

## Request for Reconsideration after Final Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	79139342
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 103
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
Please see the attached pdf which contains Applicant's argument and supporting declaration.	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_96231192246-20150429143246650169_LASA_VENATO_RR3_with_Declaration.pdf</a>
<b>CONVERTED PDF FILE(S) (6 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\393\79139342\xml20\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\393\79139342\xml20\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\393\79139342\xml20\RFR0004.JPG</a>
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	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\393\79139342\xml20\RFR0007.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	Argument with Declaration
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Jacqueline Patt/
<b>SIGNATORY'S NAME</b>	Jacqueline L.Patt
<b>SIGNATORY'S POSITION</b>	Attorney of Record, DC/MD bar member
<b>SIGNATORY'S PHONE NUMBER</b>	202-888-7892

<b>DATE SIGNED</b>	04/29/2015
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Wed Apr 29 14:58:31 EDT 2015
<b>TEAS STAMP</b>	USPTO/RFR-96.231.192.246-20150429145831298285-79139342-530a32d1f674214c694892842dff18128cd2ec6ac7b1a69eee44312342d70fdf41-N/A-N/A-20150429143246650169

PTO Form 1960 (Rev 9/2007)  
OMB No. 0651-0050 (Exp. 07/31/2017)

**Request for Reconsideration after Final Action  
To the Commissioner for Trademarks:**

Application serial no. **79139342** has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

Please see the attached pdf which contains Applicant's argument and supporting declaration.

**EVIDENCE**

Evidence in the nature of Argument with Declaration has been attached.

**Original PDF file:**

[evi\\_96231192246-20150429143246650169\\_.LASA\\_VENATO\\_RR3\\_with\\_Declaration.pdf](#)

**Converted PDF file(s)** ( 6 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /Jacqueline Patt/ Date: 04/29/2015

Signatory's Name: Jacqueline L.Patt

Signatory's Position: Attorney of Record, DC/MD bar member

Signatory's Phone Number: 202-888-7892

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79139342

Internet Transmission Date: Wed Apr 29 14:58:31 EDT 2015

TEAS Stamp: USPTO/RFR-96.231.192.246-201504291458312

98285-79139342-530a32d1f674214c694892842

dff18128cd2ec6ac7b1a69eee44312342d70fdf4

1-N/A-N/A-20150429143246650169

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: LASA PER L'INDUSTRIA DEL MARMO S.R.L.;  
abbreviated LASA MARMO SRL  
Serial No: 79/139342  
Mark: **LASA VENATO**

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**REQUEST FOR RECONSIDERATION No. 3**

The Examining Attorney has issued his fifth action maintaining his refusal of registration based on the allegation that the term LASA in Applicant's mark is primarily merely geographically descriptive of the origin of the goods under Section 2(e) of the Trademark Act. See Fifth Action dated April 9, 2015 ("April Action"). Applicant finds this additional action attaching more internet "evidence" to be both disturbing and unsettling. These repeated actions have placed a significant hardship upon the Applicant through excessive time and expense required to respond and rebut the Examining Attorney's numerous actions.

Applicant submits that these repeated actions are excessive and are in violation of the Trademark Manual of Examining Procedure. Specifically, "[t]he examining attorney's first Office action must be complete, so the Applicant will be advised of all requirements for amendment and all grounds for refusal, .... Every effort should be made to avoid piecemeal prosecution, because it prolongs the time needed to dispose of an application." TMEP §704.01. Further, "[s]econd actions should be final actions whenever possible...it is in the public interest that prosecution be limited to as few actions as is consistent with proper examination." TMEP §714.03. And finally, "[t]he examining attorney should place all evidence in support of his or her refusal in the record at the time the final action is issued." TMEP §714.04. Contrary to the foregoing, the Examiner has issued 5 actions and continues to attach new "evidence" to each action.

By the Examiner's actions, it is clear that he agrees with the Applicant that he has not yet provided sufficient evidence at any point in the examination to support his allegation that the mark is primarily geographically descriptive or that the town has an identity separate from Applicant's business since he has continued to issue more actions in an attempt to find evidence that supports his allegation. However, all roads lead back to Applicant: all the evidence provided in the previous actions and this most recent action support the Applicant's claim that the small and remote town of Lasa is only known because of Applicant's substantial goodwill established in its mark since the 1920's.

Applicant refers to its prior arguments that Lasa is a small and remote town in the province of South Tyrol, Italy with no hotels, no traffic lights, only 20 paved roads, no shopping center, and only one elementary school for children up to fifth grade. *See* July 3, 2014 Response at p. 5. Furthermore, the town of Lasa was named for Applicant's company. *See id.* at 10. Because the Applicant has established that Lasa is obscure and remote, a claim that has not been refuted by the Examining Attorney with any evidence, it is incumbent on the Examining Attorney to submit evidence to establish a goods place association of Applicant's goods with the town of Lasa. *See In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 849-50 (TTAB 1982).

Applicant has rebutted the Examining Attorney's evidence submitted with the first four actions in its prior responses. *See* Applicant's Responses filed March 31, 2015, December 24, 2014 and July 3, 2014. Now the Examining Attorney has attached 10 websites (6 of which were disposed of in previous responses) in another effort to substantiate his position. As explained below, the "new evidence" consists of 3 references that refer to Applicant and 1 that is simply in error and has no probative value. Therefore, this further evidence does nothing to support the Examiner's contention that the remote and obscure town of Lasa in Northern Italy has an identity separate and apart from Applicant and its business.

1. Wikipedia [http://en.wikipedia.org/wiki/Laas,\\_South\\_Tyrol](http://en.wikipedia.org/wiki/Laas,_South_Tyrol)

*We have already addressed this reference in the December 24, 2014 Response, p.3.*

2. Graniteland <http://www.graniteland.com/stone/lasa>

*We have already addressed in the March 31, 2015 Response, p.5.*

3. TripAdvisor Lasa [http://www.tripadvisor.com/Tourism-g2048585-Lasa\\_South\\_Tyrol\\_Province\\_Trentino\\_Alto\\_Adige-Vacations.html](http://www.tripadvisor.com/Tourism-g2048585-Lasa_South_Tyrol_Province_Trentino_Alto_Adige-Vacations.html)

*We have already addressed this in the December 24, 2014 Response, p.4.*

4. MS International Inc. <http://www.msistone.com/marble/calacatta-lasa/>

This is a US website of a large Marble and Stone distributor based in California which sells tiles and slab, mostly Indian and Chinese materials. As stated in my March Declaration, ¶37, There is no such thing as "Calacatta Lasa Marble". There is CALACATTA marble that is a rare and expensive marble that comes from Carrera, Italy (see attached Exhibit 20 attached to my March Declaration), and there is LASA marble which is Applicant's marble from the South

Tyrol region of Italy. This type of misinformation is unfortunate, but does not support the Examiner's argument that the town Lasa has an identity apart from Applicant's business. See Graf Declaration dated April 27, 2015 ("April Declaration"), ¶48, attached hereto.

5. Vinschgau <http://www.vinschgau.net/en/art-culture/places-of-interest/marble.html>

*We have already addressed this reference in the March 31, 2015 Response, p.5.*

6. Graniteland <http://www.graniteland.com/stone/lasa-bianco-vena-d-oro>

*We have already addressed in the March 31, 2015 Response, p.5.*

7. Erlebnishotel Engel <http://www.hotelengel.com/en/Lasa-the-Marble-Village.html>

*We have already addressed this reference in the March 31, 2015 Response, p.7.*

8. Dolomiti.it <http://www.dolomiti.it/en/south-tyrol/lasa/>

This website provides information on the small town of Lasa. The website discusses the railway (that was built by Lasa Marmo's founder Matthias Gasteiger in 1928, see March Declaration ¶36), two local companies (up and until 2008 there were Lechner Marmor AG and Lasa Marmo AG; today in Laas there is one company – Lechner Marmor AG who acquired Lasa Marmo in 2008) and the Lasa parish church (which was built with marble from the applicant). See April Declaration, ¶49.

9.Parks.it [http://www.parks.it/parco.nazionale.stelvio/Epun\\_dettaglio.php?id\\_pun=1274](http://www.parks.it/parco.nazionale.stelvio/Epun_dettaglio.php?id_pun=1274)

This site discusses marble quarries in Lasa. This site mentions that marble is extracted from the tunnel quarry of "Acqua Bianca" and from Covelano, the only two quarries that are still working. Acqua Bianca (or White Water or Weißwasser Bruch is Applicant's quarry, see March Declaration, ¶41). Covelano marble is extracted from the Göflaner Bruch quarry operated by a third party on the other side of the mountain in a village called Silandro/Schlanders, see March Declaration, ¶41. This site further discusses that the marble has been used to prepare the over 80,000 crosses and stars of David commissioned in the 1950s by the United States Government and placed in the American war cemeteries scattered all over the world. These crosses and stars are from Lasa Marmo and only Lasa Marmo. See April Declaration, ¶50.

10. Sudtirol.com <http://www.sudtirol.com/en/events-south-tyrol/marble-apricots.htm>

This webpage discusses a festival in Lasa in August 2013. The advertisement mentions that historical monuments in Austria, London and New York have used marble from Applicant. Indeed most of the monuments have their origin in the marble from Lasa Marmo or its predecessors. See April Declaration, ¶51.

### **Conclusion**

In sum, the term LASA is so obscure and remote that U.S. purchasers would fail to recognize the term as a geographic place and would view LASA as an arbitrary term used as Applicant's trademark for its goods. Applicant submits that after *five* attempts, if the Examining Attorney has not been able to establish that the town Lasa is "famous" or has its own identity apart from the Applicant, the refusal must fail and must be withdrawn.

It is respectfully submitted that there is sufficient doubt about the geographic descriptiveness of the term LASA in Applicant's mark in the present case so that the application should be approved for publication. "When doubts exist as to whether a term is descriptive as applied to the goods or services for which registration is sought, it is the practice of this Board to resolve doubts in favor of the Applicant and pass the mark to publication with the knowledge that a competitor of Applicant can come forth and initiate an opposition proceeding in which a more complete record can be established." In re the Stroh Brewery Co., 34 USPQ2d 1796, 1797 (TTAB 1994) (citing In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972); In re Int'l Taste Inc., 53 USPQ2d 1604, 1605-06 (TTAB 2000) (finding doubt as to the primary significance of HOLLYWOOD because of other prominent, significant meaning of HOLLYWOOD as referring to the entertainment industry in general, with the doubt resolved in favor of the Applicant).

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: LASA PER L'INDUSTRIA DEL MARMO S.R.L.;  
abbreviated LASA MARMO SRL  
Serial No: 79/139342  
Filed: September 30, 2013  
Mark: **LASA VENATO**  
LASA PER L'INDUSTRIA DEL MARMO S.R.L.; abbreviated LASA MARMO SRL

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**DECLARATION OF PAUL GRAF**

**IN SUPPORT OF THIRD REQUEST FOR RECONSIDERATION**

45. My name is Paul Graf; I am over 18 years old; I am competent to testify to, and have personal knowledge of, the matters set forth herein.
46. I have reviewed the below websites provided by the Examining Attorney in his Third Final Office Action of January 20, 2015.
47. I have previously addressed six out of the ten websites attached to this most recent action. I will address below the four new website pages.
48. <http://www.msistone.com/marble/calacatta-lasa>  
This is a US website of a Marble and Stone large distributor based in California which sells tiles and slab, mostly Indian and Chinese materials. As stated in my March Declaration, ¶37, There is no such thing as “Calacatta Lasa Marble”. There is CALACATTA marble that is a rare and expensive marble that comes from Carrera, Italy (see attached Exhibit 20 attached to my March Declaration), and there is LASA marble which is Applicant’s marble from the South Tyrol region of Italy. This type of misinformation is unfortunate, but does not support the Examiner’s argument that the town Lasa has an identity apart from Applicant’s business.
49. <http://www.dolomiti.it/en/south-tyrol/lasa/>  
This website provides information on the small town of Lasa. The website discusses the railway (that was built by Lasa Marmo’s founder Matthias Gasteiger in 1928, see my March Declaration ¶36), two local companies (up and until 2008 there were Lechner Marmor AG and Lasa Marmo AG; today in Laas there is one company – Lechner Marmor AG who acquired Lasa Marmo in 2008) and the Lasa parish church (which was built with marble from the applicant).
50. [http://www.parks.it/parco.nazionale.stelvio/Epun\\_dettaglio.php?id\\_pun=1274](http://www.parks.it/parco.nazionale.stelvio/Epun_dettaglio.php?id_pun=1274)

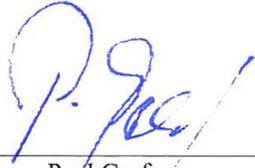
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51. <http://www.sudtirol.com/en/events-south-tyrol/marble-apricots.htm>

This webpage discusses a festival in Lasa in August 2013. The advertisement mentions that historical monuments in Austria, London and New York have used marble from Lasa. Indeed most of the monuments have their origin in the marble from Lasa Marmo or its predecessors.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge.

Date: April 27, 2015



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Paul Graf