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

Proceeding no.	92084359
Party	Defendant Charles Kenyatta Jr
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Date	03/14/2024
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

ACT BAD LLC

Petitioner

v.

Charles Kenyatta Jr

Registrant

Mark: Act Bad

Reg. No. 7177313

ANSWER TO PETITION FOR CANCELLATION AND AFFIRMATIVE DEFENSES

Registrant Charles Kenyatta Jr (“Registrant”), by and through its attorney, hereby answers the petition for cancellation filed by ACT BAD LLC (“Petitioner”) as follows. To the extent not explicitly admitted, all allegations in the petition are denied.

ANSWER

1. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 1. Registrant is doing business in USA and is the major business wholesaler and retailer of goods and services bearing the mark Act Bad under the trademark **Reg. No.** 7177313. Petitioner does not have a website, or any type of ecommerce set up in which Petitioner claims to be selling good bearing the registered mark Act Bad.

2. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 2. Registrant registered Act Bad Entertainment LLC with the Delaware secretary of state on December 28, 2020.

3. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 3. Registrant has been using the trademark ACT BAD in relation to the goods and services in USA as early as 2018. Petitioner has no evidence of prior use of the mark in 2017 in commerce. For Petitioner’s pending trademark application, Petitioner submitted a specimen of a Instagram post of an article of clothing which does not display any tag

showing the mark, no webpage where consumers can purchase the goods, no price for the goods, and no way inquire about purchasing goods therefore Petitioner is not using the goods in commerce at this point.

4. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 4. Registrant alleges on information and belief that the petition is barred by the doctrine of unclean hands.

Registrants' trademark Reg. No. 7177313 is registered for: Class 025 Beanies; Coats; Footwear; Hats; Headwear; Pants; Shirts; Shoes; Shorts; Socks; Bottoms as clothing; Hoodies; Jackets; Sweat pants; Sweat shirts; T-shirts; Tops as clothing; Hooded sweat shirts.

5. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 5. Registrant filed the specimens for use in commerce since Oct. 01, 2020 and the images used for specimens are in fact real images of merchandise for sale at that time with the mark Act Bad displayed on Registrants website Actbadent.com.

6. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 6. Registrant owns the federal trademark for the ACT BAD Marks.

7. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 7. During its longstanding, widespread, and continuous use of the ACT BAD mark and trade name in these past years, Registrant spends considerable time, effort, and financial resources in advertising and publicizing the sale of its goods through online and retail stores. Registrant has documented tax returns for the business associated with Act Bad. The ACT BAD mark and trade name are symbolic of the extensive goodwill and consumer recognition that Registrant has established. As a result, the public and the relevant industry has come to recognize the products offered in conjunction with the ACT BAD mark and the trade name as signifying ACT BAD goods. Consequently, Petitioner claims to have significant common law, prior use of trademark in the ACT BAD mark however Petitioner was aware that

Act Bad was being used in common law by Registrant and further that Registrant submitted a trademark application November 23, 2021, and received registration without any opposition. Registrant submits that Petitioner has no right to continue its application process in the USA which is pending, and that Petitioner's mark shall be cancelled in order for Registrant to enjoy its trademark and trade name rights.

8. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 8. Registrant believes that the Petitioners mark is identical or similar to Registrants Federal trademark and therefore will cause a high degree of resemblance as a result of which creates likelihood of confusion and likelihood of association.

9. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 9. Registrant believes, the mark sought to be registered by Petitioner is confusingly similar and identical to Registrants Mark, and the Petitioners use of Mark is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Petitioners goods are those of the Registrants or are endorsed, sponsored, or otherwise affiliated with or connected to the Registrants mark, or that Registrant's goods and services are associated with Petitioner, all to damage and injury goes to the public and to the damage and injury to the Registrant and its affiliates.

10. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 10. This petition to cancel must be denied and the registration of Petitioners Mark must be denied on the grounds of Registrants actual use and registration of its ACT BAD trademark, likelihood of confusion, likelihood of association, and bad faith.

**ANSWER TO CLAIM ONE FOR
RELIEF PRIORITY AND LIKELIHOOD OF
CONFUSION**

11. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 11.

12. Registrant denies knowledge or information sufficient to form a belief as to the truth of

the matters alleged in Paragraph 12. Registrant has prior rights based on its common law rights in its ACT BAD mark.

13. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 13. Registrant has prior rights based on applying and receiving a registered trademark in which the Petitioner was aware of for years without opposition.

14. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 14. Petitioners pending application is likely to cause confusion and association with the Registrants mark ACT BAD.

15. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 15. Based on the similarities between both marks, and the identical or similar goods and services of both marks, Petitioners mark so resembles Registrants mark in terms of appearance, sound, goods, services, and trade name as to cause confusion or mistake, or to deceive consumers, with consequent injury to Registrant and to the public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

16. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 16. Registrant will be damaged by the continued application process of Petitioners mark because such registration will support and assist Petitioner in the confusing and misleading use of the Registrants mark and will violate Registrants superior rights.

17. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 17. Registrant will be damaged by the continued application process of Petitioners mark because such registration will support and assist Petitioner in the confusing and misleading use of the Petitioners mark and will violate Registrants superior rights.

ANSWER TO SECOND CLAIM FOR RELIEF

FALSE SUGGESTION OF A CONNECTION WITH PETITIONER

18. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 18.

19. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 19. Registrant and Petitioner were at one point working in a capacity limited to the Registrant being the rightful owner of the brand Act Bad and the Petitioner having permission to promote the brand, however as of the cease and desist sent on 08/24/2023 Petitioner has no connection with ACT BAD and has no authority or permission to use a trademark suggesting such a connection. Petitioner was aware that Registrant filed a

trademark application in 2021. Registrant alleges on information and belief that as a result of Petitioner's own acts and/or omissions, the petition is barred by the doctrine of laches.

Petitioner tried to enter into negotiations on June 1, 2023 about licensing the brand name with Bad Boy entertainment. At the time Petitioner told Registrant about the opportunity and then connecting Registrants attorney with Bad Boy's counsel so that the license opportunity could be negotiated on Registrants' behalf. On August 17, 2023 counsel for Bad Boy inquired with Registrants' attorney about ownership over the brand Act Bad. On August 21, 2023 Registrants' attorney made counsel for Bad Boy aware that Charles Kenyatta Jr. was the rightful and sole owner of the Act Bad mark, and that the Petitioner had permission to introduce the opportunity but is not in any capacity in a position to make any decisions or have any authority of the use of the Act Bad mark.

20. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 20. Petitioners Mark is not registrable pursuant to Section 2(a) of the U.S. Trademark Act, 15 U.S.C. § 1052(a), because it falsely suggests a connection or affiliation with Registrants mark under the federal law which supersedes any common law claims.

21. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 21. If Petitioner application will be allowed to continue, the public is likely to falsely associate Petitioners mark and goods under ACT BAD with Registrants trademark or with Registrants goods, falsely believing that Petitioners services emanate from or are sponsored, endorsed, or licensed by Registrant, or falsely believe that there is some relationship between Registrant and Petitioner.

22. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 22. Allowing Petitioners continued application process would give unbearable damage to Registrant, and Petitioners continued application process would falsely suggest a connection between Registrant and Petitioner to the damage of Registrant and injury to the public, in violation of Section 2(a) of the U.S. Trademark Act, 15 U.S.C. § 1052(a).

Registrant alleges on information and belief that as a result of its own acts and omissions, Petitioner has waived any right to pursue its petition.

ANSWER TO THIRD CLAIM FOR RELIEF

BAD FAITH FILLING AND FALSE DECELERATION AND INFORMATION SUBMISSION

23. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 23. Registrant truthfully submitted the specimens of products that were being offered for sale at the time on Registrants website. While these images were also on the Petitioner's Instagram page, there were solely posted for promotional purposes and not for sale.

24. Registrant denies knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 24. Registrant truthfully submitted the specimens that were first used by the Registrant since Oct. 01, 2020, in commerce and Nov. 01, 2018 first use, as a result Registrant was awarded trademark registration number 7177313.

WHEREFORE, Registrant requests that the notice of petition be dismissed with prejudice, together with whatever other relief the Board may deem appropriate.

Dated: March 14, 2024

Respectfully submitted,
Charles Kenyatta Jr

Andrew Covington
Covington Law PLLC
Through
/Andrew Covington/
Attorney

CERTIFICATE OF ELECTRONIC FILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE TRADEMARK TRIAL AND APPEAL BOARD, VIA ESTTA, ON THE DATE INDICATED BELOW.

By: /Andrew Covington/

Service of Answer to Petition To Cancel Number: 92084359



Andrew Covington <andrew@thecovingtonlaw.com>

to info ▾

Ms. Anderson,

8:19 PM (0 minutes ago)



This email is for the service of the Answer to the Petition to Cancel number: 92084359.

Best,

Andrew Covington



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