

DUPLICATE

Frankfurt Garbus Kurnit Klein & Selz, PC

Attorneys at Law

488 Madison Avenue
New York, New York 10022
Tel: (212) 980-0120
Fax: (212) 593-9175

Richard Kurnit
Direct: (212) 826-5531
e-mail: rkurnit@fgkks.com

May 23, 2001

By Hand

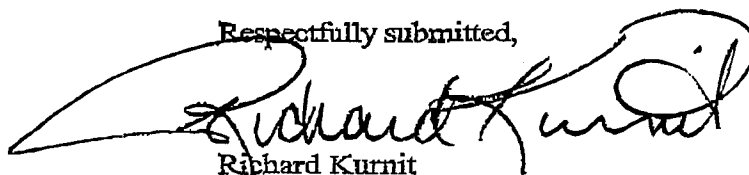
Thomas K. Kahn
Clerk
United States Court of Appeals
for the Eleventh Circuit
56 Forsyth Street, N.W.
Atlanta, Georgia 30303

Re: SunTrust Bank v. Houghton Mifflin Company, Case No. 01-12200

Dear Mr. Kahn:

We represent Plaintiff-Appellee SunTrust Bank as Trustee of the Stephens Mitchell Trusts, f/b/o Eugene Muse Mitchell and Joseph Reynolds Mitchell. Pursuant to the Notice from this Court dated May 17, 2001, we submit the attached four page letter brief directed to the case of *Cable News Network v. Video Monitoring Services*, 940 F.2d 1471 (11th Cir. 1991).

Respectfully submitted,


Richard Kurnit

- cc: Miles J. Alexander, Esq. (by facsimile)
- Leon Friedman, Esq. (by facsimile)
- Peter Canfield, Esq. (by facsimile)
- Gregg Thomas, Esq. (by facsimile)
- Thomas Rubin, Esq. (by facsimile)
- E. Edward Bruce, Esq. (by facsimile)
- Jed Rubenfield, Esq. (by facsimile)
- Hollie Manheimer, Esq. (by facsimile)
- William B.B. Smith, Esq. (by facsimile)

The jurisprudential principle of *Cable News Network v. Video Monitoring Services*, 940 F.2d 1471 (11th Cir. 1991) is that a balance must be struck between the protection of original works under the Copyright Act and the free flow of information under the First Amendment. *CNN*, 940 F.2d at 1478. An overbroad injunction, one which prohibits the dissemination of future, uncopyrighted speech, does not strike that balance properly. *Id.*, at 1479-80.

Here, the District Court properly struck that balance and no modification of the preliminary injunction is warranted. The Order states only that Defendant is enjoined from "further production, display, distribution, advertising, sale, or offer for sale of the book *The Wind Done Gone*," and it thus is limited to the book *The Wind Done Gone*, and that book only. It does not prohibit Defendant from commenting on *Gone With the Wind* in a fashion which does not violate Plaintiff's copyright interests, or from using public domain information or facts about the Civil War, Reconstruction or the evils of slavery.

Defendant Did Not Request a Modification or a "Further Order" from the Court

After refusing to respond to Plaintiff's legitimate copyright concerns,¹

¹ Compare *Salinger v. Random House, Inc.*, 650 F. Supp. 413, 417 (S.D.N.Y. 1986), *rev'd on other grounds*, 811 F.2d 90 (2d Cir. 1987) (after copyright owner objected, biographer drastically reduced amount of taking of copyrighted material).

Defendant decided to press for publication of the book "as is," seeking a change in the law of parody or an unprecedented compulsory license for this type of work. Unlike the defendant in the *CNN* case, Defendant did not communicate with Plaintiff to clarify what it might do within the confines of the preliminary injunction. Defendant did not move to clarify or amend the preliminary injunction in the District Court, *CNN*, 940 F.2d at 1476, and has not asked this Court to modify the preliminary injunction to clarify what it might do. Instead, it has asked this Court for an up or down ruling on the District Court's injunction – affirm it as entered, or enter no injunction at all and allow publication of the book as written.

Moreover, at the preliminary injunction hearing, Defendant asked to substitute the cover of the book, pending a further order from the Court, for one that would not violate the Lanham Act by causing confusion as to its source. (R. 32, pp. 79-80) (Transcript of Hearing on April 18, 2001). Defendant then elected not to proceed in the District Court for such "further order" before filing this appeal.

The Preliminary Injunction Is Not Overbroad

In *CNN*, this Court reversed because it found overbroad an injunction restraining the defendant "from copying or selling copies of any of plaintiff's programming," past, present or future, whether such copying infringed the

plaintiff's copyright or not. *CNN*, 940 F.2d at 1476. Here, the preliminary injunction covers only the book that the District Court reviewed, *The Wind Done Gone*, in its present form. (R. 7, Exh. A) (Durr Aff.). The injunction does not in any way interfere with the publication of future books. Nor does it preclude Defendant from commenting on *Gone With the Wind* in a legally permissible fashion, and indeed, following the entry of the injunction, Defendant and the author have widely published descriptions of *The Wind Done Gone* and criticism and commentary about *Gone With the Wind*. The injunction here is not overbroad and should not be disturbed by this Court.

The District Court Considered and Balanced the First Amendment

As this Court recognized in the *CNN* case, Defendant's First Amendment concerns are subsumed by the doctrine of fair use and were duly considered, balanced and decided by the District Court. In *CNN*, after acknowledging the tension between the First Amendment and the Copyright Act, this Court observed that the codification of the fair use doctrine "reflected the concern of the Congress that the interest of the public be protected; that access to the source of all ideas, the public domain, remain unrestricted." *CNN*, 940 F.2d at 1484. Here, the District Court not only carefully weighed each of the four fair use factors, it also: (a) considered the three factors, other than likelihood of success on the merits,

necessary to issue a preliminary injunction in any situation, to avoid any “automatic” issuance of an injunction in a copyright case; and (b) considered carefully other First Amendment protections, such as the idea/expression dichotomy² (Order, pp. 7, 10-11) and the uncopyrightability of facts (Order, pp. 8, 26-27, 33).

In sum, Defendant has elected to pursue the all-or-nothing strategy of putting *The Wind Done Gone* up for review by this Court without any editing or even a nod to Plaintiff’s copyright interests. Defendant sought this emergency appeal before modifying the cover of the book as promised and without waiting for a “further order” from the District Court to review. Unlike the preliminary injunction in *CNN*, the one here does not violate any legitimate copyright interest or impinge upon the fair use of any material, and Defendant’s First Amendment concerns were fully and fairly considered by the District Court. The order should be affirmed without modification.

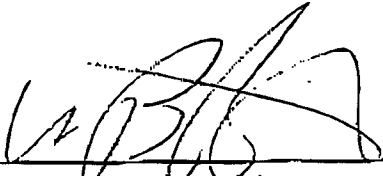
² First Amendment concerns are also protected by the “idea/expression dichotomy,” the concept that copyright law does not protect ideas, only the original expression of those ideas. *CNN*, 940 F.2d at 1478 n.13; *Harper & Row*, 471 U.S. 539, 556 (1985); see Appellee’s Br. at 43-47.

CERTIFICATE OF SERVICE

I hereby certify that I have caused true and correct copies of the foregoing letter brief to be served upon the following counsel by facsimile and United States mail (two copies):

Miles J. Alexander, Esq.
Jerre B. Swann, Esq.
Joseph M. Beck, Esq.
Kilpatrick Stockton LLP
1100 Peachtree Street, Suite 2800
Atlanta, Georgia 30309

This 23^d day of May, 2001.



William B. B. Smith
Jones Day Reavis & Pogue
3500 SunTrust Plaza
303 Peachtree Street, N.E.
Atlanta, Georgia 30308-3242
Telephone (404) 521-3939
Facsimile (404) 581-8330