

This amendment is submitted in response to the Office Action dated May 17, 2019.

#### Descriptiveness - § 2(e)(1) Refusal

The Examiner has rejected the applied-for LENS mark under § 2(e)(1) as being merely descriptive. Applicant disagrees with the Examiner's reasoning.

The as-amended listing of goods for the LENS mark refers to "laboratory instruments and computers for the analysis of the molecular weight, size, and structure of molecules and particles" and "light scattering detectors".

Whether a term is merely descriptive depends on the goods, the context in which it is being used in connection with the goods, and the possible significance the term would have to the average purchaser of the goods because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Initially, for the word LENS to be *merely* descriptive pursuant to section 2(e)(1), it must "immediately convey to one seeing or hearing it, the thought of [applicant's] product." *In re Hutchinson Technology*, 852 F.2d 552, 555 (Fed. Cir. 1988) (citing *In re Bed & Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986)). Applicant submits that the term LENS does not immediately convey to the average purchaser the thought of a "laboratory instrument and computer" or a "light scattering detector".

Continuing, Applicant believes the LENS mark is not merely descriptive because LENS is a double entendre, i.e. it has a double connotation as applied to the goods. See TMEP 1213.05(c). This creates a distinct commercial impression. In particular, molecules, particles, and chemicals are not by themselves visible through an optical lens. But the listed goods, laboratory instruments and computers or light scattering detectors, can still provide information on the molecular weight, size, and structure of the molecules, particles, and chemicals. In other words, the listed goods act as a metaphorical "lens" to discover, reveal, or provide insight about the molecules, particles, and chemicals, even though the listed goods do not operate as an optical lens.

This additional interpretation of "lens" is one that the public would make fairly readily, and is readily apparent from the mark itself. Thus, the LENS mark should not be refused registration as merely descriptive. Indeed, Applicant submits the LENS mark is at least suggestive when applied to the listed goods because it requires imagination,

thought, or perception as to the nature of the goods. *In re Shutts*, 217 USPQ 363 (TTAB 1983).

Applicant thus requests withdrawal of the descriptiveness refusal, and asks that the LENS mark proceed to publication and registration.

#### Identification Unacceptable - Requirement

The Examiner has also stated that the original word of the listing of goods and services is insufficiently definite for registration purposes. Applicant has amended the listing as suggested by the Examiner. Applicant has also deleted some of the properties that can be measured by the instruments / detectors, which is not believed to expand the goods.

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