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9 **UNITED STATES DISTRICT COURT**
10 **NORTHERN DISTRICT OF CALIFORNIA**

11 San Francisco Division

13 Uberre, Inc., a Delaware Corporation)

14 Plaintiff(s),)

15 vs.)

16 Uber Technologies, Inc., a Delaware)
17 Corporation.)

18 Defendant(s).)

Case Number:

Complaint for TRADEMARK
19 INFRINGEMENT
20 (15 U.S.C. §§1114, 1116, and 1117);
21 FEDERAL COMMON LAW, UNFAIR
22 COMPETITION AND FALSE
DESIGNATION OF ORIGIN (15 U.S.C.
§1125(a))

And Demand for Jury Trial

23 **NATURE OF THE ACTION**

24 1. This is a civil action for trademark infringement and unfair competition arising
25 under the federal Lanham Act, 15 U.S.C. §§ 1114, 1125(a), and 1125(d) resulting in damages
26 over \$250,000,000,000.00. UBER expended significant time and money in creating an extensive

28 COMPLAINT FOR TRADEMARK INFRINGEMENT (15 U.S.C. §§1114, 1116, and 1117);

1 computer software program that allows consumers to list their real property and services with an
2 emphasis on the real estate and travel accommodation industries. UBER owns valuable rights
3 and goodwill in its ÜBER trademark, which it acquired in 2017 including all rights and goodwill
4 of the previous owner, that has been used continuously in the business of real estate and rental
5 accommodations since as early as 2008 (Registration No. 5,052,252). In violation of the Lanham
6 Act, Defendant is releasing a competing application and trademark for the same services as
7 UBER. Defendant seeks to capitalize on the goodwill of UBER’s Mark, thereby profiting off
8 confusion among consumers.
9

10 **THE PARTIES, JURISDICTION, AND VENUE**

11 2. Plaintiff, UberRE, Inc., is a Delaware Corporation registered in 2017 with its
12 principal place of business in Menlo Park, California.

13 3. Defendant, Uber Technologies, Inc., is a Delaware Corporation registered in 2010
14 with its principal place of business in San Francisco, California.

15 4. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b)(2)
16 because a substantial part of the events giving rise to the claims asserted in this Complaint
17 occurred in this judicial district and/or a substantial part of the property that is the subject of the
18 action is situated in this district.
19

20 5. The trademark infringement claim asserted in this action arises under the
21 provisions of the Lanham Act, 15 U.S.C. § 1501 et seq. This Court has original jurisdiction over
22 these claims pursuant to 15 U.S.C. § 1121(a) and 28 U.S.C. § 1338(a). This Court further has
23 jurisdiction of the breach of oral contract claim pursuant to 28 U.S.C. § 1367.
24

25 6. All conditions precedent to the commencement of this action, if any, have been
26 performed, satisfied, waived, excused or have occurred.
27

FACTUAL BACKGROUND

7. The ÜBER mark was originally registered on October 4, 2016.

8. UBER holds Federal Trademark Reg. No. 5,052,252 The Registration is attached hereto as **Exhibit 1**.

9. On or about November 27, 2017, the president of UBER, Mr. Brent Ritz, acquired the intellectual property rights and goodwill in the ÜBER mark from James C. Whatley on or about November 27, 2017. A copy of the Registration and valid assignment is attached hereto as **Exhibit 2**.

10. On or about November 12, 2019, UBER commenced with the coding of the UBER website and was completed on or about May 8, 2020. The website domain has been owned and registered since November 26, 2009.

11. UBER is an innovative temporary travel accommodation and real estate company that allows its customers to list and market real property to other individuals for temporary travel accommodations, experience services as well ordering an on-demand real estate broker. UBER also allows customers to list and market personal services throughout the world. UBER has invested, and continues to invest, significant time, money, and resources to grow its business.

12. During this time, UBER reached out to the Defendant multiple times to discuss the co-existence, and potential partnership, between the two companies, including in-person conversations.

13. The Defendant has known of UBER and their intellectual property rights since as early as November 2019.

1 14. Over the last three (3) years, UBER has invested substantial amounts of money
2 into the creation, development, operation, and marketing of the ÜBER mark throughout the
3 world.

4 15. On January 3, 2022, the Defendant filed a trademark application for UBER
5 TRAVEL mark.

6 16. Upon information and belief, the Defendant will release competing software that
7 will offer competing travel accommodation and real estate services under the confusingly similar
8 UBER TRAVEL mark.

9 17. By virtue of the foregoing, Defendant is infringing upon UBER's Mark and
10 unfairly competing with UBER. Defendant's use of the UBER TRAVEL mark in connection
11 with its business is likely to cause confusion, mistake, or deception among the trade and the
12 public.
13

14 18. Additionally, UBER owns the developer accounts for the Google and Apple
15 application stores and the UBER application for 88% of the world's devices.

16 19. Defendant is knowingly, willfully, intentionally, and maliciously using their
17 confusingly similar imitations of the UBER's trademark.
18

19 20. Defendant's intentional infringement of UBER's Mark and unfair competition is
20 causing irreparable injury to UBER, and, unless the injunction sought in this Complaint is
21 granted, will continue to cause irreparable injury to UBER due to the confusion, mistake, and
22 deception that will be and has been generated among the trade and the public.
23

24 21. UBER has suffered and will continue to suffer damage, the exact amount of
25 damage being unknown at this time. The damage to UBER is, and will continue to be,
26 irreparable because, among other reasons, of the continuing nature of the trademark infringement
27

1 and unfair competition which would necessitate a multiplicity of suits for damages if the
2 continuance of the wrongs is not enjoined.

3 22. All conditions precedent to the institution and maintenance of this action have
4 occurred or been performed by UBER.

5 23. UBER has engaged the law firm of Stanton IP Law Firm, P.A. to represent it and
6 are obligated to pay its attorneys a reasonable fee for their services in this action.
7

8 **COUNT I – TRADEMARK INFRINGEMENT**
9 **(15 U.S.C. §§1114, 1116, and 1117)**

10 24. UBER realleges Paragraphs 1- 23 as if fully set forth herein.

11 25. This is an action for an injunction arising under 15 U.S.C. §§ 1114 and 1116, and
12 for damages arising under 15 U.S.C. §§ 1114 and 1117.

13 26. Defendant has, by virtue of its above-described acts, infringed upon UBER's
14 rights in its federal trademark registrations in violation of 15 U.S.C. § 1114.

15 27. Defendant's above-described acts of infringement have been committed, and are
16 continuing to be committed, willfully and with the knowledge that Defendant's Mark is intended
17 to be used to cause confusion, or to cause mistake, or to deceive.
18

19 28. Defendant's above-described acts of infringement have caused irreparable injury
20 to UBER and will continue to cause irreparable injury to UBER if Defendant is not restrained by
21 this Court from further violating UBER's trademark rights due to the confusion, mistake, or
22 deception that will likely be generated among the trade and the public as a consequence of the
23 above-described acts of infringement. UBER has no adequate remedy at law.
24

25 29. As a result of the above-described intentional and deliberate infringement of
26 UBER's trademark rights by Defendant, UBER is entitled to an injunction and an award of
27

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