

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% Order delivered on: 30th October, 2015

+ **CS (OS) No.2114/2014**

CROSS FIT INC. PLAINTIFF
Through Mr.Pravin Anand, Adv. with
Ms.Tanvi Misra, Adv.

versus

GURPREET SINGH & ANR. DEFENDANTS
Through Defendants are *ex-parte*.

CORAM:
HON'BLE MR.JUSTICE MANMOHAN SINGH

MANMOHAN SINGH, J.

1. The plaintiff has filed the present suit for permanent injunction restraining the defendants from using the mark '**KrossFit**' as



in respect of "GYM, PROVIDING OF TRAINING, SPORTING AND CULTURAL ACTIVITIES" in the name of Gurpreet Singh (defendant No.1) trading as 'KrossFit' (defendant No.2) who have sought registration of their trademark at the Trademark Registry under application No. 2382555 in class 41 and any other mark identical or deceptively similar to plaintiff's well known trademark, CrossFit.

- (a) Extracts from the website of the Indian Trademarks Registry showing the defendants' trademark application have been exhibited as Ex. PW-1/49.
- (b) Photographs of the hoardings at the defendants' premises, which bear the impugned trademark, have been exhibited as Ex. PW-1/50.

(c) Cease and desist notice sent to the defendants on 19th July, 2013, which the defendants did not reply to has been exhibited as Ex. PW-1/51.

(d) Opposition proceedings filed by the plaintiff before the Trademark Registry on 30th June, 2014 have been exhibited as Ex. PW-1/52.

2. No written statement has been filed by the defendants. Counsel for the plaintiff upon instruction has informed that the plaintiff is not pressing any relief of damages, rendition of accounts, costs except the relief of permanent injunction. He submits that in the absence of written statement, this Court may exercise its discretion even otherwise to pronounce the judgment under Order VIII Rule 10 CPC.

3. The defendants were proceeded ex-parte by the order dated 2nd February, 2015 and the plaintiff has filed the ex-parte evidence affidavit through its General Counsel, Mr. Dale Saran. The notarized true copy of the Unanimous Consent of the Board of Directors has been exhibited as Ex. PW-1/1. The notarized true copy of the bylaws of CrossFit Inc. along with the 'Action By Incorporator of CrossFit Inc' has been exhibited as Ex. PW-1/2.

4. The plaintiff has filed the scanned copy of the affidavit by way of evidence of Mr. Dale Saran. Learned counsel for the plaintiff submits that he will file the original affidavit within four weeks from today. He presses that let the decree be passed under Order VIII Rule 10 CPC.

5. **Description about CrossFit:** 'CrossFit' is a fitness regimen developed by Coach Greg Glassman over decades, which aims at optimizing fitness through constant varied functional movements executed at high intensity across broad time and modal domains. The plaintiff is the first entity in the world to use 'CrossFit' for its fitness and training services. The plaintiff Company is the first fitness

organization in the world to provide quantifiable and precise definitions of health and fitness. The plaintiff's services and products can be accessed by anyone who has an Internet connection. Web extract from the plaintiff's website providing a general description and the salient features of the CrossFit regimen has been exhibited as Ex. PW-1/3.

6. Plaintiff's network operates all over the world, with a presence in more than 70 countries, with over 11,000 gyms (referred to as "Boxes"). A map containing the locations of all the CrossFit boxes in the world has been exhibited as Ex. PW-1/12. Currently there are 17 boxes in India, as seen in the map, which has been exhibited as Ex. PW-1/37.

7. **Community aspect of the plaintiff:** The plaintiff stays connected with the community created when people practice the CrossFit regimen together.

- a) CrossFit Discussion Board: The communal aspect is essential for the regimen to be effective, which is why the plaintiff has created the CrossFit Discussion Board on its website, which enables all members of the CrossFit community to share their experiences. It provides a platform for them to exchange health and exercise tips and have their queries resolved by communicating with other members of the global CrossFit community. Extracts from the CrossFit discussion board have been exhibited as Ex. PW- 1/5.
- b) CrossFit Radio: The plaintiff broadcasts discussions and interviews of different members of the CrossFit community, irrespective of whether they are trainers, followers or simply enthusiasts. This broadens the extent of CrossFit's reach to consumers worldwide, especially since the show is available on various online broadcasting platforms. The broadcasts are

archived for future references and at present there are 405 broadcasts available at <http://journal.crossfit.com/radio/>. The web extract of the CrossFit Radio, which contains links to hundreds of live broadcasts has been exhibited as Ex. PW-1/19.

- c) The CrossFit Journal: The plaintiff is the publisher of a daily multimedia magazine on fitness, health and lifestyle called 'The CrossFit Journal', which has been exhibited as Ex.PW-1/18. The journal serves to assist the members of the CrossFit community in improving their athletic performance and their quality of life. It contains over 3,100 articles, video and audio files pertaining to various aspects of healthy living, such as exercise techniques, exercise physiology, functional movements, nutrition, injuries and rehabilitation etc. This forum welcomes participation in the form of articles, posts, videos and comments from people of every denomination in the world of fitness, whether they be mere enthusiasts or elite coaches and fitness experts. It serves as a platform to share knowledge and experiences, further strengthening ties within the CrossFit community. It serves as a space for them to share their experiences relating to CrossFit with the global CrossFit community.

8. The plaintiff is the first entity in the world to use 'CrossFit' for its fitness and training services. The mark 'CrossFit' was first used by the plaintiff in respect of its gym called 'CrossFit Santa Cruz' in Santa Cruz, California in 1995. In 1996, the plaintiff Company first commenced its business under the name 'CrossFit, Inc.' in Washington, USA. In 2008 the plaintiff Company was incorporated

under the laws of Delaware, USA and the notarized certificate of conversion of the plaintiff Company has been exhibited as Ex. PW 1/4.

9. **Plaintiff's services and products:** The plaintiff provides services including strength training, fitness programs, trainer certifications and conducts fitness seminars as well. The plaintiff also offers specialized courses that equip CrossFit trainers with the know-how to help their clients achieve specific results in various sports and athletic activities. These courses have been duly recognized by numerous health organizations.

- (a) Certification courses of the plaintiff at Level 1 and Level 2 have been exhibited as Ex. PW-1/6. There are 117,480 people with CrossFit Trainer Certificates in the world.
- (b) List of trainer courses offered by the plaintiff has been exhibited as Ex. PW-1/7. The plaintiff has over 100,000 CrossFit Level 1 accredited trainers, whose particulars are maintained in the CrossFit Trainer Directory, which has been exhibited as Ex. PW- 1/13. There are 211 CrossFit trainers in India. The directory of trainers within India has been exhibited as Ex. PW- 1/39.
- (c) Seminars are offered by the plaintiff world over and in India. Web extracts of the schedules and locations of these seminars have been exhibited as Ex. PW 1/8 and Ex. PW-1/9.
- (d) Web extracts showing range of sports gear and apparel available for sale on the Reebok website and on e-commerce platforms have been exhibited as Ex. PW-1/10 and Ex. PW-1/11 respectively.
- (e) In 2001, the plaintiff created a free blog entitled 'Workout of the Day', that soon become a staple for fitness enthusiasts across the world. Web extract containing the Workout of the

Day blog has been exhibited as Ex. PW- 1/17. This blog can be accessed from the homepage of the plaintiff's website and prescribes a new exercise every day, along with bits of information on health. It has become the most preferred and followed blogs amongst health enthusiasts around the world.

- (f) The CrossFit Games: The plaintiff is the creator of the 'Sport of Fitness', also known as the 'CrossFit Games'. This is a global competition, whose objective is to find and crown the "Fittest Man on Earth" and the "Fittest Woman on Earth". This competition has attracted a large number of people from all over the world, including India, since its inception in 2007. The prize payout for the 2015 edition of the competition is estimated to be at \$2,000,000. Web extracts showing various details of the 'CrossFit Games' have been exhibited as Ex.PW-1/23 to Ex.PW-1/29. The plaintiff hosts the CrossFit Games in collaboration with a host of 4 partners, 8 sponsors and 74 Games Exhibitors such as Reebok, The Hyatt Group etc. A complete list of all the Sponsors and Partners for the 2015 edition of the CrossFit Games has been exhibited as Ex. PW-1/30.

10. **Plaintiff's advertisement, promotions, awards and philanthropic activities :**

- a) Celebrity endorsements:

Indian celebrities: Numerous Indian celebrities have sworn by CrossFit as the perfect means of attaining the levels of physical fitness they are required to reach as per their professional and personal requirements. These celebrities include Abhishek Bachchan, Amitabh Bachchan, Aamir Khan, Hrithik Roshan, Ranveer Singh, Alia Bhat, Arjun Kapoor, John

Abraham, Jacqueline Fernandez, etc. Web extracts from numerous publications showcasing the endorsement by Indian celebrities have been exhibited as Ex. PW- 1/32 and Ex. PW- 1/33.

International celebrities: Numerous international celebrities also follow CrossFit and have publicly sworn by the regimen. These celebrities include Madonna, Jessica Kelly Clarkson, Jessica Biel, Elizabeth Banks, Vanessa Hudgens, Cameron Diaz, Malin Akerman, Paula Patton. Web extracts showing the same have been exhibited as Ex. PW-1/35..

- b) Advertisements in leading publications worldwide and in India: The plaintiff company, its CEO/founder and its regime have been extensively written about in numerous publications such as *'Men's Health Magazine'*, *'Women's Health Magazine'*, *'Vogue Magazine'*, *'Business Line'*, *'Business Standard'*, *'Hello! Magazine'*, *'The Hindu'*, *'The Times of India'*, *'The Deccan Chronicle'* etc., which collectively reach out to consumers all over India either through print or the Internet. Samples of the same have been exhibited as Ex. PW-1/36(Colly).

International publications: The plaintiff company, its CEO/founder and its regime have been extensively written about in *'New Yorker'*, *'Inc Magazine'*, *'Outside Magazine'*, *'The New York Times'*, *'Time Magazine'*, *'Business Week Magazine'* and *'News Week Magazine'* published in the United States as well as in Europe, Asia and the Middle East which are also widely circulated in India. Web extracts of the same have been exhibited as Ex. PW- 1/42.

- c) Philanthropic activities: The plaintiff's efforts to spread its regime throughout the world by means of its affiliates,

trainers, training courses, competitions, philanthropic activities, seminars etc. have created a community of CrossFit followers across the world and within India in particular, who contribute towards the betterment of the community. Even in rural areas, CrossFit has made a major impact in the lives of underprivileged children and orphans. Web extracts from the CrossFit Journal which provide evidence of the same have been exhibited as Ex. PW-1/31. The CrossFit regimen has helped differently-abled and underprivileged members of society. Web extracts of articles from the CrossFit Journal showing the same have been exhibited as Ex. PW- 1/21. CrossFit for Hope', the official fundraising arm of the plaintiff, looks to fight various social-economic ills that are prevalent within society. Its activities range from battling child cancer, reducing infant mortality to providing academic and cognitive training scholarships including coaching for both teachers and students. Web extract of from the 'CrossFit for Hope' website has been exhibited as Ex.PW-1/22.A total amount of \$332578.50 has been raised by CrossFit for Hope till 28th October, 2015.

- d) The plaintiff and its CEO have received numerous awards since the inception of CrossFit. Web extracts showing the same have been exhibited as Ex. PW-1/41.

11. **Plaintiff's trademark registration world over and applications in India:** Plaintiff has protected its well-known trademark CrossFit all over the world. The plaintiff has 272 registered trademarks and approximately 80 pending applications. The notarised consolidated list containing the details of these registrations and applications has been exhibited as Ex. PW-1/44. The plaintiff's

trademark applications in India in classes 25 and 41 being application numbers 2175375 and multi-class application being IRDI-2745868 have been exhibited as Ex. PW-1/40.

12. **Plaintiff's enforcement activities world over:**

- a) The plaintiff has filed and won numerous lawsuits in various jurisdictions and forums, which have been exhibited as Ex. PW-1/48. A table containing the details of a few of these judgments has been reproduced herein below:–

Suit details	Impugned marks
USA	
CrossFit Inc. v. The PR Cave Case No. SACV13-297-AG (RNBx)	For the use of 'CrossFitters' in the trade description
Sportsgrants Inc. v. CrossFit Inc. Case No. CV-12-0196-SI	"CROSSFIT" & "FIGHT GONE BAD"
CrossFit Inc. v. Norcal Elite Gymnastics Case No. 2:13-CV-1174 KJM KJN	"CrossFit", "CrossFitness" & "XFIT"
CrossFit Inc. v. Maximum Human Performance LLC Case No. 12cv2348-BTM-MDD	"X-Fit" The Court found that - "CrossFit is a popular fitness program, well-known for its intense workout regimen and corresponding intensity of its members." "For the purposes of the preliminary

	injunction, Crossfit has offered sufficient evidence to indicate that it owns a famous mark, including that it currently licenses over 4,600 affiliate gyms and hosts annual workout competition televised nationally by ESPN." "The overall impression is that CrossFit has a strong trademark".
CrossFit, Inc. v. T&M Inc. Case No. 2:11-cv-01061-JLR	Domain named "CrossFit" or any variation/combination of "Cross" & "Fit"
CrossFit Inc., v. Henry Alvarido Case No. 13-cv-20702	Domain named "CrossFit" or any variation/combination of "Cross" & "Fit"
CrossFit Inc., v. Island Board Rider, Inc. Case No: 13-cv-01186-AG-JPR	'CrossFit', 'Cross Fit', 'Crossfit', 'CROSSFIT', 'crossfit'
CrossFit Inc., v. Robert D. Tucker Civ. Action No. 8:13-cv-2752-t-26AEP	"CrossFit"
CrossFit Inc., v. 2XR Fit Systems, LLC civ. No. 2:13-1108 (KM)	'Cross Fitness', 'Xross Fitness', 'XFit'
CrossFit Inc., v. David Nielsen Case No. 3:12-cv-325 AJB (WVG)	'crossfitpacificbeach.com' despite the existence of an expired license, defendants continued to operate as a licensee. Therefore, the impugned mark is "CrossFit"
CrossFit Inc. v. Results	113 domain names were transferred to the

Plus Personal Training Claim no: FA1305001438576 before the National Arbitration Forum	Complainant CrossFit.
CrossFit, Inc. v. Duza, LLC, et al., (Case No. 1:13-cv- 20702-JLK; 2013	Permanent injunction and stipulated judgment against a cyber-squatter)
CrossFit, Inc. v. Moore et al., Case No. 2:11-cv- 01061-JLR (2011)	\$100,0000 judgment against the Defendant for cybersquatting in respect of 180 domains.
Italy	
Functional Store v. CrossFit Inc. Civ. suit 4027/2012	"CROSS GYM" The Court found that - "It also cannot be denied that this sign, with use over time, and in particular with its diffusion internationally and in Italy – to which the legal representative of the plaintiff company has himself contributed – has objectively reinforced its original distinctive capacity...."
OHIM	
CrossFit Inc., v. Functional Store	"CROSS GYM" was invalidated

- b) The plaintiff has also availed of a plethora of means and methods to protect its trademark and its brand name and image. These include publications and interviews that disseminate information pertaining to the protection of the

plaintiff's trademarks and the steps taken by the plaintiff to do the same. Web extracts pertaining to the plaintiff's efforts towards the protection of its brand image and trademarks have been exhibited as Ex. PW-1/46. The plaintiff has published the Terms of Use for the CrossFit trademark on its website at <http://www.crossfit.com/cf-info/terms.html>, exhibited as Ex. PW-1/45, for making the general public aware of their rights in the plaintiff's trademarks. The plaintiff has a legal team named the "*Defenders of the Faithful*", dedicated to the sole purpose of protecting the plaintiff's trademark. The plaintiff also has a separate team known as the "*The Russells*" dedicated to protecting its brand image on the Internet, which responds to fake and dubious reviews/comments about CrossFit on the Internet. Web extracts pertaining to the employees hired by the plaintiff to protect its brand image and trademarks facts have been exhibited as Ex. PW-1/43. The plaintiff has created an online IP Theft Reporting Mechanism on its website, enabling Internet users to report instances of the infringement of the plaintiff's intellectual property. A web extract of the plaintiff's IP Theft Reporting Mechanism has been exhibited as Ex. PW-1/47.

13. **Plaintiff's affiliation process :**

- (a) The plaintiff permits interested persons to affiliate themselves with 'CrossFit' to set up CrossFit Boxes upon the fulfillment of certain requirements. The application form has been exhibited as Ex. PW-1/14.
- (b) The plaintiff has simplified the affiliation process for prospective affiliates and only successful applicants are permitted to use the plaintiff's well-known mark CrossFit. The

web extract of CrossFit's guide to the affiliation process has been exhibited as Ex. PW- 1/15.

- (c) All applicants and affiliates are made aware of the fact that the plaintiff is the proprietor of the well-known mark 'CrossFit', in the interest of preventing any misuse of the plaintiff's mark by its affiliates, through the "Frequently Asked Questions" or FAQ section of the plaintiff's website. The same has been exhibited as Ex. PW-1/16.

14. **Passing Off by the defendants:**

- (i) By misrepresentation: The use of 'KrossFit' by the defendants is a deceptive and misleading use of the plaintiff's trademark/service mark/trading style/domain name/corporate name 'CrossFit', with the objective of taking unlawful benefit of the goodwill inherent in the trademark/service mark/domain name/corporate name 'CrossFit'. By these acts the defendants are deceptively holding out or giving an impression to the unassuming public that their goods have a license or approval of the plaintiff.

- (ii) The defendants' unauthorized use of 'KrossFit' and



is nearly identical to the plaintiff's trademark/service mark/trading style domain name/corporate name 'CrossFit' and the only difference is in the use of the letter 'K' by the defendants as opposed to the use of letter 'C' by the plaintiff. The pronunciation of 'C' and 'K' are the same hence, the impugned mark of the defendants is identical in part/ confusingly and phonetically identical as a whole. Even the manner of writing 'KrossFit' by the defendants is identical

to that of the plaintiff's CrossFit with the letter 'F' in upper case.

- (iii) Confusion as to source: The defendants' use of the impugned mark KrossFit in a prominent manner for gymnasium and fitness centre serves to be a source identifier and is likely to create a false impression in the mind of consumers of the possibility that the defendants are in some manner connected with or authorized by the plaintiff in relation to their services in the same class.
- (iv) 'CrossFit', which is an invented word and has no logical source of adoption has been blatantly copied by the defendants with the exception of the first letter 'C' that has been replaced by the letter 'K' leaving the mark still phonetically identical to the plaintiff's well-known mark 'CrossFit'. This is clear evidence of the defendants' malafide intention. The defendants chose to adopt this exact mark because by doing so they would evade the process of contacting the plaintiff for an authorised license to use the mark and still pass off his training facility and gym as that which has the goodwill and reputation of the plaintiff.
- (v) It is an accepted proposition of law that a well-known and reputed trademark/mark gets diluted when the consumer capacity to associate it with the original owner's products is diminished. The unauthorized use of the impugned mark by the defendants will undermine and tarnish the positive associations with and blur the singular source signal emitted by the plaintiff's trademark CrossFit.
- (vi) When members of trade and public see the well-known mark being used by unrelated and unauthorized traders, the ability

of the trademark to identify and distinguish its source stands diluted. The high degree of goodwill and reputation enjoyed by a particular trademark is worthy of a wide scope of protection.

(vii) The blatant and unrestricted use of a mark which is identical to the plaintiff's mark CrossFit in relation to the defendants' products will inevitably lead to the gradual whittling away and eventual erosion of the uniqueness and exclusivity associated with the plaintiff's trademark CrossFit.

15. The plaintiff's mark CrossFit is a well-known mark under Section 2 (1) (zg) of the Trademarks Act, 1999 and under Section 11(9) and 11(10) along with Section 11(6) and (7) of the Act.

16. In view of the above facts and circumstances, the plaintiff is entitled to a decree for permanent injunction in terms of prayers in paragraph 20 (a) and (b) of the plaint. Ordered accordingly. The decree is being passed under Order VIII Rule 10 CPC. The other reliefs are not pressed. The same are accordingly rejected.

17. Decree be drawn accordingly.

(MANMOHAN SINGH)
JUDGE

OCTOBER 30, 2015