

Mark: LYFT

Law Office No. 119

Application Serial No. 86/183891

Examining Attorney: Patty Evanko

Class 39

Owner: Lyft, Inc.

RESPONSE TO OFFICE ACTION

In the Office Action dated April 29, 2014, the Examining Attorney refused registration for the mark LYFT, on the grounds that the mark is merely descriptive of the identified services:

- Class 39: Transportation of passengers by motorized vehicle; Transportation of passengers by vehicle through a network of transportation providers.

Applicant respectfully requests that the refusal be withdrawn, as the mark LYFT is suggestive as when applied to the services enumerated in the application. Alternatively, however, the mark has acquired distinctiveness among consumers and is therefore registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f).

I. APPLICANT’S MARK IS AT LEAST SUGGESTIVE

“To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services.” TMEP § 1209.01(b). “Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.” TMEP § 1209.01(a). *See, In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall

within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread). Marks that are suggestive may be registered on the Principal Register without proof of secondary meaning. TMEP § 1209.01(a).

Further, “[a] mark that vaguely suggests a desirable characteristic of the product, or one that uses the mark in a manner not usually associated with the terms, will be considered suggestive.” TMEP § 1209.01(a), *see In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985); *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972). Moreover, “a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable.” TMEP § 1209.01(a).

A. The Primary Significance of the Mark is Not Descriptive in Nature.

Applicant’s use of the term LYFT (or “lift”) in connection with its services is not demonstrable of any primary significance of descriptiveness. “If a term has a primary significance that is descriptive in relation to at least one of the recited goods/services, and does not create any double entendre or incongruity, then the term is merely descriptive.” TMEP § 1209.03(e). The Examining Attorney has submitted one piece of dictionary evidence to support a finding of descriptiveness. The selected definition of the term “lift” by the Examining Attorney does not appear until the third page of the various definitions for the term “lift,” where it is ranked eleventh in a list of noun forms of the word.

The Examining Attorney’s submission of merely one set of dictionary search results, where the contested term is listed on the third page and in the eleventh ranked spot, cannot be considered adequate evidence to support a descriptiveness refusal. *See In re Stereotaxis Inc.*,

429 F.3d 1039 (2005), where the court stated that a refusal to register a mark on the grounds of descriptiveness should be supported by appropriate evidence.)

Furthermore, the Examining Attorney's refusal to register the mark is actually based on the idiomatic definition of the phrase "give a lift," and not the literal, standalone, meaning of "lift." An idiom is "an expression whose meaning is not predictable from the usual meanings of its constituent elements, as kick the bucket or hang one's head, or from the general grammatical rules of a language, as the table round for the round table, and that is not a constituent of a larger expression of like characteristics." See **Exhibit 1**, attached, available at <http://dictionary.reference.com/browse/idiom?s=t>. The definition cited in the office action by the Examining Attorney does not convey a primary dictionary reference to the term "lift" but instead references an idiomatic form of the term, "gave my friend a lift into town." Applicant does not agree that consumers immediately perceive LYFT as "lift," but for the sake of argument, even if they do, the primary significance of the term "lift" as in "give a lift" does not literally mean to give someone a lift into town. As such, the meaning of "give a lift" is not predictable from the usual meanings of its constituent elements. It is instead an idiomatic expression which roughly means to offer someone a ride in an automobile. Only when viewed in the full context of the idiomatic phrase – and not the singular, primary, literal, meaning – does the term "lift" begin to describe Applicant's goods and services.

"Lift" on its own does not have a primarily descriptive significance in the matter at hand. Even if the meaning of the term "lift" is ultimately deemed relevant to an understanding of the nature of Applicant's goods and services, it does not necessarily result in descriptiveness, as "a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable." TMEP § 1209.01(a).

B. Applicant's LYFT Mark Does Not Immediately Describe the Services.

In order to be merely descriptive, Applicant's mark must immediately convey information as to the services with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981) (emphasis added). Applicant's LYFT mark does not, however, immediately describe the goods and services listed in the application with any degree of particularity. The term "lift" has a multitude of meanings. An examination of dictionary definitions of the term provides definitions that vary from those as a verb meaning "to move or bring (something) upward" (as in "lift your arm"), to "remove or rescind" (as in "to lift a ban"), to the informal meaning "to steal" (as in to "lift another's wallet"). See **Exhibit 2**, attached, available at <http://dictionary.reference.com/browse/lift?s=t>. The term "lift" also is commonly used as a noun to refer to ski slope equipment, an elevator, or the addition of padding to a shoe for extra height. See **Exhibit 3**, attached, available at <http://www.thefreedictionary.com/lift>. In other words, common definitions of the term do not immediately convey with any degree of particularity that "lift" is a mobile software application or a mobile matching service matching drivers with riders. It is, however, a unique term that suggests what Lyft is about as a goods and services provider.

It is true that one of the many definitions of the term "lift" is "a ride in a vehicle given to help someone reach a destination," (see Office Action and <https://education.yahoo.com/reference/dictionary/entry/lift>), but the term has a real and understood connotation that in the case of Applicant's use is suggestive of its overall marketing and brand messaging. Think for a moment about the term "lift" as it relates to the notion of giving someone a ride. When people ask others for a "lift" they are usually asking their friends or family to help them out and do them a favor. A request for a "lift" to a friend is an optional

request where the friend is allowed to say "sorry, but I am too busy" or "I can't because I'm going in the other direction." A service provider does *not* say "sorry, but I'm too busy," in response to a service request. People reserve the term lift when talking to friends and family about giving them rides in a car, not as a term that one uses to convey a transportation match with a stranger.

The LYFT mark is used in connection with a software platform whereby drivers are connected with riders who then provide transportation services in exchange for an optional donation. The drivers and riders do not know each other before being matched up, but the mark is clever and suggests consumers will have a friendly, fun experience just like it was your friend, not a total stranger, driving the car. Indeed, the entire marketing message by Applicant for the LYFT platform supports this and is meant to convey that using its software is a friendly, fun, and even entertaining way to ultimately get from point A to point B. Drivers using the Lyft platform pick up riders in their own car, which often displays a giant pink colored mustache on the grill. *See Exhibit 4.* When a passenger gets in to the *front* seat (usually not the back seat) the driver and passenger "fist bump" with their fists as a greeting. *See Exhibit 5.*

The entire marketing message of Applicant, including the subject mark, is that transportation provided by a stranger should be akin to the experience of having a friend give you a ride. Applicant even uses the registered trademark YOUR FRIEND WITH A CAR® in support of this overall brand message. *See Exhibit 6.* The trademark LYFT is not descriptive, but it is supposed to be disarming and convey a friendly experience. In fact, the mark is so perfectly suggestive it almost makes you forget you are with a stranger, not your friend, and that money may change hands at the end of the experience.

In addition to suggesting that your "friend" is the one giving you a ride, the term "lift" is a double entendre and Applicant uses it in a way to conjure up other definitions for "lift", namely

"to hold up; support high in the air" and lift as in "elevation of spirits or mood". See definitions at **Exhibit 7** from <http://www.yourdictionary.com/lift>. Applicant's platform allows people to turn their own car, free time and sparkling personalities into a potential revenue stream, and it lifts them up (sometimes financially). Riders typically pay less for transportation through Lyft than they would in using a taxi, and it elevates one's spirit to pay less. Indeed, the Applicant uses a number of design marks depicting balloons, such as a balloon with a smiling face, which is lifting a car up into the air in support of this message. See **Exhibit 8**.

The mark LYFT as applied to a mobile market place, matching service providers that are providing the service of driving to those in need of transportation, is used by Applicant in an incongruent way to suggest that individual service providers matched on the platform is as easy as getting a ride from a friend. The mark is a double entendre and as such also conveys that using the platform will lift your spirits in the process. People have fun using Lyft -- laughing about the pink mustache, fist bumping, talking and making friends along the way. The common dictionary definitions of the term "lift" do not immediately describe Applicant's goods and services with any degree of particularity. Instead, a consumer needs to engage in an extended mental inquiry to make the connection between "lift" and Applicant's LYFT goods and services. This need to resort to imagination and multi-step reasoning renders the mark suggestive. TMEP § 1209.01(a); and see *In re George Weston Ltd.*, 228 USPQ at 57. The LYFT mark is so suggestive it makes consumers forget that by using the software platform a stranger will pick them up and provide transportation, not their friend.

II. ACQUIRED DISTINCTIVENESS UNDER SECTION 2(f)

Applicant maintains that its trademark is inherently distinctive. Alternatively, however, Applicant submits that the LYFT mark has acquired distinctiveness among consumers and

therefore is registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). Importantly, on October 25, 2014, the USPTO agreed, and approved Applicant's trademark Application Serial No. 85/743120 for the mark LYFT in Classes 9 and 38, for publication. *See Exhibit 9* (copies of pages from the online PTO record). Applicant urges the Examining Attorney to consider the evidence submitted here, and approve for publication in this case.

A. Evidence Demonstrating Acquired Distinctiveness

“An applicant may argue the merits of an examining attorney's refusal and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness under §2(f).” TMEP §1212.02(c). If Applicant elects to claim acquired distinctiveness in the alternative, “the examining attorney must treat separately the questions of: (1) the underlying basis of refusal; and (2) assuming the matter is determined to be registrable, whether acquired distinctiveness has been established.” *Id.*

The key to establishing acquired distinctiveness, or “secondary meaning” of a mark, is to demonstrate that to the consuming public the mark has come to mean that the product is produced by that particular manufacturer or source. TMEP §1212. “[I]t must be shown that the primary significance of the term in the minds of the consuming public is not the product but the producer.” *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 133, 173 USPQ 820, 823 (S.D.N.Y. 1972). To demonstrate that its mark has acquired distinctiveness, Applicant may submit “any competent evidence” into the record showing that consumers associate the goods and services provided under Applicant's mark with Applicant. TMEP §1212.01. “Actual evidence of acquired distinctiveness may be submitted regardless of the length of time the mark has been used.” *Id.*; see also *Ex parte Fox River Paper Corp.*, 99 USPQ 173, 174 (Comm'r Pats.

1953). “Competent” evidence can take a variety of forms, including items that demonstrate the extent and nature of use of the mark in commerce, and those that tend to show the mark distinguishes the goods and services. 37 C.F.R. §2.41(a). “An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner’s **method of using the mark**, supplemented by evidence of the **effectiveness of such use** to cause the purchasing public to identify the mark with the source of the product.” *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985) [**emphasis added**].

Applicant submits additional exhibits as evidence, including the Declaration of Kristin Sverchek, General Counsel of Lyft, Inc. (**Exhibit 10 - “Sverchek Decl.”**). The evidence is more than “adequate” evidence under the Federal Circuit’s *Owens-Corning* standard because it demonstrates that Applicant’s “method of using the mark” is varied, systematic and extensive, and that the “effectiveness of such use” has resulted in massive brand awareness among consumers and unsolicited media attention at the local, national, and international levels.

B. Method of Using the Mark

Since becoming available in May 2012, Applicant has expended over \$20 million in extensive and continuous marketing and advertising of its LYFT goods and services, across a wide variety of promotional channels. **Sverchek Decl. ¶ 5**. For example, on the Internet, Applicant promotes its LYFT mark via many avenues including but not limited to Facebook Advertising, Google Adwords, Pandora Streaming Radio, Spotify Streaming Radio, I Heart Radio Streaming Radio, Groupon, LivingSocial, Gilt Group, Mobile ad networks, MyLikes Social Advertising, Craigslist, MyPoints email, and Eventful email. **Sverchek Decl. ¶ 6**. Applicant also engages in prolific use of social media channels to advertise, promote, and inform

the consuming public about the LYFT goods and services, maintaining a substantial presence on Facebook, Twitter, and LinkedIn. *See, **Exhibit 11 and Exhibit 13.*** Applicant has not limited its consumer contact to the digital arena. Applicant has paired together passengers and drivers to complete many, many thousands of rideshares per week, and currently operates in more than 65 cities across the United States, including San Francisco, Los Angeles, San Diego, Chicago, Seattle, New York City, Boston, and Washington, D.C.

C. Effectiveness of Such Use

The net result of such use of the mark by Applicant has resulted in substantial recognition of LYFT by the consuming public, which undoubtedly perceives Applicant as the source of the LYFT ride-sharing app and its associated services. The numbers speak for themselves. Since going live in May 2012, Applicant's website at www.lyft.com has been visited by unique visitors over 7 million times and has had over 30 million page views. **Sverchek Decl. ¶ 7.** Search engines currently list Lyft, Inc. and the LYFT trademark as the first returned result from an online search for the term "lyft". *See, **Exhibit 12.*** Additionally, Applicant has engaged in extensive use of social media, creating brand awareness of the LYFT goods and services. For instance, currently: (a) Applicant's LYFT profile has over 222,000 "friends" on Facebook; (b) over 71,000 Twitter account holders follow Lyft's Twitter feed; and (c) Applicant's LYFT LinkedIn page has over 10,000 followers. *See, **Exhibit 13.***

Venture capital firms are so confident in Lyft, Inc., in May of 2013, only one year after the launch of the LYFT app and ride-sharing service, Andreessen Horowitz and others invested approximately \$60 million in Lyft, Inc.'s Series C round of funding. Most recently, Andreessen Horowitz and others invested a further \$250 Million in April 2014 in Lyft's Series D round of funding. *See, **Exhibit 14.*** These investments appear well founded; since the launch of its

business in May 2012, over \$1 Billion has flowed through the LYFT platform. **Sverchek Decl.** ¶ 5. Thus, not only is the LYFT trademark recognized by consumers as a product and service of Applicant, but as one of quality with the vista of a prosperous future.

As a result of Applicant's marketing efforts and the massive response by the consuming public, the LYFT mobile application has been downloaded for Apple iOS devices over 2 million times, and for Android devices, over 1 million times. **Sverchek Decl.** ¶ 4. Currently the LYFT app for Apple iOS ranks among the top ten free travel applications, and it ranks as number 2 for among transportation applications in the Google Play store. *See*, **Exhibit 11.**

Perhaps even more significantly, the LYFT mark and Applicant have received a substantial amount of unsolicited media attention – locally, nationally, and internationally. Applicant's LYFT products and services have been the subject of news coverage by *The Wall Street Journal*, *The Economist*, *The New York Times*, *Forbes*, *CNN* and *BBC*, among many others. This demonstrates that the LYFT mark is known and constantly recognized as a source indicator by consumers, the news media, city and state officials and various governmental entities, as well as traditional transportation providers such as taxicab companies and public transportation services, and competing ride share companies Uber and Sidecar. Applicant submits a table summarizing over 200 articles – a fraction of the total number of articles that have been published – as examples of the types and quality of news coverage devoted to Applicant's LYFT products and services. *See*, **Exhibit 15** (“Table of Articles” setting forth the source, date, and title of each article, and briefly indicating the relevance of each article to Applicant's acquired distinctiveness claim.)¹

¹ Applicant submitted complete copies of the majority of these articles into the USPTO record of its Application No. 85/743120. The materials are voluminous and Applicant submits the

Based on the very substantial evidence of consumer, governmental, and media recognition of the LYFT mark as signifying the products and services of Applicant, it is clear that LYFT has acquired secondary meaning in the minds of the public.

III. CONCLUSION

Applicant maintains that the use of LYFT as contemplated in this application is at least suggestive, and not merely descriptive of the services, and the Examining Attorney's evidence does not support a finding to the contrary. In the alternative, the mark has achieved secondary meaning in the minds of consumers as a product and service of Applicant, and therefore should be allowed registration on the Principal Register. Importantly, any doubts regarding a determination under Section 2(e)(1) must be resolved in favor of the applicant. *See, In re Grand Forest Holdings Inc.*, 78 USPQ2d 1152 (TTAB 2006); *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974 (TTAB 1994); *In re Conductive Services, Inc.*, 220 USPQ 84, 86 (TTAB 1983). For all of these reasons, Applicant requests that the refusal be withdrawn and that the application be approved for publication as inherently distinctive.

summary Table of Articles here in lieu of submitting the articles themselves. Applicant is prepared to submit the articles in full, however, if the Examining Attorney requires.