

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
December 6, 2017

Mailed:
January 2, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
—

CrossFit, Inc.

v.

Haeusler
—

Opposition No. 91220565
—

Joel R. Feldman of Greenberg Traurig LLP for CrossFit, Inc.

Jeffrey M. Furr, Esq. for Ralph Haeusler.
—

Before Zervas, Cataldo, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Ralph Haeusler (“Applicant”) filed an application¹ to register on the Principal Register the mark CROSSBOX in standard characters for the following goods and services:

Belts; Bottoms; Caps; Cloth bibs; Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Drawers; Dusters; Eyeshades; Footwear; Gloves as clothing; Hats; Head wraps; Headbands for clothing;

¹ Application Serial No. No. 86369676, filed on August 18, 2014 on the basis of Applicant’s allegation of a *bona fide* intention to use the mark in commerce, under Trademark Act Section 1(b), 15 U.S.C. 1051(b).

Hoods; Jackets; Jerseys; Mufflers; Pajamas; Ponchos; Shifts; Short sets; Shoulder wraps; Sports caps and hats; Sports shoes; Ties; Tops; Underwear; Wristbands, in International Class 25;

Bread and buns; Bread and pastry; Coffee and tea; Ices and ice creams; Sugar and sugar substitutes, in International Class 30;

Conducting of sports competitions; Organization of cultural shows; Organization of sports competitions; Organizing and hosting of events for cultural purposes; Organizing community festivals featuring a variety of activities, namely, sporting events, art exhibitions, flea markets, ethnic dances and the like; Organizing community sporting and cultural events; Organizing cultural and arts events, in International Class 41.

CrossFit, Inc. (“Opposer”) has opposed registration of the mark on the ground that it so resembles Opposer’s earlier used and registered mark CROSSFIT as to be likely to cause confusion, mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); and on the ground that Applicant lacked a *bona fide* intention to use the mark in regulable commerce in connection with the identified goods and services at the time Applicant filed his application, rendering the application void *ab initio*.² Applicant denied the salient allegations of the notice of opposition.³

Opposer filed a motion for summary judgment on the issue of lack of *bona fide* intention, and Applicant cross-moved for summary judgment on the issue of likelihood of confusion. The Board denied both motions.⁴ The parties then stipulated

² Amended notice of opposition, 14 TTABVUE 10-34.

³ Amended answer, 18 TTABVUE.

⁴ 21 TTABVUE.

to resolve the case by means of accelerated case resolution, whereby they would submit the case to the Board for final decision on a record consisting of the full record of their previously-filed motions for summary judgment supplemented by final briefs on the case and supplemental declarations, affidavits, and exhibits, to be submitted according to a stipulated briefing schedule.⁵ The parties submitted, with their briefs and motions, the following declarations, with attached exhibits:

For Opposer:

Declaration of Mary Martha Adkins (paralegal for Greenberg Traurig LLP) (15 TTABVUE 13-70);

Supplemental Declaration of Mary Martha Adkins (20 TTABVUE 16-21);

Declaration of Greg Glassman (co-founder of Opposer) (26 TTABVUE 28-74);

Declaration of Alexandra Holt (attorney for Greenberg Traurig LLP) (26 TTABVUE 75-272);

Declaration of Matt Holdsworth (Chief Financial Officer of Opposer) (26 TTABVUE 273-278);

Declaration of Ben Elizer (Chief Information Officer of Opposer) (26 TTABVUE 279-281);

Declaration of Craig Thornton (Vice President Finance of Reebok International, Ltd.) (26 TTABVUE 282-284);

Declaration of Kristen Fortin (Senior Manager, Brand Management-Training of Reebok International, Ltd.) (26 TTABVUE 285-294);

⁵ The Board commends the parties for their utilization of ACR and the efficiencies realized thereby.

Declaration of Justin Bergh (CrossFit Games General Manager of Opposer) (26 TTABVUE 295-297).⁶

For Applicant:

Declaration of Ralph Haeusler (Applicant) (19 TTABVUE 19-20);

Declaration of Jeffrey Furr (Applicant's counsel) (19 TTABVUE 45-46, exhibits at 21-43).

The record also includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the application file for the opposed mark. An oral hearing was held on December 6, 2017 at which both parties were represented.

I. Standing.

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). The plaintiff must show that it has a real interest in the proceeding beyond that of a mere intermeddler and that it has a reasonable basis for its belief of damage resulting from registration of the subject mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Opposer has pleaded and proven⁷ that it owns the following subsisting U.S. registrations, all relating to the mark CROSSFIT in standard characters and listing, respectively, the goods and services shown below:

⁶ Non-confidential versions of the Glassman, Holt, Holdsworth, Elizer, Thornton, Fortin and Bergh declarations are available at 27 TTABVUE.

⁷ Opposer filed with its amended notice of opposition current printouts of information from the electronic database records of the USPTO showing the status and title of the registrations. 14 TTABVUE 16-34. All of the pleaded registrations are subsisting. Reg. No.

- 3007458 Fitness training, in International Class 41.
- 4049689 Entertainment services, namely, an on-going series featuring fitness, nutrition, sports and exercise provided through television, internet; providing information in the fields of fitness, sports and exercise via a website; online publication of journals in the fields of fitness, nutrition, sports and exercise; entertainment services, namely, providing podcasts in the fields of fitness, nutrition, sports and exercise; educational services, namely, conducting lectures, seminars and workshops 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, in International Class 41.
- Providing information in the field of nutrition via a website, in International Class 44.
- 3826111 Clothing, namely, shirts, pants, shorts, jackets, sweatshirts, sweatpants, headwear, socks, in International Class 25.
- 4122681 Footwear, in International Class 25.

Opposer also submitted evidence to show that Opposer and others use the term BOX to refer to Opposer's fitness training facilities.⁸ Opposer has shown that it has a real interest in this proceeding and a reasonable basis for its belief that it will be damaged by registration of Applicant's mark, and has established its standing to oppose registration of Applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Ritchie v. Simpson*, 50 USPQ2d at

300758 has been renewed. Opposer has filed Section 8 and Section 15 affidavits with respect to Reg. Nos. 3826111 and 4049689.

⁸ *See, e.g.*, Glassman dec. ¶¶ 17-18 and Exhibit 3, 26 TTABVUE 30, 53; *see also* 26 TTABVUE 105 and 126.

1025-6; and *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

II. Petitioner's claim under Section 2(d).

Petitioner opposes registration of Applicant's mark under Trademark Act § 2(d), on the ground that Applicant's mark "so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by [Opposer] and not abandoned, as to be likely, when used on or in connection with the goods [and services] of [Applicant], to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). In view of Opposer's ownership of valid and subsisting registrations of its mark CROSSFIT, priority is not in issue with respect to the mark and the goods and services identified in the registrations. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

A. The fame of Opposer's mark.

We will first address Opposer's contention that its mark CROSSFIT is famous "for at least fitness training and education, clothing and footwear, and sports competitions."⁹ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. A famous mark has

⁹ Opposer's brief at 10, 26 TTABVUE 11.

extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). For purposes of analysis of likelihood of confusion, fame is not an “all-or-nothing factor”; rather, it “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted). Fame is “determined from the viewpoint of consumers of like products,” and not from the viewpoint of the general public. *Id.* at 1735. Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

To demonstrate the fame of its mark, Opposer has disclosed (confidentially) pertinent financial performance data. These include, for the years 2010 through 2016, annual licensing revenues; total revenues from registration fees for CROSSFIT-branded seminars in the U.S.; combined licensing royalties and sponsorship payments from Reebok International, Ltd. (“Reebok”) relating to crossbranding of footwear and apparel; annual revenues from all other sponsorships; ticket sales for the CrossFit Games; and advertising and promotional expenditures.¹⁰

¹⁰ Holdsworth dec., 26 TTABVUE 273-278.

Also of record for the years 2010-2016 are the annual number of visits to Opposer's CrossFit.com website, annual number of subscribers to CROSSFIT JOURNAL and annual downloads of CROSSFIT JOURNAL; and, as of 2017, the number of followers Opposer has on Facebook (2,806,217), Twitter (903,000), and Instagram (1,900,000), and the number of its YouTube subscribers (1,034,869).¹¹

Opposer showed that it has hosted an athletic event called CrossFit Games¹² annually since 2007; and provided, for the years 2011-2017, the annual number of individuals seeking to qualify for related regional contests at U.S. locations (*e.g.*, 387,745 in 2017); and for 2011-2016, the number of impressions from ESPN broadcasts of the CrossFit Games.¹³

Opposer submitted the declaration of the Vice President Finance of Reebok, setting forth the number of units and the value of Reebok's sales of CROSSFIT branded clothing, headwear, and footwear annually for the period 2011-2016, as well as similar figures for clothing, footwear, and headwear separately.¹⁴ Reebok's Senior Manager, Brand Management-Training testified as to the annual number of non-unique visits to the Reebok/CrossFit Website for 2015-2017; and the number of subscribers to Reebok's mailing list for information on CROSSFIT-branded clothing, footwear, and headwear. She provided samples of cross-branded advertising; and

¹¹ Elizer dec., 26 TTABVUE 279-281.

¹² TIME magazine described the CrossFit games as a competition for the title of "Fittest on Earth" that is "sponsored by Reebok and broadcast on ESPN." Sean Gregory, *Lift Squat Repeat*, TIME, January 20, 2014 at 42. 26 TTABVUE 98.

¹³ Bergh dec., 26 TTABVUE 295-297.

¹⁴ Thornton dec., 26 TABVUE 282-284.

testified as to the amount that Reebok spent between 2011 and 2017 in marketing, promoting, and advertising Reebok's CROSSFIT-branded clothing, footwear, and headwear. She also identified online addresses of unsolicited media coverage for those goods.¹⁵

Press notices of record show that Opposer's business has been the subject of articles in TIME magazine (January 20, 2014);¹⁶ INC. magazine (July/August 2013);¹⁷ MUSCLE & PERFORMANCE (May 2012);¹⁸ OXYGEN (October 2012);¹⁹ and FORBES (February 2015);²⁰ and has been mentioned in other press notices of record.²¹ FORBES magazine listed CROSSFIT among "The 25 Most Innovative Consumer Brands of 2016."²² Opposer's principal and Opposer's business were the subject of a "60 Minutes" interview, aired May 10, 2015, which referred to Opposer's business as "the biggest fitness phenomenon in the world right now."²³ Opposer has shown that a 2016 episode of the television game show Jeopardy! included the question "This workout regimen that has trademarked 'sport of fitness' calls its gyms 'boxes';"²⁴ and that in the NEW YORK TIMES crossword puzzle of April 26, 2016, "CROSSFIT" was the answer

¹⁵ Fortin dec., 26 TTABVUE 285-294.

¹⁶ "Lift Squat Repeat," 26 TTABVUE 95-100.

¹⁷ "Do Not Cross CrossFit," 26 TTABVUE 102-109.

¹⁸ "The Sport of Fitness," 26 TTABVUE 114-123.

¹⁹ "Break Through Your Comfort Zone," 26 TTABVUE 125-130.

²⁰ "How CrossFit Became A \$4 Billion Brand," 26 TTABVUE 205-6.

²¹ 26 TTABVUE 111-12, 132, 208-239, 256-264, 270-272.

²² 26 TTABVUE 194-203.

²³ "King of CrossFit," 26 TTABVUE 82-93.

²⁴ 26 TABVUE 241.

to the clue “Popular strength-training program.”²⁵ Opposer’s business has also been discussed in several nonfiction books;²⁶ and is mentioned in a fiction book.²⁷

After careful consideration of the evidence of record, we find that Opposer has demonstrated a high public profile among customers for fitness training services, constituting a substantial degree of renown throughout the United States, although not the highest degree of fame.²⁸ In the field of footwear, Opposer has demonstrated a moderate degree of renown. Although little of the evidence of record is relevant to establish fame or renown in the field of food products, we acknowledge that there is substantial overlap between the class of customers for food and the class of customers for fitness training services. As we discuss below, Opposer has promoted principles of good nutrition as an adjunct to its fitness services. We believe Opposer’s renown in the field of fitness is sufficient to have some impact upon Opposer’s public profile among customers of food. To these varying degrees, Opposer’s high public profile enhances the likelihood that customers would perceive a trademark similar to CROSSFIT as being associated with Opposer.

²⁵ 26 TTABVUE 246-248.

²⁶ Betsy Pake, “Start Small Live Big”; Kory Kogon et al., “The 5 Choices”; Stephen Madden, “Embrace the Suck”; J.C. Herz, “Learning to Breathe Fire”; and T. J. Murphy, “Inside the Box.” See 26 TTABVUE 134-162.

²⁷ Alexi Venice, “Margaret River Winery,” 26 TTABVUE 164-166.

²⁸ Cf. *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012) (“sufficient public recognition and renown” may demonstrate that a mark is strong for likelihood of confusion purposes); *Southwestern Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1027 (TTAB 2015) (“[E]ven though EFOL’s DELMONICO mark may not be truly famous, it enjoys a very substantial degree of renown throughout much of the United States.”).

B. The goods and services.

We turn next to the similarity or dissimilarity of the goods and services at issue, as identified in the Applicant's application and Opposer's pleaded registrations. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014); *Octocom Syst. Inc. v. Houston Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). "When analyzing the similarity of the goods [and services], it is not necessary that the products of the parties be similar or even competitive to support a finding of likelihood of confusion. Instead, likelihood of confusion can be found if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (internal quotation marks and citations omitted).

Considering first Applicant's goods in International Class 25, we see that the application and one or more of the pleaded registrations cover "footwear" and "jackets"; that Opposer's "shirts, pants" are identified with sufficient breadth to include within their scope Applicant's more narrowly identified "Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, ... shirts, pants ..."; and that Opposer's "headwear" includes within its scope Applicant's "Caps; ... Hats; Head wraps; Headbands for clothing; ... Sports caps and hats ...". Therefore, Applicant's goods in Class 25 are, in part, identical to goods for which Opposer has registered its mark. We need not consider whether each of Applicant's

identified goods is related to Opposer's goods; for purposes of a *du Pont* analysis, it is sufficient if likelihood of confusion is found with respect to any of Applicant's goods in a given International Class. *See Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Comput. v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Turning to Applicant's services in Class 41, we note that they include:

Conducting of sports competitions; ... Organization of sports competitions; ... Organizing community festivals featuring a variety of activities, namely, sporting events, ... Organizing community sporting and cultural events; ...

One of Opposer's pleaded registrations lists "entertainment in the nature of sports competitions." We find Applicant's Class 41 services identified above to be legally identical to these services of Opposer. Again, we need not consider whether each of Applicant's services in Class 41 is related to Opposer's services. *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 209 USPQ at 988.

Finally, we consider Applicant's Class 30 goods, which are food items. Opposer has no registration for foods of any kind, but has registered its mark for "providing information in the field of nutrition via a website," as well as the following services:

Entertainment services, namely, an on-going series featuring ... nutrition ... provided through television, internet; ... online publication of journals in the fields of ... nutrition ...; entertainment services, namely, providing podcasts in the fields of ... nutrition ...; educational services, namely, conducting lectures, seminars and workshops in the fields of ... nutrition ...²⁹

²⁹ Reg. No. 4049689.

Opposer offers its nutrition information services in association with its primary services, which are fitness training services offered through licensed facilities.

Opposer argues:

[Opposer's nutrition] principles popularized the so-called "paleo" diet ... As the CROSSFIT brand became more popular, so did the paleo diet, and a cottage industry emerged of "paleo-friendly" foods and recipes. Some of these foods and recipes resembled processed foods like bread, but were composed of ingredients largely consistent with the paleo diet.³⁰

Opposer argued at oral hearing that any fitness trainer would discuss diet and nutrition with his or her client. Opposer has submitted a copy of the May 2004 issue of its online publication THE CROSSFIT JOURNAL, which provides editorial advice regarding nutrition, quantified guidance regarding meal plans (broken down by over 200 individual food items), and approximately 100 menus for breakfast, lunch, dinner, and snacks.³¹ The charts and meal plans are introduced as follows:

Diet is critical to optimizing human function ...

For a decade we've experimented with sizing and portioning strategies that avoid scales, and measuring cups and spoons only to conclude that natural variances in caloric intake and macronutrient composition without measurement are greater than the resolution required to turn good performance to great. Life would be much easier for us were this not so!

The "meal plans" and "block chart" below have been our most expedient approach for eliciting the Zone's best offering in athletes.

³⁰ Opposer's brief on the case at 7, 26 TTABVUE 8.

³¹ 26 TTABVUE 168-177.

Void of theoretical or technical content this portal to sound nutrition still requires some basic arithmetic and weighing and measuring portions for the first week.³²

A “60 Minutes” interview with Opposer’s principal Greg Glassman included the following observations:

Greg Glassman: I invented that doing lateral raises and curls while eating pretzels is dumb. That’s what I invented.

He says for decades gym owners have ignored the importance of diet and been all too happy to watch their members fall into a trance on the treadmill.

...

To keep their energy up, they’re encouraged to follow something called a Paleo diet: heavy on meat and vegetables – food fit for a caveman.³³

Opposer’s Chief Financial Officer also testified as follows:

In connection with its annual CrossFit Games fitness competition, companies purchase sponsorships from [Opposer] in order to advertise their goods and services and have their goods and services associated with the CROSSFIT brand and the CrossFit Games. Sponsors of the CrossFit Games have included producers of food products such as protein powder and protein bars and producers of beverages, such as post-workout recovery drinks.³⁴

Opposer points out that Applicant has described the food aspect of its business as providing “healthy food for sporty people ...”³⁵ Applicant argues that Opposer does not offer any goods similar to his food products, and that none of his goods are

³² 26 TTABVUE 168.

³³ Opposer’s brief on the case, “The King of CrossFit,” May 10, 2015, 26 TTABVUE 85.

³⁴ Holdsworth dec. ¶ 45, 26 TTABVUE 276.

³⁵ Applicant’s response to Interrogatory No. 1, 15 TTABVUE 38.

particularly adapted for fitness training.³⁶ He argues that all of Opposer's goods and services are related to fitness and are offered in this "specific market."³⁷

Opposer does not, itself, offer food products. However, Opposer has shown that it has promoted the importance of a proper diet to customers of its fitness training services, and has registered its mark for providing information in the field of nutrition. We find the evidence sufficient to show that food products of the kind set forth in Applicant's identification of goods are commercially related to Opposer's fitness training and nutrition information services.

In sum, we find that the *du Pont* factor of the similarity or dissimilarity of the goods and services favors a finding of likelihood of confusion with respect to all three classes of Applicant's goods and services.

C. Trade channels; customers.

We have found the parties' goods in Class 25 to be identical in part; and we have found their services in Class 41 to be legally identical in part. With respect to those identical goods and services, we must presume that the channels of trade and classes of customers are the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). The customers for clothing and for entertainment in the form of sports competitions include ordinary consumers.

³⁶ Applicant's brief on the case at 6, 28 TTABVUE 7.

³⁷ *Id.* at 7, 28 TTABVUE 8.

There is no substantial evidence to show that food products and fitness services travel through the same trade channels. However, it is undeniable that there is an overlap of the customer classes for those goods and services. Applicant's foods, especially its bread, coffee, tea, sugar and sugar substitutes, are common consumer items of nearly universal appeal, and would very likely be of interest to customers of fitness training. Indeed, Opposer, in its CROSSFIT JOURNAL, has provided advice regarding the inclusion of "Grains and Breads" in one's diet.³⁸ Opposer has also submitted an article showing that persons interested in a "paleo" diet have an interest in sugar substitutes.³⁹

Thus, with respect to Applicant's goods and services in Classes 25 and 41, we regard the parties' trade channels and customers as identical. With respect to Applicant's goods in Class 30, the customer class overlaps with the customers of Opposer's fitness training services.

D. The marks.

Next we consider the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely

³⁸ *See* 26 TTABVUE 171.

³⁹ "Paleo Sweeteners 101," posted on <paleoplan.com>, 26 TTABVUE 187-190.

to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721 (internal quotation marks omitted).

The marks are similar in appearance and sound inasmuch as the initial component of each of them is CROSS-. The CROSS- component is also likely to be perceived as conveying the same meaning or connotation in each mark. Opposer, in its brief, argues that CROSS means “a mixture or hybrid of two or more things;”⁴⁰ and at oral hearing, Opposer’s counsel confirmed that CROSS refers to a combination of athletic disciplines. We note that the athletic shoe that Opposer markets, through Reebok, under the mark CROSSFIT NANO 7 is described as a “cross-trainer.”⁴¹ Applicant has not proposed an alternative meaning, other than to argue, at oral hearing, that Applicant’s entire mark CROSSBOX is a meaningless coinage. In any event, it is likely that customers would perceive CROSS- to have the same meaning or connotation both in the context of Opposer’s fitness training services and apparel, and in the context of Applicant’s sports competitions and apparel (including Applicant’s “Sports shoes”).

The parties’ marks differ in appearance and sound by virtue of their second, final syllables, which are -BOX and -FIT, respectively. Applicant argues also that the marks, in their entirety “have very different meanings and connotations” because of the different meanings of “box” and “fit.”⁴² “The Opposer’s mark has the word fit

⁴⁰ Opposer’s brief at 6, 26 TTABVUE 7.

⁴¹ 26 TTABVUE 266.

⁴² Applicant’s brief on the case at 5, 28 TTABVUE 6.

in it which suggests that it deals with fitness in nature while the Applicant' mark does not. ... When considered in its entirety, CROSSFIT has a different connotation from Applicant's mark because the highly distinctive word fit denotes specifically the idea of fitness."⁴³ Applicant has not proposed an interpretation of the meaning or connotation of his own mark.

Despite the facial differences between the marks, Opposer argues:

CROSSFIT and CROSSBOX are similar in meaning and commercial impression. This is because the word 'cross' has an identical meaning in both marks – a mixture or hybrid of two or more things. Although 'box' and 'fit' have different dictionary meanings, their commercial impressions are closely related because the term 'box' is a term of art, when used in connection with the CROSSFIT brand. [Footnote omitted.] Because a CROSSFIT box is a place where CROSSFIT-branded strength and conditioning is offered, CROSSBOX has a similar commercial impression to the term 'CROSSFIT box.'⁴⁴

Opposer explains that it offers its fitness training services through licensed affiliates, whose facilities are known as "boxes" or "CrossFit boxes."⁴⁵ Opposer's principal testified as follows:

The term "box" is a term of art, when used in connection with the CROSSFIT brand, to refer to any blank space, including industrial space, storage lockers, and barns, suitable for outfitting with equipment for CROSSFIT-branded strength and conditioning training. A basic tenet of CrossFit affiliate success is that industrial space is better than retail space because industrial space is

⁴³ Applicant's summary judgment brief at 12, 19 TTABVUE 13.

⁴⁴ Opposer's brief at 6, 26 TTABVUE 7.

⁴⁵ *Id.* at 2, 26 TTABVUE 3. *See also* Glassman dec. ¶ 17, 26 TTABVUE 30.

cheaper, has higher ceilings, comes with roll-up doors and is generally superior to commercial retail space.⁴⁶

Opposer submitted evidence to show that it has promoted use of the term “box” to describe the gym facilities of its affiliates, and that others have adopted the term “box” to describe such facilities. We note the following examples:

Here I want to build on that tradition by providing an updated guide to outfitting a box, whether it’s a personal garage or basement gym, a portable equipment cache for outdoor workouts, a 5,000-square-foot CrossFit affiliate, or anything in between.

Eddie Lugo, *Outfit Your Box: An Equipment Procurement Guide*, THE CROSSFIT JOURNAL, August 2008.⁴⁷

Some affiliate owners are waking up to find new CrossFit boxes setting up shop right across the street, theoretically stealing current and future clients. Sometimes, that new box is being opened by someone that affiliate trained, which leads to a host of other complaints.

Russell Berger, *Can CrossFit Affiliates Handle the Competition – from Themselves?*, THE CROSSFIT JOURNAL, 2008.⁴⁸

This workout regimen that has trademarked “sport of fitness” calls its gyms “boxes.”

Jeopardy! question, June 24, 2016.⁴⁹

At the end of 2012, there were about 5,000 CrossFit gyms, or boxes, as they are known in CrossFit lingo.

Sean Gregory, *Lift Squat Repeat*, TIME, January 20, 2014 at 42.⁵⁰

A local CrossFit gym is referred to as a box, because it can be anywhere and any style, and the culture of any box may be nothing like that of

⁴⁶ Glassman dec. ¶ 18, 26 TTABVUE 30.

⁴⁷ 26 TTABVUE 53.

⁴⁸ 26 TTABVUE 63.

⁴⁹ 26 TTABVUE 241.

⁵⁰ 26 TTABVUE 98.

Glassman's company, or of any other CrossFit box. Boxes may even have different business models.

Burt Helm, *Do Not Cross CrossFit, INC.*, July/August 2013 at 104.⁵¹

Truthfully, CrossFit locations (or "boxes," as they are commonly called) aren't much to look at – bare and basic with no fancy machines or gadgets ...

Lara McGlashan-Volz, *Break Through Your Comfort Zone*, OXYGEN, October 2012 at 90.⁵²

"It was just after New Year's Day. Avoiding the rush at the local franchise gym, I wandered into a freshly opened CrossFit Box (CrossFit calls their gyms "boxes"), not far from my house.

BETSY PAKE, *START SMALL LIVE BIG 13* (2017).⁵³

Whether it's running, participation in an organized sport, a workout at the gym, swimming, free weights, or even a hardcore workout at the local CrossFit Box, there are plenty of ways to raise your body's level of fitness.

KORY KOGON *et al.*, *THE 5 CHOICES: THE PATH TO EXTRAORDINARY PRODUCTIVITY* 172 (2015).⁵⁴

CrossFit boxes work to make newcomers feel welcome, introducing them slowly to new concepts and showing them the basics via the fundamentals program.

T. J. MURPHY, *INSIDE THE BOX: HOW CROSSFIT® SHREDDED THE RULES, STRIPPED DOWN THE GYM, AND REBUILT MY BODY* 47 (2012).⁵⁵

"... I found a CrossFit box in Busso. Let's drive over there ..." ... They gave the CrossFit box owner two StarrFitness t-shirts, and represented they were on holiday from Minnesota. ...

⁵¹ 26 TTABVUE 105.

⁵² 26 TTABVUE 126.

⁵³ 26 TTABVUFE 136.

⁵⁴ 26 TTABVUE 140.

⁵⁵ 26 TTABVUE 161.

ALEXI VENICE, MARGARET RIVER WINERY: A PEPPER MCCALLAN NOVEL 323 (2016).⁵⁶

Box: A box is a barebones gym to some, but heaven to a CrossFitter. While many CrossFitters train on their own from home or non-CrossFit gyms, “boxes” have all the equipment necessary for the range of WODs (more on those below) without the bells, whistles, and bicep curl bars of a “chrome-and-tone” gym.

“The Ultimate Guide to CrossFit Lingo,” <greatest.com>.⁵⁷

The evidence of record is sufficient to persuade us that in the field of fitness training, customers would recognize the term “box” as a word for one of Opposer’s fitness training facilities. There is no evidence to indicate that “box” is used to describe the fitness facilities of others or that others use trademarks that include the term BOX for fitness training facilities. The perception of “box” as referring to a fitness facility of Opposer will affect the meaning or connotation that customers perceive in Applicant’s mark. That is, in certain commercial contexts, CROSSBOX may be suggestive of a CrossFit “box” or a fitness facility of Opposer. Although it is not clear that Applicant intends that his use of -BOX should suggest a facility of any type, we note that Applicant’s “concept document” regarding his business states that “Crossbox may be a physical space” and refers to “Crossbox-dining establishments that prepare and offer based on the diet concept food and drink. These destinations can then act as excellent physical Crossbox rooms.”⁵⁸

⁵⁶ 26 TTABVUE 166.

⁵⁷ 26 TTABVUE 16.

⁵⁸ 19 TTABVUE 29-30.

Our analysis of the marks at issue indicates that CROSSFIT and CROSSBOX are partly similar in appearance and sound, and partly dissimilar. In meaning and connotation, the two marks are at least partly similar because of the shared term CROSS-. Moreover, because of the meaning of “box” in the field of fitness training, Applicant’s mark may be perceived as containing a reference to Opposer’s core business.

The overall commercial impression of Applicant’s mark, as compared to that of Opposer’s mark, will vary, depending on the nature of the goods and services with which it is used. With respect to Applicant’s services in Class 41, which include “conducting of sports competitions,” we find that the similarity of Applicant’s mark to Opposer’s mark in suggestive meaning strongly favors a finding of likelihood of confusion. We find that Applicant’s mark would also suggest a reference to Opposer when used on Applicant’s goods in Class 25, which include “Sports shoes,” even though apparel and shoes are not Opposer’s core business. This finding is supported by Opposer’s high degree of renown in the field of fitness training; Opposer’s significant presence in the apparel marketplace as a result of its co-branding efforts with Reebok; and the complementarity of apparel and Opposer’s core fitness training services, inasmuch as work-out apparel and athletic shoes are useful and essential to fitness training. Finally, even as used on Applicant’s food products in Class 30, we find that Applicant’s mark’s suggested reference to Opposer would remain a salient feature of its commercial impression. Again, Opposer’s high degree of renown in its core fitness services increases the scope of Opposer’s recognition in the marketplace,

and will carry over to some extent into the field of foods. This finding is further supported by Opposer's showing that its customers have an interest in nutrition as it relates to their fitness training. Overall, with respect to all three classes of Applicant's goods and services, to different degrees, the *du Pont* factor of the similarity or dissimilarity of the marks favors a finding of likelihood of confusion.

E. Other *du Pont* factors.

The parties have referred, in their briefs, to several other *du Pont* factors: the number of similar marks in use; the conditions under which sales are made; actual confusion (or absence thereof); lack of a market interface between the parties; Applicant's right to exclude others from use of his mark; and the extent of potential confusion. However, the record contains little or no evidence to support findings with respect to these factors. "Attorney argument is no substitute for evidence." *Enzo Biochem Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005). Accordingly, on this record we treat such factors as neutral.

F. Balancing the factors.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. The parties' goods in Class 25 are identical in part and their services in Class 41 are legally identical in part. These goods and services would be offered to the same classes of customers through the same channels of trade. We have found Applicant's goods in Class 30 to be related to Opposer's core fitness training services, and have found that these goods and services would be offered to classes of customers that overlap. The marks are

partly similar in appearance and sound. Importantly, in connotation and overall commercial impression Applicant's mark suggests the type of facility in which Opposer's services are offered. Indeed, at least in the context of athletic competitions it is likely that Applicant's mark would be strongly suggestive of a "CrossFit box." Moreover, we have found Opposer's mark CROSSFIT to enjoy a high degree of renown in the field of fitness training and a moderate degree of renown in the field of sports apparel. We have also found this degree of renown to be sufficient to raise Opposer's public profile in the field of food products. The renown of the mark CROSSFIT substantially increases the likelihood that customers for Applicant's goods and services would perceive in Applicant's mark a suggestion of Opposer and its core services, such that a mistaken perception of association or endorsement between Opposer and Applicant is likely. We therefore find that Applicant's mark so closely resembles Opposer's registered mark as to be likely, when used on or in connection with the goods and services of Applicant, to cause confusion, or to cause mistake, or to deceive. Accordingly, we **SUSTAIN** the opposition on the basis of Opposer's claim under Section 2(d).

Inasmuch as we have determined that registration of Applicant's mark should be refused on grounds of likelihood of confusion, we need not and do not reach Opposer's claim of a lack of *bona fide* intention to use the mark.

Decision: The opposition is **SUSTAINED** on Opposer's claim of likelihood of confusion under Section 2(d) for all three International Classes.