

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of Fluidity Operations LLC

Serial No.: 88/061,060

Law Office: 120

Filed: 1 August 2018

Examining Attorney: David S. Miller

Mark: FLUIDITY

**AMENDMENT**

Commissioner For Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Sir:

In response to the Office Action issued 19 November 2018, Applicant submits the following amendment and remarks:

**1. Amendment to Goods/Services**

Applicant hereby amends the goods/services in the application to the following:

Financial services, namely providing investment, advisory, and incubating services, for businesses employing smart contract technology, in Class 36

Please cancel the Class 9 goods and the Class 42 services.

**2. Section 2(d) Likelihood of Confusion Refusal**

The Office refused registration under Section 2(d) alleging a likelihood of confusion between the applied-for mark FLUIDITY and the registered mark FLUIDLY. The Office bases

its refusal on its analysis of (1) the similarity of the marks, and (2) the relatedness of the goods and services.

(1) Similarity of the Marks

While each of the two marks in question include the term “fluid”, this term is a commonly-used term in the financial sector, as is its synonym “liquid”. Dictionary.com<sup>1</sup> defines the term “fluid” as:

**fluid**

[floo-id]

*noun*

a substance, as a liquid or gas, that is capable of flowing and that changes its shape at a steady rate when acted upon by a force tending to change its shape.

*adjective*

pertaining to a substance that easily changes its shape; capable of flowing.  
consisting of or pertaining to fluids.  
changing readily; shifting; not fixed, stable, or rigid; *fluid movements*.  
convertible into cash: *fluid assets*.

...

Synonyms for fluid

See liquid.

The commonness of the term “fluid” for financial services is evinced from a search of the Trademark Database at the USPTO and/or a simple internet search for the terms “fluid” and “financial”. A TESS search for the term “fluid” in the Basic Index field and the term “finan\$” in the Goods and Services field returns the following results:

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<sup>1</sup> <https://www.dictionary.com/browse/fluid>, accessed 27 February 2019

Current Search: S1: (fluid\*)(BJ) and (finans)(GS) docs: 14 occ: 37

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	88285897		FLUIDITY SUMMIT	TSDR	LIVE
2	88248846		FLUID CHAINS	TSDR	LIVE
3	88125724		FLUID FUND	TSDR	LIVE
4	88061060		FLUIDITY	TSDR	LIVE
5	87388894	5311101	STARTER-FLUID	TSDR	LIVE
6	85363757	4111439	AFE AMNIOTIC FLUID EMBOLISM FOUNDATION SEEKING ANSWERS, OFFERING SUPPORT.	TSDR	LIVE
7	85351591	4068897	AFE FOUNDATION	TSDR	LIVE
8	85866609	4477143	CSF CHIARI & SYRINGOMYELIA FOUNDATION	TSDR	LIVE
9	79219484	5532422	FLUIDLY	TSDR	LIVE
10	77981625	4071280	FLUID DEVELOPMENT	TSDR	DEAD
11	77624685	3838598	FLUID TRADE	TSDR	DEAD
12	77828549	3784127	FLUID TRADE	TSDR	DEAD
13	77656402		FLUID DEVELOPMENT	TSDR	DEAD
14	76058896		FLUIDMONEY	TSDR	DEAD

As can be seen, there are 14 trademarks returned, all of which – with the exception of numbers 6-8 in the list – deal with financial-related goods and services. For example, FLUID CHAINS includes the identification of “Financial consultation in the field of blockchain and cryptocurrency”; FLUID FUND includes “financial services”; STARTER-FLUID includes “Outsource service provider in the fields of . . . finance and accounting”; FLUID DEVELOPMENT includes “computer and information systems specializing in financial reporting” and “software for . . . financial reporting”; FLUID TRADE includes “Operation of an online financial exchange” and “software for creating and operating online financial exchange”.

A brief internet search using the terms “fluid” and “financial” returned numerous results, such as: Fluid Financial Planning, LLC; Fluid Financial Inc.; Fluid Financial Solutions; Fluid Financial Services; Fluid Trust plc; and numerous articles using the term “fluid” with financial goods and/or services, *e.g.*, Oracle page for the “Finance and Accounting Fluid Homepage”, PeopleSoft Fluid Financial Request, the “Fluid Credit App” in the App Store, etc.

Consequently, the relevant consuming public understands and discerns differences between marks by looking at more than just the base term “fluid”. Furthermore, due to the number of different users of marks including the term “fluid”, no one entity has broad rights.

Therefore, under the sixth *du Pont* factor, the mark comprising predominantly of the term “fluid” is a relatively weak mark:

Evidence of third-party use falls under the sixth *du Pont* factor – the “number and nature of similar marks in use on similar goods.” *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). **If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”** *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

(TMEP §1207.01(d)(iii); bold emphasis added)

Consequently, any similarity of the marks in question is not, by itself, determinative of a likelihood of confusion.

(2) Relatedness of the Goods and Services

Applicant has amended the application to solely request registration in Class 36 for the following amended identification of services:

Financial services, namely providing investment, advisory, and incubating services, for businesses employing smart contract technology, in Class 36

The goods and services identified in the cited FLUIDLY mark are:

Financial services, namely, providing financial information via a website

The services associated with the marks in question are not so related that they would give rise to the mistaken belief that the respective services emanate from the same source. As can readily be seen from the website for FLUIDLY (<https://fluidly.com>), pages of which are appended hereto as Appendix A, the financial information marketed under the FLUIDLY mark deals with cashflow management software. This is in stark contrast to the services identified in

the present application, *e.g.*, investment, advisory, and incubating services for businesses employing smart contract technology. Furthermore, the cashflow management software provided under the FLUIDLY mark are directed to completely different customers and travel in channels of trade that are separate and distinct from the services identified in the present application.

Additionally, each entities' services are such that a relevant consumer would spend a significant amount of time researching and considering the purchase of the services thereby further minimizing any chance of confusion as to the actual source of the services.

Accordingly, looking at the totality of the circumstances there is no likelihood of confusion between Applicant's mark and the cited mark. Therefore, Applicant respectfully requests that the refusal to register the mark FLUIDITY under Section 2(d) be withdrawn.

### **3. Conclusion**

Applicant has demonstrated that there is no likelihood of confusion between the FLUIDITY mark for the amended services and the FLUID mark. Accordingly, Applicant requests that the Office issue a Notice of Allowance.

If any point remains that is deemed best resolved through a telephonic conversation, the Office is hereby requested to contact the undersigned directly.

Should any fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of the same, such a petition is hereby made and the Office is authorized to charge such fees to Deposit Account No. 04-1679.

Respectfully submitted,

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Dated: 27 February 2019

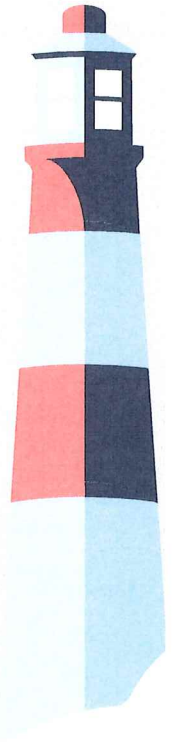
# APPENDIX A



# Intelligent cashflow management software.

AI-powered cashflow forecasting in real time and automated credit control.

START YOUR FREE TRIAL

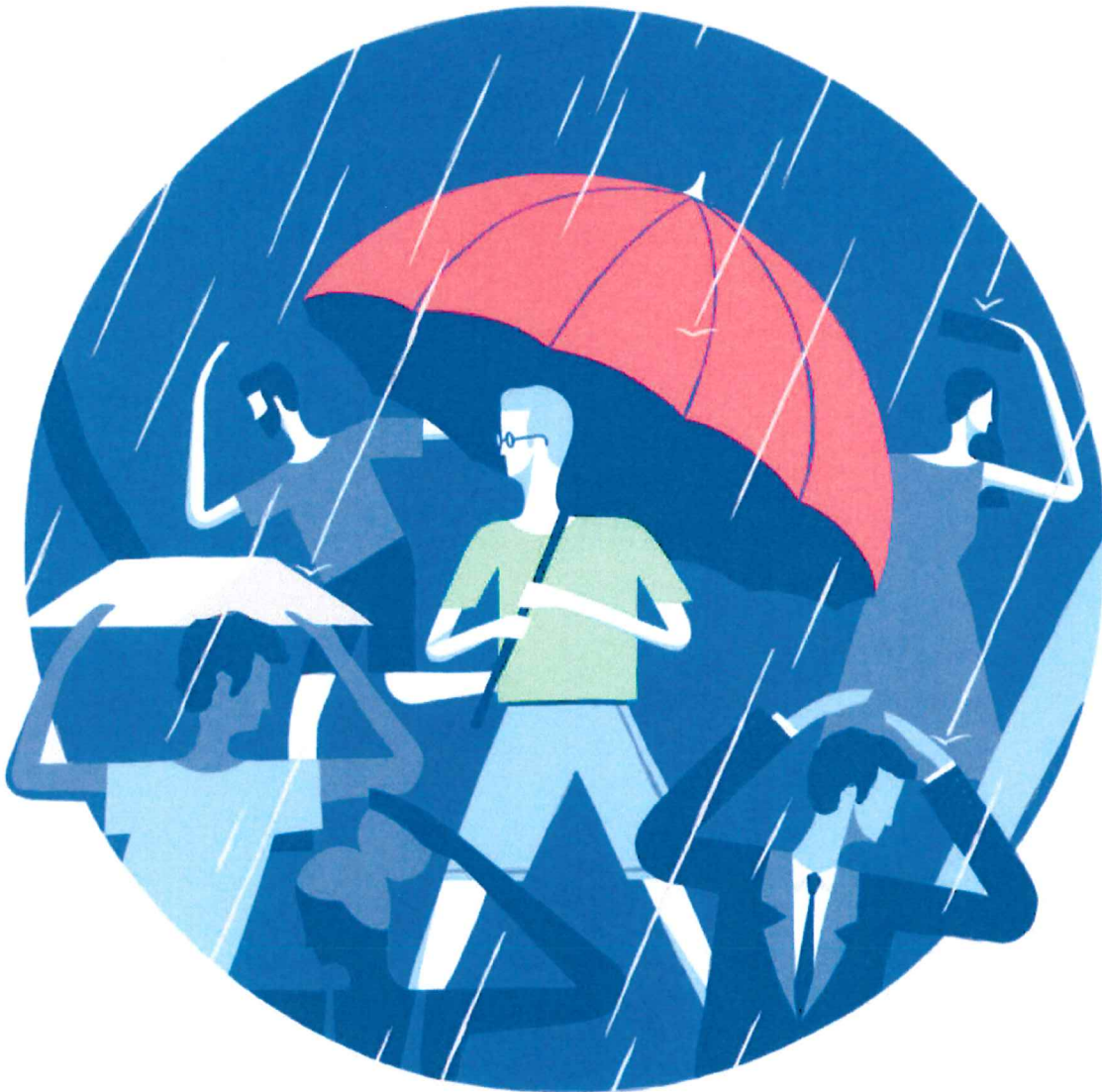


Fluidly provides intuitive cashflow forecasting and





future holds and how to optimise it.



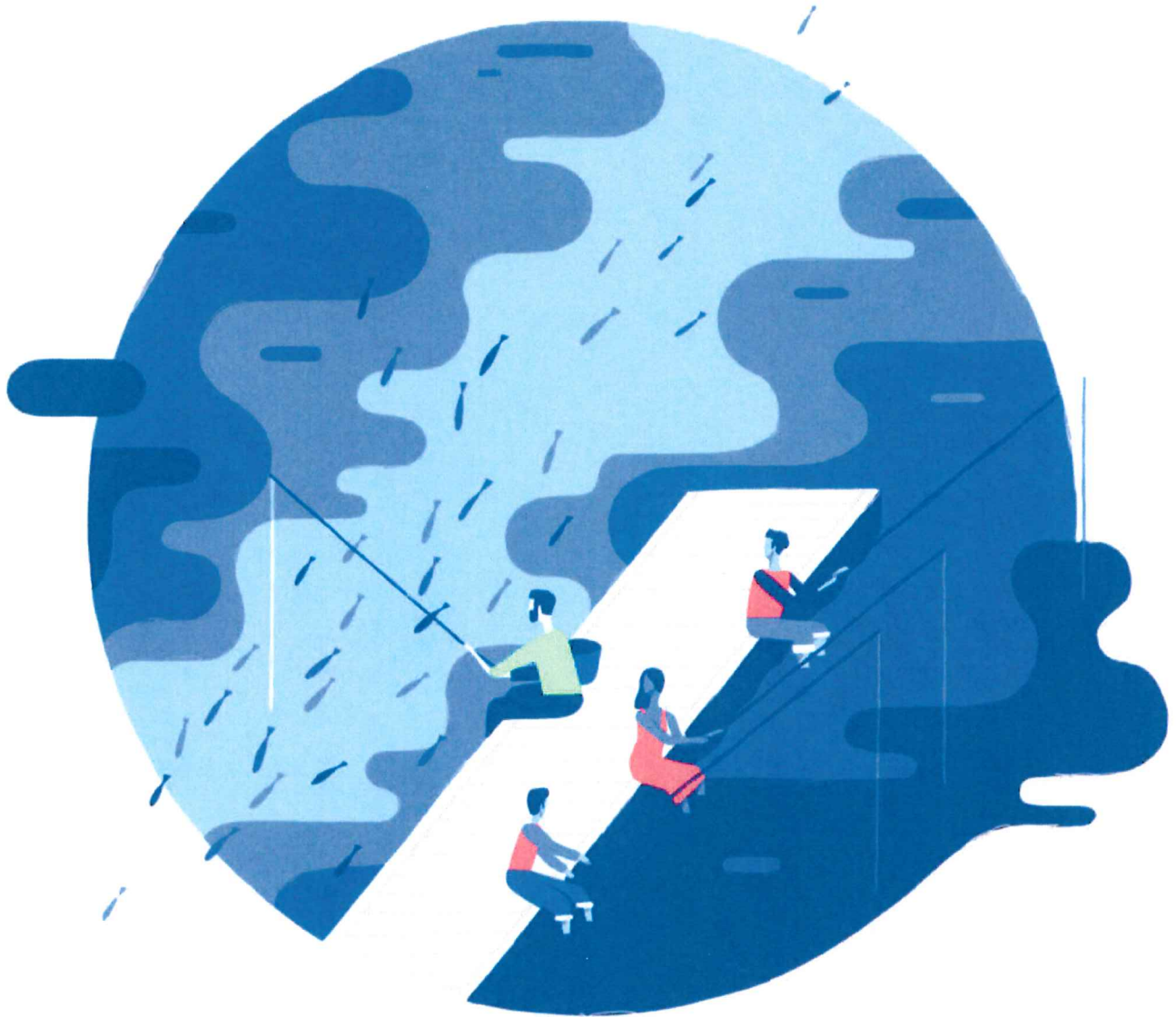
INTELLIGENT CASHFLOW FORECASTING

**Predict the future**



forecast that's always up to date.

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AUTOMATED CREDIT CONTROL

**Maximise opportunities**



Fluidly gets you paid faster and more predictably by speeding up cash collections — send automated emails, schedule calls and keep a complete record of your debtor CRM in one place.

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FINANCIAL CLARITY



Good cashflow management and forecasting is important in order to make effective financial decisions.

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★★★★★

Margaret Laidlaw, Mazars

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★★★★★

Miriam Grant, carwow

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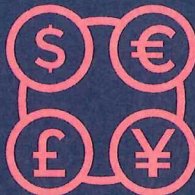


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Multi-currency

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Get the next generation of predictive technology.

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“Having the extra level of confidence in our cashflow that Fluidly provides has been great. Being able to more accurately predict when our invoices will be paid has taken a weight off of my mind and allowed me to focus my attentions elsewhere.”

★★★★★

Lauren Murphy, Adludio

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