

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF FLORIDA
TALLAHASSEE DIVISION

UBER OPERATIONS, LLC,

Plaintiff,

v.

Case No.: 4:17-cv-00391

UBER TECHNOLOGIES, INC.,

Defendant.

COMPLAINT

Plaintiff, Uber Operations, LLC ("Uber Operations"), brings this action against defendant, Uber Technologies, Inc. ("Uber Tech"), and alleges:

Allegations Common to all Counts

1. Uber Operations is a Florida limited liability company with its principal place of business in Tallahassee, Florida.
2. Uber Tech is a Delaware corporation with its principal place of business in San Francisco, California.
3. Subject matter jurisdiction exists in this Court pursuant to 28 U.S.C. secs. 1331 and 1367(a) because this case involves one or more claims that arise under the laws of the United States and the state law claims are so related to the federal claims that they form part of the same case or controversy. Jurisdiction also exists pursuant to 28 U.S.C. sec. 1332(a)(1) because this case is between citizens of different states (none of the members of Uber Operations are citizens of

Delaware or California) and the amount in controversy exceeds \$75,000.00, exclusive of interest and costs.

4. Personal jurisdiction exists in this Court pursuant to Florida's long-arm statute, Section 48.193, Fla. Stat., in that Uber Tech is engaged in substantial and not isolated activity within this State, including the advertising, marketing and sale of services within this State.

Uber Operations

5. Uber Operations is an elite data integration and cloud computing company, which specializes in providing information technology services to the healthcare industry. Its clients include agencies of both federal and state government, hospitals and other healthcare providers, associations and other organizations. Uber Operations has long-standing relationships with the State of Florida, State of Texas, Centers for Disease Control and Prevention (the "CDC"), Association of Public Health Labs, and various private companies across the United States. Uber Operations has invested much time, effort, and money into these relationships, which have taken years to build and grow.

6. Uber Operations was formed in Florida in 2004 and has been in continuous existence since. Upon its inception, Uber Operations began to use the names "Uber" and "Uber Ops" in conducting business, and those marks have been used to identify the company ever since. Uber Operations' owners, employees, vendors and clients all use the names "Uber" and "Uber Ops" to refer to the company. Uber Operations owns many domain names with "Uber" in them, including UBEROPS.com, UBEROPERATIONS.com,

UBERXCHANGE.com and UBERMOVE.com. Uber Operations has designed its logo, website, promotional materials, marketing and branding efforts around its name, and its brand identity is undeniably linked to the name "Uber."

7. On April 28, 2011, Uber Operations filed U.S. Trademark Application Serial No. 85307335 for the mark "UBER OPERATIONS" with the United States Patent and Trademark Office ("USPTO"). Following an examiner's amendment to the application, the application sought protection of the Mark in connection with:

Advisory services in the field of product development and quality improvement of software related to data integration; Computer programming and software design; Computer project management services for data integration and information exchange; Computer services, namely, design and development of computer hardware and software for bidirectional secure transmission of data between organizations and/or software and data applications for others; Computer services, namely, providing a system for customers to manage, administer, modify and control their end user computer devices, data, and software applications; Consulting in the fields of IT project management and of computer software and systems relating to data integration and information exchange; Design, development and consulting services in the field of computer hardware and software for data integration and information exchange; Information technology consultation and integration services; Research services in the field of data integration and information exchange.

8. On July 17, 2012, the USPTO acknowledged the distinctiveness of the Mark when it issued a trademark registration on the principal register for the Mark in connection with the services described in the preceding paragraph, U.S. Registration No. 4,173,895. A copy of U.S. Registration No. 4,173,895 is attached hereto as Exhibit A.

9. U.S. Registration No. 4,173,895 is valid and subsisting in law, was duly and legally issued, is prima facie evidence of the validity of the mark registered, and constitutes constructive notice of Uber Operations' ownership of the Mark in accordance with Sections 7(b) and 22 of the Federal Lanham Act, 15 U.S.C. secs. 1115(a), 1057(b), and 1072.

10. As described above, Uber Operations has used the Mark in interstate commerce since at least December 1, 2004. In addition, Uber Operations has registered the trademarks "UberXchange" and "UberMover," U.S. Registration Nos. 4,768,885 and 4,764,793 respectively. Copies of U.S. Registration Nos. 4,768,885 and 4,764,793 are attached hereto as Exhibits B and C.

11. Uber Operations has developed a reputation for offering high quality services and, as a result, has won considerable goodwill for its business.

Uber Tech

12. Uber Tech is a San Francisco-based corporation which has developed a computer software application that allows customers to "get a ride on demand from a nearby driver registered with the UBER service." Uber Tech operates the UBER® website at <https://www.uber.com/> and the UBER® mobile

application, which are accessible to users throughout the United States, including in the State of Florida.

13. On or about November 5, 2010, Uber Tech applied for registration of the mark "UBER" with the USPTO on the Principal Register, Application Serial No. 85170655. On or about June 14, 2011, the USPTO issued Uber Tech Registration Number 3977893 directed to the mark "UBER" for use in connection with:

"Computer software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles," in International Class 009; "Telecommunications services, namely, routing calls, SMS messages, and push-notifications to local third-party motorized vehicle dispatchers in the vicinity of the caller using mobile phones," in International Class 038; "Providing a website featuring information regarding transportation services and bookings for transportation services," in International Class 39; and "providing temporary use of online non-down loadable software for providing transportation services, bookings for transportation services and dispatching motorized vehicles to customers," in International Class 42."

14. In addition, on or about December 2, 2014, Uber Tech applied for registration of composite mark UBER (and design) with the USPTO on the Principal Register, Application Serial No. 86469371, for use in connection with:

"Mobile application software for connecting drivers and passengers; mobile application software for automated scheduling and dispatch of motor vehicles; mobile application software for coordinating

transportation services; mobile application software for engaging transportation services," in International Class.

The above application is still pending.

15. Uber Tech adopted, commenced use, applied to register and registered its above-described mark after Uber Operations first used its Marks, at least in Florida.

16. Uber Tech had actual or constructive notice of Uber Operations' Marks when it adopted and/or sought to register its confusingly similar marks.

Actual Customer Confusion

17. Because of the similarity between Uber Operations' Marks and Uber Tech's mark: (i) prospective customers are likely to be deceived, mistaken, or confused as to the source of origin of Uber Operations' services; (ii) the distinctiveness of Uber Operations' Mark is being diluted; and/or (iii) Uber Tech has caused the likelihood of initial interest confusion and reverse confusion.

18. Actual customer confusion, initial interest confusion and/or reverse confusion have already occurred on numerous occasions, all to the detriment of Uber Operations. In fact, Uber Operations receives and has received multiple telephone calls and emails from the public looking for or complaining about Uber Tech and/or its goods and services. Uber Operations has received thousands of calls, emails, and faxes directed to

Uber Tech. This is a constant business interruption and distraction, resulting in lost time and productivity. In addition, Uber Operations has been sent information relating to background checks, credit checks and other personal information (presumably for Uber Tech drivers or prospective drivers). Uber Operations has been sent packages with phones and other personal items in them. Uber Operations has received financing applications (with personal information) for the "Uber Xchange" leasing program (as previously noted, Uber Operations has used the mark "UberXchange" for many years).

19. Even state governments with whom Uber Operations does business have experienced confusion with Uber Tech. The Attorney General's office has sent Uber Operations legal notices, writs and other court documents, employment verification requests, and other important documents and records intended for Uber Tech. Due to the nature of these documents (which include court orders and documents with deadlines and potential fines or other penalties for failing to respond), Uber Operations has not been able to ignore them, and has had to repeatedly advise attorneys and government agents that Uber Operations is not Uber Tech. Nonetheless, these types of documents intended for Uber Tech continue to be directed to Uber Operations.

20. Individuals have created online reviews of Uber Operations on multiple platforms in an attempt to express displeasure with or direct business away from Uber Tech. Of course, this instead directs potential business away from Uber Operations. Some of Uber Operations' customers first make contact with the company online. It is therefore extremely damaging for its online presence to be affected in this way.

21. UberXchange is the backbone of one of Uber Operations' most important data exchange platforms. Uber Operations logs daily 'support tickets' that appear to be from customers of Uber Tech's leasing program, Uber Xchange. This results in significant lost time and productivity as Uber Operations' employees attempt to sift through the tickets.

22. Worst of all, Uber Operations has received threats of violence and even death threats intended for Uber Tech and its drivers. In an effort to ensure the safety of its employees, Uber Operations has forwarded threats to law enforcement. The ensuing process results in additional lost time and productivity.

23. Although Uber Operations and Uber Tech are not direct competitors, the ubiquitousness of Uber Tech's mark is such that it has saturated the market and overwhelmed Uber Operations' Mark. Additionally, Uber Tech is now moving into healthcare technology and "Uber Health" is being discussed publicly. Uber Tech is apparently already providing services

in conjunction with companies like Circulation, Inc. and Passport Health, and has stated its intention to expand its offerings in the healthcare industry. Uber Operations is a technology company focused on the healthcare industry, and Uber Tech's entry into the healthcare marketplace is highly problematic. For example, Uber Tech uses its technology platform to deliver flu vaccinations and then uses the resulting data to provide information on the effects. From the standpoint of a customer/consumer, Uber Tech is providing data on the flu through an IT platform in an almost identical way to Uber Operations.

24. As a result of this saturation, the public has come to assume that Uber Operations' services are really Uber Tech's or that Uber Operations has become somehow connected to Uber Tech, and Uber Operations has thus lost the value of its trademark, i.e., its corporate identity and control over its goodwill and reputation. Indeed, the constant business interruption, and fear of violence, have caused Uber Operations to remove information from its website, change its phone system to go straight to voicemail (so that only calls directed to Uber Operations are returned), and remove signage and other indication of the location of Uber Operations from its offices to prevent Uber Tech drivers, prospective drivers, and customers from showing up at Uber Operations' offices. Uber Operations had no desire to take any of these steps, all of which are detrimental to its business, but it felt compelled to do so to protect the productivity of its business and the safety of its

workplace. All of this is the direct result of confusion of Uber Operations for Uber Tech.

25. Uber Tech's use and continued registration of its mark and its associated domain names and social media names, in connection with its Services, has caused great and irreparable harm and damage to Uber Operations, its goodwill and business reputation and the distinctiveness of its trademarks and brand and have impaired, blurred, disparaged, tarnished and diluted same.

26. Uber Operations has no adequate remedy at law relative to the continued and future harm expected to be suffered from Uber Tech's continued conduct.

27. The balance of the equities favors preliminary and permanent injunctive relief to restrain and enjoin Uber Tech's wrongful acts from continuing in the future.

28. All prerequisites to filing suit have been satisfied, have occurred or have been waived.

29. Uber Operations has been forced to retain the undersigned firm, and has agreed to pay said firm a reasonable fee for its services.

Count I: Federal Statutory Trademark Infringement

30. Uber Operations incorporates and realleges as if fully set forth herein paragraphs 1 through 29 of the Complaint.

31. Uber Tech's use of the terms "UBER" and "Uber Xchange" constitutes infringement of Uber Operations' Marks and is likely to cause confusion and mistake among the public as to Uber

Operations' approval of and/or connection to Uber Tech's services.

32. By reason of the foregoing acts, Uber Tech is liable to Uber Operations for trademark infringement under 15 U.S.C. sec. 1114.

33. Uber Tech's activities have caused and will cause irreparable harm to Uber Operations for which Uber Operations has no adequate remedy at law. Accordingly, Uber Operations is entitled to injunctive relief pursuant to 15 U.S.C. sec. 1116(a).

34. Uber Operations is also entitled to receive Uber Tech's profits pursuant to 15 U.S.C. sec. 1117(a).

35. Uber Operations is also entitled to recover its attorneys' fees and costs of suit pursuant to 15 U.S.C. sec. 1117(a).

Count II: Common Law Trademark Infringement

36. Uber Operations incorporates and realleges as if fully set forth herein paragraphs 1 through 29 of the Complaint.

37. Uber Operations first used its Mark before Uber Tech used the term "UBER," or any of Uber Tech's other marks, to market or promote Uber Tech's services.

38. Uber Tech's use of the terms "UBER" and "Uber Xchange" infringes on Uber Operations' common law rights in its Marks and has and will continue to have the effect of causing confusion, initial interest confusion, reverse confusion, mistake, or deception as to the source and origin of Uber Tech's services so as to deceive the public by passing off Uber Tech's services as

being manufactured, sponsored, or otherwise approved by or connected with Uber Operations.

39. Uber Tech's acts have damaged Uber Operations' business reputation and have impaired, blurred, tarnished and diluted Uber Operations' goodwill in its Marks.

Count III: Common Law Unfair Competition

40. Uber Operations incorporates and realleges as if fully set forth herein paragraphs 1 through 29 of the Complaint.

41. The tendency and effect of Uber Tech's continued use of the terms "UBER" and "Uber Xchange," which are confusingly similar or identical to Uber Operations' Marks, in the advertising and marketing of Uber Tech's services is to cause confusion, initial interest confusion, reverse confusion, mistake, and deception as to the source of origin of Uber Tech's products and services. Uber Tech's acts have damaged Uber Operations' business reputation and have impaired and diluted Uber Operations' goodwill in its Marks, and constitute common law unfair competition.

42. As a result of Uber Tech's use of the terms "UBER" and "Uber Xchange," which are confusingly similar or identical to Uber Operations' Marks, Uber Operations' reputation and goodwill have been and will be damaged, and Uber Tech has wrongfully profited from its imitation and infringement of Uber Operations' Marks.

Count IV: Declaratory Judgment of Cancellation

43. Uber Operations incorporates and realleges as if fully set forth herein paragraphs 1 through 29 of the Complaint.

44. This claim arises under the federal Lanham Act, 15 U.S.C. secs. 1119 and 1064, and 28 U.S.C. secs. 2201 and 2202, for a declaratory judgment, declaring that Uber Tech's United States Trademark Registration No. 3,977,893 directed to the word mark UBER should be cancelled and directing, by writ of mandamus or other appropriate order to the USPTO, to immediately cancel and remove same from its Principal Register, and any other registers.

45. Uber Operations is the nationwide senior user of the mark UBER, as compared to Uber Tech's use of its marks.

46. Uber Tech's registered mark is being used by Uber Tech so as to misrepresent the source of the goods and services on or in connection with which the mark is used by Uber Tech.

47. Notwithstanding Uber Operations' senior use and priority of right, Uber Tech obtained United States Trademark Registration No. 3,977,893 directed to the word mark UBER, which is likely to be confused with Uber Operations' Mark by consumers and the public.

48. Uber Operations' has been, and will continue to be damaged by the aforementioned registration owned by Uber Tech so long as Registration No. 3977893 remains on the Principal Register, or any register of the USPTO.

49. In addition, defendant's mark which is the subject of Application Serial No. 86469371 is being used by Uber Tech so as to misrepresent the source of the goods and services on or in connection with which the mark is used by Uber Tech.

50. Notwithstanding Uber Operations' senior use and priority of right, Uber Tech filed Application Serial No. 86469371 directed to the word mark UBER (and design) which is likely to be confused with Uber Operations' Mark by consumers and the public.

51. Uber Operations has been, and will continue to be damaged if the aforementioned application matures into a United States Trademark Registration.

Prayer for Relief

Plaintiff, Uber Operations, LLC, respectfully requests that the Court enter judgment in its favor, and against defendant Uber Technologies, Inc., as follows:

1. Awarding Uber Operations actual damages and treble damages pursuant to 15 U.S.C. § 1117;

2. Preliminarily and/or permanently enjoining Uber Tech, and any agent, employee, and all persons acting either on behalf of or in concert with Uber Tech, from: (a) reproducing or displaying the terms "UBER" and "Uber Xchange" in any form, including any derivatives thereof, on its Internet website or otherwise; (b) further creating confusion as to the rightful ownership of Uber Operations' Marks;

3. An enhancement of any monetary award based on profits which this Court, in its discretion, finds just pursuant to 15 U.S.C. §§ 1117, 1118, or as otherwise provided by law;

4. A declaratory judgment, writ of mandamus or other appropriate order to the United States Patent and Trademark Office requiring the immediate cancellation of Defendant's United States Trademark Registrations No. 3977893 directed to the word mark UBER, and to remove same from its Principal Register, and any other registers;

5. A declaratory judgment, declaring that Defendant's United States Trademark Application Serial No. 86469371 to the USPTO's Principal Register for the composite mark UBER (and design) should be finally rejected and that Defendant is otherwise not entitled to registration therefor;

6. An award of Plaintiff's reasonable attorneys' fees incurred in this litigation;

7. An award of Plaintiff's taxable costs and other costs, expenses and disbursements incurred herein;

8. An award of prejudgment and post-judgment interest on all monetary awards; and

9. Entering any other further relief, both legal and equitable, as the Court deems just and proper.

Jury Demand

Plaintiff demands a trial by jury as to all claims so triable.

Respectfully submitted,
AUSLEY & McMULLEN, P.A.

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