

COURT OF APPEALS OF THE STATE OF SÃO PAULO

JUDICIAL DISTRICT OF SÃO PAULO

CIVIL CENTRAL COURT

2ND BUSINESS COURT AND ARBITRATION CONFLICTS

Praça Doutor Joao Mendes, S/N, Centro – CEP 01501-000, Phone: (11) 2171-6632, São Paulo-SP – E-

mail: sp2vemp@tjsp.jus.br

Opening hours: from 12:30 a.m. to 9:00 p.m.

DECISION

Digital Proceeding No.: 1043633-74.2019.8.26.0100
Class – Matter Civil Common Procedure – Trademark
Plaintiff: Crossfit, Inc.
Defendant: Sorte Eventos Ltda.

State Judge: Dr. Eduardo Palma Pellgrinelli

Case records examined.

1 – I determine that the plaintiff, within 15 days, post a bond in the amount of R\$ 20,000.00, in accordance with art. 83 of the CPC.

2 – Within the same period, I order the plaintiff to submit the sworn translation of the document of pages 50/59, 322, 323/324 and 328.

3 – This is a lawsuit brought by CROSSFIT, INC. against LUCK EVENT LTDA (HADDOCK CROSS) in order to “(i) *condemn the Defendant to refrain from using trademark ‘CROSSFIT’ in any way and under any title, or that includes, without limitation, use on websites, social networks, hashtags, advertising, stores, facades, clothing, among others, as well as expose, advertise or divulge any products and services bearing trademark ‘CROSSFIT’ (...); (ii) the definitive transfer of the domain name www.haddockcrossfit.com.br/ to the Plaintiff; (iii) the conviction is to indemnify the Plaintiff for damages suffered, including material damages and loss of profits, to be settled by arbitration, taking into account, for material damages, the criterion contained therein in article 208 of the LPI; and for loss of profits and unjust enrichment, one of the criteria set forth in art. 210 of the LPI, which is more favorable to the Plaintiff during the eventual award calculation, as well as unjust enrichment; [and] (iv) the condemnation of the Defendant to indemnify the Plaintiff for the moral damages suffered in the amount of R\$ 50,000.00 (...)*” (pages 01/28).

The initial brief was supported by documents (pages 29/338).

A request for advance protection has been made “*in order to determine: (a) the immediate abstention from use of trademark ‘CROSSFIT’, in any medium and in any way, or including, without limitation, use in websites, social networks, hashtags, advertising, stores ,*

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façades, clothing articles, among others, until a final judgment of the present suit is made, under penalty of payment of a daily fine in the amount of R\$ 5,000.00 (...) in case of noncompliance with the precept; and (b) the official dispatch to the NIC.br requesting the immediate freezing of the domain name www.haddockcrossfit.com.br”.

This is the report. I decide.

With regard to the advance protection, art. 300 of the CPC [Code of Civil Procedure] establishes as follows:

“Art. 300. The advance protection shall be granted when there are elements that evidence the probability of the right and the danger of harm or the risk to the useful result of the proceeding.

§ 1st. In order to grant advance protection, the judge may, as the case may be, demand a real or fiduciary security to compensate for damages that the other party may suffer, and the security may be waived if the economically feasible party may not offer it.

§ 2nd - The advance protection may be granted at the outset or after prior justification.

§ 3rd - The advance protection of an anticipated nature shall not be granted when there is danger of irreversibility of the effects of the decision”.

Essentially, advance protection shall be granted when there is: (1) probability of the right; and (2) risk of damage or perishment of the right itself or the useful result of the proceeding; on the other hand, there may be no danger of irreversibility of the measure.

In this case, in a preliminary and probability examination, the requirements for the granting of advance protection are present.

As may be seen, it has been documented that the plaintiff owner of the word and device service mark for “CrossFit”, under registration number 903046261, specifically for the branch of health clubs (pages 46), as well as it has the registration of word mark “CrossFit” in the United States of America (pages 48 and 49).

And according to Law no. 9.279/96, the trademark being the visually perceptible distinguishing sign identifying the product or service (article 122), its owner is entitled to exclusive use (article 129) or licensing (article 130, II) and, in any event, to ensure material integrity and reputation – 130, III.

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It occurs that photographs of pages 325/327 and 329 show that the defendant operates as a health club, as does the author, using trademark “CrossFit”, while the documents of fls. 40/42 show that the plaintiff still uses the mark in its internet domain name www.haddockcrossfit.com.br.

We have, therefore, that there is use by the defendant, of the word element of the word and device trademark owned by the plaintiff, “Crossfit”.

On this point, it must be pointed out that, even if the plaintiff is the owner, of only a word and device mark, it is possible to assert infringement of the word element of his trademark, as Lélío Denicoli Schmidt teaches:

“When formed by common words, word and device marks are only protected by the graphic or stylized figure, without generating protection for the word element. Likewise, if the drawing is common or banal, the exclusivity will fall solely on the word element. However, when comprised by distinctive expressions, word and device marks are protected either against graphic imitation or against visual imitation, so that their protection is not necessarily limited to the protection of the whole” (Trademarks: Acquisition, Exercise and Extinction of Rights, pp. 209, Rio de Janeiro, Lumen Juris, 2016).

The fact that the plaintiff did not authorize such use of its trademark is enough to characterize the likelihood of the right.

In addition, the use of the plaintiff’s trademark for the commercialization of similar services may generate damages that extrapolate the pecuniary aspect, which characterizes the danger of harm.

Therefore, advance protection must be granted, so that the defendants refrain from using trademark “CrossFit” which is the subject of the certificates of registration of pages 46, 48 and 49.

As the Court of Appeals has already held, in a similar case:

“INTELLECTUAL PROPERTY – Conflict between the word element of a word and device mark, business name and internet domain name of the plaintiff and the business name, title of establishment and domain name on the Internet of the defendant – Unfair competition configured, given the clear possibility of deviation from the plaintiff’s clientele, through confusion or association of clients and consumers – Satisfactory proof of the moral damages suffered by the

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plaintiff, as a result, in particular, from the filing of a labor claim against it by one of the defendants' officials, by having allegedly confused them, a fact which, of course, caused it several problems. Original procedural requirements Adjustment of loss of suit expenses. Appeal granted.” (TJSP - 2nd Reserved Business Law Chamber – Appeal 1002825-68.2013.8.26.0704; Rapporteur (s): Caio Marcelo Mendes de Oliveira - Trial: 11/18/2016)

In view of the foregoing, **I hereby grant advance protection**, specifically for the defendant to refrain from using the term “CrossFit” in *websites, social networks, hashtags, advertising, stores, facades, [and] clothing articles*”, as well as for refrain from using the internet address www.haddockcrossfit.com.br, in violation of the trademark “CrossFit”, which is subject to registration of pages 46, 48 and 49, within a period of 15 days counted from the receipt of this official decision.

A copy of this decision shall serve as an OFFICIAL LETTER, which shall be printed directly by the plaintiff, supported with a copy of the petition and the documents of pages 46, 48 and 49 and delivered to the defendant, which must be proven in 05 days.

4 – The defendant shall be served of process through letter, to submit defense within 15 days, under penalty of incidence of sanctions of default according to art. 344 of the NCPC [New Code of Civil Procedure].

Right away, it is not appropriate to designate of the conciliation hearing set forth in art. 334 of the NCPC, for the following reasons: (i) the autonomy of the will and the freedom to contract are fundamental rights of the parties, provided for in the Federal Constitution; (ii) they have the fundamental constitutional right to the reasonable length of the process and the means to ensure its speed of procedure (Article 5, LXXVIII of the Federal Constitution), which shall remain substantially prejudiced before the enormous audiences that will be formed, without the corresponding structure of conciliators/mediators at the disposal of the Court; (iii) the procedural principle that there is no nullity without prejudice, especially since conciliation is any time in the process; and (iv) the historical evidence regarding the evolution of the jurisprudential understanding in the sense that there was no obligation for the appointment of a conciliation in the ordinary rite, as well as of the disuse of the adoption of the summary rite to the detriment of the ordinary rite in the face of the difficulties imposed by the observance of the necessary to allow a regular and formal preliminary hearing institution, which made it impossible to carry out, a position that has been maintained by the jurisprudence of the E. Court of Justice of São Paulo after the entry into force of the New Code of Civil Procedure of 2015 [see Appeal 1001000-04.2016.8.26.0472; Rapporteur: Tasso Duarte de Melo; Judging Body: 12th Private Law Chamber; Porto Ferreira

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Court – 1st Court; Date of Trial: 11/27/2017; Date Registered: 11/27/2017; or Appeal 1064504 – 36.2016.8.26.0002; Rapporteur: Vianna Cotrim; Judging Body: 26th Private Law Chamber; Regional Court II - Santo Amaro - 1st Civil Court; Date of Trial: 11/09/2017; Date Registered: 9/11/2017].

In view of the foregoing, the service of process shall be a simple one, the term of defense starting from the filing of the respective proof of the act.

Notify.

São Paulo, May 14, 2019.

DOCUMENT DIGITALLY SIGNED PURSUANT TO LAW 11.419/2006, ACCORDING TO THE PRINTING ON THE LEFT MARGIN