

1 UNITED STATES COURT OF APPEALS  
2 FOR THE SECOND CIRCUIT

3  
4 SUMMARY ORDER  
5

6 **Rulings by summary order do not have precedential effect. Citation to a**  
7 **summary order filed on or after January 1, 2007, is permitted and is**  
8 **governed by Federal Rule of Appellate Procedure 32.1 and this Court’s Local**  
9 **Rule 32.1.1. When citing a summary order in a document filed with this**  
10 **Court, a party must cite either the Federal Appendix or an electronic**  
11 **database (with the notation “Summary Order”). A party citing a summary**  
12 **order must serve a copy of it on any party not represented by counsel.**  
13

14 At a stated term of the United States Court of Appeals for the Second Circuit,  
15 held at the Thurgood Marshall United States Courthouse, 40 Foley Square, in the  
16 City of New York, on the 23<sup>rd</sup> day of August, two thousand and eighteen.  
17

18 Present:

19 ROBERT D. SACK,  
20 PETER W. HALL,  
21 CHRISTOPHER F. DRONEY  
22 *Circuit Judges.*  
23

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24 Creazioni Artistiche Musicali, S.r.l.,  
25

26 *Plaintiff-Appellant,*  
27

28 v.  
29

17-266-cv

30 Carlin Am., Inc., Edward B. Marks Music  
31 Company,  
32

33 *Defendants-Appellees,*  
34

35 John Does 1-10,  
36

37 *Defendants.*  
38  
39  
40

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1 *For Plaintiff-Appellant:* Robert W. Clarida (Brett Van Benthysen, *on the*  
2 *brief*), Reitler Kailas & Rosenblatt LLC, New York,  
3 NY.

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5 *For Defendants-Appellees:* Eric C. Osterberg, Osterberg LLC, Boston, MA.  
6

7 Appeal from a final judgment and decision entered December 30, 2016, in the  
8 United States District Court for the Southern District of New York (Sullivan, *J.*).

9 **UPON DUE CONSIDERATION, IT IS HEREBY ORDERED,**  
10 **ADJUDGED, AND DECREED** that the district court's decision and judgment are  
11 **AFFIRMED.**\*

12 Creazioni Artistiche Musicali, S.r.l. ("CAM") brings a copyright-infringement  
13 action against the defendants-appellees, Carlin America, Inc. and Edward B. Marks  
14 Music Company, pursuant to the United States Copyright Act, 17 U.S.C. § 106. CAM  
15 alleges that in a written agreement executed on October 4, 1966, in Rome, Italy (the  
16 "1966 Agreement"), it obtained copyrights in two works ("Instrumental" and "Vocal")  
17 written in 1966 by the Italian composer Piero Umiliani. CAM claims that the  
18 defendants infringed these copyrights by granting licenses to a third work by  
19 Umiliani in 1968, "Mah Na Mah Na," to third parties. Specifically, CAM contends  
20 that "Mah Na Mah Na" is an unauthorized derivative work based on Instrumental  
21 and Vocal.

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\* Appellant's motion for judicial notice is denied as moot, as the documents we have been asked to take judicial notice of are not material to this decision.

1           The district court granted the defendants' motion to dismiss, concluding that  
2 CAM lacked standing to bring suit against the defendants for copyright infringement  
3 because the 1966 Agreement, as interpreted under Italian law, did not give CAM the  
4 exclusive right to create and exploit derivative works of Instrumental and Vocal. *See*  
5 *Creazioni Artistiche Musicali, S.r.l. v. Carlin Am., Inc.*, No. 14-cv-9270, 2016 WL  
6 7507757, 2016 U.S. Dist. LEXIS 180431 (S.D.N.Y. Dec. 30, 2016). CAM timely  
7 appealed the district court's judgment of dismissal. We assume the parties'  
8 familiarity with the underlying facts, the procedural history, the arguments  
9 presented on appeal, and the district court's ruling, which we reference only to  
10 explain our decision.

11           "We review *de novo* a [district court's] decision as to a plaintiff's standing to  
12 sue based on the allegations of the complaint and the undisputed facts evidenced in  
13 the record." *Rajamin v. Deutsche Bank Nat'l Trust Co.*, 757 F.3d 79, 84–85 (2d Cir.  
14 2014). Under Federal Rule of Civil Procedure 44.1, a court's determination of foreign  
15 law "must be treated as a ruling on a question of law," Fed. R. Civ. P. 44.1, and is  
16 therefore subject to *de novo* review. *See Curley v. AMR Corp.*, 153 F.3d 5, 11 (2d Cir.  
17 1998). To that end, "appellate courts, as well as trial courts, may find and apply  
18 foreign law," *id.* at 12, and "may consider any relevant material or source, including  
19 the legal authorities supplied by the parties on appeal as well as those authorities  
20 presented to the district court," *Carlisle Ventures, Inc. v. Banco Español de Crédito,*  
21 *S.A.*, 176 F.3d 601, 604 (2d Cir. 1999).

1           The Copyright Act's standing test, 17 U.S.C. § 501(b), "accords standing only  
2 to the legal or beneficial owner of an 'exclusive right.'" *Itar-Tass Russ. News Agency*  
3 *v. Russ. Kurier, Inc.*, 153 F.3d 82, 91 (2d Cir. 1998). Umiliani transferred rights to  
4 his music, including Instrumental and Vocal, to CAM in the 1966 Agreement, but the  
5 parties dispute whether Umiliani granted CAM the exclusive right to exploit  
6 derivative versions of his works. In resolving this dispute, the district court identified  
7 choice-of-law as a threshold issue and determined that Italian, rather than American,  
8 law applies to determine the scope of Umiliani's transfer in the 1966 Agreement.  
9 *Creazioni Artistiche Musicali*, 2016 WL 7507757, at \*3–5, 2016 U.S. Dist. LEXIS  
10 180431, at \*6–13. CAM contends that this was error and that American law applies  
11 instead. Appellant Br. at 13–16. We need not reach this choice-of-law issue, however,  
12 because the result is the same regardless of whether the 1966 Agreement is construed  
13 according to Italian or American law.†

14           Both Italian and American law require a clear expression of intent for an  
15 author to transfer full ownership of copyrights in his or her works. Under the 1909  
16 Copyright Act, which was in effect at the time the 1966 Agreement was made, "a  
17 transfer of anything less than the totality of rights commanded by copyright was

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† The district court noted that we have not yet established a principle for choice-of-law issues concerning voluntary assignment of copyright. *Creazioni Artistiche Musicali*, 2016 WL 7507757, at \*3, 2016 U.S. Dist. LEXIS 180431, at \*8–9. We decline to establish such a principle here because the result of the overall standing issue is the same under either Italian or American law. We also note that the issue of the applicable choice-of-law principle for copyright assignment was not thoroughly briefed on appeal.

1 automatically a license rather than an assignment of the copyright." *P.C. Films Corp.*  
2 *v. MGM/UA Home Video Inc.*, 138 F.3d 453, 456 (2d Cir. 1998); *see also Warner Bros.*  
3 *Pictures, Inc. v. Columbia Broadcasting Sys.*, 216 F.2d 945, 949 (9th Cir. 1954) ("The  
4 clearest language is necessary to divest the author of the fruits of his labor." (internal  
5 quotation marks omitted)).

6 Similarly, although the Italian Copyright Act provides that the economic rights  
7 of authors "may be acquired, alienated or transferred under all methods and forms  
8 allowed by law," Art. 107, Italian Copyright Act, App'x at 157, the "narrow  
9 construction of copyright transfers . . . applies, as a matter of principle, to any  
10 contractual transfer of interests from the author to another party," Alberto Musso &  
11 Mario Fabiana, *Italy* §§ 4(3)(a)(ii), 4(3)(b)(i), in *International Copyright Law and*  
12 *Practice* (Paul Edward Geller & Lionel Bentley, eds. 2013). Indeed, the exclusive  
13 rights stemming from copyright ownership "are independent of one another," Art. 19,  
14 Italian Copyright Act, App'x at 136, so "the contractual grant of one such right does  
15 not necessarily include the grant of the exclusive exercise of each of the other rights"  
16 and "any total assignment of all the economic components of copyright must be  
17 expressly agreed to," Musso & Fabiani, *Italy* § 4(2)(a).

18 We conclude that the 1966 Agreement lacks the clear expression of intent  
19 necessary to transfer full ownership of Instrumental and Vocal to CAM, which  
20 necessarily includes the right to create and exploit derivative works. The second  
21 paragraph of the 1966 Agreement defines the scope of Umiliani's transfer to CAM:

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