

WEDNESDAY, 24 SEPTEMBER 2025

GSK succeeds in bad faith case in Turkey



Mutlu Yıldırım Köse and Begüm Soydan report on a case in Turkey concerning the registration of the trade mark Clindoxyl and its use to threaten infringement proceedings against the genuine right holder, in which the courts protected the rightful owner and invalidated the bad faith registration.

Background

The dispute concerned the bad faith registration of a trade mark that had previously been registered in Türkiye in the name of Stiefel Laboratoires, Inc., an affiliate of GlaxoSmithKline Plc, the global pharmaceutical group (GSK).

GSK had been commercially using the Clindoxyl trade mark since 2010 in Türkiye, particularly in connection with acne treatment products, with a valid marketing authorisation from the Turkish Ministry of Health.

Although the trade mark was applied for in by GSK 2006 and registered in class 5 in 2007, the protection lapsed in 2016 due to an unintentional failure to renew.

In 2019, the defendant obtained registration for the Clindoxyl trade mark in class 5. Within 10 days of the registration, it sent a cease-and-desist letter to GSK Türkiye, accusing the company of trade mark infringement with the threat of collecting its products on the market based on the recent trade mark registration for Clindoxyl.

GSK immediately responded with a formal letter, reminding the defendant that it is the genuine right owner of the Clindoxyl trade mark and demanding assignment of the trade mark. However, the defendant asked for payment of a significant amount to assign the trade mark to GSK.

As this is a clear indication of bad faith, GSK decided to initiate an invalidation action against the defendant and alleged that the defendant acted in bad faith by knowingly exploiting the lapse in registration to take advantage of GSK's established brand reputation and commercial presence.

The defendant denied the bad faith claims, arguing that GSK did not have a valid registration for this trade mark and that the goods fall into different trade mark classes as the defendant aims to use the trade mark in terms of room fragrances in class 5 while GSK's use should be accepted for goods in class 3.

Decision

The first instance court ruled in favour of GSK and decided to invalidate the defendant's trade mark, with satisfactory reasoning (Izmir Civil IP Court, E. 2020/80 K. 2021/95 T. 16.06.2021).

The court concluded that GSK is the genuine right owner of the Clindoxyl trade mark since it was understood from the evidence in the file that it has used the trade mark both in Türkiye and abroad long before the application date of the defendant's trade mark and it is not coincidental that the defendant chose to register the exact same Clindoxyl trade mark, which is highly distinctive. Therefore the defendant aimed to gain unfair benefit from this trade mark although she was aware of the genuine right owner.

The defendant's appeal was rejected by the Regional Court of Appeals (Izmir Regional Court of Appeals, E. 2021/1077 K. 2024/421 T. 13.03.2024). Upon the defendant's second appeal, the Court of Cassation upheld the decision, confirming the invalidation of the defendant's trade mark (11th Civil Chamber of Court of Cassation, E. 2024/3134 K. 2025/1450 T. 04.03.2025).

As a result, GSK succeeded in the invalidity of the bad faith registration, which will no longer serve as the basis of a potential infringement case and was also creating an obstacle to the registration of its own trade mark.

Following the finalised court decision, the trade mark was declared entirely invalid with retroactive effect by the Turkish Patent and Trade Mark Office, which will enable GSK to register its own trade mark.

Comments

This ruling sets a strong precedent for protecting trade mark holders against bad faith registrations in Türkiye, especially in cases where a lapse or gap in registration is exploited by third parties. It affirms that trade mark rights are

rooted not only in formal registry entries but also in actual use, commercial recognition and ethical conduct in trade.

By citing earlier jurisprudence and reminding about the duties of a diligent trader before applying for a trade mark registration, the court drew a clear line between opportunistic filings and legitimate registrations.

Recognising the importance of genuine and earlier use, this decision contributes to the development of trade mark jurisprudence in Türkiye and serves as a robust legal tool for preventing misuse of the registration system through bad faith.