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

Proceeding	91243229
Party	Plaintiff Luxottica Group S.P.A.
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Submission	Motion to Suspend for Settlement Discussions
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Signature	/Govinda M. Davis/
Date	08/12/2020
Attachments	Luxottica v Wayfarer Development TIJ Limited - Joint Motion to Suspend.pdf(845840 bytes )

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

In the Matter of Application Serial No. 87/690,818  
Published on June 26, 2018

Luxottica Group S.p.A.,	)	
	)	
Opposer,	)	Opposition No. 91243229
	)	
v.	)	Mark: WAYFARER
	)	
Wayfarer Development Ltd. f/k/a	)	
TIJ Limited,	)	
	)	
Applicant.	)	
_____	)	

**JOINT MOTION TO SUSPEND BASED ON SHOWING OF GOOD CAUSE**

In accordance with the Board’s order dated January 24, 2020, (D.N. 36), Opposer Luxottica Group S.p.A. (hereinafter “Luxottica”) and Applicant Wayfarer Development Ltd. f/k/a TIJ Limited (hereinafter “Applicant”) provide the following showing of good cause in support of a joint motion to suspend the proceedings in light of settlement pursuant to Trademark Rule 2.117(c) and Section 510.03 of the TBMP. Luxottica and Applicant shall collectively be referred to as the “Parties.”

Per the Board’s Order, the Parties are required to discuss the circumstances of settlement and provide a declaration for review before any further suspension will be granted. As good cause in support of their Joint Motion to Suspend, the Parties report that they have made progress towards settlement and provide the following further details on the potential resolution of this matter, as required per the Board’s order:

- 1) The status of the Parties' settlement negotiations, including when the last settlement proposal was sent, by whom, and when a response is expected.

Applicant provided Luxottica with a settlement proposal with proposed terms for review. *See* Declaration of Govinda M. Davis (“Davis Declaration”) attached hereto as “Exhibit A” at ¶ 4. Luxottica provided Applicant with comments on the proposal and additional terms on July 31, 2020. *See* Davis Declaration at ¶ 5. Applicant is currently considering Luxottica’s terms and anticipates that a response will be forthcoming around August 19, 2020. *See* Davis Declaration at ¶ 6.

- 2) A recitation of the issues that have been resolved since the commencement of this proceeding and a list of issues that remain to be resolved.

Since the commencement of this proceeding, the Parties have agreed to the following, in principal: (1) Applicant’s amendment and limitation to its identification of services in Class 035; and (2) Applicant’s modification to its use of its trademark. *See* Davis Declaration at ¶ 7. The Parties note that the following issues are yet to be resolved: (1) withdrawal of Applicant’s trademark applications in the United States and abroad; and (2) limitations on Applicant’s trademark use and registration moving forward. *See* Davis Declaration at ¶ 8.

If the Parties reach a resolution of this matter, the Parties intend that the issues of likelihood of confusion and dilution raised in this opposition will be resolved by a negotiated settlement. *See* Davis Declaration at ¶ 9.

- 3) A timetable for resolution.

At the outset, the Parties note that the Covid-19 pandemic has affected both entities’ ability to act quickly to resolve this matter. Both entities are located outside of the United States – Luxottica is located in Italy and Applicant is located in Hong Kong. Therefore, even under normal circumstances, it may take an extended period of time for potential settlement terms to be reviewed and considered by each company’s decision makers. Counsel for Applicant hopes to provide

additional comments on the latest settlement proposal by August 19, 2020. Barring any unforeseen circumstances, the Parties believe that this opposition can be resolved by December 31, 2020. *See* Davis Declaration at ¶ 10.

Counsel for Applicant has provided consent to this Joint Motion to Suspend by e-mail on August 12, 2020.

The Parties submit that there is good cause to grant this Joint Motion to Suspend and the motion is not made for an improper purpose to delay the proceedings. Therefore, the Parties respectfully request that the proceeding be suspended for 60 days and then trial calendar be reset as follows:

	<b>Current Schedule</b>	<b>Proposed Schedule</b>
Suspension Ends	--	10/12/2020
Discovery Closes	09/04/2020	11/04/2020
Plaintiff's Pretrial Disclosures Due	10/19/2020	12/19/2020
Plaintiff's 30-day Trial Period Ends	12/03/2020	02/02/2021
Defendant's Pretrial Disclosures Due	12/18/2020	02/17/2021
Defendant's 30-day Trial Period Ends	02/01/2021	04/03/2021
Plaintiff's Rebuttal Disclosures Due	02/16/2021	04/18/2021
Plaintiff's 15-day Rebuttal Period Ends	03/18/2021	05/18/2021
Plaintiff's Opening Brief Due	05/17/2021	07/17/2021
Defendant's Brief Due	06/16/2021	08/16/2021
Plaintiff's Reply Brief Due	07/01/2021	08/31/2021
Request for Oral Hearing (optional) Due	07/11/2021	09/10/2021

Date: August 12, 2020

Respectfully submitted,

DINSMORE & SHOHL LLP

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Attorneys for Opposer, Luxottica Group S.p.A.



# **EXHIBIT A**

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

In the Matter of Application Serial No. 87/690,818  
Published on June 26, 2018

Luxottica Group S.p.A.,	)	
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Opposer,	)	Opposition No. 91243229
	)	
v.	)	Mark: WAYFARER
	)	
Wayfarer Development Ltd. f/k/a	)	
TIJ Limited,	)	
	)	
Applicant.	)	
_____	)	

**DECLARATION OF GOVINDA M. DAVIS**

I, Govinda M. Davis, solemnly and truly declare under penalty of perjury as follows:

1. I am a member in good standing of the Bars of the State of New York, New Jersey and Ohio, and have been admitted to practice before the United States District Court for the Southern District of New York, the Eastern District of New York, the Southern District of Ohio and the Northern District of Ohio.
2. I am an attorney with the law firm of Dinsmore & Shohl, LLP. Dinsmore & Shohl, LLP is counsel for Luxottica Group S.p.A. (hereinafter "Luxottica") in its opposition of the application owned by Wayfarer Development Ltd. f/k/a TIJ Limited ("Applicant") for registration of the mark WAYFARER.
3. I submit this signed declaration in connection with the parties' Joint Motion to Suspend. I have firsthand knowledge of the facts stated herein.
4. Applicant provided Luxottica with a settlement proposal for review.



5. Luxottica provided Applicant with comments on the proposal and additional terms on July 31, 2020.

6. Applicant's counsel advised that Applicant's settlement comments should be forthcoming by August 19, 2020.

7. The Parties have agreed in principal to Applicant's amendment and limitation to its identification of services in Class 035 and Applicant's modification to its use of its trademark.

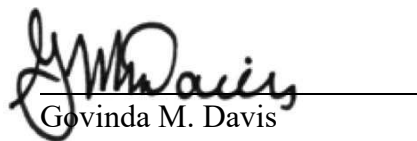
8. The Parties have yet to resolve withdrawal of Applicant's trademark applications in the United States and abroad and limitations on Applicant's trademark use and registration moving forward.

9. If the Parties reach a resolution of this matter, the Parties intend that the issues of likelihood of confusion and dilution raised in this opposition will be resolved by a negotiated settlement.

10. Barring any unforeseen circumstances, the Parties believe that this opposition can be resolved by December 31, 2020.

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of her own knowledge are true and all statements made on information and belief are believed to be true.

Executed on August 12, 2020.

  
Govinda M. Davis