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Copyright and the First Amendment: After the *Wind Done Gone*

By Joseph M. Beck*

Recent litigation between the owner of copyrights in the book and movie *Gone With the Wind* [1] and the publisher and author of *The Wind Done Gone* [2] has surfaced a number of important U.S. copyright law and First Amendment issues for which there was little precedent. Among them are the following:

(1) the potential conflict between the U.S. Copyright Act, 17 U.S.C. 101 et seq. with its provision for a preliminary injunction restraining distribution of an infringing literary work, and the First Amendment, which forbids laws restraining "speech," traditionally defined to include literary works;

(2) the meaning of the "transformative use" defense to copyright infringement in a case involving literary works; and

(3) whether the "parody" defense, previously applied only in music and photography cases, extends to the use of an entire novel and motion picture.

The 11th Circuit Court of Appeals has now provided some guidance with respect to these issues. [3]

The Works At Issue

Gone With the Wind, reputedly second only to the Bible in book sales and the most popular motion picture of all time, is familiar to people on every continent. Alice Randall [4], an accomplished African American woman and author of *The Wind Done Gone*, first read and loved *Gone With the Wind* when she was twelve. When she later reread the book, however, "an enormous question arose...:Where are the mulattos on Tara?" [5] *Gone With the Wind* is a "South without miscegenation, without whippings, without families sold apart, without free blacks striving for their education, without...Frederick Douglass." [6] In *Gone With the Wind*, blacks are "buffoonish [and] lazy ...routinely compared to 'apes,' 'gorillas,' and 'naked savages.'" [7]

In order to "add [her] voice" to the debate, Ms. Randall decided, in the words of her Houghton Mifflin editor, Anton Mueller, to "skewer [*Gone With the Wind*] for its treatment of African Americans." [8] As the device for doing so, Ms. Randall chose parody – as opposed to academic criticism – because it would reach a wider audience. [9]

In pursuing her goal, Ms. Randall faced a daunting task for at least two reasons. First, *Gone With the Wind* covers three periods of history in which the portrayal of blacks progressively worsens. [10] To parody *Gone With the Wind* at the first level, therefore, Ms. Randall did not believe she could stop with antebellum characterizations of blacks, because "blacks during the Civil War are depicted in even more demeaning terms"; she also did not believe she could "stop with the treatment during and immediately after... the war, because blacks during Reconstruction are then represented in the most derogatory fashion of all." [11]

Second, while *Gone With the Wind* created, in the words of the plaintiff's expert, a "historical myth", [12] it did so in the form of a novel of over a thousand pages containing more than 150 characters, many of whom stand for a black stereotype or represent a white Southern "ideal." [13] At the second level, then, Ms. Randall could not parody the "Old South" generally because, in *Gone With the Wind*, the "Old South" is not presented generally: rather it is a construct of many individual characters. Thus, Ms. Randall could not parody only the stereotype represented by the slave Jeems, because different and distinct stereotypes are represented by the slaves Pork, Mammy and Prissy. Similarly, Ms. Randall could not parody only the "ideal" represented by Ellen, the mistress of Tara, because different "ideals" are represented by Scarlett, Gerald, Ashley, Melanie and Rhett. As Candler Professor of English Literature at Emory University John Sitter testified, "Given the scope of both its parodic intent and its parodic object, *The Wind Done Gone* could not effec-

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tively parody *Gone with the Wind* without making numerous allusions."[14]

Summary of the Proceedings Before the Trial and Appellate Court

On March 16, 2001, plaintiff SunTrust Bank filed a complaint in the United States District Court for the Northern District of Georgia against defendant Houghton Mifflin Company, alleging copyright and trademark infringement based on defendant's yet-to-be published novel The Wind Done Gone. On March 23, plaintiff filed a motion for a temporary restraining order and preliminary injunction barring the book's imminent publication. The district court held a hearing on the motion for a temporary restraining order on March 29, 2001, and then set down a second hearing for April 18, 2001.

On April 20, 2001, the district court filed a fifty-one (51) page order granting plaintiff's motion for a preliminary injunction, and enjoining defendant "from further production, display, distribution, advertising, sale, or offer for sale of the book *The Wind Done Gone* on the grounds that the book infringed the plaintiff's copyrights.[15] An expedited appeal was requested by the defendant and granted by the U.S. Court of Appeals for the 11th Circuit.[16]

GIVEN the scope of both its parodic intent and its parodic object, *The Wind Done Gone* could not effectively parody *Gone With the Wind* without making numerous allusions.

Immediately upon the close of argument on May 25, 2001, the 11th Circuit issued an order vacating the injunction on the grounds that it was an unconstitutional prior restraint ("*SunTrust One*").[17] On October 10, 2001, the 11th Circuit vacated its order in *SunTrust One* and issued a more comprehensive opinion extensively addressing copyright and fair use issues ("*SunTrust Two*").[18]

SunTrust One: The Prior Restraint Issue

The entry of an injunction barring publication of *The Wind Done Gone* by the district court produced an extraordinary reaction. The 11th Circuit granted an emergency appeal, an expedited briefing schedule and a prompt hearing. The press, which had paid the case comparatively little attention, overwhelmingly opposed an injunction barring the publication of a book.[19] A number of parties filed "friend of court" briefs.[20]

Plaintiff SunTrust argued that injunctions barring publication of books were expressly authorized by the Copyright Act and were a routine remedy where infringement was found. SunTrust also argued that the failure to uphold an injunction against publication of what the district court called "a piratical copy" would create a precedent for the erosion of sequel rights in scores of valuable literary works.

In response, defendant Houghton Mifflin sought to distinguish the plethora of "routine" cases authorizing injunctions in copyright infringement cases from an injunction restraining speech, relying heavily on a footnote in the U.S. Supreme Court's opinion in *Campbell v. Acuff-Rose Music, Inc.*[21] In *Campbell*, the court indicated that while injunctions may issue routinely in cases of "simple piracy, such cases are 'worlds apart from any of those raising reasonable contentions of fair use' where 'there may be a strong public interest in the publication of the secondary work and the copyright owner's interest may be adequately protected by an award of damages for whatever infringement is found.'"[22]

Houghton Mifflin also relied on a recent 11th Circuit opinion, *Greenberg v. National Geographic Society*, in which the same Judge Birch who wrote *SunTrust One* and *SunTrust Two* stated that injunctive relief should not flow "automatically," even from a clear finding on appeal of infringement by a work that had been in public distribution for years.[23] "In assessing the appropriateness of injunctive relief, we urge the court [on remand] to consider alternatives...in lieu of foreclosing the public's...access to this educational and entertaining work."[24]

SunTrust advanced a number of additional arguments in support of the injunction, including a contention that there was no such thing as "prior restraint in enjoining copyright infringement"[25]; the argument that the district court's injunction "does not prohibit publication of any ideas, arguments or criticism of *Gone With the Wind*"[26]; and an *ad hominem* to the effect that vacating the injunction would leave copyright owners of novels and films with nothing more than a damages claim – in effect, with a "compulsory license" – whenever sequel rights were in dispute. In response, Houghton Mifflin argued that it was precisely the publication of **effective** criticism of *Gone With the Wind* that the injunction banned, relegating would-be critics to unread academic journals; and that the injunctive remedy

authorized by Congress was in any event permissive not mandatory.[27]

The court in *SunTrust One* communicated its rejection of SunTrust's arguments by ruling, within moments after completion of oral argument, that the district court's injunction was in violation of the prohibition against prior restraints and an abuse of discretion. Because of the abbreviated nature of the two-page opinion in *SunTrust One*, however, the court gave little guidance as to its rationale.

Interestingly, *SunTrust Two* fails to expound directly upon the ruling in *SunTrust One* insofar as the court found the preliminary injunction to be an unconstitutional prior restraint. In *SunTrust Two* the court in effect found that the copyright clause in the U.S. Constitution had as its root purpose the promotion of learning and the prohibition of "private" censorship, goals not inconsistent with those of the First Amendment:

> The Copyright Clause and the First Amendment, while intuitively in conflict, were drafted to work together to prevent censorship; copyright laws were enacted in part to prevent private censorship and the First Amendment was enacted to prevent public censorship.[28]

Having reconciled the philosophical purposes of the copyright clause and the First Amendment, the court relied principally upon fair use analysis in concluding that the plaintiff was not likely to succeed on the merits.

The Fair Use Issues

Although the 11th Circuit Court found copying of protected expression, it acknowledged that "[Alice] Randall's appropriation of elements of *Gone With the Wind* in *The Wind Done Gone* may nevertheless not constitute infringement" if the taking was protected as a fair use.[29] In analyzing fairness, the Copyright Act directs courts to weigh the following factors[30]:

(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.

The Purpose and Character of the Use

The court easily found that *The Wind Done Gone* was a "commercial product," but just as easily held that its for-profit status was "strongly overshadowed and outweighed in view of its highly transformative use of *Gone With the Wind*'s copyrighted elements." Observing that *The Wind Done Gone*'s success depended "heavily on copyrighted elements appropriated from *Gone With the Wind*," the court quickly added that *The Wind Done Gone* "is principally and purposefully a critical statement that seeks to rebut and destroy the perspective, judgments and mythologies of *Gone With the Wind*."[31]

After a discussion of numerous examples of inverted characters and altered racial viewpoints, the court concluded that the first factor not only favored fair use, but "informs our analysis of the other factors, particularly the fourth as discussed below."

The Nature of the Copyrighted Work

While agreeing with the plaintiff that *Gone With the Wind* was "undoubtedly entitled to the greatest degree of protection as an original work of fiction," the court agreed with Houghton Mifflin that "this factor is given little weight in parody cases because, as argued by the defendant and as held by the Supreme Court, parodies almost invariably copy well known expressive works."[32]

Amount and Substantiality of the Portion Used

It has always been the law that a parody must be able to "conjure up" enough of the original to make the object of the parody recognizable, but how much more the parodist may use has been the subject of much debate over the years. Noting that *The Wind Done Gone* appropriates a "substantial portion" of the copyrighted elements of *Gone With the Wind*, the court in *SunTrust Two* observed, "Houghton Mifflin argues that *The Wind Done Gone* takes nothing from *Gone With the Wind* that does not serve a parodic purpose, the crux of the argument being that a large number of characters had to be taken from *Gone With the Wind* because each represents a different ideal or stereotype that requires commentary, and that the work as a whole could not be adequately commented upon without revisiting substantial portions of the plot, including its most famous scenes."[33] After analyzing numerous instances in which *The Wind Done Gone* transformed or appropriated elements for the purpose of commentary[34], and after referring to arguments by SunTrust that *The Wind Done Gone* exceeded the bounds in using certain minor details and interaction "that arguably are not essential to the parodic purpose of the work,"[35] the court importantly noted:

> The Supreme Court in *Campbell* did not require that parodists take the bare minimum amount of copyright material necessary to conjure up the original work. 'Parody' must be able to conjure up **at least** enough of [the] original to make the object of its critical wit recognizable.[36] Parody frequently needs to be more than a fleeting evocation of an original in order to make its humorous point.... [E]ven more extensive use [than necessary to conjure up the original] would still be fair use,

> provided the parody builds upon the original, using the original as a known element of modern culture and contributing something new for humorous effect or commentary.[37]

Whether the *Wind Done Gone* took more than what was reasonable from *Gone With the Wind*, therefore, would depend on whether *The Wind Done Gone*'s overriding purpose and character was to parody *Gone With the Wind*, or in contrast to serve as a market substitute for it.[38] Regarding the first issue, the 11th Circuit stated unequivocally, "It is manifest that *The Wind Done Gone*'s *raison d'etre* is to parody *Gone With the Wind*."[39] As for the likelihood that *The Wind Done Gone* would serve as a market substitute, the 11th Circuit held that such would be the case only if *The Wind Done Gone* negatively affected the potential market for or value of *Gone With the Wind*. Based on the record on an appeal of a preliminary injunction, the court could not determine conclusively whether what had been taken was reasonable.

Effect on the Market Value of *Gone With the Wind*

At the outset, the court quickly rejected any argument that a parody might impair the market for derivative uses because it was an effective critical commentary, holding that only an adverse impact "by reason of usurpation of the demand for plaintiff's work through defendant's copying of protectable expression from such work" should be considered.[40]

Reviewing the record, the court found that plaintiff SunTrust "focuses on the value of *Gone With the Wind* and its derivatives but fails to address and offers little evidence or argument to demonstrate that *The Wind Done Gone* would supplant demand for SunTrust's licensed derivatives."[41] By comparison, the court viewed favorably evidence offered by Houghton Mifflin to the effect that no harm cognizable by copyright law was likely to occur:

> In contrast, the evidence proffered in support of the fair use defense specifically and correctly focused on market substitution and demonstrates why Randall's book is unlikely to displace sales of *Gone With the Wind*. Thus, we conclude, based on the current record, that SunTrust's evidence falls far short of establishing that *The Wind Done Gone* or others like it will act as market substitutes for *Gone With the Wind* or will significantly harm its derivatives. Accordingly, the fourth fair use factor weighs in favor of *The Wind Done Gone*.[42]

The Road Ahead

The time for SunTrust to request *certiorari* from the U.S. Supreme Court expired on January 8, 2002. The case now appears headed back for pre-trial discovery on the relatively narrow issue of market effect.[43]

ENDNOTES

*Mr. Beck, lead counsel for Houghton Mifflin, Inc., publisher of *The Wind Done Gone*, is a partner in the Atlanta office of Kilpatrick Stockton. ©Kilpatrick Stockton 2001.

[1] See MARGARET MITCHELL, GONE WITH THE WIND (Simon & Schuster Inc. 1996).

[2] See ALICE RANDALL, THE WIND DONE GONE (Houghton Mifflin Company 2001).

[3] SunTrust Bank v. Houghton Mifflin, 252 F.3d 1165 (11th Cir. 2001) [hereinafter *SunTrust One*] (vacating an injunction barring publication of *The Wind Done Gone* as a prior restraint of speech in violation of the First Amendment of the U.S. Constitution); SunTrust Bank v. Houghton Mifflin, 268 F.3d 1257 (11th Cir. 2001) [hereinafter *SunTrust Two*] (holding that although *The Wind Done Gone* used "the very same copyrighted characters, settings, and plot" as did the book and movie *Gone with the Wind*, it appeared from the record on appeal "that a viable fair use defense is available.").

[4] Ms. Randall graduated with honors in English at Harvard, spent her early adult years in Washington, D.C., where, *inter alia*, she wrote a history of that city's black elite and then moved to Nashville, Tennessee, where she has made a career as a screenwriter and best-selling country music songwriter.

[5] See A Conversation with Alice Randall, *supra* note 2, at 211.

[6] *Id.*

[7] Alice Randall Decl. at 1, SunTrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701-CAP). This declaration (as well as those of every witness in this litigation whose testimony was cited by a party) is available at http://www.thewinddonegone.com/courtpapers.html. Ms. Randall's sentiments about *Gone With the Wind* were shared by Barbara McCaskill, Professor of English at the University of Georgia specializing in African American literature, who testified:

> "Anyone who believes that perjorative characterizations of blacks are not currently accepted by many who cling to the 'historical myth' of *Gone With the Wind* must live in a different world than I do. Although we are more than a century removed from the 1850s and 1860s, the issues that the period raises...still linger, especially in the minds of black readers.... [T]he public discussion raised by

books such as *The Wind Done Gone* is critical to the continued search for healing and truth in our country." Barbara McCaskill Supp. Decl. at 5, SunTrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701-CAP).

Similarly, Henry Louis Gates, Jr., Chair of the Department of Afro-American Studies at Harvard University testified:

"[T]he embarrassing depictions of characters such as Manny and the character played by Butterfly McQueen ('I don't know nutin' about birthin' no babies, Miss Scarlett.') have taken decades for black authors to overcome. . . . *Gone With the Wind* - especially in its book form - is widely regarded in the black community as one of the most racist depictions of slavery . . . in American literature." Declaration of Henry Louis Gates, Jr., SunTrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701-CAP).

[8] Anton Mueller Decl. at 1-2, SunTrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701-CAP).

[9] Parody, a literary device used to criticize or ridicule another literary work, is at the heart of African American expression. As Harvard Professor Gates testified, "it is a creative mechanism for the exercise of political speech . . . on the part of people who feel themselves oppressed . . . and wish to protest that condition. . . . African Americans have used parody since slavery to 'fight back'. . . ." Henry Louis Gates, Jr., Decl. at 1, SunTrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701-CAP).

[10] For example, in *Gone With the Wind:*

a. Blacks in the antebellum South "would sit in the kitchen all day, talking endlessly about the good old days when a house nigger wasn't suppose to do a field hand's work." GONE WITH THE WIND, at 432.

b. During and immediately after the Civil War, many blacks are described as "apes" whom Scarlett would have liked to have "whipped until the blood ran down their backs." *Id.* at 589.

c. By Reconstruction, blacks are portrayed as "creatures of small intelligence" who "like monkeys or small children... ran wild." They "spent most of their time eating goobers and easing their unaccustomed feet into and out of new shoes." Emancipation "just ruined the darkies." *Id.* at 639, 654 & 904.

[11] Alice Randall Decl., *supra* note 8, at 4-5.

[12] Louis D. Rubin, Jr., Aff. at 3, SunTrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701-CAP).

[13] To illustrate, Jeems is the classic chattel, given at ten years of age to the Tarleton twins as "their body servant and, like the dogs, accompanied them everywhere." GONE WITH THE WIND at 10. Pork is the loyal manservant to Gerald O'Hara, won in a poker game, who in times of dire need after the War, steals chickens for his former masters, and is awarded Gerald's watch for his devotion. Manny is the loyal female retainer with the "kind of black face [having] the uncomprehending sadness of a monkey's." *Id.* at 415. And Prissy is the epitome of silliness, forever transfixed as knowing "nothing about birthin' no babies." *See* Henry Louis Gates, Jr., Decl. at 2, SunTrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701-CAP). The white characters, on the other hand, are more complex and interrelated, and depict different facets of the "good" Old South.

[14] John E. Sitter Supp. Decl. at 1, SunTrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357 (N.D. Ga. 2001) (No. 1:01 CV-701-CAP).

[15] SunTrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357 (N.D. Ga. 2001)

[16] *See* Order Dated April 25, 2001, Granting Appellant's Motion for Expedited Review, *SunTrust Two* (No. 01-12200-HH); the trademark claim was barely mentioned in the hearings and briefs and was not ruled upon by the district court.

[17] *See SunTrust One*, 252 F.3d 1165 (11th Cir. 2001).

[18] *See SunTrust Two*, 268 F.3d 1257 (11th Cir. 2001).

[19] *See e.g.* editorials, *Gone with the First Amendment*, N.Y. TIMES, May 1, 2001; *Barring Book Offends the First Amendment*, ATLANTA J. & CONST., May 23, 2001.

[20] Amicus briefs in support of Houghton Mifflin were filed by The New York Times Company, Dow Jones & Company, Inc., The Tribune Company, Media General, Inc., Cable News Network, LP, LLP, and Cox Enterprises; by Microsoft Corporation; by PEN American Center, American Booksellers Foundation for Freedom of Expression, Freedom to Read Foundation, Washington Lawyers' for the Arts, The First Amendment Project, the National Coalition Against Censorship and the Georgia First Amendment Foundation. An amicus brief in support of SunTrust Bank was filed by Paul Levinson and Walter Wager.

[21] 510 U.S. 569 (1994).

[22] *Id.* at 578, n. 10 (quoting Leval, 103 HARV.L.R. 1105, 1133 (1990)).

[23] 244 F.3d 1267 (11th Cir. 2001).

[24] *Id.* at 1275.

[25] See Brief of Plaintiff Appellee SunTrust Bank at 43, *SunTrust Two* (No. 01-12200-HH).

[26] *Id.*

[27] Houghton Mifflin also argued that traditional First Amendment principles applied with equal force in copyright infringement cases. See Trust Company Bank v. Putnam Publishing Co., 5 U.S.P.Q.2d 1874, 1879 (refusing to enjoin publication of a novel that allegedly infringed *Gone With the Wind* because of the public interest in access to the work); see *also* Glove International, Inc. v. National Inquirer, Inc., No. 98-10613 CAS, 1999 Westlaw 727232, *5 (CD CA 1999) ("the prior restraint analysis has been applied to requests for copyright injunctions, even though Congress has included injunctive relief as a remedy for infringement"); *and* Belushi v. Woodward, 598 F.Supp. 36 (D.D.C. 1984) (refusing to enjoin further publication of a book despite the fact that plaintiff had a substantial likelihood of success because the book was not "an average commercial product"); *and* Religious Technology Center v. Larma, 897 F.Supp. 260, 262-63 (ED VA 1995) ("If a threat to national security was insufficient to warrant a prior restraint in New York Times v. United States, the threat to [plaintiff's] copyrights ... is woefully inadequate.").

[28] *SunTrust Two,* 268 F.3d at 1269-70.

[29] In one of the more intriguing paragraphs of *SunTrust Two,* Judge Birch, apparently speaking only for himself, stated, "I believe that fair use should be considered an affirmative **right** under the 1976 [Copyright] Act, rather than merely an affirmative defense, as it is defined in the Act as a use that is not a violation of copyright." *SunTrust Two,* 268 F.3d at 1260, n.3. (emphasis original). Acknowledging that fair use was commonly referred to as an affirmative defense and that "we are bound by Supreme Court precedent." Judge Birch concluded, "[n]evertheless, the fact that the fair use right must be procedurally asserted as an affirmative defense does not detract from its constitutional significance as a guarantor to access and use for First Amendment purposes." *Id.*

[30] 17 U.S.C. § 107 (2002).

[31] See *SunTrust Two,* 268 F.3d at 1269-70.

[32] *Id.* at 1271.

[33] *Id.* at 1272.

[34] As an example, the court pointed to "the final lines of *Gone With the Wind,* 'tomorrow I'll think of some way to get him back. After all, tomorrow is another day,'" in comparison to *The Wind Done Gone*'s "For all those we love for whom tomorrow will not be another day, we send the sweet prayer of resting in peace." *Id.*

[35] *Id.* at 1273.

[36] *Id.* (citing *Campbell,* 510 U.S. at 588 (emphasis added by the 11th Circuit)).

[37] See *SunTrust Two,* 268 F.3d at 1273 (quoting Elsmere Music, Inc. v. National Broadcasting Company, 623 F.2d 252, 253 n.1 (2d Cir. 1980)).

[38] *Id.* at 1273.

[39] *Id.*

[40] *Id.* at 1274.

[41] *Id.* at 1275.

[42] *Id.* at 1275-76.

[43] The case settled shortly after the remand.