false sense of perceived unfairness to the plaintiff. This sense of unfairness accompanies a determination that the defendant might profit from the portion of the plaintiff’s estate he lopped off and incorporated into his work.

But the unfairness here is based on a false underlying assumption: when a court decides in favor of the defendant, it is essentially ruling the work in question is not a derivative work. This assumption mistakenly ignores the Copyright Act’s fair use exception to an author’s right to derivative works. This means some works which would *otherwise* be characterized as derivative works nonetheless are permitted as fair uses because they legitimately use elements that are residents of the public domain middle ground. Properly framed in this

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9 For example, the Act directs courts to consider “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes,” in determining if the use was fair. 17 U.S.C. § 107(1).

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

manner, when elements from the plaintiff's original work are present in a new work, courts can decide between more than simply characterizing the work as either a derivative work of the plaintiff's or an entirely new creation of the defendant's. The fair use middle ground provides a third option. It lets a court recognize a fair use that incorporates material from the derivative exceptions category, meaning the defendant did not steal elements from the plaintiff's domain, but rather gathered them from the common area of the middle ground.

### B. *Fringe Elements Category*

The second category I propose courts recognize in derivative works litigation requires them to acknowledge the limits of derivative works themselves. Instead of seeing fair use in otherwise derivative works, here courts need to acknowledge that some creations which allude to copyrighted works do not implicate the exclusive derivative works rights of the copyright holder. The theory behind this category is that certain fringe elements of all works belong to the public domain. Unlike the first category, here the elements are fixed. *Anyone* should be free to use material from the fringe elements category regardless of the use to which he or she puts them.

But courts may also be reluctant to give life to this group. And when courts construe the right to create derivative works too broadly, they force defendants that should get the benefit of using fringe elements to subject their use to a stingy fair use analysis as if they were in the derivative exceptions category. Here again, some sense of obligation to be fair to the plaintiff influences courts considering allegedly infringing uses that incorporate fringe elements. But this duty is misplaced here as well. The "one winner, one loser" approach of our adversarial system no doubt prejudices us to view a loss for a plaintiff copyright holder as a win for the defendant borrower. In some ways, of course, the defendant who prevails on an infringement action against him "wins," but that does not necessarily mean he *gains* something that used to belong to the plaintiff. Indeed, when the fringe elements category is implicated, what he wins is recognition of the fact that what he used belonged to no one: it inhabited that middle ground of the public domain.

Thus, although the dispute before a court is framed in terms of two adverse parties with personal interests in the outcome of the litigation, copyright disputes over fair use also implicate the interests of a third party, the public, which has an interest in free access to public domain elements. The fringe elements category helps a court remember the public interest involved in fair use litigation. Importantly,

then, identifying a work as using fringe elements is an intermediate step to ruling for the defendant. Although the defendant's victory is a necessary consequence of that decision to identify the work as using fringe elements, finding something to be a fringe element not only deems it fair game for the defendant to have used in that case, but also establishes it as part of the public domain for future creators.

As such, title to the portions of the work in dispute in this hypothetical case never changes hands; it remains property of the commons. Under this view, when a judge draws lines to indicate where a plaintiff's property rights end and fair use begins, she is not simply constructing a fence that demarcates the plaintiff's property on one side and the defendant's on the other. Instead, she marks only the line between the plaintiff's property and one edge of the middle ground of the public domain. Conceived of in this manner, the judge does not shift ownership; she simply maps out what has *never* belonged exclusively to the plaintiff, the defendant, or any individual. If this act results in a victory for anyone, it is in fact a win for everyone equally, for all authors are entitled to use and benefit from commonly-held fringe elements inhabiting the middle ground of the public domain.

The derivative exceptions and the fringe elements categories describe aspects of copyrighted works which should receive protection as fair uses. Courts can use this framework to transform the fair use fence, giving content to the space occupied by the middle ground of the public domain. With this approach in mind, I now turn to two leading cases to illustrate how the middle ground method will operate.

### C. The Cat NOT in the Hat!: *Borrower of Fringe Elements*

Under the middle ground approach, judges should not conceive of works that incorporate public domain fringe elements as ones that "merely" use "the substance or style of the original composition . . . to get attention or to avoid the drudgery in working up something fresh."<sup>11</sup> Yet that is exactly what the Ninth Circuit did a decade ago when it ruled the book *The Cat NOT in the Hat!* impermissibly infringed on the derivative works rights of the copyright holders.<sup>12</sup> The book satirically retold the O.J. Simpson double-murder trial by evok-

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11 *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400 (9th Cir. 1997) (quoting *Campbell*, 510 U.S. at 580).

12 *See id.*

ing the style of the popular children's book series authored by "Dr. Seuss."<sup>13</sup>

The Ninth Circuit upheld a preliminary injunction issued by the district court to enjoin the defendants from distributing *The Cat NOT in the Hat!*. An advertisement for the book declared:

Wickedly clever author "Dr. Juice" gives the O.J. Simpson trial a very fresh new look. From Brentwood to the Los Angeles County Courthouse to Marcia Clark and the Dream Team. *The Cat Not in the Hat* tells the whole story in rhyming verse and sketches as witty as Theodore [sic] Geisel's best. This is one parody that really packs a punch!<sup>14</sup>

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13 "Dr. Seuss" was Theodor S. Geisel's pen name.

14 *Dr. Seuss*, 109 F.3d at 1397. The court quoted the following portions of *The Cat NOT in the Hat!* that give a flavor of the work:

The first two pages present a view of Los Angeles, with particular emphasis on the connection with Brentwood, given the depiction of the news camera lights. The story begins as follows:

A happy town  
 Inside L.A.  
 Where rich folks play  
 The day away.  
 But under the moon  
 The 12th of June.  
 Two victims flail  
 Assault! Assail!  
 Somebody will go to jail!  
 Who will it be?  
 Oh my! Oh me!

The third page reads: "One Knife? / Two Knife? / Red Knife / Dead Wife." This stanza no doubt mimics the first poem in Dr. Seuss' *One Fish Two Fish Red Fish Blue Fish*: "One fish / two fish / red fish / blue fish. Black fish / blue fish / old fish / new fish." For the next eighteen pages, Katz writes about Simpson's trip to Chicago, the noise outside Kato Kaelin's room, the bloody glove found by Mark Fuhrman, the Bronco chase, the booking, the hiring of lawyers, the assignment of Judge Ito, the talk show interest, the comment on DNA, and the selection of a jury. On the hiring of lawyers for Simpson, Katz writes:

A plea went out to Rob Shapiro  
 Can you save the fallen hero?  
 And Marcia Clark, hooray, hooray  
 Was called in with a justice play.  
 A man this famous  
 Never hires  
 Lawyers like  
 Jacoby-Meyers.  
 When you're accused of a killing scheme



The court enjoined the work after finding the defendants had “appropriated the Cat’s image, copying the Cat’s Hat and using the image on the front and back covers and in the text” of the book.<sup>15</sup> The defendants had employed an illustration styled to match the “drawing, coloring, and shading techniques” used in *The Cat in the Hat*.<sup>16</sup> The image portrayed a cartoon “Dr. Juice” wearing the Cat’s well known red-and-white striped stove-pipe hat.<sup>17</sup> When the court upheld the characterization of *The Cat NOT in the Hat!* as a derivative work and declined to recognize a fair use defense based on parody for the work, it committed a classic blunder based on the ill-conceived approach to derivative works claims described above.

Seeing fair use as only a fence dividing the plaintiff’s property from the defendants’, the court held the defendants infringed on the plaintiff’s exclusive rights to create derivative works based on the copyrighted collections of *Cat in the Hat* and other Dr. Seuss books.<sup>18</sup> One way to view the court’s decision to enjoin *The Cat NOT in the Hat!* is to see a failure to give content to a fair use exception to an otherwise derivative work; in other words, a failure to give due regard to use of the derivative exceptions category described above. Several observers have persuasively argued the court’s decision that the work was not a

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You need to build a real Dream Team.  
 Cochran! Cochran!  
 Doodle-doo  
 Johnnie, won’t you join the crew?  
 Cochran! Cochran!  
 Deedle-dee  
 The Dream Team needs a victory.

*Id.* at 1401.

15 *Id.* at 1398.

16 *Id.* at 1399.

17 One commentator notes:

The Ninth Circuit’s rationale is misleading as a factual matter, because it implies that the character of the Cat in the Hat (the Cat’s “image”) was copied verbatim by the defendants. That is incorrect. The character of the Cat in the Hat does not appear at all in the defendant’s work. What appears is a caricature of O.J. Simpson drawn in the *style* of Dr. Seuss, wearing the Cat’s distinctive red-and-white stove-pipe hat. It is only the hat that makes the allusion to *The Cat in the Hat* recognizable. Without the hat, the defendant’s drawings would still be Seussian in general appearance, but no particular character (and certainly not the Cat) could be identified. Thus, the Ninth Circuit’s ruling amounts to a virtual monopoly on any use of a red-and-white stovepipe hat.

Ochoa, *supra* note 3, at 600 (footnote omitted).

18 *Dr. Seuss*, 109 F.3d at 1403.

parody entitled to fair use protection was incorrect as a matter of law.<sup>19</sup>

But certainly *The Cat NOT in the Hat!* was not a work Dr. Seuss Enterprises wanted to produce itself. In fact, the plaintiff sought an injunction precisely because the irreverent, satirical critique of the Simpson trial and events surrounding it did *not* match the innocent, whimsical style of the Dr. Seuss collection.<sup>20</sup> It is difficult to imagine Dr. Seuss Enterprises “deriving” *The Cat NOT in the Hat!* from other Dr. Seuss works and marketing it as another work in its existing series of children’s literature. After Theodor Geisel wrote the original *The Cat in the Hat* book, he (or Dr. Seuss Enterprises) created several books that are appropriately labeled derivative works, like *The Cat in the Hat Comes Back*, *The Cat in the Hat Beginner Book Dictionary*, *The Cat in the Hat Songbook*, and *The Cat’s Quizzer*.<sup>21</sup> These books and other licensed uses of the Cat character, such as “for use on clothing, in interactive software, and in a theme park,”<sup>22</sup> are consistent with the whimsical, playful style and target audience of the original work: children and their parents. In stark contrast, *The Cat NOT in the Hat!* employs a “jaded, satirical and mocking tone”<sup>23</sup> and “is intended primarily for adults who are either devotees of the O.J. Simpson saga or those who desire to see either O.J. Simpson or Dr. Seuss satirized in a creative and merciless manner,”<sup>24</sup> making it quite dissimilar from true derivative works.

In light of this, perhaps the court’s error is greater still: *The Cat NOT in the Hat!* should not be considered a derivative work in the first place. Unlike works that truly derive from an earlier Dr. Seuss work, *The Cat NOT in the Hat!* does not tell another tale situated in the *Cat in the Hat* world. It does not depict characters, copy dialogue, or lift illustrations from the original story. As I will explore below, decisions like this one demonstrate courts are going beyond articulated copyright protections to allow the copyright holder to dictate glosses on the im-

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19 See, e.g., Gregory K. Jung, *Dr. Seuss Enterprises v. Penguin Books*, 13 BERKELEY TECH. L.J. 119, 127–35 (1998); Ochoa, *supra* note 3, at 589–620; Kathryn D. Piele, *Three Years After Campbell v. Acuff-Rose Music, Inc.: What Is Fair Game for Parodists?*, 18 Loy. L.A. Ent. L. Rev. 75, 91–94 (1997); Jason M. Vogel, Note, *The Cat in the Hat’s Latest Bad Trick: The Ninth Circuit’s Narrowing of the Parody Defense to Copyright Infringement in Dr. Seuss Enterprises v. Penguin Books USA, Inc.*, 20 CARDOZO L. REV. 287, 303–10 (1998).

20 “Seuss alleged that *The Cat NOT in the Hat!* . . . diluted the distinctive quality of its famous marks.” *Dr. Seuss*, 109 F.3d at 1397.

21 See *id.* at 1396.

22 *Id.*

23 Ochoa, *supra* note 3, at 609.

24 *Id.* at 608.

age he or she has created by branding his or her creative work. Under this view, courts are not protecting a copyright holder's right to create derivative works based on the original. Instead, as we will see, they are getting at a different kind of right, something akin to the European concept of moral rights.<sup>25</sup> Thus, the court should have viewed *The Cat NOT in the Hat!* as using material from the fringe element category. In this case, however, the Ninth Circuit failed to see a distinction between works that are truly derivative and those that merely reference or incorporate some element(s) of an original work. Here, the single fringe element on which the district court based its decision was the defendant's use of the Cat's red-and-white stove-pipe hat.<sup>26</sup> I will explore in the last part of this Note why courts should view a well-known icon of popular culture like the Cat's hat as a fringe element inhabitant of the public domain. Icons like this permanently inhabit the commons and should be free for any use by anyone.

#### D. The Wind Done Gone: A Derivative Exception

*Suntrust Bank v. Houghton Mifflin Co.*<sup>27</sup> properly frames the tension of the derivative exceptions category between derivative works and fair use exceptions to them. The *Suntrust* court examined the ability of an author to appropriate the characters, plot, and major scenes from the book *Gone with the Wind* into a novel critiquing that book's "depiction of slavery and the Civil-War era American South."<sup>28</sup> That novel was titled *The Wind Done Gone*.

The defendants argued author Alice Randall's "retelling" of *Gone with the Wind* in *The Wind Done Gone* was an "inversion" of the original book where "the characters, places, and events lifted . . . are often cast in a different light," with "strong characters from the original . . . depicted as weak (and vice-versa)" and the romanticized "institutions and values" of *Gone with the Wind* "exposed as corrupt" in the new work.<sup>29</sup> Unlike *The Cat NOT in the Hat!*, *The Wind Done Gone* did more than simply reference a portion of an existing work. *The Wind Done Gone* incorporated "numerous characters, settings, and plot twists" from *Gone with the Wind*, and copied "often in wholesale fashion, the descriptions and histories of these fictional characters and places . . . as well as their relationships and interactions with one another."<sup>30</sup> In-

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25 See *infra* Part II.

26 See *supra* note 17 and accompanying text.

27 268 F.3d 1257 (11th Cir. 2001).

28 *Id.* at 1259.

29 *Id.* at 1267.

30 *Id.*

deed, *The Wind Done Gone* did not just tell an earlier or later story using *Gone with the Wind*'s characters and settings; it told the *same* story as the original, but from a new viewpoint: that of an illegitimate daughter and a slave on Twelve Oaks Plantation.<sup>31</sup> As Randall's lawyer put it:

More than just a stinging critique, "The Wind Done Gone" turns "Gone With the Wind" upside down. At Tata, the angelic Melanie (Mealy Mouth in Randall's version) turns out to be a murderer, Ashley Wilkes (Dreamy Gentleman) is gay, the slaves outsmart the slave owners, and Rhett (R) leaves Scarlett (Other) and marries her mulatto half-sister Cynara. And Other is indeed transported to the great white plantation in the sky.<sup>32</sup>

Thus, unlike *The Cat NOT in the Hat!*, *The Wind Done Gone* was truly a work derived directly from the original *Gone with the Wind*.

As we saw above, *The Cat NOT in the Hat!* was quite different from other licensed derivative works in the Dr. Seuss collection.<sup>33</sup> Here, however, the copyright holder had authorized the famous movie version of the book, as well as "the publication of *Scarlett: The Sequel to Margaret Mitchell's Gone With the Wind* by Alexandra Ripley[,] . . . which incorporated the characters, character traits, settings, plot lines, title and other elements of the original novel," and had also contracted to authorize, "under certain conditions, the making of a second sequel to *Gone With the Wind* again using copyrighted elements of the original novel."<sup>34</sup> Although the Eleventh Circuit noted *The Wind Done Gone* "may have little to no appeal to the fans of [*Gone with the Wind*] who comprise the logical market for its authorized derivative works,"<sup>35</sup> the defendants clearly hoped to reach readers of the original work. As the court observed, *The Wind Done Gone* "is principally and purposefully a critical statement that seeks to rebut and destroy the perspective, judgments, and mythology of" *Gone with the Wind* by "explod[ing] the romantic, idealized portrait of the antebellum South during and after the Civil War."<sup>36</sup> To be effective, *The Wind Done Gone* needed to reach the people who enjoyed the first novel and, through its inversion of the story, highlight and debunk the racist and paternalistic attitudes towards blacks depicted in *Gone with the Wind*. Thus, the purpose and character of *The Wind Done Gone* is much more closely aligned with

31 See *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357, 1367 (N.D. Ga. 2001), *rev'd*, 268 F.3d 1257 (11th Cir. 2001).

32 Zick Rubin, *Law: The Suit's Done Gone*, BOSTON GLOBE, May 26, 2002, at D2.

33 See *supra* notes 21–24 and accompanying text.

34 *Suntrust*, 136 F. Supp. 2d at 1363.

35 *Suntrust*, 268 F.3d at 1276.

36 *Id.* at 1270.

that of the authorized derivative works than in the Dr. Seuss situation. *The Wind Done Gone* was truly a derivative work of *Gone with the Wind*.

Because it was a derivative work, the Copyright Act exclusively reserved the right to publish *The Wind Done Gone* to the copyright holder of *Gone with the Wind*. Therefore, we are dealing here with the derivative exceptions category, where the fair use exception provides the only defense to an infringement claim. Unduly influenced by the false sense of unfairness responsible for narrow readings of fair use in derivative works litigation, the district court issued a preliminary injunction against *The Wind Done Gone*.<sup>37</sup> The Eleventh Circuit reversed, holding the injunction improper as a prior restraint on speech.<sup>38</sup> It remanded the case, noting "under the present state of the record, it appears that a viable fair use defense is available,"<sup>39</sup> becoming one of the few courts to broaden fair use beyond a fence. Even though the court agreed *The Wind Done Gone* derived from *Gone with the Wind* because it "appropriate[d] a substantial portion of the protected elements"<sup>40</sup> from the novel, the court reasoned "[a] use does not necessarily become infringing the moment it does more than simply conjure up another work" it parodies.<sup>41</sup> In light of its value as a social commentary and critical assessment of a copyrighted work, *The Wind Done Gone's* use of substantial portions of *Gone with the Wind* was fair; those portions it used are part of the shifting residents of the derivative elements category.

Of course, the use was not a particularly flattering one; indeed, *The Wind Done Gone* sought to condemn the original novel's portrayal of the South's social structure and attitudes. In so doing, *The Wind Done Gone* recast classic, beloved characters in an unattractive light. As the Eleventh Circuit noted, *The Wind Done Gone* "flips [*Gone with the Wind*]'s traditional race roles, portrays powerful whites as stupid or feckless, and generally sets out to demystify [*Gone with the Wind*] and strip the romanticism from Mitchell's specific account of this period of our history."<sup>42</sup> In light of this, the plaintiff protested it had "incalculable millions of dollars riding on the appropriate cultivation" of the *Gone with the Wind* franchise.<sup>43</sup> We can read into this claim the

37 *Suntrust*, 136 F. Supp. 2d at 1386.

38 *Suntrust*, 268 F.3d at 1277.

39 *Id.*

40 *Id.* at 1272.

41 *Id.* at 1273.

42 *Id.* at 1270 (footnote omitted).

43 *Id.* at 1276. This argument found sympathy with the district court judge. According to Randall's lawyer, the judge explained his decision to issue the injunction with the statement: "I guess what really troubles me is killing off Miz Scarlett." Rubin,

real fear behind the infringement action: that *The Wind Done Gone* would negatively color the image so carefully constructed and preserved by the “*Gone with the Wind* franchise.” Indeed, Randall’s lawyer explained the district court’s decision to issue an injunction in terms perfectly matched with the physical understanding of intellectual property rights advanced at the beginning of this Note:

In the judge’s view, “*The Wind Done Gone*” brazenly invaded the trusts’ territory—something like General Sherman’s march through the South itself—leaving in its wake a battered husk of a 65-year-old Southern classic whose colossal earning power would be diminished. The only way to prevent the carnage, the judge concluded, was to stop the presses. As for Randall’s First Amendment right to provide an antidote to the racism of “*Gone With the Wind*” — frankly, the judge didn’t give a damn.<sup>44</sup>

The lawsuits over *The Wind Done Gone* and *The Cat NOT in the Hat!* both evidence a concern on the part of the copyright holders to protect their profitable and successful brand or image. At some level, both plaintiffs succeeded in convincing a court this interest was legitimate and deserving of protection. Yet copyright law does not protect these kinds of moral rights. This backdoor accommodation of these kinds of interests is the subject of the next part of this Note.

## II. COURTS’ BACKDOOR ACCOMMODATION OF MORAL RIGHTS

The current trend in derivative works litigation represents an effort by some courts to accommodate copyright holders’ desires to protect the integrity of their famous creations. The accommodation certainly is not explicit; in fact, it might not even be a conscious move by the judiciary. But clearly this kind of concern motivates copyright holders to pursue derivative works litigation to protect a profitable image. As Professor Ochoa points out, “it is likely that Dr. Seuss was less concerned with the minimal threat of economic competition posed by the defendants’ work, and more concerned about protecting its ‘image’ as a provider of wholesome family entertainment.”<sup>45</sup> While Professor Ochoa analyzes this desire under various trademark and unfair competition claims,<sup>46</sup> I propose this type of claim is more properly the province of moral rights.

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*supra* note 32. “After all, the judge reasoned, in a bizarre exercise of literary realism, if *Scarlett* is killed off in an unauthorized parody, how could she ever be brought back to life in a red-blooded, authorized, rake-it-all-in sequel?” *Id.*

44 Rubin, *supra* note 32.

45 Ochoa, *supra* note 3, at 620.

46 *See id.* at 619–33.

"Moral rights are personal rights that vest in the author of a creative work and exist independent of economic rights."<sup>47</sup> These rights encompass principles "such as the notion that creators of works should also be able to prevent their works from being imperfectly copied, displayed, or reformatted, and a right of attribution."<sup>48</sup> While European law generally recognizes some form of moral rights, "[i]n the United States, for better or worse, copyright law is much more explicitly about dollars and cents."<sup>49</sup> Indeed, "American courts have often found discussions regarding an author's feelings about the use of his or her copyrighted work outside the ambit and statutory mandate of copyright law."<sup>50</sup> The concept of moral rights encompasses various specific rights, two of which are pertinent to this discussion. These are the rights of integrity and attribution.

### A. Integrity

The author's right of integrity "is generally understood as the right of an author to object to any distortion, mutilation, or modification of his work that would be derogatory to his reputation or honor."<sup>51</sup> Although integrity usually protects a specific creation, such as a particular piece of artwork, from unauthorized alteration or destruction, the idea behind it captures the desire of a U.S. copyright holder seeking to control the type of glosses associated with his or her work.<sup>52</sup> Some sort of an integrity-like claim is involved when a marketer of wholesome family entertainment like Dr. Seuss Enterprises wishes to protect the integrity of that image by suppressing an adaptation of one of its identifying elements to lightheartedly portray a murder trial. Likewise, a desire to protect the image of the characters and story associated with the novel *Gone with the Wind* causes the copyright

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47 Robert J. Sherman, Note, *The Visual Artists Rights Act of 1990: American Artists Burned Again*, 17 CARDOZO L. REV. 373, 373 (1995) (footnotes omitted).

48 John D. Shuff & Geoffrey T. Holtz, *Copyright Tensions in a Digital Age*, 34 AKRON L. REV. 555, 555 (2001).

49 *Id.*

50 Sherman, *supra* note 47, at 380 (footnote omitted).

51 *Id.* at 381 n.47.

This concept may be brought into better focus, for lawyers who might find discussion of honor and reputation slightly ephemeral, by the analogy drawn by Professor Damich: "Just as a United States Senator might be at great pains to make sure his remarks are accurately reported, so the visual artist feels he is entitled to preserve the authenticity of his visual message."

*Id.* (citing Edward J. Damich, *A Critique of the Visual Artists Rights Act of 1989*, 14 NOVA L. REV. 407, 408 (1990)).

52 Interestingly, the language of trademark claims—"dilution" and "tarnishment"—closely aligns with this notion of protection.

holders to dislike a new work that casts that story and those characters in a negative light.

### B. Attribution

Attribution is sometimes also termed a right of “paternity” and includes a number of sub-rights that a government may or may not protect.<sup>53</sup> Pertinent here, and “usually protected,” is the right “to remove one’s name from works created by another.”<sup>54</sup> The same desire to carefully manage a certain image motivates a copyright holder to fight false attributions of its image with unsavory subject matter. Dr. Seuss Enterprises would not want its customers to think it endorsed the content of *The Cat NOT in the Hat!*, nor would the holders of the copyright in *Gone with the Wind* want their loyal readers and fans to think they approved of a version of their classic story that portrayed its beloved characters as stupid, weak, or gay.<sup>55</sup>

U.S. copyright holders seek to protect interests similar to the moral rights of integrity and attribution. To the extent American courts indulge these desires, they create exceptions to the fair use of copyrighted works and expand what counts as derivative works. The final part of this Note contemplates appropriate steps to take in light of this situation.

## III. GOING FORWARD: RECOGNIZING THE MIDDLE GROUND & CONFRONTING MORAL RIGHTS

The reconceptualization of fair use from a fence to a space with content I advocated at the beginning of this Note is a first step, but it

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53 See Sherman, *supra* 47, at 381 n.48. The various sub-rights include the right to be known as the author of one’s work; the right to prevent others from falsely attributing to one the authorship of a work that one has not in fact created; the right to prevent others from being named as the author of one’s work; the right to publish a work anonymously or pseudonymously, as well as the right to change one’s mind at a later date and claim authorship under one’s own name; and the right to prevent others from using one’s work or name in such a way as to reflect adversely on one’s professional standing.

*Id.* (citing 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8D.01[A], at 8D-5 (1994)).

54 *Id.*

55 For example, in *Gone with the Wind*, “Ashley Wilkes is the initial object of Scarlett’s affection; in [*The Wind Done Gone*], he is homosexual,” and the Eleventh Circuit noted “Suntrust makes a practice of requiring authors of its licensed derivatives to make no references to homosexuality.” *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1270 & n.26 (11th Cir. 2001).



is incomplete. As I noted, a territorial view is ill-suited to analyzing intellectual property. Courts cannot measure expression like they can weigh or count tangible property. And although I argue that fringe elements are permanent residents of the public domain, the intellectual property in the derivative exceptions category belies any attempt to pin it down and label it. The framework I proposed is necessary to see defects within the current approach and helps us understand how the new method I propose alters that approach. Once we understand the mistakes courts are currently making, we can better see how they should proceed in the future.

Copyright scholarship and case law are replete with attempts to divine the purpose behind the Copyright Clause.<sup>56</sup> To consider this rich debate is beyond the scope of this Note. The debate does seem to indicate, however, that the interpretive issues related to the history and purposes behind copyright law are so complicated they may never be resolved. The conflicting evidence and theories leave modern-day commentators with significant ambiguity regarding copyright's true or original purpose. In light of this, we need to accept this uncertainty and make decisions based on policy.

The law regarding artistic works must be grounded in an appreciation for the creative process and a history of artistic development. Creative works build off one another, contributing incrementally to progress that in turn results in the creation of new genres of art, literature, and so on.

For as Justice Story explained, "[i]n truth, in literature, in science and in art, there are, and can be, few, if any, things, which in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before."<sup>57</sup>

In light of this necessary borrowing, courts need to provide enough leeway to creators to permit them to incorporate elements of existing works into their own creations so as not to stifle this process while still providing the proper incentive to invest time and effort into creation by protecting existing works. Of course, this is the balance the fair use doctrine supposedly strikes to effect the Copyright

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56 For example, Lyman Ray Patterson identifies "four basic ideas as to the purpose of copyright" during the early American settlement which are present in the constitutional clause: "that copyright is to protect the author's rights; that copyright is to promote learning; that copyright is to provide order in the book trade as a government grant; and that copyright is to prevent harmful monopoly." LYMAN RAY PATTERSON, *COPYRIGHT IN HISTORICAL PERSPECTIVE* 181 (1968).

57 *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994) (quoting *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4436)).

Clause's purpose. But when fair use is reduced to a mere fence, no balance is struck at all; future creativity is sacrificed to pacify existing copyrights.

Courts must recognize popular culture is the substance and means of communication for the modern world. In the past, authors<sup>58</sup> alluded to the Bible, classical mythology, or other well-known stories. While the Bible and other historical works are in the public domain today, most modern audiences lack the requisite familiarity with them. The result is that much contemporary incorporation of public domain works is futile. Today, icons of popular culture perform the role classical tales and characters once did. Overly-properitized approaches to copyright law inhibit modern creators from implementing this important technique of allusion.

Every book, film, and song in the world draws on an existing cultural commons. Creativity rarely, if ever, means inventing something out of nothing. It means taking the scraps and shards of culture that surround us and recombining them into something new.

When the government tells us we can't use those scraps without permission from Disney, Fox, or the Sherwood Anderson Trust, it constrains our creativity, our communications, and our art. It tells us that we cannot draw on pop songs the way we once drew on folk songs, or on TV comedy the way we once drew on vaudeville; it says we cannot pluck pieces from *Star Wars* the way George Lucas plucked pieces from foreign films and ancient legends. The consequences are staggering. Imagine what would have happened if, 100 years ago, it had been possible to copyright a blues riff. Jazz, rock, and country music simply could not have evolved if their constituent parts had been subject to the same restraints now borne by techno and hip hop.<sup>59</sup>

Works of satire and parody in particular depend on having an audience possess knowledge of a particular work. For a reader to fully appreciate and comprehend a satire or parody, he or she must be familiar with the style, manner, form, and set of conventions of the work being critiqued: "The satirist uses the prior knowledge of the audience and the presumed ability of those in the audience to detect the incongruity, contradiction, or incompatibility between what they know of the original style or form and what they perceive before

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58 Shakespeare is only the most famous of a long list of them.

59 Jesse Walker, *Copy Catfight: How Intellectual Property Laws Stifle Popular Culture*, REASON, Mar. 2000, at 44, 51.

them.”<sup>60</sup> Moreover, “because parody depends upon audience recognition of its models, the window of opportunity for the parodist is often extremely short in duration . . . [A] parody must appear while the targeted work is still fashionable and current in the minds of the audience.”<sup>61</sup> Thus, because “[a]udiences in the last quarter of the twentieth century are less and less familiar with biblical and classical literature and more or better acquainted with the artifacts of commerce, popular culture, and government,”<sup>62</sup> a jurisprudential approach which inhibits a creator’s ability to incorporate popular culture icons into his or her work “necessarily shackles the parodist’s ability to comment upon contemporary culture.”<sup>63</sup>

Furthermore, literary criticism itself can become art when it takes the form of parody or satire, and “[e]ven considered purely as artistic forms . . . parody and satire are deserving of legal protection.”<sup>64</sup>

For whatever else it is, satire is art, however peculiar and baffling it may be . . . [And] were the disposition for satire somehow to disappear from the makeup of human beings, and the variegated expressions of it were to vanish, the dance of life would be diminished by the absence of a strange and vital gesture.<sup>65</sup>

Because often “the medium is the message,” an artist who seeks to use popular culture icons cannot reach a desired audience (and generate the desired effect and response) through alternate means. A stuffy journal article simply cannot drive home the same point, and will not reach the same (or as big of an) audience, as a parodic pop song. Finding 2 Live Crew’s remake of *Oh, Pretty Woman* a fair use, the Supreme Court noted:

[W]e think it fair to say that 2 Live Crew’s song reasonably could be perceived as commenting on the original or criticizing it, to some degree. 2 Live Crew juxtaposes the romantic musings of a man whose fantasy comes true, with degrading taunts, a bawdy demand for sex, and a sigh of relief from paternal responsibility. The later words can be taken as a comment on the naiveté of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies.<sup>66</sup>

60 GEORGE A. TEST, *SATIRE: SPIRIT AND ART* 160 (1991).

61 Ochoa, *supra* note 3, at 558.

62 TEST, *supra* note 60, at 171.

63 Ochoa, *supra* note 3, at 559.

64 *Id.* at 561.

65 TEST, *supra* note 60, at 35–36; *see also* Ochoa, *supra* note 3, at 561–64 (citing “the wide variety of authors whose parodies have enriched the world’s literature and culture”).

66 *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 583 (1994).

Despite a lack of supporting empirical data, it seems a fairly safe assumption that 2 Live Crew's sales of the song in their first year, which neared a quarter of a million copies,<sup>67</sup> reached a larger segment of the American population than the Court's opinion could ever hope to.

As we give space to a more robust public domain to accommodate these socially beneficial uses of popular culture, we must also confront the current backdoor deference to moral rights in our case law. There may indeed be a place for moral rights in our copyright law. If this is the case, however, courts (or Congress) should recognize them in a principled, well-defined, and open manner. This is necessary for our society to preserve appropriate protection of First Amendment values and other policy concerns, and to ensure litigants like treatment under the law.

Copyright holders who seek to enforce their claims under a moral rights framework must also realize a moral rights conception does not consider economic harm as a measure of damages. Instead, a kind of reputational capital is at stake when rights of integrity and attribution are compromised. Therefore, a defendant might avoid liability by employing an appropriate credit or disclaimer respecting these moral rights. Even under a moral rights system, the right of integrity only protects the original creation. This kind of right to preserve the internal integrity of a work is not the same as one which tries to thwart external degradation of an image resulting from an original work. Thomas Jefferson's thoughts are illustrative here: "He who receives an idea from me, receives instruction himself without lessening mine; as he who lights his taper at mine, receives light without darkening me."<sup>68</sup> Jefferson was writing specifically about the lack of a natural property right in inventions. Yet his conception of an idea, "which an individual may exclusively possess as long as he keeps it to himself . . . but the moment it is divulged, it forces itself into the possession of every one, and the receiver cannot dispossess himself of it," and which is not diminished as it is shared, as "no one possesses the less, because every other possesses the whole of it,"<sup>69</sup> is as applicable to modern copyrighted works as it was to his immediate subject of patentable inventions. An author may claim a right in preserving his or her original work, but once it becomes part of popular culture, the second-

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67 See *id.* at 573.

68 Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813), in 13 THE WRITINGS OF THOMAS JEFFERSON 326, 333 (Andrew A. Lipscomb et al. eds., 1905).

69 *Id.* at 333-34.

and third-generation works it helps spawn should be beyond the purview of copyright protection.

For example, one commentator, Jesse Walker, surveyed the “astonishing array” of homemade fan epics available on the Internet.<sup>70</sup> One, *Kung Fu Kenobi’s Big Adventure*, is a

seven-and-a-half-minute short by one Evan Mather, with musical and visual allusions to everything from *Mission: Impossible* to *A Charlie Brown Christmas*. Performed by *Star Wars* action figures against a computer-generated animated background this film is 50 times as inventive as *The Phantom Menace* and about 100 times as entertaining.<sup>71</sup>

Walker observes:

*Kung Fu Kenobi* violates more copyrights than I could count. All the dialogue is taken directly from the soundtracks of other films. All the characters are lifted from other films, too. And I doubt Mather paid any licensing fees for the music. But it’s an original work in itself, a funny movie that appeals even to ogres like me who don’t care much for *Star Wars*.<sup>72</sup>

Walker reprints a message from the website of the directors of another homemade film, seventeen-year-old high school students from New Jersey: “If you have a video camera lying around, and better yet some editing equipment (pretty cheap for computers nowadays), go experiment. Be your own director. Go Hollywood . . . use a skateboard for dolly shots, or a fishing rod for special effects. It’s fun.”<sup>73</sup> As Walker puts it:

That is, ultimately, the best argument for letting movies like this exist. It’s not just that there’s a sizable subculture that wants to watch them, and it’s not just that sometimes a director like Evan Mather will make something so fun that even nonfans will enjoy the results. These movies are a first rung in the art of filmmaking, a

70 Walker, *supra* note 59, at 49.

71 *Id.* Walker notes:

My favorite scene: a recreation of the Jedi Council meeting in *Menace*, on a set made out of Legos. The Jedi knight played by Samuel Jackson rises and delivers a speech, sampled directly from a rather different film starring Jackson, *Pulp Fiction*:

“Blessed is he who, in the name of charity and good will, shepherds the weak through the valley of darkness, for he is *truly* his brother’s keeper. And I will strike down upon thee with great vengeance and *furios* anger—”

Yoda interrupts: “*Anger* leads to *hate*.”

*Id.*

72 *Id.*

73 *Id.* at 50.

chance for budding actors, writers, and directors to learn the rudiments of their craft. If those young auteurs want to adopt bits of the *Star Wars* mythos in their films, well, why shouldn't they? *Star Wars* is a part of our culture; it's a shared experience. And as [MIT media studies professor Henry] Jenkins points out, "If something becomes an essential part of our culture, we have a right to draw on it and make stories about it."<sup>74</sup>

Authors will be free to draw on these aspects of our shared culture to create new works to add to our collective pop culture landscape when we adopt the new understanding of fair use I propose: transforming it from a fence to the middle ground between copyrighted works.

#### CONCLUSION

The goal of fair use is to treat both parties to a copyright dispute fairly. When courts reduce the doctrine to a fence, they fail to give content to the middle ground of the public domain, and thus fail to strike a fair balance between copyright holders and those who seek to incorporate some elements of existing works in a creative, socially beneficial manner. Courts need to understand the false assumptions underlying the framework within which they perceive current derivative works disputes. They should distinguish between suits that implicate the derivative exceptions category and those that do not involve derivative works at all, and thus concern the fringe elements category. Moreover, courts need to be mindful of the influence moral rights claims have on derivative works cases. Any accommodation of integrity or attribution-like rights must be done in a conscious and carefully-considered manner. As courts approach future derivative works litigation, policy concerns in light of communication realities and artistic processes in contemporary society should inform their judgment to give proper vitality to the public domain.

