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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.
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Submission	Motion to Suspend for Settlement Discussions
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Date	07/18/2022
Attachments	wayfarer stipulated motion 7-18-2022.pdf(563102 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 April 27, 2022 and granted by the Board on the same date. 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 resolving and settling this matter. Previously, the Parties had reached a preliminary agreement as to terms upon which this matter can settle. Since then, a draft settlement agreement has been prepared delineating final terms of the settlement, and this document is under consideration and review. 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 April 27, 2022 (the date of the Parties' last request for suspension of the proceedings), the Parties have continued to discuss settlement. See Declaration of Karen Kreider Gaunt ("Gaunt Declaration") attached hereto as "Exhibit A" at ¶ 4. A draft settlement agreement was prepared by counsel for Luxottica in May 2022, then reviewed by representatives for Luxottica, and thereafter shared with counsel for Applicant. See Gaunt Declaration at ¶¶ 5-6. This draft agreement is intended to memorialize the basic terms for settlement previously accepted by both Parties. The draft settlement agreement was sent by Luxottica to Applicant on July 12, 2022. 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 basic terms of the settlement arrangement between the Parties remain as they were when as of the date of the previous suspension request. Specifically, 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; and (4) Applicant's modification to

the appearance of Applicant's trademark in use and in future applications or registrations. *See* Gaunt Declaration at ¶ 4. One issue to be resolved is the geographic scope of the settlement, including whether these same terms will be applicable to pending disputes between the Parties in other countries. *See* Gaunt Declaration at ¶ 7.

(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.

However, now that a draft final agreement is under discussion, the Parties are optimistic that final resolution of this matter is near. The Parties need additional time to negotiate the final details of the settlement and hope to have a definitive agreement prepared, negotiated and signed by October 15, 2022. *See* Gaunt Declaration at ¶ 8.

Counsel for Applicant agreed to a ninety-day suspension in an e-mail on July 13, 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 (90) days and rescheduled as follows. The dates below are extended by ninety days from the schedule set in the Board's Suspension Order of April 27, 2022 (D.N. 58).

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	July 18, 2022	October 16, 2022
Plaintiff's Opening Brief Due	July 28, 2022	October 26, 2022
Defendant's Brief Due	August 27, 2022	November 25, 2022
Plaintiff's Reply Brief Due	September 11, 2022	December 10, 2022
Request for Oral Hearing (Optional) due	September 21, 2022	December 20, 2022

Date: July 18, 2022

s/ Karen Kreider Gaunt /

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 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 18th day of July, 2022:

Geza C. Ziegler, Jr.
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s/Karen Kreider Gaunt/

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EXHIBIT A

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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' STIPULATED MOTION FOR SUSPENSION OF TTAB PROCEEDINGS. I have firsthand knowledge of the facts stated herein.

4. Since April 27, 2022 (the date of the Parties' last request for suspension of the proceedings), the Parties have continued to communicate regarding settlement of this matter. These discussions have built on the terms already under consideration by the Parties as forming a basis for settlement, which include, 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; and (4) Applicant's modification to the appearance of Applicant's trademark both in use and as to future applications and registrations.

5. In May 2022, counsel for Luxottica prepared a draft settlement agreement memorializing the basic terms of settlement agreed upon between the Parties and fleshing the same out into a formal agreement. This draft agreement was then sent to Luxottica for its review.

6. In July 2022, Luxottica provided authorization for its counsel to share the draft settlement with Applicant, and I forwarded the draft to Applicant's counsel on July 13, 2022.

7. At this time, at least one outstanding issue remains to be resolved, specifically, whether the geographic scope of the settlement will be limited to the United States or whether it will have global effect.

8. The Parties hope to have a definitive settlement agreement drafted, negotiated and signed by no later than October 15, 2022.

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 July 18, 2022



Karen Kreider Gaunt