

October 9, 2019

United States Patent and Trademark Office
ATTN: Julie H. Choe
Law Office 126
Email: Julie.Cho@uspto.gov

Re: U.S. Application Serial No. 88441961

Mark: CLEARWATER

Response to Nonfinal Office Action, dated August 13, 2019

Ms. Choe:

This letter responds to the Nonfinal Office Action, dated August 13, 2019, in which Clearwater Analytics, LLC's ("**Clearwater**") was refused by the USPTO under Trademark Act 2(d) – Likelihood of Confusion with U.S. Registration No. 3511046.

There is no likelihood of confusion between the applied-for mark ("**Analytics Mark**") and U.S. Registration No. 3511046 ("**Advisors Mark**"). Contemporaneously with this responsive letter, Clearwater is filing a copy of a Trademark Consent Agreement, dated October 3, 2019 ("**Consent Agreement**"), between Clearwater and Clearwater Advisors, LLC ("**Advisors**").

In the Consent Agreement, Advisors explicitly consents to Clearwater's registration of the Analytics Mark International Classes 35 and 42. Further, the parties agree there "is and will be no likelihood of customer confusion." This is supported by the following:

- Clearwater and Advisors previously had these two similar marks without any known customer confusion;
- Advisors provides investment advice; Clearwater does not provide any advice—only analytics and reports;
- Clearwater and Advisors do not compete for the same clients, and there is no overlap in the services provided by either.

To further protect against customer confusion, Clearwater and Advisors have agreed not to advertise or use their respective marks in a way to imply the companies or services offered by each is connected or related to the others. If actual customer confusion is discovered by either party, the parties have agreed to give prompt notice to other party and to take commercially reasonable curative and preventative steps.


The Consent Agreement is entitled to "substantial weight" in determining likelihood of confusion. *See In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 1569 (Fed. Cir. 1993). Because Clearwater and Advisors are on the "firing line," their determination that there is no likelihood of confusion, should play a dominant role in that analysis. *See Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1363 (C.C.P.A. 1973) ("Thus when those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the

scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.”).

Based on the foregoing, there is no likelihood of confusion and Application Serial No. 88441961 should be issued. Please advise of any further questions.

Best regards,

Clearwater Analytics, LLC

A handwritten signature in blue ink, appearing to read "Nick Smith", written over a horizontal line.

By: Nick Smith, Associate General Counsel

Enclosure (Consent Agreement)