

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY  
OPPOSITION DECISION  
N° 2017632  
of 31 October 2023**

**Opponent:** **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

**Invoked trademark 1: EU trademark registration 004054714**

FRAXEL

**Invoked trademark 2: Benelux trademark registration 785507**

FRAXEL

**Invoked trademark 3: International trademark registration 923526**

FRAXEL

*against*

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

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

**Contested mark:** **Benelux trademark application 1451226**

PLAXEL PLASMA PEN

## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 4 October 2021 the defendant filed a Benelux trademark application for the wordmark PLAXEL PLASMA PEN for goods and services in classes 8, 10, 41 and 44. This application was processed under number 1451226 and was published on 14 October 2021.
2. On 14 December 2021 the opponent filed an opposition against the registration of the application. The opposition 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.
  - Benelux trademark registration 785507 of the wordmark FRAXEL filed on 30 November 2005 and registered on 23 December 2005 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.
3. According to the register the opponent is the actual holder of the trademarks invoked.
4. The opposition is directed against all the goods and services covered by the contested application and is based on all the goods and services covered by the trademarks invoked.
5. The language of the proceedings is English.

### **B. Proceedings**

6. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office" or "BOIP") to the parties on 14 January 2022. Subsequently, the proceedings were once suspended, at the request of the parties. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was submitted by the opponent. The course of the proceedings meets the requirements as stated in the Benelux Convention on Intellectual Property (hereinafter: "BCIP") and the Implementing Regulations (hereinafter "IR"). The administrative phase was completed on 6 March 2023.

## **II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES**

7. The opponent filed an opposition at the Office under article 2.14 BCIP and bases the opposition on the following grounds:
  - Article 2.2ter (1) (b) BCIP, likelihood of confusion: *"A trademark shall, in case an opposition is filed, not be registered (...) 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."*
  - Article 2.2ter (3) (a) BCIP, reputation: *"A trademark shall, in case an opposition is filed, not be registered (...) where: a. it is identical with, or similar to, an earlier trademark irrespective*

*of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark".*

#### **A. Opponent's arguments**

8. The opponent starts by arguing that the invoked trademarks have been genuinely used and that the opposition is also based on the reputation of the invoked trademarks for 'aesthetic devices with a skin resurfacing laser' and the 'aesthetic treatment services', following which the invoked trademarks enjoy a broader scope of protection. This follows from evidence attached to the observations, the submitted witness statement and the evidence annexed to the witness statement.

9. The opponent continues by comparing the involved goods and services. With regard to the goods in class 8 of the contested sign, the opponent 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 sign are legally and literally identical to the goods in class 10 of the trademarks invoked. Regarding the training services in class 41 of the contested sign, the opponent argues that these are not specified and therefore cover all possible types of training such as training to work with medical devices consisting of lasers and parts and accessories therefor. Such services can be considered similar to goods and services from classes 10 and 44 of the trademarks invoked. With regard to the services in class 44 of the contested sign, the opponent argues that these are identical to the services in class 44 of invoked international trademark.

10. With regard to the comparison of the signs the opponent states that PLAXEL is the only distinctive and consequently dominant element in the contested sign. The element PLASMA PEN is of little or no weight in the comparison since it is a descriptor and therefore non-distinctive for the goods and services involved.

11. The opponent 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 such devices. From the results concerning searches in trademark registers, combined with the in-use-search, the opponent concludes that the single trademark found cannot cause dilution and that the suffix -AXEL is therefore highly distinctive.

12. Regarding the visual comparison, the opponent argues that the first syllables 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 signs are highly similar. As regards the phonetic comparison, FRAXEL and PLAXEL have the same length, rhythm, intonation and four out of six letters overlap. Therefore they are similar. The prefix FRA- refers to 'fractional technology'. 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 signs are conceptually similar.

13. As regards the global assessment the opponent 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 signs should be kept.

14. The opponent argues that the submitted evidence shows that the contested sign is actually being used as PLAXEL and not PLAXEL PLASMA PEN and that the actual use of the signs concerns identical goods and services.

15. The opponent concludes by stating that the trademarks invoked have been genuinely used during the relevant period for all goods and services registered for and that there exists a likelihood of confusion. The opponent requests the Office to grant the opposition, to refuse the application of the contested sign for all goods and services and to grant an award of costs to the opponent.

## **B. Defendant's arguments**

### *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 opponent.

17. Regarding the nature of use, the defendant states that from the evidence submitted by the opponent, 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 period. Most evidence that does show use in the relevant period relates to the United States of America and the United Kingdom. The numerous screenshots of opponent's websites and websites of third party clinics are all undated or are dated after the relevant period. The opponent should at least demonstrate that the websites were active during the relevant period. With regard to the vast majority of screenshots this has not been shown. The submitted invoices cover just over six months of the relevant period.

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 trademarks invoked outside the Benelux and the EU.

20. With regard to the extent of use the defendant argues that the claim of the opponent 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. Only two clinics from the Benelux are being mentioned. Even if the listed clinics use FRAXEL devices, these devices may have been supplied either before or after the relevant period.

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. Some goods were sold with a 100% discount, which does not constitute genuine use. The first invoice, namely an invoice to a client in Italy, shows sales of medical laser devices for skin therapy being 22 pieces with a commercial value of € 42.000,-. The other invoices mentioning FRAXEL goods priced

between the low prices of € 234,16 and € 453,- are likely to be accessories and not laser devices. Five actual sales for a total of 16 FRAXEL accessories have been shown by the opponent. The goods are not exclusive and are not expensive. Hence, they are not produced or sold in low numbers by their nature. These sales are not sufficient to constitute genuine use, according to the defendant.

23. The defendant argues that none of the invoices relate to the class 10 goods '*optical fiber and direct radiation delivery equipment for medical lasers*' or '*fiber optic and beam delivery apparatus for medical lasers*' and none of the evidence relates to the class 44 services '*cosmetic and plastic surgery and dermatological treatment services*'.

24. The defendant further argues that 'Solta Medical, Inc.' was not the holder of the invoked trademarks throughout the relevant period, that part of the evidence shows use by 'Bausch+Lomb Netherlands BV' instead of 'Solta Medical, Inc.' and that hence there was no use by or with the consent of the holder.

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

#### *Response to opponent's arguments*

26. The defendant is of the view that the opposition should be considered unjustified even if sufficient use has been shown.

27. 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.

28. 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 '*medical devices consisting of lasers*' from class 10 of the trademarks invoked and are therefore dissimilar. Also, the '*educational services*' in class 41 of the contested sign are entirely dissimilar to the goods and services the trademarks invoked are registered for. As for the other contested goods and services, namely the goods and services in classes 10 and 44, the defendant states to not contest the identity or similarity.

29. With regard to the comparison of the signs, the defendant contests the claim of the opponent 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 words PLASMA PEN from the contested sign, the defendant admits that these may be considered descriptive for the contested goods that can concern 'plasma pens' or goods and services directly connected to such goods. However, this does not mean that the element PLASMA PEN can be disregarded entirely when comparing the signs. While it is necessary to examine the distinctiveness of an element of a composite sign when assessing the similarity of signs to determine any dominant elements, it is not appropriate to take account a low degree of distinctiveness at this stage.

30. In the view of the defendant the signs are conceptually dissimilar. The contested sign refers to the concept of 'plasma pen'. The trademarks invoked, being FRAXEL, and the element PLAXEL from the contested sign have no meaning. Visually, the signs 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 signs differ in their beginnings being FR- and PL-. The endings also differ because the contested sign ends with PLASMA PEN,

whereas the invoked trademarks do not. Phonetically, the signs differ in their beginnings and endings. The only sound the signs have in common is represented by the letters AXEL. In the view of the defendant the signs are phonetically similar to only a low degree. Regarding the overall similarity the defendant states that the fact that the signs share the letters AXEL is not sufficient to render the signs similar overall. The signs display a low degree of similarity only.

31. The defendant disagrees to the conclusion of the opponent that the element -AXEL is highly distinctive following the fact that not many trademarks in the market for skin care products end with -AXEL and this element has not been diluted. Enhanced distinctiveness may be the result of longstanding and intensive usage, which has not been demonstrated by the opponent.

32. With respect to the likelihood of confusion the defendant argues that while some goods for which the signs have been applied for 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 signs. Given the very low degree of similarity between the signs, no realistic risk of confusion should be presumed regarding all goods and services, even those that may be found identical.

33. Regarding the claim of the opponent 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.

34. The defendant concludes that the opponent failed to demonstrate genuine use, that the signs display an insufficient degree of similarity to cause a likelihood of confusion among the relevant consumers for any of the goods and services, that the opponent failed to demonstrate the existence of a reputation of the trademarks invoked. The defendant requests the Office to dismiss the opposition in its entirety and to award costs in favor of the defendant.

### **III. DECISION**

#### **A Proof of use**

35. In accordance with article 2.16bis BCIP the opponent, at the request of the defendant, shall furnish proof that the trademarks invoked have been put to genuine use as provided for in article 2.23bis BCIP. Or that proper reasons for non-use existed. The evidence must show genuine use in a period of five years prior to the filing date of the trademark against which the opposition is lodged.

36. The filing date of the contested sign is 4 October 2021. Therefore, the opponent was required to show use of the invoked trademarks during the period from 4 October 2016 to 4 October 2021 ('the relevant period'). Given the fact that the invoked trademarks are registered more than five years prior to the filing date of the contested sign, the defendant's request for proof of use is legitimate.

37. 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.<sup>1</sup> 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,

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<sup>1</sup> 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).

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.<sup>2</sup> 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.<sup>3</sup>

38. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.<sup>4</sup> 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.<sup>5</sup>

39. 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.<sup>6</sup>

40. Invoked trademark 1 concerns an EU trademark registration and invoked trademark 3 concerns an International trademark 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 market.<sup>7</sup> It should be demonstrated that the trademarks are 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.<sup>8</sup>

41. 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 opposition is based.

42. 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.
  
- BX 785507  
Class 10 Medical devices and instruments consisting of lasers and parts and accessories, such as

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<sup>2</sup> 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).

<sup>3</sup> 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).

<sup>4</sup> 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).

<sup>5</sup> 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).

<sup>6</sup> General Court (EU) 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

<sup>7</sup> 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).

<sup>8</sup> CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, point 58 (ONEL).

replaceable ("disposable") tips for lasers, therefor; direct radiation delivery apparatus for medical lasers.<sup>9</sup>

- IR 923526  
Class 44 Cosmetic and plastic surgery and dermatological treatment services.

### Analysis of the proof of use

43. The opponent submits, along with its arguments in support of the opposition, proof of use. In response to the defendant's request to submit proof of use, the opponent submits additional proof as well as refers to the proof submitted earlier in these opposition proceedings.

44. The opponent submitted the following proof of use:

1. Witness statement dated 19 August 2022 by Jeremy Blackowicz executive director, head of global trademarks of Bausch Health organisation, a group of companies to which the opponent also belongs. Concerning background information on the company, a short explanation on the FRAXEL products 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 opponent 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 opponent's websites *solta\_medical.com* and *fraxel.com* mentioning the FRAXEL trademark, 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*;

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<sup>9</sup> The list of goods is in Dutch. The English translation is added for the sole purpose of readability of this decision.



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 apparatus, amongst which apparatus types FRAXEL DUAL, FRAXEL Re:pair and FRAXEL Re:Store DUAL, accessories bearing the trademark FRAXEL and pictures that show treatment by means of FRAXEL apparatus and pictures of results after treatment by FRAXEL apparatus;
10. Screenshot from webarchive.org showing the homepage of fraxel.com of 1 August 2020;
11. List of 188 clients from the EU, Norway and the United Kingdom that have bought FRAXEL goods between 2019 - 2022;
12. Invoices dating between 19 March 2021 and 4 January 2022 to clients in the Netherlands, France and Italy;
13. Screenshot with print date 26 August 2022 of websites of clinics in the Benelux showing that they offer FRAXEL treatments:
  - From Kazem.nl, supported by a screenshot from webarchive.org concerning a webpage from Kazem.nl mentioning FRAXEL of 3 August 2021;
  - From Lamaison-amsterdam.nl, supported by a screenshot from webarchive.org concerning a webpage from Lamaison-amsterdam.nl mentioning FRAXEL of 5 May 2019;
14. 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, supported by a screenshot from webarchive.org concerning a webpage from derma-loft.de mentioning FRAXEL of 25 October 2019;
  - From German website lasthetic.berlin, supported by a screenshot from webarchive.org concerning a webpage from lasthetic.berlin mentioning FRAXEL of 23 December 2018;
  - From French website crpce.com, supported by a screenshot from webarchive.org concerning a webpage from crpce.com mentioning FRAXEL of 21 June 2020;
  - From French website lazeo.com, supported by a screenshot from webarchive.org concerning a webpage from crpce.com mentioning FRAXEL of 20 September 2020;
  - From Polish website elite.waw.pl, supported by a screenshot from webarchive.org concerning a webpage from elite.waw.pl mentioning FRAXEL dating back to 18 June 2021;
  - From Polish website instytutbeautyderm.pl, supported by a screenshot from webarchive.org concerning a webpage from instytutbeautyderm.pl mentioning FRAXEL dating back to 1 December 2020;
  - From Spanish website clinicablue moon.es, supported by a screenshot from webarchive.org concerning a webpage from clinicablue moon.es mentioning FRAXEL dating back to 27 September 2021;
  - From Spanish website clinicasdiegodeleon.com, supported by a screenshot from webarchive.org concerning a webpage from clinicasdiegodeleon.com mentioning FRAXEL dating back to 7 February 2019;
15. Witness statement dated 27 December 2022 by Jeremy Blackowicz, executive director, head of global trademarks of Bausch Health organisation, a group of companies to which the opponent also belongs, concerning revenues in the Benelux and EU-wide under the FRAXEL trademark within the period 2016-2020.

45. The Office first notes that the fact that certain documents are undated or originate from outside the relevant period, 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.<sup>10</sup> Furthermore, these documents are likely to support the other evidence relied upon.<sup>11</sup> Moreover, screenshots from opponent's websites and screenshots of websites from cosmetic clinics obtained via webarchive.com as well as the submitted invoices do relate to the relevant period.

46. Based on the above material, the Office finds that the opponent has proven genuine use of FRAXEL for part of the goods in class 10 for which the invoked trademarks are registered. The submitted invoices (annex 12) show sales of a medical laser device for skincare and dozens of related accessories, as also confirmed by the defendant (see point 22).<sup>12</sup> The invoices refer to the trademark FRAXEL and the different types of devices ('DUAL', 'repair' and 're:Store DUAL') that are sold under this name. The submitted information about the products (annex 9) shows images of the different types of devices and explanations regarding the different names of the products. The invoices relate to a limited number of sales, however they do exceed the threshold of mere token use.<sup>13</sup> Especially when taking into account the characteristics of the market in question, namely expensive medical laser devices for skincare and accessories that are not purchased on a regular basis.<sup>14</sup> 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 trade mark protection to the case where large-scale commercial use has been made of the marks.<sup>15</sup>

47. 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 accessories are offered for free. These related goods are therefore also offered with the intention of creating or maintaining a market share.<sup>16</sup>

48. The defendant also argues that the submitted invoices only relate to just over six months of the relevant period (see point 18), the Office notes that use does not have to be made during a minimum period of time to qualify as 'genuine'. In particular, use does not have to be continuous throughout the relevant period of 5 years. It is sufficient if use was made at the very beginning or end of the period, provided the use was genuine.<sup>17</sup>

49. The Office finds that there is no sufficient evidence showing that the other goods in class 10 or the treatment services in class 44 have been offered or provided within the relevant period within the Benelux or the EU at all. Although the opponent 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 period within the Benelux or the EU. As noted above (see point 39), the genuine use of a trademark

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<sup>10</sup> 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).

<sup>11</sup> 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).

<sup>12</sup> Instead of 22 laser devices with a total commercial value of € 42.000,- as argued by the defendant, the invoice mentions 1 laser device of € 42.000,-.

<sup>13</sup> 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).

<sup>14</sup> General Court (EU) 8 July 2004, T-334/01, EU:T:2004:223, point 51 (Hipoviton).

<sup>15</sup> 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).

<sup>16</sup> General Court (EU) 9 September 2011, T-289/09, EU:T:2011:452, points 67 and 68 (Omnicare Clinical Research).

<sup>17</sup> General Court (EU) 16 December 2008, T-86/07, ECLI :EU:T:2008:577 (Deitech).

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*

50. 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 period within the EU for the goods '*medical devices consisting of lasers for skincare and parts and accessories therefor*' in class 10.

### **B.1 Likelihood of confusion**

51. In accordance with article 2.14 (1) BCIP, the applicant or holder of a prior trademark may submit a written opposition to the Office, within a period of two months following the publication date of the application, against a trademark which in the order of priority, ranks after its own in accordance with article 2.2ter BCIP.

52. Article 2.2ter (1) BCIP stipulates insofar as relevant that, "*A trademark shall, in case an opposition is filed, not be registered (...) 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.*"<sup>18</sup>

53. 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.<sup>19</sup>

54. 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 signs 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.<sup>20</sup>

### **Comparison of the signs**

55. 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.<sup>21</sup>

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<sup>18</sup> Article 2.2ter (1) (b) BCIP implements article 5 (1) (b) Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks. A similar provision can be found in article 8 (1) (b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

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

<sup>20</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

<sup>21</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

56. 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.<sup>22</sup> 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.<sup>23</sup>

57. 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.

58. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
FRAXEL	PLAXEL PLASMA PEN

#### *Visual comparison*

59. The invoked trademarks concern a wordmark, consisting of the verbal element "FRAXEL" composed of 6 letters. The contested sign also concerns a wordmark, consisting of the verbal elements "PLAXEL PLASMA PEN" composed of 3 words and 15 letters.

60. The Office finds that with respect to the contested sign, since the public reads from left to right, the most attention will be paid to the beginning of the sign, being PLAXEL.<sup>24</sup> After all, this word is placed at the beginning of the contested sign. In addition to the fact that the words PLASMA and PEN are placed at the end of the contested sign, to which less attention will be paid, these words concern common terms in commerce to indicate that the product involves 'plasma' and concerns a 'pen'.

61. 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.<sup>25</sup> The dominant element PLAXEL and the invoked trademarks FRAXEL coincide in the element -AXEL. Moreover, the first letters from the involved signs, being 'F' and 'P', show visual similarities.

62. Despite the fact that the last two words in the contested sign and the differences in the prefixes FR- and PL- of the involved signs cause some visual differences, the Office finds that these differences cannot undo the visual similarity between the signs resulting from the resemblance between the first letters 'F' and 'P' and the identical elements -AXEL.

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

<sup>22</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivaleza).

<sup>23</sup> 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).

<sup>24</sup> General Court (EU) 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

<sup>25</sup> 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).

*Phonetic comparison*

64. The dominant elements in the signs involved, being FRAXEL from the invoked trademarks and PLAXEL from the contested sign, have the same cadence, intonation and the same number of syllables being two. The signs involved coincide in the sound of the letter 'A' at the end of the first syllables FRA- and PLA- and coincide in the syllable -XEL. The two first consonants of the involved signs, being FR- and PL-, and the last elements PLASMA and PEN from the contested sign which have no counterpart in invoked trademarks, cause phonetic differences.

65. Despite the fact that the first two consonants of the involved signs and the last two words from the contested sign cause phonetic differences, these cannot undo the phonetic similarity between the involved signs resulting from the similar sounds of the first syllables and the identical sound of the second syllables.

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

*Conceptual comparison*

67. The opponent argues that -XEL has no meaning (see point 12). The defendant argues that the contested sign only refers to the concept of a 'plasma pen', that the invoked trademarks have no meaning and that the involved signs are therefore conceptually dissimilar (see point 30).

68. The Office finds that the words FRAXEL and PLAXEL as a whole have no fixed meaning to the relevant public in the Benelux, as also argued by the defendant (see point 30). One of the meanings of PLASMA is 'the fourth state of matter, after solid, liquid and gas'. PEN means 'a small pointed metal tool, usually used for writing or drawing'. These meaningful words will be recognized by the relevant public.<sup>26</sup>

69. Whereas FRAXEL is meaningless and the elements PLASMA and PEN from the contested sign do convey a meaning to the relevant Benelux public, the involved signs are conceptually dissimilar.

*Conclusion*

70. Given the above, the Office considers that the involved signs are visually and phonetically similar to a certain degree and are conceptually dissimilar. Based on the overall impression, the signs are similar.

***Comparison of the goods and services***

71. When assessing the similarity of goods and services, all relevant factors characterising the relationship between them must be taken into account. These include, inter alia, their nature, their end-users, their method of use and whether they are in competition with each other or are complementary.<sup>27</sup>

72. 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.<sup>28</sup>

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<sup>26</sup> See also BenCJ (second chamber) 23 January 2023, C 2021/17/7, point 33 (Tubex Piping).

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

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

73. Having regard to the principle of hearing both sides, opposition proceedings are limited to the arguments, facts and evidence put forward by the parties.<sup>29</sup>

74. Genuine use has been demonstrated for medical devices consisting of lasers for skincare and parts and accessories therefor. The Office will continue with the comparison of goods and services considering the aforementioned goods.

75. The goods and services to be compared are:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
	CI 8 Hand tools for use in beauty care; hand tools for use in home, hand operated; 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 vibrations to the skin; apparatus and instruments for facial or eyes treatments; parts of all the aforesaid goods.
	CI 41 Training; Training services; Providing training; Providing of training; Production of training videos; Providing courses of training; Training courses.

<sup>29</sup> Article 2.16 (1) BCIP and rule 1.21 IR.

	<p>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.</p>

#### Class 8

76. The opponent 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 28). 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.

77. Regarding the remaining contested goods, being *'hand tools for use in beauty care; 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 73), these goods must be considered highly similar.

#### Class 10

78. The opponent argues that all goods in class 10 of the contested sign 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 28). The identity of the goods in question is thus manifestly *in confesso*, so that the Office need not examine it further.

#### Class 41

79. The opponent argues that all services in class 41 of the contested sign concern *'training services'* which are similar to the goods in class 10 of the trademarks invoked, since it can involve all possible types of training like training regarding class 10 goods (see point 9). In the view of the defendant the educational services in class 41 of the contested sign are dissimilar to the goods and services the invoked trademarks are registered for (see point 28). The Office agrees with the defendant that the contested services in class 41 are dissimilar to the goods and services the invoked trademarks are registered for. In general, goods and services are of a different nature, due to the fungible nature of the former and the non-fungible nature of the latter. Furthermore, they do not have the same use. However, goods and services can be complementary: after all, some services cannot be rendered without using some goods.<sup>30</sup> Although the *'training services'* could involve training regarding class 10 goods, there is no complementarity between training services and goods like *'accessories to medical devices'* in the sense that these goods are

<sup>30</sup> General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 52 (O STORE).

indispensable for the provision of the services of the contested sign and that the public might believe that they would originate from the same undertakings. The involved goods and services are dissimilar.

#### *Class 44*

80. With regard to the services in class 44 of the contested sign, the opponent 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 49), the aforementioned argument cannot succeed. Since opposition 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 sign and the remaining goods in class 10 of the trademarks invoked is not being argued by the opponent, the involved services must be held to be dissimilar to the involved goods.

#### *Conclusion*

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

### **B.2 Global assessment**

82. 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.<sup>31</sup> 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 opponent 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.

83. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be taken into account and, in particular, 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.<sup>32</sup>

84. In the case at hand, the involved signs are visually and phonetically similar to a certain degree and conceptually dissimilar. The conceptual dissimilarity is insufficient to neutralize the visual and phonetic similarities, as the differences concern the elements PLASMA and PEN which the opponent and the defendant both find descriptive (see points 10 and 29), as does the Office. The relevant public will generally not regard descriptive elements as the distinctive and dominant element of a sign.<sup>33</sup> 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 goods found to be identical or 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*

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<sup>31</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

<sup>32</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 (Equivalenza) and the case-law mentioned there.

<sup>33</sup> See, for example, General Court (EU) 3 July 2003, T-129/01, ECLI:EU:T:2003:184, point 53 (Budmen) and BenCJ (second chamber) 18 October 2022, C-2021/5/7, point 25 (Luxauto).



85. 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; 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.

### **C. Reputation**

86. The opponent has based the opposition also on Article 2.2ter, 3 (a) BCIP.

87. 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, all contested services from class 41 and all contested services from class 44.

88. 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.

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

90. The opponent submitted exhibits 1 to 8 (see point 44) to demonstrate the reputation of the invoked trademarks.

i. *The signs are either identical or similar*

91. The Office has already established that the signs are similar (see point 70).

ii. *The earlier trademark has a reputation*

92. The opponent 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 opponent 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 opponent'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.

93. 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 opposition on the basis of this article must be rejected.

#### **D. Other factors**

94. Regarding the arguments concerning actual use of the involved signs (see points 11 and 14), the Office notes that actual use of a sign cannot be taken into account in opposition proceedings, as the comparison of the signs and goods and services is solely based on the trademarks as registered and the sign as applied.<sup>34</sup>

95. In as far as the defendant means to argue that the opposition should be rejected because the current holder 'Solta Medical, Inc.' was not the holder of the invoked trademarks throughout the relevant period and part of the evidence shows use by 'Bausch+Lomb Netherlands B.V.' instead of 'Solta Medical, Inc.' (see point 24) 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 opponent submitted, and apparently obtained, part of the proof of use from 'Bausch+Lomb Netherlands B.V.' there is no reason to doubt that there was use of the mark with the opponent's consent.<sup>35</sup> Use of a trademark with the consent of the holder is considered use by the holder.<sup>36</sup> Moreover, the witness statement as well as screenshots of opponent'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'.

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

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

<sup>36</sup> Article 2.23bis (6) BCIP.

**IV. DECISION**

96. The opposition with number 2017632 is partly justified.

97. The Benelux application with number 1451226 will not be registered for the following goods and services:

- Class 8: hand tools for use in beauty care; 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*);

98. The Benelux application with number 1451226 will be registered for the following goods and services that are not similar:

- Class 8: hand tools for use in home, hand operated;
- Class 41 (*all services*).
- Class 44 (*all services*).

99. Neither of the parties shall pay the costs in accordance with article 2.16 (5) BCIP in conjunction with rule 1.28 (3) IR, as the opposition is partly justified.

The Hague, 31 October 2023



Yvonne Noorlander  
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