

# Exhibit B

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Cataldo

MAILED

OCT 11 2002

PAT. & T.M. OFFICE

Opposition No. 91-115,085

Surestream, Inc.

v.

Realnetworks, Inc.

**Peter Cataldo, Interlocutory Attorney**

On October 8, 2002, counsel for applicant contacted the Board regarding the possibility of holding a telephone conference for this case. Counsel stated that the parties were at odds regarding the suspension of this proceeding pending the disposition of a civil action between the parties herein.

On that date and at the Board's request, counsel for applicant submitted to the Board a copy of its motion to suspend by facsimile.<sup>1</sup> See Patent and Trademark Rule 1.6(d)(8). See also TBMP §107 and the authorities cited therein. On October 9, 2002, the Board contacted counsel for opposer regarding the time for holding a phone conference and the agenda.

The parties agreed to hold a conference at 2 p.m. EST

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<sup>1</sup> Applicant served a copy of same on opposer via certificate of Express Mail dated October 8, 2002.

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on Thursday, October 10, 2002. The Board determined that additional briefing of the issue under consideration would be unnecessary.

The conference was held as scheduled among Jeffrey J. Look, as counsel for opposer, Rachel E. Matteo-Boehm, as counsel for applicant, and the above signed, as the Board attorney responsible for resolving interlocutory disputes in this case.

Under consideration in the phone conference was applicant's October 8, 2002 motion to suspend action on the instant proceeding pending the disposition of CIV 02-1308 M, styled *Surestream, Inc. v. Realnetworks, Inc.* filed on September 18, 2002 in the United States District Court for the Western District of Oklahoma.

The Board carefully considered the arguments raised by counsels for both parties with regard to the above matter. However, an exhaustive review of those arguments would only serve to delay the Board's disposition thereof.

Turning now to applicant's motion, the Trademark Rules of Practice and other relevant authorities provide that whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. See Trademark Rule

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2.117(a); and *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling will have a bearing on the rights of the parties in the Board case. See *Martin Beverage Co. Inc. v. Colita Beverage Company.*, 169 USPQ 568, 570 (TTAB 1971). USPQ 861 (TTAB 1973).

In this case, the parties to the instant opposition and Civil Action 02-1308 M are the same. Further, the mark at issue in this proceeding, namely, "SURESTREAM," is at issue in the civil action. Because the complaint contains allegations of false designation of origin in violation of the Lanham Act with regard to applicant's "SURESTREAM" mark, the decision in the civil case may include a determination of applicant's rights to that asserted mark. Any such determination of applicant's rights to its "SURESTREAM" mark in the civil action will be dispositive of, or at least have a bearing on, the issues before the Board. Moreover, to the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. See, for example, *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950

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(2d Cir.1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn. 1986).

Opposer has advanced as arguments in opposition to the motion to suspend that the instant opposition proceeding is currently in a more advanced stage, i.e., the trial stage, than the civil action; that applicant has been afforded the advantage of being served with opposer's testimony and evidence in this case; that the opposition has been pending for approximately three years; and that the opposition presents comparatively simple issues that are easily decided. Opposer's arguments and concerns are noted. However, the interests of judicial economy coupled with the possibility of the Board and the District Court reaching inconsistent results mitigate against the prosecution of this proceeding during the pendency the District Court action.

In view of the foregoing, and in the interest of judicial economy and consistent with the Board's inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, **proceedings herein are suspended pending final disposition of the civil action between the parties.**

Within twenty days after the final determination of the civil action, the interested party should notify the Board

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