

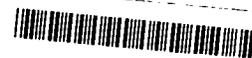
TTAB

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

Fred Wisniewski, a/k/a Captain Rat, )  
 )  
 Petitioner, )  
 )  
 v. )  
 )  
 Captain Rat and the Blind Rivets, )  
 )  
 Respondent. )

Cancellation No. 20,442



09-26-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

**RESPONSE TO RESPONDENT'S "REQUEST  
CONCERNING RESETTING OF TESTIMONY PERIOD"**

Petitioner, Fred Wisniewski, a/k/a Captain Rat, hereby responds to respondent's "Request Concerning Resetting Of Testimony Period." As discussed below, respondent's request that petitioner be given a one week testimony period is contrary to the parties' previous agreement when, at respondent's request, they postponed petitioner's testimony depositions, including subpoenaed depositions of respondent's three principals, and entered into settlement discussions. Accordingly, the Board should resume proceedings, allowing petitioner its full testimony period.

**FACTS**

On May 16, 1996, the Board issued an Order that, *inter alia*, reset the testimony periods in the above proceeding. Petitioner's testimony period was set to open on June 15, 1996 and close on July 15, 1996.

Two days after the testimony period opened, on June 17, 1996, petitioner noticed the testimony depositions of two of respondent's principals, namely, Roger Prillaman and Mark Rubel, for June 24, 1996. Two days later, on June 19, 1996, petitioner noticed the testimony deposition of

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Tim Vear, another principal of respondent for July 3, 1996. The necessary subpoenas were served on Messrs. Prillaman, Rubel and Vear. On June 19, 1996, petitioner also noticed the deposition of a third party witness, Al York, for July 11, 1996.

On June 21, 1996, respondent proposed that the taking of testimony depositions be postponed and the testimony periods extended to give the parties time to discuss settlement of the above proceeding and the related civil litigation in which petitioner and the principals of respondent were engaged. *See*, Exhibit A, attached hereto. Petitioner agreed to both the proposed postponement of testimony depositions, including the noticing of additional depositions, and to a sixty-day extension of the testimony periods. Respondent then requested that the periods be extended an additional two weeks to accommodate the vacation plans of Roger Prillaman, the individual and attorney who has been representing respondent in this proceeding.<sup>1</sup> *See*, Exhibit B. Petitioner agreed and the parties filed an Agreed Motion to extend the close of petitioner's testimony period to September 27, 1996. *See*, Exhibit C.

Respondent refused to agree on new dates for the depositions of Messrs. Prillaman, Rubel and Vear, all of whom, as indicated above, had been subpoenaed for deposition prior to the postponement proposed by respondent. Petitioner issued a new set of deposition notices and subpoenas, and depositions were set to begin August 29, 1996, well before the new date (September 27, 1996) on which the parties had agreed for the close of petitioner's testimony period.

On August 29, 1996, after the noticed depositions began, the parties agreed to suspend the completion of depositions and focus their efforts on settlement. The August 29 settlement discussion was attended by petitioner, petitioner's counsel in this proceeding and the attorney who

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<sup>1</sup> Respondent has been represented in this proceeding by Roger Prillaman, who is the attorney of record for respondent, but who in filing papers in this proceeding has indicated that he also is acting in the capacity as a member of the partnership which applied to register the mark at issue.

10/02/2008 10:00 AM

represented petitioner in the related civil action and by respondent's principal and attorney Roger Prillaman and respondent's principals Mark Rubel and Tim Vear. Significant progress was made toward settlement and the depositions were deferred by agreement so settlement discussions could continue. As part of the agreement to postpone the continuation of the depositions, it was agreed that if settlement was not reached, respondent's principals would appear for their depositions without petitioner having to subpoena them for a third time. *See*, Exhibit D. Settlement negotiations continued between petitioner's attorney in the civil action and Roger Prillaman on behalf of respondent.

During the week of September 2, 1996, the parties agreed to further postpone the depositions, with the proviso that depositions would take place the following week if settlement talks were not successful. *See*, Exhibit D. It appeared, however, that the parties would be able to resolve the above proceeding and the related civil action by agreement. As a result, rather than proceed with depositions, on September 17, 1996, respondent filed a Stipulation by the parties to extend the testimony period thirty days to October 27, 1996. Exhibit E, attached. The following month it became apparent that additional time was required to work on finalizing a written settlement agreement. Respondent's counsel Roger Prillaman indicated that he would prefer a request for suspension to a further extension and petitioner accordingly filed a Motion To Suspend Proceedings.<sup>2</sup> Exhibit F, attached.

Following the request for extension, settlement efforts continued, with petitioner's counsel in the civil action conducting the negotiations on behalf of petitioner and Roger Prillaman conducting the negotiations on behalf of respondent. To date, however, the parties have been unable to finalize a written agreement.

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<sup>2</sup> The request was filed seven business days, and ten calendar days, before the close of the rescheduled

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## DISCUSSION

As set forth above, petitioner served its testimony deposition notices within a few days of its testimony period opening. When respondent requested that the depositions be postponed, petitioner agreed, but again rescheduled depositions to begin well before the end of the testimony period through the service of new deposition notices and new subpoenas. Petitioner's completion of its testimony depositions of respondent's principals and other witnesses, such as those of Al York, Johnny Hahn and petitioner, was postponed only because it appeared that the matter would be resolved by agreement.

Under these circumstances, the testimony period should be reset to put petitioner in the same position to complete its depositions as he was when he agreed on August 29, 1996, twenty-eight days before the September 27, 1996 close of his testimony period, to postpone the completion of testimony depositions in light of the parties' settlement efforts. This clearly was the parties' intent as shown by the Stipulation filed on September 17, 1996, which gave petitioner thirty days to complete his testimony depositions. Exhibit E. This should not be changed by the fact that, at respondent's request, the parties filed a request for suspension rather than another motion to extend, when it became apparent the following month that additional time was required.

Giving petitioner a week or ten days in which to take the necessary depositions will make it difficult to notice depositions in a manner that accommodates the schedule of third party witnesses, as well as those of parties and counsel. Further, while respondent's principals, Prillaman, Vear and Rubel, agreed, as part of the postponement of their depositions, that they would appear for depositions if settlement was not reached without requiring petitioner to subpoena them for a third

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testimony period.

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time, respondent's recent request indicates that respondent may not intend to honor that agreement.<sup>3</sup>

The testimony period should be reset in a manner which allows petitioner and respondent time to agree to a mutually convenient schedule for the depositions of respondent's principals or, if respondent decides not to honor the agreement, to allow petitioner to re-subpoena respondent's principals.

The testimony periods accordingly should be reset in a manner which allows petitioner full opportunity to take the necessary testimony depositions. Respondent should not be allowed to claim that petitioner should be restricted to five days, when the parties previously agreed to postpone the completion of testimony depositions with the clear understanding petitioner's testimony period would be reset to give petitioner thirty days in which to complete his testimony.

SMART & BOSTJANCICH

By: John Bostjancich  
Patricia S. Smart  
John Bostjancich  
19 South LaSalle Street  
Suite 1300  
Chicago, Illinois 60603  
(312) 857-2424

Attorneys For Petitioner

---

<sup>3</sup> Petitioner called Mr. Prillaman after receiving respondent's request to discuss this matter, but to date, Mr. Prillaman has failed to return petitioner's call.

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CERTIFICATE OF SERVICE

I, John Bostjancich, hereby certify that a copy of the foregoing Response To Respondent's "Request Concerning Resetting Of Testimony Period" was served upon Roger Prillaman, Captain Rat And The Blind Rivets, 220 W. Main Street, Urbana, Illinois, 61801, by first class mail, postage prepaid, this 22nd day of September 2003.

John Bostjancich

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Trademarks, 2900 Crystal Drive, Arlington VA 22202-3514 on September 22, 2003.

John Bostjancich  
JOHN BOSTJANCICH

10/09/2003 10:00 AM

SMART & BOSTJANCICH  
19 South LaSalle Street  
Suite 1300  
Chicago, Illinois 60603

John Bostjancich  
Patricia S. Smart

Telephone (312) 857-2424  
Facsimile (312) 201-0737

June 25, 1996

VIA FACSIMILE

Roger L. Prillaman, Esq.  
Prillaman & Prillaman Ltd.  
117 North Broadway  
Urbana IL 61801

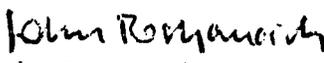
  
09-26-2003  
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

Re: Wisniewski v. Captain Rat and the Blind Rivets

Dear Roger:

This is further to your suggestion that the parties extend the dates in the cancellation proceeding in order to explore the possibility of settlement. Mr. Wisniewski is willing to consider the possibility of settlement, and accordingly we can agree to a sixty day extension and further can agree to reschedule the testimony depositions previously noticed for June 24 and to defer the taking of our other testimony depositions to allow for settlement discussions.

Enclosed is an Agreed Motion For Extension of Time. Please review the motion, and if agreeable, sign it and fax the signed copy to us so that we can file it promptly. If there are any questions regarding the motion, please let us know right away.

Very truly yours,  
  
John Bostjancich

JB/ms  
(Enclosure)

EXHIBIT A

10/06/2002TTAB

BOX TTAB NO FEE

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

Fred Wisniewski,	)	
a/k/a Captain Rat,	)	
	)	
Petitioner,	)	Cancellation No. 20,442
	)	
v.	)	
	)	
Captain Rat and the	)	
Blind Rivets,	)	
	)	
Respondent.	)	

**AGREED MOTION FOR EXTENSION OF TIME**

Petitioner, Fred Wisniewski a/k/a Captain Rat, and respondent, Captain Rat and the Blind Rivets, hereby jointly request that the dates for the testimony periods in the above proceeding be extended as follows:

Testimony period for party in position of plaintiff to close):	September 13, 1996
Testimony period for party in position of defendant to close (opening thirty days prior thereto):	November 13, 1996
Rebuttal testimony period to close (opening fifteen days prior thereto):	December 28, 1996

The extension is requested to allow the parties to conduct settlement negotiations, and, if such negotiations do not lead to resolution of this proceeding, to allow petitioner time to

10/09/2009 10:01 AM

reschedule testimony depositions and complete its testimony.

Respectfully submitted,

SMART & BOSTJANCICH

By \_\_\_\_\_  
John Bostjancich  
Patricia S. Smart  
19 S. LaSalle Street, Suite 1300  
Chicago, Illinois 60603  
(312) 857-2424

Attorneys For Petitioner.

CAPTAIN RAT AND THE BLIND RIVETS

By \_\_\_\_\_  
Roger L. Prillaman, General Partner  
117 North Broadway Avenue  
Urbana, Illinois 61801  
(217) 384-1310

Respondent.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner For Trademarks, 2900 Crystal Drive, Arlington VA 22202-3513 on \_\_\_\_\_.

Date: \_\_\_\_\_

\*\*\*\*\* -COMM. JOURNAL- \*\*\*\*\* DATE JUN-25-1996 \*\*\*\*\* TIME 15:16 \*\*\*\*\* P.1

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\*\*\*\*\* ( FAX-310 U2.18)\* - \*\*\*\*\*

10/08/2008TTAB

**SMART & BOSTJANCICH**  
19 South LaSalle Street  
Suite 1300  
Chicago, Illinois 60603

**John Bostjancich**  
**Patricia S. Smart**

Telephone (312) 857-2424  
Facsimile (312) 201-0737

June 27, 1996

**VIA FACSIMILE**

**Roger L. Prillaman, Esq.**  
**Captain Rat and the Blind Rivets**  
117 North Broadway  
Urbana, IL 61801

**Dear Roger:**

Enclosed is an Agreed Motion For Extension of Time which has been revised pursuant to your request to extend the dates an additional two weeks over the extension in the motion we forwarded this past Tuesday, to accomodate your vacation plans for the second and third weeks of August.

Please sign the motion and fax and mail the signed copy to us for filing. We will return a fully executed copy for your file.

Sincerely,

*John Bostjancich*  
John Bostjancich

**EXHIBIT B**

BOX TTAB NO FEE

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

Fred Wisniewski,	)	
a/k/a Captain Rat,	)	
	)	
Petitioner,	)	Cancellation No. 20,442
	)	
v.	)	
	)	
Captain Rat and the	)	
Blind Rivets,	)	
	)	
Respondent.	)	

**AGREED MOTION FOR EXTENSION OF TIME**

Petitioner, Fred Wisniewski a/k/a Captain Rat, and respondent, Captain Rat and the Blind Rivets, hereby jointly request that the dates for the testimony periods in the above proceeding be extended as follows:

Testimony period for party in position of plaintiff to close):	September 27, 1996
Testimony period for party in position of defendant to close (opening thirty days prior thereto):	November 27, 1996
Rebuttal testimony period to close (opening fifteen days prior thereto):	January 13, 1997

The extension is requested to allow the parties to conduct settlement negotiations, and, if such negotiations do not lead to resolution of this proceeding, to allow petitioner time to

10/06/2008TTAB

**reschedule testimony depositions and complete its testimony.**

Respectfully submitted,

**SMART & BOSTJANCICH**

By \_\_\_\_\_  
John Bostjancich  
Patricia S. Smart  
19 S. LaSalle Street, Suite 1300  
Chicago, Illinois 60603  
(312) 857-2424

Attorneys For Petitioner.

**CAPTAIN RAT AND THE BLIND RIVETS**

By \_\_\_\_\_  
Roger L. Prillaman, General Partner  
117 North Broadway Avenue  
Urbana, Illinois 61801  
(217) 384-1310

Respondent.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner For Trademarks, 2900 Crystal Drive, Arlington VA 22202-3513 on \_\_\_\_\_.

Date: \_\_\_\_\_

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\*\*\*\*\* ( FAX-310 V2.18)\* -

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BOX TTAB NO FEE

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

Fred Wisniewski, )  
a/k/a Captain Rat, )  
Petitioner, )  
v. )  
Captain Rat and the )  
Blind Rivets, )  
Respondent. )

Cancellation No. 20,442



09-26-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

AGREED MOTION FOR EXTENSION OF TIME

Petitioner, Fred Wisniewski a/k/a Captain Rat, and respondent, Captain Rat and the Blind Rivets, hereby jointly request that the dates for the testimony periods in the above proceeding be extended <sup>and modified</sup> as follows: (RP)

- Testimony period for party in position of plaintiff to close: (Reopening 30 days prior thereto.) (RP) September 27, 1996
- Testimony period for party in position of defendant to close (opening thirty days prior thereto): November 27, 1996
- Rebuttal testimony period to close (opening fifteen days prior thereto): January 13, 1997

The extension is requested to allow the parties to conduct settlement negotiations, and, if such negotiations do not lead to resolution of this proceeding, to allow petitioner time to

EXHIBIT C

10/06/2000 10:11:43 AM

commence

(R)

reschedule testimony depositions and ~~complete~~ its testimony.

Respectfully submitted,

SMART & BOSTJANCICH

By John Bostjancich

John Bostjancich

Patricia S. Smart

19 S. LaSalle Street, Suite 1300

Chicago, Illinois 60603

(312) 857-2424

Attorneys For Petitioner.

CAPTAIN RAT AND THE BLIND RIVETS

By Roger L. Prillaman

Roger L. Prillaman, General Partner

117 North Broadway Avenue

Urbana, Illinois 61801

(217) 384-1310

Respondent.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner For Trademarks, 2900 Crystal Drive, Arlington VA 22202-3513 on July 8, 1996.

Date: 7/8/96

John Bostjancich

10/06/96 10:00:11 AM

SMART & BOSTJANCICH

19 South LaSalle Street  
Suite 1300  
Chicago, Illinois 60603

John Bostjancich  
Patricia S. Smart

Telephone (312) 857-2424  
Facsimile (312) 201-0737

September 6, 1996

VIA FACSIMILE (217) 384-1318

Roger L. Prillaman, Esq.  
Prillaman & Prillaman Ltd.  
117 North Broadway  
Urbana IL 61801



09-26-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

Re: Wisniewski v. Captain Rat and the Blind Rivets

Dear Roger:

This is to confirm that the continuation of your deposition, Mark Rubel's deposition and Tim Vear's deposition set for today will be postponed and our testimony period extended in light of the ongoing settlement talks. If no settlement is reached, we will proceed with the testimony depositions of you, Mark Rubel, and, if he can be available, Tim Vear on Tuesday September 10. If Tim is not available Tuesday, we will schedule his deposition for a mutually convenient day shortly thereafter. In addition, we wanted to let you know that the dates that Jonny Hahn and Al York are available for deposition are September 18 and 19 respectively. Hopefully, a settlement will be reached and the dates they are available will become a moot point, but we wanted to advise you so you could mark your calendar.

Very truly yours,

Patricia S. Smart

PSS:ms

EXHIBIT D

\*\*\*\*\* -COMM. JOURNAL- \*\*\*\*\* DATE SEP-06-1996 \*\*\*\*\* TIME 09:44 \*\*\*\*\* P.1

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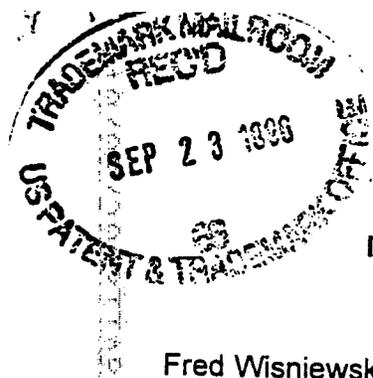
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-312 201 0737

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\*\*\*\*\* ( FAX-310 U2.18)\* -

- \*\*\*\*\*



BOX TTAB NO FEE

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

Fred Wisniewski, )  
a/k/a Captain Rat, )  
Petitioner, )  
v. )  
Captain Rat and the )  
Blind Rivets, )  
Respondent. )

Cancellation No. 20,442

**APPROVED**

*as corrected*

OCT 4 1996

*[Signature]*  
Paralegal Specialist  
Trademark Trial & Appeal Bd.

STIPULATION FOR EXTENSION OF TIME

Petitioner, Fred Wisniewski a/k/a Captain Rat, and Respondent, Captain Rat and the Blind Rivers, hereby stipulate, this Honorable Board consenting hereto, that the dates for the testimony periods in the above proceeding be extended thirty (30) days as follows:

Testimony period for party in position of plaintiff to close :

October 27, 1996

Testimony period for party in position of defendant to close (opening thirty days prior thereto):

December 27, 1996

Rebuttal testimony period to close (opening fifteen days prior thereto):

February 12, 1996<sup>7</sup>



09-26-2003

U.S. Patent & TM Office Mail Rept Dt #78

The parties are in the process of drafting a settlement agreement following negotiations for settlement of this proceeding. This extension of the time periods is sought to allow the parties time to agree on the language of a settlement agreement, whereupon an appropriate document

10/09/96 10:00:00 AM

terminating this proceeding would be filed with the Board.

Respectfully submitted,

SMART & BOSTJANCICH

By Patricia S. Smart

Patricia S. Smart  
19 S. LaSalle Street, Suite 1300  
Chicago, Illinois 60603  
(312) 857-2424

Attorneys For Petitioner

CAPTAIN RAT AND THE BLIND RIVETS

By Roger L. Prillaman

Roger L. Prillaman, General Partner  
117 North Broadway Avenue  
Urbana, Illinois 61801  
(217) 384-1310

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner For Trademarks, 2900 Crystal Drive, Arlington VA 22202-3513 on September 17, 1996.

Date: September 17, 1996

Roger L. Prillaman  
Roger L. Prillaman

10/16/03 09:00:11 AM

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

Fred Wisniewski, a/k/a Captain Rat, )  
 )  
Petitioner, )  
 )  
v. )  
 )  
Captain Rat and the Blind Rivets, )  
 )  
Respondent. )

Cancellation No. 20,442



09-26-2003  
U.S. Patent & TMO/TM Mail Rcpt Dt. #78

MOTION TO SUSPEND PROCEEDINGS

Petitioner, Fred Wisniewski a/k/a Captain Rat, hereby requests that the above proceeding be suspended.

As noted in the Agreed Motion For Extension Of Time filed September 17, 1996, the parties are in the process of drafting a settlement agreement to resolve their disputes, including, *inter alia*, the above proceeding. When petitioner suggested a further extension of the testimony periods, respondent indicated they preferred that proceedings be stayed while the parties worked on a settlement agreement. Petitioner therefore requests that the proceeding be suspended in accordance with Rule 2.117 of the Trademark Rules of Practice.

SMART & BOSTJANCICH

By: John Bostjancich  
John Bostjancich  
19 South LaSalle Street  
Suite 1300  
Chicago, Illinois 60603  
(312) 857-2424

Attorneys For Petitioner

EXHIBIT F

10/18/96/2000750701

**CERTIFICATE OF SERVICE**

I, John Bostjancich, hereby certify that a copy of the foregoing MOTION TO SUSPEND PROCEEDINGS was served upon respondent, Captain Rat And The Blind Rivets, 117 North Broadway, Urbana, Illinois, 61801, by first class mail, postage prepaid, this 18th day of October 1996.

John Bostjancich

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner For Trademarks, 2900 Crystal Drive, Arlington VA 22202-3513 on October 18, 1996.

JOHN BOSTJANCICH

Date October 18, 1996

John Bostjancich