


DUPLICATE

FILED IN OFFICE OF THE
U.S.D.C. Atlanta

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

APR 17 2001

By:  L. THOMAS, Clerk
Deputy Clerk

SUNTRUST BANK as Trustee of)
the Stephens Mitchell Trusts f/b/o Eugene)
Muse Mitchell and Joseph Reynolds Mitchell)
Plaintiff,)
v.)
HOUGHTON MIFFLIN COMPANY,)
Defendant.)

Civil Action File
No. 1:01 CV-701-CAP

**DEFENDANT'S MOTION TO STRIKE PLAINTIFF'S LANHAM ACT
ARGUMENT AND MEMORANDUM OF LAW IN SUPPORT THEREOF**

Pursuant to Fed. R. Civ. P. 12(f), Defendant Houghton Mifflin Company ("Defendant") respectfully moves this Court to strike Section III of Plaintiff's Reply Memorandum of Law in Further Support of Plaintiff's Motion for a Preliminary Injunction, filed April 16, 2001 ("Plaintiff's April 16 Brief"). Defendant submits this motion for the following reasons: (1) the Lanham Act arguments set forth in this portion of Plaintiff's April 16 Brief were not timely raised; and (2) Plaintiff's Lanham Act arguments are facially deficient and misstate the law. Should this Court decide not to strike Section III of Plaintiff's April 16 Brief, Defendant requests that it be afforded an opportunity to respond thereto.

**I. PLAINTIFF'S ADDITIONAL LANHAM ACT ARGUMENTS
WERE NOT TIMELY SUBMITTED.**

In their Stipulation and Order dated April 9, 2001, the parties agreed as follows:

that written submissions . . . be served on and received by opposing counsel and the court no later than 5:00 P.M. on April 12, 2001; and that reply written submissions, if any, be served . . . no later than 5:00 P.M. on April 16, 2001.

Stip. and Order at ¶ 2. Plainly, the phrase "reply written submissions" refers to any papers to be filed in response to the "written submissions" that were due on April 12.

In its "written submissions" of April 9 and 12, 2001, Plaintiff focused exclusively upon copyright questions. Defendant's "reply written submission" of April 16, 2001 focused squarely on responding to issues raised in Plaintiff's April 9 and 12 filings. In contrast, Plaintiff devoted five pages of its "reply written submission" to discussing its Lanham Act claim, which had not been raised in either party's submissions from the previous week. By definition, a "reply brief" is a document that responds to content presented in a preceding document; it is not a forum for raising new arguments. *See, e.g., U.S. v. Georgia Dept. of Natural Resources*, 897 F. Supp. 1464, 1471 (N.D. Ga. 1995) (granting motion to strike argument raised for first time in reply brief) ("This court will not consider arguments raised for the first time in a reply brief.").

II. PLAINTIFF'S LANHAM ACT ARGUMENT MISSTATES THE LAW.

At this juncture, defendant cannot respond fully to the Lanham Act questions first raised in Plaintiff's April 16 Brief. Plaintiff, however, makes two assertions that are so plainly incorrect that Defendant is compelled to bring them to the Court's attention. First, the Plaintiff twice suggests that Defendant bears the burden of proving that its book will not create confusion. Pls. Br. at 30, 34. The statement is contrary to the well-established precedent of this -- and every other -- circuit. *See, e.g., Aloe Crème Laboratories v. Estee Lauder, Inc.*, 533 F.2d 256, 257 (5th Cir. 1976) ("It is well established that a plaintiff bears the burden of proving both the validity of its trademark and the confusion caused by defendant's use of a similar mark"); *Cues, Inc. v. Polymer Indus., Inc.*, 680 F. Supp. 380, 383

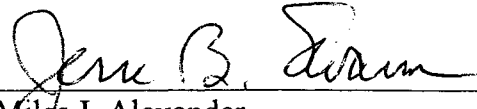
(N.D. Ga. 1988) ("Plaintiff bears the burden of proving both the validity of its trademark and the likelihood of confusion, mistake or deception caused by defendants").

Second, Plaintiff suggests that it need only establish an "association" with *Gone with the Wind* to prevail on its Lanham Act claim. By definition, however, a parody must call the original to mind, *see, e.g., Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.2d 490, 494 (2d Cir. 1989) (effective parody must "convey two simultaneous -- and contradictory -- messages: that it is the original, but also that it is not the original and is instead a parody"), and mere association is insufficient to establish infringement. *See, e.g., Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 264 (5th Cir. 1980) (mere word association is not "meaningful evidence of likelihood of confusion"); *Harvey Cartoons v. Columbia Pictures, Inc.*, 645 F. Supp. 1564 (S.D.N.Y. 1986) (mere association between "Ghostbusters" logo and "Casper the Ghost" characters is not sufficient to establish confusion). As a leading commentator on trademark law has observed, "'Confusion' means more than that the junior user's mark merely 'calls to mind' the senior user's mark." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:9 (4th ed. 2001).

III. IF THIS COURT CHOOSES TO CONSIDER PLAINTIFF'S APRIL 16 LANHAM ACT ARGUMENTS, DEFENDANT REQUESTS AN OPPORTUNITY TO SUBMIT A FULL WRITTEN RESPONSE.

In the event that this Court decides to consider the Lanham Act arguments raised in Plaintiff's April 16 Brief, Defendant respectfully requests that it be afforded the opportunity to submit a full written response to these issues.

Respectfully submitted this 17th day of April, 2001.



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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Defendant's Motion to Strike Plaintiff's Lanham Act Argument has been hand-delivered to counsel of record as follows:

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This 17th day of April, 2001.



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