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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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Date	11/09/2020
Attachments	Luxottica v Wayfarer - Luxotticas Opposition to Applicants Motion to Extend and Exhibit A.pdf(1102868 bytes )

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

<b>Luxottica Group S.p.A.</b>	)		
	)		
	<b>Opposer</b>	)	
	)		
	)		
<b>vs.</b>	)		Opposition No. 91243229
	)		<b>Mark: WAYFARER</b>
	)		Serial No. 87/690,818
	)		
<b>Wayfarer Development Ltd.</b>	)		
<b>F/k/a TIJ Limited,</b>	)		
	)		
	<b>Applicant.</b>	)	

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**OPPOSER’S OPPOSITION TO APPLICANT’S MOTION TO EXTEND THE  
DISCOVERY DEADLINE**

Opposer Luxottica Group S.p.A. (“Luxottica”) respectfully opposes the Motion to Extend filed by Wayfarer Development Ltd. F/k/a TIJ Limited (“Applicant”) (D.N. 42). The Board should deny Applicant’s motion to extend the discovery deadline because Applicant has failed to show good cause for its motion. Applicant submitted untimely discovery requests, to which Luxottica has no obligation to respond. Tellingly, Applicant’s discussion of the factual background does nothing more than demonstrate its own carelessness and failure to comply with the Trademark Rules. Applicant’s shortcomings not constitute good cause, in fact, they preclude it. The Board, therefore, should deny Applicant’s motion to extend the discovery deadline.

**I. Factual and Procedural Background**

Luxottica filed the instant notice of opposition against Applicant’s trademark on August 24, 2018 (D.N. 1). Shortly thereafter, the parties began discussing a potential resolution to this matter and agreed to several consented extensions of time for Applicant to file its answer. The

Board subsequently indicated that it would grant no further suspension or extension for the purposes of settlement without a showing of extraneous circumstances supported by a declaration. (D.N. 36). The Board simultaneously set the close of discovery for September 4, 2020. *Id.* Applicant filed its answer on February 7, 2020. (D.N. 37).

Luxottica served its initial disclosures and first set of discovery requests on August 4, 2020 (thirty one days before the then-scheduled close of discovery). (D.N. 35); *see* 37 C.F.R. § 2.120(a)(3) (requiring a party to serve discovery requests at least thirty days before the close of discovery); *see also* Declaration of Govinda M. Davis (“Davis Declaration” attached as **Exhibit A** at ¶ 4. Applicant did not serve requests by the deadline. *See* Davis Declaration at ¶ 5.

Applicant’s motion to extend notes that on July 31, 2020, Luxottica proposed a joint motion to suspend the proceedings in light of settlement. (D.N. 42 at p. 3). Applicant failed to note, however, that Luxottica contacted Applicant before the thirty-day window to serve discovery and requested Applicant’s response by August 3, 2020 (the day before the deadline to serve requests). *See* Davis Declaration at ¶ 7. In that correspondence, Luxottica requested that Applicant advise if it wished to join in the motion to suspend in light of settlement discussions, but Applicant did not respond until August 7, 2020—three days after the deadline to serve discovery requests. *See* Davis Declaration at ¶ 8.

The parties discussed a draft and, on August 12, 2020, submitted the joint motion to suspend the proceeding. (D.N. 38). On October 8, 2020 the Board granted the motion, suspending the proceeding through October 12, 2020 and resetting the close of discovery to November 4, 2020. (D.N. 39).

Applicant first attempted to serve requests on September 4, 2020—the last day of the discovery period, prior to the suspension. *See* Davis Declaration at ¶ 9. In response, Luxottica

objected to the requests as untimely, directed Applicant to the relevant rule (37 C.F.R. § 2.120(a)(3)), and informed Applicant that “discovery requests would have had to be served ‘early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery.’” *See id.* at ¶ 10.

After the Board granted the joint motion to extend, Applicant again attempted to serve discovery requests. *See id.* at ¶ 11. Again, however, Applicant’s discovery requests were untimely because Applicant attempted to serve on October 13, 2020, less than thirty days before the new close of discovery (November 4, 2020). *See id.* Luxottica again objected to these requests as untimely. *See id.* at ¶ 12. Since Applicant did not serve its discovery requests thirty days before the close of discovery, as required by the Trademark Rules, and because Applicant has not shown good cause for an extension, the Board should deny Applicant’s motion to extend the discovery deadline.

## **II. Applicant Has Failed To Show Good Cause for the Requested Extension**

The Board should deny Applicant’s motion because it fails to show good cause for the extension. The Trademark Rules require that a party seeking an extension show good cause. Applicant presents facts that demonstrate nothing more than its own carelessness and lack of diligence in serving discovery. These facts do not constitute good cause and, therefore, the Board should deny Applicant’s motion.

A party moving to extend discovery deadlines “must set forth with particularity the facts said to constitute good cause for the requested extension[.]” TBMP § 509.01(a). The moving party “must demonstrate that the requested extension of time is not necessitated by the party’s own lack of diligence or unreasonable delay in taking the required action during the time period previously allotted therefor.” *Id.*

The term “good cause” does not appear anywhere in Applicant’s motion nor does Applicant’s motion allege any facts that would support a finding of good cause. Applicant fails, therefore, to “set for *with particularity* the facts said to constitute good cause[.]” *Id.* (emphasis added). Nevertheless, Applicant’s allegations demonstrate nothing more than its own lack of diligence and Applicant’s motion fails both logically and as a matter of law.

*A. Applicant’s Lack of Diligence Regarding the Motion To Suspend Does Not Constitute “Good Cause.”*

Applicant argues that it did not serve discovery requests by the deadline because it had a “mistaken understanding” of and “did not appreciate” the effect of the potential motion to suspend. (D.N. 42 p. 1-3). Applicant argues this despite having had an “opportunity to review and comment.” *Id.* at 3. Nevertheless, this argument fails both logically and as a matter of law.

This argument fails logically because Applicant claims that it did not serve discovery requests by the August 4, 2020, deadline because of the parties’ joint motion to suspend. But the parties did not agree to file the joint motion to suspend until several days later, and did not, in fact, file it until eight days after the deadline (on August 12, 2020). (D.N. 38). Applicant’s counsel did not even acknowledge Luxottica’s request to file a joint motion to suspend until the day after the deadline and at that point, Luxottica served its own set of discovery requests by the deadline. The joint motion to suspend, therefore, could not have prevented Applicant from serving requests by the deadline.

Applicant’s argument also fails as a matter of law. Rather than “demonstrate that the requested extension of time is not necessitated by the party’s own lack of diligence,” Applicant appears to embrace its lack of diligence and attempts to assert it as a reason to grant the motion. Applicant admits that it had an “opportunity to review and comment” on the motion to suspend.

(D.N. 42 at p. 3). It appears to have simply failed to exercise diligence during that review and comment period.

*B. Applicant's "Misunderstanding" of the Joint Motion To Suspend Does Not Constitute Good Cause.*

Applicant appears to argue that the motion to suspend that the parties jointly filed—or its “misunderstanding” thereof—constitutes good cause. Applicant argues that it believed that, during the suspension period, “the parties’ efforts would be focused on settlement, rather than discovery[.]” (D.N. 42 at p. 3). Applicant also argues that it “act[ed] in good faith when it agreed to the Joint Motion to Suspend ‘*in an effort to focus on settlement, rather than discovery.*’” (*Id.* at 4.) Again, this argument fails both logically and as a matter of law.

This argument fails logically because, while Applicant claims it thought that “the parties’ efforts would be focused on settlement, rather than discovery[.]” it *served requests on September 4, 2020—“during the suspension period.”* (*Id.* at p. 2–3). If Applicant believed, as it claims, that the parties would not engage in discovery during this period, then it is nonsensical that it would serve requests on September 4 when the opposition was effectively suspended.<sup>1</sup>

This argument also fails as a matter of law, because the existence of settlement discussion does not excuse a delay in serving discovery requests. In *National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (TTAB 2008), a party argued that it “delayed taking discovery because the parties were engaged in settlement discussions.” *Id.* at 1854. The Board rejected this reasoning, noting that the party did not “point[] to any exigent circumstances that prevented them from serving discovery while they continued” attempted settlement discussions.

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<sup>1</sup> Luxottica notes that, in the event that Applicant attempts to argue that it did not understand the rules that apply to service of discovery in Board proceedings, perhaps the Board would have winked at Applicant’s ignorance of the rules during the transition period when the rules went into effect in 2017, but such a lack of diligence cannot constitute good cause today.

*Id.* at 18545–55; *see Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (“[T]he mere existence of [settlement] negotiations or proposals, without more, would not justify petitioner’s delay in proceeding with testimony.”).

In this case, Applicant has failed to show good cause as to why it could not have served discovery requests, as Luxottica did, on August 4. Because it has failed to show good cause, the Board should deny its motion to extend.

### **III. Luxottica Has No Obligation To Respond to Applicant’s Untimely Discovery**

The parties do not dispute that Applicant submitted its requests in an untimely manner and that Luxottica has no obligation to respond to the requests as they stand. The Trademark Rules require a party to serve requests “early enough in the discovery period . . . so that responses will be due no later than the close of discovery.” 37 C.F.R. § 2.120(a)(3). Since responses “must be served within thirty days from the date of service of such discovery requests,” that means that a propounding party must serve requests at least thirty days before the close of discovery. *See id.* “A party has no obligation to respond to the merits of an untimely request for discovery[.]” TBMP § 403.01; *Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1271 (TTAB 2017) (sustaining an objection to requests as untimely where the propounding party failed to serve requests thirty days prior to the close of discovery).<sup>2</sup>

Luxottica served its discovery requests on August 4, 2020—thirty one days before the then-current close of discovery. Applicant admittedly failed to do so. (D.N. 42 at p. 1–2). Instead of serving discovery by the deadline, Applicant attempted to serve its first set of requests on September 4, 2020—the last day of the discovery period before the Board reset it. Applicant does

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<sup>2</sup> Note that in *Estudi* the Board reopened discovery to allow the propounding party’s requests to “be considered timely,” *because* the “case was pending as of the effective date of the revised rules and was initially filed under the prior rules” (under which file requests until the last date of discovery). *Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1271.

not dispute that it served its requests outside of the thirty-day response window deadline or that Luxottica “has no obligation to respond[.]” TBMP § 403.01.

On October 13, 2020, after the Board rescheduled the close of discovery to November 4, 2020, Applicant attempted to serve requests a second time. Again, Applicant served its requests with less than thirty days remaining in the discovery period. Because Applicant attempted to serve these requests outside of the time period required by the Trademark Rules, Luxottica still, therefore, has no obligation to respond to these requests.

The parties do not dispute that Applicant served its discovery requests outside of the time period mandated by the Trademark Rules. Since, therefore, Applicant served its requests after the deadline, Luxottica has no obligation to respond to these untimely requests. Therefore, Luxottica request that the Board deny Applicant’s motion to extend.



#### IV. Conclusion

The Board should deny Applicant's motion to extend the deadline for the close of discovery because Applicant has failed to show good cause in support of its motion. Instead, Applicant attempts to argue that its own lack of diligence constitutes good cause. As shown above, these arguments fail logically and as matters of law, the discovery period should remain as set, and Luxottica should not be required to respond to Applicant's untimely discovery requests. Luxottica respectfully requests that the Board deny Applicant's motion to extend discovery.

Respectfully Submitted,

Dated: November 9, 2020

/ Karen Kreider Gaunt/

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of **Opposer's Opposition to Applicant's Motion to Extend** has been served upon counsel of record, this 9th day of November, 2020 by e-mail addressed as follows:

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# **EXHIBIT A**

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
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<b>vs.</b>	)		Opposition No. 91243229
	)		<b>Mark: WAYFARER</b>
	)		Serial No. 87/690,818
<b>Wayfarer Development Ltd.</b>	)		
<b>F/k/a TIJ Limited,</b>	)		
	)		
	)	<b>Applicant.</b>	

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**DECLARATION OF GOVINDA M. DAVIS**

I, Govinda M. Davis, declare the following:

1. I am a citizen of the United States of America and am over 18 years of age. I have personal knowledge of the matters stated in this declaration.
2. I am an associate at Dinsmore & Shohl LLP.
3. I represent Luxottica Group S.p.A in the above-referenced matter.
4. On August 4, 2020, Luxottica served its initial disclosures and its first set of discovery requests on Wayfarer Development Ltd. F/k/a TIJ Limited (“Applicant”).
5. Applicant did not serve discovery request on August 4, 2020.
6. On July 31, 2020, Luxottica proposed a joint motion to suspend the proceedings in light of settlement discussions to Applicant’s counsel.
7. In proposing this joint motion, Luxottica requested that Applicant’s counsel respond by August 3, 2020.

8. Applicant's counsel did not respond to Luxottica regarding the joint motion to suspend until August 7, 2020.

9. Applicant's counsel first attempted to send discovery requests on September 4, 2020.

10. I responded to Applicant's counsel's attempt to serve discovery requests by objecting to the requests as untimely, referring them to the relevant rule Trademark Rule § 2.120(a)(3), and advised that "discovery requests would have had to be served 'early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery.'"

11. Applicant's counsel attempted to send discovery requests again on October 13, 2020.

12. I responded to Applicant's counsel's second attempt to serve discovery requests by objecting to the requests as untimely.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on November 9, 2020.

  
Govinda Davis