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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	10/17/2022
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**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: <b>WAYFARER</b>
	)	
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 July 18, 2022 and granted by the Board on July 29, 2022. 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, Luxottica had prepared a draft settlement agreement based on basic terms agreed upon in principle by the Parties, and that document was out for review by Applicant. Since then, the Parties have continued negotiations and refined the terms of the settlement agreement such that it is nearly in condition for execution. 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 July 18, 2022 (the date of the Parties' last request for suspension of the proceedings), the Parties have continued negotiating the terms of settlement, including discussions regarding the scope of the settlement agreement and its applicability to applications filed in countries other than the U.S. See Declaration of Karen Kreider Gaunt ("Gaunt Declaration") attached hereto as "Exhibit A" at ¶¶ 4-6. A revised settlement agreement reflecting these discussions was prepared by counsel for Luxottica, and shared with counsel for Applicant on October 5, 2022. See Gaunt Declaration at ¶ 7. On October 14, 2022, Counsel for Applicant indicated that the revised draft was acceptable, but asked to revise it slightly to include an additional example showing acceptable use of Applicant's mark. See Gaunt Declaration at ¶ 8.

(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. Although the basic terms of the settlement as it pertains to the U.S. market have not changed, the Parties have resolved the main issue that remained outstanding as of the date of the last request for suspension in this matter,

specifically, the geographic scope of the agreement and its applicability to applications filed in countries other than the U.S. See Gaunt Declaration at ¶ 6. The Parties are now in the final stage of refining the terms of the agreement in preparation for execution of the same.

(3) A proposed timetable for resolution of the unresolved issues. Although only one minor point remains to be resolved, the fact that both parties are companies located outside of the United States does impact each Party's ability to react swiftly. As to Luxottica, communications to the client in Italy must be translated, discussed with, and decided upon by responsible individuals. Thus, it takes substantial time for both Parties to have the issues considered and have the appropriate individuals at the companies finalize the decisions and take the necessary actions to execute the final agreement. Further, the Parties are mindful that the holiday season is approaching, which may also impact the ability to secure the participation of necessary individuals on a timely basis.

However, given that the issues are nearly resolved — with only one minor question, regarding approval of an example of acceptable use, outstanding — the Parties are hopeful that this matter will be resolved by the end of the calendar year. However, under the circumstances, the Parties recognize that a more realistic target for resolution is likely to fall in early 2023. See Gaunt Declaration at ¶ 9.

Counsel for Applicant agreed to a ninety-day suspension in an e-mail on October 14, 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 July 29, 2022 (D.N. 60).

<b>Action</b>	<b>Current Date</b>	<b>New Date</b>
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	October 16, 2022	January 14, 2023
Plaintiff's Opening Brief Due	October 26, 2022	January 24, 2023
Defendant's Brief Due	November 25, 2022	February 23, 2023
Plaintiff's Reply Brief Due	December 10, 2022	March 10, 2023
Request for Oral Hearing (Optional) due	December 20, 2022	March 20, 2023

Date: October 17, 2022

*s/ 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 17th day of October, 2022:

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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  
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 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 July 18, 2022 (the date of the Parties' last request for suspension of the proceedings), the Parties have continued to communicate regarding settlement of this matter.

5. In July 2022, a draft settlement agreement was under consideration by counsel for Applicant. In late July, counsel for Applicant responded with some minor modifications to the Agreement, and a request that the agreement also cover pending applications outside of the U.S.

6. During August and September of 2022, the Parties engaged in further discussions regarding the geographic scope of the settlement agreement and the marks and applications covered thereby. These negotiations, which concerned pending applications in other jurisdictions, resolved the last significant outstanding issue to be covered by the settlement agreement.

7. Luxottica provided a draft agreement reflecting those discussions to Applicant on October 5, 2022. On October 14, 2022, counsel for Applicant indicated that the terms of the agreement were acceptable, but asked to include an additional example of approved use.


8. At this time, the only outstanding issues to be resolved are securing Luxottica's approval of the additional example of approved use, and execution of the agreement itself.

9. The Parties hope to have these steps completed before the end of the calendar year, but recognizing that holiday schedules could impact the timing of this resolution, seek to suspend matters until early 2023.

*[continued]*

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 October 17, 2022

  
\_\_\_\_\_  
Karen Kreider Gaunt