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

Proceeding no.	91243229
Party	Plaintiff Luxottica Group S.P.A.
Correspondence address	KAREN KREIDER GAUNT DINSMORE & SHOHL LLP 255 EAST FIFTH STREET SUITE 1900 CINCINNATI, OH 45202 UNITED STATES Primary email: karen.gaunt@dinsmore.com Secondary email(s): govinda.davis@dinsmore.com, robin.bissantz@dinsmore.com, trademarks@dinsmore.com 513-977-8200
Submission	Stipulated/Consent Motion to Extend
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Signature	/Karen Kreider Gaunt/
Date	01/26/2022
Attachments	Luxottica v. Wayfarer - Opp No. 91243229 - Stipulated Motion for Suspension.pdf(76829 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.)	
_____)	

STIPULATED MOTION FOR SUSPENSION OF TTAB PROCEEDINGS

Opposer Luxottica Group S.p.A. (“Luxottica”) and Applicant Wayfarer Development Ltd. f/k/a TIJ Limited (“Applicant”), pursuant to Trademark Rule 2.117(c) (37 C.F.R. § 2.117(c)), and Section 510.03 of the Trademark Trial and Appeal Board Manual of Procedure (hereinafter referred to as “TBMP”), hereby move the Trademark Trial and Appeal Board for an additional suspension of the proceedings in Opposition No. 91243229. Luxottica and Applicant hereby submit this Stipulated Motion for Suspension based on the Parties’ progress on settlement proceedings since its last Motion for Suspension, filed on October 19, 2021 and granted by the Board on December 7, 2021. This Stipulated Motion is supported by good cause.

Per the Board’s orders dated October 27, 2021, and December 7, 2021 the Board requires a showing of good cause be provided for suspension requests and must indicate: 1. The status of the parties’ settlement negotiations, including when the last settlement proposal was sent, by whom, and when a response is expected; 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; and 3. A timetable for resolution.

Luxottica and Applicant report that they have made additional progress on an agreement, which may resolve this matter and have had additional discussions regarding a potential settlement. The Parties further report that they have narrowed the issues for settlement down to one remaining issue which the Parties are currently actively negotiating. As such, the Parties meet all elements for a showing of good cause. Namely:

(1) The status of the parties' settlement negotiations, including when the last settlement proposal was sent, by whom, and when a response is expected. Since October 19, 2021 (the date of the Parties' last request for suspension of the proceedings), the Parties have communicated regarding settlement on October 19, 2021; January 7, 2022, January 10, 2022; and January 18, 2022. See Declaration of Karen Kreider Gaunt ("Gaunt Declaration") attached hereto as "Exhibit A" at ¶ 4. The communications referenced above have been by e-mail discussing the terms upon which the parties may be willing to resolve the opposition. *See* Gaunt Declaration at ¶ 5.

The last settlement proposal was sent by Opposer on January 7, 2022, in which Opposer expressed a willingness to revisit prior potential settlement terms and provided a general framework in which Opposer would be willing to resolve the matter. Applicant responded on January 18, 2022 with agreement to some of the terms proposed by Opposer and proposing one change to the terms as proposed by Opposer, in order to settle this Opposition. *See* Gaunt 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. 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 agreement relative to certain limitations to the field of use for Applicant's mark; and (3) Applicant's agreement relative to Opposer's trade dress. *See* Gaunt Declaration at ¶ 7. The following issues are yet to be resolved: (1) modification to the appearance of Applicant's trademark both in use and as to registration. *See* Gaunt Declaration at ¶ 8.

(3) A proposed timetable for resolution of the unresolved issues. The COVID19 crisis continues to affect both parties' ability to get things done quickly and move forward on settlement. Additionally, both parties are companies located outside of the United States. As to Luxottica, communications to the client in Italy must also be translated, discussed with, and decided upon by responsible individuals. Thus, it takes substantial time, even without the complications of the COVID19 pandemic, for both Parties to have the issues considered and have the appropriate individuals at the companies finalize the decisions. Counsel for Luxottica hopes to provide additional substantive comments to counsel for Applicant by February 28, 2022 and the Parties are hopeful that a settlement may be reached by April 30, 2022. *See* Gaunt Declaration at ¶ 9.

Counsel for Applicant agreed to a ninety-day suspension in an e-mail on January 21, 2022.

This Stipulated Motion for Suspension is made for the foregoing reasons and is not made for the purpose of undue delay in proceedings in the Trademark Trial and Appeal Board. It is submitted that the Parties have shown good cause in support of the Motion for Suspension.

Accordingly, the Parties respectfully move for the discovery and testimony periods to be suspended for ninety days and rescheduled as follows. Please note that the dates below are extended by ninety days from the date of the previous motion to suspend (D.N. 53).

Action	Current Date	New Date
Answer Due	Closed	
Deadline for Discovery Conference	Closed	
Discovery Opens	Closed	
Initial Disclosures Due	Closed	
Expert Disclosures Due	Closed	
Discovery period to close	Closed	
Plaintiff Pretrial Disclosures	Closed	
Plaintiff's 30-day Trial Period ends	Closed	
Defendant's Pretrial Disclosures	Closed	
Defendant's 30-day Trial Period ends	Closed	
Plaintiff's Rebuttal Disclosures	Closed	
Plaintiff's 15-day Rebuttal Period ends	Closed	
Suspension Ends	N/A	April 18, 2022
Plaintiff's Opening Brief Due	January 28, 2022	April 28, 2022
Defendant's Brief Due	February 27, 2022	May 28, 2022
Plaintiff's Reply Brief Due	March 14, 2022	June 12, 2022
Request for Oral Hearing (Optional) due	March 24, 2022	June 22, 2022

Date: January 26, 2022

s/ Karen Kreider Gaunt /

 Karen Kreider Gaunt
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 Attorneys for Opposer, Luxottica Group
 S.p.A.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document has been served upon the following by e-mail on counsel of record, this 26th day of January, 2022:

Geza C. Ziegler, Jr.
Ziegler IP Law Group LLC.
3135 Easton Turnpike, Shu Ihub, W-256
Fairfield, CT 06825 gziegler@gziplaw.com
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s/Karen Kreider Gaunt/

Karen Kreider Gaunt
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EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Opposer,)	Opposition No. 91243229
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v.)	Mark: WAYFARER
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Wayfarer Development Ltd. f/k/a)	
TIJ Limited,)	
)	
Applicant.)	
_____)	

DECLARATION OF KAREN KREIDER GAUNT

I, Karen Kreider Gaunt, solemnly and truly declare under penalty of perjury as follows:

1. I am a member in good standing of the State of Ohio Bar, and have been admitted to practice before the United States District Court for 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’ Consent Motion for Suspension. I have firsthand knowledge of the facts stated herein.

4. Since October 19, 2021 (the date of the Parties' last request for suspension of the proceedings), the Parties have communicated regarding settlement on October 19, 2021; January 7, 2022, January 10, 2022; and January 18, 2022.

5. The communications referenced above have been by e-mail discussing the terms upon which the parties may be willing to resolve the opposition.

6. The last settlement proposal was sent by Opposer on January 7, 2022, in which Opposer expressed a willingness to revisit prior potential settlement terms and provided a general framework in which Opposer would be willing to resolve the matter. Applicant responded to same on January 18, 2022 with its indication of agreement to most of the terms proposed by Opposer, and a counterproposal with respect to one term relative to Applicant's potential modification of use and registration of its mark moving forward. Opposer is taking this counter proposal into consideration.

7. 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 agreement relative to certain limitations to the field of use for Applicant's mark; and (3) Applicant's agreement relative to Opposer's trade dress.

8. The following issue is yet to be resolved: (1) modification to the appearance of Applicant's trademark both in use and as to registration.

9. Counsel for Luxottica hopes to provide additional substantive comments to counsel for Applicant by no later than February 28, 2022 and the Parties are hopeful that a settlement may be reached by April 30, 2022. *See* Gaunt Declaration at ¶ 9.

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 January 26, 2022



Karen Kreider Gaunt