UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

ENNIO MORRICONE MUSIC INC., Plaintiff,	:	
-v-	:	16-cv-8475 (KBF)
BIXIO MUSIC GROUP LTD., Defendant.	:	OPINION & ORDER

KATHERINE B. FORREST, District Judge:

Plaintiff Ennio Morricone Music Inc. commenced this action on October 31, 2016, seeking a declaratory judgment that it is the sole owner of the copyrights to several film scores and thus under 17 U.S.C. § 203 may terminate an assignment of those copyrights. (ECF No. 1.) Before the Court is plaintiff's motion for summary judgment. (ECF No. 24.) Both parties agree that the principal question to be decided in this matter is one of law: are the film scores at issue "works for hire" under Italian law? (See Joint Prelim. Pre-Trial Statement ("JPPS") (ECF No. 18) at 3.) If so, then plaintiff has no ownership interest in the copyrights and may not terminate them under § 203. For the reasons set forth below, the Court finds that on the undisputed facts, the works in question were specifically commissioned and constitute works for hire. Plaintiff's motion for summary judgment is DENIED; the Court instead GRANTS summary judgment in favor of defendant.

I. BACKGROUND[1]

Ennio Morricone ("Morricone") is the composer of six film scores, and plaintiff is the assignee of his alleged copyrights. (Compl. ¶ 2.) Defendant is a New York corporation which is the assignee of copyrights from Edizioni Musicali Bixio ("Bixio"), an Italian music publishing entity. (Id. ¶ 3.)

In the late 1970s and early 1980s, Morricone and Bixio entered into a number of written agreements (identical in all material respects) requiring Morricone to compose a musical score. (Id. at 3-4; Def.'s Mem. of Law in Opp. to Pl.'s Mot. for Summ. J. ("Mem in Opp.") at 2.) For each of these agreements, Bixio also entered into a contract with a film producer to license the score composed by Morricone for use in a film. (Def.'s Responses to Pl.'s Local Rule 56.1 Statement ("Def.'s 56.1 Statement") at 3.)

Essentially, Bixio was a sort of broker—it acted as a middleman between Morricone and a third-party filmmaker who needed a score for an existing film.[2] Under each contract, Morricone was to compose a score to match a film made by a producer with whom Bixio was also engaged.[3] (JPPS at 2.) Each agreement between Bixio and Morricone "assign[ed] the copyright in the Score to the music publisher so that the music publisher could license the Score to the film producer for use in the film." (Pl.'s Mem. of Law in Supp. of Summ. J. ("Mem. in Supp.") at

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[1] The material facts at issue here are undisputed by either party.
[2] Ennio Morricone notes that this is the "customary model in the Italian film industry," as opposed to the United States's model, in which film producers commission composers directly. (Decl. of Ennio Morricone ¶ 4.)
[3] Disputed, but immaterial here, is how many of those film scores were created by plaintiff alone, or by plaintiff and another person. (See Def.'s 56.1 Statement at 2.)

3.) The contract transferred to Bixio "all the rights of economic use, in any country in the world, with regard to the works." (Pl.'s Local Rule 56.1 Statement ("Pl.'s 56.1 Statement"), Ex. A at 3.) Specifically, Bixio retained the rights to:

> use the works to produce the recordings thereof, which shall be transferred into the film's musical soundtrack; and/or to have the works disseminated along with the film; and/or to have parts thereof disseminated along with parts of the film when presenting the film to the public; and/or to have the works published, to have them reproduced in print, through phonography, and/or with any other reproduction procedure; to execute and perform them, and to disseminate them using any remote broadcasting medium . . .; to place them into the stream of commerce and lease them out; to translate and/or adapt any literary texts into any foreign language and/or to make versions thereof in different dialects; [and] to process, modify, and adapt the musical parts.

(Id.) Bixio also retained the right to transfer its right to use the recordings abroad to a third party, as long as it complied with various notification requirements. (Id. at 10.) The contract required Morricone to meet deadlines as set by the film producer. (Id. at 4.) "As consideration for the transfers" of "the works' exploitation rights" Morricone received: 3,000,000 Italian Lira; the right to a credit in the copies of the film to be screened in Italy and abroad ("Musiche composte e dirette da Ennio Morricone" or "Music composed and conducted by Ennio Morricone"); the right to three hundred copies on phonographic discs; and the right to a portion of the proceeds from use of the scores.[4] (Id. at 5-6.) Over several years, Morricone

[4] "For the right of public execution together with the film, in Italy (so-called DEM Class II)," Morricone received 10/24 of the amount derived from economic use in works without literary text or texts, and 8/24 of the amount derived from economic use in works with literary text or texts. (Id. at 6.) "For the right of public execution together with the film, abroad," Morricone received 12/24 of the amount derived from economic use in works without literary text or texts, and 8/24 of the amount derived from economic use in works with literary text or texts. (Id.) "For the right of public execution separate from the film, in Italy and/or abroad," Morricone received 12/24 of the amount

composed six scores under this type of agreement: Cosi Como Sei, Il Giocatollo, Un Sacco Bello, Bianco Rosso e Verdone, Tragedy of a Ridiculous Man, and Lady of the Camelias. (Def.'s 56.1 Statement at 1-2.)

Similarly, each agreement between Bixio and a film producer granted Bixio the soundtrack as its "absolute property in all Countries of the world with all exploitation rights of any kind whatsoever." (Pl.'s 56.1 Statement, Ex. B at 1; see also id. at 4.) Under the contract, Bixio was obligated to provide and fund the composition bonus, scores and orchestrations, copying of scores, a complete orchestra, rental and transportation of instruments, and other items relevant to creation of the recording. (Id. at 1-2.) As compensation for these expenses, Bixio was to receive "all the revenue derived from the film's public screenings" as well as a film credit and revenue derived from other uses, including television, radio, or wire broadcasts, public performances of detached sections, and recordings. (Id. at 2-3.)

Under a separate agreement with Bixio, defendant became the administrator of the U.S. copyrights in the scores. (JPPS at 2.) Defendant registered a claim with the American Society of Composers, Authors, and Publishers to collect all royalties from the public performance of the scores in the United States. (Id.) In 2012, plaintiff served defendant with a notice terminating the assignment of its copyrights under 17 U.S.C. § 203. (Id.) The parties agree that the principal

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derived from economic use in works without literary text or texts, and 8/24 of the amount derived from economic use in works with literary text or texts. (Id.)

question before the Court is whether the exception in § 203, which prohibits the termination of a copyright assignment by an author when the work was "made for hire," applies to the six scores at issue. (See 17 U.S.C. § 203; see also JPPS at 3; Mem. in Supp. at 2; Mem. in Opp. at 1-2.)

II. PROCEDURAL POSTURE

"In considering a motion for summary judgment, if our analysis reveals that there are no genuine issues of material fact, but that the law is on the side of the non-moving party, we may grant summary judgment in favor of the non-moving party even though it has made no formal cross-motion." Orix Credit Alliance, Inc. v. Horten, 965 F. Supp. 481, 484 (S.D.N.Y. 1997) (citing Int'l Union of Bricklayers v. Gallante, 912 F. Supp. 695, 700 (S.D.N.Y. 1996); see also Coach Leatherware Co. v. AnnTaylor, Inc., 933 F.2d 162, 167 (2d Cir. 1991) ("[I]t is most desirable that the court cut through mere outworn procedural niceties and make the same decision as would have been made had defendant made a cross-motion for summary judgment." (citing Local 33, Int'l Hod Carriers v. Mason Tenders Dist. Council, 291 F.2d 496, 505 (2d Cir. 1961))). "Summary judgment may be granted to the non-moving party in such circumstances so long as the moving party has had an adequate opportunity to come forward with all of its evidence." Id. (citing Cavallaro v. Law Office of Shapiro & Kreisman, 933 F. Supp. 1148, 1152 (E.D.N.Y. 1996)). "Absent some indication that the moving party might otherwise bring forward evidence that would affect the court's summary judgment determination," it is not necessary for

the Court to provide the movant with an opportunity to respond. Coach Leatherware Co., 933 F.2d at 167.

Here, the parties agree that the sole question before the Court is one of law and that summary judgment is appropriate. (See JPPS at 3; Mem. in Support at 2.) Defendants—the non-movants—state that the Court can "award summary judgment to either party." (Mem in Opp. at 5.) Plaintiff has not asserted otherwise.

III. LEGAL PRINCIPLES

A. Summary Judgment Standard

Summary judgment may be granted when, based on admissible evidence in the record, "there is no genuine dispute as to any material fact and the [parties are] entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). The Court's function on summary judgment is to determine whether there exist any genuine issues of material fact to be tried, not to resolve any factual disputes. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248-49 (1986).

B. Choice of Law

"Works made for hire"—the definition of which is at issue in this case—are defined differently in Italy and the United States. When there is a conflict of laws in a property ownership dispute, the Court must apply "the law of the state with the most significant relationship to the property and parties." Itar-Tass Russian News Agency v. Russian Kurier, 153 F.3d 82, 90 (2d Cir. 1998) (internal quotation omitted); see also Eli Lilly Do Brasil v. Fed. Express Corp., 502 F.3d 78, 81 (2d Cir. 2007) ("In general, "[t]he federal common law choice-of-law rule is to apply the law

of the jurisdiction having the greatest interest in the litigation." (citing In re Koreag, Controle et Revision S.A., 961 F.2d 341, 350 (2d Cir. 1992))). When the works at issue were created by a country's nationals and first published in that country, the Court applies the laws of that country. Itar-Tass Russian News Agency, 153 F.3d at 90.

In determining a foreign country's law, the Court may weigh the "persuasive force" of the parties' experts' opinions, rather than their credibility. Id. at 92; see also Fed. R. Civ. P. 44.1 ("In determining foreign law, the court may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence. The Court's determination must be treated as a ruling on a question of law."). Rule 44.1 has "two purposes: (1) to make a court's determination of foreign law a matter of law rather than fact, and (2) to relax the evidentiary standard and to create a uniform procedure for interpreting foreign law." In re Vitamin C Antitrust Litigation, 837 F.3d 175 (2d Cir. 2016); see also Rationis Enterprises Inc. v. Hyundai Mipo Dockyard Co., 426 F.3d 580, 585 (2d Cir. 2005).

C. Copyright Assignment and Works for Hire

For most artistic works, the Copyright Act of 1976 (the "Act") provides that ownership vests initially in the author of the work. 17 U.S.C. § 201(a). "As a general rule, the author is the party who actually creates the work," but "[t]he Act carves out an important exception . . . for 'works made for hire.'" Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 737 (1989). "If the work is for hire, 'the

employer or other person for whom the work was prepared is considered the author' and owns the copyright, unless there is a written agreement to the contrary." Id. (quoting 17 U.S.C. § 201(b)). As such, § 203 of the Act, which protects an author's right to terminate a prior assignment of a copyright, does not cover works for hire: authors of works for hire have no such termination rights. 17 U.S.C. § 203(a).

Thus, the definition of a "work for hire" under Italian law is crucial. Each party submitted an expert declaration to clarify the application of Italian intellectual property law to the facts presented in this case. They offer opposing conclusions as to whether the six scores at issue are works for hire under Italian law, but plaintiff's expert does not sufficiently contradict the underlying legal principles put forth by defendant's expert. In contrast, defendant's expert specifically and persuasively refutes plaintiff's statement of the law.

Professor Rescigno, defendant's expert, maintains that a score may be classified as a work for hire under Italian law when: (1) there is a contract between a film producer and a music publisher that confers the exclusive ownership of the soundtrack, as well as the role of music producer, onto the publisher; (2) there is a contract between the publisher and the author which commissions a soundtrack to follow the film's "visual track," as well as instructions and deadlines set by the client; (3) these two contracts lay out requirements concerning the "procedures and time-limits for the production and delivery of the works . . . and set the term of the exclusive rights and limits imposed on the composer"; and (4) the publisher and the film producer retain the right to decide not to use the soundtrack produced, or to

use only part of it, and the composer receives a "fixed price." (Decl. of Barry I. Slotnick in Opp. to Pl.'s Mot. for Summ. J., Ex. B ("Rescigno Decl.") at 5-8.)

Additionally, because Italian law does not provide a specific definition of a "work for hire," Rescigno likens the concept to a "commissioned" work—a term with legal significance in Italy. (Slotnick Decl., Ex. C ("Rescigno Reply") at 7.) He explains that when one arrangement exists between a film producer and a publisher and a related agreement is formed by the publisher and a composer, once the work "has been commissioned by the publisher and realized by the author, the publisher acquires full title to it . . . ." (Id. at 2.) A commissioned work is

> a new production that has been commissioned and expressly intended to serve a main purpose, that is, that of supporting a motion picture, to which the musical publisher . . . has directly acquired exclusive full rights by virtue of the contract for the commissioning of the production and distribution of the soundtrack for the film to be produced. (Id.)

In other words, a work is "commissioned" under Italian law, according to Rescigno, if it was created in response to an "order" from a publisher or producer, and if the contract governing its creation assigns full rights to the publisher or producer who requested the work. (Id.) On the other hand, no commission has occurred if the author completes the work before it is requested or used by a music publisher or film producer. (Id.) "The distinction between the commissioning of an original soundtrack and the use of a pre-existing work of music as the soundtrack to a film determines different types of existing contracts." (Id.)[5] He concludes that, because

[5] American law "confers work-for-hire status on a work where 'the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.'" Warren v. Fox Family Worldwide, Inc., 328 F.3d 1136, 1140 (9th Cir. 2003) (citing 17 U.S.C. § 101); see also Estate of Burne Hogarth v. Edgar Rice Burroughs, Inc., 342 F.3d 149, 162 (2d Cir. 2003) ("[A]s to

Morricone composed the six scores in question after being specifically contracted to do so by Bixio, the scores are "commissioned" under Italian law. (Id.)

Plaintiff's expert, Professor Ricolfi, agrees that Italian law applies to the question before the Court. (Decl. of Pl. Expert Dr. Marco Ricolfi ("Ricolfi Decl.") ¶ 6.) Ricolfi states that ownership of a copyright vests in an original creator, but agrees that it may be transferred; either way, he says, creators always retain rights to "separate compensation" and moral rights such as a right to a credit and a say in adaptions to the score. (Id. ¶¶ 7-9.) From this, Ricolfi concludes that Italian law "rules out in principle" that a composer's work can ever be a "work for hire." (Id. ¶ 10.) Notably, he agrees that, on the facts here, the works were "commissioned" under Italian law. (See, e.g., id. ¶ 7 (discussing work-for-hire doctrine as it relates to corporate entities "commissioning" works); id. ¶ 19 (however, arguing that the fact that a work has been "commissioned" does not necessarily indicate it is a work for hire).) And while he focuses on the retained rights of attribution and certain compensation, he does not dispute the works' status as commissioned.

Ricolfi further states that the "only implication" of a work being commissioned is that the rights to that work "are automatically transferred" to the producer or publisher "when it comes into existence." (Id.) Though he then argues, without legal rationale, that this does not mean the "transferees" are the "initial

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commissioned works, courts of appeals 'generally presumed that the commissioned party had impliedly agreed to convey the copyright, along with the work itself, to the hiring party.'" (quoting Cmty. for Creative Non-Violence, 490 U.S. at 749)).

owners." (Id.) This contradiction aside, Ricolfi provides no specific support for his allegations that the scores at issue were not works for hire.

IV. ANALYSIS

In order to decide whether the plaintiff has termination rights under 17 U.S.C. § 203, the Court must determine whether the works in question were "works for hire" such that their creator may not terminate the assignment.

A. Choice of Law

The parties agree that Italian law applies to the definition of "work for hire" in this context. (See JPPS at 2; Mem. in Supp. at 5, 20; Mem. in Opp. at 7-12.) They are correct—the contracts at issue were formed in Italy by Italian nationals, so Italy is the jurisdiction with the most significant connection to this dispute. (Slotnick Decl., Ex. C at 3.) As such, this Court evaluates whether the six scores at issue are "works for hire" under Italian law.[6]

B. Works for Hire

The six musical scores at issue here are indeed commissioned works under Italian law as defined by Rescigno; the legal effect is the same as the American equivalent of work for hire. Thus, plaintiff's purported termination of the copyright assignment has no legal effect.[7] First, the initial contracts between Bixio and the

[6] Additionally, it is worth noting that the Rome Convention, which sets out rules for resolving conflicts of law, does not apply here because there is no actual conflict of laws in this matter.
[7] Plaintiff and defendant stipulate that the contracts for each of the six scores were identical in all material respects. (Pl.'s 56.1 Statement ¶ 6; Def.'s 56.1 Statement ¶ 6; Mem. in Opp. at 2.) An example of a film producer-publisher contract and a producer-composer contract were submitted to the court by plaintiff and were not challenged by defendant in any way. (Pl.'s 56.1 Statement, Exs. A, B.)

film producers confer ownership of the score and the role of music producer on Bixio. The contracts each require Bixio—the "publisher"—to "produce the musical soundtrack" and state that the soundtrack "will be the Publisher's absolute property in all Countries of the world with all exploitation rights of any kind whatsoever." (Pl.'s Local Rule 56.1 Statement, Ex. B, at 1.)

Second, the contract between Morricone and Bixio commissions a score to match an existing film, and it lists instructions and deadlines that Morricone was to abide by. The contract specifies a film and "entrust[s]" plaintiff with "assignments" including "composing the original musical score of said film," "musically arranging said music," and "conducting the orchestra that will play the film's musical score." (Pl.'s 56.1 Statement, Ex. A, at 1.) Under the contract, Bixio also retained the exclusive right to "use the works to produce the recordings thereof." (Id. at 3.) Additionally, the agreement requires Morricone to meet deadlines set by the film's producer. (Id. at 4.)

Third, the contract provides Morricone with "procedures and time-limits" for producing the score, such as requiring that the recordings "take place in the city of Rome, in the studios and on the dates that . . . shall be set by reciprocal agreement by and between us, also in consultation with the film's producer." (Id. at 4.) Most significantly, the contract explicitly requires Morricone to "grant and transfer to [Bixio], exclusively, for the maximum total duration permitted by the laws in force in each country in the world, . . . all the rights of economic use, in any country in the world, with regard to the works." (Id. at 3.) The contract grants Bixio the exclusive

rights to "have the works [or parts of the works] disseminated along with the film," to have the works published or reproduced, and to generally place them into the "stream of commerce." (Id.)

Finally, the contract implicitly reserves the right of Bixio and the film producer to choose not to use the score created by Morricone without incurring liability. While no provision states this explicitly, the agreement states that plaintiff receives 3,000,000 Italian Lira as consideration, in addition to credits and a percentage of amounts derived from future economic use of the works. (Id. 5-6.) Ostensibly, Morricone would have received the 3,000,000 Italian Lira whether or not Bixio and the producers decided to use the various compositions.

The Court finds Rescigno's explanation of Italian law more persuasive than Ricolfi's. See Itar-Tass Russian News Agency, 153 F.3d at 92. Ricolfi argues that Italian law "rules out in principle that the work of a Composer may be considered a work for hire in the meaning adopted by the U.S. legal system."[8] (Ricolfi Decl. ¶ 10.) However, while the Italian copyright laws referred to by Ricolfi do typically grant the original copyright to a work to its creator, Rescigno explains that this does not prevent the assignment of those rights—an assignment which took place under each agreement between Morricone and Bixio. (Rescigno Reply at 4.) Ricolfi does not substantiate his opinion that a score cannot be a "work for hire"; and Rescigno claims Article 2222 of the Italian Civil Code directly covers this type of agreement

[8] However, later in his declaration, Ricolfi states that "Italian law applies the Rome Convention in conflict of laws situations," and goes on to analyze the American law definition of "works for hire." (Ricolfi Decl. ¶¶ 11-13.) This inconsistency notwithstanding, the parties have agreed in numerous filings that the Italian definition of "work for hire" is the operative one here.

as an "independent labour contract" under which "one of the parties undertakes to render to . . . the other party (against payment of a consideration) a service or work (not yet existing)." (Id. at 7.)

As further evidence that Italy does not recognize a "work for hire," Ricolfi argues that Italian copyright law mandates that certain moral rights always remain with a work's creator, even after ownership of the work is transferred. (Ricolfi Decl. ¶ 19.) But moral rights are irrelevant. Economic exploitation rights—the only rights at issue in this case—are separate from moral rights relating to an artistic composition. (Rescigno Reply at 7.) There is no contention here that Morricone has lost his moral rights. And Rescgino points out that Italian law must recognize a "work for hire" doctrine, as "articles 12 bis, 12 ter., 38, 45, 88 and 89 of the [Italian] Copyright Law" demonstrate that copyrights can vest with persons other than the original creator. (Id. at 5 (alteration in original).)

Additionally, applying the definition of "commissioned" that Rescigno offers as an Italian corollary to the American understanding of "work for hire," the six scores at issue clearly qualify. The scores were produced pursuant to contracts with a music publisher, and they were meant to serve as soundtracks for films that had already been created. (See Pl.'s 56.1 Statement, Ex. A at 1-2.) Additionally, the publisher (Bixio) acquired exclusive rights to the works under the agreements. (See id. at 3.)

Ultimately, Rescigno's well-reasoned analysis, combined with the text of the example contracts submitted to the Court by plaintiff, indicates that the six scores

created by Morricone were, in fact, works for hire as defined by Italian law. Defendant is thus the owner of the copyrights of the six scores. As such—and as the parties agree—17 U.S.C. § 203 prevents plaintiff's termination of the assignment of those rights.

V. CONCLUSION

For the foregoing reasons, the Court GRANTS summary judgment in favor of defendant, as the six scores at issue are in fact "works for hire" under Italian law. The Court of Clerk is directed to terminate the motion at ECF No. 24 and to close this action.

SO ORDERED.

Dated: New York, New York
October 6, 2017

KATHERINE B. FORREST
United States District Judge