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The Derivative Work Right: Incentive or Hindrance for New Literature Note

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Note

THE DERIVATIVE WORK RIGHT: INCENTIVE OR HINDRANCE FOR NEW LITERATURE?

SARAH E. ZYBERT

The Copyright Act provides incentives to stimulate the production of artistic work for the good of the general public. These incentives include the exclusive right to prepare derivative works, such as a sequel. This Note argues that in practice, however, the right to prepare derivative works actually stifles creativity. Suntrust Bank v. Houghton Mifflin Company and Salinger v. Colting provide examples of legal challenges to valuable work from new authors who wrote novels based on previously published works. While both novels provided valuable commentary and critique to previous works, existing copyright law only protected one. In 2001, the Eleventh Circuit found in Suntrust Bank v. Houghton Mifflin Company that Alice Randall's novel, The Wind Done Gone, was a parody of Gone with the Wind, and therefore constituted fair use. In contrast, the Second Circuit found in 2010 that Fredrik Colting would not succeed with a fair use defense because his novel 60 Years Later, Coming Through the Rye was a sequel to J.D. Salinger's Catcher in the Rye with satiric elements, rather than a parody.

The existing regime fails to meet its intended goal of promoting the useful arts for the public because works such as 60 Years Later, Coming Through the Rye are prevented from distribution, even when the original author had no intent of preparing any derivative works to benefit the public. This Note proposes two suggestions to improve the system. First, this Note argues that the distinction between parody and satire should be eliminated and both forms of commentary should be given equal protection. Second, this Note argues that the intentions of the copyright owner should be considered in determining the period of time the owner is granted the exclusive right to prepare derivative works and within the fair use analysis.

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SARAH E. ZYBERT*

I. INTRODUCTION

The United States Constitution calls for the promotion of the “Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”¹ For copyright law to successfully achieve this goal, it must maintain the delicate balance between creating incentives for authors to produce new works and giving the public access to these works. This Note examines one of these incentives, the exclusive right to prepare derivative works, and how it stifles creativity to the detriment of the public.

In an attempt to balance the goals of copyright law, the Copyright Act grants authors several exclusive rights, including the right to prepare derivative works.² As a limitation to these rights, the Copyright Act recognizes a fair use defense, which “permits 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.”³ This Note examines two cases where the copyright owner of an original novel brought an infringement action against subsequent writers for attempting to publish unauthorized derivative works and where the subsequent authors raised the fair use defense.⁴ Examining these two cases shows that fair use does not always protect against the stifling of creativity. This Note proposes two independent changes to the current regime that would diminish the problems caused by the derivative work rights: first, the elimination of the distinction between parodies and satires in the courts’ fair use analysis and second, the consideration of the intentions of the copyright owner in determining the length of the derivative work right and whether derivatives

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¹ U.S. CONST. art. I, § 8, cl. 8.

² See 17 U.S.C. § 106 (2006) (enumerating the exclusive rights of copyright owners).

³ *Iowa State Univ. Research Found., Inc. v. Am. Broad. Cos., Inc.*, 621 F.2d 57, 60 (2d Cir. 1980).

⁴ See *Salinger v. Colting*, 607 F.3d 68, 71–72 (2d Cir. 2010); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1259 (11th Cir. 2001) (illustrating two similar legal battles about unauthorized literary sequels).

constitute fair use by the U.S. Copyright Office and the courts.

Part II provides an overview of the United States copyright system, including a discussion of the exclusive right to prepare derivative works, the period of copyright protection, the goals of the copyright system, and tensions within the copyright system. Part III summarizes the district court and court of appeals decisions in *Suntrust Bank v. Houghton Mifflin Co.* and *Salinger v. Colting*, where the court in each case applied the fair use analysis to allegedly infringing derivative works. Part IV explains why the parody/satire dichotomy is problematic and proposes that courts should eliminate the distinction when performing a fair use analysis. Finally, Part V suggests that the U.S. Copyright Office and the courts should consider the intentions of the copyright owner when determining the length of the exclusive right to prepare derivative works and when conducting a fair use analysis.

II. OVERVIEW OF COPYRIGHT

A. *Exclusive Right to Prepare Derivative Works*

Section 106 of the U.S. Copyright Act grants the owner of a copyright the right to do and authorize the “reproduc[tion of] the copyrighted work in copies” and the “prepar[ation of] derivative works.”⁵ The right to prepare derivative works was codified in the Copyright Act of 1976.⁶ American copyright law originally only protected against the literal reproduction of a work.⁷ United States copyright law “traces its source to British censorship laws of the sixteenth century.”⁸ The Statute of Anne prevented publishers from reproducing works without the original author’s consent.⁹ The Statute of Anne strived “to encourage creativity and ensure that the public would have free access to information by putting an end to the continued use of copyright as a device of censorship.”¹⁰ This limited protection against reproduction has gradually expanded in United States copyright law. For example, in 1870, Congress gave authors “the right to dramatize or translate.”¹¹ A derivative work is now broadly defined as:

[A] work based upon one or more preexisting works, such as

⁵ 17 U.S.C. §§ 106(1)–(2) (2006).

⁶ Pub. L. No. 94-553, 90 Stat. 2541, 2546 (codified as amended at 17 U.S.C. § 106(2) (2006)).

⁷ Jed Rubenfeld, *The Freedom of Imagination: Copyright’s Constitutionality*, 112 YALE L.J. 1, 49 (2002).

⁸ ROBERT A. GORMAN, COPYRIGHT LAW 1 (2d ed. 2006).

⁹ See Statute of Anne, 1710, 8 Ann., c. 19 (Eng.) (granting the author the sole right of printing his or her book).

¹⁰ *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1260 (11th Cir. 2001) (internal quotation marks omitted).

¹¹ Rubenfeld, *supra* note 7, at 50 (internal quotation marks omitted).

a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a “derivative work”.¹²

This definition gives copyright owners extensive control over the potential exploitation of their work. In the context of literature, derivative works include sequels.¹³ A sequel recasts, transforms, or adapts a preexisting work.¹⁴ A derivative work right that is overly broad subverts the very goals of copyright.

One argument for the expansion of copyright protection to include the right to prepare derivative works is that the prospective profits from these works are necessary to incentivize the production of the original.¹⁵ This argument is only viable “where the projected economic gain from the original work is less than its production costs, and the additional projected gain from the derivative work is large enough to compensate the author for the costs of producing both works.”¹⁶ Moreover, if the original author chooses not to produce or license derivative works, even if it is economically beneficial to do so, then clearly the derivative work right is not a necessary incentive for the creation of the original work.¹⁷ This point is manifested in J.D. Salinger’s insistence that there should be no derivative works of his famous novel *The Catcher in the Rye*.¹⁸

While it is unclear whether the derivative work right is a necessary economic incentive for authors, it does give original authors a high level of control over the future of the copyrighted work. The right to control potential adaptations of the work may be a crucial incentive for certain authors. For instance, some authors may only write a new book with the assurance that the integrity of the work can be maintained with the right to

¹² 17 U.S.C. § 101 (2006).

¹³ Thomas F. Cotter, *Transformative Use and Cognizable Harm*, 12 VAND. J. ENT. & TECH. L. 701, 750 (2010) (“Sequels generally are derivative works . . .”).

¹⁴ See *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357, 1375 (N.D. Ga. 2001) (relying on a definition of a sequel as a literary work which continues the narrative of a preceding work).

¹⁵ John M. Newman, Note, *Holden Caulfield Grows Up: Salinger v. Colting, The Promotion-of-Progress Requirement, and Market Failure in a Derivative-Works Regime*, 96 IOWA L. REV. 737, 745 (2011).

¹⁶ *Id.*

¹⁷ *Id.* at 745–46.

¹⁸ See *Salinger v. Colting*, 607 F.3d 68, 71 (2d Cir. 2010) (“Salinger has never permitted, and has explicitly instructed his lawyers not to allow, adaptations of his works.”).

manage all derivatives of the copyrighted material, such as films or sequels.

B. *Length of Protection*

Currently, the copyright protection lasts for the life of the author plus seventy years.¹⁹ The period of protection has continued to expand since the inception of copyright law. The Copyright Act of 1909 granted federal copyright protection for twenty-eight years, and an additional twenty-eight years upon timely renewal.²⁰ Under the Copyright Act of 1976,

[w]orks then in the first term or the renewal term of copyright under the 1909 Act had their term of protection potentially extended to 75 years. Works created on or after January 1, 1978, or first published thereafter, were to be protected for 50 years after the death of the author, and corporate works were to be protected for 75 years after publication.²¹

In 1998, Congress followed the lead of European nations and added twenty years to the length of copyright protection.²² The Sonny Bono Copyright Term Extension Act extended protection for corporate works and works protected under the 1909 Act from seventy-five to ninety-five years.²³ It also extended protection for works created after January 1, 1978 from life plus fifty years to life plus seventy years.²⁴ In *Eldred v. Ashcroft*, the Supreme Court held that the Copyright Term Extension Act of 1998 did not violate the “limited times” requirement established in the Constitution.²⁵ Because the length of protection is virtually perpetual, the consequences of problems within the system are heightened because they continue for so long.

C. *Fair Use*

Section 107 places some limitations on the exclusive rights of authors because others may use the original author’s works if that use constitutes “fair use.”²⁶ The fair use defense is designed to protect “purposes such as criticism, comment, news reporting, teaching (including multiple copies

¹⁹ 17 U.S.C. § 302(a) (2006).

²⁰ GORMAN, *supra* note 8, at 2–3.

²¹ *Id.* at 3.

²² *Id.* at 65.

²³ *Id.* at 5.

²⁴ *Id.*

²⁵ 537 U.S. 186, 199–204 (2003).

²⁶ *See* 17 U.S.C. § 107 (2006) (outlining the fair use defense).

for classroom use), scholarship, or research.”²⁷ In *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court held that parodies may claim fair use under Section 107.²⁸

Fair use analysis considers four factors:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (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 upon the potential market for or value of the copyrighted work.²⁹

D. Tensions in Copyright Law

Congress receives its authority to grant copyright protection from Article I, Section 8, Clause 8 of the Constitution. In order to promote the progress of the arts, Congress can grant authors exclusive rights to copyrightable subject matter for limited times.³⁰ The promotion of progress of the arts is challenged by the complexity of balancing the incentive necessary for authors and publishers to create and distribute new works against the availability of these works to the public. Tension also exists between granting authors exclusive rights to their works and the First Amendment’s commitment to freedom of speech.³¹

United States courts have recognized the tensions within copyright law, and often emphasize the ultimate goals of congressional power and the Copyright Act in their opinions. The Supreme Court stated that the ultimate goal of copyright law is “to stimulate artistic creativity for the general public good.”³² The means to achieve this goal is to provide incentive to authors to create artistic works by granting them a monopoly. Specifically, the limited grant of exclusive rights “is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.”³³ Congress’s task of serving the public good with ultimate access to artistic works requires a difficult balance between the interests of authors “in the control and exploitation of their [works]” and “society’s competing interest in the free

²⁷ *Id.*

²⁸ 510 U.S. 569, 579 (1994).

²⁹ 17 U.S.C. § 107.

³⁰ U.S. CONST. art. I, § 8, cl. 8.

³¹ See U.S. CONST. amend. I (“Congress shall make no law . . . abridging the freedom of speech . . .”).

³² *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

³³ *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

flow of ideas, information, and commerce.”³⁴

In its opinion in *Suntrust Bank v. Houghton Mifflin, Co.*, the Eleventh Circuit identified three main goals of copyright law: “the promotion of learning, the protection of the public domain, and the granting of an exclusive right to the author.”³⁵ The court explained that copyright law promotes learning by guarding against censorship and by incentivizing authors to create new works, which together promote public access to new ideas and concepts.³⁶ Copyright law protects the public domain because it ensures that artistic works enter the public domain after the limited exclusive rights expire.³⁷ Finally, copyright grants authors these exclusive rights “to encourage the creation of original works.”³⁸

On their face the Copyright Clause and the First Amendment are inherently in conflict.³⁹ While copyright law provides incentive for the creation and distribution of creative works, copyright law “also burdens speech. We often copy or build upon another’s words, images, or music to convey our own ideas effectively. We cannot do that if a copyright holder withholds permission or insists upon a license fee that is beyond our means.”⁴⁰ The balance between the First Amendment and the Copyright Clause is supposedly served by copyright’s idea/expression dichotomy and the fair use doctrine.⁴¹ Copyright protection can be granted only to expression and not to ideas.⁴² Furthermore, the fair use doctrine protects First Amendment values because the purposes allowed under the fair use analysis “allow later authors to use a previous author’s copyright to introduce new ideas or concepts to the public.”⁴³ The following cases demonstrate how these safeguards are inadequate with regard to the exclusive right to prepare derivative works, particularly because current law makes a problematic distinction between parody and satire and ignores the intentions of copyright owners.⁴⁴

³⁴ *Id.*

³⁵ 268 F.3d 1257, 1261 (11th Cir. 2001).

³⁶ *Id.* at 1261–62.

³⁷ *Id.* at 1262.

³⁸ *Id.*

³⁹ Compare U.S. CONST. amend. I (“Congress shall make no law . . . abridging the freedom of speech, or of the press.”), with U.S. CONST. art. I, § 8, cl. 8 (“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”).

⁴⁰ NEIL WEINSTOCK NETANEL, COPYRIGHT’S PARADOX 3 (2008).

⁴¹ *Suntrust Bank*, 268 F.3d at 1263.

⁴² See *Baker v. Selden*, 101 U.S. 99, 107 (1879) (concluding that copyright for a blank accounting book did not grant the owner the exclusive right over the accounting method).

⁴³ *Suntrust Bank*, 268 F.3d at 1264.

⁴⁴ While this Note does not examine the exclusive right to reproduction, problems with the derivative works right may also arise from the reproduction right.

III. TWO CASES

Two recent cases involving literary works which were substantially similar to the novels of previous authors raise questions about the ways in which current law is succeeding or failing to achieve the goals of copyright. In both cases, a subsequent author wrote what can arguably be deemed a sequel to an original author's work.⁴⁵ In one case, the court found that the work was a parody and therefore had a valid fair use defense.⁴⁶ In a case nine years later, the court found that the "sequel" was a satire, and therefore did not constitute fair use.⁴⁷ Ironically, both authors pulled characters, relationships, settings, famous scenes, and even dialogue from the original novel.⁴⁸

A. Suntrust Bank v. Houghton Mifflin Co.

In *Suntrust Bank v. Houghton Mifflin Co.*, the United States District Court for the Northern District of Georgia and the Eleventh Circuit disagreed about whether Alice Randall's novel, *The Wind Done Gone*, constituted fair use of Margaret Mitchell's novel, *Gone with the Wind*.⁴⁹ Suntrust Bank brought suit as "the trustee of the Mitchell Trust, which holds the copyright in [*Gone with the Wind*]."⁵⁰ The Trusts actively managed the copyright, and previously authorized derivative works of the novel, including a sequel.⁵¹

Alice Randall's novel *The Wind Done Gone* uses characters and scenes from *Gone with the Wind*.⁵² The work is told from the perspective of a slave named Cynara, the daughter of a *Gone with the Wind* character, Mammy, and the half-sister of the character Other, who represents Mitchell's character of Scarlet in *Gone with the Wind*.⁵³ In the book, Cynara has a relationship with the character representing Rhett Butler from *Gone with the Wind*.⁵⁴ In the end, Cynara inherits the plantation where she

⁴⁵ *Salinger v. Colting*, 607 F.3d 68, 72 (2d Cir. 2010) (describing the various elements which Fredrik Colting used from J.D. Salinger's *Catcher in the Rye*); *Suntrust Bank*, 268 F.3d at 1267 (explaining that Alice Randall used multiple features from Margaret Mitchell's *Gone with the Wind*).

⁴⁶ *Suntrust Bank*, 268 F.3d at 1277.

⁴⁷ *Salinger*, 607 F.3d at 83.

⁴⁸ *Id.* at 72; *Suntrust Bank*, 268 F.3d at 1267.

⁴⁹ Compare *Suntrust Bank*, 268 F.3d at 1269–76 (concluding that "[*The Wind Done Gone*] is entitled to a fair-use defense" after analyzing the fair use factors), with *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357, 1370–84 (N.D. Ga. 2001) (concluding that Suntrust Bank would likely succeed on its infringement claim).

⁵⁰ *Suntrust Bank*, 268 F.3d at 1259.

⁵¹ *Id.*

⁵² Note, *Gone with the Wind Done Gone: "Re-Writing" and Fair Use*, 115 HARV. L. REV. 1193, 1194 (2002).

⁵³ *Id.*

⁵⁴ *Id.*

grew up, “Tata,” which is similar to *Gone with the Wind*’s “Tara.”⁵⁵ Other characters and places also appear in both novels.⁵⁶

Alice Randall admitted to appropriating elements from *Gone with the Wind*, but she claimed that the use was necessary for her critique of the depiction of slavery and the Civil War era American South in Mitchell’s novel.⁵⁷ In her declaration to the court, Randall explained:

In order to effectively debunk the harmful and offensive view of black people portrayed throughout *Gone with the Wind*, I thus had to create a work that would comment on the pervasiveness of that view in the book, in part by pointing out and dissecting for the reader the elements of that book—characters, scenes and even carefull [sic] selected lines of dialogue—that help perpetuate that view.⁵⁸

Randall claimed to target *Gone with the Wind* for her parody because more than any other work she knew, it “presented and helped perpetuate an image of the South” that she “felt compelled to comment upon and criticize.”⁵⁹ This compulsion for commentary and criticism could be similar to Fredrik Colting’s desire to comment on the quirks of Holden Caulfield and the way in which J.D. Salinger became a recluse.⁶⁰ Under the current copyright system, however, Randall’s criticism was freely shared with the rest of the public while Colting’s was barred from distribution.⁶¹

The United States District Court for the Northern District of Georgia and the Eleventh Circuit disagreed about whether Mitchell’s estate should have been granted an injunction against the publication and distribution of the allegedly infringing book.⁶² This contrast in opinion boiled down to

⁵⁵ *Id.*

⁵⁶ See *Suntrust Bank*, 268 F.3d at 1267 (“[*The Wind Done Gone*] appropriates numerous characters, settings, and plot twists from [*Gone with the Wind*].”).

⁵⁷ *Id.* at 1259.

⁵⁸ Declaration of Alice Randall at 6, *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357 (2001) (No. 1:01 CV-701-CAP).

⁵⁹ *Id.* at 1.

⁶⁰ See *Salinger v. Colting*, 607 F.3d 68, 72 (2d Cir. 2010) (discussing Colting’s claim that his novel was not a sequel, but rather a critique of Salinger).

⁶¹ See *id.* at 83 (concluding that on remand Salinger was likely to succeed on infringement claim and Colting was unlikely to succeed with fair use defense); *Suntrust Bank*, 268 F.3d at 1277 (finding an injunction to be an inappropriate remedy because *The Wind Done Gone* has a viable fair use defense).

⁶² Compare *Suntrust Bank*, 268 F.3d at 1276 (finding the district court erred by presuming irreparable injury simply because there was a likelihood of copyright infringement without properly considering the success of a fair-use defense), with *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357, 1386 (N.D. Ga. 2001) (granting a preliminary injunction which “enjoined [Houghton Mifflin Company] from further production, display, distribution, advertising, sale, or offer for sale of the book *The Wind Done Gone*”).

the courts' differing assessments of the fair use analysis.⁶³ The fair use analysis considers the purpose and the character of the work, the nature of the copyrighted work, the amount and substantiality of the portion of the work used, and finally, the effect on the market value of the original.⁶⁴

1. Purpose and Character of the Work

The biggest discrepancy between the district court and the appellate court was in their treatment of the first factor.⁶⁵ In *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court held that in examining the purpose and character of the use, the critical question is whether the secondary work is transformative.⁶⁶ A finding that the secondary work is transformative is not dispositive of fair use, but the more transformative the work, the less other factors, such as a commercial purpose, will weigh against a finding of fair use.⁶⁷

The district court found that the first factor weighed in favor of the plaintiff because of the commercial purpose of *The Wind Done Gone*.⁶⁸ The district court also found, however, that the work was somewhat transformative and would therefore not give the first factor undue weight.⁶⁹ The district court concluded that while Randall's book criticized *Gone with the Wind* in part, the overall purpose of the work was "to create a sequel to the older work and provide Ms. Randall's social commentary to the antebellum South. The work retells the earlier story in a condensed version from a different perspective but, in truth, merely encapsulates the same story while adding new twists."⁷⁰ The district court found that *The Wind Done Gone* contained transformative parodic elements that generally criticized the earlier work and the antebellum South, but the transformation was no more than that resulting from a sequel to an original work.⁷¹ The district court emphasized the Supreme Court's holding in *Campbell* that a parody must comment on an author's work,⁷² and found that Randall did not simply seek to criticize the treatment of African Americans in *Gone with the Wind*, but to give a more general criticism of the treatment of African Americans in the South.⁷³

⁶³ See *Suntrust Bank*, 268 F.3d at 1276–77 (stating that a fair use defense was likely to prevail because of a lack of irreparable injury and because comment and criticism are generally protected).

⁶⁴ 17 U.S.C. § 107 (2006).

⁶⁵ See *Suntrust Bank*, 268 F.3d at 1271 (finding the new work had to include much of the original to effectively be a parody, and was thus transformative); *Suntrust Bank*, 136 F. Supp. at 1378 (holding the new work is primarily a sequel and its transformative nature has little effect on that characteristic).

⁶⁶ 510 U.S. 569, 579 (1994).

⁶⁷ *Id.*

⁶⁸ *Suntrust Bank*, 136 F. Supp. 2d at 1379.

⁶⁹ *Id.*

⁷⁰ *Id.* at 1378.

⁷¹ *Id.*

⁷² *Id.* at 1372 (citing *Campbell*, 510 U.S. at 580–81).

⁷³ *Suntrust Bank*, 136 F. Supp. 2d at 1377–78.

To support its claim that the work was closer to a sequel than a parody, the district court looked to a dictionary definition of a sequel: “a literary work continuing the course of a narrative begun in a preceding one.”⁷⁴ The district court went on to conclude that *The Wind Done Gone* satisfied this definition because it used the fifteen main characters from *Gone with the Wind*, gave explanation and further details about what happened in the first work, and then explained what happened to them later on.⁷⁵ The district court was not satisfied with the argument that because the work was told through Cynara’s perspective, it was not a sequel. The district court found that “[i]f the work is intended to supply the missing story of the earlier work and takes up where the former work left off, then it is a sequel,” and therefore an infringement of the copyright owner’s derivative work.⁷⁶

In contrast to the district court, the Eleventh Circuit concluded that *The Wind Done Gone* was a parody of *Gone with the Wind*, not a sequel, and therefore was highly transformative.⁷⁷ The Eleventh Circuit determined that Randall’s work was a statement seeking “to rebut and destroy the perspective, judgments, and mythology of [*Gone with the Wind*].”⁷⁸ The court of appeals also noted that Randall tells the story through a different viewpoint, that Randall’s language is vastly different from Mitchell’s prose, and that the events from the original work are transformed into a new tale.⁷⁹ The Eleventh Circuit held that Randall used the tools of parody to “make war” against Mitchell’s *Gone with the Wind*.⁸⁰

2. Nature of the Copyrighted Work

Both courts agreed that the second factor, the nature of the copyrighted work, weighed in favor of the copyright holder because *Gone with the Wind* should be afforded greater protection as a work of fiction.⁸¹ The Eleventh Circuit gave the factor little weight, however, because it was a parody case, and “parodies almost invariably copy publicly known, expressive works.”⁸²

3. Amount and Substantiality of the Portion of the Work Used

Application of the third factor was another point of disagreement between the district court and the court of appeals. The third factor

⁷⁴ *Id.* at 1375 (internal quotation marks omitted).

⁷⁵ *Id.*

⁷⁶ *Id.* at 1377.

⁷⁷ *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1271 (11th Cir. 2001).

⁷⁸ *Id.* at 1270.

⁷⁹ *Id.*

⁸⁰ *Id.* at 1271.

⁸¹ *Id.*; *Suntrust Bank*, 136 F. Supp. 2d at 1380.

⁸² *Suntrust Bank*, 268 F.3d at 1271 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586 (1994)) (internal quotation marks omitted).

considers the amount and substantiality of the portion used in the secondary work in relation to the copyrighted work as a whole.⁸³ The Supreme Court in *Campbell* explained that this factor requires courts to consider the reasonableness of the quantity and value of the material in light of the purpose of the copying.⁸⁴ The Court recognized that parodies present an interesting situation because “the parody must be able to ‘conjure up’ at least enough of that original to make the object of its critical wit recognizable.”⁸⁵

The district court found that the amount and substantiality of the work used weighed against a finding of fair use.⁸⁶ The district court concluded that Randall used too much copyrighted material to criticize Mitchell’s portrait of Southern history in *Gone with the Wind*.⁸⁷ By including “the original work’s plot, themes, characters, character traits, settings, scenes, descriptive phrases, and verbatim quotes,” Randall went beyond what was necessary to parody Mitchell’s work and crossed into the realm of piracy.⁸⁸

The Eleventh Circuit was not convinced that Randall appropriated too much copyrighted material, nor was the court convinced that Randall did not. The court of appeals noted several instances in which Randall used elements of *Gone with the Wind* and transformed them in *The Wind Done Gone* for purposes of commentary.⁸⁹ The Eleventh Circuit considered the argument that Randall took more than was necessary to parody *Gone with the Wind*.⁹⁰ On appeal, the court explained that the use is not necessarily infringing if it does more than conjure up the work, but that fair use depends on other factors such as the overriding purpose of the use and the likelihood that the parody will be a market substitute for the original.⁹¹ The Eleventh Circuit concluded, however, that the record did not support a finding one way or the other about the reasonableness of the quantity and value of the materials used in relation to the purpose of the work.⁹²

4. *Effect of the Market Value on the Original*

The fourth and final factor resulted in another split between the district court and the Eleventh Circuit. The fourth factor calls for an analysis of “the effect of the use upon on the potential market for or value of the copyrighted work,” including both harm to the market for the original and

⁸³ 17 U.S.C. § 107 (2006).

⁸⁴ *Campbell*, 510 U.S. at 586.

⁸⁵ *Id.* at 588.

⁸⁶ *Suntrust Bank*, 136 F. Supp. 2d at 1381.

⁸⁷ *Id.* at 1380–81.

⁸⁸ *Id.* at 1381.

⁸⁹ *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1272 (11th Cir. 2001).

⁹⁰ *See id.* at 1272 (considering the particular elements taken from the original for the parody).

⁹¹ *Id.* at 1273.

⁹² *Id.* at 1274.

for derivative works.⁹³ The fact that the commentary might be successful in killing demand for the original or derivative works is not the type of harm the courts are concerned with.⁹⁴

The district court found that while the parodic intent of the work may have been substantial, it did not compare to the potential harm due to the extensive copying.⁹⁵ Because the district court found that the work was more similar to a sequel than a parodic commentary, that court held that the fourth factor weighed against a finding of fair use.⁹⁶ In contrast, the Eleventh Circuit concluded that Mitchell's estate did not establish that *The Wind Done Gone* would act as a market substitute for *Gone with the Wind* or significantly harm its derivative market.⁹⁷

Despite the promising verdict of the Eleventh Circuit, Houghton Mifflin Company agreed to a settlement with the estate of Margaret Mitchell in May of 2002.⁹⁸ At the request of the Mitchell Trusts, a contribution was made to Morehouse College and the copies of *The Wind Done Gone* would continue to be labeled an unauthorized parody.⁹⁹

B. Salinger v. Colting

The United States District Court for the Southern District of New York and the Second Circuit both held that author Fredrik Colting would not likely prevail in a fair use defense against claims of copyright infringement for his use of material from J.D. Salinger's novel, *The Catcher in the Rye*.¹⁰⁰ *The Catcher in the Rye* ("Catcher") tells the story of a sixteen-year-old, Holden Caulfield, who wanders around New York City for several days after being expelled from school. The story is told from Holden's perspective and throughout the novel there is a tension between Holden's cynical view of "a world full of phonies and crooks and his love of family."¹⁰¹ Colting's novel, *60 Years Later, Coming Through the Rye* ("*60 Years Later*"), tells the story of seventy-six-year-old Mr. C "in a world that includes Mr. C's ninety-year-old author, a 'fictionalized Salinger.'"¹⁰² The two works share similarities including:

⁹³ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994) (quoting 17 U.S.C. § 107(4) (2006)).

⁹⁴ *Id.* at 592–93 (considering the argument that Randall took more than was necessary to parody the original work).

⁹⁵ *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357, 1383 (N.D. Ga. 2001).

⁹⁶ *Id.*

⁹⁷ *Suntrust Bank*, 268 F.3d at 1276.

⁹⁸ David D. Kirkpatrick, *Mitchell Estate Settles 'Gone With the Wind' Suit*, N.Y. TIMES, May 10, 2002, at C6.

⁹⁹ *Id.*

¹⁰⁰ *Salinger v. Colting*, 607 F.3d 68, 83 (2d Cir. 2010); *Salinger v. Colting*, 641 F. Supp. 2d 250, 268 (S.D.N.Y. 2009).

¹⁰¹ *Salinger*, 607 F.3d at 70–71 (internal quotation marks omitted).

¹⁰² *Id.* at 71–72.

Mr. C is Holden Caulfield. Mr. C narrates like Holden, references events that happened to Holden, and shares many of Holden's notable eccentricities. Also, Mr. C's adventures parallel those of Holden. Both characters leave an institution, wander around New York City for several days, reconnect with old friends, find happiness with Phoebe, and ultimately return to a different institution. Finally, within these broader structural similarities, the novels contain similar scenes¹⁰³

A significant difference between the two novels is that *60 Years Later* includes a fictionalized Salinger who is haunted by his literary creation.¹⁰⁴ Salinger wishes to bring Caulfield back to life so that he can kill him.¹⁰⁵ In the end, Caulfield meets Salinger in his home and the author, unable to kill him, decides to set him free.¹⁰⁶

Salinger was adamantly against derivative works involving Holden Caulfield. He specifically instructed his lawyers not to allow any adaptations of his works.¹⁰⁷ Colting argued that *60 Years Later* was not a sequel, but rather a commentary on the portrayal of Holden Caulfield in *Catcher*, and on the relationship between Salinger and his created character. Colting suggested that as the author grew old he "remain[ed] imprisoned by the literary character he created."¹⁰⁸ Given the transformative nature of this commentary, and the role of the Salinger character, Colting argued that the use of material from *Catcher* constituted fair use.¹⁰⁹ Both the district court and court of appeals disagreed with Colting.¹¹⁰

1. *Purpose and Character of the Work*

The district court found that the first factor, the nature and purpose of the work, weighed against a finding of fair use.¹¹¹ The district court found that there was an obvious commercial use because it was to be sold for profit.¹¹² In addition, the district court concluded that the novel was not a parody, and while it did contain some transformative elements because of the use of the Salinger character to comment on the author, it was not

¹⁰³ *Id.* at 72 (citation omitted).

¹⁰⁴ *Id.* at 71–72.

¹⁰⁵ *Id.* at 72.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at 71.

¹⁰⁸ *Id.* at 72 (quoting Brief for Defendants-Appellants at 10, *Salinger v. Colting*, 607 F.3d 68 (2d Cir. 2010) (No. 09-2878-CV)).

¹⁰⁹ *Salinger v. Colting*, 641 F. Supp. 2d 250, 254 (S.D.N.Y. 2009).

¹¹⁰ *Salinger*, 607 F.3d at 73–74; *Salinger*, 641 F. Supp. 2d at 268.

¹¹¹ *Salinger*, 641 F. Supp. 2d at 263.

¹¹² *Id.*

enough to weigh in favor of fair use.¹¹³ Specifically, the district court rejected Colting's classification of his work as a parody of *Catcher* and its author because the work contained no specific criticism of a character or theme in *Catcher*.¹¹⁴ Rather, the district court concluded that Colting reiterated the same themes and traits found in Holden Caulfield in Salinger's original story, instead of exposing them or commenting on them.¹¹⁵ The district court found that "[i]t is hardly parodic to repeat that same exercise in contrast, just because society and the characters have aged."¹¹⁶

The district court further concluded that the use of Salinger as a character was novel, but that it was not a parody because it critiqued the reclusive nature of Salinger and his zealous protection of his intellectual property.¹¹⁷ Parody criticizes the work, however, and therefore a criticism of Salinger did not constitute parody.¹¹⁸

2. *Nature of the Copyrighted Work, Amount and Substantiality of the Portion of the Work Used, and the Effect of the Market Value on the Original*

The district court also concluded that the second factor weighed against a finding of fair use because *Catcher* is a creative work of fiction, and therefore entitled to strong copyright protection.¹¹⁹ Furthermore, the court found that the third factor weighed against a finding of fair use because Colting took more than was necessary from *Catcher* for the purpose of criticizing Salinger.¹²⁰ In addition to the similarities between Holden and Mr. C, the district court found that the use of "similar and sometimes nearly identical supporting characters, settings, tone, and plot devices" was "unnecessarily high" for the alleged purpose.¹²¹

Finally, the district court concluded that the potential harm to the market of the original work also weighed against a finding of fair use because Colting's book had the potential to harm the market for sequels and other derivative works.¹²² In light of the fact that Salinger was adamant that there should never be any derivative works to *Catcher*, it is ironic that the district court concerned itself with harm to a market for works that would be highly unlikely to come.

¹¹³ *Id.* at 262–63.

¹¹⁴ *Id.* at 258.

¹¹⁵ *Id.* at 258–60.

¹¹⁶ *Id.* at 259.

¹¹⁷ *Id.* at 261.

¹¹⁸ *Id.*

¹¹⁹ *Id.* at 263.

¹²⁰ *Id.* at 267.

¹²¹ *Id.* at 264–66.

¹²² *Id.* at 268.

Ultimately, the district court decided that Colting was not likely to succeed with a fair use defense and therefore granted the requested preliminary injunction against the “manufacturing, publishing, distributing, shipping, advertising, promoting, selling, or otherwise disseminating any copy of *60 Years* or any portion thereof, in or to the United States.”¹²³ The Second Circuit agreed that *60 Years Later* was not likely to constitute fair use, supporting the district court’s conclusion that Colting’s assertion that the primary purpose of the novel was to critique Salinger was not credible.¹²⁴ The court of appeals remanded for a reevaluation of the preliminary injunction consistent with its holding that the standards laid out by the Supreme Court in *eBay, Inc. v. MercExchange, L.L.C.* and *Winter v. Natural Resources Defense Council* apply to copyright infringement.¹²⁵

Colting reached a settlement with Salinger’s literary estate in December 2010.¹²⁶ The settlement prohibited Colting from publishing or distributing the work in the United States or Canada, but freed him to sell the book in other international territories.¹²⁷ Colting also agreed to change the title from “Coming Through the Rye,” and make no dedication of the book to Salinger.¹²⁸ Moreover, the settlement prohibited “Colting or any publisher of the book from referring to *The Catcher in the Rye*, Salinger, the book being ‘banned’ by Salinger, or from using the litigation to promote the book.”¹²⁹

C. Comparing the Two Cases

Suntrust Bank v. Houghton Mifflin Co. and *Salinger v. Colting* are similar because both cases involve an action to enjoin a secondary author from publishing a derivative work to an original author’s novel.¹³⁰ Furthermore, both secondary authors, Randall and Colting, appropriated characters, settings, and even some dialogue from the original works.¹³¹ Finally, both cases are analogous in that both Randall and Colting asserted the affirmative defense of fair use¹³²—the defense resulted in the court’s

¹²³ *Id.* at 268–69.

¹²⁴ *Salinger v. Colting*, 607 F.3d 68, 83 (2d Cir. 2010).

¹²⁵ *Id.* at 84.

¹²⁶ Andrew Albanese, *J.D. Salinger Estate, Swedish Author Settle Copyright Suit*, PUBLISHERS WKLY. (Jan. 11, 2011), <http://www.publishersweekly.com/pw/by-topic/industry-news/publisher-news/article/45738-j-d-salinger-estate-swedish-author-settle-copyright-suit.html>.

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ *Salinger*, 607 F.3d at 71–72; *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1259 (11th Cir. 2001).

¹³¹ *Salinger*, 607 F.3d at 72; *Suntrust Bank*, 268 F.3d at 1267.

¹³² *Salinger*, 607 F.3d at 72–73; *Suntrust Bank*, 268 F.3d at 1259.

analysis of the four fair use factors, including whether the secondary works were transformative parodies.¹³³

The significant difference between the two cases is that the Eleventh Circuit found that *The Wind Done Gone* was a parody of *Gone with the Wind*,¹³⁴ and the Second Circuit agreed with the district court that critique was not the purpose of *60 Years Later*.¹³⁵ The Eleventh Circuit found *The Wind Done Gone* very transformative because it was a parody of Mitchell's novel.¹³⁶ By fitting the novel into the parody niche, the Eleventh Circuit was able to weigh the first factor in favor of fair use.¹³⁷ By contrast, the district court concluded that *The Wind Done Gone* was not a parody of Mitchell's novel, and found that it was not transformative enough to constitute fair use.¹³⁸ Likewise, the Second Circuit upheld the finding of United States District Court for the Southern District of New York that *60 Years Later* was not sufficiently transformative because it did not parody *Catcher*.¹³⁹ The courts agreed that the novel was transformative because Colting satirized Salinger's life, but that this transformative element was not adequate to weigh in favor of fair use.¹⁴⁰

As evidenced by these cases, where the court concluded that the work was a parody, and not a satire or general criticism, more weight was given towards a finding of fair use. By contrast, satires were not considered to be very transformative. This difference in weight was a result of the distinction between parody and satire made by the Supreme Court in *Campbell*.¹⁴¹ As a result of this distinction, creativity is stifled and the public suffers the loss of new works with different perspectives. This is problematic to the overall goal of copyright: serving the public good.

In both *Suntrust Bank* and *Salinger*, a consideration of the future intentions of the copyright owner with regard to derivative works did not play a substantial role. The United States District Court for the Northern District of Georgia reviewed the Mitchell Trusts' past actions with regard to authorizing sequels,¹⁴² and mentioned the Trust's authorization of

¹³³ See *supra* Part III.A (discussing the Eleventh Circuit and district court's fair use analysis in *Suntrust Bank v. Houghton Mifflin Company*); *supra* Part III.B (discussing the Second Circuit and district court's fair use analysis in *Salinger v. Colting*).

¹³⁴ *Suntrust Bank*, 268 F.3d at 1271.

¹³⁵ *Salinger*, 607 F.3d at 83.

¹³⁶ See *Suntrust Bank*, 268 F.3d at 1271 (noting the social benefit provided by Randall's commentary on an earlier work).

¹³⁷ *Id.*

¹³⁸ *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357, 1378 (N.D. Ga. 2001).

¹³⁹ *Salinger*, 607 F.3d at 73, 83; *Salinger v. Colting*, 641 F. Supp. 2d 250, 261, 263 (S.D.N.Y. 2009).

¹⁴⁰ *Salinger*, 607 F.3d at 73; *Salinger*, 641 F. Supp. 2d at 261.

¹⁴¹ See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994) (explaining that parodies must mimic the original, whereas satires can stand on their own).

¹⁴² *Suntrust Bank*, 136 F. Supp. 2d at 1363–64.

sequels in the analysis of the fourth fair use factor, but the district court did not consider its future plans.¹⁴³ In *Salinger*, the courts disregarded Salinger's intentions to not create or license any derivative works of *Catcher*.¹⁴⁴ By ignoring the fact that the copyright owner would prevent the publication of new works, the Second Circuit ensured that the ultimate goal of copyright would not be achieved. There should be a more formal consideration of copyright owners' intentions with regard to the derivative works right in order for courts and the U.S. Copyright Office to better manage the publishing of derivative works for public discourse.

IV. PARODY V. SATIRE

One of the inherent problems with the fair use analysis is the distinction courts draw between parody and satire. Courts should eliminate the parody/satire dichotomy because both parodies and satires share a common purpose of comment or criticism, these purposes are important to the public, and a copyright owner may be just as unwilling to give permission for a parody as for a satire.

A. Common Purpose

The fair use defense protects works with such purposes as criticism or commentary.¹⁴⁵ In *Campbell*, the Supreme Court held that "parody, like other comment or criticism, may claim fair use under § 107."¹⁴⁶ While both parodies and satires aim to criticize or comment, courts are more willing to find parodies to be fair use.¹⁴⁷ Courts rely on the distinction the Supreme Court made in *Campbell*. For the purpose of copyright law, the Court defined parody as "the use of some elements of a prior author's

¹⁴³ See *id.* at 1382 (noting that the Trust has authorized derivative works in the past, but not mentioning any future plans for derivative works).

¹⁴⁴ *Salinger*, 607 F.3d at 74 (citing *Salinger*, 641 F. Supp. 2d at 268).

¹⁴⁵ 17 U.S.C. § 107 (2006).

¹⁴⁶ *Campbell*, 510 U.S. at 579.

¹⁴⁷ See Juli Wilson Marshall & Nicholas J. Siciliano, *The Satire/Parody Distinction in Copyright and Trademark Law—Can a Satire Ever Be a Fair Use?*, ABA Section of Litig. Intell. Prop. Litig. Comm. 3, available at http://apps.americanbar.org/litigation/committees/intellectual/roundtables/0506_outline.pdf (explaining that courts are "transfixed by the apparent dichotomy in *Campbell* between parody and satire"); see also *Campbell*, 510 U.S. at 580–81 ("Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing."); *Salinger*, 607 F.3d at 73 ("*60 Years Later* does not parody *Catcher* or the Holden character, and although it might parody Salinger, that is insufficient because according to the Supreme Court's decision in *Campbell*, parody must critique or comment on the work itself." (citations omitted)); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1268 (11th Cir. 2001) (emphasizing that parody justifiably borrows from the original work and satire does not); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997) (finding that *The Cat NOT in the Hat!* is not transformative because the work does not hold the Dr. Seuss characteristic style up to ridicule).

composition to create a new one that, at least in part, comments on that author's works."¹⁴⁸ In contrast, the Court stated that other forms of commentary borrowing from original works, including satire, which have "no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh" have less claim to fair use.¹⁴⁹ Parodists have better claim to the fair use defense because they are commenting on the original work, whereas satirists are commenting on something broader. While the Court in *Campbell* weighed all of the factors in analyzing fair use, other courts rely heavily on the dichotomy the Court created between parody and satire. The trend in courts is that

if the new work arguably criticized or commented on the original, a parodic character reasonably can be perceived . . . the other factors concurrently become less important, and a fair use finding is quick to follow. On the other hand, if the new work used the original work as a mere vehicle to criticize something else (such as society in general), it is satire, not parody, and therefore not fair use.¹⁵⁰

In spite of this distinction, both parodies and satires share a common purpose—commentary—that is protected under the fair use defense.¹⁵¹ Alice Randall attempted to criticize Margaret Mitchell's depiction of slavery and the South, and Fredrik Colting attempted to criticize J.D. Salinger and his desperate protection of the Holden Caulfield character. In both instances, the courts relied on the Supreme Court's distinction between parody and satire. The Eleventh Circuit found that Randall criticized *Gone with the Wind*, and *The Wind Done Gone* was therefore a parody because it critiqued a preexisting work.¹⁵² In contrast, Colting used the work to critique Salinger, and not *Catcher*. Colting clearly criticized Salinger and made a comment on *Catcher*.¹⁵³ Because the fair use analysis calls for a balancing test, it cannot be said that the courts found the fact that Colting wrote a satiric sequel and not a parody dispositive of copyright infringement.¹⁵⁴ But the Eleventh Circuit was certainly generous with *The Wind Done Gone* as it, as well as Suntrust Bank, fit it into the parody

¹⁴⁸ *Campbell*, 510 U.S. at 580.

¹⁴⁹ *Id.*

¹⁵⁰ Marshall & Siciliano, *supra* note 147, at 3.

¹⁵¹ 17 U.S.C. § 107 (2006).

¹⁵² *Suntrust Bank*, 268 F.3d at 1271.

¹⁵³ *Salinger v. Colting*, 641 F. Supp. 2d 250, 261 (S.D.N.Y. 2009).

¹⁵⁴ See *Campbell*, 510 U.S. at 580–81 n.14 (explaining that in light of the other fair use factors and the extent of transformation, a parody may not constitute fair use and satire may be fair use).

niche.¹⁵⁵

A significant result of the parody/satire dichotomy is the post-hoc realization by attorneys and judges to classify derivative works as parodies in order to find fair use. Courts' preference for parody over satire corresponds with "a tendency for both lawyers and judges to couch any work it deems a fair use as a parody."¹⁵⁶ This is particularly problematic because many works tend to resist classification. Like *The Wind Done Gone* and *60 Years Later*, many works combine satiric and parodic elements to comment generally on or to criticize an original work and something broader. For example, the Eleventh Circuit found that *The Wind Done Gone* was specifically a criticism of Mitchell's depiction of slavery in *Gone with the Wind*.¹⁵⁷ In contrast, the district court found that the work was not merely a criticism of the treatment of African-Americans in *Gone with the Wind*, "but also [a] comment upon the treatment of black Americans in the South in the 1930's, 1940's and 1950's as well as today."¹⁵⁸ Relying on *Campbell*, the district court concluded that the work would not gain fair use protection as a parody if it simply used the work to ridicule a broader subject.¹⁵⁹ The district court would not find *The Wind Done Gone* a parody because "the parodical work must parody the work itself and not other general concepts and ideas about the way black Americans have been and are treated in the South."¹⁶⁰ In light of the difficulty of classifying works as a parody or a satire, it is illogical to create a bright line between the two. The parody/satire dichotomy encourages lawyers and judges to create a bright line where none exists.

B. Both Forms of Critique Are Important to the Public

The Supreme Court has emphasized that this country strives for "the widest possible dissemination of information from diverse and antagonistic sources."¹⁶¹ Criticism and commentary—of artistic and non-artistic works alike—are important to the dissemination of information and the resulting discussion. In its opinion in *Suntrust Bank*, the Eleventh Circuit identified "one of the most important purposes to consider [as] the free flow of ideas—particularly criticism and commentary."¹⁶² The fair use statute

¹⁵⁵ See *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357, 1376–77 (N.D. Ga. 2001) (explaining that the former cover of *The Wind Done Gone* did not describe the work as a parody, and the new cover was changed to explicitly advertise the work as a parody before the plaintiff's motion for a temporary restraining order).

¹⁵⁶ Marshall & Siciliano, *supra* note 147, at 6.

¹⁵⁷ *Suntrust Bank*, 268 F.3d at 1270.

¹⁵⁸ *Suntrust Bank*, 136 F. Supp. 2d at 1377.

¹⁵⁹ *Id.* at 1377–78.

¹⁶⁰ *Id.* at 1378.

¹⁶¹ *Turner Broad. Sys., Inc. v. F.C.C.*, 520 U.S. 180, 192 (1997) (citations omitted).

¹⁶² *Suntrust Bank*, 268 F.3d at 1268.

makes no distinction between commentary and criticism of copyrighted works or other subject matter.¹⁶³ This proves that commentary and criticism are generally worthy of protection, not just commentary or criticism of copyrighted works.

C. Licenses for a Derivative Work

The underlying theory of protecting parodies under fair use is that a copyright owner would license an author to use his or her work for satire, but not for parody.¹⁶⁴ It rests on the notion that a copyright owner would be willing to license his work as a vehicle for broader social commentary (satire), but not to criticize his or her own work (parody).¹⁶⁵ This theory is logical, but inaccurate. For example, J.D. Salinger would not allow Colting the use of *Catcher* to create a satire.¹⁶⁶ Furthermore, several artists gave licenses to Weird Al Yankovic to parody their music.¹⁶⁷ Dimension Films also gave a license to the parody, *Scary Movie*, based on Dimension Films' own movie *Scream*.¹⁶⁸

A broader, but more accurate theory would not distinguish between parody and satire. Rather, it should be said that a secondary author who wants to create a derivative work that will reflect negatively on the original work will be unlikely to secure a license from the copyright owner.¹⁶⁹ In *Dr. Seuss Enterprises v. Penguin Books*, the authors of *The Cat NOT in the Hat!*, a book satirizing the O.J. Simpson double-murder trial, did not seek permission from Seuss Enterprises to use its copyrighted books.¹⁷⁰ In the resulting lawsuit,

Dr. Seuss's motivation in seeking to enjoin Penguin's book was to avoid having the reputation of its works damaged by the sordid events of the Simpson murders. Given the negative reflection this kind of use creates, the original author is unlikely to voluntarily grant a license at any

¹⁶³ 17 U.S.C. § 107 (2006).

¹⁶⁴ Marshall & Siciliano, *supra* note 147, at 5.

¹⁶⁵ *Id.*

¹⁶⁶ See *supra* Part III.B (discussing *Salinger v. Colting*, 607 F.3d 68, 83 (2d Cir. 2010)); see also *Salinger v. Colting*, 641 F. Supp. 2d 250, 268 (S.D.N.Y. 2009) (noting that "Salinger has not demonstrated any interest in publishing a sequel or other derivative work of *Catcher*").

¹⁶⁷ Marshall & Siciliano, *supra* note 147, at 5.

¹⁶⁸ *Id.*

¹⁶⁹ See Jason M. Vogel, Note, *The Cat in the Hat's Latest Bad Trick: The Ninth Circuit's Narrowing of the Parody Defense to Copyright Infringement* in *Dr. Seuss Enterprises v. Penguin Books USA, Inc.*, 20 CARDOZO L. REV. 287, 310–11 (1998) ("[I]n an ordinarily functioning market a subsequent author wishing to create a socially-valuable (and thus economically-viable) derivative work will be able to secure a license from the original author, who presumably will be inclined to permit any wealth-producing use. However, in certain circumstances, where the subsequent use reflects negatively on the original author, she will be disinclined to license the use at any price." (footnote omitted)).

¹⁷⁰ 109 F.3d 1394, 1396 (9th Cir. 1997).

price.¹⁷¹

In *Salinger*, the copyright owner was unwilling to grant a license for any derivative work,¹⁷² but it was even more unlikely to license a work that reflected negatively on Salinger himself. In *Suntrust Bank*, the Mitchell Trusts authorized sequels to *Gone with the Wind*, but sought to enjoin Randall from publishing the negatively skewed *The Wind Done Gone*.¹⁷³ The ultimate settlement suggests that for a certain price the Mitchell Trusts might have licensed the alleged parody, but there is no guarantee that either party would have agreed without a lawsuit.

The Eleventh Circuit noted that “copyright laws were enacted in part to prevent private censorship.”¹⁷⁴ The derivative work right gives authors the right to an indirect censorship power because copyright owners have excessive control over subsequent works that may reflect negatively on the original work. The concurring judge in the Eleventh Circuit opinion in *Suntrust Bank* rejected granting authors the power of indirect censorship.¹⁷⁵ The judge expressed particular concern over empowering copyright owners to block the publication of critical derivative works.¹⁷⁶ The Eleventh Circuit successfully prevented the Mitchell Trusts from prohibiting a critical examination of *Gone with the Wind*, but J.D. Salinger was able to stop Colting from publishing a work that was critical of him. Distinguishing between parodies and satires gives authors greater indirect censorship power because courts are more likely to find parodies to be fair use than satires. Therefore, satiric works which may reflect negatively on the original work, but are important to the public discourse, are prevented from publication.

D. *Overcoming the Challenge to Removing the Distinction Between Parody and Satire*

A major challenge to the idea of removing the distinction between parody and satire is the Court’s justification in *Campbell* that “[p]arody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s (or collective victims’) imagination, whereas

¹⁷¹ Vogel, *supra* note 169, at 313 (footnote omitted).

¹⁷² *Salinger v. Colting*, 607 F.3d 68, 71 (2d. Cir. 2010).

¹⁷³ *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357, 1363–64 (N.D. Ga. 2001).

¹⁷⁴ *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1263 (11th Cir. 2001).

¹⁷⁵ *Id.* at 1283 (Marcus, J., concurring) (“The law grants copyright holders a powerful monopoly in their expressive works. It should not also . . . grant them a power of indirect censorship.”).

¹⁷⁶ *See id.* (“Copyright law is not designed to stifle critics. Destructive parodies play an important role in social and literary criticism and thus merit protection even though they may discourage or discredit an original author.”); *see also* *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 115 n.3 (2d Cir. 1998) (“Because the social good is served by increasing the supply of criticism—and thus, potentially, of truth—creators of original works cannot be given the power to block the dissemination of critical derivative works.”).

satire can stand on its own two feet and so requires justification for the very act of borrowing.”¹⁷⁷ The Court’s claim rests on the notion that parody comments on the author’s work and satire comments on something outside of the work.¹⁷⁸ Parodists must use the original work, whereas satirists can use various original works, or none at all. While this idea is logical, it is counterproductive to the promotion of the arts because it stifles creativity. Colting chose to satirize the life of J.D. Salinger.¹⁷⁹ It is possible that Colting could have written a satire about Salinger without reference to any original work, but Salinger is known for his writing, particularly *Catcher*. Without the use of *Catcher* and the character of Holden Caulfield, the effect of Colting’s satire may be lost. Theoretically a “satire can stand on its own two feet,”¹⁸⁰ but authors may find it more effective to use a previous work that will conjure up themes, ideas, and images for the audience. The Court stated that a satire required a “justification for the very act of borrowing.”¹⁸¹ Promoting creativity for the good of the public is a valid justification that should not be ignored.

V. PROPOSAL FOR THE CONSIDERATION OF THE INTENTIONS OF COPYRIGHT OWNERS FOR DERIVATIVE WORKS

A. *Reasons to Consider the Intentions of Copyright Owners*

Another solution to promote the publication of new works is for the U.S. Copyright Office and the courts to consider the copyright owner’s intentions with regard to the derivative work right. *Suntrust Bank* and *Salinger* provide two examples of the right to prepare derivative works creating obstacles to the public’s access to new works. Granting copyright owners the exclusive right to prepare derivative works does not guarantee that copyright owners will use the right. For example, the Mitchell Trusts attempted to prevent Randall’s derivative work, and likewise, Salinger and later his estate effectively prevented Colting from publishing in the United States. Moreover, Salinger himself was adamant that he would not create any derivative works to *Catcher* or the character of Holden Caulfield.¹⁸²

When copyright owners do not intend to use the exclusive right to prepare derivative works, either through their own creation or licensing others to do so, it can be problematic to the goals of copyright. It acts to recognize moral rights of literary authors and grants them an indirect censorship power. Authors like Fredrik Colting are being denied a basic

¹⁷⁷ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994).

¹⁷⁸ *Id.* at 580.

¹⁷⁹ *Salinger v. Colting*, 607 F.3d 68, 72 (2d Cir. 2010).

¹⁸⁰ *Campbell*, 510 U.S. at 581.

¹⁸¹ *Id.*

¹⁸² *Salinger*, 607 F.3d at 71.

First Amendment right to free speech.

An example from the United Kingdom is illustrative. The United Kingdom granted a perpetual copyright for J.M. Barrie's play, *Peter Pan*, to the long-term copyright holder, Great Ormond Street Hospital.¹⁸³ According to author Emily Somma, the work has already entered the public domain in the United States.¹⁸⁴ The play has been used to create several new works, including the recent movies *Hook* and *Finding Neverland*, as well as a new book written by Somma, *After the Rain*.¹⁸⁵ The creation of these works "illustrate the ability of authors and artists to build upon previous works."¹⁸⁶ Even still, the Great Ormond Street Hospital legally opposed the publishing of Somma's book.¹⁸⁷ When a copyright holder is "able to control such copyrights in perpetuity, the creation of many new works, of benefit to society for purposes ranging from entertainment to education to self-enlightenment, [has] to be aborted."¹⁸⁸ When the copyright owner opposes new derivative works through a lawsuit or refusal to license the derivative work, the United States public is denied creative new works that give a fresh perspective to beloved past works. Likewise, authors are being denied free expression. *Suntrust Bank* and *Salinger* present similar situations because two authors wrote with a new perspective on stories and characters that have been integral to American literature. Because of the exclusive right to prepare derivative works, society is denied the creativity of secondary authors and individuals are denied the right to freely express themselves.

By taking into account the copyright owner's intentions, the system can reduce the frequency of copyright owners stifling creativity of secondary authors through the refusal to create or license derivative works.

B. *Practical Approaches to Considering the Intentions of Copyright Owners*

1. *Renewal of Derivative Rights Work*

A practical way to take into account the intentions of the copyright owner is to require owners to renew the exclusive right to prepare derivative works. Rather than the right to prepare derivative works lasting for the life of the author plus seventy years, it should last for a short length

¹⁸³ Jennifer S. Green, Comment, *Copyrights in Perpetuity: Peter Pan May Never Grow Up*, 24 PENN ST. INT'L L. REV. 841, 844 (2006).

¹⁸⁴ *Id.*

¹⁸⁵ *Id.* at 842, 852.

¹⁸⁶ *Id.*

¹⁸⁷ See *id.* at 842 (stating that Somma's "contemporary novel . . . inspired both litigation and discussion focusing on copyright issues").

¹⁸⁸ *Id.* at 852.

of time.¹⁸⁹ For example, each copyright owner will be granted the exclusive right to prepare derivative works for ten years. After ten years, the copyright owner can renew the right by submitting to the U.S. Copyright Office evidence of the intention to create or license a derivative work. Trademark law requires owners of the mark to submit an affidavit that the mark is still being used in commerce, otherwise the mark is considered abandoned and goes into the public domain.¹⁹⁰ By requiring copyright owners to submit evidence of plans for a derivative work right, the U.S. Copyright Office can encourage potential new works. The fair use limitation would continue to protect secondary authors who wish to create derivative works that are critical of original works and who have difficulty receiving a license.

2. *Adding a Fair Use Analysis Factor that Considers the Intentions of the Copyright Owner*

Another possibility is to add a fifth factor into the fair use analysis in cases involving derivative works. The factor would consider the intentions of the copyright owner. In *Salinger*, the courts should have given more weight to a finding of fair use because J.D. Salinger had no intention of preparing or licensing any derivative works. By considering the intention of the author, the court is able to consider what will most benefit the public. The public will receive greater benefit from a new work by a secondary author than from protecting the moral rights of J.D. Salinger.

In *Salinger* the courts indirectly recognized the moral rights of J.D. Salinger. Although the court recognized that Salinger had publicly disclaimed any intention of authorizing a sequel, the court noted that Salinger had the right to change his mind and, even if he had no intention of changing his mind, there is value in the right not to authorize derivative works.¹⁹¹ The choice not to create derivative works, and not to license anyone else to create derivative works, serves to protect the integrity of *Catcher*. By preventing any derivative works, including those written by him, “Salinger seemingly wanted to classify *Catcher* and Caulfield as off-

¹⁸⁹ Another alternative to shortening the period of protection of the derivative works right is to shorten the length of all copyright protection. The period of protection for copyrighted works should be shortened. When there are problems in the system it is always better for those problems to last for a shorter period of time. The length of protection is currently life of the author plus seventy years, virtually granting copyright owners perpetual protection. As a result, the free expression of new authors and the public is limited. See generally Green, *supra* note 183; Matthew A. Kaplan, Note, *Rosencrantz and Guildenstern Are Dead, but Are They Copyrightable?: Protection of Literary Characters with Respect to Secondary Works*, 30 RUTGERS L.J. 817, 838–39 (1999) (proposing that the length of protection should be limited to the life of the author).

¹⁹⁰ 15 U.S.C. § 1058 (2006); see also Kaplan, *supra* note 189, at 839 (suggesting that copyright owners submit proof that they plan on using their works in the future).

¹⁹¹ *Salinger v. Colting*, 607 F.3d 68, 74 (2d Cir. 2010) (citing *Salinger v. Colting*, 641 F. Supp. 2d 250, 268 (S.D.N.Y. 2009)).

limits . . . as if any later use would compromise the integrity of the work and the character and would alter the vision he had for them at the time of creation.”¹⁹² Salinger’s focus on the integrity of *Catcher* suggested a moral-rights objective in his action against Colting. U.S. copyright law does not traditionally protect moral rights, but rather emphasizes economic rights.¹⁹³ Where federal copyright law does recognize moral rights, it applies to works of visual art, under the protection of the Visual Artists Rights Act.¹⁹⁴ Moral rights are not given to authors of literary works, like Salinger.¹⁹⁵ If courts consider the intentions of copyright owners they can more effectively make decisions that will lead to the publication of derivative works.

An alternative to having a fifth factor is to include a consideration of the copyright owner’s intentions in the fourth factor: the effect on the market value of the original. In both *Suntrust Bank* and *Salinger* the courts considered the impact on the potential derivatives market.¹⁹⁶ If the copyright owner has no intention of creating derivative works or licensing others to create them, this factor should weigh in favor of a finding of fair use.

C. *Obstacles to the Effective Consideration of the Intentions of Copyright Owners*

Considering the author’s intentions through a required renewal of the exclusive right to prepare derivative works or adding a fifth factor to a fair use analysis in derivative works cases faces two significant obstacles. The first is that it diminishes the importance of author’s rights. The second is that it is impractical to know the true intentions of a copyright owner.

1. *Diminishing Authors’ Rights*

The Second Circuit recognized that Salinger had no intention of preparing or licensing derivative works. The court decided that Salinger had a right to change his mind and that there is value to an exclusive right

¹⁹² Arlen W. Langvardt & Tara E. Langvardt, *Caught in the Copyright Rye: Freeing First Amendment Interests from the Constraints of the Traditional View*, 2 HARV. J. SPORTS & ENT. L. 99, 138 (2011).

¹⁹³ *Id.* at 138.

¹⁹⁴ *Id.* at 139.

¹⁹⁵ *Id.* at 133 (“[M]oral rights are not available to authors of works of the sort at issue in *Salinger*.”).

¹⁹⁶ See *Salinger*, 641 F. Supp. 2d at 267 (“The inquiry ‘must take account not only of harm to the original but also of harm to the market for derivative works.’” (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994))); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1274 (11th Cir. 2001) (“The final fair-use factor requires us to consider the effect that the publication of [*The Wind Done Gone*] will have on the market for or value of Suntrust’s copyright in [*Gone with the Wind*], including the potential harm it may cause to the market for derivative works based on *GWTW*.”).

to prepare derivative works, but there is also value in the choice to not authorize these works.¹⁹⁷ By requiring copyright owners to renew the right to prepare derivative works by offering evidence of an intention to do so, the copyright owner's option of changing his or her mind is effectively eliminated. Furthermore, it eliminates the author's choice to not authorize any derivative work and isolate the original work as one of a kind. This may be counterproductive to the promotion of new works because

some artists may be further incentivized to create original works due to the availability of the right *not* to produce any sequels. This might be the case if, for instance, an author's artistic vision includes leaving certain portions or aspects of his character's story to the varied imaginations of his readers, or if he hopes that his readers will engage in discussion and speculation as to what happened subsequently. Just as licensing of derivatives is an important economic incentive to the creation of originals, so too will the right *not* to license derivatives sometimes act as an incentive to the creation of originals.¹⁹⁸

By eliminating the option to not license derivative works and maintain the exclusive right, fewer original authors may be compelled to write.

This is a necessary risk, however. Furthermore, this proposal maintains the other exclusive rights which act to incentivize new works. In light of the other incentives artists will continue to create. By considering the intentions of copyright owners, copyright law can also encourage artists to be inspired by past works.

The copyright system calls for a balance between creating incentives for authors, and giving the public access to new works. The Supreme Court concluded, however, that the ultimate goal of copyright law is "to stimulate artistic creativity for the general public good."¹⁹⁹ As it is, copyright law gives greater deference to creating incentives for copyright owners than the need to stimulate artistic output. By considering the intentions of copyright owners with regard to the opportunity to prepare derivative works, the copyright system can prevent copyright owners from stifling future works. If a copyright owner does not see fit to create derivative works, then a copyright owner should not have the exclusive right to do so. The ultimate goal of copyright law is to serve the public.

¹⁹⁷ *Salinger v. Colting*, 607 F.3d 68, 74 (2d Cir. 2010) (citing *Salinger*, 641 F. Supp. 2d at 268). The court explained that while the licensing of derivative works is an economic incentive to produce originals, the right not to license such works may also be an incentive to the production of originals. *Id.*

¹⁹⁸ *Salinger*, 641 F. Supp. 2d at 268.

¹⁹⁹ *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

The public is best served by increased access to new works and fresh perspectives.

2. *Determining the Intentions of Copyright Owners*

It may be impractical to determine the true intentions of a copyright owner because the inquiry is subjective. It would be administratively difficult for the U.S. Copyright Office to follow up on the activity of every copyright owner. Copyright owners may feel compelled to submit false affidavits to renew the right, without any actual intention of following through. Likewise, copyright owners may submit evidence of intentions for derivative works to courts that they actually have no intention of following through with. A multi-factor test would need to be created which considers past activity and current steps towards a derivative work. Ultimately, it would take time to perfect the system, but the result would be beneficial to the public good.

VI. CONCLUSION

In his infinite wisdom J.D. Salinger wrote:

Among other things, you'll find that you're not the first person who was ever confused and frightened and even sickened by human behavior. You're by no means alone on that score, you'll be excited and *stimulated* to know. Many, many men have been just as troubled morally and spiritually as you are right now. Happily, some of them kept records of their troubles. You'll learn from them—if you want to. Just as someday, if you have something to offer, someone will learn something from you. It's a beautiful, reciprocal arrangement. And it isn't education. It's history. It's poetry.²⁰⁰

Alice Randall and Fredrik Colting had something to offer to this “beautiful, reciprocal arrangement.” Unfortunately, the laws of copyright stood in their way. In the case of Colting's *60 Years Later* the public was denied the opportunity to learn something from Colting. In the case of Randall's *The Wind Done Gone*, the public is fortunate that Houghton Mifflin was able to support the high transaction costs of litigation.

The current copyright system is unable to achieve its ultimate goal of serving the public good with new artistic creation, which can contribute to the exchange of ideas. United States copyright law grants too much power and control to authors, particularly in light of the expansive derivative works right.

²⁰⁰ J.D. SALINGER, *THE CATCHER IN THE RYE* 189 (1991).

Both parodies and satires serve important purposes and should be seen as very transformative in the fair use analysis. By removing the distinction between the two, the public will have increased access to works of criticism and commentary.

It is also necessary to consider whether copyright owners intend to prepare derivative works. It is counterproductive to the goal of creating new works to grant copyright owners the exclusive right to prepare derivative works when the owners have no intention of doing so. Creating incentives for original authors to create work is vitally necessary for the promotion of the arts. If copyright law continues to allow authors to prevent other future works, however, without providing his or her own work, then progress is stifled and the copyright system fails. It is time for the United States copyright system to realign with its goals and encourage authors to contribute to the beautiful reciprocal arrangement that benefits the public good.