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April 24 2008 - Thailand

Tilleke & Gibbins International Ltd

Application for CERASIL dismissed on grounds of bad faith

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In *Unimin Corporation v Department of Intellectual Property* (February 19 2008), the Board of Trademarks has held that [Industrial Mineral Development Co Ltd](#) had applied for the registration of the trademark CERASIL in bad faith.

In 2004 Industrial Mineral, a Thai company, filed an application for the registration of the trademark CERASIL for silica products for industrial use. The trademark applied for was identical to the unregistered trademark of [Unimin Corporation](#), one of the largest companies in the mineral industry, and covered the same goods. Unimin and Sibelco Mineral (Thailand) Co Ltd, which are both affiliates of the same parent company, opposed the application on the grounds that:

- they had prior rights in the word mark CERASIL; and
- Industrial Mineral had filed the application in bad faith.

The registrar of trademarks found that Unimin and Sibelco had failed to provide sufficient evidence that they had prior rights in the trademark and that Industrial Mineral had filed the application in bad faith. The registrar thus dismissed the opposition.

Unimin appealed to the Board of Trademarks. Among other things, Unimin provided evidence that:

- it had owned registrations for the trademark CERASIL in several countries for over a decade; and
- it had distributed more than 14 million tons of goods under the trademark CERASIL.

More importantly, Unimin presented evidence that a managing director of Industrial Mineral had been employed as general manager of Sibelco (formerly Clay and Mineral (Thailand) Co Ltd) for 18 years. According to Unimin, there is a clear connection between Sibelco and Unimin, as they are both affiliates of the same parent company. The board concluded that the director could have obtained information on the trademark CERASIL (which was invented and used by Unimin) through Sibelco and had intentionally used this information to apply for the registration of the mark without authorization.

Therefore, the board held that Industrial Mineral had applied for the registration of the trademark CERASIL in bad faith in an attempt to derive benefits from the goodwill attached to Unimin's trademark CERASIL. The registrar thus found that the registration of Industrial Mineral's mark CERASIL would be contrary to public policy under Section 9(9) of the [Trademark Act](#) (BE 2534). Consequently, the board reversed the registrar's decision and refused to allow the registration of the trademark CERASIL.

Nuttaphol Arammuang and Kawin Kanchanapiroj, Tilleke & Gibbins International Ltd, Bangkok