

## Infringement And Defenses – Famous Marks

### “GAP/ VETO GAP, GAP DENİM”

(\*\*) 2<sup>nd</sup> Commercial Court of Istanbul

Decision No.: E: 1998/179 – K: 2000/248

16 June 2000

(\*\*\*) Supreme Court – 11<sup>th</sup> Civil Chamber

Decision No.: E: 2001/5479 – K: 2001/7121

24 September 2001

(\*\*\*\*) Decision No.: E: 2004/11395 – K: 2002/920

5 February 2002

### **The GAP Inc vs. GAP Güneydoğu Tekstil ve Ticaret A. Ş.& Veto Giyim Sanayi ve Dış Ticaret Ltd. Şti.**

**(\*) 1st Court of Istanbul on Intellectual and Industrial Rights, Case no. 2002/332-Decision no. 2004/612 (October 5, 2004)**

An action (\*) was instituted for trademark infringement claiming the cancellation of the defendants' trademark registrations GAP on grounds of similarity to the plaintiff's well-known trademark GAP and for the determination and stopping of unfair competition and its effects.

The plaintiff claimed that the plaintiff company is one of the most renowned companies in the world in the field of ready wear considering their turnover, quality, and their chain of stores, that the trademark GAP is registered in many countries and all around the world, and also registered in Turkey, where it is under protection according to the article 6 bis of the Paris Convention, and according to article 7 parag. 1(i) 556 of the Decree Law, and in accordance with the Turkish Code of Commerce since the word GAP is a distinctive element of the plaintiff's trade name. The registration of the word GAP by the defendants constitutes

infringement of the plaintiff's trade name and trade marks, the defendant having registered the word GAP or have filed an application there for, and in view of the fact that the plaintiff's trade name and trademark are well known worldwide, and that the plaintiff manufactures their product range in Turkey via contract manufacturing, also the fact that the defendant is active in the field of textile manufacturing, that it is not possible that the defendants do not know about the plaintiff's GAP trademark, that the defendants are ill-willed as the word GAP used by the defendants in their trademarks is identical with the plaintiff's GAP trademark, the plaintiff has requested for the such acts be recognized to constitute infringement of the plaintiff's well-known trademark and trade name and an act of unfair competition and have asked for the cancellation of the defendants' trademarks since they have no right to such registration and the defendant has requested cancellation and abandonment of the defendant's trademark.

The first instance Court (\*\*) partially accepting the plaintiff's claims ruled for the cancellation of the defendants' trademarks but refused the exclusion of the word GAP from the trade names of the defendants. Two of the defendants GAP GÜNEYDOĞU TEKSTİL SAN. VE TİC. A.Ş. and GAP GÜNEYDOĞU ANADOLU PAZARLAMA VE TARIM ÜRÜNLERİ VE TİC. A.Ş. appealed.

One of the plaintiffs claimed together with the objections against the procedure that there was no intention by the defendant to make GAP trademark notorious, that the wording GAP was the abbreviation for Turkey's Güneydoğu Anadolu Project (South Eastern Anatolia Project) and that this was well known both in Turkey and around the world, that the defendant had activity in the city of Gaziantep which is located in this region, he had registered the abbreviation GAP as trade name and trademark, and during this period the plaintiff's trademark did not possess the quality of notoriety and was not registered in the country, if the foreign trademark was known publicly in Turkey, it could benefit from article 6 bis of the Paris Convention, and requested rejection of the case stating that the wording GAP was well known not because of the trademark GAP of the trade activity of the plaintiff, but because of the name of the project conducted for the development of Güneydoğu Anadolu Region (South Eastern Anatolia Region).

The Supreme Court (\*\*\*) upheld the decision (\*\*) of the first instance Court, which became finalized for one of the defendants GAP GÜNEYDOĞU ANADOLU PAZARLAMA VE TARIM ÜRÜNLERİ VE TİC. A.Ş.

The other defendant GAP GÜNEYDOĞU TEKSTİL SAN. VE TİC. A.Ş. further appealed before the Supreme Court for reconsideration on formal grounds of failure of proper notification of the decision upon which the Supreme Court overturned (\*\*\*\*) the decision upon which the case was referred to the first instance Court for further decision (\*).

The court (\*) has partially accepted the plaintiff's claims in the light of the previous final decisions with regard to the other defendants and decided to cancel the entry in official records of the trademark registration in the name of the defendant and rejected plaintiff's request related to the use of the word GAP by defendants in their trade name together with differing elements since this does not constitute infringement of plaintiff's trade name.

(\*) Istanbul Court of Intellectual and Industrial Rights.

Decision No.: E: 2002/671 – K: 2003/588

23 October 2003