

ESTTA Tracking number: **ESTTA499863**

Filing date: **10/12/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Outlier Solutions Inc.
Granted to Date of previous extension	10/13/2012
Address	213 SW Ash St.Suite 205 Portland, OR 97204 UNITED STATES

Attorney information	Robert J. Ireland Ireland & Ireland PC PO BOX 273 Banks, OR 97106 UNITED STATES ip@irelandpc.com, rob@irelandpc.com Phone:503-324-1500
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Applicant Information

Application No	85560270	Publication date	08/14/2012
Opposition Filing Date	10/12/2012	Opposition Period Ends	10/13/2012
Applicant	Outlier Enterprises, LLC Suite 112 1033 Bells Highway Walterboro, SC 29488 UNITED STATES		


Goods/Services Affected by Opposition

Class 042. First Use: 2011/10/10 First Use In Commerce: 2011/10/10 All goods and services in the class are opposed, namely: Application service provider (ASP), namely, hosting computer software applications of others; Application service provider, namely, hosting, managing, developing, and maintaining applications, software, and web sites, in the fields of personal productivity, wireless communication, mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops and mobile electronic devices; Computer software development; Computer software development in the field of mobile applications
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Common-law trademark rights having a priority first use date of May 1, 2005 and having filed an application to register the mark which is currently pending. See 15 U.S.C. 1075(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85716429	Application Date	08/29/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	OUTLIER SOLUTIONS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Computer website design; Design and development of multimedia products; Graphic design services		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BE THE OUTLIER Serial No. 85/750,799 First use: 09/27/2007 in commerce 09/27/2007		
Goods/Services	Class 035 Advertising and marketing		

Attachments	85716429#TMSN.jpeg (1 page)(bytes) Ben's affidavit and attachments.pdf (11 pages)(580256 bytes) Jared's affidavit.pdf (4 pages)(310269 bytes) Notice of Opposition.pdf (6 pages)(329112 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Robert J. Ireland/
Name	Robert J. Ireland
Date	10/12/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 85/560,270
Filed March 5, 2012
For the Mark "OUTLIER APPS"
Published in the Official Gazette (Trademarks) on August 14, 2012

Outlier Solutions, Inc.
a Oregon Corporation;

Opposer,

v.) Opposition No. _____

Outlier Enterprise, LLC
a South Carolina Limited Liability Company,

Applicant

Affidavit in Support of Opposition
Made By Ben Friedle - Co-Founder Outlier Solutions

I, Ben Friedle - Co-Founder Outlier Solutions, Inc., an Oregon Corporation (Opposer) having the business address of 213 SW Ash St., Ste. 205 Portland, OR 97204, make this affidavit and hereby an oath state the following:

1. Outlier Solutions, Inc. was started as an S-Corp, founded by Ben Friedle and Jared Herzog in May of 2005. From the beginning, our sales efforts targeted large metro areas in the United States searching for businesses that would benefit from our Outlier services. Our Outlier promotional and advertising efforts include attending US industry

tradeshows, participating in work groups, and speaking at conferences and symposiums across the United States. We also reach out nationally to our existing customers and our prospective customers through our webpage having the domain OUTLIER.COM.

2. Our philosophy in promotion, advertising and business development services resulted in national recognition within our industry as the "Outliers" from the beginning. Our initial promotional efforts in 2005 resulted in new client accounts to include Clemson University in South Carolina, Labnet International of New Jersey, and BioRep Inc. of New Jersey as well as a mixture of regional clients in Oregon and Washington area. Not only did we reach out under the "OUTLEIR" brand to let people know who we were and what services we provided, but the efforts resulted in new accounts, many of which we service today.
3. At the time in 2005, the term "Outlier" was selected as our service identifier mark including the first term of our company name "Outlier Solutions, Inc. because it was rare and had a technical appeal that matched our business model. Our business model was originally internet based and we differentiated our creative agency by focusing on web as a primary communications channel. Our service summary statement published via the internet across the United States in 2005 read: "Our focus is on leveraging technology to create stronger brand awareness, support lead generation, and aid in product training and promotion."
4. At the time of our founding we were focused on Website development, graphic design, public relations, and video production. With a recent giant trend towards mobile and tablet marketing and development, Outlier Solutions now caters to customers seeking these 'application' based services and presently offers a wide array of application services under the "OUTLIER" brand as provided by Outlier Solutions of Portland Oregon, to include business software development, mobile apps, content marketing, and branding strategy, as well as our core services mentioned previously. Applicant's mobile application services are in direct competition with the services Outlier Solutions provides nationally.
5. Over the last seven years, we have heavily invested in our "Outlier" brand as used in "Outlier Solutions" for the source identifier and "Be The Outlier" as one of our

advertising slogans since September 27, 2012. We also conduct business through various "Outlier" domain names to include, OUTLIER.COM, BETHEOUTLIER.COM, OUTLIERVERIDEOS.COM, and OUTLIERCLIENTS.COM. In short, we have become known as the "Outlier" in the industries that we provide services in.

6. The applicant for the "OUTLIER APPS" mark is Outlier Enterprises, LLC LIMITED LIABILITY COMPANY SOUTH CAROLINA Suite 112 1033 Bells Highway Walterboro-South Carolina, which we find of interest because in 2005 under the "OUTLIER" brand we provided services for "Project Pipeline" of Clemson University web development, graphic design, and Adobe Flash Animation services. Clemson and applicant are about a hundred miles apart
7. Applicant Outlier Enterprises provides services akin and similar to the services we provide, and it appears they do so under the same branding term "OUTLIER" but with a conjunction of a merely descriptive term "APPS". The term of distinction is "OUTLIER", and to allow Applicant a registration for our brand would irrevocably harm our business by diluting our famous mark, creating the circumstance where customers and prospective customers would likely be confused as between the entities suggest affiliation, wrongfully divert leads, and damage our goodwill developed over the last seven years under the brand "OUTLIER".
8. Jared Herzog and I both graduated from Clemson University and both began our careers in North and South Carolina. We have business contacts and clients in this geographic area. Currently, we service large multi-national organizations in the Life Science industry such as Corning Life Sciences Incorporated, and receive regular inquiries from the Research Triangle Park in the Raleigh Durham area of North Carolina.
9. Having nurtured a nationwide client base, and seen 7 years of consistent growth, our record shows that we will continue to attract clients from across the country because of our reputation as the "OUTLIER", having the goodwill associated with our feats in marrying technology and marketing to promote business. We continue to attend conferences and tradeshows for pertinent industries across the United States. For Example: Our Director of Marketing Communications will be promoting Outlier Solutions at a conference in Boston next week.

10. Many of our clients conduct business both nationally and globally, which is proving to increase "OUTLIER" brand recognition which is the likely reason we have consistently seen 30% revenue growth each year. New customers and the customers that have been with us from the beginning all refer to us as the "OUTLIER", and our business philosophy, company practices, slogans, entity name, and domains have promoted this association.
11. Outlier Solutions, Inc. is the exclusive owner for the trademark "OUTLIER SOLUTIONS" including owner of the application having serial number 85716429, filed on August 29, 2012 in International Class 042 for computer website design; design and development of multimedia products; and graphic design services.
12. Outlier Solutions, Inc. is the exclusive owner for the trademark "BE THE OUTLIER" including owner of the application having serial number 85750799, filed on October 10, 2012 in International Class 35 for advertising and marketing services.
13. Between May 2005 through 2011, our company has generated over \$1.5 million dollars in revenue under the "OUTLIER" brand, specifically under the conjunctive use of "OUTLIER SOLUTIONS" and "BE THE OUTLIER" all prior to Applicant's filing date and before Applicant's alleged first use date.
14. We have continuously referred to ourselves as the "OUTLIER" service provider and has provided services under the "OUTLIER" branding theme resulting in over seventy customer accounts with more than half of those accounts in states other than Oregon, including one of the first accounts with Clemson University in South Carolina, the home state of Applicant. (See Attached Customer List with Address).
15. Our company has grown consistently each year even during a recession, and it is expected in 2012 that revenue will exceed half a million dollars.
16. Our repeat customers I attribute to the excellent product we produce, but our strong growth and new client accounts that are coming in from all over the United States I accredit to our reputation as the "OUTLIER" including our company name Outlier Solutions, our slogan "BE THE OUTLIER", and our domain coverage as discussed

above.

Date: October 12, 2012

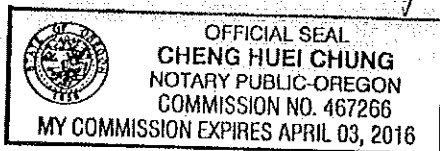
Respectfully confirmed,

By [Signature]
Ben Friedle - Co-Founder Outlier Solutions

SUBSCRIBED AND SWORN to before me this 24 day of October, 2012.

[Signature]
Notary Public for the State of Oregon
My commission expires on:

April / 3rd / 2016



ATTACHMENT 1
Summary of Customer Account Inception
By Date and State

CALIFORNIA

6/16/2006	Hillsboro, CA
8/1/2006	Orange, CA
6/30/2008	Sunnyvale, CA
7/10/2008	San Diego, CA
10/13/2008	Emeryville, CA
8/7/2009	San Francisco, CA
10/27/2010	Los Angeles, CA
5/3/2011	Danville, CA
11/21/2011	Mill Valley, CA

ILLINOIS

11/30/2005	South Holland, IL
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MASSACHUSETTS

11/9/2011	Lowell, MA
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NEW HAMPSHIRE

10/20/2009	West Lebanon, NH
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NEW JERSEY

1/4/2006	Edison, NJ
3/10/2006	Jackson, NJ
8/1/2006	Edison, NJ
6/10/2010	Piscataway, NJ
1/5/2011	Piscataway, NJ
7/12/2012	Edison, NJ

NEW MEXICO

7/2/2012	Moriarty, NM
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ATTACHMENT 1
Summary of Customer Account Inception
By Date and State

NEW YORK

1/4/2011	Gardener, NY
7/5/2011	Northport, NY
5/2/2012	New York, NY

OREGON

5/1/2005	Cornelius, OR
5/1/2005	Newberg, OR
7/25/2005	Hillsboro, OR
10/14/2005	Portland, OR
12/9/2005	Portland, OR
12/26/2005	Tualatin, OR
1/30/2006	Hillsboro, OR
3/7/2006	Hillsboro, OR
4/11/2006	Beaverton, OR
7/20/2006	Eugene, OR
10/2/2006	Portland, OR
3/27/2007	Hillsboro, OR
4/9/2007	Portland, OR
7/13/2007	Portland, OR
9/17/2007	Portland, OR
1/14/2008	Portland, OR
1/29/2008	Lake Oswego, OR
3/17/2008	Milwaukie, OR
4/3/2008	Portland, OR
6/18/2008	Beaverton, OR
9/19/2008	Portland, OR
12/18/2008	Portland, OR
12/2/2009	Portland, OR
1/6/2010	Beaverton, OR
4/22/2010	Salem, OR
1/4/2011	Wilsonville, OR
1/28/2011	Portland, OR
3/29/2011	Gresham, OR
11/22/2011	Beaverton, OR
1/13/2012	Portland, OR
3/15/2012	Hillsboro, OR
6/15/2012	Portland, OR

ATTACHMENT 1
Summary of Customer Account Inception
By Date and State

7/3/2012	Portland, OR
9/5/2012	Milwaukie, OR

SOUTH CAROLINA

5/1/2005	Clemson, SC
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TEXAS

12/6/2005	Georgetown, TX
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TENNESSEE

12/6/2006	Oneida, TN
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WASHINGTON

7/11/2006	Seattle, WA
7/21/2006	Seattle, WA
9/18/2007	Vancouver, WA
10/25/2007	Seattle, WA
11/4/2008	Vancouver, WA
7/2/2009	Kent, WA
1/21/2010	Seattle WA
1/27/2010	Liberty Lake, WA
8/12/2010	Vancouver, WA
8/17/2010	Vancouver, WA
12/30/2010	Seattle, WA
7/5/2011	Liberty Lake, WA
11/8/2011	Airway Heights, WA

ATTACHMENT 1

Fitova	Invoice	8/17/2010 700 SE 16Dth Ave.	Vancouver WA 98684
Friedle Construction	Invoice	1/4/2011	Gardener, New York
Goldstar	Invoice	10/27/2010	Los Angeles, CA
Icon Time	Invoice	6/18/2008	15201 NW Greenbrier Pkwy., Beaverton, OR 97006
IEEE	Invoice	1/5/2011	445 Hoes Lane 5320 SW Macadam Piscataway, NJ 08854
Inflow	Invoice	7/3/2012	Ave. Portland, OR 97239
Communications	Invoice		11880 SW Wilsonville, OR 97070
InnerSkil	Invoice	1/4/2011	Riverview Lane 97070
Pacific Northwest Chapter, IPC Designers	Invoice	3/27/2007	Hillsboro, OR Milwaukie, OR 97222
J&PWire	Invoice	3/17/2008	International Way 5720-C NE 121st Vancouver, WA 98682
KASO Plastics	Invoice	8/12/2010	Ave. 98682
Kevin Spence Attorney (Out of Business)	Invoice	12/18/2008	620 SW Main St., Suite 338 Portland, OR 97205
Kinetix EV (out of business)	Invoice	8/1/2006	Edison, New Jersey
The Kotter Group	Invoice	12/30/2010	1000 Second Ave., Suite 3300 Seattle, WA 98104
L&M Precision Fabrication	Invoice	11/8/2011	13026 W. McFarlane Rd. Airway Heights, WA 99001
Labnet International	Invoice	1/4/2006	31 Mayfeild Ave Edison, NJ 08837
Macadoos Grille	Invoice	7/5/2011	Northport, Long Island
Main Street Development	Invoice	1/14/2008	Portland, OR
Memorytime Inc.	Invoice	12/9/2005	6605 SW Macadam Ave Portland, OR 97239
Miles Consulting	Invoice	3/29/2011	Gresham, OR
Miles Fiberglass	Invoice	9/17/2007	8855 S.E. Otty Road Portland, OR 97266
MINDS-i Inc.	Invoice	7/5/2011	22819 E. Appleway Liberty Lake, WA, 99019
Monsoon Commerce	Invoice	10/13/2008	1250 45th Street Suite 100 Emeryville, CA 94608
Measurement Tec 1 NW	Invoice	7/11/2006	4211 24th Avenue West Seattle, Washington 98199
Nationwide Notary Network	Invoice	4/9/2007	310 SW 4th Ave. Ste. 805 Portland, OR 97204
NECC Workshop	Invoice	7/20/2006	Eugene, OR
ISTE	Invoice	1/6/2010	Beaverton, OR
NewKinetix	Invoice	6/16/2006	
Northwest EMC	Invoice		22975 NW Evergreen Pkwy., Hillsboro, OR 97124
Northwest EMC	Invoice	1/30/2006	#400

ATTACHMENT 1

Company	Type	Date of First Doing Business	Address	City State
2011 EMC Symposium	Invoice	6/10/2010	445 Hoes Lane	Piscataway, NJ 08854
Accurate Dispersions	Invoice	11/30/2005	192 West 155st. 5055 N. Greeley Ave.	South Holland, IL 60478
adidas	Invoice	1/28/2011	Ave.	Portland, OR 97217
AL-TAR Services	Invoice	6/30/2008	12019 NE 99th St#	Vancouver, WA 98682
Alpha Tee	Invoice	9/18/2007	1780 22819 E. Appleway	Liberty Lake, WA, 99019
ALTEK Inc.	Invoice	1/27/2010	Ave.	San Francisco, CA 94101
Bay Creative BenchMark Scientific	Invoice	8/7/2009	110 Sutter St.	Edison, NJ 08818
Big South Fork Airpark	Invoice	7/12/2012	PO Box 709 1 Airpark Way	Oneida, Tennessee, 37841
BioCision LLC	Invoice	12/6/2006	775 E. Blithesdale	Mill Valley, CA 94941
BioRep Inc (Out of Business)	Invoice	11/21/2011	Ave Ste 203	Jackson, NJ 08527
Body of Being (out of business)	Invoice	3/10/2006	32 Serendipity Dr.	Jackson, NJ 08527
Cascade TEK	Invoice	7/13/2007	5245-A NE Elam	Portland, OR Hillsboro, OR, 97124
ControiTEK	Invoice	7/25/2005	Young Pkwy 3905 NE 1121h	Vancouver, WA 98682
CORE Logistics	Invoice	11/4/2008	Avenue	Danville, CA 94526
CORE77	Invoice	5/3/2011	PO box 975 561 Broadway, 6th	New York, NY 10012
Corinthian Textile Solutions	Invoice	5/2/2012	Floor 9800 Southeast	Milwaukie, OR 97222
Corning Life Sciences	Invoice	9/5/2012	Main Street, Tower 2, 4th Floor,	Lowell, MA 01851
Developmen!Now Digital Control Systems Inc.	Invoice	11/9/2011	900 Cheimsford St.	Lowell, MA 01851
Dreamlife Sports Dry Snow Technologies	Invoice	12/2/2009	310 SW 4th Ave 7401 SW Capitol	Portland, OR 97204
EMA of Oregon Engineered Compost Systems	Invoice	10/14/2005	Hwy	Portland, OR 97219
Dreamlife Sports Dry Snow Technologies	Invoice	10/2/2006	6188 NW 112th Ave	Portland Or 97220
EMA of Oregon Engineered Compost Systems	Invoice	1/21/2010	2373 NW 185t,	Seattle WA
EMA of Oregon Engineered Compost Systems	Invoice	3/7/2006	PMB 670 4211 24th Avenue	Hillsboro, OR 97124 Seattle, Washington 98199
EMA of Oregon Engineered Compost Systems	Invoice	7/21/2006	West	Orange, CA 92869-5242
EPS Ovens	Invoice	8/1/2006	574 S. Shasta Way	5242
Falcon Industries	Invoice	7/2/2012	P.O. Box 1459 6000 Meadows	Moriarty, NM 87035 Lake Oswego, OR 97035
Ethics Point Inc.	Invoice	1/29/2008	Road, Suite 200 9606 Aero Drive,	San Diego, CA 92123
Event Network	Invoice	7/10/2008	Suite 1000	92123

ATTACHMENT 1

Chehalem Insurance Associates	Invoice	22134 SW Hillsboro Hwy	Newberg, OR 97132
OMAXCorp	Invoice	7/2/2009 21409 72nd Ave. S	Kent, WA 98032
OnThePlates	Invoice	6/15/2012	Portland, OR
OnCare	Invoice	1631 NE Broadway, #813	Portland, OR 97232
Plasti-Fab	Invoice	12/26/2005 Po Box 100	Tualatin, OR 97062
Project Pipeline (Clemson, University)	Invoice	5/1/2005 409-B Tillman Hall	Clemson, SC 29634-0705
PSU Center for Design & Innovation Business	Invoice	4/3/2008	Portland, OR
REMANTECH	Invoice	17622 NW Rolling Hill Lane	Beaverton, OR 97006
RFM Preferred Seating	Invoice	4/11/2006	
RNA Networks	Invoice	3/15/2012 619 SW Wood St. 34 NW 1st Ave,	Hillsboro, OR 97123
San Gabriel House Seattle	Invoice	9/19/2008 Suite 400	Portland, OR 97209
Refrigeration (out of business)	Invoice	1008 E. University Ave.	Georgetown, Texas 78626-6111
Sheldon Manufacturing	Invoice	12/6/2005	
		10/25/2007 1050 S. Director St.	Seattle, WA 98108
		5/1/2005 P.O. Box 627	Cornelius OR 97113
Textco BioSoftware	Invoice		West Lebanon, NH 03784
Trusted Computing Group	Invoice	10/20/2009 27 Gilson Road	Beaverton, Oregon 97006
Ultra Tape	Invoice	11/22/2011 3855 SW 153rd Drive	
		4/22/2010 2814 19th St., SE	Salem, OR 97302

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 85/560,270
Filed March 5, 2012
For the Mark "OUTLIER APPS"
Published in the Official Gazette (Trademarks) on August 14, 2012

Outlier Solutions, Inc.
a Oregon Corporation;

Opposer,

v.) Opposition No. _____

Outlier Enterprise, LLC
a South Carolina Limited Liability Company,

Applicant

Affidavit in Support of Opposition
Made By Jared Herzog- Co-Founder Outlier Solutions

I, Jared Herzog - Co-Founder Outlier Solutions, Inc., an Oregon Corporation (Opposer) having the business address of 213 SW Ash St., Ste. 205 Portland, OR 97204, make this affidavit and hereby an oath state the following:

1. The strength of our brand, ranking of our web site, and effectiveness of our advertising under the Outlier brand has yielded Outlier unsolicited, initial contacts from customers across the United States, and across the world to include international corporations such as Adidas, and Accurate Dispersions (partnered with Sherwin Williams), Goldstar, and

most recently, discussions with Microsoft as to providing innovative marketing strategies, media products, and web based promotion in the immediate future.

2. Our 'Outlier' philosophy in advertising and business development services has over the years resulted in national recognition within our industry as Outlier Solutions of Portland being the one and only "Outliers" of modern media marketing.
3. The meaning behind "Outlier" fit our business model, as we strive to deviate from the normal advertising and marketing services by approaching each project as a team effort with our customer. Our products are never the same, as no two customers have the same needs, thus our services are custom crafted to the needs of our customers.
4. At the time of our founding we were focused on Website development, graphic design, public relations, and video production. With a recent giant trend towards mobile and tablet marketing and development, Outlier Solutions now caters to customers seeking these 'application' based services and presently offers a wide array of application services under the "OUTLIER" brand as provided by Outlier Solutions of Portland Oregon, to include business software development, mobile apps, content marketing, and branding strategy, as well as our core services mentioned previously.
5. Applicant's mobile application services as displayed on their webpage are in direct competition with the services Outlier Solutions provides nationally and specifically in South Carolina.
6. Over the last seven years, we have continuously invested time and energy into our 'Outlier' identity, our 'Outlier' brand, and our 'Outlier' culture as shared with our clients. On our webpage at www.outlier.com/services we state "Outlier is a full service agency with a diverse skill set, yet we described all of our services simply as marketing."
7. We conduct much of our business through various "Outlier" domain names to include, OUTLIER.COM, BETHEOUTLIER.COM, OUTLIERVIDEOS.COM, and OUTLIERCLIENTS.COM.

8. Clemson University was one of our first customer accounts. We continue to provide business services and continuous conversations as to future services with Clemson University in South Carolina and customers in the surrounding areas including Charleston South Carolina, Oneida Tennessee, and North Carolina, all within driving distance from Applicant's business address.
9. The languages and structure of Mobile Apps Development and Website Development belong to the same field of occupation as ours at Outlier Solutions, Inc.. Outlier Solutions has already been solicited and provided quotes for mobile apps across the United States, and in response to meet this new demand, Outlier Solutions development team has conducted training and developed of in-house skill sets specific to drafting applications, developing mobile based services and smart phone support.
10. With the increase of current Outlier Solutions customers requesting mobile device service as a compliment to their Outlier web based assets, I believe mobile devices and mobile app development will be key to the future success of any creative agency such as Outlier Solutions. I further believe that the use of OUTLIER APPS will cause confusion as to affiliation and allow Applicant to wrongfully trade on our Outlier reputation in South Carolina and surrounding states.
11. Outlier has attended the national conference on Drupal for the three years (San Francisco, Chicago, and Denver). All members of our development team attended this show and represented themselves as Outlier. Drupal is the framework that the majority of our web projects were built on. At this past year's conference, Outlier's lead developer attended sessions, training courses and focused their professional development work on mobile app development with Drupal. Outlier and its developers are currently members of the International Drupal Association.
12. Outlier's client "New Kinetix" sole business product "the Rē" was an iPod/iPhone/iPad accessory and mobile application that extended IR Remote capabilities to these devices.. Outlier built New Kinetix's website, mobile website, localized website, marketing materials, videos and developed marketing strategy for this product. This product was sold exclusively in the mobile device and app marketing place including the official Apple App Store.

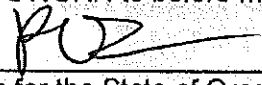
13. In partnership with our customers that conduct business worldwide we have implemented a number of localized products including Spanish, and French versions of websites, videos and marketing assets for Labnet International, Sheldon Manufacturing, and Plasti-Fab.
14. The Outlier brand is credited for the promotional assets, diverse web products and videos have greatly increased exposure for our Outlier brand, and is currently resulting in international brand recognition.
15. We have developed the OUTLIER brand over the last seven years and for the first time we are being asked, "Did you set up the outlierapps.com webpage, is that you?" Just having the question asked confirms that some of our current customers are likely confused and it is also likely prospective customers may believe that our good reputation in South Carolina and surrounding states is affiliated with Outlier Apps, which we are not.
16. Allowing OUTLIER APPS to exist as a registered mark would cause massive brand confusion as Applicant is a direct competitor, and the services we provide overlap with theirs.

Date: October 12, 2012

Respectfully confirmed.

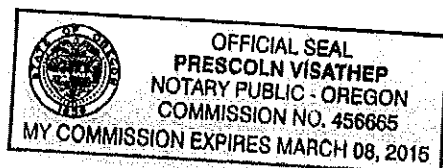
By 
Jared Herzog - Co-Founder Outlier Solutions

SUBSCRIBED AND SWORN to before me this ___ day of October, 2012.



Notary Public for the State of Oregon

My commission expires on: 03/08/2015



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 85/560,270
Filed March 5, 2012
For the Mark "OUTLIER APPS"
Published in the Official Gazette (Trademarks) on August 14, 2012

Outlier Solutions, Inc.
a Oregon Corporation;

Opposer,

v.

)

Opposition No. _____

Outlier Enterprise, LLC
a South Carolina Limited Liability Company,

Applicant

NOTICE OF OPPOSITION

Outlier Solutions, Inc., a Oregon Corporation (Opposer) having the business address of 213 SW Ash St., Suite 205, Portland, OR 97204 believes that it will be damaged by the registration of the mark "OUTLIER APPS", which is the subject of application Serial No. 85/560,270 published in the Official Gazette on August 14, 2012, and hereby opposes the registration of said mark and requests that registration be refused. As grounds in support of its opposition, Opposer presents that:

1. Opposer is a nationwide provider for marketing services relating to business development and promotion including but not limited to computer website design; design and development of multimedia products; and graphic design services, and has been conducting business as Outlier Solutions, Inc., and providing services under the a.k.a of "OUTLIER" since May 1, 2005.
2. Opposer has continuously used the mark "OUTLIER" in conjunction with the descriptor "Solutions" as both a company name and as a brand in the subject industries to include use of the mark "OUTLIER" in conjunction with the advertising slogan "BE THE OUTLIER" since September 27, 2007.

3. Opposer is the exclusive owner for the trademark "OUTLIER SOLUTIONS" including owner of the application having serial number 85/716,429, filed on August 29, 2012 in International Class 042 for computer website design; design and development of multimedia products; and graphic design services.

4. Opposer is the exclusive owner for the trademark "BE THE OUTLIER" including owner of the application having serial number 85/750,799, filed on October 10, 2012 in International Class 35 for advertising and marketing services.

5. Opposer is famously known as the "OUTLIER" providing specialized services since 2005 for promotion, marketing, advertising, business web development and graphic design industries, and Opposer's services are referred to as "OUTLIER" professional services coming from a source of origin from Outlier Solutions Inc. of Portland Oregon, "OUTLIER" being the first word of the service mark having the greatest distinguishing value and carries with it the greatest consumer recognition and good will as within the identified industries and among Opposer's prospective customer base.

6. On 3/5/2012, Applicant filed an application to register the mark "OUTLIER APPS" for an application service provider (ASP), namely, hosting computer software applications of others; Application service provider, namely, hosting, managing, developing, and maintaining applications, software, and web sites, in the fields of personal productivity, wireless communication, mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops and mobile electronic devices; Computer software development; Computer software development in the field of mobile applications in international class 042, and was assigned application serial number 85/560,270. The mark was published in the Official Gazette on August 14, 2012.

7. Opposer's continuous use of the term "OUTLIER" as an identifier for the source of their specialized services since 2005 provides unequivocal common law trademark rights predating and having priority over Applicant's application for "OUTLIER APPS".

8. Opposer began advertising using the terms "OUTLIER" as their source identifier and specifically "OUTLIER SOLUTIONS" nationally in May of 2005 through their web portal content, mailers/flyers, and by participating in conferences and trade shows across the United States.

9. Opposer has continuously referred to themselves as the "OUTLIER" service provider and has provided services under the "OUTLIER" branding theme resulting in over seventy customer accounts with more than half of those accounts in states other than Oregon, including one of the first accounts with Clemson University in South Carolina, the home state of Applicant.

10 Between May 2005 through 2011, Opposer has generated over \$1.5 million dollars in revenue under the “OUTLIER” brand, specifically under the conjunctive use of “OUTLIER SOLUTIONS” and “BE THE OUTLIER” all prior to Applicant’s filing date and before Applicant’s alleged first use date. Further, Opposer has benefitted from a consistent 30% increase in business revenue under the “OUTLIER” brand to include expected revenue for 2012 to exceed half a million dollars. Opposer’s extensive advertising, growing national customer base, developed good will, and established reputation as “Outlier Solutions, Inc.” of Portland Oregon, a.k.a. OUTLIER benefits from the protections afforded under the Section 43(c) of the Trademark (Lanham) Act.

11. Applicant’s “OUTLIER APPS” proposed trademark in application shares the exact term of distinction with Opposer’s common law trademark “OUTLIER”, and Applicant’s proposed mark so resembles or mimics Opposer’s applied for trademark registrations for “OUTLIER SOLUTIONS” and “BE THE OUTLIER”, each having the first term or the term of distinction being “OUTLIER”, that the exacting similarity in sound and appearance is likely to cause confusion, mistake, or deception, when used in connection with any mobile application service provider services (ASP), namely, hosting computer software applications of others; application service provider, namely, hosting, managing, developing, and maintaining applications, software, and web sites, in the fields of personal productivity, wireless communication, mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops and mobile electronic devices; Computer software development; Computer software development in the field of mobile applications, as ‘use’ is defined within the meaning of Section 2(d) of the Lanham Trademark Act.

12. Applicant’s “OUTLIER APPS” proposed trademark in application is filed in the exact same international class 042 as Opposer’s application for principal registry for “OUTLIER SOLUTIONS”.

13. Applicant’s “OUTLIER APPS” mark indicates or wrongfully suggests that Applicant is Opposer, or in the least has an affiliation with the Opposer by using the “OUTLIER” term as an identifier for Applicant’s services relating to the same types of services provided historically by Opposer.

14. Applicant’s “OUTLIER APPS” mark so resembles Opposer’s common law trademark “OUTLIER” and pending application for principal registration for “OUTLIER SOLUTIONS” and “BE THE OUTLIER” that it causes dilution of the distinctive quality of Opposer’s marks, specifically the distinguishing first term “OUTLIER”, as defined within the meaning of Section 43(c) of the Lanham Trademark Act.

15. In view of the reasons stated above, Opposer will be damaged by the registration Applicant seeks because the registration will assist and support Applicant in trading on the reputation and good will of Opposer, confusing or misleading consumers as to Applicant's affiliation with Opposer, diluting Opposer's common law trademark rights in "OUTLIER", diluting if not encroaching on Opposer's applied for principal registration of the marks "OUTLIER SOLUTIONS" and "BE THE OUTLIER", and improperly gives color of exclusive statutory rights to Applicant in violation and derogation of Opposer's first in time priority trademark rights.

LEGAL FOUNDATION DISCUSSED

United States trademark law, which necessarily includes applicable common law, does not provide the 'first to file' applicant priority preference over the 'first to use' owner of the mark. The 'first to use' date on which a mark was first used by its owner in the United States provides the right of priority, irrespective of whether the mark is ever registered in the U.S. Trademark Office. Use as a service mark, a brand, or an identifier as to the source of origin are all 'uses' of an unregistered common law mark that in the United States, unequivocally provide the user, here Opposer, territorial priority trademark rights.

Opposer's first in time 'use' of OUTLIER as a brand for the subject services advertised nationally in the U.S. since May 2005 deriving clients from across the country coupled with Opposer's applied for principal registration mark "OUTLIER SOLUTIONS" claiming first use in commerce May 2005, and applied for principal registration mark "BE THE OUTLIER" claiming first use in commerce of October 2007 establishes a right of priority even over the first to 'file' U.S. application for OUTLIER APPS.

Anticipating Applicant's statutory argument, there is a method for establishing priority trademark rights through 'constructive use' of the mark by filing an application to register on the principal registry thereby conferring a nationwide right of priority that takes precedent over a later date of actual common law use. However, this 'constructive use' of the mark does not trump earlier in date actual common law use. Also of import, the application to register necessarily must mature into a principal registration. Section 7(c) of the U.S. Trademark (Lanham) Act, 15 U.S.C. § 1057(c), defines this core "first to file" tenet of U.S. Trademark Law as follows:

Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in

effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing—

(1) has used the mark;

(2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or

(3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 44(d) [§ 1126(d)] of this title to register the mark which is pending or has resulted in registration of the mark.

(Underline Emphasis Added)

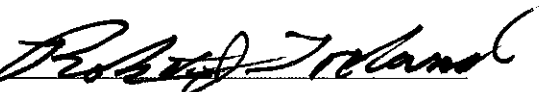
Here, Applicant does not have the benefit of a principal registration, and thus no statutory ‘constructive priority’. Of worthy note, Opposer has a first use date of the OUTLIER mark dating back to 2005 in South Carolina when services for Clemson University were performed under the OUTLIER brand, and under the service mark OUTLIER SOLUTIONS, all provided by Opposer. Opposer has filed two applications to register principally the marks “OUTLIER SOLUTIONS” and “BE THE OUTLIER” cleanly satisfying the Section 7(c) of the U.S. Trademark (Lanham) Act, 15 U.S.C. § 1057(c).

WHEREFORE, Opposer prays that the opposition be sustain and that the registration be refused.

Date: October 12, 2012

Respectfully submitted.

IRELAND & IRELAND P.C.

By 

Robert J. Ireland OSB 00451, USPTO 47,237, WSB 38661

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing NOTICE OF OPPOSITION was served upon the listed owner on the subject application, listed attorney of record on the subject application, and was served upon the listed Registered Agent of the owner of the subject application 85/560,270:

Applicant/Owner:

Outlier Enterprises LLC
1033 Bells Highway
Suite 112
Walterboro, SC 29488

Attorney of Record:

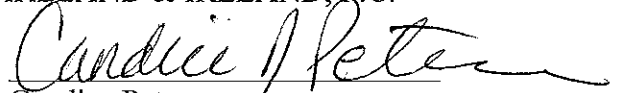
Mr. Hunter St. Clair Copley Freeman
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PO Box 447
Greenville, SC 29602

Registered Agent:

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Walterboro, SC 29488

By mailing true copies of said document by first class mail in sealed, postage paid envelopes, addressed as set forth above on the 12 of OCTOBER, 2012

IRELAND & IRELAND, P.C.


Candice Peterson