

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

SUNTRUST BANK as Trustee of)
the Stephens Mitchell Trusts f/b/o Eugene)
Muse Mitchell and Joseph Reynolds Mitchell)
Plaintiff,) Civil Action File
v.) No. 1:01 CV-701-CAP
HOUGHTON MIFFLIN COMPANY,)
Defendant.)
_____)

**DEFENDANT HOUGHTON-MIFFLIN CO.'S RESPONSE
IN OPPOSITION TO PLAINTIFF'S MOTION FOR A
TEMPORARY RESTRAINING ORDER AND PRELIMINARY
INJUNCTION**

Defendant Houghton Mifflin Company ("Defendant") respectfully submits the following memorandum in opposition to Plaintiff's motion for a temporary restraining order and preliminary injunction, which was served on counsel on the evening of March 23, 2001.

This case involves an attempt by the copyright owners of *GWTW* ("*GWTW*") to prevent the publication of a new novel, entitled *The Wind Done Gone* ("*WDG*"). Defendant, an independent publishing house with a more than 150 year-long tradition of publishing important books, respectfully requests that the Court deny Plaintiff's motion so that the novel can be made available to the public.

STATEMENT OF FACTS

WDG is the work of Alice Randall, an African-American woman born in Detroit who now lives in Nashville, Tennessee. The book is Ms. Randall's first novel. The central protagonist, a woman named Cynara, is the out-of-wedlock child of "Planter," a white Southern aristocrat, and "Mammy," one of his slaves. The novel is written as Cynara's diary. Its entries describe her younger days as a slave on the plantation "Tata," her marriage to a white man whom she eventually leaves, and her travels to Europe and Washington, D.C., where she meets a black Congressman from the South for whom she later leaves her white husband.

WDG is a multidimensional work of literature. Declaration of Emory University's Charles Howard Chandler Professor of English John Sitter ("Sitter Decl.", Exh. 1 hereto) at ¶ 5. On one level, it is the story of Cynara's self-development and coming of age. But it is also a story about the mixing of cultural influences, **including language itself**. As Cynara says, after reflecting on phrases of slave speech and on phrases from Shakespeare's sonnets, "all the different ways of talking English I throw together like a salad and dine greedily on my mongrel tongue." *WDG* at 90. The book is filled with allusions to the many works of literature that the slave Cynara has read. See, e.g., *WDG* at 11, 114, 192 (referring to Homer's *Odyssey*, Shakespeare's *Othello*, and Charles Dickens' *Great Expectations*). As such, it is a very different work from *GWTW*.

At another level, however, *WDG* is a classic parody of *GWTW*. Sitter Decl. at ¶ 15. A parody is "a work which imitates another work and in doing so

comments on that work, usually in order to ridicule it or to suggest its limitations.”
Id. Throughout *WDG*, there are references and allusions to *GWTW* which have precisely these effects. For example, in *WDG*, the bodies at Mammy’s funeral are secretly switched so that Planter lies beside Mammy instead of Lady (his wife), mocking the white characters ignorance of Planter’s affair with Mammy, which led to the birth of Cynara. Sitter Decl. ¶ 15.

WDG uses fragments from the world of *GWTW*, just as any parody must, as a backdrop to Cynara’s tale, but recasts and reinterprets those events through perspectives unseen in *GWTW*. Cynara herself, the central character and first-person narrator of *WDG*, does not exist at all in *GWTW*. Those characters who do have analogs – e.g., Garlic/Pork, Scarlett/Other, Gerald O’Hara/Planter, and Mammy -- are portrayed in such radically different ways and from such contrasting perspectives that they simply are not the same characters Margaret Mitchell created. In *WDG*, in sharp contrast to *GWTW*, the black characters are clever and interesting while the white characters are little more than stereotypes.

In parodizing *GWTW*, Alice Randall has created a “pervasive and profound” criticism and commentary on *GWTW*, skillfully and sporadically invoking references to *GWTW* to make a powerful **political**—as well as artistic and social—statement. Sitter Decl. at ¶ 17. If it is allowed to be published, *WDG* will make an important contribution not only to serious academic study, but also to America’s important, ongoing, and at times painful, conversation about race, history, and culture, id.

WDG is by no means the first parody of *GWTW* not to have been licensed by the Mitchell Trusts. A search of electronic databases conducted on March 24, 2001, revealed at least fifty-one (51) individual parodies of *GWTW* that have been created in various forms from 1981 to 2001. See Affidavit of John R. Renaud (“Renaud Aff.,” Exh. 2 hereto) at ¶¶ 2-3. There is no evidence that any of these previous parodies have irreparably damaged the owners of the copyright in *GWTW*.

By contrast, there is considerable evidence that Defendant will suffer irreparable and lasting harm if this Court enjoins publication of *WDG*. Defendant is one of the last remaining independent American publishing houses that publishes a wide variety of fiction and non-fiction books for the general market. Affidavit of Houghton Mifflin Executive Vice-President Wendy Strothman (“Strothman Aff.” Exh. 3 hereto, at ¶ 2). Other formerly independent publishers, such as Random House and Simon & Schuster, have been taken over in recent years by multimedia conglomerates like Bertelsmann and Viacom. Id. at ¶ 6. Defendant derives most of its revenue from sales of textbooks and other educational materials to schools, colleges, and universities. Id. at ¶ 3. Defendant does not focus on publishing the works of highly visible “blockbuster” authors, such as Stephen King or Danielle Steele. Id. at ¶ 6. Rather, Defendant tries to cultivate books with lasting literary merit. Id.

Defendant decided to publish Alice Randall’s book, *WDG*, precisely because Ms. Randall is a provocative new literary voice. Id. at ¶ 7. As such,

publication of the novel fits perfectly with Defendant's longtime strategy of developing such new voices. Many prominent American writers have already reviewed and lavishly praised Ms. Randall's work, and Defendant expects that it will become an unusually successful first novel. Id.

In the months-long, carefully planned process of orchestrating the publication of *WDG*, Defendant has put in place numerous interviews and publicity engagements for Ms. Randall, and many cooperative arrangements with bookstores nationwide, through which the work is to be publicized and distributed. Id. at ¶ 9. Indeed, the Margaret Mitchell House in Atlanta has invited Ms. Randall to speak here at their expense and has publicized the trip through its "Scarlet Letter."

Defendant determined quite some time ago that the chances of success for *WDG* would be maximized if it were included in Defendant's Spring 2001 catalog. Id. at 8. Disruption of the long-planned publication date (currently set for June 6, 2001) would substantially disrupt not only Defendant's efforts to promote and sell *WDG*, but would also force Defendant to divert important resources from the promotion of other works planned for the Fall 2001 season and beyond. Id. Such a disruption in the scheduled publication date would also inevitably harm Defendant's reputation and ability to continue to attract talented authors. Id. at ¶ 6.

DISCUSSION

PLAINTIFFS ARE NOT ENTITLED TO A TEMPORARY RESTRAINING ORDER OR A PRELIMINARY INJUNCTION

I. PLAINTIFFS DO NOT HAVE A SUBSTANTIAL LIKELIHOOD OF PREVAILING ON THE MERITS OF THEIR COPYRIGHT INFRINGEMENT ACTION.

The Supreme Court has said many times that the central purpose of copyright protection is to promote the production of creative works, with monetary rewards to creators as a secondary concern. Fogerty v. Fantasy, Inc., 510 U.S. 517, 526, 114 S.Ct. 1023, 1029 (1999); Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349-50, 111 S. Ct. 1282, 1289-1290 (1992); Mazer v. Stein, 347 U.S. 201, 74 Sup. Ct. 460 (1954). See also H.R. No. 2222, 60th Cong. (2d Sess. 1909).

A. There is no substantial similarity between *WDG* and the protectable expression in *GWTW*.

1. The Limits of Copyright Protection

An “axiom of copyright law” is that it protects the original way in which ideas are expressed, but not the ideas. Herzog v. Castlerock Entm't, 193 F.3d 1241, 1248 (11th Cir. 1999), citing Reyher v. Children's Television Workshop, 533 F.2d 87, 91 (2nd Cir. 1976). See also 17 U.S.C. § 102(b); Beal v. Paramount Pictures Corp., 20 F.3d 454, 459 (11th Cir. 1994).

Moreover, stock scenes – including plantations, slave shanties, and stereotypes of black and white southerners – are never protectable, id. at 458-59, and no one may use a copyright to monopolize history or facts. See Alexander v.

Haley, 460 F. Supp. 40 (S.D.N.Y. 1978) (rejecting a copyright infringement claim by author of the novel *Jubilee* against Alex Haley's *Roots*); Gardner v. Nizer, 391 F. Supp. 940 (S.D.N.Y. 1975) (most similarities in two books about Julius and Ethel Rosenberg involved historical facts and events, to which no copyright could be claimed).

GWTW is a work of fiction, but it is historical fiction. For this reason, *GWTW* cannot claim a monopoly on the historical theories it portrays, nor on the historical facts (or purported facts), research, plots, or other historical subject matter that it contains. As the Second Circuit held in Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 978 (2d Cir.), cert. denied, 449 U.S. 841, 101 S. Ct. 121 (1980), “[t]o avoid a chilling effect on authors who contemplate tackling an historical issue or event, broad latitude must be granted to subsequent authors who make use of historical subject matter, including theories or plots.”

Finally, all of the unprotectable material in the claimant's work must be filtered out before the court compares the works at issue in a copyright infringement case. Bateman v. Mnemonics, Inc., 79 F.3d 1532, 1545, n.27 (11th Cir. 1996). “If the similarity between the works concerns only noncopyrightable elements,” the defendant will prevail. Beal, 20 F.3d at 459.

2. Plaintiff's copyright claims based on its sequel *Scarlett* must fail because the author of *WDG* has never had access to *Scarlett*.

Except in rare cases where there is direct evidence of copying, a plaintiff must prove that the defendant has copied its work by establishing both (a) that the

defendant had access to plaintiff's work, and (b) that the defendant's work is substantially similar. Herzog, 193 F.3d at 1248. Although Plaintiffs allege that Defendant has also copied *Scarlett*, the licensed sequel that was published in 1991, Plaintiff has no support for this assertion, and the evidence will show that the author of *WDG* has never read *Scarlett*. Thus, Plaintiff's claim that its copyright in *Scarlett* was infringed must fail.

3. The works are not substantially similar in copyrightable expression.

Even literal copying is not necessarily copyright infringement. In Bateman, 79 F.3d at 1545, the Eleventh Circuit held that, even though there was sufficient evidence supporting a finding of infringement, reversal was nevertheless warranted because the lower court had failed to instruct the jury properly that even literal copying must be filtered out of the substantial similarity analysis where it involves literal copying of uncopyrightable elements. The court referred to the idea that literal copying was by definition copyright infringement as "a manifest distortion and misstatement of the law." Id.

In order to conduct the substantial similarity inquiry in this case, the Court itself must carefully read both books.¹ As the Eleventh Circuit has stressed: "[i]n adjudicating a copyright dispute, the Court must compare the works in question." Herzog, 193 F.3d at 1257, citing Beal, 20 F.3d at 456 (additional cits. omitted). In

¹ Since Defendant's lack of access to the sequel *Scarlett* is fatal to Plaintiff's claims based on infringement of that work's copyright, the Court need not read *Scarlett*.

Herzog, for example, the Eleventh Circuit “independently compared and reviewed the two screenplays . . . in order to compare different aspects of the work in question, including characters, theme, plot, setting, and mood and pace.” 193 F.3d at 1257-58.

Plaintiffs have submitted an exhaustive list of alleged similarities between *WDG* and *GWTW*. While the use of such lists is a common tactic in copyright cases., the Eleventh Circuit has repeatedly held that such lists are “inherently subjective and unreliable[.]” Id. at 1257, citing Beal, 20 F.3d at 460. See also Williams v. Crichton, 84 F.3d 581, 590 (2d Cir. 1996) (lists of alleged similarities “fail to address the underlying issue of whether a lay observer would view the works as a whole substantially similar to one another.”).

In Trust Co. Bank v. Putnam Publ. Co., 5 U.S.P.Q.2d 1874 (C.D. Cal. 1988), the same Plaintiffs sued the publisher of the novel *The Blue Bicycle*, claiming that it infringed their copyright in *GWTW*. As here, Plaintiffs presented charts and lists which purported to detail similarities between the two works. Rejecting Plaintiff’s request for a preliminary injunction, the court noted that “courts must be circumspect about such charts and lists because they are inherently subjective and unreliable, especially if the list emphasizes random similarity scattered throughout the works.” Id. at 1878 (internal quotes omitted).

4. The works are not substantially similar under 11th Circuit literary case law

The Eleventh Circuit has previously considered copyright cases involving works of literature alleged to have been illegally copied from prior works, analyzing expression of the following elements: “plot, mood, characterization, pace, . . . setting . . . [and] sequence of events.” Beal, 20 F.3d at 460.

(a) Characters

In Herzog, the Eleventh Circuit found there was no substantial similarity between characters who shared a “broad similarity” but who otherwise were “completely different in background story, personal attributes, and most distinctively in purpose,” 193 F.3d at 1259, referring to the famous decision by Judge Learned Hand in Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930). See Herzog, 193 F.3d at 1258.²

In Nichols, the Plaintiff owned the copyright in a play that was about a Jewish boy marrying a Catholic, about the anger of both families, and about their reconciliation at the birth of grandchildren. The Defendant told the same basic story in its movie, except that the boy was Irish-Catholic and the girl Jewish. Of the four characters common to both works, the two young lovers had similar characteristics in each work (“loving and fertile”). But the Plaintiff’s work had

² In Miller v. Universal Pictures, the old Fifth Circuit also relied extensively on the Second Circuit’s more recent decision in Hoehling v. Universal City Studios, Inc., 618 F.2d 972 (2d Cir.), cert. denied 449 U.S. 841, 101 S. Ct. 121 (1980), which itself relies on Nichols. It is worth noting that, according to the Second Circuit’s decision in Hoehling, the district court judge in the case had declined to enjoin the release of the allegedly infringing film. 618 F.2d at 977.

drawn them with insufficient distinctiveness for them to be protectable. And although the two fathers had similar traits in each work (“grotesque, extravagant, . . . quarrelsome[, and] fond of display”), they were different in many respects. Plaintiff’s Jewish father was obsessed with religion, “affectionate, warm, and patriarchal,” while defendant’s Jewish father was “tricky, ostentatious, and vulgar, only by misfortune redeemed into honesty.” Plaintiff’s Irish father was “a mere symbol for religious fanaticism and patriarchal pride, scarcely a character at all[,]” while the defendant’s Irish father is “a grotesque hobbledohoy, used for low comedy of the most conventional sort, which any one might borrow[.]”

Like the indistinct character of the Irish father in Nichols, many of the characters in *GWTW*, particularly the African-American characters, are “scarcely characters at all.” The characters of Mammy, Pork and Prissy are little more than stereotypes and stock characters in *GWTW*, and they are not entitled to copyright protection. Conversely, in *WDG*, they are active, intelligent, and interesting characters who shape their surroundings and influence those around them. To the extent *GWTW*’s fully-developed characters have analogs in *WDG*, *WDG*—as part of its parody—presents them as flat, one-dimensional characters who are not substantially similar to the characters created by Margaret Mitchell. The analog to Scarlett, a character known as “Other,” is in many respects simply the archetypal “other” person which is, in much conventional literature, the minority race. Sitter Decl. at ¶ 15.

(b) Theme

In Herzog, the Eleventh Circuit held that the basic theme of both works — “that the past has the power to influence the present” — “is not entitled to copyright protection.” 193 F.3d at 1259. Nor is that theme—to the extent it is present in *GWTW* and *WDG*—protectable here. Indeed, Plaintiff does not even contend that the themes of these two radically different works are similar, much less substantially similar in copyrightable expression.

(c) Plot

In Herzog, although the primary plots of both works involved “[a] murder investigation which reveals the corrupt past of a small town[,]” the Eleventh Circuit observed that such an idea is “a familiar plot that is not subject to copyright protection.” 193 F.3d at 1259 (noting that *To Kill a Mockingbird* and William Faulkner’s *A Rose for Emily* had similar plots). Moreover, as Nichols, 45 F.2d at 122, makes clear, even where a defendant has borrowed ideas from an earlier work, such borrowing does not constitute copyright infringement unless substantial similarity in protectable expression exists:

[i]f the defendant took [the basic plot of his story] from the plaintiff, it may well have been because her amazing success seemed to prove that this was a subject of enduring popularity. Even so, granting that the plaintiff’s play was wholly original, and assuming that novelty is not essential to a copyright, there is no monopoly in such a background. Though the plaintiff discovered the vein, she could not keep it to herself; so defined, the theme was too generalized an abstraction from what she wrote. It was only a part of her “ideas.”

45 F.2d at 122.

Fragments from the world of *GWTW* are a mere backdrop to Cynara's story. Sitter Decl. at ¶ 5. The central plot in *WDG* involves the self-development and coming of age of a person invisible in the world of *GWTW*, a person that the author of *GWTW* did not (and perhaps could not) conceive. *Id.* The protagonist in *WDG* interacts with historical events in a way that suggests an entirely different post-Civil War Reconstruction, the events of which are seen as the beginning, rather than the end, of a era.

(d) Setting

The court in *Herzog* held that, although there were several similarities in the small-town settings of each work, the settings were otherwise “very different.” Notably, the court found that much of the difference in the settings of the two works was

revealed in part by the characters' very different feelings about the place. The protagonist in plaintiff's work was bored by the unexciting pace of life in the small town. By contrast, the setting the defendant's work in a small town in Texas was an area with a complex mix of racial and sociological tensions of the interrelated subplots.

193 F.3d at 1260.

In this case, the settings of the two novels are seen from such radically different perspectives that they can hardly be the same landscape. The settings of *GWTW*, and particularly Tara, are romanticized. By contrast, the settings of *WDG* are informed by the slave perspective. For example, through naming the plantation “Twelve Slaves Strong as Trees,” *WDG* brings to light the blood, sweat,

and tears of the black slaves in building the house (“They stood for the original twelve dark men who cleared the land. And the lines, the flutes, on those columns stood for the stripes on the slaves’ backs.”). *WDG* at 55. Also, in *GWTW*, much is made of Scarlett’s father’s attachment to the land being due to the fact that he is Irish, while in *WDG* his love of the land “had something African in it.” *WDG* at 63. And, whereas Scarlett clings to Tara, Cynara is uprooted from her home early, and later spends a good portion of the novel traveling. Sitter Decl. at ¶ 14.

(e) Mood and Pace

In analyzing the similarities in the mood and pace of the two works, the court in *Herzog* described plaintiff’s work as an “action-adventure featuring the exploits of a female law enforcement officer from the big city proving herself in the male-dominated sheriff’s department of her small hometown.” *Id.* at 1260. By contrast, the defendant’s work was “slow and stately[,]” involving “very little action and/or adventure,” and “is much more thoughtful and reflective than tension-filled.” *Id.*

The pace and style of *WDG* are radically different from those of *GWTW*. *GWTW* is told with conventional linear narration by a third-person omniscient narrator. *WDG* is told in an experimental first-person, nonconventional, non-linear narration. The active pulse of the short chapters in *WDG* contrasts with the passive, genteel flow of the prose in *GWTW*.

(f) Miscellaneous Similarities

Plaintiffs allege that *WDG*'s allusions to *GWTW* constitute unlawful appropriation of protected expression. Allusion, however, is a basic literary technique that is quite distinct from copying. It briefly points to a particular detail in an earlier work as a way of evoking the context and atmosphere of a passage, in order to create new meaning or significance. Plaintiffs' chart of purported similarities obscures the point of the allusions in *WDG*. For example, the allusion to the "twins" having been to various colleges is an ironic comment, pointing out that Garlic got more education standing in Harvard square, while his master attended classes, than the twins acquired in several years. Sitter Decl. at ¶ 6.

B. Even if *WDG* were found to have copied protectible expression, any such copying would be a fair use of *GWTW*.

The Copyright Act states: "the fair use of a copyrighted work...for purposes such as criticism [or] comment, . . . is not an infringement of copyright." 17 U.S.C. § 107. The Supreme Court has described the purpose of the fair use doctrine as "permit[ting] courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster." Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 577, 114 S.Ct. 1164, 1170 (1994).

1. Analysis of the fair use factors.

Under Section 107 of the Copyright Act, the Court must consider the following factors in determining whether *WDG* makes fair use of *GWTW*: (1) the

purpose and character of the use; (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 on the potential market for or value of the copyrighted work. When each of these factors is considered, it is clear that *WDG* is a fair use of *GWTW*.

(a) The purpose and character of the use

The Supreme Court characterized the "central purpose" of the investigation under this first factor as determining whether the new work is "transformative"; that is, whether it "adds something new, with a further purpose or different character, altering the first [work] with new expression, meaning, or message." Campbell, 510 U.S. at 579, 114 S.Ct. at 1170.

WDG makes just such a transformative use of the skeletal framework of *GWTW*, powerfully creating new information, new aesthetics, new insights and understandings. Moreover, "'parody' has an obvious claim to transformative value." Campbell, 510 U.S. at 579, 114 S.Ct. at 1171.

Campbell itself involved a song called "Ugly Woman" by the rap group 2 Live Crew, which borrowed the tune and some of the words from the song "Pretty Woman," written by Roy Orbison. The Court described the effect as follows:

2 Live Crew juxtaposes the romantic musings of a man whose fantasy comes true, with degrading taunts, a bold demand for sex, and a sigh of relief from parental responsibility. The later words can be taken as a comment on the naiveté of the original of an earlier day [i.e., "Pretty Woman"], as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies.

Id. at 583, 114 S.Ct. at 1173. The Court added that “[w]hether parody is in good taste or bad does not and should not matter for fair use.” Id. at 582, 114 S. Ct. at 1173.³

Campbell makes clear that parody’s status as fair use derives from its elements of commentary and criticism, not from whether it is “comic.” Thus, Plaintiffs’ oversimplified contention that *WDG* is not a parody because it “does not even attempt to achieve comic effect,” Pl.’s Memo. at 24, not only misconstrues the core feature of parody that entitles it to fair use protection, it also reflects the limited perspective of Plaintiff’s lawyers about what is and is not humorous.

In fact, *WDG* is precisely the type of fair use parody the Supreme Court contemplated in Campbell. Every event in *WDG* that echoes an element of *GWTW* does so to make that element appear ridiculous, or to suggest *GWTW*’s limitations, as understood in the new context. See Sitter Decl. ¶ 15. More importantly, the novel’s parody effects a critical commentary on the original work: what aspects of *GWTW* are invoked by *WDG* are ingeniously and ironically reconstituted, as if they had passed through a prism. See Sitter Decl. at ¶ 11.

The character known as Garlic – an analog to Pork in *GWTW* -- is a prime example of how *WDG* ridicules *GWTW*. Rather than being the loyal, obedient slave that Pork was in *GWTW*, the character Garlic, while still a slave, controls his

³ Moreover, the fact that “Ugly Woman” was commercially successful did not affect its status as fair use. Id. at 584, 114 S. Ct. at 1174.

“master” so thoroughly that, when Garlic pulls the strings, the master “dance[s] like a bandy-legged Irish marionette.” *WDG* at 63. While this description may not strike Plaintiff’s distinguished counsel as “even attempting to achieve comic effect,” more diverse audiences will see the scene differently.

Mocking *GWTW*’s portrayal of Gerald O’Hara (Scarlett’s slave-owning father) as deriving his “love of land” from his Irish ancestry, the narrator of *WDG* describes the character Planter (Gerald O’Hara’s analog) as being so influenced by Garlic that he became culturally *African*:

There was always something African about Planter, and Garlic was it. Even Planter’s love of the land had something African in it. Black people are ancestor worshippers. They have the sense of sacred places.

WDG at 63-64. Randall’s depiction of the slave-owning Irishman, Planter, as in fact culturally African ridicules the obsession with racial purity characteristic in certain elements of Southern culture, as exemplified by *GWTW*.

(b) Nature of copyrighted work

Plaintiffs claim that the nature of *GWTW* cuts in their favor simply because it is an expressive work of fiction. Once again, Plaintiff’s analysis is too simple. Plaintiffs have either misread or ignored the Supreme Court’s opinion in Campbell, which states that the fact that the original is a creative work of expression “**is not much help in this case, or ever likely to help much in separating the fair use sheep from the infringing goats in a parody case, since parodies almost invariably copy publicly known, expressive works.**”

Campbell, 510 U.S. at 586, 114 S.Ct. at 1175. See also Leibovitz v. Paramount Pictures Corp., 137 F.3d 109 (2d Cir. 1998). Therefore, the fact that *GWTW* is creative fiction is of no significance to the Court's fair use analysis.

(c) **Amount and substantiality of the portion used**

WDG does not gratuitously copy from *GWTW*. Rather, it carefully selects and artistically recasts those elements of *GWTW* most likely to advance *WDG*'s critical endeavor. Plaintiffs contend that *WDG* incorporates "more material than necessary" from *GWTW*. But Plaintiffs once again ignore Supreme Court authority that makes clear that, even if this contention were true (and even if *WDG* had engaged in *extensive* copying of protectable elements), this third factor would still not cut against a finding of fair use: "When parody takes aim at a particular original work, the parody must be able to 'conjure up' *at least* enough of the original to make the object of its critical wit recognizable." Id. at 588, 114 S.Ct. at 1176 (emphasis added). In so holding, the Supreme Court rejected prior decisions which had suggested that in order to be entitled to the fair use defense, a parody could take no more than an amount sufficient to "conjure up" the original. Id. See also Leibovitz, 137 F.3d at 116 ("Campbell instructs that a parodist's copying of more of an original than is necessary to conjure it up will not necessarily tip the third factor against fair use.").

Such copying can even appropriate the "heart" of plaintiff's work, if necessary, because "the heart is also what most readily conjures up the [original] for parody, and it is the heart at which parody takes aim," Campbell, 510 U.S. at

588, 114 S.Ct. at 1176. Even if *WDG* invoked the “heart” of *GWTW*, the fact that it then quickly and vividly flies off on tangents never conceived – or conceivable – in the original work, cuts sharply in favor of fair use. If *WDG* were found to have copied any protectable expression from *GWTW*, such use was not excessive in relation to Ms. Randall’s parodic purpose, and was therefore fair.

(d) The effect on the market for or value of the original

The Supreme Court has held that “[a] parody and the original [upon which it is based] usually serve different market functions[,]” and that, as a result, “it is more likely that the new work will not affect the market for the original in a way cognizable under [the fourth] factor[.]” Campbell, 510 U.S. at 591, 114 S. Ct. at 1179 (citations omitted). In particular, the Supreme Court recognized that, although parodies may “kill” demand for the original, just as “a scathing theatre review kills demand,” Id. at 592, 114 S. Ct. at 1178, the market harm to the original work is not “cognizable under the Copyright Act,” Id. at 591-92, 114 S. Ct. at 1178:

There is no protectable market for criticism. The market for potential derivative uses includes only those that creators of original work would in general develop or license others to develop.

Id. at 591, 114 S. Ct. at 1178 (emphasis added).

Here, it is impossible to conceive of Plaintiffs’ licensing a stinging critique of *GWTW* such as *WDG*. And even if it were possible to imagine such a thing,

Campbell makes clear that Plaintiffs have no right under the Copyright Act to monopolize the market for critical transformations of *GWTW* for the purpose of censoring out viewpoints with which they disagree.⁴

Plaintiffs fail to mention to the Court that the market is already saturated with parodies of *GWTW* including three apparently unlicensed books that present themselves as sequels. See Renaud Aff. The plaintiff's argument that, if *WDG* is published, then "anyone could tell the story of *GWTW* from another point of view or create sequels or prequels populated by the Mitchell characters" is belied by the scores of parodies and the two direct spoofs that have already been published without this effect. Id.

(e) Conclusion: *WDG* is fair use

In sum, consideration of the statutory fair use factors compels a finding of fair use in this case. Defendants win under the first fair use factor because *WDG* is a transformative use and a parody of *GWTW*. The second factor is, at most, neutral, because "parodies almost invariably copy publicly known, expressive works." Id. at 586, 114 S. Ct. at 1175. As for the third factor, while some of the elements of *GWTW* are used to "conjure up" that work for the purposes of criticism and comment, copying of this sort is not only permissible but necessary. And finally, under the fourth factor, the harm Plaintiffs truly fear -- that they will not be able to control the impact of works critical of *GWTW* -- is not protectable by

⁴ Plaintiffs in their papers have touted the strict requirements and editorial control they have consistently imposed in licensing derivative works. Pl.'s Memo. at 27. Plaintiffs freely admit that it has been -- and will continue to be -- their practice to retain the right to censor and approve any derivative works based on *GWTW*.

copyright. Given the flood of parodies of *GWTW* already in the market, it is far too late for Plaintiff to assert irreparable harm from Defendant's work.

II. NEITHER A TEMPORARY RESTRAINING ORDER NOR A PRELIMINARY INJUNCTION IS APPROPRIATE UNDER THESE CIRCUMSTANCES.

A. Plaintiffs Have Failed To Demonstrate Their Entitlement to a Either a Temporary Restraining Order or a Preliminary Injunction.

Preliminary injunctive relief is "a drastic remedy." Snook v. Trust Co. of Georgia Bank of Savannah, N.A., 909 F.2d 480, 483 n.3 (11th Cir. 1990). In order to obtain such relief, Plaintiff must "clearly carry the burden of persuasion" on each of the following four factors:

1. Plaintiff must show a substantial likelihood of prevailing on the merits;
2. Plaintiff must show that it will suffer irreparable harm if an injunction does not issue;
3. Plaintiff must prove that its threatened injury outweighs the harm that would result to defendant from an injunction; and
4. "The injunction must not disserve the public interest."

Swatch Watch, S.A. v. Taxor, Inc., 785 F.2d 956, 958-59 (11th Cir. 1986); Snook, 909 F.2d at 483 n.3 (11th Cir. 1990).

Notably, the Snook court observed that the Eleventh Circuit is not among those circuits applying the "alternative test" in which injunctive relief is justified upon a showing of either probable success on the merits and possible irreparable injury, or "sufficiently serious questions going to the merits to make them a fair

ground of litigation” coupled with a balance of hardships tipping decidedly toward plaintiff. 909 F.2d at 483.

B. As Argued Above, Plaintiffs Have Not Established a Substantial Likelihood of Success on the Merits of Either Their Copyright Claims or Their Lanham Act Claims.

Here, as demonstrated supra, Plaintiff have clearly failed to establish a substantial likelihood of success. At most, they have raised “sufficiently serious questions going to the merits to make them fair ground of litigation.” Their attempt to justify their request for the extraordinary relief they seek⁵ focuses almost entirely on the harm they claim they will suffer if Defendant’s book is published (e.g., harm to the future commercial success of yet-to-be-created sequels of *GWTW*.) The Snook decision makes clear, however, that such a showing is not enough in the Eleventh Circuit to obtain a preliminary injunction or TRO.

C. Defendant would suffer irreparable harm from even a temporary curtailment of their freedom to publish.

There is considerable evidence that Defendant will suffer irreparable and lasting harm if this Court enjoins publication of *WDG*. *Strothman Aff.* at ¶ 2. As described in the Statement of Facts, supra, Defendant relies heavily on the publication of important literary works to enhance the overall reputation and goodwill of the company as a whole. Id. at ¶ 5. Disruption of the long-planned

⁵ Plaintiffs ask this Court to halt in its tracks the publication process of *WDG*. See Pl.’s Proposed Temp. Restr. Order at 2, which asks this Court to restrain and enjoin Houghton-Mifflin from the “manufacture, publication, display, distribution, advertising of, sale or offer for sale of” *WDG*.

publication date for *WDG* (currently set for June 6, 2001) would substantially disrupt and cause lasting harm to Defendant's business. Id. at 9.

The case of Belushi v. Woodward, 598 F. Supp. 36 (D.D.C. 1984) is instructive. That case involved a photographer whose copyrighted photograph had been included without permission in Bob Woodward's biography of John Belushi. The court held that plaintiff was not entitled to an injunction even though she had demonstrated a substantial likelihood of success because she had not shown the inadequacy of a legal remedy. The court observed that irreparable injury is normally presumed in a copyright case once plaintiff demonstrates a substantial likelihood of success. "Even under such a diminished burden, plaintiff must demonstrate that equitable relief is warranted." Id. at 37.

The court went on to note the substantial harm defendant would suffer from plaintiff's requested relief were granted:⁶ "their carefully orchestrated and costly plans for selling and marketing the book will be disrupted, costing them a substantial amount in lost sales. Defendants emphasize that successful marketing of a book like *Wired* depends upon the coordination of advertising, serialization, author appearances, and reviews, and the release to the public of the book." Id. at 37.

⁶ Defendant had already distributed 145,000 copies of the book to bookstores nationwide. 30,000 copies remained in Defendant's possession. These 30,000 copies were the object of plaintiff's TRO request. Id. at 37.

D. The presumption of irreparable harm to Plaintiff is rebutted in this case.

While the irreparable harm element is often presumed in intellectual property infringement case, Plaintiffs here, like the plaintiff in Belushi, cannot dispute the adequacy of a legal remedy. In the event Defendant's work were ultimately found to infringe *GWTW*, any impact to Plaintiffs could be quantified in terms of lost sales, including future sales, of *GWTW* and related works, and testimony about the value of a licensed slave narrative.

E. The public interest cuts strongly in favor of not issuing a temporary or preliminary injunction.

Injunctions are not favored in fair use cases. As the Supreme Court said, while an injunction is justified in cases of "simple piracy, such cases are 'worlds apart from many 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.'" Campbell 510 U.S. 569 at 578 n. 10, 114 S.Ct. at 1170, n.10.

Plaintiffs rely heavily on Showcase Atlanta, but do not mention to the Court its more recent failure in another attempt to enjoin a fair use of *GWTW*. In Trust Co. Bank v. Putnam Publ. Co., 5 U.S.P.Q.2d 1874 (C.D. Cal. 1988), the court refused to issue a preliminary injunction restraining publication of a novel entitled *The Blue Bicycle*, which Plaintiffs claimed infringed their copyright in *GWTW*. The court observed that "[t]here is a strong public interest favoring the

publication of books and novels; an injunction prohibiting the publication of The Blue Bicycle would not serve that public interest. The public interest in the integrity of copyrights does not in this case outweigh the public interest in free expression.” Id. at 1879, citing Rosemont Enters., Inc. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966) cert. denied, 385 U.S. 1009, 187 S.Ct. 714 (1967); Belushi v. Woodward, 598 F. Supp. at 37-38.

Even less are injunctions favored in prior restraint cases. As the court observed in Religious Tech. Center v. Lerma, 897 F. Supp. 260, 262-63 (E.D. Va. 1995), “if a threat to national security was insufficient to warrant a prior restraint in New York Times v. U.S., the threat to plaintiff’s copyrights and trade secrets is woefully inadequate.” The plaintiff in that case had filed a copyright infringement action and asked for a preliminary injunction against CBS’s reporting on copyrighted materials contained in court files. The court held that an injunction restricting CBS’s right to report on the contents of the materials would constitute “a prior restraint on expression,” and that “there is a strong presumption against the constitutionality of such actions.” Id.

Likewise, in Globe Int’l, Inc. v. Nat. Enquirer, Inc., No. 98-10613 CAS, 1999 WL 727232, at *5 (C.D. Cal., Jan. 25, 1999), the court noted that “the prior restraint analysis has been applied to requests for copyright injunctions, even though Congress has included injunctive relief as a remedy for infringement.” The court quotes at length from Judge Lumbard’s concurring opinion in Rosemont: “The spirit of the First Amendment applies to the copyright laws at

least to the extent that the courts should not tolerate any attempted interference with the public's right to be informed regarding matters of general interest when anyone seeks to use the copyright statute which was designed to protect interests of quite a different nature." Also citing Trust Co. Bank, 5 U.S.P.Q.2d 1874 (the *Blue Bicycle* case).

The Eleventh Circuit as recently as March 22 of this year reminded a district court of the importance of public access to the defendant's written words even though, in that case, they infringed the plaintiff's copyrights. See Greenberg v. Nat'l Geographic Soc'y, No. 00-10510, 2001 WL 280075 at *7 (11th Cir., Mar. 22, 2001) ("In assessing the appropriateness of injunctive relief, we urge the court [on remand] to consider alternatives, such as mandatory license fees, in lieu of foreclosing the public's computer-aided access to this educational and entertaining work.")

If this were a case involving copyright infringement of a carpet design or a piece of software instead of a work protected by the First Amendment⁷; and if the plaintiff had shown a substantial likelihood of prevailing on the merits; and if

⁷ The Belushi court, 598 F. Supp. 36, also took note of the vital public interest that was at stake in the decision whether to grant a TRO to plaintiff. "[T]here is a competing public interest in this case: the promotion of free expression and robust debate. If this were a case in which relief would enjoin the distribution of an average commercial product, [temporary injunctive] relief would not be so drastic." Id. at 37, citing Rosemont Enterprises, Inc., 366 F.2d at 311, where the Court noted "The normal reluctance to impose a summary restraint in advance of a full and complete trial is particularly acute in a case such as this which deals with the publication of a book." Id. at 311, quoting Estate of Hemingway v. Random House, 49 Misc.2d 726, 728, 268 N.Y.S.2d 531, 534 (N.Y. Sup. Ct. 1966).

there were no comparable harm to the defendant, then the drastic remedy of an injunction might be appropriate. But, this is not such a case – for each of those reasons.

III. PLAINTIFF'S HAVE FAILED TO DEMONSTRATE A LIKELIHOOD OF SUCCESS ON THEIR SECTION 43(a) CLAIM.

Plaintiff's Complaint and TRO brief contain general allegations of unfair competition under Section 43(a) of the Lanham Act without specifying which "marks" Plaintiff contends have been infringed. Plaintiff's Complaint, in one paragraph, claims trademark rights in the "characters, settings, plot lines and other elements of the original novel," Compl. at ¶ 38, and, in another, states that Plaintiff is recognized as the "source of the trademarks in the title, characters and fictional settings of the novel." Compl. at ¶ 1. Plaintiff's TRO brief states that the Mitchell Trusts own "common-law trademark rights in their characters, settings and other elements of 'Gone with the Wind.'" Pls. TRO Br. at 29.

To the extent that its trademark claims are discernible, Plaintiff's allegations must fail for two reasons. First, Plaintiff is improperly attempting to use trademark law to protect aspects of its novel -- settings, plot lines and "other elements" -- that may only be protected under copyright law. Second, even if Plaintiff has sufficiently asserted unfair competition with respect to any protectible marks, the Defendant's use, in the context of its artistic work, is not likely to create confusion.

A. **§ 43(a) Is an Inappropriate Mechanism for Enforcement of Rights in Settings, Plot Lines and "Other Elements" of a Novel.**

The Lanham Act defines a trademark as:

any word, name, symbol, or device, or any combination thereof ...
used by a person ... to identify and distinguish his or her goods,
including a unique product, from those manufactured or sold by
others and to indicate the source of the goods.

15 U.S.C. § 1127. In contrast, the Copyright Act seeks to protect "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102. "A trademark is meant to identify goods so that a customer will not be confused as to their source. A copyright is intended to protect the owner's right in ... [a] creative product." United States v. Giles, 213 F.3d 1247, 1252 (10th Cir. 2000).

Several decisions have dealt with attempts to extend trademark law into copyright territory. In a recent decision, the Second Circuit held "that a musical composition cannot be protected as its own trademark under the Lanham Act." EMI Catalogue Partnership v. Hill, Holliday, Connors, Cosmopolus, Inc., 228 F.3d 56, 64 (2d Cir. 2000). As the court observed, "The ... source identifying function of trademarks requires that a trademark in a musical composition not be coextensive with the music itself." Id. See also Oliveira v. Frito-Lay, Inc., 50 U.S.P.Q.2d 1152, 1155 (S.D.N.Y. 1999) (rejecting plaintiff's attempt to claim trademark right in song "The Girl from Ipanema") ("Protection of a musical work falls under the rubric of copyright, not trademark law"); Galerie Furstenberg v. Coffaro, 697 F. Supp. 1282, 1290 (S.D.N.Y. 1988) (trademark law an inappropriate vehicle for enforcing rights in works of artist Salvador Dali) (plaintiff

“endeavors to enforce what is at best a copyright claim through the mechanism of trademark protection”).

Accordingly, Plaintiff's attempt to use trademark law to protect "settings," "plot lines" and unspecified "elements" of its novel should be rejected. Plaintiff is improperly asking this Court to find that trademarks in "Gone with the Wind" are coextensive with the work itself.

B. Defendant Has Not Used Any of Plaintiff's Marks in a Manner Likely to Cause Confusion.

It is possible, on a narrower basis, to claim trademark protection in titles, as well as in character names or likenesses. In order to succeed on a Section 43(a) claim, however, the plaintiff still must establish that the defendant has used a mark in a manner that is likely to create confusion. See, e.g. Ross Bicycles, Inc. v. Cycles USA, Inc., 765 F.2d 1502 (11th Cir. 1985) ("To prevail on a false designation of origin claim under [§ 43 (a)] a plaintiff must establish that the defendant adopted a mark confusingly similar to the plaintiff's mark such that there was a likelihood of confusion as to the origin of the goods.").⁸

Here, the title, *Gone with the Wind*, creates a mental image of a genteel, aristocratic, **white** South prior to, during and immediately after the Civil War. *The*

⁸ The Eleventh Circuit utilizes a test to determine whether two marks are likely to be confused, incorporating the following seven factors: (1) the type of mark; (2) the similarity of the marks; (3) the similarity of the products; (4) the identity of retail outlets and purchasers; (5) the similarity of the advertising media used; (6) the defendant's intent; and (7) actual confusion. See, e.g., Swatch Watch, S.A. v. Taxor, Inc., 785 F.2d 956 (11th Cir. 1986). Defendant will address certain of these elements in its discussion below.

Wind Done Gone was chosen by a black authoress, as a black idiom, to evoke a novel with a strong black perspective. The two titles are dramatically juxtaposed and conjure up conflicting thought patterns.

The same dramatic juxtaposition is carried throughout the challenged work: the central character of *WDG* is Cynara, a triumphant, multidimensional mulatto who does not remotely resemble the stereotyped Black figures in *GWTW*. The message of the two works could not differ more. In addition, the front cover of *WDG* will carry a prominent and accurate disclaimer; one presently under consideration is “A provocative, literary parody that explodes the mythology perpetrated by a Southern classic.” The first line on the back cover begins, “a brilliant rejoinder and an inspired act of literary invention....”

Because the Defendant's title conjures up a distinctly different image from Plaintiff's title, and because Defendant's reference to Plaintiff's title serves a clearly legitimate expressive purpose, the use of the title *The Wind Done Gone* does not constitute a Section 43(a) violation. With respect to the significant characters in *The Wind Done Gone*, Defendant has not used similar names or portrayals in a fashion that creates a likelihood of confusion under the Lanham Act.

1. Use of *The Wind Done Gone* Title Is Not Confusing and Serves a Legitimate Expressive Purpose.

Even if *WDG* were not a literary work of exceptional merit, there would be no likelihood of confusion. A case in point is Jordache Enterprises, Inc. v. Hogg

Wyld, Ltd., 828 F.2d 1482 (2d Cir. 1987) where the Second Circuit held that the trademark Jordache superimposed over a gold horse's head, for designer jeans, was not confusingly similar to Lardashe beneath a pink pig's head, for jeans for full-figured women. The two marks had different connotations and the Court held that the defendant was entitled to "create a comic **or satiric** contrast to a serious work." 828 F.2d at 1486 (emphasis supplied).

Turning to the significance of *WDG's* literary nature, the court in Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc., 886 F.2d 490 (2d Cir. 1989), reversed a preliminary injunction where the defendant, as one component of a parody, had replicated plaintiff's trademarked cover. The Second Circuit specifically noted that parody, by definition, must convey the message that it is a play on the "original." It went on to note, however, that parody is a protected form of expression under the First Amendment, that "the Lanham Act must be construed narrowly when First Amendment values are involved," and that "somewhat more risk of confusion is to be tolerated when a trademark holder seeks to enjoin artistic expression such as parody." Id. at 495. It held, therefore, that a parody is non-infringing if it "simultaneous[ly conveys the message] that it is not the original and is instead a parody," Id. at 494.

Here, *GWTW* refers to the passing of a supposedly genteel, refined era; *WDG* uses black vernacular to suggest that bad times are gone. The use of the

black vernacular also foreshadows the book's contents: a story alluding to the milieu of *GWTW*, but told from a distinctly black vantage.

The court in Cliff Notes also took notice of the defendant's prominent use of the words "A Satire" on the book's front and back cover. Here, the disclaimer on the front cover and the differentiating language on the back will serve even more to dispel likely confusion. In Cliff Notes, the court concluded that the defendant's book "raise[d] only a slight risk of consumer confusion that is outweighed by the public interest in free expression." Id. at 497. Here, there is no risk of confusion, and the literary merit of defendant's work compelling.

A series of subsequent cases have adopted the Cliffs Notes approach where defendants have created works that invoke a plaintiff's marks for legitimate expressive purposes. See Yankee Publishing, Inc. v. News America Publishing, Inc., 809 F. Supp. 267 (S.D.N.Y. 1992) (finding no infringement where defendant's magazine cover spoofed plaintiff's "Farmer's Almanac" books); Girl Scouts of the United States v. Bantam Doubleday Dell Pub. Group, Inc., 808 F. Supp. 1112 (S.D.N.Y. 1992), aff'd, 996 F.2d 1477 (2d Cir. 1993) (relying on Cliffs Notes and similar authority in upholding defendant's publication of children's book series "Pee Wee Scouts").⁹ A related line of cases has recognized that artists must be entitled to expressive leeway in choosing titles for their works. In Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989), the Second Circuit affirmed the denial of relief where dancer Ginger Rogers sought to enjoin the distribution of a film

⁹ Both Yankee Publishing and Girl Scouts make clear that a defendant's work need not be a parody, per se, to warrant First Amendment protection from trademark claims. According to the Yankee Publishing court, "[P]arody is merely an example of the types of expressive content that are favored in fair use analysis under the copyright law and First Amendment deference under the trademark law." Yankee Publishing, 809 F. Supp. at 279.

entitled "Ginger & Fred," recounting the fictional tale of two Italian dancers who, in their youths, had impersonated Ginger Rogers and Fred Astaire. Rejecting Rogers' Section 43(a) arguments, the court wrote:

The subtleties of a title can enrich a reader's or a viewer's understanding of a work. Consumers of artistic works thus have a dual interest: They have an interest in not being misled and they also have an interest in enjoying the results of the author's freedom of expression. For all these reasons, the expressive element of titles requires more protection than the labeling of ordinary commercial products.

Rogers, 875 F.2d at 998. See also Parks v. LaFace Records, 76 F. Supp.2d 775 (E.D. Mich. 1999) (following Rogers and granting summary judgment for defendant on Section 43(a) claim where defendant distributed album featuring song entitled "Rosa Parks").

Finally reducing any possibility of confusion is the fact that the target audience for Defendant's book is likely to be distinct from the audience for Plaintiff's work and its derivatives. *WDG* seeks to appeal to a demographic that has been stigmatized by the stereotypes within *GWTW*. Moreover, as several cases have noted, likely purchasers of novels are inherently more sophisticated, and are less likely to be confused by minor similarities, than are purchasers of inexpensive consumer goods. See Yankee Publishing, 809 F. Supp. at 275 (magazine purchasers are sophisticated); Girl Scouts, 808 F. Supp. at 1130 ("purchasers of children's books are undoubtedly literate; moreover, undoubtedly they have in mind supplying quality reading material to a 5 or 6 year old").

For the foregoing reasons, Defendant's distribution is highly unlikely to create confusion under Section 43(a) of the Lanham Act, particularly in view of the heightened likelihood of confusion standard that must be satisfied where expressive works are involved.

2. Defendant is Not Making Trademark Use of Any Character Names from Plaintiff's Work.

In certain situations, plaintiffs may use trademark law to protect names and likenesses of fictional characters from inappropriate **trademark use**. Thus, the DC Comics and Toho cases cited in Plaintiff's brief both found liability where a character name was being used in a blatant commercial fashion. See DC Comics, Inc. v. Unlimited Monkey Business, Inc., 598 F. Supp. 110 (N.D. Ga. 1984) (enjoining defendant's provision of singing telegram services using a character named **SUPER STUD in a Superman costume** and a character named **WONDER WENCH in a Wonder Woman costume**); Toho Co. Ltd. v. William Morrow & Co., 33 F. Supp.2d 1206 (C.D. Cal. 1998) (enjoining defendant's unauthorized distribution of a book entitled "Godzilla!" featuring the same logo and typeface used for plaintiff's **GODZILLA** trademark).

In reviewing the character name list supplied at pages 8 and 9 of Plaintiff's memorandum, it is clear that the vast majority of the character names in Defendant's work are not similar to the names used in *GWTW*. To the extent that several names are similar, the use of these names is buried within the pages of

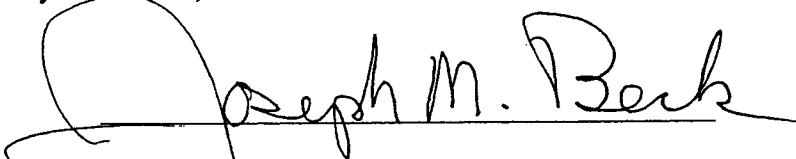
WDG and they are not used in a trademark fashion. See Walt Disney Productions v. Air Pirates, 581 F.2d 751 (9th Cir. 1978) (reversing grant of summary judgment for Walt Disney's claim of trademark infringement where defendant's use of Disney's marks and characters "appeared only in the middle of their comic books").

Moreover, where there are discernible differences in character names, plaintiff's cases yield to parody interests. For example, in Toho Co. Ltd v. Sears, Roebuck & Co., 645 F.2d 788 (9th Cir. 1981) defendant's use of "Bagzilla," for "monstrously strong garbage bags," was deemed noninfringing. Under no circumstances, therefore, can Plaintiff prevail against Other, Dreamy Gentleman, Mealy Mouth, Debt Chauffeur and the other distinctive characters in Defendant's work. Plaintiff's Section 43(a) allegations with respect to the alleged use of characters must fail.

CONCLUSION

For the foregoing reasons, Defendant respectfully requests that the Court deny Plaintiffs' motion for temporary restraining order and a preliminary injunction, and allow Defendant to publish this important novel.

Respectfully submitted this 28th day of March, 2001.

A handwritten signature in black ink that reads "Joseph M. Beck". The signature is written in a cursive style with a large, looping initial "J".

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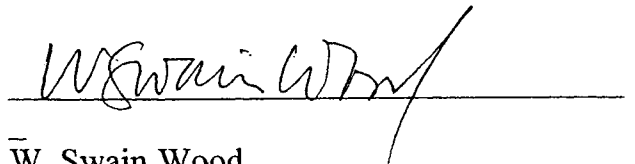
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **Defendant Houghton-Mifflin Co.'s Response In Opposition To Plaintiff's Motion For A Temporary Restraining Order And Preliminary Injunction** has been hand-delivered to counsel of record as follows:

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This 28th day of March, 2001.



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