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

San Francisco Division

Uberre, Inc., a Delaware Corporation

Plaintiff(s),

vs.

Uber Technologies, Inc., a Delaware Corporation.

Defendant(s).

Case Number:

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

And Demand for Jury Trial

**NATURE OF THE ACTION**

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

COMPLAINT FOR TRADEMARK INFRINGEMENT (15 U.S.C. §§1114, 1116, and 1117);  
FEDERAL COMMON LAW, UNFAIR COMPETITION AND FALSE DESIGNATION OF  
ORIGIN (15 U.S.C. §1125(a))

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.

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

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

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

Defendant's profits, up to three (3) times any damages sustained by UBER, costs of this action, and attorneys' fees, all as set forth in 15 U.S.C. §§ 1116 and 1117, subject to the discretion of this Court.

**COUNT II – FEDERAL COMMON LAW, UNFAIR COMPETITION AND FALSE  
DESIGNATION OF ORIGIN**  
**(15 U.S.C. §1125(a))**

30. UBER realleges Paragraphs 1- 25 as if fully set forth herein.

31. This is an action for an injunction arising under 15 U.S.C. §1125(a).

32. Defendant has, by virtue of its above-described acts, infringed upon UBER rights in its federal trademark registrations in violation of 15 U.S.C. § 1125(a).

33. UBER has offered its services under the ÜBER Mark in commerce throughout the world since November 14, 2006. It has used the ÜBER Mark continuously since that time and currently offer's its services on its website: uberrealestate.com.

34. UBER has invested substantial time, effort, and financial resources promoting its Mark in connection with the marketing and sale of its goods in interstate commerce. The ÜBER Mark has become, through widespread and favorable public acceptance and recognition, an asset of substantial value as a symbol of UBER, its quality services, and its goodwill. The consuming public recognizes the ÜBER Mark and associates it with UBER.

35. Notwithstanding UBER's established rights in the ÜBER Mark, Defendant adopted and will use a confusingly similar trademark and logo in interstate commerce in connection with the offering of substantially similar services as UBER.

36. Defendant's above-described acts of infringement have caused irreparable injury to UBER and will continue to cause irreparable injury to UBER if Defendant is not restrained by this Court from further violating UBER's trademark rights due to the confusion, mistake, or

1 deception that will likely be generated among the trade and the public as a consequence of the  
2 above-described acts of infringement. UBER has no adequate remedy at law.

3 37. As a result of the above-described intentional and deliberate infringement of  
4 UBER's trademark rights by Defendant, UBER is entitled to an injunction and an award of  
5 Defendant's profits, up to three (3) times any damages sustained by UBER, costs of this action,  
6 and attorneys' fees, all as set forth in 15 U.S.C. §1125(a), subject to the discretion of this Court.  
7

8  
9 **PRAYER FOR RELIEF**

10 WHEREFORE, UBER prays this Honorable Court enter such preliminary and final orders and  
11 judgements as are necessary to provide Plaintiff with the following requested relief:

- 12 a) an injunction preliminarily during the pendency of this action and thereafter  
13 permanently enjoining and restraining Defendant, their officers, agents, servants,  
14 employees, and attorneys, and all other persons in active concert or participation with  
15 them, from infringing UBER's trademark rights and unfairly competing with UBER  
16 in any manner whatsoever in connection with the operation of its business, and from  
17 continuing to operate its business in any manner tending to confuse or deceive the  
18 public into believing that its business is in any way connected with, sponsored by, or  
19 affiliated with UBER;  
20  
21 b) an order directing Defendant to file with the Court and serve upon UBER a report in  
22 writing under oath setting forth in detail the manner and form in which Defendant has  
23 complied with the injunction entered by the Court within thirty (30) days after the  
24 entry of the injunction in compliance with 15 U.S.C. § 1116(a);  
25  
26  
27  
28

- 1 c) an accounting of Defendant's wrongfully derived profits and an order that the same  
2 be paid over to UBER;
- 3 d) up to three (3) times any damages sustained by UBER;
- 4 e) That UBER be awarded compensation for corrective advertising for the damage to  
5 UBER's goodwill;
- 6 f) That, based on Defendants' willful and deliberate infringement of Plaintiff's Mark,  
7 and to deter such conduct in the future, UBER be awarded punitive damages;
- 8 g) restitution to UBER of any and all money Defendant has acquired by means of unfair  
9 competition;
- 10 h) interest on such profits and damages at the highest rate allowed by law;
- 11 i) That Defendant be required to pay UBER's the cost of this action and Plaintiff's  
12 reasonable attorneys' fees, pursuant to 15 U.S.C. § 1117;
- 13 j) such other relief as the Court may deem just and appropriate.
- 14
- 15

16 **DEMAND FOR JURY TRIAL**

17 UBER, by and through its undersigned attorneys, request a trial by jury on all issues so  
18 triable.

19 //

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26 //



**RESERVATION OF RIGHTS**

UBER reserves the right, upon further investigation and discovery, to assert such claims against Defendant and other responsible parties as may be just and appropriate under the circumstances.

Dated:

Respectfully submitted

/s/ Curtis E. Smolar

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/s/ Thomas Stanton

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Tampa, FL 33602  
PH: 813.421.3883

*Attorneys for Plaintiff*

Pro Hac Vice Pending

## **Exhibit 1-- Federal Trademark Reg. No. 5,052,252**

# United States of America

United States Patent and Trademark Office

## ÜBER

**Reg. No. 5,052,252**

**Registered Oct. 04, 2016**

**Int. Cl.: 36**

**Service Mark**

**Principal Register**

James C. Whatley (UNITED STATES INDIVIDUAL)  
303 Hunter Place  
Fort Walton Beach, FL 32548

CLASS 36: Real estate agencies; Real estate brokerage

FIRST USE 1-31-2008; IN COMMERCE 1-31-2008

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

The English translation of "ÜBER" in the mark is "denoting an outstanding or supreme example of a particular kind of person or thing".

SER. NO. 86-500,939, FILED 01-12-2015  
WILLIAM PATR SHANAHAN, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office

## **Exhibit 2--Registration and Valid assignment**

# TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1  
Stylesheet Version v1.2

ETAS ID: TM466234

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT		
<b>NATURE OF CONVEYANCE:</b>	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
<b>CONVEYING PARTY DATA</b>			
<b>Name</b>	<b>Formerly</b>	<b>Execution Date</b>	<b>Entity Type</b>
James C Whatley		11/27/2017	INDIVIDUAL: UNITED STATES
<b>RECEIVING PARTY DATA</b>			
<b>Name:</b>	UberRE, Inc.		
<b>Street Address:</b>	101 Jefferson Drive		
<b>City:</b>	Menlo Park		
<b>State/Country:</b>	CALIFORNIA		
<b>Postal Code:</b>	94025		
<b>Entity Type:</b>	Corporation: DELAWARE		
<b>PROPERTY NUMBERS Total: 1</b>			
<b>Property Type</b>	<b>Number</b>	<b>Word Mark</b>	
<b>Registration Number:</b>	5052252	ÜBER	
<b>CORRESPONDENCE DATA</b>			
<b>Fax Number:</b>	7759968787		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
<b>Phone:</b>	7758522600		
<b>Email:</b>	mark@goodmanlawnevada.com		
<b>Correspondent Name:</b>	Mark A. Goodman, Esq.		
<b>Address Line 1:</b>	401 Ryland Street		
<b>Address Line 2:</b>	STE 200		
<b>Address Line 4:</b>	Reno, NEVADA 89502		
<b>ATTORNEY DOCKET NUMBER:</b>	907-Ritz 4318-002		
<b>NAME OF SUBMITTER:</b>	Mark A. Goodman, Esq.		
<b>SIGNATURE:</b>	/Mark Goodman/		
<b>DATE SIGNED:</b>	03/19/2018		
<b>Total Attachments: 6</b>			
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**REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

- **First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.
- **Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.\* See 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

**NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.**

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## Trademark Assignment

This Trademark Assignment (hereinafter referred to as the "Assignment") is made and entered into on November 17, 2017 (the "Effective Date") by and between the following parties:

**James C. Whatley**  
303 Hunter Place  
Fort Walton Beach, Florida 32548

(the "Assignor")

AND

**UberRE, Inc.**  
a Delaware *Corporation*  
101 Jefferson Drive  
Menlo Park, California 94025

(the "Assignee")

WHEREAS, the Assignor is the sole and rightful owner of certain trademarks and/or service marks and the corresponding registrations and/or applications for registration (collectively referred to as the Trademarks) set forth in Exhibit A attached hereto; and

WHEREAS, the Assignee desires to purchase or acquire the Assignor's right, title, and interest in and to the Trademarks; and

WHEREAS, the Assignor and Assignee are both duly authorized and capable of entering into this Assignment.

NOW, THEREFORE, for valuable consideration, the receipt of which is acknowledged, the parties hereto agree as follows:

### 1. ASSIGNMENT.

The Assignor does hereby sell, assign, transfer and set over to Assignee all of its right, title, and interest in and to the Trademarks in the United States and all jurisdictions outside the United States including, without limitation, the ongoing and existing portion of the Assignor's business associated with the Trademarks, together with the goodwill of the business connected with and symbolized by the Trademarks (including, without limitation, the right to sue and recover for any past or continuing infringements or contract breaches related to the Trademarks, the right to renew any registrations included in the Trademarks, the right to apply for trademark registrations within or outside the United States based in whole or in part upon the Trademarks, and any priority right that may arise from the Trademarks), the same to be held and enjoyed by Assignee as fully and entirely as said interest could have been held and enjoyed by Assignor had this sale, assignment, transfer and conveyance not been made.



The Assignor authorizes the United States Patent and Trademark Office and any other applicable jurisdictions outside the United States to record the transfer of the registrations and/or registration applications set forth in Exhibit A to Assignee as recipient of Assignors entire right, title and interest therein.

Assignor further agrees to upon the request and at the expense of Assignee: (a) cooperate with Assignee in the protection of the trademark rights and prosecution and protection of foreign counterparts; (b) execute, verify, acknowledge and deliver all such further papers, including registration applications and instruments of transfer; and (c) perform such other acts as Assignee lawfully may request to obtain or maintain the Trademarks and any and all applications and registrations for the Trademarks.

## **2. WARRANTY.**

Assignor warrants that Assignor is the legal owner of all right, title and interest in the Trademarks, that the Trademarks have not been previously pledged, assigned, or encumbered and that this Assignment does not infringe on the rights of any person.

## **3. GOVERNING LAW AND CHOICE OF FORUM**

This Assignment is governed by, and is to be construed in accordance with the laws of the State of Nevada. Any dispute regarding this Assignment shall be litigated in the Washoe County, Nevada.

## **4. ENTIRE AGREEMENT.**

This Assignment constitutes the sole agreement of the parties and supersedes all oral negotiations and prior writings with respect to the subject matter hereof.

## **5. SEVERABILITY.**

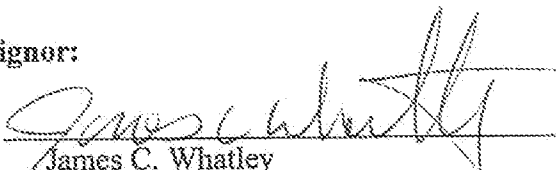
If one or more provisions of this Assignment are held to be unenforceable under applicable law, the parties agree to renegotiate such provision in good faith. If the parties cannot reach a mutually agreeable and enforceable replacement for such provision, then (i) such provision will be excluded from this Assignment, (ii) the balance of the Assignment will be interpreted as if such provision were so excluded and (iii) the balance of the Assignment will be enforceable in accordance with its terms.

## **6. ADVICE OF COUNSEL.**

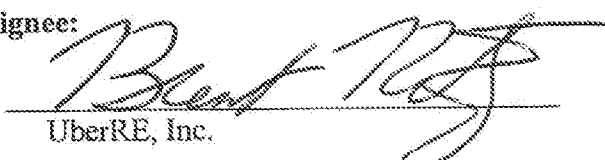
EACH PARTY ACKNOWLEDGES THAT, IN EXECUTING THIS AGREEMENT, SUCH PARTY HAS HAD THE OPPORTUNITY TO SEEK THE ADVICE OF INDEPENDENT LEGAL COUNSEL, AND HAS READ AND UNDERSTOOD ALL OF THE TERMS AND PROVISIONS OF THIS AGREEMENT. THIS AGREEMENT WILL NOT BE CONSTRUED AGAINST ANY PARTY BY REASON OF THE DRAFTING OR PREPARATION HEREOF.

IN WITNESS whereof, the Assignor and Assignee have executed this Agreement as of the Effective Date.

Assignor:

By:  Date: 11/27/17  
James C. Whatley

Assignee:

By:  Date: 11/28/17  
UberRE, Inc.

[Notary Acknowledgement to Follow]

**Exhibit A**

**List of Trademark/Service Mark**

Trademark/Service mark: Uber

Registration/Application number: Registration 5052252; Serial 86500939

Dated: October 04, 2016



### Assignee Acknowledgement

A notary public or other officer completing this certificate verifies only the identity of the individual(s) who signed the document to which this certificate is attached, and not the truthfulness, accuracy, or validity of that document.

State of CALIFORNIA       )  
County of SAN MATEO     )

On November 28, 2017 before me the undersigned Notary Public, personally appeared Brent Rite ASSIGNEE, who proved to me on the basis of satisfactory evidence to be the person whose name is subscribed to the within instrument and acknowledged to me that he/she executed the same in his/her authorized capacity, and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

I certify under PENALTY OF PERJURY under the laws of the State of California that the foregoing paragraph is true and correct.

WITNESS my hand and official seal.

[Signature] (Notary Seal)  
Notary Public

Oct. 8, 2021  
My commission expires

