

ESTTA Tracking number: **ESTTA1348451**  
Filing date: **03/26/2024**

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

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer information

Name	Charles (Chad) Hugo
Granted to date of previous extension	05/08/2024
Address	3860 LITTLE NECK POINT VIRGINIA BEACH, VA 23452 UNITED STATES
Party who filed extension of time to oppose	Chad Hugo
Relationship to party who filed extension of time to oppose	Legal name correction

Attorney information	KENNETH D. FREUNDLICH & MAX J. SPRECHER FREUNDLICH LAW & LAW OFFICES OF MAX J. SPRECHER 5850 CANOGA AVENUE 4TH FLOOR WOODLAND HILLS, CA 91367 UNITED STATES Primary email: max@sprecherlaw.com Secondary email(s): ken@freundlichlaw.com 18189962255
Docket no.	

### Applicant information

Application no.	97655357	Publication date	01/09/2024
Opposition filing date	03/26/2024	Opposition period ends	05/08/2024
Applicant	PW IP Holdings, LLC SUITE 602 15 EAST 26TH STREET NEW YORK, NY 10010 UNITED STATES		

### Goods/services affected by opposition

Class 038. First Use: None First Use In Commerce: None  
All goods and services in the class are opposed, namely: 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

### Applicant information

Application no.	97655382	Publication date	01/16/2024
Opposition filing date	03/26/2024	Opposition period ends	
Applicant	PW IP Holdings, LLC SUITE 602 15 EAST 26TH STREET NEW YORK, NY 10010 UNITED STATES		

### Goods/services affected by opposition

Class 041. First Use: None First Use In Commerce: None  
 All goods and services in the class are opposed, namely: 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

### Applicant information

Application no.	97655285	Publication date	02/06/2024
Opposition filing	03/26/2024	Opposition period	

date		ends	
Applicant	PW IP Holdings, LLC SUITE 602 15 EAST 26TH STREET NEW YORK, NY 10010 UNITED STATES		

## Goods/services affected by opposition

<p>Class 009. First Use: None First Use In Commerce: None</p> <p>All goods and services in the class are opposed, namely: 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</p>
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## Grounds for opposition

Applicant not rightful owner of mark for identified goods or services	Trademark Act Section 1
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols	Trademark Act Section 2(a)
Deceptiveness	Trademark Act Section 2(a)
Other	Applicant has acted fraudulently and in bad faith by unilaterally claiming ownership without designating co-owner; Registration will dilute Opposer's rights in famous mark co-owned by Opposer.

Attachments	2024-03-26-Oppositions to The Neptunes Marks by C Hugo.pdf(45707 bytes )
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Signature	/max j sprecher/
Name	MAX J. SPRECHER
Date	03/26/2024

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

Charles Hugo, an individual	Opposition No.:
Opposer,	Application No. 97655357
vs.	Mark: THE NEPTUNES Class 38
PW Holdings, LLC, a Delaware limited liability company,	Application No. 97655382
Applicant.	Mark: THE NEPTUNES Class 41
	Application No. 97655285
	Mark: THE NEPTUNES Class 9

**I. NOTICE OF OPPOSITION**

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

2. Opposer believes that he is being and will be damaged by Application Serial Nos. 97655357, 97655382 and 97655285 for THE NEPTUNES filed by PW IP Holdings, LLC (“Applicant”) and opposes such applications on the following grounds:

a. Opposer is the rightful fifty percent (50%) co-owner of the marks covered by Application Serial Nos. 97655357, 97655382 and 97655285 (the “Trademarks”) yet Applicant has failed to designate him as co-owner;

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

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

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

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

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

## **II. Applications Subject to Opposition:**

4. Serial No. 97655357: On or about October 31, 2022, Applicant filed an intent-to-use application 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.” This application was published on January 9, 2024, and Opposer obtained an extension of time to oppose on January 30, 2024.

5. Serial No. 97655382: On or about October 31, 2022, Applicant filed an intent-to-use application 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.” This application was published on January 16, 2024 and Opposer obtained an extension of time to oppose on January 30, 2024.

6. Serial No. 97655285: On or about October 31, 2022, Applicant filed an intent-to-use application 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. The application was filed on an intent-to-use basis. This application was published on February 6, 2024 and Opposer obtained an extension of time to oppose on February 6, 2024.

7. Each of these applications should have identified Opposer as a co-owner or otherwise identified the General Partnership as to the owner.

8. Applicant's failure to do so reflects and intentional effort to mislead the U.S.P.T.O. and injure Opposer.

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

**III. Applicant's Prior Applications and Registrations Show a Pattern of Bad Faith Actions.**

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

a. For example, Applicant'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 mark registered on December 21, 2021. The date of first use is alleged to be August 19, 2003. The specimen submitted by Applicant on August 26, 2021 shows an image of Opposer and Williams.



b. Similarly, Applicant's Registration 7164541 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 mark registered on September 12, 2023. The date of first use is alleged to be August 19, 2003. The original specimen submitted by Applicant on May 3, 2022, which was subsequently rejected, only shows an image of Williams. However, the specimen submitted by Applicant on January 6, 2023 and accepted by the examiner shows an image of Opposer and Williams.

11. The foregoing registrations (and possibly others) will be subject to a separate cancellation proceeding.

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

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

#### **IV. Background and Basis for Opposition**

14. Opposer alleges the following facts as grounds for this Notice of Opposition:

15. Opposer 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 Opposer Charles Hugo, professionally known as Chad Hugo, and Pharrell Williams.

16. In or about 1992, Opposer and Williams came together to form a musical duo with Opposer 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, Opposer and Williams came to be known as “The Neptunes.”

17. 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, Opposer together with Williams are credited as “The Neptunes.”

18. 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.

19. 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.

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

21. Throughout their over thirty (30) year history, Opposer 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 Applicant with the unilateral authority to register the trademarks solely in the name of Applicant without including Opposer or without naming the General Partnership as owner.

22. In the alternative, as a general partner of the General Partnership, Opposer alleges that the General Partnership is the rightful co-owner of the Application Serial Nos. 97655357, 97655382 and 97655285. In addition, the General Partnership is the rightful co-owner of any other applications and registrations filed by Applicant in connection with the mark THE NEPTUNES.

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

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

25. Opposer is further informed and believes and based thereon alleges that Applicant 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 Applicant 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 Opposer and without the required compensation to Opposer.

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

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

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

**V. Prayer**

1. Opposer prays that this Notice of Opposition to Application Serial Nos. 97655357, 97655382 and 97655285 for THE NEPTUNES be granted in favor of Opposer.

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

Dated: March 26, 2024

Respectfully submitted,

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

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