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

Proceeding	79139342
Applicant	LASA PER L'INDUSTRIA DEL MARMO S.R.L.; a
Applied for Mark	LASA VENATO
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Law Office 103  
Examining Attorney: Seth A. Rappaport

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**

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**APPLICANT'S APPEAL BRIEF**

Applicant submits herewith its Appeal brief in response to the Examining Attorney's Final Refusal of registration based upon the section 2(e)(2) of the Trademark Act.

Respectfully submitted,



Date: June 9, 2015

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Table of Contents

<b>I. <u>Introduction</u></b> .....	<b>4</b>
<b>II. <u>The Record</u></b> .....	<b>4</b>
<b>III. <u>The Examiner’s Position</u></b> .....	<b>4</b>
<b>IV. <u>The Applicant’s Position</u></b> .....	<b>4</b>
<b>V. <u>Summary of the Facts</u></b> .....	<b>5</b>
<b>A. Application Serial No. 79139342 For The Mark LASA VENATO</b> .....	<b>5</b>
<b>B. The Town LASA Was Named After Applicant</b> .....	<b>5</b>
<b>C. LASA Is A Small And Remote Village In The Northern Mountain Region Of Italy</b> .....	<b>7</b>
<b>D. Applicant’s Mark Is A Recognized Indicator Of The Source Of Applicant’s Goods In The U.S.</b> .....	<b>7</b>
<b>E. There Are Other Meanings Of The Term LASA</b> .....	<b>8</b>
<b>VI. <u>Argument</u></b> .....	<b>8</b>
<b>A. The Standard for Primarily Geographically Descriptive Marks</b> .....	<b>9</b>
<b>B. Laas Is So Obscure And Remote That U.S. Customers Would Fail to Recognize the Term as Geographic.</b> .....	<b>11</b>
<b>C. American Consumers Identify The Primary Significance Of The Mark LASA As An Indicator Of Source Of Applicant's Goods.</b> .....	<b>13</b>
1. The Town LASA Was Named For Applicant And The Mark Has Come To Signify Applicant’s Goods. ....	13
2. The Term LASA Has Meanings Other Than As A Geographic Location .....	16
<b>D. The Examining Attorney’s Evidence Does Not Establish A Public Association Of The Goods With The Place</b> .....	<b>16</b>
<b>VII. <u>Summary</u></b> .....	<b>20</b>
<b>VIII. <u>Conclusion</u></b> .....	<b>21</b>

## Table of Authorities

### Cases

<i>ConAgra Inc. v. Saavedra</i> , 4 USPQ2d 1245 (TTAB 1987) .....	9
<i>Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.</i> , 93 USPQ 250 (S.D.N.Y. 1951), <i>aff'd</i> , 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), <i>cert. denied</i> , 346 U.S. 827, 99 USPQ 491 (1953).....	13
<i>In re Bavaria St. Pauli Brauerei AG</i> , 222 USPQ 926 (TTAB 1984).....	10
<i>In re Brauerei Aying Franz Inselkammer KG</i> , 217 USPQ 73 (TTAB 1983) .....	11
<i>In re Brouwerij Nacional Balashi NV</i> , 80 USPQ2d 1820 (TTAB 2006).....	9, 11, 13, 15
<i>In re Cambridge Digital Systems</i> , 1 USPQ2d 1659 (TTAB 1986).....	10
<i>In re Cotter &amp; Co.</i> , 228 USPQ 202 (TTAB 1985).....	14
<i>In re Gourmet Bakers, Inc.</i> , 173 USPQ 565 (TTAB 1972).....	20
<i>In re Handler Fenton Westerns, Inc.</i> , 214 USPQ 848 (TTAB 1982).....	10, 16
<i>In re Int'l Taste Inc.</i> , 53 USPQ2d 1604 (TTAB 2000).....	20
<i>In re Kapalua Land Company, Ltd.</i> , Serial No. 76670962 (March 26, 2013) [not precedential].....	14
<i>In re Mankovitz</i> , 90 USPQ2d 1246 (TTAB 2009).....	9
<i>In re Namibia Breweries Limited</i> , Serial Nos. 77761812 and 77761817 (September 12, 2011) [not precedential] ....	10
<i>In re Nantucket, Inc.</i> , 213 USPQ 889 (CCPA 1982) .....	9
<i>In re Pebble Beach Co.</i> , 19 USPQ2d 1687 (TTAB 1991).....	14
<i>In re Societe Generale des Eaux Minerales de Vittel, S.A.</i> , 3 USPQ2d 1450 (Fed. Cir. 1987).....	10, 12
<i>In re the Stroh Brewery Co.</i> , 34 USPQ2d 1796 (TTAB 1994).....	20
<i>In re Wada</i> , 52 USPQ2d 1539 (Fed. Cir. 1999) .....	9

### Statutes

15 U.S.C. §1052(e)(2) .....	i, 4, 8, 9, 13, 21
-----------------------------	--------------------

### Other Authorities

Applicant's First Request for Reconsideration dated December 24, 2014.....	4, 5, 6, 14, 17, 18
Applicant's First Response dated July 3, 2014.....	4, 6, 17
Applicant's Second Request for Reconsideration dated March 31, 2015.....	4, 18
Applicant's Third Request for Reconsideration dated April 29, 2015.....	4, 18
Examiner's Fifth Action dated January 20, 2015.....	4, 18
Examiner's First Office Action dated January 15, 2014.....	4, 7, 12, 17
Examiner's Fourth Action dated January 20, 2015 .....	4, 18
Examiner's Second Action (Final) dated July 3, 2014.....	4, 17
Examiner's Seventh Action dated May 8, 2015 .....	4, 19
Examiner's Sixth Action dated April 9, 2015 .....	4, 18
Examiner's Third Action dated January 5, 2015.....	4, 18

### Rules

TMEP §1210.02(a).....	13
TMEP §1210.02(B)(I).....	13
TMEP §1210.04 .....	9
TMEP §704.01.....	19
TMEP §710.01(b).....	17
TMEP §714.03.....	19
TMEP §714.04.....	20

**I. Introduction**

This matter is before the Board on Appeal by the Applicant from a final refusal of registration based on Section 2(e)(2). 15 U.S.C. §1052(e)(2).

**II. The Record**

The record for this appeal consists of seven actions from the Examining Attorney as well as Applicant's application and four responses and requests for reconsideration of the Examining Attorney's actions as noted below:

- Examiner's First Office Action dated January 15, 2014
- Applicant's First Response dated July 3, 2014
- Examiner's Second Action (Final) dated July 3, 2014
- Applicant's First Request for Reconsideration dated December 24, 2014
- Examiner's Third Action dated January 5, 2015
- Examiner's Fourth Action dated January 20, 2015
- Examiner's Fifth Action dated January 20, 2015
- Applicant's Second Request for Reconsideration dated March 31, 2015
- Examiner's Sixth Action dated April 9, 2015
- Applicant's Third Request for Reconsideration dated April 29, 2015
- Examiner's Seventh Action dated May 8, 2015

**III. The Examiner's Position**

It is the Examiner's position that the term LASA in Applicant's mark is geographically descriptive of Applicant's goods.

**IV. The Applicant's Position**

It is the Applicant's position that the term LASA is not geographically descriptive of Applicant's goods because (1) the municipality 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, and (2) the primary significance of the term LASA is to signify Applicant's goods and the marble it quarries because Lasa was named after Applicant's business and only through Applicant's efforts and use of the mark since the 1920's has the name become recognized as a source of marble goods.

**V. Summary of the Facts**

**A. Application Serial No. 79139342 For The Mark LASA VENATO**

Applicant LASA PER L'INDUSTRIA DEL MARMO S.R.L.; abbreviated LASA MARMO SRL filed an extension to the U.S. of its International Registration for the mark LASA VENATO under Section 66(a). *See* Application Serial No. 79/139342 with an effective date of September 30, 2013. During examination, Applicant disclaimed any exclusive right to the term VENATO apart from the mark as a whole and amended the identification of goods in International Class 9 as follows:

Non-metallic building materials, namely, floor and wall tiles, slabs of natural stone, surrounds for fireplaces, gabions; monuments, not of metal; aquarium gravel; aquarium sand; balustrades; building stone; busts of stone, concrete and marble; clinker ballast; facings, not of metal, for building, namely, marble tiles and slabs; floor tiles, not of metal; floors, not of metal; grave and tomb enclosures, not of metal; gravel in all sizes and dimensions; lime building materials; limestone; marble and marble in block and slab form; memorial plaques of stone; architectural moldings, not of metal, for building; mosaics made of natural stone and stone tile for building; paving blocks, not of metal; window sills, not of metal; stair-treads, not of metal; staircases, not of metal; statues of stone, concrete and marble; statuettes of stone, concrete and marble; stone for building and construction; tiles, not of metal, for building; tomb slabs, not of metal; tomb monuments, not of metal; tombs, not of metal; tombstone plaques, not of metal; tombstone stelae, not of metal; tombstones of stone, concrete or marble; burial vaults, not of metal; synthetic wall claddings, not of metal, for building; wall linings, not of metal, for building; window frames, not of metal; works of art of stone, concrete and marble; works of art of stonemasonry.

**B. The Town LASA Was Named After Applicant**

The town now known as “Lasa” was originally named LAS in 1143 and then LAAS in 1326. *See* Declaration of Paul Graf dated December 24, 2014 (“December Declaration”) attached as Exhibit 6 to First Request for Reconsideration, ¶ 27, and “*Toponym Laas*” (Names of Villages of South Tyrol and their History) with English translation, attached as Exhibit 14 to First Request for Reconsideration, showing the historical naming of the current municipality Lasa.

In 1912, the founder of Applicant’s predecessor company was granted a lease to a quarry in, at the time, a region in Austria called Laas Valley and created a new company called *LAASA*

*Marmor-Bruchbetrieb GmbH* (translated “LAASA Marble Quarrying LLCs). See Declaration of Paul Graf dated June 16, 2014 (“June Declaration”) attached as Exhibit 2 to Response, ¶10. It is believed that the founder chose the name LAASA for his company to mimic the melodic sound of the well known marble “Carrera” and added the euphonic “a” to the German “LAAS.” See December Declaration, ¶30, and [www.LasaMarmo.it](http://www.LasaMarmo.it), attached as Exhibit 15 to First Request for Reconsideration.

Despite the devastation in the area and to the economy of the region during World War I, LAASA Marble Quarrying LLCs was very successful and even expanded its business into commercial uses. See June Declaration, ¶11. In 1919, after World War I, the Austro Hungarian Empire was divided up and the region now called South Tyrol, formerly an Austrian Territory, became an Italian territory. See *id.* ¶12, and Exhibit 5 to Response.

An Italian decree in 1923 required that all the German names of villages, places and public institutions were banned in favor of Italian names. German newspapers, publishing houses, organized clubs and associations, road and pathnames and the surnames of the German population were all forced to be renamed. See “*Italianization of South Tyrol*” on Wikipedia®, attached as Exhibit 5 to Response, and June Declaration, attached as Exhibit 2, ¶13.

As a result of the Italian decree, the town of LAAS was changed to LAASA as a reflection of the then well known company *LAASA Marmor-Bruchbetrieb GmbH*, but without the “AA” from the German name because there is no “AA” in the Italian language. See “*Gazzetta Ufficiale del Regno d Italia*” (the publication of the Royal Decree 800 on April 27, 1923) and English translation (ordering the new Italian names of the villages in the South Tyrol), attached as Exhibit 16 to First Request for Reconsideration; “Names of Villages of South Tyrol and their History”, attached as Exhibit 14 to Request for Reconsideration (showing the new name LASA); December Declaration, ¶25-26. Therefore, the village became “LASA”. See June Declaration, ¶13.

Up until 1923 the name “LAASA” was only used for Applicant’s predecessor company.

See December Declaration, ¶29. The company *LAASA Marmor-Bruchbetrieb GmbH* was also forced to Italianize its name removing the German double “AA” to the Italian single “A” to become “Società Anonima LASA per l’Industria del Marmo”, in short “LASA Marmo.” See December Declaration ¶28.

**C. LASA Is A Small And Remote Village In The Northern Mountain Region Of Italy**

Lasa is located in the Alpine region of northern Italy. See “Laas, South Tyrol” on Wikipedia, attached to the First Office Action, p.15. Today, the geographic footprint of Lasa is 42 square miles. See *id.* In 2013, there were just 2146 inhabitants in the town of Lasa. See June Declaration, ¶5. Applicant, Lasa Marmo is the largest employer in Lasa and there is no other industry of value in Lasa. See *id.* at ¶6.

In Lasa, there are no hotels, and there are just a few small private bed and breakfasts. There are three small restaurants and one coffee shop (but that is not open year round). There is no shopping center and only a few small retail stores. There is no cinema or theatre. There is no tourist or entertainment infrastructure. There is only one elementary school for children up the 5<sup>th</sup> grade and kindergarten. There are only 20 paved roads with no traffic lights. See *id.*

**D. Applicant’s Mark Is A Recognized Indicator Of The Source Of Applicant’s Goods In The U.S.**

Applicant’s LASA marble has a long tradition over more than a century in the U.S. See June Declaration, ¶15. Several monuments in the U.S. including the Loreley Fountain in the Bronx, New York, 23 sculptures in front of the Manhattan Appellate Courthouse in New York, and the Total Abstinence Fountain in Philadelphia, Pennsylvania used LASA marble and were built before the year 1900. In the 1950’s, the U.S. government commissioned some 96,000 crosses using LASA marble for the American World War II cemeteries all over the world, from England to Italy to France to the Philippines, etc. See *id.*

More recently, Applicant's LASA marble has been used in buildings throughout the U.S. including Greenwich, CT, Facade of the United-States-Tobacco-Building, Greenwich, Connecticut (1972), Facade of the Mausoleum in White Chapel Memorial Gardens & Mausoleum, Wichita, Kansas, Façade of the First-Federal-Savings-Bank Miami, Florida (1969), Façade of the City Hall (1963) in Memphis, Tennessee and First National Bank, Dallas Connecticut. *See id.* ¶16.

The most prominent building in the U.S to use LASA marble will be the World Trade Transportation Hub, designed by Santiago Calatrava, in New York. This project is set to be complete in 2015. *See id.* ¶17.

**E. There Are Other Meanings Of The Term LASA**

The following are other recognized uses of the term "Lasa":

- Lasas were gods and goddesses in Etruscan mythology.
- Laboratory Animal Science Association
- Latin American Studies Association
- Liberal Arts and Science Academy High School of Austin Texas
- Lasa, a small village in France
- Lhasa, the capital of Tibet Autonomous Region in China
- Lasa, a village in Paphos Cyprus
- Mikel Lasa a Spanish football player
- German Chess master Tassilo von Heydebrand und der Lasa

*See* Wikipedia entry for LASA, attached as Exhibit 3.

In addition, the term "Lasa" can be translated from Romanian to mean "let" or "leave".

*See* Google Translate attached as Exhibit 4.

**VI. Argument**

The Examining Attorney has refused 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)(2) of the Trademark Act and the term VENETO is descriptive. Applicant has disclaimed all rights to the term VENATO apart from the mark as a whole. Applicant respectfully requests that the refusal of the term LASA be withdrawn for the following

reasons.

**A. The Standard for Primarily Geographically Descriptive Marks**

It is the examining attorney's burden to establish the prima facie case in support of the refusal of registration. When the mark identifies the geographic origin of the goods as is the case at hand, a prima facie case for refusal under Section 2(e)(2) that the mark is primarily geographically descriptive of the goods requires a showing that (1) the mark's primary significance is a generally known geographic location; and (2) that the relevant public would be likely to make a goods/place association, i.e., would be likely to think that the goods originate (or will originate) in the place named in the mark. *See* TMEP §1210.04; *see also In re Mankovitz*, 90 USPQ2d 1246 (TTAB 2009) (THE MONTECITO DIET held *not* primarily geographically descriptive because “the mere fact that applicant sleeps in Montecito is not necessarily enough to establish a goods/place relationship”).

A mark is not "primarily" geographic where the geographic meaning is minor, obscure, remote, or unconnected with the goods. *See In re Wada*, 52 USPQ2d 1539 (Fed. Cir. 1999); *In re Nantucket, Inc.*, 213 U.S.P.Q. 889, 892 (CCPA 1982) (finding Nantucket not geographically misdescriptive when the only evidence of record that Nantucket is primarily geographic is a dictionary listing and there was no evidence that the purchasing public would expect mens shirts to originate in Nantucket). Where the mark identifies a place that is obscure and remote, the term is an arbitrary designation because consumers will not perceive the geographic nature of the term as its primary significance and will not make a goods/place or services/place association. *See* TMEP §1210.04(c); *see also In re Brouwerij Nacional Balashi NV*, 80 USPQ2d 1820, 1827 (TTAB 2006) (finding Balashi, Aruba so obscure or remote that purchasers in the United States would not recognize it as indicating the geographical source of applicant's beer); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987) (TAPATIO held not primarily geographically

deceptively misdescriptive of meatless hot sauce when the significance of the term is lost on the public because of its obscurity).

Remoteness or obscurity is determined from the perspective of the average American consumer. See *In re Societe Generale des Eaux Minerales de Vittel, S.A.*, 3 USPQ2d 1450 (Fed. Cir. 1987) (“In dealing with all of these questions of the public's response to word symbols, we are dealing with the supposed reactions of a segment of the American public, in this case the mill-run of cosmetics purchasers, not with the unusually well-travelled, the aficionados of European watering places, or with computer operators checking out the meaning of strange words on NEXIS.”). The significance of the term is determined not in the abstract, but from the point of view of the consumers of the particular goods or services identified in the application. *In re Namibia Breweries Limited*, Serial Nos. 77761812 and 77761817 (September 12, 2011) (finding Windhoek remote and obscure) [not precedential]. See

<http://ttabvue.uspto.gov/ttabvue/v?pno=77761812&pty=EXA&eno=15>

Thus, registration should **not** be refused where, for example, (1) there is a genuine issue that the place named in the mark is so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods to which the mark is applied; or (2) an admittedly well-recognized term has other meanings, such that the term's geographical significance may not be the primary significance to prospective purchasers. See *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 849-50 (TTAB 1982) (DENVER WESTERNS ("WESTERNS" disclaimed) held primarily geographically descriptive of western-style shirts originating in Denver).

In these cases, the Trademark Examining Attorney would need to submit evidence to establish a public association of the goods with that place. See *Societe Generale Des Eaux Minerales*, 3 USPQ2d at 1451 (finding the evidence insufficient to show the likelihood of that the American cosmetic-purchasing public would think that Vittel refers to a place where the goods come from); see also *In re Bavaria St. Pauli Brauerei AG*, 222 USPQ 926 (TTAB 1984)

(reversing refusal of JEVER and design for beer originating in Jever, West Germany, where the sole evidence of a goods/place association was an entry from a 32-year-old geographic index); *In re Brauerei Aying Franz Inselkammer KG*, 217 USPQ 73 (TTAB 1983) (AYINGER BIER held not primarily geographically descriptive of beer emanating from Aying, West Germany, a hamlet of 500 inhabitants, where the examining attorney's only evidence of a goods/place association was the specimen label identifying Aying as the place of origin).

Applicant respectfully requests that such refusal be withdrawn for the following reasons:

(1) the municipality LASA is so obscure and remote that American customers would fail to recognize the term as geographic, (2) the significance of the term LASA is to signify Applicant's goods and the marble it quarries because Lasa was named after Applicant's business and only through Applicant's efforts and use of the mark since the 1920's has the name become recognized as a source of marble goods, and the term LASA has other meanings, and (3) the Examiner has not provided any evidence to establish a public association of the goods with that place.

**B. Laas Is So Obscure And Remote That U.S. Customers Would Fail to Recognize the Term as Geographic.**

In *Brouwerij Nacional Balashi*, although applicant's beer originated from Balashi, a goods/place association could not be presumed because Balashi is so remote and obscure. *Brouwerij Nacional Balashi*, 80 USPQ2d 1820 (finding evidence insufficient to establish that American consumers of beer would in make an association with Balashi). In that case, the Examining Attorney provided evidence that Balashi was a tourist destination and known for gold mining and for a large desalination plant. The applicant provided evidence that Balashi was a small and commercially insignificant neighborhood in the district of Santa Cruz with no boundaries and no official status, no hotels, government offices, post offices, churches or schools, and only a single restaurant and 14 maps which fail to show "Balashi" as a geographic place. The Board agreed with the Applicant:

"... the isolated area or neighborhood of Balashi in the Caribbean island of Aruba is simply so minor, remote and obscure that its geographic significance would not be known or otherwise readily apparent to purchasers of applicant's beer. To be sure, the average American beer consumer, after perhaps quaffing a few 'brews' while spending some time lying around on, or at least contemplating a vacation to, the white sand beaches of Aruba that serve as the island's principal tourist destinations, might have occasion to research and/or check out whatever other attractions, including gold mine ruins, a large desalination plant and applicant's brewery, would be of interest as a side trip to the locale of Balashi. The geographical significance, however, of the term 'Balashi' would not be apparent without, at a minimum, consulting sources of tourism information."

*See id.*

Also, in *Societe Generales des eaux Minerales*, the Federal Circuit found the small town of Vittel in northeastern France in the Department of Voges in the Voges mountains which had a population of 5476 in 1962 and where there is a resort with mineral springs was remote and obscure. *Societe Generales des eaux Minerales*, 3 USPQ2d at 1451.

Similarly, LASA identifies the Italian translation of a small, insignificant municipality in South Tyrol, which, except for applicant's business, is otherwise essentially devoid of any meaningful commercial activity.

Here, LAAS (Italian translation: LASA) identifies a remote and obscure municipality in the province of South Tyrol in northern Italy. *See* "Laas, South Tyrol" on Wikipedia, attached to the First Office Action, p.15. The geographic footprint of Laas/Lasa is 42 square miles. *See id.* In 2013, there were just 2146 inhabitants in the town of Laas. *See* June Declaration, ¶5. Applicant, Lasa Marmo is the largest employer in Laas and there is no other industry of value in Laas. *See id.* ¶6.

In Laas, there are no hotels, and there are just a few small private bed and breakfasts. There are three small restaurants and one coffee shop (but that is not open year round). There is no shopping center and only a few small retail stores. There is no cinema or theatre. There is no tourist or entertainment infrastructure. There is only one elementary school for children up to the 5<sup>th</sup> grade and kindergarden. There are only 20 paved roads with no traffic lights. *See id.* ¶6.

In contrast, there is no evidence that the town is a tourist destination, for any tourists whether from the US or elsewhere. There is no evidence that Lasa has been mentioned in any US

media or that it has a tourism board that targets Americans. Moreover, most of Lasa's own inhabitants refer to the town as LAAS, making it even more unlikely that US customers would know of LASA or associate Applicant's goods with the small remote town with the official name of LAAS.

The term LASA, therefore, 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

**C. American Consumers Identify The Primary Significance Of The Mark LASA As An Indicator Of Source Of Applicant's Goods.**

If the most prominent meaning or significance of the mark is not geographic, or if the mark creates a separate readily understood meaning that is not geographic, registration must not be refused under §2(e)(2), §2(e)(3), or §2(a). See TMEP §1210.02(B)(1); *see Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951), *aff'd*, 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) (holding that the primary significance of HYDE PARK for men's suits is to suggest that the product is stylish or of high quality rather than to provide information about geographic origin).

**1. The Town LASA Was Named For Applicant And The Mark Has Come To Signify Applicant's Goods.**

The term LASA is not primarily geographically descriptive because the term LASA originated with Applicant's predecessor company in 1912, and the municipality was named after the company. "The mere fact that a term may be the name of a place that has a physical location does not necessarily make that term geographic under §2(e)(2)." *See* TMEP §1210.02(a); *see also Brouwerij Nacional Balashi*, 80 USPQ2d 1820 (TTAB 2006) (finding that the applicant called attention to the more compelling and overwhelming evidence that U.S consumers of beer primarily identify "Balashi" with Applicant); *In re Pebble Beach Co.*, 19 USPQ2d 1687 (TTAB

1991 (17 MILE DRIVE not a geographic term, where it refers to a specific location wholly owned by applicant, and was coined by applicant to refer both to applicant's services and the place where the services were performed); *In re Cotter & Co.*, 228 USPQ 202, 205 (TTAB 1985) (finding primary significance of “West Point” to be U.S. Military Academy rather than town in New York where academy is located); *In re Kapalua Land Company, Ltd.*, Serial No. 76670962 (March 26, 2013) [not precedential], see <http://ttabvue.uspto.gov/ttabvue/v?pno=76670962&pty=EXA&eno=10> (finding that the Board found the geographic significance of the term KAPALUA to be subsidiary to the function of the word as a service mark).

In *Kapalua Land Company*, the evidence showed that KAPALUA did not signify a geographic place before applicant adopted the term to designate the origin of its resort services and there was no record evidence of any manufacturer or other commercial enterprise in a place named “Kapalua” outside of applicant’s ownership or control.

Similarly, Lasa was named after the Applicant’s predecessor company. See “Gazzetta Ufficiale del Regno d Italia” (the publication of the Royal Decree 800 on April 27, 1923) and English translation (ordering the new Italian names of the villages in the South Tyrol), attached as Exhibit 16 to First Request for Reconsideration; “Names of Villages of South Tyrol and their History”, attached as Exhibit 14 to Request for Reconsideration (showing the new name LASA); December Declaration, ¶25-26. There are no other active quarries in Lasa other than Applicant’s quarries and no other marble businesses that have a legitimate claim to the use of the term LASA for marble. See December Declaration, ¶ 21; *In re Nantucket*, 677 F.2d 95, 106 (CCPA 1982), Nies, J., concurring (“It is incumbent on the PTO to put forth evidence that other businesses have or are likely to have legitimate interests in use of the geographic name claimed by the applicant). Therefore, any geographic significance of the term LASA is subsidiary to the function of the word as a service mark.

Further, the primary significance of the term LASA is to signify Applicant's goods and the marble it quarries and is a reflection of the company that is the largest employer and the only industry of any value in the small remote town. The term LASA has been a trademark of Applicant since the 1920's Applicant actively monitors and polices its trademark LASA to ensure no third party uses Applicant's trademark without permission. For example, Applicant was successful recently in requiring a competitor from removing reference to LASA on its website and materials. See December Declaration, ¶ 30.

In *Brouwerij Nacional Balashi*, the applicant called attention to the more compelling and overwhelming evidence that U.S consumers of beer primarily identify "Balashi" with Applicant. *Brouwerij Nacional Balashi*, 80 USPQ2d 1820. In this case, Applicant's marble is so well known, that the term LASA is primarily associated with Applicant's products. The LASA marble has a long tradition over more than a century in the US. See June Declaration, ¶15. Several monuments in the US including the Loreley Fountain in the Bronx, New York, 23 sculptures in front of the Manhattan Appellate Courthouse in New York, and the Total Abstinence Fountain in Philadelphia, Pennsylvania used LASA marble and were built before the year 1900. In the 1950's, the US government commissioned some 96,000 crosses using LASA marble for the American World War II cemeteries all over the world, from England to Italy to France to the Philippines, etc. See *id.*

More recently, Applicant's LASA marble has been used in buildings throughout the US including Greenwich, CT, Facade of the United-States-Tobacco-Building, Greenwich, Connecticut (1972), Facade of the Mausoleum in White Chapel Memorial Gardens & Mausoleum, Wichita, Kansas, Façade of the First-Federal-Savings-Bank Miami, Florida (1969), Façade of the City Hall (1963) in Memphis, Tennessee and First National Bank, Dallas Connecticut. See *id.* ¶16.

The most prominent building in the US to use LASA marble will be the World Trade Transportation Hub, designed by Santiago Calatrava, in New York. This project is set to be

complete in 2015. *See id.* ¶17.

The evidence supports a finding that the primary significance of the mark LASA is as an indicator of source of Applicant's goods. In this case, the primary significance of the term LASA is to signify Applicant's goods and the marble it quarries, and the use of the term to identify the small, obscure and remote municipality is secondary if at all.

## **2. The Term LASA Has Meanings Other Than As A Geographic Location**

There are at least 10 other meanings for LASA. *See* Wikipedia entry for LASA, attached as Exhibit 3; *see* Google Translate attached as Exhibit 4. The most prominent meaning of "Lasa" is not geographic but could be a reference to mythology, or an acronym for any number of U.S. organizations, or associations, or a surname. It follows that the term "Lasa" is not *primarily* a geographic region.

### **D. The Examining Attorney's Evidence Does Not Establish A Public Association Of The Goods With The Place**

Based on the foregoing, Applicant has raised a genuine issue that Lasa is so obscure and remote that purchasers would fail to recognize the term as indicating the geographical source of the goods to which the mark is applied. When there is a genuine issue that the place named in the mark is so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods to which the mark is applied, it is incumbent on the Trademark Examining Attorney to submit evidence to establish a public association of the goods with that place. *Handler Fenton Westerns*, 214 USPQ at 849-50. None of the Examining Attorney's evidence submitted in his eight actions shows that the town of Lasa is well known or that there is an association between the word LASA and the goods listed in the application. At most, the Examining Attorney's evidence shows that Applicant's goods are the only goods of its kind that originates from Lasa. As such, Applicant submits that the mark is not geographically descriptive.

Examiner's First Office Action January 15, 2014

The Examiner attached pages from Applicant's Website "The Marble Products and the Wikipedia® page for "Laas, South Tyrol." Applicant responded that the Wikipedia® page was for the town called "Laas", a name that the predominantly German-speaking locals use, rather than the Italian version of LASA. *See* Response at p.3 (Lasa is located in the Alpine region of northern Italy and the geographic footprint of Lasa is 42 square miles). Further the Wikipedia® page and other evidence supports Applicant's position that the town is remote and obscure. *See id.* at p.4.

The Examining Attorney also attached a definition of "marble" and another Wikipedia® page regarding "Marble" which refers to Carrera marble from Carrera, Italy and Sienna marble from Siena, Italy, but does not mention Lasa.

Examiner's Second Action (FINAL) July 24, 2014

In his Final Action, the Examiner again attached the Wikipedia® page for "Laas" in support of his position that Lasa is "famous" for marble. However, the references on Wikipedia® cited by the Examiner are references to Applicant's quarries and only Applicant's quarries as there are no other active quarries in Lasa not owned by Applicant. *See* Applicant's First Request for Reconsideration at p. 3 (with supporting evidence from December Declaration, ¶22 and Applicant's website, Exhibit 7).

Further, the simple existence of a Wikipedia page by itself does not make a small commune or municipality "famous" or even "generally known" as the Examining Attorney alleges. In addition, there is no mention of "Lasa" being "generally well known" or "famous" in the article. Also, "[g]iven its inherent limitations, any information obtained from Wikipedia® should be treated as having limited probative value. If the examining attorney relies upon Wikipedia® evidence and makes it of record, then additional supportive and corroborative evidence from other sources should also be made of record, especially when issuing final actions." *See* TMEP §710.01(b).

The Examiner attached a TripAdvisor® page for Lasa, Italy. However, this page shows just how remote and obscure Lasa is. *See* Applicant’s First Request for Reconsideration at p.4. There are only two bed & breakfasts in Lasa such that only 26 people can visit Lasa at one time and all other listings for hotels, bed and breakfasts, and restaurants were many miles from Lasa. *See id.* (with supporting evidence including maps and pages from websites for the establishments listed on TripAdvisor®).

Examiner’s Third Action dated January 5, 2015

The Examining Attorney denied Applicant’s Request for Reconsideration.

Examiner’s Fourth Action and Fifth Action both dated January 20, 2015

The Examiner attached eight website to each of the Fourth and Fifth Actions to support his position that the town has an identity apart from Applicant’s business and that it is a recognized and well known geographic location. However, upon further review, the “evidence” consisted of one reference that was Applicant’s website, one that was copied directly from Applicant’s website, five that were about Applicant or featured Applicant’s products, one that featured counterfeit LASA products, and one that contained incorrect information. *See* Applicant’s Second Request for Reconsideration at pp.2-9 (with supporting evidence including Declaration of Paul Graf dated March 31, 2015 (“March Declaration”), and other supporting material). Therefore, this further evidence did 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, but rather supports the fact that Lasa’s identity is intimately connected to Applicant and Applicant’s business.

Examiner’s Sixth Action April 9, 2015

The Examining Attorney again refused reconsideration and attached ten websites in a further attempt to find support for his position that the town of Lasa has an identity apart from Applicant. However, six of the references were attached to previous actions and already rebutted by the Applicant. *See* Third Request for Reconsideration, pp. 2-4 (with supporting Declaration of

Paul Graf dated April 27, 2015 (April Declaration). Two of the remaining “new” references referred to Applicant and its goods and the last website was simply in error and had no probative value. *See id.* p.2-3. Therefore, the further evidence did nothing to support the Examiner’s contention that the remote and obscure town of Lasa in Northern Italy had an identity separate and apart from Applicant and its business.

Examiner’s Seventh Action dated May 8, 2015

The Examining Attorney again denied Applicant’s Request for Reconsideration.

It is evident by the Examining Attorney’s seven actions that he agreed with Applicant that he had not, at any stage of the examination, provided sufficient evidence to support his allegation that Applicant’s mark was primarily geographically descriptive or that the town had an identity separate from Applicant’s business. To the contrary, all the evidence provided supported Applicant’s argument 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 submits that there is no evidence provided by the Examining Attorney that American consumers of marble would have any knowledge of Lasa or that Lasa was “famous” for marble or that customers would make a goods/place association with the term LASA.

Finally, Applicant objects to the Examining Attorney’s repeated actions that 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 had issued seven actions with new “evidence” to each action that Applicant believes are excessive.

## **VII. Summary**

The term LASA in Applicant’s Mark is not primarily geographically descriptive because the small town is so obscure and remote that American customers would fail to recognize the term as geographic and the significance of the term LASA is to signify Applicant’s goods and the marble it quarries because Lasa was named after Applicant’s business and only through Applicant’s efforts and use of the mark since the 1920’s has the name become recognized as a source of marble goods. Finally, the Examiner has not provided any evidence to establish a public association of the goods with the place.

In sum, 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).

**VIII. Conclusion**

In view of the foregoing, it is respectfully requested that the refusal of registration under 15 U.S.C. §1052(e)(2) be withdrawn and the mark forwarded for publication in the *Official Gazette*.



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