

**IN THE UNITED STATES DISTRICT COURT  
FOR THE  
DISTRICT OF NEW HAMPSHIRE**

NEW HAMPSHIRE PUBLIC RADIO, INC.,

Plaintiff,

v.

MARIAH MEDIA NETWORK, LLC

Defendant.

Civil Action No.

**COMPLAINT**

Plaintiff, New Hampshire Public Radio, Inc., (“NHPR”) by and its undersigned counsel, submits this Complaint against Defendant, Mariah Media Network, LLC, for Declaratory Judgment and other relief, and in support thereof alleges the following:

**NATURE OF THE ACTION**

1. This action is brought pursuant to the Declaratory Judgment Act. NHPR seeks declaratory relief under the Lanham Act that use of the OUTSIDE/IN™ for its podcast is lawful and does not infringe any trademark rights Defendant has in the “Outside” mark. Defendant incorrectly claims the scope of its trademark protection covers podcasts and threatens to sue NHPR. Defendant’s attempt to prevent NHPR’s lawful use of its non-infringing OUTSIDE/IN™ mark is an unlawful restraint on competition in violation of the Lanham Act. Declaratory relief is warranted.

## **JURISDICTION AND VENUE**

2. This is an action for a declaratory judgment arising under (i) 15 USC § 1051 *et seq.* (the “Trademark Act”); (ii) 15 U.S.C. §1125, *et seq.* (the “Lanham Act”); and (iii) 28 U.S.C. §§ 2201 and 2202 (the “Declaratory Judgment Act”). This Court has original jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338.

3. The Court has personal jurisdiction over Defendant because Defendant engages in business within the State and operates an interactive website available for access within the State. Defendant distributes and mails its publication, *Outside Magazine*, in this District.

4. Defendant, directly and indirectly, has made use of the means and instrumentalities of interstate commerce and of the mails in sending correspondence to NHPR and its counsel in this District, in connection with its acts, practices and courses of business, and specifically in furtherance of its claims of trademark infringement and trademark dilution as alleged herein.

5. Venue is proper under 28 U.S.C. § 1391(b)(2) and § 1391(c)(2).

6. An actual case or controversy has arisen between the parties. Defendant has threatened litigation against NHPR if it does not cease using OUTSIDE/IN™, and it has asserted that NHPR’s use of the name OUTSIDE/IN™ for its podcast constitutes trademark infringement and dilution of Defendant’s trademark. These statements threaten injury to NHPR.

## **PARTIES**

7. NHPR is a nonprofit corporation organized and existing under the laws of the state of New Hampshire with a principal place of business at 2 Pillsbury Street, Suite 600, Concord, New Hampshire 03301. It is a charitable organization under section 501(c)(3) of the Internal Revenue Code.

8. Upon information and belief, Defendant, Mariah Media Network, LLC, is a limited liability company organized under the laws of the State of New Mexico, with its principal place of business at 400 Market Street, Santa Fe, New Mexico 87501.

### **ALLEGATIONS COMMON TO ALL CAUSES OF ACTION**

#### **NHPR's Trademark OUTSIDE/IN**

9. Located in Concord, New Hampshire, NHPR is an award-winning National Public Radio member station network serving the state of New Hampshire and parts of Massachusetts, Maine and Vermont.

10. NHPR first signed on the air in August 1981. It operates nine transmitters and seven translators covering the entire state in analog and digital format under the call signs and frequencies WEVO 89.1, WEVH 91.3, WEVN 90.7, WEVC 107.1, WEVJ 99.5, WEVS 88.3, WEVF 90.3, WEVQ 91.9, and WCNH 91.5.

11. NHPR produces and broadcasts a mixed format of news, information and cultural programming.

12. As the only statewide source of radio news in the New Hampshire, NHPR produces and broadcasts news and feature reports on national, regional, state and local topics and issues.

13. It also produces and broadcasts daily interview, arts, cultural and information programs.

14. In addition to its terrestrial radio broadcasts, NHPR also has a downloadable application, which allows users to listen to its content, pause and rewind audio from mobile devices.

15. NHPR registered the domain name OUTSIDEINRADIO.ORG on March 3, 2015, and launched the OUTSIDE/IN website in November 2015. Attached as **Exhibit A** is a printout of the Whois information for the domain name OUTSIDEINRADIO.ORG.

16. NHPR's first use of the OUTSIDE/IN™ mark in interstate commerce dates to November 20, 2015, when it posted the podcast trailer "*What is OUTSIDE/IN?*" on OUTSIDEINRADIO.ORG. Initially available for download from the podcast platforms audioBoom, iTunes, GooglePlay and Stitcher, OUTSIDE/IN™ podcasts today are also available for download from the National Public Radio (NPR) podcast platform. Attached as **Exhibit B** are screenshots of the OUTSIDE/IN™ podcasts available from NPR, iTunes and Stitcher.

17. Since November 2015, NHPR has continuously and prominently used and promoted the OUTSIDE/IN™ mark in connection with its podcasts, websites, social media platforms and radio broadcasts.

18. In April 2016, the first OUTSIDE/IN™ radio show was broadcast on NHPR.

19. The name OUTSIDE/IN™ was conceived at a retreat in which NHPR producers brainstormed to create a name that conveyed the concept and content of its new program: "bringing the outside in to your ears." The producers believed that statement expressed their goals for the program and they hit upon the name "outside/in," which conveyed the precise idea but was shorter, distinctive and memorable.

20. The OUTSIDE/IN™ podcast is promoted as "A show about the natural world and how we use it." Attached as **Exhibit C** is a screenshot of the OUTSIDEINRADIO.ORG website showing use of the OUTSIDE/IN™ tagline and logo.

21. To date, NHPR has published forty OUTSIDE/IN™ podcasts to iTunes and other podcast platforms.

22. The majority of the OUTSIDE/IN™ podcast episodes are about subject matters relating to natural science and energy. Representative examples of OUTSIDE/IN™ podcasts include:

- Ep 1: Kiwi Apocalypse

- Ep 2: 10x10: Vernal Pools
- Ep 5: Ginkgo Stink
- Ep 10: Gridlocked
- Ep 11: Tiny Terror
- Ep 13: Ask Sam: Maple Syrup
- Ep 14: Whale entanglement
- Ep 15: Biocontrol
- Ep 18: Dr. Percy Julian and medicinal plants
- Ep 20: Eat the Invaders: Lionfish
- Ep 21: Nature is a haunted house
- Ep 23: 10x10: Traffic circle
- Ep 25: Mt Washington and history of tourism
- Ep 28: Net metering

23. NHPR distributes the OUTSIDE/IN™ radio broadcast nationally through the Public Radio Exchange (PRX), an online marketplace for distribution, review, and licensing of public radio programs. As of January 2017, PRX Remix had purchased twelve OUTSIDE/IN™ podcasts from NHPR. Attached as **Exhibit D** is a screenshot from the PRX webpage with information about OUTSIDE/IN™ podcasts and radio broadcasts available for download.

24. Since its debut in November 2015, NHPR's OUTSIDE/IN™ podcast has received accolades from several content providers, including:

- Named one of the “*Best Podcasts About Science and Nature*” by Bello Collective;
- Named one of the “*The Best Podcasts of 2016*” by Runner's World Magazine;
- Named one of the “*50 Podcasts You Should Be Listening To*” by Xconomy;

- Included in “7 Outdoor Podcasts You Should Listen To In 2017” by actionHub.

25. As a result of NHPR’s promotion of OUTSIDE/IN™ for podcasts and radio broadcasts, and through considerable acceptance and recognition, the relevant consuming public has come to recognize and identify OUTSIDE/IN™ as the source of quality podcast content and programming. Of significance, Defendant, itself, recognized the OUTSIDE/IN™ podcast as the “Best Podcast of 2016” in the December 2016 issue of *Outside Magazine*. See **Exhibit E**

26. NHPR has acquired good will and brand recognition in the OUTSIDE/IN™ podcast through the use and promotion of the OUTSIDE/IN™ mark. As a result, NHPR has acquired valuable common law rights in the mark.

#### **Defendant’s Trademark OUTSIDE**

27. Defendant owns and publishes *Outside Magazine*, a monthly publication focused on the outdoor sports, fitness and recreation.

28. Defendant’s magazine is sold through various retail channels, including bookstores, grocery stores, and newsstands. *Outside Magazine* is also available on a subscription basis.

29. Upon information and belief, Defendant has been in business since 1976.

30. Defendant claims a first use date of November 16, 1976 for its “Outside” mark in connection with its magazine, and continuous use of the “*Outside*” mark since 1976 in connection with its magazine.

31. Upon information and belief, however, from 1976 to 1979, the magazine was named *Mariah* after the company publishing it, Mariah Media Inc. It changed the name to *Mariah/Outside* and in 1980 another change to “*Outside*”. Attached as **Exhibit F** are printouts showing *Mariah* and *Mariah/Outside* magazines.

32. Defendant is the owner of trademark registrations granted by the USPTO for the *stylized* mark “Outside” covering “magazines in the field of outdoor sports, fitness and recreational activities” in International Class 16, Registration Nos. 2,025,585 and 1,507,125. Defendant also owns a trademark registration for the *stylized* mark “Outside” in International Class 41 covering services for “information in the field of outdoor sports, fitness and recreational activities by means of a global computer network,” Registration No. 2,648,063. Attached as **Exhibit G** is a printout of the USPTO TESS database with details of each of Defendant’s trademark registrations for the *stylized* mark “Outside”.

33. Upon information and belief, Defendant, from January 1998 until June 1999, produced a weekly syndicated radio broadcast that featured interviews and stories on outdoor sports, fitness and recreation under the name “Outside Radio Network.”

34. In July 1999, Defendant obtained a federal trademark registration for the mark “OUTSIDE RADIO NETWORK,” covering “entertainment in the nature of an ongoing radio program in the field of outdoor sports, fitness and recreation” (Registration No. 2,261,533). The registration was subsequently cancelled in April 2006.

35. Defendant has registered and owns the domain name OUTSIDEONLINE.COM and operates a website in conjunction therewith. Defendant also owns the domain names OUTSIDEMAG.COM and OUTSIDEMAGAZINE.COM, which directs users to the website for OUTSIDEONLINE.COM.

36. Defendant’s website focuses on outdoor sports, fitness and recreation as well as the promotion of *Outside Magazine*. It also features online shopping and travel-related services.

37. Defendant does not own the domain name OUTSIDE.COM which is currently owned and registered by First Place internet Inc. Defendant was unsuccessful in its domain name

arbitration complaint filed against First Place internet Inc. Attached as **Exhibit H** is a printout of the WIPO Arbitration and Mediation Center's Administrative Panel Decision for the domain name OUTSIDE.COM.

38. Upon information and belief, Defendant published its first "Outside" podcast in March 2016.

39. Defendant markets and describes its "Outside" podcast as "Adventure tales for audio." Attached as **Exhibit I** is a screenshot of the OUTSIDEONLINE.COM website showing use of the tagline and logo for the "Outside" podcast, and screenshots of the "Outside" podcasts available from iTunes and Stitcher.

#### **DISPUTE AND CONTROVERSY**

40. Defendant, by letter to NHPR on October 17, 2016, demanded, that it cease use of the OUTSIDE/IN™ in connection with its podcasts and "cease otherwise exploiting any trademark or other name that is likely to cause confusion with OUTSIDE, or suggest an association or affiliation" with Defendant. The letter is attached as **Exhibit J**.

41. NHPR responded by letter dated November 1, 2016. It demurred to the demand to cease using OUTSIDE/IN™ in conjunction with its podcasts and stated it was "open to exploring a creative, rather than legal resolution," adding that "a collaborative relationship" would be the best outcome for both sides. The letter is attached as **Exhibit K**.

42. Defendant responded by letter dated December 1, 2016. Reiterating its demand that NHPR "cease infringing" its rights in the "Outside" mark, Defendant asserted not only that NHPR's use of OUTSIDE/IN™ for podcasts dilutes the distinctiveness of Defendant's "famous family of Outside trademarks," but also that "use of OUTSIDE/IN™ is unlawful" since it "blurs the distinctiveness" of Defendant's "famous Outside mark." The letter is attached as **Exhibit L**.



43. On January 12, 2017, Betsy Gardella, President and Chief Executive Office of NHPR, wrote to Defendant requesting that it “consider a collaborative course of action” and noted that NHPR’s and Defendant’s production teams “want to work together in what we know is an open and viral marketplace.” Her letter is attached as **Exhibit M**.

44. Defendant rejected Ms. Gardella’s request by letter dated January 31, 2017. It continued to demand that “NHPR cease infringing Mariah Media’s OUTSIDE mark”. The letter is attached as **Exhibit N**.

45. As of the date of this Complaint, the parties have been unable to reach a resolution of this trademark dispute and are at an impasse.

46. Based upon Defendant’s allegations of trademark infringement, NHPR has a reasonable apprehension that Defendant will commence suit against NHPR for trademark infringement and dilution of its “Outside” mark.

#### **No Infringement**

47. NHPR has a good faith belief that it is not infringing on Defendant’s Marks or otherwise violating the Lanham Act.

48. To prevail on a trademark infringement claim, the party alleging infringement must show that it owns a protectable trademark. Defendant does not own and does not have any proprietary rights in the “Outside” mark for podcasts that was registered or used prior to NHPR’s use of OUTSIDE/IN™ for its podcasts.

49. Upon information and belief, Defendant does not possess any valid federal trademark registrations for the mark “Outside” covering podcasts.

50. NHPR's use of OUTSIDE/IN™ in connection its podcast does not infringe any protectable trademark rights Defendant may have in the word "Outside" under trademark law, including any of Defendant's rights that may flow from its federal trademark registrations.

51. Upon information and belief, NHPR's use in commerce of the OUTSIDE/IN™ mark in relation to podcasts predates Defendant's first date of use of the "Outside" mark for podcasts. NHPR therefore has priority over Defendant's use in conjunction with podcasts.

52. Some two weeks before it first wrote NHPR, Defendant, on October 4, 2016, filed an intent-to-use trademark application with the USPTO for "Outside" in International Class 41 covering "Entertainment services, namely providing podcasts in the fields of travel, sports, health and fitness". Application No. 87193005. Defendant did not claim date of first use for the podcast.

53. NHPR has made no attempt to misappropriate Defendant's Mark or the good will associated with the "Outside" mark.

54. The iTunes platform is the most commonly used platform for podcasts. Within iTunes there is a podcast category list from which podcast creators choose to classify their podcasts. Each podcast can be classified in up to three separate categories and the podcasts will be ranked separately under each category.

55. A search of the iTunes podcast directory shows that NHPR's OUTSIDE/IN™ podcasts are classified under the categories "Natural Sciences" and "Science & Medicine".

56. Defendant's podcasts are classified separately under the categories "Outdoor" and "Sports & Recreation" in the iTunes podcast directory.

57. Through its unsupported assertions of the purported strength and coverage of its marks, Defendant is trying to extend the scope of the services described in its trademark registrations to cover podcasts. Such conduct constitutes trademark misuse in conflict with the Lanham Act.

58. Defendant's conduct in seeking to extend the narrow protection afforded its mark to include all uses of the word "outside" for use on goods and services covering outdoor sports, fitness and recreation, is not supported by its trademark registrations.

59. Defendant has misrepresented the scope of its lawful coverage for its "Outside" mark to bolster its cease and desist demand to NHPR.

60. Defendant has made unsupported claims of trademark infringement and has sought to prevent NHPR's lawful use of the non-infringing OUTSIDE/IN™ mark to prevent NHPR from the lawful production and promotion of its OUTSIDE/IN™ podcast, which amounts to an unlawful restraint on competition.

61. Given its common law rights in the OUTSIDE/IN™ mark, NHPR has clear priority of use over Defendant's use of "Outside" in connection with podcasts, and thus there can be no infringement of Defendant's rights in the "Outside" mark.

62. Defendant's Marks are not distinctive, are weak and are not entitled to have the scope of protection extended to preclude NHPR or other third party uses of the word "outside".

### **No Likelihood of Confusion**

63. NHPR's use of OUTSIDE/IN™ for its podcasts is distinctive and not likely to cause confusion with Defendant's "Outside" mark because each mark is distinguishable in overall sound, appearance, and commercial impression.

64. All three trademark registrations that Defendant cites in its October 17, 2016 cease and desist letter to NHPR are *stylized* trademarks for the word "Outside." See **Exhibit G**.

65. Registration for a stylized trademark does not obtain protection for the word itself. Although greater weight is often given to the word element of the mark than to the design elements in a stylized mark, the stylistic elements are important in determining whether a competing mark is too similar. That is, the rights in a stylized mark can be limited to its stylistic elements.

66. Furthermore, one of the three registrations that Defendant claims that NHPR is infringing is the *stylized* mark “Outside,” which claims the colors yellow and red as a feature of the mark and is registered for magazines. (Registration No. 2,025,585). NHPR’s OUTSIDE/IN™ mark does not contain the color yellow or red and is not used in conjunction with any print publication.

67. Given that the word “outside” is a common English word used to refer to the outdoors, Defendant’s rights in its “Outside” trademark are limited to its *stylized* presentation and not the word itself.

68. NHPR’s OUTSIDE/IN™ mark with the additional word “in,” distinct design, and stylized font is not likely to cause confusion with Defendant’s Marks. NHPR’s mark is composed of two words: “OUTSIDE” presented in all capital letters followed by a forward slash “/” then followed by word “IN” in all capital letters. For its part, Defendant’s “Outside” mark is one word presented in the color yellow with a thin red outline in a *stylized* font and only the first letter is capitalized. Each mark contains a different number of syllables; the “Outside” mark consists of two syllables, while OUTSIDE/IN™ consists of three.

69. When compared in their entirety the marks, OUTSIDE/IN™ and “Outside,” as they appear in the marketplace are distinguishable in appearance and sound, and do not convey the same idea, stimulate the same mental reaction, or have the same overall meaning.

70. The marks as used in commerce are dissimilar. The context in which the marks are used in advertising is probative of the significance which a mark is likely to project to consumers. The overall context of the marks as used to promote their respective podcasts is significantly different.

71. There is a clear distinction between the designs, wording and overall commercial impression of these marks:



72. Such distinct and divergent overall commercial impressions negate any likelihood of confusion between NHPR's OUTSIDE/IN™ mark and Defendant's "Outside" mark.

73. Aside from the common use of the word "outside," the marks do not communicate a similar connotation or quality. Consumers do not see the marks as conveying the same message and the differences between the full marks minimizes any potential confusion between the two.

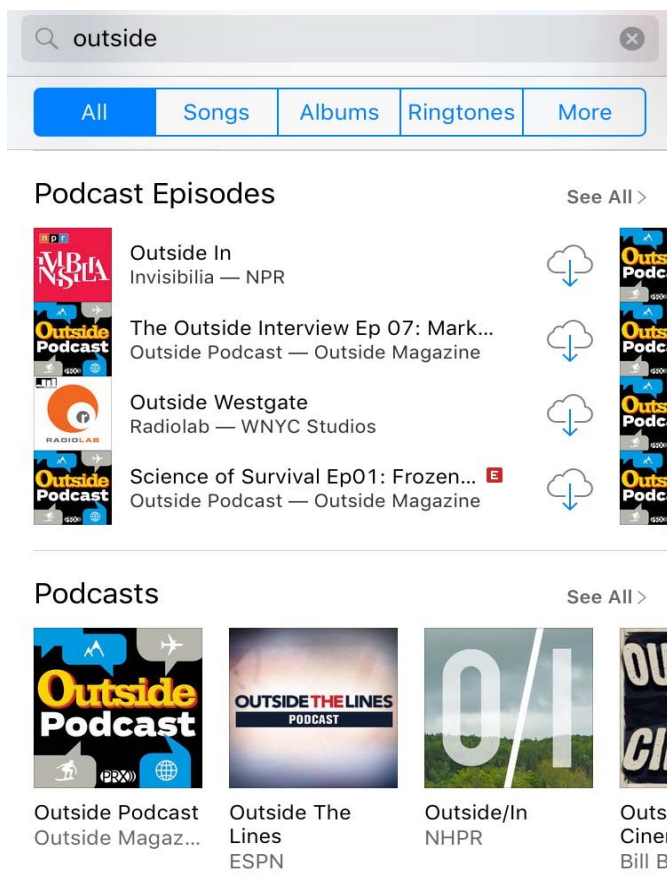
74. In the context of the marketplace, when the two marks are considered each as a whole and without giving weight to the single common element "outside" there is no basis for finding a likelihood of confusion between the two.

75. Defendant's "Outside" mark is highly suggestive of the content of its magazine which features content pertaining to outdoor sports, fitness and recreation, further evidence that its mark is weak and entitled to a narrow scope of protection.

76. In the context of the marketplace consumers of NHPR content receive it through audio podcasts and radio broadcasts. In contrast, consumers of Defendant's content receive it through print, *Outside Magazine*.

77. Consumers can readily distinguish between the parties' marks and will not assume any association between the source of the OUTSIDE/IN™ podcasts and broadcasts and Defendant's *Outside Magazine* or podcasts. There is no likelihood of confusion and, thus, no infringement.

78. In a search of the word "outside" in iTunes, both "Outside" and OUTSIDE/IN™ come up under "Podcast Episodes" and "Podcasts." Each is readily distinguishable:



79. Not only is the OUTSIDE/IN™ podcast visually distinct, it contains the subheading "NHPR," which attributes it to New Hampshire Public Radio and further differentiates it from

Defendant's podcast, which has the subheading "Outside Magazine". Attached as **Exhibit O** is a screenshot of the two podcasts as presented on iTunes.

80. The side-by-side visual comparison of the two marks used in commerce highlights their dissimilarities. Viewed in their entirety, the marks create different general commercial impressions.

81. Moreover, a search of iTunes demonstrates that the OUTSIDE/IN™ podcasts and Defendant's "Outside" podcasts are not the only podcasts or podcast episodes that contain the word "outside." Attached as **Exhibit P** are screenshots of iTunes and Stitcher showing results for a search of the word "outside."

82. To the extent the Defendant alleges that it holds exclusive rights over the use of the common word "outside", the considerable usage of that word by third parties for the same or similar goods and/or services demonstrates the mark is conceptually weak and only entitled to a narrow scope of protection.

83. Defendant's "Outside" mark is neither distinctive nor famous as evidenced by the number of other third-party uses of various "Outside" marks for their podcasts covering outdoor sports, fitness and recreation. Examples of such podcasts currently available on the podcast platforms, iTunes and Stitcher include:

- OUTSIDE THE LINES
- OUTSIDE HEALTH & FITNESS
- THE OUTSIDE IN SHOW
- G.O. GET OUTSIDE
- OUTSIDE THE ZONE
- THE OUTSIDE WITHIN

- BASEBALL OUTSIDE THE BOX
- OUTSIDE THE HUDDLE!
- OUTSIDE THE RING
- THE OUTSIDE CORNER
- OUTSIDE THE CAGE

Attached as **Exhibit Q** is a printout with details of each of these podcasts.

84. The above-referenced podcasts specifically relate to subject matter covering outdoor sports, fitness and recreation, and like Defendant, many are classified under the categories “Outdoor” and “Sports & Recreation” in the iTunes podcast directory.

85. Along with the above-referenced podcasts, there are numerous other podcasts that contain the word “outside” that do not pertain to outdoor sports, fitness or recreation but coexist with the Defendant’s mark without consumer confusion. This further establishes that the Defendant’s mark is weak.

86. Moreover, a search of trademark registrations in International Class 41 in the USPTO TESS database reveals that Defendant’s “Outside” mark coexists alongside many other “outside” marks in Class 41, many of which also are in the fields of outdoor sports, fitness and recreation. A list of third party registrations which are currently in full force and effect with the USPTO in Class 41 that contain the word “outside” include:

- THE OUTSIDE GUIDE (Registration No. 4,240,436)
- OUTSIDE THE LINES (Registration No. 1,735,396)
- HEALTH FROM THE OUTSIDE IN (Registration No. 4,242,635)
- OUTSIDE IN (Registration No. 4,073,146)
- GO PLAY OUTSIDE NOT (Registration No. 4,258,201)



- OUTSIDE VOICE (Registration No. 4,010,351)
- LIFE'S BETTER OUTSIDE (Registration No. 3,162,233)
- GOING OUTSIDE. GROWING INSIDE. (Registration No. 3,262,648)
- OUTSIDE THE CAGE (Registration No. 3,471,558)
- WOD OUTSIDE (Registration No. 4,924,304)
- I'D RATHER BE...OUTSIDE (Registration No. 4,679,021)
- LIFE HAPPENS OUTSIDE! (Registration No. 4,731,101)
- LIVE LIFE OUTSIDE (Registration No. 4,333,724)
- TELLURIDE OUTSIDE (Registration No. 4,402,975)
- COLLEGE OUTSIDE (Registration No. 4,331,196)
- WEC OUTSIDE THE CAGE (Registration No. 3,471,559)

Attached as **Exhibit R** are printouts from the USPTO TESS database with details of each of these valid and subsisting trademark registrations.

87. The word “outside” also appears in many third party domain names and websites offering online information and services in the fields of outdoor sports, fitness and recreation. Examples of these currently active domain names and websites include:

- TAKEITOUTSIDECA.COM
- SEEKOUTSIDE.COM
- NEWENGLANDOUTSIDE.COM
- TEXASOUTSIDE.COM
- SHOPOUTSIDE.COM
- OUTSIDELASVEGAS.ORG

- FLOWOUTSIDE.COM
- OREGONOUTSIDE.NET
- COLLEGEOUTSIDE.COM
- THEBIGOUTSIDE.COM
- VENTURE-OUTSIDE.COM
- HAPPIEROUTSIDE.COM
- UTAHOUTSIDE.COM

Attached as **Exhibit S** are screenshots with details of each of these websites.

88. Along with the above-referenced domain names and websites offering online information and services specifically covering outdoor sports, fitness or recreation, there are numerous other domain names and websites that contain the word “outside” that do not pertain to outdoor sports, fitness and recreation but coexist with the Defendant without consumer confusion. These names further establish that Defendant does not have exclusive use of the word “outside”.

89. These third party uses and registrations limit the scope of Defendant’s rights in the *stylized* “Outside” mark to those uses for which it has trademark registrations.

90. To the extent Defendant has attempted to dissuade or otherwise taken affirmative action to stop third parties from use of the common word “outside” for podcasts in the fields of outdoor sports, fitness or recreation, it has not succeeded.

91. Defendant’s Marks exist in a crowded field, having coexisted for years alongside many other “outside” marks for podcasts and other goods/services in the fields of outdoor sports, fitness and recreation. This is indicative of the lack of distinctiveness of Defendant’s Marks.

92. Defendant claims to be concerned about NHPR's "unlawful" use of OUTSIDE/IN™ for its podcasts and claims to take NHPR's "encroachment" on its "Outside family of trademarks ... very seriously," see **Exhibit L**, yet it named OUTSIDE/IN™ the "Best Podcast of 2016."

93. The OUTSIDE/IN™ mark is distinctive and is not suggestive of the nature of the content of its podcasts or radio broadcasts.

94. The fact that the word "outside" appears in so many other podcasts, trademarks, and domain names, and the considerable number of third parties using the word on the same or similar goods and services further establishes that Defendant's rights in its "Outside" trademark are limited to its *stylized* presentation and not the word itself.

95. As a result of the coexistence of numerous uses of the word "outside" in connection with outdoor sports, fitness and recreation, consumers are able to distinguish between such uses based on the addition of other distinctive elements, including words and/or designs.

96. Any rights Defendant has in the "Outside" mark are limited and narrow in scope of protection; there is no likelihood of confusion between NHPR's OUTSIDE/IN™ podcast and Defendant's Marks as applied to its goods and/or services, which do not include coverage for podcasts.

97. Defendant cannot monopolize use of the word "outside" and does not have the exclusive right to use the mark "Outside" in commerce. Given the narrow scope of protection afforded Defendant's "Outside" mark, Defendant cannot exclude legitimate uses of the word "outside".

98. The extensive third party usage of "outside" demonstrates the limited scope of protection to which the Defendant is entitled for its mark, "Outside," and further illustrates that consumers are able to distinguish among various "outside" uses by the inclusion of other words in the marks.

99. The longstanding use and/or registrations of “outside” marks by third parties clearly establishes that NHPR’s use of OUTSIDE/IN™ for its podcasts does not dilute Defendant’s Marks and further refutes any claim of harm by Defendant to its “famous” mark.

100. NHPR has expended time, money and resources to promote and advertise its OUTSIDE/IN™ podcasts and radio broadcasts and will be damaged and harmed if it were prohibited from using OUTSIDE/IN™ for its podcasts.

### **COUNT I**

#### **Declaratory Judgment of Non-Infringement (28 U.S.C. §§ 2201 and 2202)**

101. NHPR hereby repeats, re-alleges and incorporates by reference herein the allegations set forth in Paragraphs 1 through 100 hereof as part of this claim for relief.

102. An actual controversy and dispute has arisen and now exists between NHPR and Defendant regarding whether NHPR’s use of the OUTSIDE/IN™ mark in connection with its podcasts infringes on any of Defendant’s purported rights in the mark “Outside” under federal or state trademark laws. Such controversy and dispute presents a case or controversy within the meaning of Article III of the United States Constitution.

103. Declaratory relief will serve the useful purpose of clarifying and settling the legal rights between the parties with respect to the use of the word “outside”.

104. NHPR is entitled to a declaration under the Federal Declaratory Judgment Act, 28 U.S.C. § 2201(a), and Fed. R. Civ. P. 57, that use of the OUTSIDE/IN™ mark in connection with its podcasts is lawful and does not infringe upon Defendant’s Marks.

## **COUNT II**

### **Declaratory Judgment Against Trademark Dilution Under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c)**

105. NHPR hereby repeats, re-alleges and incorporates by reference herein the allegations set forth in Paragraphs 1 through 104 hereof as part of this claim for relief.

106. Defendant's Marks are not famous, and not well known, beyond the narrow market of outdoor magazines and publications.

107. The word "Outside" is widely used by other third parties producing podcasts in the fields of outdoor sports, fitness and recreation, as set forth in paragraph 83 hereof.

108. NHPR's use of the OUTSIDE/IN™ mark in relation to its podcasts does not dilute Defendant's Marks.

109. NHPR is entitled to a declaratory judgment that its use of the OUTSIDE/IN™ mark in connection with its podcast does not constitute trademark dilution under 15 U.S.C. § 1125(c).

### **RELIEF REQUESTED**

For the above reasons, NHPR respectfully requests that this Court:

- A. Enter judgment in favor of NHPR and against Defendant;
- B. Issue an order declaring that NHPR's use of OUTSIDE/IN™ does not infringe on any valid trademark rights of Defendant, or otherwise violate any of Defendant's rights;
- C. Issue an order declaring that NHPR's use of OUTSIDE/IN™ does not dilute Defendant's Marks, or otherwise violate any of Defendant's rights;
- D. Issue an order declaring that NHPR is not violating any federal law as a result of its use of the OUTSIDE/IN™ mark in commerce;
- E. Award NHPR its costs in this action; and
- F. Grant NHPR such additional relief as this Court deems just and proper.

**Request for Jury Trial**

NHPR requests a trial by jury on all issues so triable.

Respectfully submitted,

New Hampshire Public Radio, Inc.

By its attorneys,

Hage Hodes, Professional Association  
1855 Elm Street  
Manchester, NH 03104

Dated: February 10, 2017

By: Lisa N. Thompson  
Lisa N. Thompson, Esq. (Bar No. 265428)

Orr & Reno, P.A.  
45 South Main Street  
Concord, NH 03301-03550

Dated: February 10, 2017

By: William L. Chapman  
William L. Chapman, Esq. (Bar No. 397)

1688663\_1