

On March 24, 2015, the Office refused registration, pursuant to Section 2(d) of the Lanham Act, 15 USC § 1052(d), on the grounds that Applicant's mark **JUST RIDE** for "providing transportation information for commuters, namely, providing an institution-specific, interactive website for the dynamic optimization of commuting options for individuals all commuting to a single location; and providing transportation information for commuters, namely, providing an institution-specific, interactive website for the dynamic optimization of user-specific commuting options for individuals all commuting to a single location area" is likely to be confused with the mark **JUSTRIDE** (U.S. Registration No. 4,553,845) for "arranging tickets for train, bus and other forms of public transport; booking of tickets for train, bus and other forms of public transport; booking of tickets for travel; booking of travel tickets; information services relating to transport timetables; information services relating to travel; issuing of tickets for travel; on-line transportation reservation and travel ticket reservation services; providing an on-line searchable computer database featuring information on travel; providing travel information to travelers regarding fares, timetables and public transport; provision of computerised travel information; provision of information on matters relating to travel; provision of information relating to travel routes; provision of information relating to travel; provision of travel information; ticket booking services for travel; ticket reservation services for travel; ticketing services for travel; travel and transport information and advisory services; travel information services; travel ticket reservation service."¹

According to the Office, source confusion is likely as the involved marks are "identical in sound and virtually identical in appearance" and because the services "share the same channels

¹ Registration issued on April 8, 2014 to Masabi Ltd.

of trade.” In the same action, the Office requested a disclaimer of **RIDE**, asserting that the term is “merely descriptive” under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). Applicant disagrees upon review and as explained below, requests withdrawal of the refusal and the disclaimer requirement.²

Initially, the marks appear similar in sound and appearance, and when considered in their entireties, arguably project similar commercial impressions. Insofar as Applicant is willing to concede this factor however, the likelihood of confusion analysis does not stop there. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Instead, the final determination involves an analysis of other probative factors, including: 1) the similarities or dissimilarities between the goods, and 2) the established, likely to continue channels of commercial trade. *Federated Foods, Inc., v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Absent some significant relationship or competitive proximity between the services, therefore, confusion under the Lanham Act - even when the marks are identical - is unlikely. *Shen Mfg.Co., v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004).

With that in mind, the Office has not established how the services are related to warrant refusing registration under the Lanham Act. *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009). Indeed, any similarity of purpose and/or channels of trade, as set forth by the Office, are inconclusive for the following reasons.

First, the services at issue differ in several aspects, including their respective purposes. Applicant offers information about commuting options for travelers seeking to visit similar

² The Office accepted Applicant’s amended recitation of services so this is no longer an issue.

locations, and Registrant primarily offers “information” for buying and displaying tickets for public transportation admission. Indeed, per the attachment (Exhibit A), Registrant touts itself as the “ticket machine in your pocket” that lets “you buy and display tickets with your smartphone” for use in connection with public transit vehicles.

Conversely, Applicant does not offer any municipally-sponsored transportation services. Instead, as provided in the Office’s evidence purporting to *support* the refusal (emphasis added), Applicant’s information services are used to “match drivers and riders” privately, in particular co-workers, to “share the cost of their commute.” And, to the extent Applicant offers a “ridesharing” program (Office’s description), wherein passengers share a vehicle as well as any underlying gas expenses and tolls - fees generally not associated with municipal passenger transport - the respective services will not travel in the same channels of trade nor will they be marketed simultaneously or even under similar conditions to the same class of consumer.

Next, the Office has supplied no evidence that the respective services emanate from the same source under the same or a similar mark. This constitutes another probative factor in support of registration, as the Office generally relies upon third-party registrations to establish relatedness.

Moreover, consumer sophistication cannot be overlooked, and also weighs in favor of **JUST RIDE** registering. The respective services are not casually used or consumed impulsively, as they clearly require deliberation as well as collaboration to use. *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 1 USPQ2d 1388, 1392 (Fed. Cir. 1992), quoting *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 212 USPQ 246,

252 (1st Cir. 1981). See also *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) and Trademark Manual of Examining Procedure (TMPE) §1207.01(d)(vii) (October 2014 version) (“there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED” since “only sophisticated purchasers exercising great care would purchase the relevant goods”). Interestingly, the evidence submitted with the Office Action, namely, materials from Registrant’s website, further evidences the deliberative quality of Applicant’s services, which has been completely ignored in this case. Note that Exhibit B, also attached, contains more information about Applicant’s activities and further distinguishes them from those of the Registrant.

Additionally, as **JUSTRIDE** is registered and already coexisting (US Registration No. 4,193,573 attached as Exhibit C), the cited mark should only be afforded the narrowest scope of protection. *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1155 (TTAB 2012). This is especially true as the services in this case are fundamentally different and in no way realistically compete with one another. Thus, even though the marks may be similar, the refusal is not justified under the totality of the circumstances

As for the proposed disclaimer, a term must describe at least one significant function, attribute, or characteristic of the involved services for a disclaimer property to apply. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). Likewise, the context in which the term is used or intended to be used, as well as the significance that the mark would convey to the average, ordinary purchaser of the services, also must be considered. *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

Additionally, determining whether a term is suggestive or merely descriptive is a complex undertaking, so when reasonable people differ on the issue, any doubt must be resolved in Applicant's favor. *In re The Stroh Brewery Co.*, 34 USPQ2d 1796 (TTAB 1995). And the Office - not Applicant - bears the burden of establishing that a term is merely descriptive of the relevant goods or services. *In re Noble Co.*, 225 USPQ 749 (TTAB 1985). Here, the Office has not satisfied that burden.

Opposite the Office's justification for treating **RIDE** descriptively, Applicant in fact features **RIDE** as a prominent indicator of source, capitalizing the beginning letter no matter where the noun appears on its www.ride.com website. For example, Applicant directs the Office to the following, non-exhaustive uses of **RIDE** which consumers would have no choice but to perceive as source-identifying:

- Ride can help you figure it out.
- Ride does all the work: match co-workers, arrange the rides, process transactions and create monthly reports on your company's savings and sustainability impact.
- Ride allows you to quickly contact anyone in your group to discuss logistics, sudden changes, or the finale of your favorite TV show.
- For partnering companies, we'll have a number of clean and ready-to-go cars available at your work location for Ride users.

What's more, at least one of the Office's references - purportedly showing the descriptiveness of **RIDE** and ignored by the Office - unequivocally reflects use as a valid trademark ("As a Ride partner, your company is provided with tools to educate your employees

on the benefits of ridesharing. We make it easy for employees to take their first Ride”). Additionally, the Office is reminded that Applicant seeks registration of **JUST RIDE**, not “JUST RIDES” or “JUST RIDESHARING.” Thus, the Office’s references to “rides” and “ridesharing” to support the refusal are misplaced.

Next, to the extent Applicant offers information for forecasting routes and coordinating commuting options, consumers must engage their imagination to discern the meaning of **RIDE**. This is especially true when the immediate reaction to **RIDE** would be that of something associated with an actual vehicle and nothing more. *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (“SUGAR & SPICE” held not merely descriptive when “the mark clearly does not tell the potential purchaser only what the goods are, their function, their characteristics or their use, or, of prime concern here, their ingredients”).

In that regard, Applicant is obviously not offering a vehicle; instead its application primarily identifies commuting option information. At the very least, contrary to the Office’s assertion, multi-staged reasoning is clearly required to discern the meaning of **RIDE** as Applicant does not offer physical “transport in a vehicle” nor seek to do the same. *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985). Therefore, Applicant’s mark is more than eligible to register on the Principle Register without disclaiming **RIDE**.

Continuing, it does not appear from the record that competition in the sale or production of the relevant services will be blocked by Applicant’s registration of **JUST RIDE** on the Principal Register without a disclaimer. *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1448 (TTAB 2000). Plus, each case must be decided on its own merits; a term’s descriptiveness must be based upon the evidentiary record at the time registration is sought. *In re Nett Designs*

Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Clearly, on that basis, the Office has not fulfilled that evidentiary burden.

Last but not least, **JUST** is also a nebulous, hard to define term capable of various meanings. As such and when paired with **RIDE**, the resulting combination is a unitary phrase whose expression is greater than the sum of its individual components and arguably refers to something that is occurring, but is an impossibility since Applicant is providing commuting information rather than actual vehicles. *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991); §1213.05(b)(ii)(A) and §1213.05 (d) (“TMEP”) (July 2015 Ed.).

In closing, the Office is encouraged to contact the undersigned attorney with questions. Otherwise, Applicant respectfully requests that its mark be approved for publication on the Principal Register as its mark is not confusingly similar to the cited registration and because disclaiming **RIDE** is unnecessary.