

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
CANCELLATION DECISION
N° 3000410
of 27 November 2023

Claimant: **Solta Medical, Inc.**
400 Somerset Corporate Blvd
08807 Bridgewater
United States of America

Representative: **Merkenbureau Knijff & Partners B.V.**
Leeuwendeldseweg 12
1382 LX Weesp
Netherlands

against

Defendant: **Safety4yoU BV**
Uraniumweg 10
8445 PH Heerenveen
Netherlands

Representative: **intellectueeleigendom.nl**
Savannahweg 17
3542 AW Utrecht
Netherlands

Contested trademark: Benelux registration 1450011

PLAXEL⁺

I. FACTS AND PROCEEDINGS

A. Facts


1. On 16 February 2022 the claimant filed an application for a declaration of invalidity with the Benelux Office for Intellectual Property (hereinafter: "the Office") in accordance with Article 2.30bis (1)(b), invoking the relative ground for invalidity as stated under Article 2.2ter (1)(b) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP")¹, namely that there exists a likelihood of confusion on the part of the public and under Article 2.2ter (3)(a), namely that the contested trademark takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier trademark.

2. The claim for invalidity is based on:

- EU trademark registration 004054714 of the wordmark FRAXEL filed on 6 October 2004 and registered on 1 June 2006 for goods in class 10.
- International trademark registration 923526, designating the European Union (hereinafter: "EU"), of the wordmark FRAXEL registered on 19 March 2007 (after limitation) for services in class 44.
- Benelux trademark registration 785507 of the wordmark FRAXEL filed on 30 November 2005 and registered on 23 December 2005 for goods in class 10.

3. According to the register the claimant is the actual holder of the earlier trademarks invoked.

4. The application for a declaration of invalidity is aimed at Benelux trademark registration 1450011,

of the combined word-/figurative trademark  filed on 11 September 2021 for goods in classes 8 and 10 and services in class 44. In accordance with article 2.8 (2) BCIP, the defendant requested an accelerated registration. This was processed under 1450011 and was published and registered on 14 September 2021.

5. The claim for a declaration of invalidity is directed against all goods and services of the contested trademark and based on all goods and services of the trademarks invoked.

6. The language of the proceedings is English.

B. Course of the proceedings

7. The application for a declaration of invalidity is admissible and was notified by the Office to the parties on 21 February 2022. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was submitted. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 10 November 2022.

II. ARGUMENTS

A. Claimant's arguments

8. The claimant argues that the invoked trademarks have been genuinely used for "*medical laser devices consisting of lasers*", "*parts and accessories therefor*" and "*treatment services*". In addition, the claimant argues that the invoked trademarks have a reputation with regard to "*aesthetic devices with a skin resurfacing laser*" and "*aesthetic treatment services*", following which they enjoy a broader scope of protection. According to the claimant this follows from evidence attached to the observations, the submitted witness statement and the evidence annexed to the witness statement.

9. The claimant continues by comparing the involved goods and services. With regard to the goods in class 8 of the contested trademark, the claimant argues that the nature and purpose of the goods are identical to the goods in class 10 of the trademarks invoked and that the involved goods are therefore similar to a very high degree. The goods in class 10 of the contested trademark are legally and literally identical to the goods in class 10 of the trademarks invoked. Also, the services in class 44 of the contested trademark are legally and literally identical to the services in class 44 of the trademarks invoked.

10. With regard to the comparison of the trademarks the claimant states that PLAXEL is the only distinctive and consequently dominant element in the contested trademark. The element "+" and the stylization is of little or no weight in the comparison since "+" will be perceived as "having a value" and therefore constitutes a laudatory indication and is non-distinctive. The stylization concerns a special script that is simple and plain, which cannot provide a sign with distinctiveness.

11. The claimant argues that in respect to trademarks registered for similar goods and services containing the suffix -AXEL, an in-use-search shows that only one trademark is actually being used for aesthetic skin treatment and devices alike. From the results concerning searches in trademark registers, combined with the in-use-search, the claimant concludes that the single trademark found cannot cause dilution and that the suffix -AXEL is therefore highly distinctive.

12. Regarding the visual comparison, the claimant argues that the first syllables of the dominant elements FRAXEL and PLAXEL, being FRA- and PLA-, are similar and the last syllables -XEL and the last letters -AXEL are identical. FRAXEL and PLAXEL have the same length and four out of six letters are identical. This shows that the trademarks are visually highly similar. As regards the phonetic comparison, FRAXEL and PLAXEL have the same length, rhythm, intonation and four out of six letters overlap. The element "+" will be pronounced as "plus" and is laudatory, non-distinctive and has little impact on the phonetic comparison. Regarding the conceptual comparison the claimant states that the prefix FRA- refers to "fractional technology" and the prefix PLA- refers to "plasma technology". The element -XEL has no meaning. A conceptual comparison can be made in connection to the structure of the marks, both referring to non-invasive technologies. This shows that the trademarks are conceptually similar.

13. As regards the global assessment the claimant states that in respect to the goods in class 10 the relevant public is the cosmetic specialist and in respect to the services in class 44 the relevant public is the consumer. For the goods and services aimed at the medical specialist, an increased level of attention may be assumed. However, it follows from settled caselaw that with regard to medical and surgical goods and services there is a higher need to avoid confusion because of the severity of the consequences in case of confusion. Therefore a greater distance between the trademarks should be kept.

14. The claimant argues that the submitted evidence shows that the contested trademark is actually being used as PLAXEL, not as PLAXEL+ and that the actual use of the trademarks concern identical goods and services.

15. The claimant concludes by stating that the trademarks invoked have been genuinely used during the relevant period for "*medical laser devices consisting of lasers*", "*parts and accessories therefor*" and "*treatment services*" and that there exists a likelihood of confusion. The claimant requests the Office to invalidate the contested trademark for all goods and services and to grant an award of costs to the claimant.

B. Arguments of the defendant

Response to proof of use

16. The defendant initially requests proof of use and upon receipt thereof, the defendant responds to the submitted proof of use as well as the arguments of the claimant.

17. Regarding the nature of use, the defendant states that from the evidence submitted by the claimant, it is clear that the trademarks invoked are meant for "*medical devices comprising lasers for skin treatment*".

18. As regards the time of use the defendant argues that very little evidence shows actual use during the relevant periods. Most evidence that does show use in the relevant periods relates to the United States of America and the United Kingdom. The numerous screenshots of claimant's websites and websites of third party clinics are all undated or are dated but not within either of the relevant periods. For the vast majority of screenshots it has not been demonstrated that these were active and accessible in the relevant time period. Part of these sites may have been active during the relevant periods, but this is conjecture.

19. Concerning the place of use, it is clear that sales were made in the EU, including one in the Netherlands. The defendant confirms that at least some use in the relevant territory has been established. However, many items of evidence appear to relate to use of the invoked trademarks outside the Benelux and the EU.

20. With regard to the extent of use the defendant argues that the claim of the claimant that FRAXEL products have been sold to 188 clinics, based on a list mentioning these clinics, has not been sufficiently substantiated. In addition, the list of clinics also contains some clinics from countries outside of the EU, like the United Kingdom and Norway. Even if the listed clinics use FRAXEL devices, these devices may have been supplied either before or after the relevant periods.

21. Unless the trademark FRAXEL is explicitly being mentioned, or it is otherwise made clear that we are dealing with sales of FRAXEL products, it cannot be assumed that all goods on the invoices were sold under the trademark FRAXEL.

22. One invoice only concerns goods sold with a 100% discount, which does not contribute to the turnover and does not constitute genuine use. This invoice should be disregarded, according to the defendant.

23. With regard to other invoices it is not clear to what kind of goods they relate. With regard to the description "FRAXEL re:store/re:fine Access" the defendant presumes that these refer to some sort of accessories. However, accessories could be anything.

24. In relation to the goods descriptions "FRAXEL re:store Cool Roller TI" and "FRAXEL re:store Cool Roller" mentioned on the submitted invoices, no catalogues or images have been submitted. The defendant presumes that it concerns types of rollers. However, rollers can cover many types of products.

25. The unit prices mentioned on the invoices ranging between € 234,16 and € 453,- suggest that we are not talking about "*medical laser devices for skin therapy*" as such devices are normally not sold for such prices.

26. The defendant argues that none of the invoices relate to "*medical devices and instruments comprising lasers; optical fiber and direct radiation delivery equipment for medical lasers*" or "*medical devices consisting of lasers; fiber optic and beam delivery apparatus for medical lasers*" or to the services "*cosmetic and plastic surgery and dermatological treatment services*". At best the goods mentioned on the invoices fall within the terms "*parts and accessories, including replaceable ("disposable") tips for lasers, for medical devices and instruments comprising lasers*" and "*parts and accessories for medical devices consisting of lasers*".

27. Sales of 12 products in the first relevant period and 29 products in the second relevant period is just not enough, according to the defendant.

28. The defendant further argues that the current holder, "Solta Medical, Inc." was not the holder of the invoked trademarks throughout the relevant periods. Regarding the invoked Benelux trademark registration, the defendant notes that the assignment was not recorded until the 3rd of January 2022 and that it has effect vis-à-vis third parties from this date. As a consequence, it has to be demonstrated that any use by "Solta Medical Inc." prior to this date has been by or with the consent of the original holder. The same applies to the invoked EU trademark registration and the invoked international trademark registration designating the EU.

29. While the relevant invoked trademark registrations were in the name of "Reliant Technologies Inc." invoices were issued by "Bausch e Lomb – IOM SpA" from Italy and by "Bausch+Lomb Netherlands B.V." This suggests that there was use by Bausch. It has not been clarified whether this use was with the permission of "Reliant Technologies Inc.".

30. The defendant concludes that the claimant has failed to demonstrate genuine use of the invoked trademarks FRAXEL for any of the goods or services registered for.

Response to claimant's arguments

31. The defendant is of the view that the cancellation procedure should be considered unjustified even if sufficient use has been shown.

32. With regard to the relevant public and the level of attention, the defendant argues that we are dealing with trademarks for "*medical devices in the field of skin therapy*" and that these goods are only sold to professional users. When it comes to such goods, the level of attention of the professional user is particularly high.

33. Regarding the comparison of goods and services, the defendant argues that the contested goods "*hand tools for use in home, hand operated*" from class 8 have nothing in common with the goods from

class 10 of the trademarks invoked and are therefore dissimilar. As for the remaining goods and services from the contested registration, the defendant states to not contest the identity or similarity.

34. With regard to the comparison of the trademarks, the defendant contests the argument of the claimant that the element FR- from the trademarks invoked is descriptive for the relevant goods and services and is therefore of lesser importance. As for the "+" element the defendant admits that this is weakly distinctive as it may be perceived as a reference to a feature of the involved goods and services, in particular that they offer something "extra". The "+" element will not be considered as the dominant element. However, this does not mean that the "+" element can be disregarded entirely when comparing the trademarks. Conceptually, a comparison is not possible since FRAXEL and PLAXEL+ have no meaning. Visually, the trademarks are similar to a low degree. In general, the consumer attaches greater importance to the first part of a word. The defendant notes that the trademarks differ in their beginnings being FR- and PL-. The endings also differ because the contested trademark ends with the "+" element, is printed in a striking purple colour and contains a stylized letter A, whereas the invoked trademarks do not. Phonetically, the trademarks differ in their beginnings and endings. "+" will be pronounced as "plus". The only sound the trademarks have in common is represented by the letters AXEL. In the view of the defendant the trademarks are phonetically similar to only a low degree. Regarding the overall similarity the defendant states that the fact that the trademarks share the letters AXEL is not sufficient to render the trademarks similar overall. The trademarks display a low degree of similarity only.

35. With respect to the likelihood of confusion the defendant argues that while some goods for which the trademarks are registered may be considered identical or similar, the fact remains that the relevant well informed and circumspect consumer will not be confused by the similarity of the trademarks. Given the very low degree of similarity between the trademarks, no realistic risk of confusion should be presumed regarding the goods and services, even those that may be found identical.

36. Regarding the argument of the claimant that the trademarks invoked have a reputation, the defendant argues that an earlier trademark deserves increased protection only if it has a reputation. The submitted evidence does not allow the conclusion that the trademarks invoked enjoy a reputation.

37. The defendant concludes that the trademarks display an insufficient degree of similarity to cause a likelihood of confusion among the relevant consumers for any of the goods and services and that the claimant failed to demonstrate the existence of a reputation of the trademarks invoked. The defendant requests the Office to dismiss the cancellation procedure in its entirety and to award costs to the maximum rate in favor of the defendant.

III. DECISION

A.1 Legal framework

38. Pursuant to Article 2.30bis (1)(b)(i) BCIP the proprietor of an earlier trademark may file an application for invalidation with the Office against a registered trademark based on the relative grounds for invalidity referred to in Article 2.2ter BCIP.

A.2 Regarding the ground set out in Article 2.2ter (1)(b) BCIP – relative grounds for invalidity and likelihood of confusion

39. According to Article 2.2ter (1) BCIP "a trademark shall, in case an opposition is filed, not be registered or, if registered, shall be liable to be declared invalid where: (...) b. because of its identity with,

or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."

40. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.¹

41. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the trademarks at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.²

Proof of use

42. The application for a declaration of invalidity was filed on 16 February 2022. The contested trademark was filed on 11 September 2021. The claimant invokes trademark registrations that were registered on 1 June 2006, 19 March 2007 and 23 December 2005.

43. In accordance with articles 2.30quinquies (1) and (2), 1 and 2.23bis, 1 BCIP the trademark invoked must have been put to genuine use during the five years preceding the date on which the application for a declaration of invalidity of the contested trademark was filed if, at that time, the trademark invoked was already registered for a period exceeding that five-year period. Furthermore, it must also have been put to genuine use during the five years preceding the application date of the contested trademark if the trademark invoked was registered at that time for a period exceeding that five years.

44. Both situations occur here. Therefore, there are two relevant, overlapping, periods during which proof of use of the trademarks invoked should be demonstrated. The relevant periods are from 16 February 2017 to 16 February 2022 and from 11 September 2016 to 11 September 2021.

45. In accordance with the case-law of the European Court of Justice (hereinafter: "CJEU") there is genuine use of a trademark if the mark, in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, is used in order to create or preserve an outlet for those goods or services, not including token use for the sole purpose of preserving the rights conferred by the mark.³ When assessing whether use of the trade mark is genuine, regard must be had for all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.⁴ In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly.⁵

¹ CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

² CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

³ CJEU 3 July 2019, C-668/17, ECLI:EU:C:2019:557, point 38 (Viridis) and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

⁴ CJEU 31 January 2019, C-194/17, ECLI:EU:C:2019:-80, point 83 (Pandalis) and CJEU 11 March 2003, C40/01, ECLI:EU:C:2003: 145, point 43 (Ansul).

⁵ General Court (EU) 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 29 and the case-law mentioned there (Testa Rossa).

46. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.⁶ In interpreting the concept of genuine use, account should be taken of the fact that the *ratio legis* of the requirement that the mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trademark protection to the case where large-scale commercial use has been made of the marks.⁷

47. Genuine use of a trademark cannot be proven by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned.⁸

48. Invoked trademark 1 concerns an EU trademark registration and invoked trademark 2 concerns an International trademark registration designating the EU. Whilst it is reasonable to expect that an EU trademark registration and an International trademark designating the EU should - because they enjoy more extensive territorial protection than a national trade mark - be put to use in a larger area than the territory of a single Member State in order for that use to be capable of being deemed to be "genuine use", it is not necessary that the trademarks should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market⁹. It should be demonstrated that the trademark is used for the purpose of maintaining or creating market share within the EU, taking into account all relevant facts and circumstances such as characteristics of the market concerned, the nature of the goods or services protected by the trademarks and the territorial extent and the scale of the use as well as its frequency and regularity.¹⁰

49. Following rule 1.25, paragraph 2 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the trademarks invoked for the goods and services on which the application for a declaration of invalidity is based.

50. The goods and services for which genuine use has to be demonstrated are the following:

- EU 004054714
Class 10 Medical devices consisting of lasers and parts and accessories therefor; fiber optic and beam delivery apparatus for medical lasers.
- IR 923526
Class 44 Cosmetic and plastic surgery and dermatological treatment services.
- BX 785507
Class 10 Medical devices and instruments consisting of lasers and parts and accessories, such as replaceable ("disposable") tips for lasers, therefor; optical fiber and direct radiation delivery apparatus for medical lasers.¹¹

⁶ General Court (EU) 8 July 2004, T-334/01, ECLI:EU:T:2004:223, point 36 (Hipoviton) and General Court (EU) 30 April 2008, T-131/06, ECLI:EU:T:2008:135, point 41 (Sonia Sonia Rykiel).

⁷ General Court (EU) 4 April 2019, T-910/16 and T911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).

⁸ General Court (EU) 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

⁹ General Court (EU) 1 June 2022, T-316/21, ECLI:EU:T:2022:310, point 73 (Superior Manufacturing) and CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, points 50 and 54 (ONEL).

¹⁰ CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, point 58 (ONEL).

¹¹ The list of goods is in Dutch. The English translation is added for the sole purpose of readability of this decision.

Analysis of the proof of use

The claimant submits, along with its arguments in support of the application for a declaration of invalidity, proof of use. In response to the defendant's request to submit proof of use, the claimant submits additional proof as well as refers to the proof submitted earlier in the proceedings.

51. The claimant submitted the following proof of use:

1. Witness statement dated 20 April 2022 by Kristi Lynn McIntyre, director business and legal affairs within the "Bausch Health" organization, authorized to make this witness statement on behalf of "Solta Medical". Concerning background information on the company, a short explanation on the FRAXEL products FRAXEL dual, FRAXEL re:fine, FRAXEL re:pair and treatments, information on the launch of FRAXEL in 2004, a short overview of countries where the trademark is registered and the claim that FRAXEL is well-known with referral to the annexes of the witness statement (the claimant requests to not cite the contents of the submitted witness statement in detail, nor to make it available to third parties, as it is of a confidential nature);
2. Screenshots dated 19 April 2022 of the homepages of claimant's websites solta_medical.com and fraxel.com mentioning the FRAXEL trademark and the product FRAXEL dual, annexed to the witness statement;
3. Screenshot dated 19 April 2022 of the website theconsultingroomgroup.co.uk explaining that it concerns an independent aesthetic information website, annexed to the witness statement;
4. Screenshot of articles mentioning FRAXEL, allegedly confirming the worldwide well-known status of FRAXEL, annexed to the witness statement:
 - "*Fraxel Fall: Why the best skincare treatments include resurfacing lasers*" dated 14 October 2020 on the website scribd.com;
 - "*Here's what your skin looks like after Fraxel treatments*" dated 12 June 2019 from the website healthline.com;
 - "*Everything you need to know about Fraxel lasers*" dated 31 March 2021 from the website Elle.com;
 - "*Everything you need to know about Fraxel laser treatment*" dated 2 September 2021 from the website aedit.com;
 - "*Favorite celebrity cosmetic procedures: Fraxel*" from the website skinneymedspa.com;
5. Screenshots of articles mentioning FRAXEL, allegedly confirming the well-known status of FRAXEL in the Benelux, annexed to the witness statement:
 - "*Fraxel: De keuze van Hollywood beroemdheden*" from the website thermagefraxel.nl;
 - "*Werkt laserhuidverzorging? De primeur voor Fraxel, IPL en meer*" from the website nl.people-lifestyle.com;
 - "*Fractional laser, een aanrader of niet*" from the website mens-en-gezondheid.infonu.nl with reader reactions dating back to as far as 3 April 2017;
 - "*Gezichtsverjonging met Fraxel laser in Ukkel, Brussel*" from the website Clinique-observatoire.be;
6. Screenshot dated 19 April 2022 of the websites lamaison-amsterdam.nl, kazem.nl, kliniekeninfo.nl, lazeo.be, totalskinclinic.nl, davinciclinic.be, bellevueclinic.be and editus.lu showing availability of FRAXEL treatments via clinics in the Benelux, annexed to the witness statement;
7. Screenshots dated 17 April 2022 of the website whatclinic.com showing availability of FRAXEL treatments via clinics in the EU, annexed to the witness statement;
8. Screenshots of websites with information on won awards "*2021 award for best laser*" from InStyle and "*2021 award for best laser for sun damaged skin*" from New Beauty, annexed to the witness statement;

9. Pictures of products named FRAXEL dual, and FRAXEL re:store, accessories bearing the trademark FRAXEL and pictures that show treatments by means of FRAXEL apparatus and pictures of results after treatments by FRAXEL apparatus;
10. List of 188 clients from the EU, Norway and the United Kingdom that have bought FRAXEL goods between 2019 - 2022;
11. 8 Invoices dating between 19 March 2021 and 24 November 2021 to clients in the Netherlands, France and Italy;
12. Screenshot with print date 26 August 2022 of websites of clinics in the Benelux showing that they offer FRAXEL treatments:
 - From Kazem.nl;
 - From Lamaison-amsterdam.nl.
13. Screenshots with print date 26 August 2022 of websites of clinics in the EU showing that they offer FRAXEL treatment;
 - From German website derma-loft.de;
 - From German website lasthetic.berlin;
 - From French website crpce.com;
 - From French website lazeo.com;
 - From Polish website elite.waw.pl;
 - From Polish website instytutbeautyderm.pl;
 - From Spanish website clinicablue moon.es;
 - From Spanish website clinicasdiegodeleon.com.

52. The claimant argues that the trademarks invoked have been genuinely used during the relevant period for "*medical laser devices*" and "*parts and accessories therefor*" and "*treatment services*" (see point 8) and submits proof of use to this end.

53. The Office first notes that the fact that certain documents are undated or originate from outside the relevant periods, as noted by the defendant (see point 18), does not necessarily mean that they should be ignored. Even if a document is dated after a certain date, it may be possible to draw conclusions from it about a situation that occurred before that date.¹² Furthermore, these documents are likely to support the other evidence relied upon.¹³ Moreover, a number of media articles, the invoices as well as the awards are dated and do relate to the relevant periods.

54. Contrary to the claimant, the defendant argues that none of the invoices show use for the goods and services the invoked trademarks are registered for (see points 26 and 30). Based on the submitted proof of use, the Office finds that the claimant has proven genuine use of FRAXEL for part of the goods in class 10 for which the invoked trademarks are registered, namely "*medical devices consisting of lasers for skincare and parts and accessories therefor*", as also stated by the claimant (see point 8). The witness statement, screenshots of claimant's homepages and several pictures of medical devices contain the product names "FRAXEL re:store" and "FRAXEL dual". The submitted invoices show sales of a product with the commercial value of € 42.000 and dozens of products with a commercial value of several hundreds of euro's per item under product names containing "re:store dual", "FRAXEL re:store" and "FRAXEL dual". From the product name "FRAXEL re:store cool roller" mentioned on the invoices and the pricing of several hundreds of euro's the Office understands that "cool roller" concerns an accessory to, or a part of, the

¹² CJEU 17 July 2008, C-488/06, ECLI:EU:C:2008:420, point 72 (Aire Limpio); BOIP 23 October 2008, Opposition Decision no. 2000904 (Y-TAG).

¹³ General Court (EU) 8 July 2004, T-203/02, ECLI:EU:T:2004:225, point 53 (Vitafruit); BOIP 30 June 2008, opposition decision no. 2000980 (HOLLANDER).

"FRAXEL re:store" device. Moreover, one of the invoices contains the product description "FRAXEL re:store" combined with "access" contributing to the finding that part of the goods concern accessories.

55. Although the invoices relate to a limited number of sales, as argued by the defendant (see point 27), they do exceed the threshold of mere token use.¹⁴ Especially when taking into account the characteristics of the market in question, namely expensive medical laser devices for skincare and parts and accessories therefor that are not purchased on a regular basis.¹⁵ The Office recalls that the purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trademark protection to the case where large-scale commercial use has been made of the marks.¹⁶

56. As to the observation of the defendant that certain goods mentioned on one of the invoices have been sold against a 100% discount and can therefore not constitute genuine use (see point 22), the Office considers that in this case, the invoices show actual sales of products and as part of this transaction, certain related parts and accessories are offered for free. These related goods are therefore also offered with the intention of creating or maintaining a market share.¹⁷

57. As to the "*treatment services*", regarding which the claimant also states to have used genuinely (see point 8), the Office finds that there is no sufficient evidence showing that the "*treatment services*" in class 44 have been offered or provided at all. Although the claimant submits a lot of screenshots indicating that several clinics offer treatments under the name FRAXEL, there is no evidence as to the volume and places the treatment services have been offered or evidence confirming that "*treatment services*" have been provided within the relevant periods within the Benelux or the EU. As noted above (see point 47), the genuine use of a trademark cannot be assumed on the basis of probabilities or suppositions, but must be demonstrated by concrete and objective evidence proving actual and conclusive use of the trademark in the relevant market.

Conclusion

58. After careful analysis of the proof of use provided, the Office concludes that the evidence submitted, taken together, sufficiently demonstrates genuine use in the relevant periods within the EU for the goods "*medical devices consisting of lasers for skincare and parts and accessories therefor*" in class 10.

Comparison of the trademarks

59. To assess the degree of similarity between the conflicting signs, their visual, phonetic and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.¹⁸

¹⁴ CJEU 3 July 2019, C-668/17, ECLI:EU:C:2019:557, point 38 (Viridis), and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

¹⁵ General Court (EU) 8 July 2004, T-334/01, EU:T:2004:223, point 51 (Hipoviton).

¹⁶ General Court (EU) 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).


¹⁷ General Court (EU) 9 September 2011, T-289/09, EU:T:2011:452, points 67 and 68 (Omnicare Clinical Research).

¹⁸ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

60. While the comparison must be based on the overall impression left by the signs in the memory of the relevant public, it must nevertheless be made in the light of the intrinsic qualities of the conflicting signs.¹⁹ The overall impression created by a composite mark (word and figurative element) in the minds of the relevant public may, in certain circumstances, be dominated by one or more of its components. In assessing whether this is the case, particular account must be taken of the intrinsic qualities of each of those components by comparing them with the qualities of the other components. Moreover, it is possible to consider how the various components in the configuration of the composite mark relate to one another.²⁰

61. In short, as regards the visual, phonetic and conceptual similarity of the marks, the assessment of their similarity should be based on the overall impression created by the marks, taking into account, inter alia, their distinctive and dominant components.

62. The trademarks to be compared are the following:

| Cancellation based on: | Cancellation directed against: |
|------------------------|--|
| FRAXEL |  |

Visual comparison

63. The invoked trademarks concern a wordmark, consisting of the verbal element "FRAXEL" composed of 6 letters. The contested trademark concerns a combined word/figurative mark, in the colour purple, consisting of the verbal element "PLAXEL" composed of 6 letters and the sign "+". The letter A is somewhat stylized.

64. Where a sign consists of both verbal and figurative elements the former has, in principle, a greater impact on the consumer than the latter. The reason for this is that the public does not always analyze the signs and often refers to the sign by using the verbal element.²¹ Although the figurative elements in the involved trademarks will not go unnoticed, the attention of the relevant public will mainly go to the word elements. The graphical aspects of the contested trademark, being a typeface and a color, can be qualified as rather marginal, which the consumer will perceive as adornment.²²

65. The Office finds that with respect to the contested trademark, since the public reads from left to right, most attention will be paid to the beginning of the trademark, being PLAXEL²³. In addition to the fact that the "+" sign is placed at the end of the contested trademark to which less attention will be paid, it concerns a common sign in commerce to suggest "something extra" or "added value".

66. Two trademarks are similar if, from the point of view of the relevant public, they are at least partially identical in one or more relevant aspects.²⁴ The dominant element PLAXEL and the invoked

¹⁹ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

²⁰ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen); 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

²¹ General Court (EU) 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 (Smarter Travel) and the case-law mentioned there.

²² General Court (EU) 30 June 2004, T-186/02, ECLI:EU:T:2004:197, point 47 (Dieselit).

²³ General Court (EU) 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

²⁴ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, point 30 (Matratzen); CJEU 11 November 1997, C-251/95, ECLI:EU:C:1997:528, point 6 (Sabel).

trademarks FRAXEL coincide in the element -AXEL. Moreover, the first letters from the involved trademarks, being "F" and "P", show visual similarities.

67. Despite the fact that the contested trademark contains the "+" sign which has no counterpart in the invoked trademarks and the differences in the prefixes FR- and PL- of the involved trademarks cause some visual differences, the Office finds that these differences cannot undo the visual similarity between the trademarks resulting from the resemblance between the first letters "F" and "P" and the identical elements -AXEL.

68. The trademarks are visually similar to a certain degree.

Phonetic comparison

69. As regards the phonetic comparison, it should be borne in mind that, strictly speaking, the phonetic reproduction of a complex sign consists of the reproduction of all its verbal elements, irrespective of their graphic specificities, which are more a matter for the visual analysis of the sign.²⁵

70. Also phonetically, the most attention will be paid to the beginning of words.²⁶ The dominant elements of the trademarks involved, being FRAXEL from the invoked trademarks and PLAXEL from the contested trademark, have the same cadence, intonation and the same number of syllables being two. The trademarks involved coincide in the sound of the letter -A- at the end of the first syllables FRA- and PLA- and coincide in the syllables -XEL. The two first consonants of the involved trademarks, being FR- and PL- cause phonetic differences, as does the "+" sign in the contested trademark which is pronounced as "plus" according to both parties (see points 12 and 34).

71. Despite the fact that "plus", which has no counterpart in the trademarks invoked, and the first two consonants of the involved trademarks, cause phonetic differences these cannot undo the phonetic similarities between the involved trademarks resulting from the similar sounds of the first syllables and the identical sounds of the second syllables.

72. Taking the aforementioned into consideration, the Office finds that on a phonetic level, the trademarks at hand are similar to a certain degree.

Conceptual comparison

73. Regarding the conceptual comparison the claimant states that the prefix FRA- refers to "fractional technology" and the prefix PLA- refers to "plasma technology" and that a conceptual similarity exists since both refer to non-invasive technologies (see point 12). The defendant argues that FRAXEL and PLAXEL+, as a whole, have no meaning (see point 34). It has not been established that PLA- and FRA- are common abbreviation for "plasma" and "fractional", following which the Office agrees with the defendant that the trademarks have no meaning and that therefore a conceptual comparison cannot be made.

Conclusion

74. Given the above, the Office considers that the involved trademarks are visually and phonetically similar to a certain degree and a conceptual comparison cannot be made. Based on the overall impression, the trademarks are similar.

²⁵ General Court (EU) 25 May 2005, T-352/02, ECLI:EU:T:2005:176, point 42 (PC Works) ; and 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

²⁶ General Court (EU) 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

Comparison of the goods and services

75. In assessing the similarity of the goods or services concerned, all the relevant factors relating to these goods or services themselves should be considered. These factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with each other or are complementary.²⁷

76. When comparing the goods and services, the goods and services shall be considered in the terms set out in the register, in as far as genuine proof of use was provided, and not the actual or intended use.²⁸

77. Having regard to the principle of hearing both sides, cancellation proceedings are limited to the arguments, facts and evidence put forward by the parties.²⁹

78. The goods and services to be compared are the following:

| Cancellation based on: | Cancellation directed against: |
|---|--|
| | CI 8 Hand tools for use in beauty care; hand tools for use in home, hand operated; manicure and pedicure sets; hand-operated hygienic and beauty implements for humans, not included in other classes; hand-operated apparatus for the cosmetic care of eyebrows. |
| CI 10 Medical devices consisting of lasers for skincare and parts and accessories therefor. | CI 10 Physical therapy equipment, namely, apparatus using plasma arcs and plasma flashes for skin tightening treatments and for the treatment of old-age wart, light and age-related skin damage, scars and fatty deposits; cosmetics apparatus and instruments, namely, apparatus and instruments using plasma arcs and plasma flashes for skin tightening treatments and for the treatment of old-age wart, light and age-related skin damage, scars and fatty deposits; electro-therapy instruments, namely, instruments using plasma arcs and plasma flashes for skin tightening treatments; hygienic and beauty implements for humans, namely, plasma arc devices and plasma flash devices for the cosmetic treatment of wrinkles in the face and skin and for tightening eyelids, and electrically-powered apparatus for treating wrinkles by applying low level light and sonic |

²⁷ CJEU 29 September 1998, C-39/97, ECLI:EU:C: 1998:442, point 23 (Canon).

²⁸ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

²⁹ Article 2.30 (1) BCIP and rule 1.21 IR.

| | |
|--|--|
| | vibrations to the skin; apparatus and instruments for facial or eyes treatments; parts of all the aforesaid goods. |
| | CI 44 Cosmetic treatment for the face; Facial beauty treatment services; Skin care salons; Services for the care of the skin; Hygienic and beauty care; Cosmetic body care services; Beauty salon services; Services for the care of the face. |

Class 8

79. The claimant argues that the goods in class 10 of the trademarks invoked have an identical nature and purpose to the contested goods in class 8, and are therefore similar to a high degree (see point 9). The defendant argues that "*hand tools for use in home, hand operated*" have nothing at all in common with the goods of the invoked trademarks and are therefore dissimilar (see point 33). They have different natures, purposes, distribution channels and manufacturers. The Office confirms that these goods do not coincide in their manufacturers, do not share the same distribution channels and do not target the same end users. The goods are dissimilar.

80. Regarding the remaining contested goods, being "*hand tools for use in beauty care; manicure and pedicure sets; hand-operated hygienic and beauty implements for humans, not included in other classes; hand-operated apparatus for the cosmetic care of eyebrows*" the defendant does not contest the alleged high degree of similarity. Therefore, given the principle of hearing both sides as discussed (see point 77), these goods must be considered highly similar.

Class 10

81. The claimant argues that all goods in class 10 of the contested trademark are identical to all goods in class 10 of the invoked trademarks (see point 9). The defendant states that he does not contest the identity or similarity of these goods (see point 33). The identity of the goods in question is thus manifestly *in confesso*, so that the Office need not examine it further.

Class 44

82. With regard to the services in class 44 of the contested trademark, the claimant only argues that these are identical to the services in class 44 of the invoked trademark registrations (see point 9). Since genuine use has not been proven with regard to the services in class 44 of the relevant trademark invoked (see point 57), the aforementioned argument cannot succeed. Since cancellation proceedings are limited to the arguments, facts and evidence put forward by the parties and identity or similarity regarding the services in class 44 of the contested trademark and the remaining goods in class 10 of the trademarks invoked is not being argued by the claimant, the involved services must be held to be dissimilar to the involved goods.

Conclusion

83. The goods and services concerned are partly identical, partly highly similar and partly dissimilar.

84. As regards the dissimilar goods and services (see points 79 and 82) the application for a declaration of invalidity can already not succeed since there can be no likelihood of confusion when goods or services are dissimilar. Below, the Office will proceed with a global assessment of the likelihood of confusion in respect of the identical and similar goods in classes 8 and 10 (see points 80 and 81).

Global assessment

85. The global assessment must be made by reference to the average consumer, who is reasonably well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer only rarely has the opportunity to make a direct comparison between the different trademarks, but relies on the imperfect impression left upon him. It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.³⁰ In general, an increased level of attention applies in case of medical goods, as noted by the defendant as well as the claimant (see point 13 and 32)³¹. The Office considers that the goods found to be identical concern medical goods directed at medical professionals with specific expertise and knowledge. Considering also the possible impact of the relevant goods on the health of patients, the level of attention of the relevant public will be high. The class 8 goods "*hand tools for use in beauty care; manicure and pedicure sets; hand-operated hygienic and beauty implements for humans, not included in other classes; hand-operated apparatus for the cosmetic care of eyebrows*" found to be similar are directed at the general public with a normal level of attention.

86. The greater the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.³² In the present case, the invoked trademark FRAXEL has a normal distinctiveness, as it is not descriptive of the goods and services concerned. Insofar as the claimant means to invoke an enhanced distinctiveness through use, the Office finds that it is not necessary to discuss this argument as it has no influence on the outcome of these proceedings.

87. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be considered and between the similarity of the conflicting signs and the goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.³³

88. In the case at hand, the involved trademarks are visually and phonetically similar to a certain degree. A conceptual comparison cannot be made. The goods and services concerned are partly identical, partly highly similar and partly dissimilar. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that, notwithstanding the higher level of attention of the public regarding part of the goods, there is indeed a likelihood of confusion regarding the

³⁰ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

³¹ See also General Court (EU) 15 December 2010, T-331/09, ECLI:EU:T:2010:520, point 29 (Tolposan); General Court (EU) 15 March 2012, T-288/08, ECLI:EU:T:2012:124, point 36 (Zydus).

³² CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

³³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 (Equivalenza) and the case-law mentioned there.

goods found to be identical and similar, in the sense that the public may believe that the goods come from the same undertaking or, as the case may be, from undertakings which are economically linked.

Conclusion

89. Based on the foregoing, the Office concludes that there exists a likelihood of confusion with regard to the contested goods "*hand tools for use in beauty care; manicure and pedicure sets; hand-operated hygienic and beauty implements for humans, not included in other classes; hand-operated apparatus for the cosmetic care of eyebrows*" from class 8 and all contested goods from class 10.

A.3 Regarding the ground set out in Article 2.2ter (3)(a) BCIP – relative grounds for invalidity and invoked trademarks with reputation

90. The claimant has also based the application for a declaration of invalidity on Article 2.2ter, 3 (a) BCIP. The Office will proceed with the assessment of this claim, only with regard to part of the contested goods and services for which no identity or similarity has been established, being '*hand tools for use in home, hand operated*' from class 8, and all contested services from class 44.

91. Article 2.2ter, 3 (a) BCIP is only applicable when the following conditions are met:

- (i) The conflicting signs are either identical or similar;
- (ii) The earlier trademark has a reputation;
- (iii) The use of the contested sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark;
- (iv) There is no due cause for the use of the contested sign.

92. The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the application for a declaration of invalidity based on Article 2.2ter, 3 (a) BCIP.

93. The claimant submitted exhibits 1 to 8 (see point 51) to demonstrate the reputation of the invoked trademarks.

i. *The signs are either identical or similar*

94. The Office has already established that the trademarks are similar (see point 74).

ii. *The earlier trademark has a reputation*

95. The claimant claims that the invoked trademarks have a reputation for "*aesthetic devices with a skin resurfacing laser*" and "*aesthetic treatment services*" only. Considering the proof of reputation submitted, which has also been submitted as part of the proof of use, the Office finds that the claimant does not prove or insufficiently proves that the invoked trademarks have acquired a reputation in the relevant territories. The proof of use is barely sufficient to ascertain genuine use. The screenshots of the homepages of claimant's websites, screenshots of websites of clinics mentioning FRAXEL and screenshots of online news articles about FRAXEL, annexed to the witness statement as well as the witness statement itself, do not show that a significant part of the public knows FRAXEL. No numbers of visitors to websites or other quantitative data on trademark awareness, market share or intensity of use have been submitted, besides the limited proof of use. Moreover, from many of the screenshots of the websites of clinics and news articles it does not become clear if these are directed at the Benelux or EU public.

96. In light of the above, it cannot be established that the trademarks invoked have a reputation. Therefore, one of the necessary conditions contained in Article 2.2ter (3) (a) BCIP is not fulfilled, and the application for a declaration of invalidity on the basis of this article must be rejected.

B. Other factors

97. Regarding the arguments concerning actual use of the involved trademarks (see points 11 and 14), the Office notes that actual use of a sign cannot be taken into account in this invalidity action based on Article 2.2ter (1)(b) and Article 2.2ter (3) (a) BCIP, as the comparison of the signs and goods and services is solely based on the trademarks as registered.³⁴

98. In as far as the defendant means to argue that the application for a declaration of invalidity should be rejected because the current holder "Solta Medical, Inc." was not the holder of the invoked trademarks throughout the relevant periods yet and part of the evidence shows use by "Bausch+Lomb Netherlands B.V." instead of "Solta Medical, Inc.", with regard to which consent by the trademark owner is missing (see point 28), the Office notes that following the transfer of rights the current holder "Solta Medical, inc." is deemed to have entered into the rights of any previous holders. Since the claimant submitted, and apparently obtained, part of the proof of use from "Bausch+Lomb Netherlands B.V." (see point 29) there is no reason to doubt that there was use of the mark with the consent of the trademark owner.³⁵ Use of a trademark with the consent of the holder is considered use by the holder.³⁶ Moreover, the witness statement as well as screenshots of claimant's website make mention of an affiliation between "Solta Medical, Inc." and "Bausch". Use by companies economically linked is also regarded as use with the consent of the trademark holder. This means that use by "Bausch" can be regarded as use by "Solta Medical, Inc".

C. DECISION

99. The application for a declaration of invalidity with number 3000410 is partly justified.

100. The Benelux registration with number 1450011 is declared invalid for the goods deemed identical and similar:

- Class 8: hand tools for use in beauty care; manicure and pedicure sets; hand-operated hygienic and beauty implements for humans, not included in other classes; hand-operated apparatus for the cosmetic care of eyebrows;
- Class 10 (*all goods*).

101. The Benelux registration with number 1450011 will remain registered for the dissimilar goods:

- Class 8: hand tools for use in home, hand operated;
- Class 44 (*all services*).

³⁴ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

³⁵ CJEU 11 May 2006, C-416/04 P, ECLI:EU:C:2006:310, point 51 (Vitafruit).

³⁶ Article 2.23bis (6) BCIP.

102. Neither of the parties shall pay the costs in accordance with article 2.30ter (5) BCIP in conjunction with rule 1.44 (2) IR, as the application for a declaration of invalidity is only partly justified.

The Hague, 27 November 2023



Yvonne Noorlander
(*rapporteur*)

Pieter Veeze

Eline Schiebroek

Administrative officer: Rémy Kohlsaat