

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF THE
INTELLECTUAL PROPERTY OFFICE OF SINGAPORE**

[2024] SGIPOS 4

Trade Mark No. 40201912621Q

**IN THE MATTER OF A REGISTERED TRADE MARK
IN THE NAME OF**

PLAY DISTRIBUTION PTE LTD

... Proprietor

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
BY**

CROSSFIT, LLC

... Applicant

GROUND OF DECISION

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CrossFit LLC
v
Play Distribution Pte Ltd

[2024] SGIPOS 4

Trade Mark No. 40201912621Q
Principal Assistant Registrar Tan Mei Lin
27 February 2024

27 May 2024

Principal Assistant Registrar Tan Mei Lin:

Introduction

1 This matter concerns the following trade mark registered in Singapore in the name of Play Distribution Pte Ltd (the “Proprietor”) on 10 June 2019 (the “Relevant Date”):

TM No.	40201912621Q
Mark (the “Subject Mark”)	CrossFeet
Class	25
Specification (the “Registered Goods”)	Headwear; Bathing caps; Berets; Cap peaks; Hat frames [skeletons]; Hats; Mantillas; Miters [hats]; Shower caps; Skull caps; Top hats; Turbans; Visors [headwear]; Wimples; Aprons; Ascots; Babies' pants [clothing]; Bandanas; Bath robes; Bathing trunks; Bathing suits; Beach clothes; Waist belts; Bibs, not of paper; Feather boas; Bodices; Brassieres; Breeches for wear; Camisoles; Chasubles; Clothing for gymnastics; Clothing;

	Clothing of imitations of leather; Clothing of leather; Coats; Collar guards for protecting clothing collars; Collars; Combinations [clothing]; Corselets; Corsets [underclothing]; Cuffs; Cyclists' clothing; Detachable collars; Dress shields; Dresses; Dressing gowns; Ear muffs; Fishing vests; Footmuffs, not electrically heated; Fur stoles; Furs [clothing]; Gabardines [clothing]; Garters; Girdles; Gloves [clothing]; Headbands [clothing]; Heelpieces for stockings; Hoods; Hosiery; Jackets [clothing]; Jerseys; Pinafore dresses; Knitwear [clothing]; Layettes [clothing]; Leggings [trousers]; Leg warmers; Liveries; Maniples; Masquerade costumes; Mittens; Money belts [clothing]; Motorists' clothing; Muffs [clothing]; Neckties; Outerclothing; Overalls; Overcoats; Drawers [clothing]; Paper clothing; Paper hats [clothing]; Parkas; Pelerines; Pelisses; Petticoats; Pocket squares; Pockets for clothing; Ponchos; Pullovers; Pajamas; Ready made linings for clothing; Ready-made clothing; Saris; Sarongs; Sashes for wear; Scarves; Shawls; Shirt yokes; Shirt fronts; Shirts; Short-sleeve shirts; Sports jerseys; Ski gloves; Skirts; Skorts; Sleep masks; Slips [clothing]; Sock suspenders; Socks; Gaiters; Stocking suspenders; Stockings; Sweat-absorbent stockings; Stuff jackets; Suits; Suspenders; Anti-sweat underwear; Sweaters; Teddies [underclothing]; Tee-shirts; Tights; Togas; Gaiter straps; Trousers; Underpants; Underwear; Uniforms; Veils [clothing]; Vests; Waterproof clothing; Wet suits for water-skiing; Bath sandals; Bathing slippers; Beach shoes; Boot uppers; Boots; Boots for sports; Esparto shoes or sandals; Fittings of metal for footwear; Football shoes; Footwear; Footwear uppers; Galoshes; Gymnastic shoes; Half-boots; Heelpieces for footwear; Heels; Inner soles; Lace boots; Non-slipping devices for footwear; Sandals; Shoes; Ski boots; Slippers; Soles for footwear; Sports
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	shoes; Studs for football boots; Tips for footwear; Welts for footwear; Wooden shoes [footwear].
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2 CrossFit LLC (the “Applicant”) applied for a declaration of invalidity against the trade mark registration.

Background of parties

3 The Applicant (formerly known as CrossFit, Inc. which was incorporated in 2000 and first conceived as “Cross-Fit” as early as 1985) is a United States-based company that specialises in fitness content and education and fitness training services. Its first CrossFit-branded gym, offering CrossFit-branded classes, was opened in Santa Cruz, California in 2001. Shortly thereafter, the Applicant began its affiliate programme, which allowed interested gyms to apply to become a licensed CrossFit affiliate. As of 2022, the Applicant had over 5,000 affiliates throughout the United States and over 11,000 affiliates worldwide.

4 The Applicant owns the following trade mark registrations for “CROSSFIT” (the “Applicant’s Mark”) in Singapore:

Trade Mark No.	Filing Date	Goods/Services
T1215655B	30 May 2012	<u>Class 25</u> Clothing, namely, shirts, pants, shorts, jackets, sweatshirts, sweatpants, headwear, socks; footwear. <u>Class 41</u> Entertainment services, namely, provision of entertainment programmes featuring fitness, nutrition, sports and exercise

		provided through pay television or internet; providing information in the fields of fitness training, sports and exercise via a website; online publication of journals in the fields of fitness, nutrition, sports and exercise; entertainment services, namely, providing information in the fields of fitness training, sports, and exercise via a podcast; educational services, namely, conducting lectures, seminars and workshops (training) in the fields of fitness, nutrition, sports and exercise; entertainment in the nature of competitions in the field of fitness; entertainment in the nature of sports competitions; fitness training.
T1408504J	21 January 2014	<u>Class 16</u> Paper goods and printed matter, namely, a series of books, written articles, handouts and worksheets in the fields of fitness, nutrition, sports and exercise; printed instructional, educational, and teaching materials in the fields of fitness, nutrition, sports and exercise; magazines in the fields of fitness, nutrition, sports and exercise; general feature magazines; exercise books; posters; bumper stickers. <u>Class 28</u> Exercising equipment, namely, weight lifting bars, dumbbells, medicine balls, climbing ropes, nets for sports, exercise bars; fitness machines and equipment,

		namely, rowing machines; exercise weights; gymnastic apparatus.
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5 The Proprietor is a company incorporated in Singapore on 8 March 2017 but “primarily based” in Sweden. It commenced use of the stylised mark  in Singapore, since December 2020, in relation to training socks specially designed in Sweden for use during fitness workouts such as high-intensity interval training (HIIT) and functional workouts. More recently, the Subject Mark has also been used in relation to apparel such as T-shirts. The Proprietor’s “CrossFit” products are currently sold worldwide including in Sweden and Singapore.

6 The Proprietor has been an official sponsor of several CrossFit events¹ organised by the Applicant’s affiliates or licensees.

7 In addition to Singapore, the Proprietor has obtained registration of its “CrossFit” mark in Switzerland and the European Union.

Grounds of invalidation

8 The Applicant relies on the following grounds in this application for a declaration of invalidity:

- (a) section 23(3)(a)(i) read with s 8(2)(b) of the Trade Marks Act 1998 (the “Act”);

¹ The CrossFit France/Switzerland/Belgium Affiliate Summit 2021, The Southcoast Showdown II, The Westcoast Throwdown 2022, The STHLM Mayhem, The Fareast Throwdown 2022, The Amsterdam Throwdown, The Lyon Showdown, CrossFit Butchers Classics, The Italian Showdown 2022 and The Italian Showdown 2021.

- (b) section 23(3)(a)(iii) read with s 8(4)(b)(i) and s 8(4)(a) of the Act;
- (c) section 23(3)(a)(iii) read with s 8(4)(b)(ii)(A) of the Act;
- (d) section 23(3)(a)(iii) read with s 8(4)(b)(ii)(B) of the Act; and
- (e) section 23(3)(b) read with s 8(7)(a) of the Act.

9 The Applicant’s written submissions included the ground of bad faith under s 23(1) read with s 7(6) of the Act but this is not a pleaded ground, and the Applicant did not apply to amend its pleadings to include this ground. I have therefore disregarded it.

Applicant’s evidence

10 The Applicant’s evidence comprises the following:

- (a) a Statutory Declaration made by Marshall Brenner, General Counsel of the Applicant, on 12 October 2022 (“ASD1”);
- (b) a Statutory Declaration in Reply made by the same Marshall Brenner on 26 September 2023 (“ASD2”); and
- (c) a Supplementary Statutory Declaration in Reply made by the same Marshall Brenner on 3 November 2023 (“ASD3”).

Proprietor’s evidence

11 The Proprietor’s evidence comprises a Statutory Declaration made by Chong Jee Siang, Director of the Proprietor, on 21 April 2023 (“PSD”).

Applicable law and burden of proof

12 The applicable law is the Act. There is no overall onus on the Proprietor before the Registrar during examination or in invalidation proceedings. The undisputed burden of proof in the present case falls on the Applicant.

Ground of invalidation under s 23(3)(a)(i) read with s 8(2)(b)

13 Section 23(3)(a)(i) of the Act reads:

23(3) The registration of a trade mark may be declared invalid on the ground —

(a) that there is an earlier trade mark in relation to which —

(i) the conditions set out in section 8(1) or (2) apply;

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

Section 8(2)(b) of the Act reads:

(2) A trade mark must not be registered if, because —

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

14 To succeed under this ground, the Applicant must establish that:

(a) the Subject Mark is similar to the Applicant's Mark;

(b) the Registered Goods are identical or similar to the goods and services for which the Applicant's Mark is registered; and

- (c) there exists a likelihood of confusion arising from the similarities in (a) and (b) above.

15 I will examine each of these elements in turn.

Similarity of marks

16 In assessing the marks for similarity, the applicable principles can be summarised as follows:

- (a) The marks are to be compared for visual, aural and conceptual similarities. There is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar. The ultimate question is whether the marks, when observed in totality, are similar rather than dissimilar (*Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”) at [17]-[18]).
- (b) Distinctiveness (in both its technical and non-technical senses) is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar (*Staywell* at [30]). More specifically, the greater the earlier mark’s technical distinctiveness, the higher the threshold before a competing mark is considered dissimilar to it (*Staywell* at [25]).
- (c) When assessing two contesting marks, it should be borne in mind that the average consumer has imperfect recollection. Therefore, the two marks should not be compared side by side or examined in detail for the sake of isolating particular points of difference because the person who is confused often makes a comparison from memory removed in time and space from the marks (*Hai Tong Co (Pte) Ltd v Ventree Singapore*

Pte Ltd [2013] 2 SLR 941 (“*Hai Tong*”) at [40(d)], [62(a)]). Ultimately, the matter is one of “the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.”

(d) The assessment of marks similarity is mark-for-mark, without consideration of any external matter (*Staywell* at [20]).

(e) The marks are to be compared “as a whole” (*Hai Tong* at [40(b)]). When speaking of the assessment of a mark as a whole, the similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (*Staywell* at [23], [26]).

17 I turn now to apply these general principles to the competing marks.

Visual similarity

18 A relevant consideration when assessing the similarity of marks is the distinctiveness of the earlier trade mark in question. The Applicant submits that “CROSSFIT” has a high level of technical distinctiveness, both inherent and acquired, and therefore enjoys a high threshold before the Subject Mark will be considered different to it.

19 On inherent technical distinctiveness, the Applicant’s case is that the Applicant’s Mark consists of a single conjoined word (although one made up of two English words, “CROSS” and “FIT”). The conjoined word is not a dictionary word. It is therefore an invented word and should be regarded as highly distinctive.

20 I do not agree. I do not consider that the conjoining of the words makes any material difference. The relevant public would still be able to recognise that the Applicant's Mark is made up of separate dictionary words.

21 The Applicant concedes that the words "CROSS" and "FIT" possess weak distinctive character given that they are common words². The Proprietor, however, contends that even as a whole, the Applicant's Mark has a low level of technical distinctiveness as it refers to "cross-discipline fitness". The Proprietor cites in support of its view ASD1 at [7] which states:

The Applicant's functional fitness content, also known as "high intensity interval training", was conceived as a programme that would incorporate movements from a wide variety of physical activities and disciplines such as gymnastics, athletics, and weightlifting.

22 I agree with the Proprietor that the Applicant's Mark has a low level of inherent technical distinctiveness. The Applicant's Mark is made up of words which are not just common words but also words which have descriptive connotations to the Applicant's goods and services. The word "CROSS" refers to a type of fitness workout which incorporates a variety of exercises known as "cross-training"³ while the word "FIT" describes the intended purpose of the service (to keep fit), or the intended use of the goods (clothing to be used when one is keeping fit). When conjoined, the suggestive connotation is still clear – the goods and services offered relate to cross-training to keep fit.

23 In relation to acquired technical distinctiveness, the Applicant tried to persuade me not to follow *VV Technology Pte Ltd v Twitter, Inc* [2023] 5 SLR

² Applicant's written submissions at [4.21].

³ ASD2 at [9(b)] mentions that "cross-training" is "the generic term for the type of interdisciplinary fitness training for which the Applicant's "CrossFit" brand is a market leader".

513 (“*Twitter*”) which held at [119(c)] that acquired technical distinctiveness should not be considered at the marks-similarity stage for reasons of precedent, principle and policy. However, the Applicant’s arguments for not following *Twitter* were fully considered by the High Court in *Twitter* itself and are not new. I do not see any reason to depart from *Twitter*. In any event, the High Court’s decision is binding on me.

24 I now compare the marks visually, bearing in mind that the Applicant’s Mark has a low level of inherent technical distinctiveness. For ease of reference only, still bearing in mind the principle at [16(c)] above that marks should not be compared side by side, the competing marks are:

Subject Mark	Applicant’s Mark
CrossFeet	CROSSFIT

25 The Applicant’s Mark is a plain word mark registered in plain block capital letters. Such a registration protects the word itself irrespective of font, typeface or design: *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] SGCA 56 (“*Sarika*”) at [24]-[25]. Therefore, the fact that the Applicant’s Mark is in capital letters and the Subject Mark, in title case, is not relevant.

26 The competing marks share the same structure. They both consist of a single conjoined word made up of two ordinary English words.

27 The Applicant’s Mark has no other elements or stylisation. This means that the overall impression lies in the conjoined word itself as neither the prefix nor the suffix may be said to be more outstanding or memorable than the other. As for the Subject Mark, the conjoined word is presented in a particular font, although the font is not so unusual that it falls outside the scope of protection

granted to the Applicant's Mark. Its overall impression also lies in the conjoined word with neither the prefix nor the suffix more dominant than the other.

28 The competing marks share the first word "CROSS", the letter "F" in the beginning of the second word, and the letter "T" at the end of the mark. In total there are seven letters in common between the marks, all in identical order. Having said that, this should not automatically lead to a finding that the marks are visually similar. At the end of the day, the exercise here is to determine the overall impression given by the mark on the consumer who does not spend too much time analysing the marks. Overall, I do not think that consumers are likely to overlook the presence of the word "Feet" in the Subject Mark. In my view, the roundedness of the "ee" letters gives visual prominence to the word "Feet" and ensures that it is not easily missed.

29 As for the length of the marks, the Applicant's Mark is eight letters long whereas the Subject Mark is nine letters long. One letter difference in length in marks of eight/nine letters is not particularly significant although the rounded "ee" letters may give the impression that the Subject Mark is longer.

30 Ultimately, having regard to all the above, I am of the view that the marks are visually more similar than dissimilar, and the degree of similarity is average.

Aural similarity

31 There are two possible approaches to assessing aural similarity: the first is to undertake the analysis by reference to the dominant components of the marks; whereas the second is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not (*Staywell* at [31]-[32]). In *Sarika*, the Court of Appeal at [30]-[31] also endorsed the consideration of "how an average Singaporean consumer would pronounce the

respective words" and the making of "allowances for imperfect recollection and careless pronunciation and speech".

32 Applying the dominant component approach, the Applicant submits that “CROSS” is the dominant element of both marks as this word is “the prefix, which is generally taken to be the most memorable element of a word mark”. This element is identical between the marks. Further the suffix of the marks, “FIT” and “Feet”, is aurally also very similar, as not just do they start and end with the same sound, but the vowel sound in between is also aurally similar.

33 As for the quantitative approach, the Applicant submits that both marks have two syllables each, with one syllable (“CROSS”) in common, and one syllable very similar. Taking into account slurring of the ends of words and careless pronunciation in the differentiating vowel sound, the marks are aurally very similar.

34 The Proprietor on the other hand, submits that both marks do not have a dominant component and that the quantitative approach is thus more appropriate for analysing the aural similarities between the marks. Under the quantitative approach, it is the Proprietor’s position that the marks are aurally dissimilar, or similar only to a low degree. While it agrees that the marks share an identical first syllable, it contends that the second syllable is unlikely to be mispronounced. This is because the word “FIT” has a short vowel sound whereas the word “Feet” has a long vowel sound.

35 I do not agree that the approach to determining the aurally dominant component of marks is as simple as the Applicant makes it out to be. It is to be recalled that in *Staywell*, “Regis” was found to be the dominant component of the marks “St Regis” and “Park Regis” even though it is not the first word of

either marks. In so concluding, the court took into account that “Regis” was technically distinctive in relation to hotels and hospitality services as well as distinctive in the non-technical sense because it is what will stand out in the imperfect recollection of the consumer. In the present case, I have found that the word “CROSS” is descriptive in relation to the Applicant’s goods and services, and that inherent technical distinctiveness of the Applicant’s Mark resides in the mark as a whole. In my view, neither “CROSS” nor “FIT” can be said to be the aurally dominant component of the Applicant’s Mark. Similarly, for “CrossFeet”. The dominant component approach therefore does not help the Applicant.

36 As for the quantitative approach, I agree with the Applicant that the marks have one syllable in common and one syllable similar. The syllable which is similar has the same beginning and end. They differ only in their middle. Taking into account imperfect recollection and careless pronunciation and speech, I find that the marks are aurally more similar than dissimilar, and the degree of similarity is above average.

Conceptual Similarity

37 Conceptual similarity is directed at the ideas that lie behind and inform the understanding of the mark as a whole (*Staywell* at [35]). These ideas must manifest in the look and feel of the mark, and not in something that is known only to the creator of the mark (*Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2015] 3 SLR 321 at [43]).

38 The Applicant submits at [4.24] of its written submissions:

... the common underlying concept of *both* the Applicant’s [Mark] and the Subject Mark, viewed as the total sum of their parts, is that which underpins the Applicant’s [Mark] – the

concept of a a (sic) “functional fitness”-based lifestyle brand, where the functional fitness methodology calls for a versatile range of movements that can be applied both across a wide discipline of sports and everyday tasks (as simple as picking up a pencil).

39 In so saying, the Applicant alleges, among other things:

(a) The Proprietor has repeatedly made reference to the Applicant’s “CROSSFIT” regime on its website;

(b) The Proprietor’s Instagram account states “Crossfeet socks are made with crossfitters in mind”, “Don’t buy our socks if you’re not a serious Crossfitter” and “Crossfit is our religion and we practice it peacefully”;

(c) The Proprietor’s website mentions “cross-training”, a generic term for the type of interdisciplinary fitness training for which the Applicant is known.

40 The Proprietor on the other hand takes the view that the marks are conceptually dissimilar. It elaborates at [42] of its written submissions:

... “CROSSFIT” is a descriptive reference to “cross-disciple (sic) fitness”. Even if the mark does not evoke ideas of exercise across multiple disciplines, it will at the very least call to the mind the idea of fitness or exercise. On the other hand, the term “CrossFeet” does not convey ideas or concepts relating to physical exercise and health pursuits. At most, the term “CrossFeet” evokes the idea of feet being in a crossed position. Ideas or concepts relating to physical exercise and health pursuits are present in the CROSSFIT Mark only by virtue of the word “FIT”, not the word “CROSS”.

41 I am of the view that the marks are conceptually different. The ideas that lie behind marks must manifest in the look and feel of the marks themselves and I should not consider matters which are extraneous to the marks such as the

parties' websites or social media accounts. On its own, the Subject Mark does not convey the idea of functional fitness (which the Applicant contends is the idea behind the Applicant's Mark) but rather, the idea of feet being in a crossed position.

Overall conclusion on marks-similarity

42 I have found that the Subject Mark and the Applicant's Mark are:

- (a) visually similar to an average degree;
- (b) aurally similar to an above average degree; and
- (c) conceptually dissimilar.

43 As recognised in *Staywell* at [18], trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry. The three aspects of similarity are but signposts meant to guide the inquiry and I must ultimately come to a conclusion whether the marks, when observed in their totality, are similar rather than dissimilar. This is inevitably a matter of impression, as the Court of Appeal in *Staywell* highlights (at [17]-[18]).

44 I am of the view that when observed in their totality, the conceptual differences between the marks will counteract their visual and aural similarities. As such, while the marks are more similar than dissimilar, the degree of similarity is average.

Similarity of goods and services

45 The second step of the three-step test in *Staywell* requires identity or similarity of goods to be established.

46 The Proprietor does not dispute that the Registered Goods are similar to the Applicant's Class 25 goods registered under Trade Mark No. T1215655B. However, it disagrees that the Registered Goods are similar to the Applicant's services in Class 41 (registered under Trade Mark No. T1215655B) and goods in Class 16 and Class 28 (registered under Trade Mark No. T1408504J).

47 In my view the Registered Goods and the Applicant's Class 25 goods are not merely similar but clearly overlap. Accordingly, the second step of the three-step test is met.

48 For reasons of procedural economy, I will not undertake a comparison between the Registered Goods and the Applicant's goods in Classes 16 and 28, and services in Class 41. Instead, I will first assess the invalidation in relation to the goods which are obviously identical to those covered by the Applicant's. If the invalidation fails where the goods are identical, it follows that it will also fail where the goods are only similar.

Likelihood of Confusion

49 The Court of Appeal in *Hai Tong* at [74] held that there are at least two specific aspects to the element of confusion. The first is where the consumer mistakes one mark for another. The second is where the relevant segment of the public may well perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies, and may perceive that goods or services of both marks emanate from the same source or from sources that are economically linked or associated. The Court of Appeal, nonetheless, recognised at [75] that confusion in the sense of "mere association" is not enough. This means that "it is not sufficient that the relevant segment of the public would recognise or recollect similarities between the contesting marks if there is no likelihood of confusion as to origin ensuing".

50 Further, in *Sarika*, the Court of Appeal said that the test to be adopted in determining likelihood of confusion is whether a substantial portion of the relevant public will be confused. In this regard, the Court of Appeal also said in *Sarika* at [57] that:

... the essence of this requirement is that there must not be an insubstantial number of the relevant public being confused. This standard is above *de minimis* and must be appreciable, though it is not necessary to show that a majority of the public is confused. It is insufficient, however, if only a “single member” of the relevant public is confused or if only a “very small and unobservant section” is confused ...

51 The Court of Appeal in *Staywell* at [96] listed the following factors as admissible in the confusion inquiry:

(a) Factors relating to the impact of marks-similarity on consumer perception: the degree of similarity of the marks themselves; the reputation of the marks; the impression given by the marks; and the possibility of imperfect recollection of the marks.

(b) Factors relating to the impact of the goods or services-similarity on consumer perception: the normal way in or the circumstances under which consumers would purchase the goods or services of that type; whether the goods or services in question are expensive or inexpensive items; the nature of the goods or services, and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective consumers; and the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase.

52 The average consumer of the goods are members of the general public and businesses. The cost of the goods is likely to vary – though they are not very

expensive, they are not cheap either. The goods are likely to be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process for the goods, such as materials used, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

53 The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or a catalogue. This means that visual considerations will be the most significant. I do not, however, discount that there will also be an aural component to the purchase of the goods, as advice may be sought from a sales assistant or representative and word-of-mouth recommendations may play a part.

54 Taking all of the above into account, and even bearing in mind the principle of imperfect recollection, I do not see how consumers would misremember or inaccurately recall the marks as each other. The marks concerned here evoke clear and specific concepts which can be grasped immediately by consumers. “Cross”, “Fit” and “Feet” are not difficult or invented words. Consequently, I do not consider that the average consumer would overlook the “ee”/“I” in the middle of the suffixes of the marks, especially as the effect is to provide a significant and distinct conceptual hook to assist in differentiating between the marks. I do not consider there to be a likelihood of direct confusion.

55 I now consider the likelihood of indirect confusion.

56 First, indirect confusion might arise where the common element is so strikingly distinctive that the average consumer would assume that no-one else,

but the brand owner, would be using it. In this instance, the common element between the marks is the word “CROSS”. The Applicant conceded that this element being a common English word possesses weak distinctive character. I agree and I earlier found that the distinctiveness of the Applicant’s Mark lies in the conjoined word. Indirect confusion based on this reason is therefore not likely.

57 Secondly, indirect confusion may occur when the later mark simply adds a non-distinctive element to the earlier mark. For this to be satisfied, the Applicant’s Mark as a whole would need to be reproduced, with an addition of a non-distinctive element. It is not. Further, the addition of “Feet” to “CROSS” cannot be said to be non-distinctive as combined in this way, “CROSS” loses its significance as a reference to cross-training and a new unitary meaning is created (feet which are crossed). Indirect confusion on this basis is also not satisfied.

58 Thirdly, indirect confusion may also occur where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. In this case, both marks start with the word “CROSS”. Therefore, it has to be determined whether changing the suffix from “FIT” to “Feet” is a logical brand extension. I do not consider that it is. This is because “CROSS” combined with “Feet” creates a new unitary meaning. I do not consider that the average consumer would think the Applicant’s goods originate from the Proprietor or vice versa because of the clear and distinct conceptual difference separating the marks as wholes. These are clearly not natural variants or brand extensions of each other. This type of indirect confusion is not likely to occur.

59 I bear in mind that the three examples above are not exhaustive. However, I do not consider that there are any other logical examples of how the Applicant's Mark could be indirectly confused with the Subject Mark and the Applicant has not suggested any. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. Consequently, I consider that there is no likelihood of indirect confusion.

Conclusion on s 23(3)(a)(i) read with s 8(2)(b)

60 The ground of invalidation under Section 23(3)(a)(i) read with Section 8(2)(b) therefore fails.

Grounds of invalidation under s 23(3)(a) read with s 8(4)(b)(i) and s 8(4)(a), s 23(3)(a)(iii) read with s 8(4)(b)(ii)(A) and s 23(3)(a)(iii) read with s 8(4)(b)(ii)(B) of the Act

61 The relevant provisions are:

23.—(3) The registration of a trade mark may be declared invalid on the ground —

(a) that there is an earlier trade mark in relation to which

(iii) where the trade mark has been registered pursuant to an application for registration of the trade mark made on or after 1st July 2004, the conditions set out in section 8(4) apply;

Section 8(4) of the Act reads:

8(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered –

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark;

(ii) if the earlier trade mark is well known to the public at large in Singapore —

(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

(B) would take unfair advantage of the distinctive character of the earlier trade mark.

Section 2(1) of the Act, in relation to “well known trade mark”, reads:

“well known trade mark” means —

(a) any registered trade mark that is well known in Singapore; or

(b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —

(i) is a national of a Convention country; or

(ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore;

Section 2(7) to (9) of the Act reads:

(7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it is relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

(a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;

(b) the duration, extent and geographical area of —

- (i) any use of the trade mark; or
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
 - (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
 - (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
 - (e) any value associated with the trade mark.
- (8) Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark is deemed to be well known in Singapore.
- (9) In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:
- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;
 - (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;
 - (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

62 Section 8(4)(b)(i) relates to marks that are well known in Singapore, whereas s 8(4)(b)(ii)(A) and s 8(4)(b)(ii)(B) relate to marks that are well known to the public at large in Singapore. Since a mark that is not well known in Singapore cannot be well known to the public at large in Singapore, if the Applicant is unable to establish that the Applicant’s Mark is well known in Singapore, the invalidation on all three grounds will fail. I will therefore deal with this element first.

Whether the Applicant's Mark is well known in Singapore

63 The Applicant submits that the relevant sector of the public the Applicant's Mark is well known to are "people in Singapore who practise high-intensity interval training and other forms of physical training". In support of its contention, it submits as follows.

64 The Applicant's Mark was first conceived as "Cross-Fit" as early as 1985 and has been used – first in the United States – since 1985.

65 As of 12 October 2022, the Applicant had 11 affiliates across 12 gyms in Singapore as listed below:

CrossFit Hub	44 Pasir Panjang Road, S(118504)
CrossFit Enduro	502 Serangoon Road, S(218212)
CrossFit Unit	1 Stadium Place, #02-05 Kallang Wave Mall, S(397628)
CrossFit Mobilus Clarke Quay	20 Upper Circular Road, The Riverwalk, #B1-10/16, S(058416)
CrossFit Mobilus Chinatown	90 Eu Tong Sen Street, Block C #01-11, S(059811)
Innervate CrossFit	398 Race Course Road, S(218651)
Actualize CrossFit	251 Jalan Besar, S(208924)
CrossFit Urban Edge	12 Bukit Pasoh Road, S(089826)
CrossFit Morpheus	812 Upper Bukit Timah Road, S(678146)
Battlefront CrossFit	118 Pasir Panjang Road, S(118541)
Pom Pi Pi CrossFit	69 Circular Road, S(049423)
WAO CrossFit	200 Turf Club Road, S(287994)

66 The Applicant keeps its revenue figures strictly confidential. Most of the promotion of its goods and services is also carried out by its affiliates. However, with a few exceptions, each CrossFit-affiliated gym pays US\$3,000 per year to be allowed to be called an affiliate.

67 In 2007, the Applicant began operating the "CrossFit Games" event, an athletic competition where participants compete to complete various workouts

programmed by the Applicant and to earn the coveted title of “Fittest on Earth”. From 2010 to 2020, the Applicant’s Mark was used on apparel in collaboration with Reebok.

68 As of September 2022, the Applicant’s Facebook page has over 3 million people who “like” the page while “The CrossFit Games” Facebook page has over 4.1 million followers and over 2.5 million people who “like” the page. In addition, the Applicant’s Instagram page has over 956,000 followers, while the “CrossFit Games” Instagram page has over 1.6 million followers.

69 The Applicant’s website, <https://www.crossfit.com>, is accessible in Singapore. The Applicant’s fitness training services have been featured in articles by mainstream media in Singapore, such as:

- (a) CNA Insider, on 20 February 2022⁴
- (b) The Straits Times, on 15 May 2018⁵
- (c) CNA Lifestyle, on 11 June 2019⁶
- (d) CNA Lifestyle, on 5 March 2023⁷

70 The Applicant’s Mark has been mentioned and/or reported on favourably in various publications of international recognition and reach, including The New York Times, USA Today, Time Magazine, Newsweek Magazine, and Cosmopolitan, among others. The results of the CrossFit Games

⁴ ASD2 at page 19.

⁵ ASD2 at page 31.

⁶ ASD2 at page 35.

⁷ ASD2 at page 45.

are also reported on major publications such as Men’s Health and Muscle & Fitness, among others.

71 The business model of the Applicant has been well-documented and studied over the years, even in academic papers for business studies.

72 The Applicant’s Mark has been successfully registered in the United States, the United Kingdom, Australia, China, the European Union, France, Germany, India, Japan, Israel, Korea, Kuwait, Sri Lanka, Switzerland, and the United Arab Emirates, with the first record of use in commerce being as early as 1985 in the United States, and registrations dating back as early as 2003.

73 The Applicant’s Mark was found to be well known by:

(a) the United Kingdom’s Intellectual Property Office in the case of O-853-22, an opposition by the Applicant against the mark “BOSSFIT HEALTH CLUBS ESTD 2020”.

(b) the Indian Trademark Office in the case of *CrossFit Inc v. Gurpeet Singh and Anr* (CS (OS) 2114 of 2014), an opposition by the Applicant against the trade mark “KROSSFIT”.

(c) the United States Patent and Trademark Office Trial and Appeal Board, in the case of *CrossFit, Inc. v. Haeusler*, Opposition No. 91220565 (T.T.A.B. 2018), an opposition by the Applicant against the trade mark “CROSSBOX”.

My decision: The Applicant's Mark is not well known in Singapore as at the Relevant Date

74 The Relevant Date for determining whether the Applicant's Mark is well known in Singapore is 10 June 2019, the date the Proprietor applied to register the Subject Mark.

75 Although the Applicant's evidence is clear that it had by 2022, 11 CrossFit affiliates across 12 gyms in Singapore, it is totally silent as to the number of gyms it had in Singapore as of the Relevant Date. Further, the Applicant did not disclose the date the Applicant's Mark was first used in Singapore and the length of operation of each of the gyms in Singapore. No evidence was also given of the membership numbers in each gym, the activities undertaken to promote the Applicant's Mark in Singapore, or the Applicant's market share in Singapore. For the avoidance of doubt, I have examined The Straits Times article referred to in [69(b)] and the CNA Lifestyle article referred to in [69(c)] (dated just one day after the Relevant Date) but I do not consider that they take the Applicant's case much further. Whilst the articles mention Innervate Fitness and CrossFit Fire City (not listed above as one of the Applicant's gyms), respectively, "CrossFit" on its own is not referred to in a trade mark sense but as a "strength and conditioning workout" and "another popular workout".

76 The Applicant's evidence falls short of showing whether, how and to what extent it impacts the relevant sector of the public in Singapore such that the Applicant's Mark is well known to it at the Relevant Date.

Conclusion on s 23(3)(a) read with s 8(4)(b)(i) and s 8(4)(a), s 23(3)(a)(iii) read with s 8(4)(b)(ii)(A) and s 23(3)(a)(iii) read with s 8(4)(b)(ii)(B) of the Act

77 The grounds of invalidation under s 23(3)(a) read with s 8(4)(b)(i) and s 8(4)(a), s 23(3)(a)(iii) read with s 8(4)(b)(ii)(A), and s 23(3)(a)(iii) read with s 8(4)(b)(ii)(B) of the Act fails.

Ground of invalidation under s 23(3)(b) read with s 8(7)(a)

78 Section 23(3)(b) of the Act reads:

(3) The registration of a trade mark may be declared invalid on the ground —

(b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

79 Section 8(7)(a) of the Act reads:

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade;

80 It is not disputed that to succeed on this ground, the Applicant has to prove the "classical trinity of goodwill, misrepresentation and damage" (*Staywell* at [130]).

Goodwill

81 The Proprietor does not dispute that the Applicant has goodwill in Singapore.

Misrepresentation

82 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 provided the following guidance in relation to determining misrepresentation in an action for passing off:

[38] In our judgment, the issue of distinctiveness is best understood as a threshold inquiry in the context of determining whether the defendant has committed an actionable misrepresentation. Simply put, if a mark or get-up is not distinctive of the plaintiff's products or services, the mere fact that the defendant has used something similar or even identical in marketing and selling its products or services would not amount to a misrepresentation that the defendant's products or services are the plaintiff's or are economically linked to the plaintiff ...

...

[40] ... The misrepresentation in question must give rise to confusion (or the likelihood thereof) in order to be actionable under the law of passing off. This is ultimately a matter for the court's judgment and it is not to be determined on a visual side-by-side comparison. Rather it is to be assessed from the vantage point of a notional customer with imperfect recollection.

83 I have earlier found, in the context of the claim under Section 8(2)(b) of the Act, that there is no likelihood of confusion between the competing marks. It therefore follows that there cannot be any misrepresentation that is sufficiently likely to deceive the public into thinking that the Proprietor's goods and services are those of the Applicant's. As misrepresentation which is an essential component under the ground of passing off has not been established, it is not necessary for me to assess the element of damage.

Conclusion on s 23(3)(b) read with s 8(7)(a)

84 The ground of invalidation under s 23(3)(b) read with s 8(7)(a) fails.

Overall conclusion

85 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the application for a declaration of invalidity fails on all grounds.

86 I have considered the parties' submissions on costs and, having regard to all the circumstances, award the Proprietor the sum of S\$8,045.00 (inclusive of disbursements).

Tan Mei Lin
Principal Assistant Registrar

Suhaimi Lazim and Jin WenRui (Mirandah Law LLP) for the
Applicant;
Gillian Tan and Michael Yee (That.Legal LLC) for the
Proprietor.