



Mark S. Puzella

Partner

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Practice Areas

- Copyright, Trademark & False Advertising
- Intellectual Property
- U.S. International Trade Commission
- Trials

Education

- J.D., Northeastern University School of Law, 1999
- B.A., Wesleyan University, 1994

Memberships

- International Trademark Association
- Media Law Resource Center
- Massachusetts Bar Association
- Boston Bar Association
- American Bar Association

Trademark and copyright litigator Mark Puzella protects some of the world's most powerful brands and emerging technologies. Clients rely on his ability to anticipate and resolve problems before they arise, whether developing comprehensive strategies to avoid litigation where possible, or succeeding in litigation when necessary.

As a trial lawyer, Mark excels at handling accelerated, complex cases. For example, as lead counsel for New Balance, Mark won a swift six-month International Trade Commission (ITC) investigation concerning claims of trade dress infringement. The ITC ruled in favor of his client, finding that the plaintiff had no rights in the claimed design. And, as lead plaintiff counsel for Explorica in a trademark case, he won a jury verdict just ten weeks after filing the complaint. During that short span, the parties engaged in complete discovery, including taking and defending numerous fact and expert depositions. Clients routinely ask him to take over matters at the close of discovery or prior to trial, which presents unique challenges and time constraints.

He is also skilled at explaining complex concepts and technology to judges and juries in a persuasive, intelligible style. In the high-profile Supreme Court case *ABC v. Aereo*, he led the trial and appellate team's presentation of the key technology. That presentation was the basis of the trial court's denial of a preliminary injunction, and the Second Circuit's affirmation of that decision.

Mark draws upon his litigation experience to help clients anticipate and avoid legal issues related to new technologies and brands. For example, Mark has advised numerous technology and media companies on the creation, use, and delivery of content and helped clients assess whether their products will withstand investor and competitor scrutiny. He also has significant experience advising on branding and re-branding projects, including private brand or store brand clearance and risk assessments.

Mark's exceptional record has earned him praise as a problem solver from client and peer surveys. *World Trademark Review 1000* has called him "intelligent, thoughtful and client-oriented" and "incredibly impressive." *Legal 500* has described him as a "smart, creative" trial lawyer who "anticipates everything." And in 2016, *IP Law360* named two of his cases among the top ten trademark decisions of the year. However, Mark's greatest accomplishment lies with his client relationships. At every turn, in every case, Mark's clients know their problems are his problems and that his ultimate

focus is helping them grow their businesses.

The World Trademark Review WTR 1000, a peer and client surveyed listing, has identified Mark as a leading practitioner for trademark litigation ten years in a row (2011-2020). *WTR 1000* has characterized Mark's work as "incredibly impressive" and further praised him as "highly recommended" for court room work. Clients turn to Mark because he is "intelligent, thoughtful and client-oriented" and one who can "expertly parse through substantial volumes of information to quickly identify the crux of the matter." In 2015, Mark was identified as a "force to be reckoned with" and won "plaudits for his narrative skills before a jury, thanks to his instincts for the best way to present a case." More recently, the 2018 edition acknowledged him as a "truly superb" and "first-class" practitioner. He and fellow Orrick partner David Hosp were praised by their clients for being "far and away the most knowledgeable, hard-working and talented attorneys [they] have ever encountered."

The Legal 500, another peer and client surveyed listing, has also repeatedly identified Mark as a leading trademark litigator. He is identified as a "notable practitioner" who is "smart, creative, and anticipate[s] everything." He "has a quick grasp on trademark law and procedure" and "can be the 'brains' behind a team effort."

Mark is also recognized by *The Legal 500* as a "Recommended Lawyer" (2020), noted as an "IP Star" by *Managing Intellectual Property* magazine (2014 - 2019), listed in the 2019 "The Best Lawyer's in America" List by Best Lawyers, included in the "IP Strategy 300" by IAM, and identified by the *World Trademark Review* as a "Global Leader."

Representative Engagements

Mark's work includes representing:

- The world's largest retailer in product clearance matters and in the prosecution and defense of trademark and unfair competition claims at trial and on appeal nationwide.
- Mahindra & Mahindra in an ITC investigation concerning trademark and trade dress claims brought by FCA US LLC related to the Jeep Wrangler.
- Locast, an over-the-air broadcast platform, in copyright litigation brought by the major television networks.
- New Balance in a purported class action concerning "Made in the USA" marketing.
- New Balance in an ITC investigation concerning trade dress claims related to Converse's "Chuck Taylor All-Star" footwear.
- Sazerac, a leading spirits company, in various trademark and trade dress matters.
- Samsung in a trademark litigation related to its use of MILK in connection with a streaming music application.
- Microsoft in a copyright litigation brought by Getty Images concerning the Bing Image Widget.
- RTIC in trademark and trade dress litigations brought by Yeti concerning coolers and drinkware.
- Aereo, a remote antenna and RS-DVR technology platform provider, in multi-district copyright litigation brought by the major television networks.
- Monotype Imaging, Linotype, International Typeface Corporation, and Bitstream in connection with trademark and

copyright issues, including royalty disputes with licensees of their font software.

- Cabelvision in copyright litigation concerning its RS-DVR technology brought by the major television networks.
- Houghton Mifflin Harcourt and The Learning Company in trademark litigation concerning the mark OREGON TRAIL in connection with video games.
- The New York Times and the Boston Globe in copyright and trademark litigation concerning the use of third-party ledes and hyperlinks.
- Salvator Mundi LLC, the owners of a “lost” DaVinci painting, concerning copyright claims related to photographs of the restored work.
- Explorica, Inc., a market leader in educational travel, in several matters, including as lead counsel in a trademark infringement trial against a competitor that rebranded as EXPLORITAS.

Publications

- Co-author, “Destroying the AD-and-Marketing Budget is the Worst Thing A Company Could Do To It’s Brand During the Pandemic,” *Morningstar* (May 2020)

Speeches and Programs

- “Empirical Surveys in Trademark and Advertising Cases,” McCarthy Symposium: Trademark Law and its Challenges (February 23, 2018).
- “Empirical issues in Trademark Law,” McCarthy Symposium: Trademark Law and its Challenges (February 17, 2017).
- “Trademark Litigation 2016: Practical Strategies,” *World Trademark Review* (April 21, 2016).
- “TrademarkLaw Update in the US: An In-Depth Review of Case Law and TTAB Decision,” McCarthy, Microsoft, and INTA Symposium, Trademark Law and Its Challenges (September 26, 2015).
- “Investigation and Enforcement Strategies to Counter Evolving Threats to Your Brand and Product,” Consero Brand Protection & Anti-Counterfeiting Executive Roundtable (July 25, 2014).
- Intellectual Property IQ: A Workshop For Artists, Developers, And Entrepreneurs,” SXSW Interactive (March 11, 2014).

Admissions

- Massachusetts

Court Admissions

- **United States District Courts** | District of Massachusetts
- **United States District Courts** | Eastern District of Michigan
- **United States District Courts** | Western District of Michigan
- **United States District Courts** | Northern District of New York
- **United States Courts of Appeals** | First Circuit
- **United States Courts of Appeals** | Second Circuit
- **United States Courts of Appeals** | Fourth Circuit
- **United States Courts of Appeals** | Sixth Circuit
- Supreme Court of the United States

