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Sheppard Mullin lawyers win trademark case for TV client

By Joshua Sebold
Daily Journal Staff Writer

A team of California attorneys defeated trademark infringement claims brought against a British television producer by a technology company in the Southern District of New York.

Codename Enterprises Inc. contended that Fremantlemedia North America Inc.'s defunct Buzzr channel, which provided archival footage of classic game shows, infringed on the trademarked website creation tool owned by Codename, also called Buzzr.

Jill Pietrini and her team at Sheppard, Mullin, Richter & Hampton LLP convinced U.S. District Judge Analisa Torres that the two products had nothing in common and that Codename couldn't prove that the brand recognition for its website creation tool had suffered because of the defendant's use of the term.

Pietrini contended that the two companies' use of the word Buzzr

had completely different connotations. She told the court the website creation tool used the word to connote that a company could generate a "buzz" around their product with a new website, while the game show channel was specifically referring to buzzers typically used on game shows.

Torres wrote that those arguments were compelling but added in her order earlier in January that Codename's branding efforts for its website creation tool weren't very successful to begin with, weakening the strength of its trademark.

"All factors suggest that plaintiff's mark is in fact weak," she wrote. "Plaintiff has invested little in building association in the minds of consumers between the Buzzr mark and plaintiff."

Torres also wrote that the plaintiffs didn't provide any proof that the defendant played a role in diminishing the web design company's brand. *Codename Enterprises Inc. v. Fremantlemedia North America Inc.*, 16-CV1267 (S.D.

N.Y., filed Feb. 18, 2016).

"Even assuming that plaintiff's mark dropped in search results over time, plaintiff nevertheless fails to present admissible evidence that defendant was the cause of such a drop."

Ronald D. Coleman, an attorney with Mandelbaum Salsburg PC who represented Codename, said he was disappointed with the ruling.

"Unfortunately, courts are still applying 1950s judicial conceptions of how trademark rights are established to 21st century markets, technology and consumer sensibility," he wrote in an emailed statement. "As a result, if a major media or fashion company wants to use a trademark — registered or otherwise — that belongs to a startup, the courts will seldom get in the way."

Pietrini referred a request for comment to her client. Representatives for Fremantlemedia did not respond.

joshua_sebold@dailyjournal.com