



Reprinted
February 1, 2005

HOUSE BILL No. 1673

DIGEST OF HB 1673 (Updated January 31, 2005 4:03 pm - DI 103)

Citations Affected: IC 24-2; noncode.

Synopsis: Trademarks and service marks. Replaces the Indiana Trademark Act with the Model State Trademark Act. Repeals obsolete provisions of the Indiana Trademark Act.

Effective: July 1, 2005.

Harris T, Murphy, Walorski, Reske

January 19, 2005, read first time and referred to Committee on Commerce, Economic Development and Small Business.
January 27, 2005, amended, reported — Do Pass.
January 31, 2005, read second time, amended, ordered engrossed.

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HB 1673—LS 7334/DI 110+



First Regular Session 114th General Assembly (2005)

PRINTING CODE. Amendments: Whenever an existing statute (or a section of the Indiana Constitution) is being amended, the text of the existing provision will appear in this style type, additions will appear in **this style type**, and deletions will appear in ~~this style type~~.

Additions: Whenever a new statutory provision is being enacted (or a new constitutional provision adopted), the text of the new provision will appear in **this style type**. Also, the word **NEW** will appear in that style type in the introductory clause of each SECTION that adds a new provision to the Indiana Code or the Indiana Constitution.

Conflict reconciliation: Text in a statute in *this style type* or ~~this style type~~ reconciles conflicts between statutes enacted by the 2004 Regular Session of the General Assembly.

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HOUSE BILL No. 1673

A BILL FOR AN ACT to amend the Indiana Code concerning trade regulation.

Be it enacted by the General Assembly of the State of Indiana:

- 1 SECTION 1. IC 24-2-1-2 IS AMENDED TO READ AS FOLLOWS
2 [EFFECTIVE JULY 1, 2005]: Sec. 2. ~~As used in this chapter:~~ **The**
3 **following definitions apply throughout this chapter:**
4 (1) "Abandoned" means either of the following:
5 (A) If the use of a mark has been discontinued with the
6 intent not to resume the use of the mark. Intent not to
7 resume may be inferred from circumstances. Two (2)
8 consecutive years without use of a mark constitutes prima
9 facie evidence of abandonment of the mark.
10 (B) If the conduct of the owner, including acts of omission
11 and commission, causes the mark to lose its significance as
12 a mark.
13 (2) "Applicant" means a person who files an application for
14 registration of a mark under this chapter and the legal
15 representatives, successors, or assigns of the person.
16 (3) "Dilution" means the lessening of the capacity of a famous
17 mark to identify and distinguish goods or services, regardless



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of the presence or absence of:

(A) competition between the owner of the famous mark and other parties; or

(B) the likelihood of confusion, mistake, or deception.

(4) "Mark" means a trademark or service mark that is entitled to registration under this chapter, whether the mark is registered or not.

(5) "Person" means a:

(A) human being;

(B) corporation;

(C) partnership; or

(D) limited liability company.

The term includes an applicant or another person who is entitled to a benefit or privilege under this chapter or who is rendered liable under this chapter.

(6) "Registrant" means a person to whom the registration of a mark under this chapter is issued and the legal representatives, successors, or assigns of the person.

(7) "Secretary" means the secretary of state or the designee of the secretary charged with the administration of this chapter.

(8) "Service mark" means a word, name, symbol, device, or a combination of a word, name, symbol, or device, that is used by a person to:

(A) identify a service, including a unique service, of a person and distinguish the person's service from the service of another person; and

(B) indicate the source of a service or, if the source is unknown, indicate that the source of the service is unknown.

Titles, character names, and other distinctive features of a radio or television program used by a person may be registered as a service mark even though the radio or television program on which the titles, character names, and other distinctive features appear advertise the goods or services of the sponsor of the radio or television program.

~~(a)~~ (9) The term "Trademark" means any a word, name, symbol, or device or any combination thereof adopted and of a word, name, symbol, or device that is used by a person to:

(A) identify goods or services made, sold, or rendered by him and to distinguish them from goods or services made, sold, or rendered by others: goods, including a unique product, of a

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1 **person and distinguish the person's goods from goods**
 2 **manufactured or sold by another person; and**

3 **(B) indicate the source of the goods or, if the source is**
 4 **unknown, indicate that the source of the goods is unknown.**

5 (b) The term "person" means any individual, firm, partnership,
 6 corporation, limited liability company, association, union of
 7 workingmen, or other organization.

8 (c) The term "applicant" embraces the person filing an application
 9 for registration of a trademark under this chapter, his legal
 10 representatives, successors, or assigns.

11 (d) The term "registrant" embraces the person to whom the
 12 registration of a trademark under this chapter is issued, his legal
 13 representatives, successors, or assigns.

14 (e) For the purposes of this chapter, a trademark shall be deemed to
 15 be "used" in this state when it is placed in any manner on the goods or
 16 their containers or on the tags or labels affixed thereto; or when it is
 17 used to identify the services of one person and distinguish them from
 18 the services of others; and such goods or services are sold, otherwise
 19 distributed, or rendered in this state.

20 **(10) "Trade name" means a name used by a person to identify**
 21 **a business or vocation of the person.**

22 **(11) "Use" means the bona fide use of a mark in the ordinary**
 23 **course of trade and not a use made merely to reserve a right**
 24 **in a mark. A mark is considered to be in use:**

25 **(A) on a good if the mark is placed in any manner on:**

- 26 **(i) the good;**
- 27 **(ii) a container of the good;**
- 28 **(iii) a display associated with the good; or**
- 29 **(iv) a tag or label affixed to the good;**

30 **(B) on a good if the nature of the good makes placement of**
 31 **the mark as described in clause (A) impracticable and:**

- 32 **(i) the mark is placed in any manner on a document**
 33 **associated with the good or with the sale of the good; and**
- 34 **(ii) the good is sold or transported in commerce in**
 35 **Indiana; and**

36 **(C) on a service if:**

- 37 **(i) the mark is used or displayed in the sale or**
 38 **advertising of the service; and**
- 39 **(ii) the service is rendered in Indiana.**

40 SECTION 2. IC 24-2-1-3 IS AMENDED TO READ AS FOLLOWS
 41 [EFFECTIVE JULY 1, 2005]: Sec. 3. A trademark mark by which the
 42 goods or services of any an applicant for registration may be

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1 distinguished from ~~the other~~ goods or services ~~of others~~ **shall may** not
 2 be registered if ~~it~~ **the mark**:

3 ~~(a)~~ **(1)** consists of or comprises immoral, deceptive, or scandalous
 4 matter;

5 ~~(b)~~ **(2)** consists of or comprises matter ~~which~~ **that** may:
 6 **(A)** disparage or falsely suggest a connection with:
 7 **(i)** persons living or dead;
 8 **(ii)** institutions;
 9 **(iii)** beliefs; or
 10 **(iv)** national symbols; or
 11 **(B)** bring ~~them~~ into contempt or disrepute: **a**
 12 **(i) persons living or dead;**
 13 **(ii) institutions;**
 14 **(iii) beliefs; or**
 15 **(iv) national symbols;**

16 ~~(c)~~ **(3)** consists of or comprises the flag, ~~or~~ coat of arms, or other
 17 insignia of:
 18 **(A)** the United States;
 19 **(B)** ~~or of any a~~ state or municipality;
 20 **(C)** ~~or of the~~ United Nations; or
 21 **(D)** ~~of any a~~ foreign nation; ~~or any simulation thereof~~

22 ~~(d)~~ **(4)** consists of or comprises the name, signature, or portrait of
 23 ~~any a particular~~ living individual, ~~except with his~~ **unless the**
 24 **individual provides** written consent; ~~or~~

25 ~~(e)~~ consists of **(5)** is a mark ~~which~~ **that**:
 26 **(1)** when applied to **(A)** **if used on or in connection with** the
 27 goods or services of the applicant, is merely descriptive or
 28 deceptively ~~misdescriptive~~ **descriptive** of ~~them~~ **the goods or**
 29 **services;**
 30 **(2)** when applied to **(B)** **if used on or in connection with** the
 31 goods or services of the applicant, is primarily geographically
 32 descriptive or deceptively ~~misdescriptive~~ **geographically**
 33 **descriptive of them the goods or services;** or
 34 **(3)** **(C)** is primarily ~~merely~~ a surname.

35 ~~Provided, however, that nothing in~~ This subdivision ~~shall~~ **does**
 36 **not** prevent the registration of a mark **that is** used in ~~this state~~
 37 **Indiana** by the applicant ~~which~~ **and** has become distinctive of the
 38 applicant's goods or services. The secretary ~~of state~~ may accept
 39 **proof of continuous use of a mark by the applicant in Indiana**
 40 **for the five (5) years immediately preceding the date on which**
 41 **the claim of distinctiveness is made** as evidence that the mark
 42 has become distinctive, as ~~applied to~~ **used on or in connection**

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1 with the applicant's goods or services; proof of substantially
 2 exclusive and continuous use thereof as a mark by the applicant
 3 in this state or elsewhere for the five (5) years next preceding the
 4 date of the filing of the application for registration; or
 5 (f) consists of or comprises (6) is a trademark mark which that
 6 so resembles a trademark mark registered in this state Indiana or
 7 deemed registered in this state; as provided for by section 16 of
 8 this chapter; a mark or trade name previously used by another
 9 person and not abandoned, as to be likely, when applied to if
 10 used on or in connection with the goods or services of the
 11 applicant, to cause deception, confusion, or mistake. or to
 12 deceive: unless there shall be filed with the secretary of state the
 13 written consent of the registrant of such trademark, signed and
 14 verified under oath by the registrant or one (1) of its officers or
 15 partners:

16 SECTION 3. IC 24-2-1-4 IS AMENDED TO READ AS FOLLOWS
 17 [EFFECTIVE JULY 1, 2005]: Sec. 4. (a) Subject to the limitations set
 18 forth in of this chapter, any a person who adopts and uses a trademark
 19 in this state mark may file in the office of the secretary, of state; on a
 20 form to be furnished by the secretary of state; in a manner that
 21 complies with the requirements of the secretary, an application for
 22 registration of that trademark setting the mark. The application must
 23 set forth, but is not limited to, the following information:

24 (a) (1) The name and business address of the person applying for
 25 such registration of the mark, and:

26 (A) if the applicant is a corporation, the state of
 27 incorporation; or

28 (B) if the applicant is a partnership, the:

- 29 (i) state in which the partnership is organized; and
- 30 (ii) names of the general partners, as specified by the
 31 secretary.

32 (b) (2) The:

33 (A) goods or services on which the mark is used and the
 34 goods or services used in connection with which the mark;
 35 is used; and the

36 (B) mode or manner in which the mark is used on or in
 37 connection with such the goods or services; and the

38 (C) class in which such the goods or services fall.

39 (c) (3) The date when on which the trademark mark was first
 40 used in the United States and the date of its on which the mark
 41 was first use used in this state Indiana by the applicant or his the
 42 applicant's predecessor in business.

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- ~~(4)~~ **(4) A statement that:**
 - ~~(A)~~ **(A) that the applicant is the owner of the trademark mark;**
 - ~~(B)~~ **(B) the mark is in use; and**
 - ~~(C)~~ **(C) that to the knowledge of the person verifying the application, no other another person:**
 - ~~(i)~~ **(i) has not registered the mark, either federally or in Indiana; or**
 - ~~(ii)~~ **(ii) has does not have the right to use such trademark in this state the mark either in the identical form thereof or in such near resemblance thereto to the form as might be calculated to deceive or to be mistaken therefor; however, this statement shall not be required if written consent is obtained in the manner provided for in section 3(f) of this chapter: to be likely, if applied to the goods or services of the other person, to cause deception, confusion, or mistake.**
 - (b) The secretary may also require on an application:**
 - (1) a statement indicating whether an application to register a mark or parts or a composite of an application to register a mark has been filed by the applicant or a predecessor in the interest of the applicant in the United States Patent and Trademark Office. If an application has previously been filed in the United States Patent and Trademark Office, the applicant must provide full particulars with respect to the previous application, including the:**
 - (A) filing date and serial number of each application;**
 - (B) status of each application; and**
 - (C) reason or reasons for the refusal of the application or the nonregistration of the mark if an application to register the mark was finally refused registration or if an application to register the mark has not resulted in a registration; and**
 - (2) a drawing of the mark that complies with the requirements of the secretary.**
 - ~~(c)~~ **(c) The application shall must be signed and verified by oath, affirmation, or declaration subject to perjury laws by:**
 - ~~(1)~~ **(1) the applicant; or by**
 - ~~(2)~~ **(2) a member of the applicant firm or applicant limited liability company; or**
 - ~~(3)~~ **(3) an officer of the applicant corporation or association.**
- ~~applying.~~ **The application shall must be accompanied by three (3) specimens or facsimiles of such trademark and shall contain a brief description of such trademark as it appears on such specimens or**

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1 ~~facsimiles, showing actual use of the mark.~~ The application for
 2 registration ~~shall~~ **must** be accompanied by a filing fee of ten dollars
 3 ~~(\$10) an application fee, payable to the secretary. of state.~~

4 SECTION 4. IC 24-2-1-4.5 IS ADDED TO THE INDIANA CODE
 5 AS A NEW SECTION TO READ AS FOLLOWS [EFFECTIVE JULY
 6 1, 2005]: **Sec. 4.5. (a) If a person files an application for registration
 7 of a mark and pays the application fee, the secretary may examine
 8 the application for conformity with this chapter.**

9 **(b) An applicant must provide additional information requested
 10 by the secretary, including a description of a design mark.**

11 **(c) An applicant may make or authorize the secretary to make
 12 reasonable amendments to an application that are requested by the
 13 secretary or are considered by the applicant to be advisable to
 14 respond to a rejection or an objection.**

15 **(d) The secretary may require an applicant to submit a new
 16 application if the secretary determines amendments to the
 17 application are necessary and the applicant does not make or
 18 authorize the secretary to make amendments under subsection (c).**

19 **(e) The secretary may require an applicant to disclaim a
 20 component of a mark that is not eligible for registration, and an
 21 applicant may voluntarily disclaim a component of a mark for
 22 which registration is sought. A disclaimer does not prejudice or
 23 affect the applicant's rights:**

24 **(1) existing at the time of application or arising after the
 25 application in the disclaimed matter; or**

26 **(2) on another application if the disclaimed matter is or
 27 becomes distinctive of the applicant's goods or services.**

28 **(f) If an applicant is not entitled to registration of a mark under
 29 this chapter, the secretary shall advise the applicant of the reason
 30 or reasons the applicant is not entitled to registration of the mark.
 31 The applicant has a reasonable time specified by the secretary:**

32 **(1) to reply to the reason or reasons the applicant is not
 33 entitled to registration; or**

34 **(2) to amend the application.**

35 **If the applicant fails to reply to the secretary or to amend the
 36 application in a reasonable time, the application must be
 37 reexamined.**

38 **(g) The procedure under subsection (f) in which the secretary
 39 advises the applicant of the reason or reasons the applicant is not
 40 entitled to registration of the mark and the applicant replies to the
 41 reason or reasons provided by the secretary or amends the
 42 application may be repeated until:**

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- 1 (1) the secretary finally refuses registration of the mark; or
- 2 (2) the applicant fails to reply or amend the application within
- 3 the time specified by the secretary, at which time the
- 4 application is considered to have been abandoned.

5 (h) If the secretary finally refuses registration of a mark, an
 6 applicant may seek a writ of mandamus to compel the registration
 7 of the mark. A writ may be granted without costs to the applicant
 8 on proof that all statements in the application are true and the
 9 mark is entitled to registration.

10 (i) If applications are concurrently processed by the secretary
 11 for registration of the same or confusingly similar marks for the
 12 same or related goods or services, the secretary shall grant priority
 13 to the applications in order of filing. If a previously filed
 14 application is granted a registration, the other application or
 15 applications must be rejected. A rejected applicant may bring an
 16 action for cancellation of the previously registered mark based
 17 upon previous or superior rights to the mark.

18 SECTION 5. IC 24-2-1-5 IS AMENDED TO READ AS FOLLOWS
 19 [EFFECTIVE JULY 1, 2005]: Sec. 5. (a) ~~Upon compliance by the~~ **If an**
 20 applicant **complies** with the requirements of this chapter, the secretary
 21 of state shall ~~cause issue and deliver~~ a certificate of registration ~~to be~~
 22 issued ~~and delivered~~ to the applicant. The certificate of registration
 23 ~~shall must~~ be issued under the signature of the secretary of state and
 24 the seal of the state of Indiana. ~~and it shall show~~ **The certificate of**
 25 **registration must include the following:**

- 26 (1) The name and business address ~~and, if of the person claiming~~
 27 **ownership of the mark. If the person claiming ownership of**
 28 **the mark is:**
 - 29 (A) a corporation, **the certificate of registration must show**
 - 30 the state of incorporation; ~~of the person claiming ownership of~~
 - 31 the trademark;
 - 32 (B) a partnership, **the certificate of registration must show**
 - 33 **the state in which the partnership is organized and the**
 - 34 **names of the general partners, as specified by the**
 - 35 **secretary; or**
 - 36 (C) a limited liability company, **the certificate of**
 - 37 **registration must show the state in which the limited**
 - 38 **liability company is organized.**
- 39 (2) The date claimed for the first use of the trademark ~~in the~~
 40 ~~United States and this state;~~ **mark and the date claimed for the**
 41 **first use of the mark in Indiana.**
- 42 (3) The class of goods or services and a description of the goods

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1 or services on which the ~~trademark~~ **mark** is used.

2 **(4) The class of goods or services and a description of the**

3 **goods or services used in connection with the mark.**

4 **(5) A reproduction of the mark.**

5 **(6) The registration date. and**

6 **(7) The term of the registration. One (1) specimen or facsimile of**

7 **the trademark supplied under section 4 of this chapter shall be**

8 **attached to and made a part of the certificate of registration.**

9 (b) ~~Any~~ **A certificate of registration issued by the secretary of state**

10 **under the provisions of subsection (a) or a copy thereof duty of a**

11 **certificate of registration certified by the secretary of state shall be is**

12 **admissible in evidence as competent and sufficient proof of the**

13 **registration of such trademark the mark in any an action or judicial**

14 **proceedings proceeding in any a court of this state. Indiana.**

15 SECTION 6. IC 24-2-1-6 IS AMENDED TO READ AS FOLLOWS

16 [EFFECTIVE JULY 1, 2005]: Sec. 6. **(a) Registration of a trade-mark**

17 **hereunder shall be mark under this chapter is effective for a term of**

18 **ten (10) five (5) years from the date of registration.**

19 **and upon (b) If a person who registers a mark under subsection**

20 **(a) files an application filed within not more than six (6) months prior**

21 **to before the expiration of such the five (5) year term, on a form to be**

22 **furnished by the secretary of state, in a manner complying with the**

23 **requirements of the secretary, the registration may be renewed for a**

24 **like term an additional five (5) year term commencing at the end of**

25 **the expiring five (5) year term.**

26 **(c) A renewal fee of ten dollars (\$10.00), payable to the secretary of**

27 **state, shall must accompany the application for renewal of the**

28 **registration.**

29 **(d) A trade-mark registration may be renewed for successive periods**

30 **of ten (10) five (5) years in like the manner described in subsection**

31 **(b).**

32 **(e) The secretary of state shall notify the registrants of trade-marks**

33 **marks of the necessity of renewal within the year next preceding the**

34 **expiration of the ten (10) five (5) years from the date of the registration**

35 **by writing to the last known address of the registrants.**

36 SECTION 7. IC 24-2-1-7 IS AMENDED TO READ AS FOLLOWS

37 [EFFECTIVE JULY 1, 2005]: Sec. 7. **(a) Any A registration in force**

38 **on March 8, 1955, shall expire March 8, 1956, unless July 1, 2005,**

39 **continues in full force and effect for the unexpired term of the**

40 **registration and may be renewed by:**

41 **(1) filing an application for renewal with the secretary; of state**

42 **on a form furnished by him and**

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1 (2) paying the renewal fee;
2 ~~described in the manner described in~~ section 6 of this chapter ~~within~~
3 ~~not more than~~ six (6) months ~~prior to~~ before the expiration of the
4 registration.

5 (b) An application for renewal under this chapter, whether for
6 a registration made under this chapter or a registration made
7 under a prior law, must include:

- 8 (1) a verified statement that the mark has been and remains
9 in use; and
- 10 (2) a specimen showing actual use of the mark on or in
11 connection with goods or services.

12 SECTION 8. IC 24-2-1-8 IS AMENDED TO READ AS FOLLOWS
13 [EFFECTIVE JULY 1, 2005]: Sec. 8. ~~Any trademark (a) A mark and~~
14 ~~its the~~ registration of a mark under this chapter ~~shall be~~ are assignable
15 with the:

- 16 (1) good will of the business in which the trademark mark is
17 used; or with that
- 18 (2) part of the good will of the business:
 - 19 (A) connected with the use of the mark; and
 - 20 (B) symbolized by the trademark: use of the mark.

21 (b) ~~Assignment shall~~ An assignment:

- 22 (1) must be made by an instrument in writing duly executed; and
- 23 (2) ~~shall may~~ be recorded with the secretary of state upon the
24 payment of a recording fee of ten dollars (\$10) payable to the
25 secretary. of state who;

26 (c) ~~upon recording of the assignment;~~ The secretary, after
27 recording an assignment, shall issue in the name of the assignee a
28 new certificate of registration for the remainder of the term of the:

- 29 (1) registration; or
- 30 (2) ~~of the last most recent~~ renewal thereof: of the registration.

31 (d) An assignment of ~~any a~~ registration under this chapter ~~shall be~~
32 is void ~~as~~ against ~~any a~~ subsequent purchaser for valuable
33 consideration without notice unless ~~it the~~ assignment is recorded with
34 the secretary of state: not more than three (3) months:

- 35 (1) after the date of the assignment; or
- 36 (2) before the subsequent purchase.

37 SECTION 9. IC 24-2-1-8.5 IS ADDED TO THE INDIANA CODE
38 AS A NEW SECTION TO READ AS FOLLOWS [EFFECTIVE JULY
39 1, 2005]: Sec. 8.5. (a) A registrant or an applicant who changes the
40 name of the person to whom the mark is issued or for whom an
41 application is filed may record a certificate of change of name of
42 the registrant or applicant with the secretary upon the payment of

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a recording fee.

(b) The secretary may issue a new certificate of registration or an assigned application in the name of the assignee. The secretary may issue a new certificate of registration in the name of the assignee for the remainder of the term of the:

- (1) certificate of registration; or
- (2) most recent renewal of the certificate of registration.

SECTION 10. IC 24-2-1-9 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 9. The secretary of state shall keep for public examination a record of all trademarks marks registered or renewed under this chapter as well as a record of all instruments recorded under sections 8 and 8.5 of this chapter.

SECTION 11. IC 24-2-1-10 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 10. The secretary of state shall cancel from the register in whole or in part:

- (1) after March 8, 1956; all registrations under prior statutes which have not been renewed in accordance with this chapter;
- (2) (1) any a registration concerning for which the secretary of state shall receive receives a voluntary request for cancellation thereof from the registrant or the assignee of record;
- (3) (2) all registrations a registration granted under this chapter and not renewed in accordance with the provisions under section 6 of this chapter;
- (4) (3) any a registration concerning for which a court of competent jurisdiction shall find: finds that:
 - (A) that the registered trademark mark has been abandoned;
 - (B) that the registrant is not the owner of the trademark; mark;
 - (C) that the registration was granted improperly; or
 - (D) that the registration was obtained fraudulently; and
- (5) (4) when a registration if a court of competent jurisdiction shall order orders cancellation of a the registration on any ground;
- (6) a mark that is or has become the generic name for the goods or services or a part of the goods or services for which the mark was registered; and
- (7) a mark if the:
 - (A) mark registered under this chapter is so similar to a mark registered in the United States Patent and Trademark Office as to be likely to cause deception, confusion, or mistake between the marks; and
 - (B) mark registered in the United States Patent and

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1 Trademark Office was registered before the filing of the
2 application for registration by the registrant under this
3 chapter.

4 However, a mark is not abandoned and may not be canceled
5 under this subdivision if the registrant proves that the
6 registrant is the owner of a concurrent registration of a mark
7 in the United States Patent and Trademark Office covering an
8 area including Indiana.

9 SECTION 12. IC 24-2-1-11 IS AMENDED TO READ AS
10 FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 11. (a) The following
11 general classes secretary shall adopt rules under IC 4-22-2 to
12 establish:

13 (1) a classification of goods and services are established for
14 convenience of administration of this chapter but not to limit or
15 extend the an applicant's or registrant's rights; and

16 (2) a single application for registration of a trademark mark that:
17 (A) may include any or all goods or services each good upon
18 which a mark is used;

19 (B) may include each service or in connection with which the
20 trademark a mark is actually being used;
21 comprised in a single class; but in no event shall a single
22 application include goods or services upon or in connection
23 with which the trademark is being used which fall within
24 different and

25 (C) must indicate the appropriate class or classes of the
26 goods or services.

27 To the extent practical, the classification of goods or services
28 should conform to the classification of goods or services adopted by
29 the United States Patent and Trademark Office.

30 (b) If a single application includes goods or services that fall
31 within multiple classes, the secretary may require payment of a fee
32 for each class.

- 33 (b) The said classes are as follows:
- 34 (1) Raw or partly prepared materials.
 - 35 (2) Receptacles.
 - 36 (3) Baggage; animal equipments; portfolio; and pocketbooks.
 - 37 (4) Abrasives and polishing materials.
 - 38 (5) Adhesives.
 - 39 (6) Chemicals and chemical compositions.
 - 40 (7) Cordage.
 - 41 (8) Smokers' articles; not including tobacco products.
 - 42 (9) Explosives; firearms; equipments; and projectiles.

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- 1 (10) Fertilizers.
- 2 (11) Inks and inking materials.
- 3 (12) Construction materials.
- 4 (13) Hardware and plumbing and steam-fitting supplies.
- 5 (14) Metals and metal castings and forgings.
- 6 (15) Oils and greases.
- 7 (16) Paints and painters' materials.
- 8 (17) Tobacco products.
- 9 (18) Medicines and pharmaceutical preparations.
- 10 (19) Vehicles.
- 11 (20) Linoleum and oiled cloth.
- 12 (21) Electrical apparatus, machines, and supplies.
- 13 (22) Games, toys, and sporting goods.
- 14 (23) Cutlery, machinery, and tools, and parts thereof.
- 15 (24) Laundry appliances and machines.
- 16 (25) Locks and safes.
- 17 (26) Measuring and scientific appliances.
- 18 (27) Horological instruments.
- 19 (28) Jewelry and precious-metal ware.
- 20 (29) Brooms, brushes, and dusters.
- 21 (30) Crockery, earthenware, and porcelain.
- 22 (31) Filters and refrigerators.
- 23 (32) Furniture and upholstery.
- 24 (33) Glassware.
- 25 (34) Heating, lighting, and ventilating apparatus.
- 26 (35) Belting, hose, machinery packing, and nonmetallic tires.
- 27 (36) Musical instruments and supplies.
- 28 (37) Paper and stationery.
- 29 (38) Prints and publications.
- 30 (39) Clothing.
- 31 (40) Fancy goods, furnishings, and notions.
- 32 (41) Canes, parasols, and umbrellas.
- 33 (42) Knitted, netted and textile fabrics, and substitutes thereof.
- 34 (43) Thread and yarn.
- 35 (44) Dental, medical, and surgical appliances.
- 36 (45) Soft drinks and carbonated waters.
- 37 (46) Foods and ingredients of foods.
- 38 (47) Wines.
- 39 (48) Malt beverages and liquors.
- 40 (49) Distilled alcoholic liquors.
- 41 (50) Cosmetics and toilet preparations.
- 42 (51) Detergents and soaps.

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- 1 ~~(52) Merchandise not otherwise classified.~~
- 2 ~~(53) Miscellaneous.~~
- 3 ~~(54) Advertising and business.~~
- 4 ~~(55) Insurance and financial.~~
- 5 ~~(56) Construction and repair.~~
- 6 ~~(57) Communication.~~
- 7 ~~(58) Transportation and storage.~~
- 8 ~~(59) Material treatment.~~
- 9 ~~(60) Education and entertainment.~~

10 SECTION 13. IC 24-2-1-12 IS AMENDED TO READ AS
 11 FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 12. ~~(a) Any~~ **A** person
 12 who ~~shall for himself, or on behalf of any other person, procure the~~
 13 ~~filing or registration of any trade-mark files an application for~~
 14 ~~registration of a mark or registers a mark~~ in the office of the
 15 secretary of state under the provisions hereof; ~~this chapter~~ by
 16 knowingly making any a false or fraudulent representation or
 17 declaration ~~orally~~, in writing, or by ~~any other fraudulent means, shall~~
 18 ~~be is~~ liable to pay for all damages sustained in consequence of ~~such the~~
 19 ~~filing or registration. to be~~

20 **(b) The damages may be recovered by or on behalf of the injured**
 21 ~~party injured thereby in any a court of competent jurisdiction.~~

22 SECTION 14. IC 24-2-1-13 IS AMENDED TO READ AS
 23 FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 13. Subject to the
 24 provisions of section 15 of this chapter, ~~any a person who: shall:~~

25 ~~(a) (1) use; uses,~~ without the consent of the registrant, ~~any a~~
 26 ~~reproduction, counterfeit, copy, or colorable imitation of a~~
 27 ~~trademark mark~~ registered under this chapter in:

28 **(A)** connection with the sale, offering for sale, **distribution**, or
 29 advertising of any goods or services; **or**

30 **(B)** ~~on or in connection with which such use a manner that is~~
 31 likely to cause confusion, ~~or mistake, or to deceive as to result~~
 32 **in deception regarding** the source ~~or of~~ origin of ~~such the~~
 33 goods or services; **or**

34 ~~(b) (2) reproduce; counterfeit; copy; reproduces, counterfeits, or~~
 35 **copies a mark** or colorably imitate any such trademark ~~renders~~
 36 **a color imitation of a mark** and ~~apply such~~ **applies the**
 37 reproduction, counterfeit, copy, or colorable imitation to labels,
 38 signs, prints, packages, wrappers, receptacles, or advertisements
 39 intended to be ~~used upon or used:~~

40 **(A)** in ~~conjunction~~ **connection** with the sale or other
 41 distribution **of the goods or services in this state Indiana; or**

42 **(B)** of such goods or services **on the goods or services;**

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1 shall be is liable to in a civil action brought by the owner of such
2 registered trademark registrant for any or all of the remedies provided
3 in section 14 of this chapter, except that under subdivision (b) (2) the
4 registrant shall is not be entitled to recover profits or damages unless
5 the acts have been are committed with knowledge that such trademark
6 is intended to be used the intent to cause deception, confusion, or
7 mistake. or to deceive.

8 SECTION 15. IC 24-2-1-13.5 IS ADDED TO THE INDIANA
9 CODE AS A NEW SECTION TO READ AS FOLLOWS
10 [EFFECTIVE JULY 1, 2005]: Sec. 13.5. (a) An owner of a mark that
11 is famous in Indiana is entitled, subject to the principles of equity
12 and terms a court considers reasonable, to an injunction against
13 another person's commercial use of the mark or trade name if the
14 other person's use begins after the mark has become famous and
15 the other person's use causes dilution of the distinctive quality of
16 the mark. In determining whether a mark is distinctive and
17 famous, a court may consider factors such as:

- 18 (1) the degree of inherent or acquired distinctiveness of the
- 19 mark in Indiana;
- 20 (2) the duration and extent of use of the mark in connection
- 21 with the goods or services with which the mark is used;
- 22 (3) the duration and extent of advertising and publicity of the
- 23 mark in Indiana;
- 24 (4) the geographical extent of the trading area in which the
- 25 mark is used;
- 26 (5) the channels of trade for the goods or services with which
- 27 the mark is used;
- 28 (6) the degree of recognition of the mark in the trading areas
- 29 and channels of trade in Indiana as it relates to the use of the
- 30 mark by the:
 - 31 (A) mark's owner; and
 - 32 (B) person against whom the injunction is sought;
- 33 (7) the nature and extent of use of the same or a similar mark
- 34 by a third party; and
- 35 (8) whether the mark is the subject of a:
 - 36 (A) registration in Indiana;
 - 37 (B) federal registration under the Act of March 3, 1881;
 - 38 (C) federal registration under the Act of February 20,
 - 39 1905; or
 - 40 (D) registration on the principal register.

41 (b) In an action brought under this section, the owner of a
42 famous mark is entitled only to injunctive relief unless the person

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against whom the injunctive relief is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If willful intent is proven, the owner of the famous mark is entitled to the other remedies set forth in this chapter, subject to the discretion of the court and the principles of equity.

(c) The following are not actionable under this section:

(1) Fair use of a famous mark by another person in comparative commercial advertising or promotion.

(2) Noncommercial use of the mark.

(3) All forms of news reporting and news commentary.

SECTION 16. IC 24-2-1-14 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 14. (a) ~~Any~~ **An** owner of a ~~trademark~~ **mark** registered under this chapter may ~~proceed by suit~~ **bring an action** to enjoin the manufacture, ~~use~~, display, or sale of any ~~counterfeits~~ **a counterfeit** or ~~imitations thereof~~, **imitation mark**, and any a court of competent jurisdiction may grant ~~injunctions~~ **an injunction** to restrain ~~such~~ **the** manufacture, ~~use~~, display, or sale of ~~the counterfeit or imitation mark~~ **as may be** by the said court ~~deemed~~ **considers** just and reasonable. ~~and~~

(b) **A court** may:

(1) require ~~the~~ **a** defendant to pay to ~~such~~ **the** owner of a mark all:

(A) profits derived from; ~~and/or all~~ **and**

(B) damages suffered by reason of;

~~such~~ **the** wrongful manufacture, ~~use~~, display, or sale of ~~the mark~~; and

(2) ~~such~~ **court** may also order that any ~~such~~ **counterfeits** a ~~counterfeit~~ or ~~imitations~~ **imitation mark** in the possession or under the control of ~~any~~ **a** defendant in ~~such~~ **the** case be delivered to an officer of the court or to the complainant ~~to be destroyed for~~ **destruction of the counterfeit or imitation mark**.

(c) **In addition to amounts a court may award under subsection (b), a court may enter judgment for:**

(1) **an amount not to exceed three (3) times the profits derived from the wrongful manufacture, display, or sale of the mark;**

(2) **an amount not to exceed three (3) times the damages suffered by reason of the wrongful manufacture, display, or sale of the mark; and**

(3) **reasonable attorney's fees;**

if the court finds the defendant knowingly committed wrongful acts or committed acts in bad faith, or if the court finds other aggravating circumstances.

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1 ~~(b)~~ **(d)** The ~~enumeration invocation~~ of any a right or remedy in this
2 chapter ~~shall~~ **does** not affect a registrant's right to **prosecute**
3 **prosecution** under any a penal law. ~~of this state.~~

4 SECTION 17. IC 24-2-1-14.5 IS ADDED TO THE INDIANA
5 CODE AS A **NEW** SECTION TO READ AS FOLLOWS
6 [EFFECTIVE JULY 1, 2005]: **Sec. 14.5. (a) An action for**
7 **cancellation of a mark registered under this chapter or an action**
8 **in mandamus to compel registration of a mark under this chapter**
9 **must be brought in the circuit court of the county in which the**
10 **registrant or person seeking registration or cancellation is located.**

11 **(b) An action in mandamus is based solely on the record before**
12 **the secretary.**

13 **(c) This subsection applies to an action for cancellation of a**
14 **mark. The secretary:**

- 15 **(1) may not be made a party to an action; and**
- 16 **(2) must be notified of the filing of a complaint in an action by**
17 **the clerk of the court in which the complaint is filed.**

18 **(d) The secretary is entitled to intervene in an action for**
19 **cancellation of a mark.**

20 **(e) A person who files an action under this section may serve the**
21 **registrant of a mark who does not reside in Indiana by serving the**
22 **secretary, as an agent for service, in the manner prescribed by**
23 **Indiana Trial Rule 4.10.**

24 SECTION 18. IC 24-2-1-15 IS AMENDED TO READ AS
25 FOLLOWS [EFFECTIVE JULY 1, 2005]: ~~Sec. 15. Nothing herein~~
26 ~~shall~~ **This chapter does not** adversely affect the rights or the
27 enforcement of rights in ~~trade-marks~~ **a mark** acquired in good faith at
28 any time at common law.

29 SECTION 19. IC 24-2-1-15.3 IS ADDED TO THE INDIANA
30 CODE AS A **NEW** SECTION TO READ AS FOLLOWS
31 [EFFECTIVE JULY 1, 2005]: **Sec. 15.3. (a) The secretary shall adopt**
32 **rules under IC 4-22-2 to establish:**

- 33 **(1) an application fee;**
- 34 **(2) a renewal fee;**
- 35 **(3) a recording fee; and**
- 36 **(4) fees for related services.**

37 **(b) A fee is nonrefundable unless otherwise specified in the rules**
38 **adopted by the secretary under subsection (a).**

39 SECTION 20. THE FOLLOWING ARE REPEALED [EFFECTIVE
40 JULY 1, 2005]: IC 24-2-1-1; IC 24-2-1-16.

41 SECTION 21. [EFFECTIVE JULY 1, 2005] **The provisions of this**
42 **act do not affect a legal proceeding or appeal initiated under**

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1 **IC 24-2-1 before July 1, 2005.**

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COMMITTEE REPORT

Mr. Speaker: Your Committee on Commerce, Economic Development and Small Business, to which was referred House Bill 1673, has had the same under consideration and begs leave to report the same back to the House with the recommendation that said bill be amended as follows:

Page 9, line 32, reset in roman "The secretary".

Page 9, line 32, reset in roman "shall notify the registrants of".

Page 9, line 32, after "trade-marks" insert "**marks**".

Page 9, line 32, after "trade-marks" reset in roman "of".

Page 9, reset in roman line 33.

Page 9, line 34, reset in roman "of the".

Page 9, line 34, after "(10)" insert "**five (5)**".

Page 9, line 34, reset in roman "years from the date of the registration by writing to the".

Page 9, reset in roman line 35.

Page 17, line 35, after "to" insert "**an action for cancellation of a mark**".

Page 17, line 37, delete "filed in;" and insert "**filed.**".

Page 17, delete line 38.

and when so amended that said bill do pass.

(Reference is to HB 1673 as introduced.)

BORROR, Chair

Committee Vote: yeas 10, nays 0.

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HOUSE MOTION

Mr. Speaker: I move that House Bill 1673 be amended to read as follows:

Page 4, line 24, after ";" insert "**or**".

Page 5, line 30, delete "the".

Page 9, line 32, before "The" insert "(e)".

Page 11, delete lines 8 through 28.

Page 11, line 33, after "8" delete "," and insert "**and**".

Page 11, line 33, after "8.5" delete ", and 8.7".

Page 17, line 34, after "(c)" insert "**This subsection applies to an action for cancellation of a mark.**".

Page 17, line 35, delete "for cancellation of a".

Page 17, line 36, delete "mark".

Page 17, line 37, after "complaint" insert "**in an action**".

Renumber all SECTIONS consecutively.

(Reference is to HB 1673 as printed January 28, 2005.)

HARRIS T

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