

HOUSE BILL No. 1673

DIGEST OF INTRODUCED BILL

Citations Affected: IC 24-2-1.

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

January 19, 2005, read first time and referred to Committee on Commerce, Economic Development and Small Business.

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

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

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

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

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

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

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

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

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

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

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

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

(C) on a service if:

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

SECTION 2. IC 24-2-1-3 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 3. A trademark mark by which the 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;

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)** the 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 ~~duly 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~~ **an** action or judicial**
 14 **proceedings ~~proceeding~~ in ~~any a~~ **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 **The secretary of state shall notify the registrants of trade-marks of**
 33 **the necessity of renewal within the year next preceding the expiration**
 34 **of the ~~ten (10) years~~ from the date of the registration by writing to the**
 35 **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 24-2-1-8.7 IS ADDED TO THE INDIANA CODE AS A NEW SECTION TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 8.7. (a) A license, security interest, mortgage, or other instrument that relates to a mark registered under this chapter or an application for registration pending under this chapter may be recorded at the discretion of the secretary upon the payment of a recording fee, if the license, security interest, mortgage, or other instrument is in writing and is executed.

(b) An acknowledgment is prima facie evidence of the execution of:

- (1) a license;
- (2) a security interest;
- (3) a mortgage; or
- (4) another instrument that relates to a mark;

and, if an instrument described in subdivisions (1) through (4) is recorded by the secretary, the recording of the instrument is prima facie evidence of execution.

(c) A photocopy of an instrument referred to in subsection (b) must be accepted for recording if the photocopy is certified by the owner of the instrument or a successor of the owner of the instrument to be a true and correct copy of the original.

SECTION 11. 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, 8.5, and 8.7 of this chapter.

SECTION 12. 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

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1 and not renewed in accordance with the provisions under section
 2 6 of this chapter;
 3 ~~(4)~~ **(3) any a registration concerning for** which a court of
 4 competent jurisdiction ~~shall find:~~ **finds that:**
 5 (A) ~~that~~ the registered trademark mark has been abandoned;
 6 (B) ~~that~~ the registrant is not the owner of the trademark;
 7 **mark;**
 8 (C) ~~that~~ the registration was granted improperly; or
 9 (D) ~~that~~ the registration was obtained fraudulently; and
 10 ~~(5)~~ **(4) when a registration if** a court of competent jurisdiction
 11 ~~shall order~~ **orders** cancellation of ~~a~~ **the** registration on any
 12 ground;
 13 **(5) a mark that is or has become the generic name for the**
 14 **goods or services or a part of the goods or services for which**
 15 **the mark was registered; and**
 16 **(6) a mark if the:**
 17 (A) **mark registered under this chapter is so similar to a**
 18 **mark registered in the United States Patent and**
 19 **Trademark Office as to be likely to cause deception,**
 20 **confusion, or mistake between the marks; and**
 21 (B) **mark registered in the United States Patent and**
 22 **Trademark Office was registered before the filing of the**
 23 **application for registration by the registrant under this**
 24 **chapter.**
 25 **However, a mark is not abandoned and may not be canceled**
 26 **under this subdivision if the registrant proves that the**
 27 **registrant is the owner of a concurrent registration of a mark**
 28 **in the United States Patent and Trademark Office covering an**
 29 **area including Indiana.**
 30 SECTION 13. IC 24-2-1-11 IS AMENDED TO READ AS
 31 FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 11. (a) The following
 32 general classes secretary shall adopt rules under IC 4-22-2 to
 33 establish:
 34 (1) a classification of goods and services ~~are established~~ for
 35 convenience of administration of this chapter but not to limit or
 36 extend ~~the an~~ applicant's or registrant's rights; and
 37 (2) a single application for registration of a trademark mark that:
 38 (A) may include any or all goods or services **each good** upon
 39 **which a mark is used;**
 40 (B) **may include each service or in connection with which the**
 41 **trademark a mark is actually being used;**
 42 **comprised in a single class, but in no event shall a single**

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1 application include goods or services upon or in connection
 2 with which the trademark is being used which fall within
 3 different and

4 **(C) must indicate the appropriate class or classes of the**
 5 goods or services.

6 **To the extent practical, the classification of goods or services**
 7 **should conform to the classification of goods or services adopted by**
 8 **the United States Patent and Trademark Office.**

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

12 (b) The said classes are as follows:

- 13 (1) Raw or partly prepared materials:
- 14 (2) Receptacles:
- 15 (3) Baggage; animal equipments; portfolio; and pocketbooks:
- 16 (4) Abrasives and polishing materials:
- 17 (5) Adhesives:
- 18 (6) Chemicals and chemical compositions:
- 19 (7) Cordage:
- 20 (8) Smokers' articles; not including tobacco products:
- 21 (9) Explosives; firearms; equipments; and projectiles:
- 22 (10) Fertilizers:
- 23 (11) Inks and inking materials:
- 24 (12) Construction materials:
- 25 (13) Hardware and plumbing and steam-fitting supplies:
- 26 (14) Metals and metal castings and forgings:
- 27 (15) Oils and greases:
- 28 (16) Paints and painters' materials:
- 29 (17) Tobacco products:
- 30 (18) Medicines and pharmaceutical preparations:
- 31 (19) Vehicles:
- 32 (20) Linoleum and oiled cloth:
- 33 (21) Electrical apparatus; machines; and supplies:
- 34 (22) Games; toys; and sporting goods:
- 35 (23) Cutlery; machinery; and tools; and parts thereof:
- 36 (24) Laundry appliances and machines:
- 37 (25) Locks and safes:
- 38 (26) Measuring and scientific appliances:
- 39 (27) Horological instruments:
- 40 (28) Jewelry and precious-metal ware:
- 41 (29) Brooms; brushes; and dusters:
- 42 (30) Crockery; earthenware; and porcelain:

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- 1 (31) Filters and refrigerators:
- 2 (32) Furniture and upholstery:
- 3 (33) Glassware:
- 4 (34) Heating, lighting, and ventilating apparatus:
- 5 (35) Belting, hose, machinery packing, and nonmetallic tires:
- 6 (36) Musical instruments and supplies:
- 7 (37) Paper and stationery:
- 8 (38) Prints and publications:
- 9 (39) Clothing:
- 10 (40) Fancy goods, furnishings, and notions:
- 11 (41) Canes, parasols, and umbrellas:
- 12 (42) Knitted, netted and textile fabrics, and substitutes thereof:
- 13 (43) Thread and yarn:
- 14 (44) Dental, medical, and surgical appliances:
- 15 (45) Soft drinks and carbonated waters:
- 16 (46) Foods and ingredients of foods:
- 17 (47) Wines:
- 18 (48) Malt beverages and liquors:
- 19 (49) Distilled alcoholic liquors:
- 20 (50) Cosmetics and toilet preparations:
- 21 (51) Detergents and soaps:
- 22 (52) Merchandise not otherwise classified:
- 23 (53) Miscellaneous:
- 24 (54) Advertising and business:
- 25 (55) Insurance and financial:
- 26 (56) Construction and repair:
- 27 (57) Communication:
- 28 (58) Transportation and storage:
- 29 (59) Material treatment:
- 30 (60) Education and entertainment:

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31 SECTION 14. IC 24-2-1-12 IS AMENDED TO READ AS
 32 FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 12. (a) ~~Any~~ A person
 33 who shall for himself, or on behalf of any other person, procure the
 34 filing or registration of any trade-mark files an application for
 35 registration of a mark or registers a mark in the office of the
 36 secretary of state under the provisions hereof, this chapter by
 37 knowingly making any a false or fraudulent representation or
 38 declaration orally, in writing, or by any other fraudulent means, shall
 39 be is liable to pay for all damages sustained in consequence of such the
 40 filing or registration. to be

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



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

4 ~~(a) (1) use,~~ **uses**, without the consent of the registrant, ~~any~~ a
5 reproduction, counterfeit, copy, or colorable imitation of a
6 ~~trademark mark~~ registered under this chapter in:

7 (A) connection with the sale, offering for sale, **distribution**, or
8 advertising of ~~any~~ goods or services; **or**

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

13 ~~(b) (2) reproduce, counterfeit, copy,~~ **reproduces, counterfeits, or**
14 **copies a mark** or colorably imitate any such trademark ~~renders~~
15 **a color imitation of a mark** and ~~apply such~~ **applies the**
16 reproduction, counterfeit, copy, or colorable imitation to labels,
17 signs, prints, packages, wrappers, receptacles, or advertisements
18 intended to be ~~used upon or used:~~

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

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

22 ~~shall be~~ **is liable to in** a civil action **brought** by the owner of such
23 registered trademark ~~registrant~~ for ~~any or all of~~ the remedies provided
24 in ~~section 14~~ of this chapter, except that under subdivision ~~(b) (2)~~ the
25 registrant ~~shall is~~ not be entitled to recover profits or damages unless
26 the acts ~~have been~~ **are** committed with knowledge that such trademark
27 is intended to be used ~~the intent~~ to cause **deception**, confusion, or
28 mistake. ~~or to deceive:~~

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

39 (1) **the degree of inherent or acquired distinctiveness of the**
40 **mark in Indiana;**

41 (2) **the duration and extent of use of the mark in connection**
42 **with the goods or services with which the mark is used;**

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- 1 **(3) the duration and extent of advertising and publicity of the**
- 2 **mark in Indiana;**
- 3 **(4) the geographical extent of the trading area in which the**
- 4 **mark is used;**
- 5 **(5) the channels of trade for the goods or services with which**
- 6 **the mark is used;**
- 7 **(6) the degree of recognition of the mark in the trading areas**
- 8 **and channels of trade in Indiana as it relates to the use of the**
- 9 **mark by the:**
- 10 **(A) mark's owner; and**
- 11 **(B) person against whom the injunction is sought;**
- 12 **(7) the nature and extent of use of the same or a similar mark**
- 13 **by a third party; and**
- 14 **(8) whether the mark is the subject of a:**
- 15 **(A) registration in Indiana;**
- 16 **(B) federal registration under the Act of March 3, 1881;**
- 17 **(C) federal registration under the Act of February 20,**
- 18 **1905; or**
- 19 **(D) registration on the principal register.**

20 **(b) In an action brought under this section, the owner of a**
 21 **famous mark is entitled only to injunctive relief unless the person**
 22 **against whom the injunctive relief is sought willfully intended to**
 23 **trade on the owner's reputation or to cause dilution of the famous**
 24 **mark. If willful intent is proven, the owner of the famous mark is**
 25 **entitled to the other remedies set forth in this chapter, subject to**
 26 **the discretion of the court and the principles of equity.**

- 27 **(c) The following are not actionable under this section:**
- 28 **(1) Fair use of a famous mark by another person in**
 - 29 **comparative commercial advertising or promotion.**
 - 30 **(2) Noncommercial use of the mark.**
 - 31 **(3) All forms of news reporting and news commentary.**

32 **SECTION 17. IC 24-2-1-14 IS AMENDED TO READ AS**
 33 **FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 14. (a) ~~Any~~ An owner**
 34 **of a trademark mark registered under this chapter may ~~proceed by suit~~**
 35 **bring an action to enjoin the manufacture, ~~use~~, display, or sale of any**
 36 **counterfeits a counterfeit or imitations thereof, imitation mark, and**
 37 **any a court of competent jurisdiction may grant injunctions an**
 38 **injunction to restrain such the manufacture, ~~use~~, display, or sale of the**
 39 **counterfeit or imitation mark as may be by the said court deemed**
 40 **considers just and reasonable. ~~and~~**

- 41 **(b) A court may:**
- 42 **(1) require ~~the~~ a defendant to pay to such the owner of a mark**

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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.

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

SECTION 18. IC 24-2-1-14.5 IS ADDED TO THE INDIANA
 CODE AS A NEW SECTION TO READ AS FOLLOWS
 [EFFECTIVE JULY 1, 2005]: Sec. 14.5. (a) An action for
 cancellation of a mark registered under this chapter or an action
 in mandamus to compel registration of a mark under this chapter
 must be brought in the circuit court of the county in which the
 registrant or person seeking registration or cancellation is located.

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

(c) The secretary:

(1) may not be made a party to; and

(2) must be notified of the filing of a complaint by the clerk of
 the court in which the complaint is filed in;

an action for cancellation of a mark.

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

(e) A person who files an action under this section may serve the
 registrant of a mark who does not reside in Indiana by serving the

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1 **secretary, as an agent for service, in the manner prescribed by**
 2 **Indiana Trial Rule 4.10.**
 3 SECTION 19. IC 24-2-1-15 IS AMENDED TO READ AS
 4 FOLLOWS [EFFECTIVE JULY 1, 2005]: Sec. 15. ~~Nothing herein~~
 5 ~~shall~~ **This chapter does not** adversely affect the rights or the
 6 enforcement of rights in ~~trade-marks~~ **a mark** acquired in good faith at
 7 any time at common law.
 8 SECTION 20. IC 24-2-1-15.3 IS ADDED TO THE INDIANA
 9 CODE AS A **NEW** SECTION TO READ AS FOLLOWS
 10 [EFFECTIVE JULY 1, 2005]: **Sec. 15.3. (a) The secretary shall adopt**
 11 **rules under IC 4-22-2 to establish:**
 12 (1) **an application fee;**
 13 (2) **a renewal fee;**
 14 (3) **a recording fee; and**
 15 (4) **fees for related services.**
 16 (b) **A fee is nonrefundable unless otherwise specified in the rules**
 17 **adopted by the secretary under subsection (a).**
 18 SECTION 21. THE FOLLOWING ARE REPEALED [EFFECTIVE
 19 JULY 1, 2005]: IC 24-2-1-1; IC 24-2-1-16.
 20 SECTION 22. [EFFECTIVE JULY 1, 2005] **The provisions of this**
 21 **act do not affect a legal proceeding or appeal initiated under**
 22 **IC 24-2-1 before July 1, 2005.**

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