

[PUBLISH]

IN THE UNITED STATES COURT OF APPEALS

FOR THE ELEVENTH CIRCUIT

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No. 01-12200  
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FILED  
U.S. COURT OF APPEALS  
ELEVENTH CIRCUIT  
OCTOBER 10, 2001  
THOMAS K. KAHN  
CLERK

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

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

Plaintiff-Appellee,

versus

HOUGHTON MIFFLIN COMPANY,

Defendant-Appellant.

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

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**(October 10, 2001)**

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

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

BIRCH, Circuit Judge:

In this opinion, we decide whether publication of *The Wind Done Gone* (“TWDG”), a fictional work admittedly based on Margaret Mitchell’s *Gone With the Wind* (“GWTW”), should be enjoined from publication based on alleged copyright violations. The district court granted a preliminary injunction against publication of TWDG because it found that Plaintiff-Appellee SunTrust Bank (“SunTrust”) met the four-part test governing preliminary injunctions. We VACATE the injunction and REMAND for consideration of the remaining claims.

## I. BACKGROUND

### A. Procedural History

SunTrust is the trustee of the Mitchell Trust, which holds the copyright in GWTW. Since its publication in 1936, GWTW has become one of the best-selling books in the world, second in sales only to the Bible. The Mitchell Trust has actively managed the copyright, authorizing derivative works and a variety of commercial items. It has entered into a contract authorizing, under specified conditions, a second sequel to GWTW to be published by St. Martin’s Press. The

Mitchell Trust maintains the copyright in all of the derivative works as well. See 17 U.S.C. § 103.<sup>1</sup>

Alice Randall, the author of TWDG, persuasively claims that her novel is a critique of GWTW's depiction of slavery and the Civil-War era American South. To this end, she appropriated the characters, plot and major scenes from GWTW into the first half of TWDG. According to SunTrust, TWDG “(1) explicitly refers to [GWTW] in its foreword; (2) copies core characters, character traits, and relationships from [GWTW]; (3) copies and summarizes famous scenes and other elements of the plot from [GWTW]; and (4) copies verbatim dialogues and descriptions from [GWTW].” SunTrust Bank v. Houghton Mifflin Co., 136 F. Supp. 2d 1357, 1364 (N.D.Ga. 2001), vacated, 252 F.3d 1165 (11th Cir. 2001). Defendant-Appellant Houghton Mifflin, the publisher of TWDG, does not contest the first three allegations,<sup>2</sup> but nonetheless argues that there is no substantial similarity between the two works or, in the alternative, that the doctrine of fair use protects TWDG because it is primarily a parody of GWTW.

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<sup>1</sup>Hereafter, the Copyright Act of 1976 shall be referred to by only the section number of the Act.

<sup>2</sup>Houghton Mifflin denies that there are passages from GWTW copied verbatim in TWDG.

After discovering the similarities between the books, SunTrust asked Houghton Mifflin to refrain from publication or distribution of TWDG, but Houghton Mifflin refused the request. Subsequently, SunTrust filed an action alleging copyright infringement, violation of the Lanham Act, and deceptive trade practices, and immediately filed a motion for a temporary restraining order and a preliminary injunction.

After a hearing, the district court granted the motion, preliminarily enjoining Houghton Mifflin from “further production, display, distribution, advertising, sale, or offer for sale of” TWDG. SunTrust Bank, 136 F. Supp. 2d at 1386. In a thorough opinion, the court found that “the defendant’s publication and sale of [TWDG would] infringe the plaintiff’s copyright interests as protected under the copyright laws.” Id. Houghton Mifflin appealed. At oral argument, we issued an order vacating the injunction on the grounds that it was an unconstitutional prior restraint. SunTrust Bank v. Houghton Mifflin Co., 252 F. 3d 1165 (11th Cir. 2001). We now vacate that order and issue this more comprehensive opinion.

B. Standard of Review

“We review the district court’s grant of a preliminary injunction for abuse of discretion.” Warren Pub., Inc. v. Microdos Data Corp., 115 F.3d 1509, 1516 (11th Cir. 1997) (en banc). We review decisions of law *de novo* and findings of fact for

clear error. Mitek Holdings, Inc. v. Arce Eng'g Co., Inc., 89 F.3d 1548, 1554 (11th Cir. 1996).

## II. DISCUSSION

Our primary focus at this stage of the case is on the appropriateness of the injunctive relief granted by the district court. In our analysis, we must evaluate the merits of SunTrust's copyright infringement claim, including Houghton Mifflin's affirmative defense of fair use.<sup>3</sup> As we assess the fair-use defense, we examine to what extent a critic may use a work to communicate her criticism of the work without infringing the copyright in that work. To approach these issues in the proper framework, we should initially review the history of the Constitution's Copyright Clause and understand its relationship to the First Amendment.

### A. History and Development of the Copyright Clause

The Copyright Clause finds its roots in England, where, in 1710, the Statute of Anne “was designed to destroy the booksellers’ monopoly of the booktrade and

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<sup>3</sup>I believe that fair use should be considered an affirmative *right* under the 1976 Act, rather than merely an affirmative defense, as it is defined in the Act as a use that is not a violation of copyright. See Bateman v. Mneumonics, Inc., 79 F.3d 1532, 1542 n.22 (11th Cir. 1996). However, fair use is commonly referred to an affirmative defense, see Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 590, 114 S. Ct. 1164, 1177 (1994), and, as we are bound by Supreme Court precedent, we will apply it as such. See also David Nimmer, A Riff on Fair Use in the Digital Millennium Copyright Act, 148 U. PA. L. REV. 673, 714 n. 227 (2000) (citing Bateman). Nevertheless, the fact that the fair use right must be procedurally asserted as an affirmative defense does not detract from its constitutional significance as a guarantor to access and use for First Amendment purposes.

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