

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Charles Hugo, an individual

Petitioner,

vs.

PW Holdings, LLC, a Delaware limited
liability company,

Respondent.

Cancellation No.:

Registration No. 6598717
Mark: THE NEPTUNES
Date of Issue: December 21, 2021

Registration No. 7164541
Mark: THE NEPTUNES
Date of Issue: September 12, 2023

PETITION FOR CANCELLATION

1. Petitioner Charles Hugo p/k/a “Chad Hugo” (“Petitioner”) is an individual who is a citizen of the United States and a resident of Virginia Beach, VA. Petitioner also is a general partner in the general partnership, The Neptunes (the “General Partnership”), which consists of Petitioner and Pharrell Williams (“Williams”) as equal owners, and which owns/holds/controls the assets belonging to the world-famous music producing duo consisting of Petitioner and Pharrell Williams.

2. Petitioner believes that he is being and will be damaged by the trademark Registration Nos. 6598717 and 7164541 THE NEPTUNES held by PW IP Holdings, LLC (“Respondent”) and seeks cancellation of such registrations on the following grounds:

a. Petitioner is the rightful fifty percent (50%) co-owner of the marks covered by Registration Nos. 6598717 and 7164541 (the “Trademarks”) yet Respondent has failed to designate him as co-owner;

b. In the alternative, the Trademarks are owned by the General Partnership and the Respondent has failed to designate the General Partnership as the owner.

c. Respondent has acted fraudulently and in bad faith by filing the trademark applications without including Petitioner as co-owner or without designating the General Partner as the owner;

d. Pursuant to Section 2(a) of the Lanham Act, Respondent's applications are so confusingly similar to the mark co-owned by Petitioner with Williams that it creates a false suggestion of connection to Petitioner and to the General Partnership; and,

e. Respondent's registrations will dilute Petitioner's rights in the famous mark co-owned by Petitioner and Williams, or otherwise owned by the General Partnership.

3. Petitioner is informed and believes and thereon alleges that Respondent PW IP Holdings, LLC is a Delaware limited liability company with an address of 15 East 26th Street, Suite 602, New York, New York 10010. Petitioner is further informed and believes that Respondent is wholly-owned and controlled by Williams.

I. Registrations Subject to Cancellation:

4. Respondent's Registration 6598717 is for the word mark THE NEPTUNES in Class 9 for "Musical sound recordings; audio-visual recordings, namely, compact discs, phonograph records and downloadable MP3 files, all featuring music; downloadable musical sound recordings; downloadable music via the Internet and wireless devices." The date of first use is alleged to be August 19, 2003, and the specimen submitted by Respondent on August 26, 2021 shows an image of Petitioner and Pharrell Williams. The mark registered on December 21, 2021.

5. Respondent's Registration 7164541 is for the word mark THE NEPTUNES in Class 9 for "Audio-visual recordings, namely, audio cassettes, CD-ROMs, video discs, DVDs and laser discs, all featuring music and soundtracks." The date of first use is alleged to be August 19, 2003, and the specimen submitted by Respondent on January 6, 2023 shows an image of Petitioner and Williams. Notably, the original specimen submitted by Respondent on May 3, 2022, which was subsequently rejected, only shows an image of Williams but the actual Spotify

webpage has images of both Petitioner and Williams. The mark registered on September 12, 2023.

6. Each of these registrations should have identified Petitioner as a co-owner or otherwise identified the General Partnership as the owner.

7. Respondent's failure to do so reflects and intentional effort to mislead the U.S.P.T.O. and injure Petitioner.

8. In addition, Petitioner is the rightful co-owner of any and all other applications and registrations filed by Respondent in connection with the mark THE NEPTUNES.

II. Respondent's Other Applications Show a Pattern of Bad Faith Actions.

9. Petitioner is informed and believes and based thereon alleges that Respondent has engaged in this pattern and practice of filing applications and securing registrations for the mark THE NEPTUNES without including Petitioner as a co-owner or designating the general partnership of which both Petitioner and Williams are equal partners as the owner.

a. For example, Respondent's Application Serial No. 97655357 is for the word mark THE NEPTUNES in Class 38 for "Streaming of music, audio, images, video and other multimedia content over the internet, wireless networks and other computer networks and electronic communications networks; electronic transmission of streamed and downloadable music, audio, video and other multimedia content for others; broadcasting and electronic transmission of streamed and downloadable digital music, audio, video and multimedia content for others; webcasting services; providing online chat rooms, online electronic bulletin boards and online community forums for the transmission of information and messages between users, in the field of entertainment, music, concerts, news and cultural events; providing access to websites and databases on the internet that present artists, music albums, songs and entertainment services in the nature of music, current events and entertainment news and that allow customers to program audio, text, video and other multimedia content, including music, concerts, news, cultural events, and entertainment-related programs on a website and in mobile

applications; broadcasting of cable television, television and radio programs; text and numeric wireless digital messaging services; providing e-mail transmission services; providing instant messaging services; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest; video streaming services via the internet, featuring independent films and movies; telecommunications services, namely, the transfer of data by telecommunication.” Respondent fails to identify or include Petitioner as an owner in the application. This application is the subject of an Opposition proceeding filed March 26, 2024.

b. Similarly, Respondent’s Application Serial No. 97655382 is for the word mark THE NEPTUNES in Class 41 for “Entertainment in the nature of live performances by a musical artist, musical group and musical band; entertainment in the nature of live visual and audio performances by a musical artist, musical group, and musical band; entertainment, namely, live music concerts; entertainment, namely, personal appearances by a musician, musical group, musical band, entertainer, actor, and celebrity; record production; music production; audio recording and production; videotape production; motion picture song production; production of video discs for others; recording studios; entertainment services, namely, producing musical audio and video programs; music composition and transcription for others; song writing services; music publishing services; entertainment services, namely, providing a website featuring non-downloadable videos featuring musical performances, musical videos, video film clips, and photographs in the fields of entertainment, music, music videos, musical artists, poetry, dance and art; entertainment services, namely, providing non-downloadable prerecorded music, information in the field of music, commentary and articles about music, all online via a global computer network; providing a web site that features information on music, entertainment, television, film, games, and the arts; production of television and radio programs; radio entertainment production; motion picture film

production; entertainment in the nature of on-going television, cable television and radio programs featuring music, beauty, fashion, modeling, comedy, dramatic acts, and spoken word poetry; presentation of a variety show distributed over television, cable television, radio, satellite, audio and video media; entertainment, namely, a continuing variety and musical show broadcast over television, satellite, the internet, audio and video media; entertainment in the nature of theater production; entertainment in the nature of traveling tours, namely, live musical, dramatic, and spoken word poetry performances; entertainment services, namely, providing an on-line computer game; amusement parks and centers; amusement arcades; children's entertainment and amusement centers, namely, interactive play areas; entertainment in the nature of an amusement park ride; entertainment services in the nature of an amusement park attraction, namely, a themed area; entertainment services in the nature of an amusement park show.” Respondent fails to identify or include Petitioner as an owner in the application. This application is the subject of an Opposition proceeding filed March 26, 2024.

c. Similarly, Respondent’s Application Serial No. 97655285 is for the word mark THE NEPTUNES in Class 009 for “Downloadable video recordings featuring music; downloadable electronic publications in the nature of books, booklets, magazines, journals, manuals, brochures, leaflets, pamphlets and newsletters, all in the field of music, entertainment, television, film, the arts, fashion, lifestyles, culture, social issues and politics; electronic publications, namely, books, booklets, magazines, journals, manuals, brochures, leaflets, pamphlets and newsletters, all in the field of music, entertainment, television, film, the arts, fashion, lifestyles, culture, social issues and politics, recorded on CD-ROMs; magnets; decorative magnets; refrigerator magnets; novelty magnets; mouse pads; fitted cases for storage and transportation, namely, cases for compact discs, audio cassettes, video cassettes, CD-ROMs, computers, cameras, camcorders and portable phones; computer carrying cases; downloadable ring tones, graphics, and electronic game software via the Internet and wireless devices; downloadable wireless electronic game

software; downloadable wireless entertainment via the internet and wireless devices, namely, ring tones, screen savers, images in the field of music, musical performers, pop art, modern art, cartoons, portraits, scenery, and geometric designs, and wallpaper images in the field of music, musical performers, pop art, modern art, cartoons, portraits, scenery, and geometric designs; computer game discs, and downloadable computer game software; video game discs and downloadable video game software and programs; downloadable interactive multimedia computer game program; downloadable interactive video game programs; interactive audio game discs containing action games and role playing games; downloadable virtual reality game software; multi-media software recorded on CD-ROM featuring music and games; Downloadable computer software for use in the design, development and execution of wireless game and entertainment programs and applications.” Respondent fails to identify or include Petitioner as an owner in the application. This application is the subject of an Opposition proceeding filed March 26, 2024.

10. Respondent also has filed the following additional application for the word mark THE NEPTUNES without naming Petitioner or the General Partnership as the owner, which is currently suspended: Serial No. 97655306 – Class 25

11. The following applications for the word mark THE NEPTUNES which have expired also were filed solely by Respondent without including Petitioner or the General Partnership: Serial No. 88950663 - Class 9; Serial No. 88950665 – Class 25; Serial No. 88950671 – Class 38; Serial No. 88950663 – Class 41.

III. Background and Basis for Cancellation

12. Petitioner alleges the following facts as grounds for this Petition for Cancellation.

13. Petitioner together with Williams are a world-famous musical songwriting and producing duo known as “The Neptunes” with a long list of chart topping worldwide musical hits. The Neptunes are known worldwide both in the music business and to the general public as

consisting of Petitioner Charles Hugo, professionally known as Chad Hugo, and Pharrell Williams.

14. In or about 1992, Petitioner and Williams came together to form a musical duo with Petitioner playing tenor saxophone and Williams on drums. They decided on the name the NEPTUNES for their musical endeavors and debuted in a talent show in Virginia Beach, Virginia. From and after that time, Petitioner and Williams came to be known as “The Neptunes.”

15. Shortly thereafter, The Neptunes were discovered by established hip hop and R&B producer Teddy Reilly and their career took off. In the next thirty years, they produced innumerable chart-topping hits, including, but not limited to, “Hollaback Girl” performed by Gwen Stefani and “Milkshake” by Kelis. On all of these hits, Petitioner together with Williams are credited as “The Neptunes.”

16. In 2004, The Neptunes won a Grammy for Producer of the Year, Non-Classical. The Neptunes have also received two other Grammy Awards – for 1) Best Pop Vocal Album for Justin Timberlake’s “Justified” and 2) Best Rap Song for Ludacris “Moneymaker.” The Neptunes have also received twelve (12) Grammy Nominations.

17. The Neptunes have also been the recipients of the Billboard R&B/Hip Hop Awards. They won Producer of the Year in 2003 and Producer of the Decade in 2009. They have received a total of six (6) nominations.

18. In 2022, The Neptunes were inducted into the Songwriters Hall of Fame.

19. Throughout their over thirty (30) year history, Petitioner and Williams agreed to, and in fact, have divided all assets, including intellectual property rights, of their business relationship equally. All publishing rights and publishing agreements were/are divided equally. All advances, fees and royalties were/are divided equally. Nothing, either written or oral, provided Williams or Respondent with the unilateral authority to register THE NEPTUNES marks solely in the name of Respondent without including Petitioner or without naming the General Partnership as owner.

20. In the alternative, as a general partner of the General Partnership, Petitioner alleges that the General Partnership is the rightful co-owner of the Registration Nos. 6598717 and 7164541. In addition, the General Partnership is the rightful co-owner of any other applications and registrations filed by Respondent in connection with the mark THE NEPTUNES.

21. Respondent knowingly and intentionally filed applications for the marks THE NEPTUNES for his own benefit without including Petitioner or the General Partnership as an owner of the applications. Respondent was fully aware that Petitioner or the General Partnership was co-owner of the applications yet filed them without notice to Petitioner and without including Petitioner or the General Partnership as a fifty percent (50%) co-owner.

22. By ignoring and excluding Petitioner from the any and all applications filed by Respondent for the mark THE NEPTUNES, Respondent has committed fraud in securing the trademarks and acted in bad faith toward Petitioner.

23. Petitioner is further informed and believes and based thereon alleges that Respondent and Williams knowingly and intentionally used one or more of the registrations for the mark THE NEPTUNES referenced herein to fraudulently represent to business associates and to the public that Respondent and Williams solely owned the name and registration for the mark THE NEPTUNES so that Williams could use the mark unilaterally for producing musical tracks for his own benefit and to enter into merchandising deals for his own benefit without the express written permission or knowledge of Petitioner and without the required compensation to Petitioner.

24. Petitioner has repeatedly contacted Respondent through counsel in connection with the co-ownership issue. Respondent's counsel has in fact admitted that Petitioner is equal co-owner of the trademarks and repeatedly stated that 50% of the rights would be transferred to Petitioner. Respondent, however, has never made the transfer. Respondent also has conditioned the transfer upon Petitioner agreeing to onerous business terms which would deprive Petitioner of control of and compensation from the trademarks.

25. Petitioner has been and will continue to be damaged by the actions of Respondent by being deprived of the rights and benefits due to him as co-owner of the Trademarks. In addition, Respondent's actions will dilute the value of the mark in which Petitioner is a co-owner.

26. In the alternative, Respondent's registrations are of marks which are confusingly similar to the famous mark co-owned by Petitioner and/or owned by the General Partnership and known to the public to refer to the world famous producing and songwriting duo of Chad Hugo and Pharrell Williams. Petitioner and the General Partnership have extensive common law rights and the marks are recognized in the minds of the public as belonging to Petitioner as co-owner or to the General Partnership. Thus, Respondent's applications tend to dilute the value of the mark co-owned by Petitioner as well as create a false suggestion of a connection to the producing team of Petitioner and Williams. In addition, the mark co-owned by Petitioner and owned by the General Partnership have priority of use. Thus, registration of the subject applications will damage Petitioner by causing confusion in the public's mind as to whom Respondent's marks refer.

IV. Prayer

1. Petitioner prays that this Petition to Cancel Registration Nos. 6598717 and 7164541 for THE NEPTUNES be granted in favor of Petitioner.

2. In the alternative, Petitioner respectfully requests the ownership of the registration be amended to provide for Petitioner as 50% co-owner or to name the General Partnership as owner in place of Respondent.

Dated: March 27, 2024

Respectfully submitted,

/s/ Kenneth D. Freundlich
Kenneth D. Freundlich
Attorney for Petitioner

Freundlich Law
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