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980960-023001

May 31, 2001

VIA HAND DELIVERY

Thomas K. Kahn, Clerk  
Eleventh Circuit Court of Appeals  
56 Forsyth Street, N. W.  
Atlanta, Georgia 30303

Re: 01-12200: SunTrust Bank v. Houghton Mifflin

Dear Mr. Kahn:

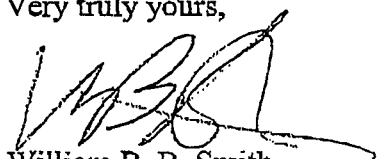
Today we have filed "Plaintiff-Appellee's Emergency Petition for Rehearing and Rehearing En Banc" in the above-referenced matter.

On May 25, 2001, the panel in the above matter issued its decision to vacate a preliminary injunction previously entered by the District Court that enjoined distribution of the Defendant's fictional work based on Plaintiff-Appellee's copyright infringement claim in order to maintain the status quo pending a decision on the merits. Immediately following the panel decision, the Defendant publicly announced its intention to have the work available for purchase in stores by as early as June 7.

In light of the immediacy of the issues raised by Plaintiff-Appellee's Emergency Petition, we respectfully request that same be circulated to the entire Court for consideration as quickly as possible.

With thanks, and with best wishes, I remain

Very truly yours,

  
William B. B. Smith

cc: Joseph M. Beck, Esq.  
AT:114048001

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**IN THE UNITED STATES COURT OF APPEALS  
FOR THE ELEVENTH CIRCUIT**

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**CASE NO. 01-122-00-HH**

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SUNTRUST BANK as Trustee of the Stephens  
Mitchell Trusts, f/b/o Eugene Muse Mitchell  
and Joseph Reynolds Mitchell,

Plaintiff-Appellee,

v.

HOUGHTON MIFFLIN COMPANY,

Defendant-Appellant.

---

On Appeal from the United States District Court  
for the Northern District of Georgia

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**PLAINTIFF-APPELLEE'S EMERGENCY PETITION FOR  
REHEARING AND REHEARING *EN BANC***

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Edward H. Rosenthal, Esq.  
Thomas D. Selz, Esq.

Attorneys for Plaintiff-Appellee

---

***SunTrust v. Houghton Mifflin, No. 01-122-00-HH***

CM Finance, L.L.C., affiliate of Appellee

CMC Oreo Inc., affiliate of Appellee

Computer Adaptive Technologies, Inc., affiliate of Appellant

Crestar Capital Trust I, affiliate of Appellee

Crestar Securitization, L.L.C., affiliate of Appellee

Crestar SP Corporation, affiliate of Appellee

Crestview, L.L.C., affiliate of Appellee

DC Properties, Inc., affiliate of Appellee

Florida Aviation, Inc., affiliate of Appellee

Frankfurt Garbus Kurnit Klein & Selz, P.C., law firm for Appellee

Martin Garbus, Esq., counsel for Appellee

Great Source Education Group, Inc., affiliate of Appellant

HMI Holdings, Inc., affiliate of Appellant

Houghton Mifflin Canada Limited, affiliate of Appellant

Houghton Mifflin Foreign Sales Corporation, affiliate of Appellant

Houghton Mifflin Company, Appellant

Houghton Mifflin Company International, Inc., affiliate of Appellant

Houghton Mifflin International, Inc., affiliate of Appellant

***SunTrust v. Houghton Mifflin, No. 01-122-00-HH***

Jefferson Funding Corporation I, affiliate of Appellee

Anne M. Johnson, Esq., counsel for Appellee

Jones, Day, Reavis & Pogue, law firm for Appellee

Kasalta Miramar, Inc, affiliate of Appellee

Kilpatrick Stockton LLP, law firm for Appellant

Richard Kurnit, Esq., counsel for Appellee

Madison Insurance Company, affiliate of Appellee

McDougal Littell, Inc., affiliate of Appellant

MD Properties, Inc., affiliate of Appellee

Eugene Muse Mitchell, beneficiary of Appellee

Joseph Reynolds Mitchell, beneficiary of Appellee

Ralph R. Morrison, Esq., counsel for Appellee

On-Line Learning, Inc., affiliate of Appellant

Palladian Mortgage, L.L.C., affiliate of Appellee

The Honorable Charles A. Pannell, Jr., United States District Court Judge

Partnership Mortgage, L.L.C., affiliate of Appellee

Premium Assignment Corporation, affiliate of Appellee

Alice Randall, author of *The Wind Done Gone*

***SunTrust v. Houghton Mifflin, No. 01-122-00-HH***

Regency Constructors, Inc, affiliate of Appellee.

Regency Development Associates, Inc., affiliate of Appellee

The Riverside Publishing Company, affiliate of Appellant

Edward H. Rosenthal, Esq., counsel for Appellee

Thomas D. Selz, Esq., counsel for Appellee

Sentry Realty Corporation, affiliate of Appellant

Service of Volusia County, Inc., affiliate of Appellee

William B. B. Smith, Esq., counsel for Appellee

Southern Service Corporation, affiliate of Appellee

STB FNC Corporation, affiliate of Appellee

STB Management Corporation, affiliate of Appellee

STB Real Estate (Atlanta), Inc., affiliate of Appellee

STB Real Estate (Augusta), Inc., affiliate of Appellee

STB Real Estate (Central Florida), STB Real Estate (East Central Florida), Inc.,  
affiliate of Appellee

STB Real Estate (Gulf Coast), Inc., affiliate of Appellee

STB Real Estate (Miami), Inc., affiliate of Appellee

STB Real Estate (Middle Georgia), Inc., affiliate of Appellee

***SunTrust v. Houghton Mifflin, No. 01-122-00-HH***

STB Real Estate (Mid-Florida), Inc., affiliate of Appellee

STB Real Estate (Nature Coast), Inc., affiliate of Appellee

STB Real Estate (North Central Florida), Inc., affiliate of Appellee

STB Real Estate (North Florida), Inc., affiliate of Appellee

STB Real Estate (Northeast Georgia), Inc., affiliate of Appellee

STB Real Estate (Northwest Florida), Inc., affiliate of Appellee

STB Real Estate (Northwest Georgia), Inc., affiliate of Appellee

STB Real Estate (Savannah), Inc., affiliate of Appellee

STB Real Estate (South Florida), Inc., affiliate of Appellee

STB Real Estate (South Georgia), Inc., affiliate of Appellee

STB Real Estate (Southeast Georgia), Inc., affiliate of Appellee

STB Real Estate (Southwest Florida), Inc., affiliate of Appellee

STB Real Estate (Tampa Bay), Inc., affiliate of Appellee

STB Real Estate (West Georgia), Inc., affiliate of Appellee

STB Real Estate Holdings (Atlanta), Inc., affiliate of Appellee

STB Real Estate Holdings (Augusta), Inc., affiliate of Appellee

STB Real Estate Holdings (Central Florida), Inc., affiliate of Appellee

STB Real Estate Holdings (East Central Florida), Inc., affiliate of Appellee

***SunTrust v. Houghton Mifflin, No. 01-122-00-HH***

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STB Real Estate Holdings (Southeast Georgia), Inc., affiliate of Appellee

STB Real Estate Holdings (Southwest Florida), Inc., affiliate of Appellee

STB Real Estate Holdings (Tampa Bay), Inc., affiliate of Appellee

STB Real Estate Holdings (West Georgia), Inc., affiliate of Appellee

STB Real Estate Investment Corporation, affiliate of Appellee

***SunTrust v. Houghton Mifflin, No. 01-122-00-HH***

STB Real Estate Parent (Atlanta), Inc., affiliate of Appellee

STB Real Estate Parent (Augusta), Inc., affiliate of Appellee

STB Real Estate Parent (Central Florida), Inc., affiliate of Appellee

STB Real Estate Parent (East Central Florida), Inc., affiliate of Appellee

STB Real Estate Parent (Gulf Coast), Inc., affiliate of Appellee

STB Real Estate Parent (Miami), Inc., affiliate of Appellee

STB Real Estate Parent (Middle Georgia), Inc., affiliate of Appellee

STB Real Estate Parent (Mid-Florida), Inc., affiliate of Appellee

STB Real Estate Parent (Nature Coast), Inc., affiliate of Appellee

STB Real Estate Parent (North Central Florida), Inc., affiliate of Appellee

STB Real Estate Parent (North Florida), Inc., affiliate of Appellee

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STB Real Estate Parent (Northwest Florida), Inc., affiliate of Appellee

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STB Real Estate Parent (South Florida), Inc., affiliate of Appellee

STB Real Estate Parent (South Georgia), Inc., affiliate of Appellee

STB Real Estate Parent (Southeast Georgia), Inc., affiliate of Appellee

***SunTrust v. Houghton Mifflin, No. 01-122-00-HH***

STB Real Estate Parent (Southwest Florida), Inc., affiliate of Appellee

STB Real Estate Parent (Tampa Bay), Inc., affiliate of Appellee

STB Real Estate Parent (West Georgia), Inc., affiliate of Appellee

STB Real Estate Parent Mid-Atlantic, affiliate of Appellee

STB Receivables (Central Florida), Inc., affiliate of Appellee

STB STR, affiliate of Appellee

STI Credit Corporation, affiliate of Appellee

STI Investment Management (Collateral), Inc., affiliate of Appellee

STI Investment Management, Inc., affiliate of Appellee

SunTrust Annuities (Alabama), Inc., affiliate of Appellee

SunTrust Asia, Limited, affiliate of Appellee

SunTrust Bank, Appellee

SunTrust Bank, as Trustee to The Stephens Mitchell Trusts f/b/o Eugene Muse

Mitchell and Joseph Reynolds Mitchell, Appellee

SunTrust Bank Holding Company, affiliate of Appellee

SunTrust BankCard, National Association, affiliate of Appellee

SunTrust Banks, Inc., parent of Appellee

SunTrust Banks Trust Company (Cayman) Ltd., affiliate of Appellee

***SunTrust v. Houghton Mifflin, No. 01-122-00-HH***

SunTrust Benefits Management, Inc., affiliate of Appellee

SunTrust Capital I, affiliate of Appellee

SunTrust Capital II, affiliate of Appellee

SunTrust Capital III, affiliate of Appellee

SunTrust Community Development, affiliate of Appellee

SunTrust Community Development Corporation, MidAtlantic, affiliate of  
Appellee

SunTrust Delaware Trust Company, affiliate of Appellee

SunTrust Education Financial Services Corporation, affiliate of Appellee

SunTrust Equitable Securities Corporation, affiliate of Appellee

SunTrust Equitable Securities Corporation of Delaware, Inc., affiliate of Appellee

SunTrust Insurance Company, affiliate of Appellee

SunTrust Insurance Services (Virginia), Inc., affiliate of Appellee

SunTrust Insurance Services, Inc., affiliate of Appellee

SunTrust International Banking Company, affiliate of Appellee

SunTrust Leasing Corporation, affiliate of Appellee

SunTrust Mortgage, Inc., affiliate of Appellee

SunTrust Personal Loans, Inc., affiliate of Appellee

***SunTrust v. Houghton Mifflin, No. 01-122-00-HH***

SunTrust Plaza Associates, L.L.C., affiliate of Appellee

SunTrust Procurement Services, L.L.C., affiliate of Appellee

SunTrust Properties, Inc., affiliate of Appellee

SunTrust Real Estate Corporation, affiliate of Appellee

SunTrust Real Estate Investment Corporation, affiliate of Appellee

SunTrust Securities, Inc., affiliate of Appellee

SunTrust Student Loan, L.L.C., affiliate of Appellee

SunTrust Vehicle Leasing, Inc., affiliate of Appellee

Jerre B. Swann, counsel for Appellant

TCB Holdings, Inc., affiliate of Appellee

Ticknor & Fields, Inc., affiliate of Appellant

Trusco Capital Management, Inc., affiliate of Appellee

Trust Company of Tennessee (inactive), affiliate of Appellee

Universal Capital Mortgage, L.L.C., affiliate of Appellee

VA Properties, Inc., affiliate of Appellee

ValuTree Lender Management, L.L.C., affiliate of Appellee

ValuTree Real Estate Services, L.L.C., affiliate of Appellee

Winward Mortgage, L.L.C. (Tampa), affiliate of Appellee

***SunTrust v. Houghton Mifflin, No. 01-122-00-HH***

Winward Mortgage of Georgia, L.L.C., affiliate of Appellee

Maura J. Wogan, Esq., counsel for Appellee

W. Swain Wood, Esq., counsel for Appellant

  
An Attorney for Appellee

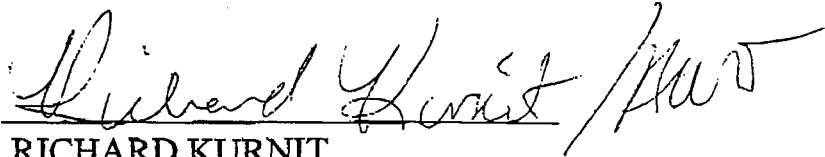
## STATEMENT OF COUNSEL

I express a belief, based on a reasoned and studied professional judgment, that the Panel decision is contrary to the following decisions of the Supreme Court of the United States and the precedents of this Circuit and that consideration by the full court is necessary to secure and maintain uniformity of decisions in this court: U.S. Supreme Court: *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 591 (1994). Eleventh Circuit: *In re Capital Cities/ABC*, 918 F.2d 140 (11th Cir. 1990); *Cable/Home Communication Corp. v. Network Prods., Inc.*, 902 F.2d 829 (11th Cir. 1990); *Pacific and Southern Co., Inc. v. Duncan*, 744 F.2d 1490 (11th Cir. 1984).

I express a belief, based on a reasoned and studied professional judgment, that this appeal involves questions of exceptional importance:

1. Whether an injunction against “unabated piracy” of a work of fiction is a “prior restraint” prohibited by the First Amendment.
2. Whether strictly applying the specific directions of the Supreme Court and issuing a preliminary injunction against “unabated piracy” of a copyrighted work that was not justified as “fair use” is an abuse of discretion.

3. Whether the Panel's order vacating the preliminary injunction and permitting dissemination of unabated piracy of a work of fiction causes irreparable harm to Plaintiff.



RICHARD KURNIT

Attorney of Record for Plaintiff-Appellee

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## INTRODUCTION

The Panel vacated the District Court's preliminary injunction from the bench without reason or explanation. Irreparable harm will result from Defendant's widespread dissemination of an unauthorized sequel. If this Court does not immediately hear this case and vacate the Panel decision, Plaintiff's right to the only real remedy will be irretrievably lost.

The Panel's decision that an injunction against copyright infringement constitutes a "prior restraint" in violation of the First Amendment is a "precedent-setting error of extraordinary importance." 11th Cir. R. 35-7. Simply put, an injunction to prevent copyright infringement is not a prior restraint, particularly in the context of works of fiction. The Panel's decision is in direct conflict with precedent set by the Supreme Court, the Eleventh Circuit and other Circuit Courts, as well as the copyright scheme mandated by the Constitution and enacted by Congress.<sup>1</sup>

In *Cable News Network, Inc. v. Video Monitoring Services of America, Inc.*, 949 F.2d 378 (11th Cir. 1991), this Court recognized the propriety and necessity of a preliminary injunction to halt copyright infringement, by deciding to rehear *en banc* a panel's unprecedented reversal of just such a preliminary injunction.

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<sup>1</sup> Defendant's counsel has publicly declared that the Panel's application of "prior restraint" to fiction is "new law." Boston Globe, May 26, 2001.

*CNN*, 940 F.2d 1471 (11th Cir.), *vacated, reh'g en banc granted*, 949 F.2d 378 (11th Cir. 1991), *appeal dismissed*, 959 F.2d 188 (11th Cir. 1992). The court *en banc* must again speak in unison and affirm the law of the Circuit and the Supreme Court which has definitively held that copyrighted material cannot be licensed by judicial fiat of this or any Court.

**STATEMENT OF THE ISSUES**  
**MERITING EN BANC CONSIDERATION**

1. Whether the explicit holdings of the Supreme Court, the Eleventh Circuit and other Circuit Courts that the issuance of a preliminary injunction to enjoin copyright infringement is not an unconstitutional prior restraint were properly overruled by a Panel containing two judges of this Court?

2. Whether the District Court abused its discretion in granting a preliminary injunction in accordance with the specific instructions of the Supreme Court in *Campbell*?

3. Whether vacating a preliminary injunction and destroying the copyright owner's exclusive right to license derivative works explicitly provided under the Copyright Act will cause immediate and irreparable harm to Plaintiff?

**STATEMENT OF THE COURSE OF PROCEEDINGS**  
**AND DISPOSITION OF THE CASE**

On March 16, 2001, Plaintiff filed a complaint against Defendant in the United States District Court for the Northern District of Georgia alleging that *The*

*Wind Done Gone* violated Plaintiff's copyrights in the novel *Gone With the Wind*, and was a violation of Section 43(a) of the Lanham Act. (R. 1.) On March 23, 2001, Plaintiff filed a motion for a temporary restraining order and preliminary injunction. (R. 5.) Defendant opposed the motion on the ground that *The Wind Done Gone* was a parody of *Gone With the Wind*, and therefore protected by fair use.

On March 29, 2001, the District Court held a hearing on the temporary restraining order. The District Court did not render a decision, but scheduled a hearing on Plaintiff's motion for a preliminary injunction. (R. 14.) Both parties made voluminous submissions to the District Court (R. 20-22, 25-27) and a hearing was held on April 18, 2001. (R. 31.)

On April 20, 2001, the District Court issued a 51-page decision and order finding that *The Wind Done Gone* was unabated piracy and granting Plaintiff's motion for a preliminary injunction and enjoining Defendant: "Pending further order by the court . . . from further production, display, distribution, advertising, sale or offer for sale of the book *The Wind Done Gone*." (R. 35, p. 51; Order.) Defendant appealed the Order on an expedited basis. (R. 39.) On May 25, 2001, at the conclusion of the oral argument on the appeal, a panel including two judges of this Court issued a two page per curiam order vacating the preliminary injunction "forthwith," without remand to the District Court, on the ground that it

“amounts to an unlawful prior restraint in violation of the First Amendment.” (Per Curiam Order, p. 3, a true and correct copy is attached hereto as Exhibit A.) The Panel stated that a comprehensive opinion would follow. *Id.*

### STATEMENT OF FACTS

Plaintiff owns the copyright in the novel *Gone With the Wind* by Margaret Mitchell. (Order, p. 5.) Over the years, Margaret Mitchell and her heirs have chosen to exercise the rights under Section 106(2) of the Copyright Act (Order, p. 5) to authorize derivative works of *Gone With the Wind*, including the Academy Award winning film starring Clark Gable and Vivien Leigh, a sequel book by Alexandra Ripley, and a second sequel book slated to tell the story from Rhett Butler’s perspective. (Order, p. 2.) These and other authorized exploitations of the unique characters and settings of *Gone With the Wind* have been carefully controlled and protected by Plaintiff and have inherent and inestimable value. (R. 5, ¶¶ 6, 8, 9; R. 17, Exh. A, ¶ 9.)

After engaging in its own “independent review and comparison” (Order, p. 9) of the two works, the District Court found that “as a factual matter,” *The Wind Done Gone* “copies” from *Gone With the Wind*. (Order, p. 11.) The District Court concluded that *The Wind Done Gone*:

does not create a new story of the South during Reconstruction. Rather, with the canvas of *Gone With the Wind* as a backdrop, *The Wind Done Gone* repeats the story of *Gone With the Wind*, by

utilizing a detailed encapsulation of the older work and exploiting its copyrighted characters, story lines and settings as the palette for the new story.

(Order, p. 11.)

The District Court found that "*The Wind Done Gone* uses fifteen fictional characters from *Gone With the Wind*, incorporating their physical attributes, mannerisms, and the distinct features that Ms. Mitchell used to describe them, as well as their complex relationships with each other." (Order, p. 10.) The distinct words and phrases that constitute the essence of artistic expression protected by copyright are appropriated. Thus, in *Gone With The Wind* Scarlett O'Hara is described as a "vital" (p. 80), black-haired, green-eyed "belle of five counties" (p. 59), who "was not beautiful, but men seldom realized it . . ." (p. 3); and in *The Wind Done Gone* "Other" is described as having "vitality" (p. 47) and a "raven haired" (p. 14), green-eyed "belle of five counties" (p. 1); who is "not beautiful, but men seldom recognized this" (p. 1). Similarly, the Tarleton twins, who are in no way the subject of any commentary, are described in *Gone With The Wind* as big and red-haired and kicked out of four Southern Universities (p. 4), and killed at Gettysburg (p. 510); and in *The Wind Done Gone* the Twins, B. and S., are described as big and red-haired (p. 51), kicked out of several Southern Universities, and killed at Gettysburg (p. 170).

The District Court also found copying of fictional, not historical, places

such as Tara and Twelve Oaks (Order, p. 14) and held that “[s]ettings, characters, themes, and plot of *The Wind Done Gone* closely mirror those contained in *Gone With the Wind*.” (Order, p. 10.) *The Wind Done Gone* “does not simply make general descriptions that passively call attention to the former work; on the contrary, it repeatedly abridges several pages of the lengthy text of *Gone With the Wind* and merely retells the same scene in a single paragraph.” (Order, p. 14.)

The District Court found that the infringing work “takes fifteen main characters . . . and then tells what happens to them thereafter – a sequel.” (Order p. 27.) In telling where Rhett Butler goes and who he falls in love with upon leaving Tara and Scarlett at the end of *Gone With the Wind*, *The Wind Done Gone* “provided a second sequel” (Order p. 29) which “usurps the original’s right to create its own sequel.” (Order p. 45.) Indeed, as the Court found, the licensed “Second Sequel is expected to tell Rhett’s story. A story that Ms. Randall attempts to tell in *The Wind Done Gone*.” (Order p. 44.) The District Court noted that Defendant first sought to promote and sell *The Wind Done Gone* as a sequel, and rejected Defendant’s post hoc characterization of the work as parody. It found that “the book’s overall purpose is to create a sequel to the older work and provide Ms. Randall’s social commentary on the antebellum South.” (Order, pp. 27, 33.)<sup>2</sup>

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<sup>2</sup> *Gone With the Wind* takes place in the 1860’s and 1870’s and Ms. Randall does not seek to simply criticize the treatment of black Americans in *Gone*

The District Court held that any parodic purpose is “slight in comparison to the extensive copying” (Order p. 45), and found that defendant “makes excessive use of the original work.” (Order p. 50.) The Court also found that publication of the new work would cause irreparable harm to Plaintiff (Order, p. 45-47), and that “failure to enjoin . . . the wide dissemination of the infringing work now would likely prevent the Court from providing adequate relief in the future.” (Order pp. 47-48.)

### ARGUMENT AND AUTHORITIES

#### I. THE PANEL SET AN ERRONEOUS PRECEDENT IN FINDING A COPYRIGHT INJUNCTION TO BE A PRIOR RESTRAINT

##### A. The Panel’s Unprecedented Decision Conflicts with Harper & Row and Eleventh Circuit Precedent

In *Harper & Row*, the Supreme Court definitively held that the protections of the First Amendment are “already embodied in the Copyright Act’s distinction between copyrightable expression and uncopyrightable facts and ideas.” *Harper & Row*, 471 U.S. at 560. Since the Copyright Act does not protect information or ideas, only the artistic expression of those ideas, the idea/expression dichotomy “strikes a definitional balance between the First Amendment and the Copyright

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*With the Wind’s* fictional time, but also “to comment upon the treatment of black Americans in the South in the 1930’s, 1940’s and 1950’s as well as today.” (Order, p. 32.)

Act by permitting free communication of facts while still protecting an author's expression." *Id.*, at 556; accord, *New York Times Co. v. United States*, 403 U.S. 713, 726 n.\* (1971) (Brennan, J., concurring); *id.*, at 731 n.1 (White, J. concurring) ("no one denies that a newspaper can properly be enjoined from publishing the copyrighted works of another"). The preliminary injunction did not restrain any facts, news, or information. It simply enjoined piracy of artistic expression in a work of fiction. The prior restraint doctrine has no place in the world of fiction.

Moreover, the doctrine of fair use represents Congress' balancing of the copyright owner's interest in protecting its artistic expression against the second-comer's interest in expressing its ideas and viewpoint. *Harper & Row*, 471 U.S. at 560 (First Amendment protections are "already embodied in . . . the latitude for scholarship and comment traditionally afforded by fair use . . .").<sup>3</sup> Any ideas or information, comment or criticism may be communicated in any number of ways without appropriating copyrightable material which is not yet in the public domain. *In re Capital Cities/ABC*, 918 F.2d 140, 145 (11th Cir. 1990)

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<sup>3</sup> See also *Eldred v. Reno*, 239 F.3d 372, 376 (D.C. Cir. 2001) (quoting *United Video, Inc. v. FCC*, 890 F.2d 1173, 1191 (D.C. Cir. 1989)) ("the familiar idea/expression dichotomy of copyright law, under which ideas are free but their particular expression can be copyrighted, has always been held to give adequate protection to free expression.").

("[p]etitioner can express the content (i.e., ideas) in another manner which does not infringe the copyright owner's protected manner of expression."); *see also Iowa State Univ. v. American Broadcasting Co., Inc.*, 621 F.2d 57, 61 (2d Cir. 1980) ("the fair use doctrine is not a license for corporate theft, empowering a court to ignore a copyright whenever it determines the underlying work contains material of possible public importance").

It is well-settled law in this Circuit that injunctive relief to prevent copyright infringement is not just constitutional, but entirely appropriate. *See, e.g., Cable/Home Communication Corp. v. Network Prods., Inc.*, 902 F.2d 829, 849 (11th Cir. 1990) (injunction against infringing activity did not infringe First Amendment interests of defendant); *Pacific and Southern Co., Inc. v. Duncan*, 744 F.2d 1490, 1499 (11th Cir. 1984) (reversing District Court's failure to grant injunctive relief); *Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Coop. Prods. Inc.*, 479 F. Supp. 351, 362 (N.D. Ga. 1979) (enjoining prior to opening night a musical production based upon *Gone With the Wind*). In fact, "the Copyright Act clearly contemplates injunctive relief to "prevent infringement" be it in a case of "simple piracy" or one requiring a more complex analysis. *Capital Cities/ABC*, 918 F.2d at 143 (specifically rejecting claim that injunction to prevent copyright infringement is a prior restraint). This Court has correctly, and repeatedly, held that "the [F]irst [A]mendment is not a license to trammel on legally recognized

rights in intellectual property.” *Id.*; *Cable/Home*, 902 F.2d at 849.

Numerous cases in other Circuits conflict with the Panel’s decision, in that they routinely allow injunctions as proper remedies in cases of copyright infringement. *See, e.g., Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997) (affirming injunction where District Court rejected argument of prior restraint); *Salinger v. Random House, Inc.*, 811 F.2d 90, 100 (2d Cir. 1987) (directing District Court to enter preliminary injunction against an infringing book); *Gilliam v. ABC*, 538 F.2d 14 (2d Cir. 1976) (reversing and remanding with directions to issue preliminary injunction); *TY, Inc. v. Publs. Int’l, Ltd.*, 81 F. Supp. 2d 899 (N.D. Ill. 2000) (granting preliminary injunction and noting that “‘obeying copyright laws’ usually includes obeying orders to stop violating the copyright laws”); *Universal City Studios v. Film Ventures Int’l*, 543 F. Supp. 1134 (C.D. Cal. 1982) (granting preliminary injunction to prevent copyright infringement of “Jaws”); *Douglas Int’l Corp. v. Baker*, 335 F. Supp. 282 (S.D.N.Y. 1971) (granting preliminary injunction against a play that infringed plaintiff’s copyrighted book); *Marvin Worth Prod. v. Superior Films Corp.*, 319 F. Supp. 1268 (S.D.N.Y. 1970) (preliminary injunction granted to prevent defendant’s alleged infringement on plaintiff’s copyright).

Prior restraints concern stopping the dissemination of newsworthy information. There is nothing in the District Court’s injunction that restrains

dissemination of facts or criticism of slavery, the antebellum South, or society at large. The Panel wrote new law in holding that the District Court's injunction was a prior restraint, and that precedent must not stand.

B. The Panel Decision Conflicts with *Campbell*

The Supreme Court's unanimous decision in *Campbell* provides explicit instructions to the lower courts in analyzing a claim of fair use parody: "Once enough has been taken to assure identification" of the original work, the Court must step back and consider "how much more is reasonable" depending on "the extent to which the [work's] overriding purpose and character is to parody the original or, in contrast, the likelihood that the parody may serve as a market substitute for the original." *Id.* at 588. The District Court scrupulously followed those instructions.<sup>4</sup> It found that *The Wind Done Gone* copied "characters, story

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<sup>4</sup> The District Court first found under three separate tests of substantial similarity – the "average lay observer" test, the "fragmented literal similarity" test and the "comprehensive nonliteral similarity" test – that *The Wind Done Gone* infringed upon the copyright in *Gone With the Wind*. (Order, p. 17.) With respect to character copying, the District Court held, among other things, that the characters from *Gone With the Wind* were copyrightable, and that "*The Wind Done Gone* uses fifteen fictional characters from *Gone With the Wind*, incorporating their physical attributes, mannerisms, and the distinct features that Ms. Mitchell used to describe them, as well as their complex relationships with each other." *Id.* The Panel decision did not criticize any of these findings. Indeed, this Court has held these characters to be copyrighted creative expression. *Trust Company Bank v. MGM/UA Entertainment Co.*, 772 F.2d 740 (11<sup>th</sup> Cir. 1985).

lines, detailed descriptions of settings . . . constitut[ing] unabated piracy of *Gone With the Wind*" (Order, p. 14), and that its social commentary, to the extent that there was any, was directed at the South generally, not *Gone With the Wind*.

(Order, p. 33.) It then established that "*The Wind Done Gone*'s use of copyrighted material from *Gone With the Wind* goes well beyond that which is necessary to parody it. The use of so much material removes the new work from the safe harbor of parody and, as written, becomes piracy." (Order, p. 41.) Thus, the District Court properly found that "the parodic effect . . . is slight in comparison to the extensive copying," and "that the market harm created by *The Wind Done Gone* is not due to the 'effectiveness of its critical commentary' but rather to its 'market substitution' as a sequel" (Order, p. 45.)

The Panel cavalierly ignored the clear command of the unanimous Supreme Court in *Campbell* that the appropriation of copyrighted expression that is not itself commented upon is not justified as fair use. 510 U.S. at 586-90. The Panel shockingly ignored the unanimous Supreme Court's holding that parody does not encompass comment on society generally. *Id.* at 580-82. There can be no question, as the District Court unequivocally found, that *The Wind Done Gone* is not pure criticism of *Gone With the Wind*. Where, as here, "a work contain[s] both parodic and unparodic elements," the infringing work must be judged by weighing the relevant factors "in light of the ends of copyright law." *Id.* at 581. A work that

is not “parody pure and simple,” but rather has “a more complex character with effects not only in the arena of criticism but also in protectible markets for derivative works” may not be a fair use if there is substantial harm to the original “because the licensing of derivatives is an important economic incentive to the creation of originals.” *Id.* at 592-93.<sup>5</sup> Thus, the Panel’s apparent conclusion that a claim of social commentary is a license for excessive appropriation of copyrighted material is wrong.<sup>6</sup>

The Supreme Court in *Campbell* held that an injunction is proper where there is “piracy,” *id.* at 578 n.10, or where there is a risk that the infringing work will serve “as a substitute for the . . . licensed derivatives.” *Id.*, at 580 n.14. The District Court properly found both piracy (Order, p. 41) and market substitution. (Order, p. 45, p. 50 Findings of Fact No. 9.) It also found that “wide dissemination of the infringing work now would likely prevent the court from providing adequate relief in the future.” (Order, p. 48.) Thus, *Campbell* clearly holds that the District Court acted properly and did not abuse its discretion in

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<sup>5</sup> Any one of the fifteen characters, *e.g.* the Tarleton twins, appropriated without specific comment is entitled to at least as much copyright value as the three note bass riff which the Court in *Campbell* held could be the basis for finding infringement in a parody.

<sup>6</sup> Last week a majority of the Supreme Court reaffirmed its holding in *Harper & Row* that claims of social commentary under the First Amendment cannot overcome congressionally created rights. *Bartnicki v. Vopper*, \_\_\_ U.S. \_\_\_, 2001 U.S. LEXIS 3815, at \*33 (May 21, 2001).

using this preliminary injunction.

II. THE PANEL'S ERROR IS ONE OF EXCEPTIONAL IMPORTANCE

Rather than remanding this case to the District Court with instructions, the Panel vacated the injunction from the bench as a "prior restraint." This decision has repercussions not only for the Plaintiff, now left with no adequate remedy for Defendant's copyright infringement, but also for all copyright owners.

The Supreme Court in *Campbell* noted the grave risk posed to the entire copyright scheme by permitting fair use to invade the rights of copyright holders generally. It stated that the courts are required "to consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also 'whether unrestricted and widespread conduct of the sought engaged in by the defendant . . . would result in a substantially adverse impact on the potential market' for the original." *Campbell*, 510 U.S. at 590.

The District Court found that if this infringing, unauthorized "sequel" were to be unleashed on the marketplace, it would be "difficult, if not impossible" to provide a remedy. (Order, p. 50; Findings of Fact, No. 10.) Now, based on the Panel's characterization of the Order as an unlawful prior restraint, not only the Defendant but any infringer will be free to use the characters, plot and other copyrightable elements of *Gone With the Wind* to tell the same story, or a new one, with only some social commentary.

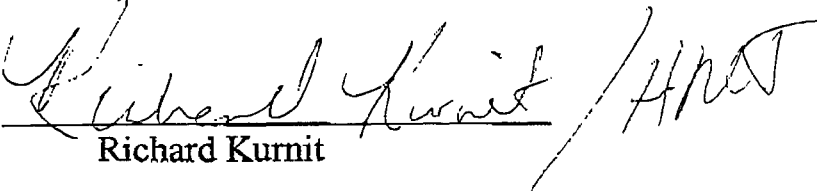
In holding that entry of a preliminary injunction to redress copyright infringement by unauthorized derivative works is unconstitutional, the Panel's decision affects all copyright owners. It guts the derivative rights provision of the Copyright Act and allows second-comers to take as freely from copyrighted works as those in the public domain. Only Congress can shorten the term of copyright or establish a compulsory license scheme. Only Congress can legislate such a dramatic change in the law. *Harper & Row*, 471 U.S. at 569.

### CONCLUSION

Plaintiff respectfully petitions the Panel to reconsider its decision on an emergency basis and for this Court to vacate that decision by setting the case for *en banc* review.

Dated: May 31, 2001

Respectfully submitted,

  
Richard Kurnit

**PUBLISH**

**IN THE UNITED STATES COURT OF APPEALS  
FOR THE ELEVENTH CIRCUIT**

\_\_\_\_\_  
No. 01-12200  
\_\_\_\_\_

D. C. Docket No. 01-00701 CV-CAP-1

**FILED**  
U.S. COURT OF APPEALS  
ELEVENTH CIRCUIT  
**MAY 25 2001**  
THOMAS K. KAHN  
CLERK

SUNTRUST BANK, as Trustee of the  
Stephens Mitchell trusts f.b.o. Eugene  
Muse Mitchell and Joseph Reynolds Mitchell,

Plaintiff-Appellee,

versus

HOUGHTON MIFFLIN COMPANY,

Defendant-Appellant.

\_\_\_\_\_  
Appeal from the United States District Court  
for the Northern District of Georgia  
\_\_\_\_\_

Before BIRCH, MARCUS and WOOD\*, Circuit Judges.

\_\_\_\_\_  
\*Honorable Harlington Wood, Jr., U.S. Circuit Judge for the Seventh Circuit, sitting by  
designation.

## PER CURIAM:

It is manifest that the entry of a preliminary injunction in this copyright case was an abuse of discretion in that it represents an unlawful prior restraint in violation of the First Amendment.

While it falls within the district court's discretion to grant a preliminary injunction, see Mitek Holdings, Inc. v. Arce Eng'g Co., Inc., 189 F.3d 840, 842 (11<sup>th</sup> Cir. 1999), "[t]he district court does not exercise unbridled discretion." Canal Authority of State of Fla. v. Callaway, 489 F.2d 567, 572 (5<sup>th</sup> Cir. 1974); Nnadi v. Richter, 976 F.2d 682, 690 (11<sup>th</sup> Cir. 1992). Plainly, it must exercise that discretion in light of what we have termed the "four prerequisites for the extraordinary relief of preliminary injunction." West Point-Pepperell, Inc. v. Donovan, 689 F.2d 950, 956 (11<sup>th</sup> Cir. 1982) (quoting Canal Authority, 489 F.2d at 572.). The prerequisites are: (1) that there is a substantial likelihood plaintiff will prevail on the merits; (2) that there is a substantial threat plaintiff will suffer irreparable injury if the injunction is not granted; (3) that the threatened injury to the plaintiff outweighs the threatened harm the injunction may do to the defendant; and (4) that granting the preliminary injunction will not disserve the public interest. See Warren Publ'g, Inc. v. Microdos Data Corp., 115 F.3d 1509, 1516 (11<sup>th</sup> Cir. 1997). We add that a preliminary injunction is an extraordinary and drastic remedy that should not be granted unless

the movant clearly carries its burden of persuasion on each of these prerequisites. Canal Authority, 489 F.2d at 573.

After thorough review of the entire record, we have concluded that Appellee Sun Trust has failed to make this critical showing, that the district court abused its discretion by granting a preliminary injunction, and that its ruling amounts to an unlawful prior restraint in violation of the First Amendment. Accordingly, we VACATE forthwith the preliminary injunction of the district court. A comprehensive opinion of the court will follow.

It is so ORDERED this 25<sup>th</sup> day of May, 2001.

CERTIFICATE OF SERVICE

I hereby certify that I have caused two true and correct copies of the Plaintiff-Appellee SunTrust Bank's Emergency Petition for Rehearing and Rehearing En Banc to be served upon the following counsel via hand delivery:

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This 31st day of May, 2001.



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An Attorney for Appellee