



February 10, 2006

**ENGROSSED
HOUSE BILL No. 1353**

DIGEST OF HB 1353 (Updated February 8, 2006 11:05 am - DI 106)

Citations Affected: IC 24-2; IC 32-36; noncode.

Synopsis: Trademarks, service marks, and rights of publicity. Conforms certain provisions of the Indiana trademark act to the Model Trademark Act and repeals obsolete provisions of the Indiana Trademark Act. Specifies that a judicial or administrative interpretation of the federal trademark act may be considered as persuasive authority in construing provisions of the Indiana trademark act. Provides that a person's heirs, assigns, or estate may not claim a property interest in the right of publicity of a person if the publicity is related to the person's criminal involvement in a criminal offense.

Effective: July 1, 2006.

Walorski, Heim, Crooks, Thomas

(SENATE SPONSORS — BRAY, BRODEN)

January 12, 2006, read first time and referred to Committee on Commerce, Economic Development and Small Business.

January 19, 2006, reported — Do Pass.

January 23, 2006, read second time, amended, ordered engrossed.

January 24, 2006, engrossed.

January 26, 2006, read third time, passed. Yeas 92, nays 0.

SENATE ACTION

February 1, 2006, read first time and referred to Committee on Judiciary.

February 9, 2006, amended, reported favorably — Do Pass.

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February 10, 2006

Second Regular Session 114th General Assembly (2006)

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 2005 Regular Session of the General Assembly.

ENGROSSED HOUSE BILL No. 1353



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 24-2-1-0.5 IS ADDED TO THE INDIANA CODE
2 AS A **NEW** SECTION TO READ AS FOLLOWS [EFFECTIVE JULY
3 1, 2006]: **Sec. 0.5. This chapter is intended to provide a system of**
4 **state trademark registration and protection that is consistent with**
5 **the federal system of trademark registration and protection under**
6 **the Trademark Act of 1946. A judicial or an administrative**
7 **interpretation of a provision of the federal Trademark Act may be**
8 **considered as persuasive authority in construing a provision of this**
9 **chapter.**

10 SECTION 2. IC 24-2-1-2 IS AMENDED TO READ AS FOLLOWS
11 [EFFECTIVE JULY 1, 2006]: Sec. 2. ~~As used in this chapter:~~ **The**
12 **following definitions apply throughout this chapter:**

13 (1) "Abandoned" means either of the following:

14 (A) **The person who owns the mark has discontinued use of**
15 **the mark and does not intend to resume use of the mark. A**
16 **person's intent not to resume use of the mark may be**
17 **inferred from the circumstances. Three (3) consecutive**

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EH 1353—LS 7131/DI 110+



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years without use of a mark constitutes prima facie evidence that the use of the mark has been abandoned.

(B) The conduct of the owner, including an act or omission, has caused the mark to lose its significance as a mark.

(2) "Applicant" means a person who files an application for registration of a mark under this chapter and the legal representatives, successors, or assigns of the person.

(3) "Dilution" means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless 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) a corporation;

(C) a partnership;

(D) a limited liability company; or

(E) any other entity or organization:

(i) capable of suing and being sued in a court of law;

(ii) entitled to a benefit or privilege under this chapter; or

(iii) 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 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, even if the source is unknown.

Titles and character names and other distinctive features of radio or television programs used by a person may be

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registered as a service mark even though the radio or television programs may advertise the goods of the sponsor.

(a) The term (9) "Trademark" means any 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; and distinguish goods, including a unique product, of a person and distinguish the person's goods from goods manufactured or sold by another person; and

(B) indicate the source of the goods, even if the source 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 or in connection with a good if the:
 - (i) mark is placed in any manner on the good, a container for the good, a display associated with the good, or a tag or label affixed to the good; or
 - (ii) nature of the good makes placement of the mark as described in item (i) impracticable and the mark is placed on a document associated with the good or with the sale of the good; and
- (B) if the good described in clause (A) is sold or

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transported in Indiana.
A mark is considered to be in use on or in connection with a service if the mark is used or displayed in the sale or advertising of the service and the service is rendered in Indiana.

SECTION 3. IC 24-2-1-3 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 3. A ~~trademark~~ **mark** by which the goods or services of ~~any an~~ applicant for registration may be distinguished from ~~the other~~ goods or services of others ~~shall may~~ not be registered if ~~it~~ **the mark:**

- ~~(a)~~ **(1)** consists of or comprises immoral, deceptive, or scandalous matter;
 - ~~(b)~~ **(2)** consists of or comprises matter ~~which~~ **that** may:
 - (A)** disparage or falsely suggest a connection with:
 - (i)** persons living or dead;
 - (ii)** institutions;
 - (iii)** beliefs; or
 - (iv)** national symbols; or
 - (B)** bring ~~them~~ into contempt or disrepute: a
 - (i)** persons living or dead;
 - (ii)** institutions;
 - (iii)** beliefs; or
 - (iv)** national symbols;
 - ~~(c)~~ **(3)** consists of or comprises the flag, ~~or~~ coat of arms, or other insignia of:
 - (A)** the United States;
 - (B)** ~~or of any a~~ state or municipality;
 - (C)** ~~or of the~~ United Nations; or
 - (D)** ~~of any a~~ foreign nation; ~~or any simulation thereof;~~
 - ~~(d)~~ **(4)** consists of or comprises the name, signature, or portrait of ~~any~~ **identifying a particular** living individual, ~~except with his~~ **unless the individual provides** written consent; ~~or~~
 - ~~(e)~~ consists of **(5)** is a mark ~~which:~~ **that:**
 - ~~(1)~~ when applied to **(A)** **if used on or in connection with** the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of ~~them~~ **the goods or services;**
 - ~~(2)~~ when applied to **(B)** **if used on or in connection with** the goods or services of the applicant, is primarily geographically descriptive or deceptively **geographically** misdescriptive of ~~them~~ **the goods or services;** or
 - ~~(3)~~ **(C)** is primarily merely a surname.
- Provided; however; that nothing in This subdivision ~~shall~~ **does**

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

23 SECTION 4. IC 24-2-1-4 IS AMENDED TO READ AS FOLLOWS
 24 [EFFECTIVE JULY 1, 2006]: Sec. 4. (a) Subject to the limitations set
 25 forth ~~in of~~ this chapter, any a person who ~~adopts and~~ uses a trademark
 26 ~~in this state~~ **mark in Indiana** may file in the office of the secretary, of
 27 ~~state, on a form to be furnished by the secretary of state; in a manner~~
 28 **that complies with the requirements of the secretary,** an application
 29 for registration of ~~that trademark setting the mark. The application~~
 30 **must forth; but not limited to; include** the following information:

- 31 ~~(a)~~ **(1)** The name and business address of the person applying for
 32 such registration **of the mark,** and:
 33 (A) if **the applicant is** a corporation, the state of
 34 incorporation;
 35 (B) if **the applicant is a partnership, the:**
 36 (i) **state in which the partnership is organized; and**
 37 (ii) **names of the general partners, as specified by the**
 38 **secretary; or**
 39 (C) if **the applicant is another form of legal entity, the**
 40 **jurisdiction in which the legal entity was organized.**
 41 ~~(b)~~ **(2)** The:
 42 (A) goods or services **on or in connection with which the**

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mark is used; in connection with which the mark,
 is used; and the
 (B) mode or manner in which the mark is used on or in
 connection with such the goods or services; and the
 (C) class in which such the goods or services fall.

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

(d) (4) A statement that:

(A) that the applicant is the owner of the trademark mark;
 (B) the mark is in use; and that no other
 (C) to the knowledge of the person verifying the
 application, another person: has

(i) has not registered the mark, either federally or in
 Indiana; or
 (ii) 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 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.

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1 (c) The application ~~shall~~ **must** be signed and verified **under oath,**
2 **affirmation, or declaration subject to perjury laws** by:

3 (1) the applicant; ~~or by~~

4 (2) a member of the **applicant** firm or **applicant** limited liability
5 company; or

6 (3) an officer of the **applicant** corporation, ~~or association,~~
7 ~~applying~~ **or other form of legal entity.**

8 The application ~~shall~~ **must** be accompanied by three (3) specimens ~~or~~
9 facsimiles of such trademark and shall contain a brief description of
10 such trademark as it appears on such specimens or facsimiles: **showing**
11 **actual use of the mark.** The application for registration ~~shall~~ **must** be
12 accompanied by a filing fee of ten dollars (~~\$10~~) **an application fee**
13 payable to the secretary. ~~of state.~~

14 SECTION 5. IC 24-2-1-4.5 IS ADDED TO THE INDIANA CODE
15 AS A NEW SECTION TO READ AS FOLLOWS [EFFECTIVE JULY
16 1, 2006]: **Sec. 4.5. (a) If a person files an application for registration**
17 **of a mark and pays the application fee, the secretary may examine**
18 **the application for conformity with this chapter.**

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

21 (c) **An applicant may make or authorize the secretary to make**
22 **reasonable amendments to an application that are requested by the**
23 **secretary or are considered by the applicant to be advisable to**
24 **respond to a rejection or an objection.**

25 (d) **The secretary may require an applicant to submit a new**
26 **application if the secretary determines amendments to the**
27 **application are necessary and the applicant does not make or**
28 **authorize the secretary to make amendments under subsection (c).**

29 (e) **The secretary may require an applicant to disclaim a**
30 **component of a mark that is not eligible for registration, and an**
31 **applicant may voluntarily disclaim a component of a mark for**
32 **which registration is sought. A disclaimer does not prejudice or**
33 **affect the applicant's rights:**

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

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

38 (f) **If an applicant is not entitled to registration of a mark under**
39 **this chapter, the secretary shall advise the applicant of the reason**
40 **the applicant is not entitled to registration of the mark. The**
41 **applicant has a reasonable time specified by the secretary:**

42 (1) **to reply to the reason the applicant is not entitled to**

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registration; or
(2) to amend the application.
If the applicant replies to the secretary or amends the application within the reasonable time, the secretary shall reexamine the application.

(g) The procedure under subsection (f) may be repeated until:
(1) the secretary finally refuses registration of the mark; or
(2) the applicant fails to reply or amend the application within the time specified by the secretary, at which time the secretary shall consider the application to have been withdrawn.

(h) If the secretary issues a final order refusing the registration of a mark, an applicant may bring a civil action in a court with jurisdiction to compel the registration of the mark. A court may order the secretary to register a mark, without costs to the secretary, on proof that all statements in the application are true and the mark is entitled to registration.

(i) If two (2) or more applications are concurrently processed by the secretary for registration of the same or confusingly similar marks for the same or related goods or services, the secretary shall grant priority to the applications in order of filing. If a previously filed application is granted a registration, the other application or applications must be rejected. A rejected applicant may bring an action for cancellation of the previously registered mark based upon previous or superior rights to the mark under section 10 of this chapter.

SECTION 6. IC 24-2-1-5 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 5. (a) ~~Upon compliance by the~~ If an applicant **complies** with the requirements of this chapter, the secretary of state shall **cause issue and deliver** a certificate of registration to be issued and delivered to the applicant. The certificate of registration shall **must** be issued under the signature of the secretary of state and the seal of the state of Indiana. ~~and it shall show~~ **The certificate of registration must include all of the following:**

- (1) The name and business address ~~and, if of the person claiming ownership of the mark.~~ **If the person claiming ownership of the mark is:**
 - (A) a corporation, **the certificate of registration must show** the state of incorporation; ~~of the person claiming ownership of the trademark;~~
 - (B) a partnership, **the certificate of registration must show** the state in which the partnership is organized and the

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names of the general partners, as specified by the secretary; or

(C) another form of legal entity, the certificate of registration must show the jurisdiction in which the legal entity is organized.

(2) The date claimed for the first use of the trademark in the United States and this state; mark anywhere and the date claimed for the first use of the mark in Indiana.

(3) The class of goods or services and a description of the goods or services on or in connection with which the trademark mark is used.

(4) A reproduction of the mark.

(5) The registration date. and

(6) The term of the registration. One (1) specimen or facsimile of the trademark supplied under section 4 of this chapter shall be attached to and made a part of the certificate of registration:

(b) Any A certificate of registration issued by the secretary of state under the provisions of subsection (a) or a copy thereof duly of a certificate of registration certified by the secretary of state shall be is admissible in evidence as competent and sufficient proof of the registration of such trademark the mark in any an action or judicial proceedings proceeding in any a court of this state- Indiana.

SECTION 7. IC 24-2-1-6 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 6. (a) Registration of a trade-mark hereunder shall be mark under this chapter is effective for a term of ten (10) five (5) years from the date of registration. and upon

(b) If a person who registers a mark under subsection (a) files an application filed within not more than six (6) months prior to before the expiration of such the five (5) year term, on a form to be furnished by the secretary of state; in a manner complying with the requirements of the secretary, the registration may be renewed for a like term an additional five (5) year term commencing at the end of the expiring five (5) year term.

(c) A renewal fee of ten dollars (\$10.00); payable to the secretary of state; shall must accompany the application for renewal of the registration.

(d) A trade-mark registration may be renewed for successive periods of ten (10) five (5) years in like the manner described in subsection (b).

(e) The secretary of state shall notify the registrants of trade-marks marks of the necessity of renewal within the year next preceding the expiration of the ten (10) five (5) years from the date of the registration

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1 by writing to the last known address of the registrants.

2 (f) **An application for renewal under this chapter for a mark**
3 **registered under this chapter or a mark registered under a prior**
4 **law, must include:**

5 (1) **a verified statement that the mark has been and remains**
6 **in use; and**

7 (2) **a specimen showing actual use of the mark on or in**
8 **connection with the good or service.**

9 SECTION 8. IC 24-2-1-7 IS AMENDED TO READ AS FOLLOWS
10 [EFFECTIVE JULY 1, 2006]: Sec. 7. ~~Any~~ **A registration in force on**
11 **March 8, 1955, shall expire March 8, 1956, unless July 1, 2006,**
12 **continues in full force and effect for the unexpired term of the**
13 **registration and may be renewed by:**

14 (1) filing an application **for renewal** with the secretary; ~~of state~~
15 ~~on a form furnished by him~~ and

16 (2) paying the renewal fee;

17 ~~described in the manner described in~~ section 6 of this chapter ~~within~~
18 **not more than** six (6) months ~~prior to before~~ the expiration of the
19 registration.

20 SECTION 9. IC 24-2-1-8 IS AMENDED TO READ AS FOLLOWS
21 [EFFECTIVE JULY 1, 2006]: Sec. 8. ~~Any trademark~~ **(a) A mark and**
22 **the registration of a mark** under this chapter ~~shall be~~ **are** assignable
23 with the:

24 (1) good will of the business in which the ~~trademark~~ **mark** is
25 used; or ~~with that~~

26 (2) part of the good will of the business:

27 (A) connected with the use of **the mark**; and

28 (B) symbolized by the ~~trademark~~. ~~Assignment shall~~ **mark.**

29 **(b) An assignment:**

30 (1) **must be made by an** instrument in writing duly executed; and

31 (2) ~~shall may~~ be recorded with the secretary ~~of state~~ upon the
32 payment of a **recording fee of ten dollars (\$10)** ~~payable to the~~
33 ~~secretary of state who, upon recording of the assignment,~~

34 **(c) The secretary, after recording an assignment,** shall issue in
35 the name of the assignee a new certificate **of registration** for the
36 remainder of the term of the:

37 (1) registration; or ~~of the last~~

38 (2) **most recent renewal thereof. of the registration.**

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

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1 **(1) after the date of the assignment; or**
 2 **(2) before the subsequent purchase.**
 3 SECTION 10. IC 24-2-1-8.5 IS ADDED TO THE INDIANA CODE
 4 AS A NEW SECTION TO READ AS FOLLOWS [EFFECTIVE JULY
 5 1, 2006]: **Sec. 8.5. (a) A registrant or an applicant who changes the**
 6 **name of the person to whom the mark is issued or for whom an**
 7 **application is filed may record a certificate of change of name of**
 8 **the registrant or applicant with the secretary upon the payment of**
 9 **a recording fee.**
 10 **(b) The secretary may issue a new certificate of registration or**
 11 **an assigned application in the name of the assignee. The secretary**
 12 **may issue a new certificate of registration in the name of the**
 13 **assignee for the remainder of the term of the:**
 14 **(1) certificate of registration; or**
 15 **(2) most recent renewal of the certificate of registration.**
 16 SECTION 11. IC 24-2-1-9 IS AMENDED TO READ AS
 17 FOLLOWS [EFFECTIVE JULY 1, 2006]: ~~Sec. 9. The secretary of state~~
 18 ~~shall keep for public examination a record of all trademarks marks~~
 19 ~~registered or renewed under this chapter as well as a record of all~~
 20 ~~instruments recorded under sections 8 and 8.5 of this chapter.~~
 21 SECTION 12. IC 24-2-1-10 IS AMENDED TO READ AS
 22 FOLLOWS [EFFECTIVE JULY 1, 2006]: ~~Sec. 10. The secretary of~~
 23 ~~state shall cancel from the register in whole or in part:~~
 24 ~~(1) after March 8, 1956, all registrations under prior statutes~~
 25 ~~which have not been renewed in accordance with this chapter;~~
 26 ~~(2) any (1) a registration concerning for which the secretary of~~
 27 ~~state shall receive receives a voluntary request for cancellation~~
 28 ~~thereof from the registrant or the assignee of record;~~
 29 ~~(3) (2) all registrations granted under this chapter and not~~
 30 ~~renewed in accordance with the provisions under section 6 of~~
 31 ~~this chapter;~~
 32 ~~(4) any (3) a registration concerning for which a court of~~
 33 ~~competent jurisdiction shall find: finds that:~~
 34 (A) ~~that~~ the registered ~~trademark mark~~ has been abandoned;
 35 (B) ~~that~~ the registrant is not the owner of the ~~trademark;~~
 36 **mark;**
 37 (C) ~~that~~ the registration was granted improperly; ~~or~~
 38 (D) ~~that~~ the registration was obtained fraudulently; ~~and~~
 39 **(E) the registered mark is or has become the generic name**
 40 **for the good or the service, or a part of the good or the**
 41 **service, for which the mark was registered; or**
 42 **(F) the registered mark is so similar to a mark registered**

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by another person on the principal register in the United States Patent and Trademark Office as to be likely to cause deception, confusion, or mistake between the marks, and the mark registered in the United States Patent and Trademark Office was filed before the filing of the application for registration by the registrant under this chapter. However, a mark may not be canceled under this clause if the registrant proves that the registrant is the owner of a concurrent registration of a mark in the United States Patent and Trademark Office covering an area including Indiana; or

(5) when (4) a registration if a court of competent jurisdiction shall order orders cancellation of a the registration on any ground.

SECTION 13. IC 24-2-1-11 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 11. (a) The following general classes secretary shall adopt rules under IC 4-22-2 to establish:

- (1) a classification of goods and services are established for convenience of administration of this chapter but not to limit or extend the an applicant's or registrant's rights; and
- (2) a single application for registration of a trademark mark that:
 - (A) may include any or all goods or services each good upon or in connection which a mark is used;
 - (B) may include each service with which the trademark a mark is actually being used; comprised in a single class; but in no event shall a single application include goods or services upon or in connection with which the trademark is being used which fall within different and
 - (C) must indicate the appropriate class or classes of the goods or services.

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

- (b) The said classes are as follows:
 - (1) Raw or partly prepared materials.
 - (2) Receptacles.
 - (3) Baggage; animal equipments; portfolio; and pocketbooks.
 - (4) Abrasives and polishing materials.
 - (5) Adhesives.
 - (6) Chemicals and chemical compositions.

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- 1 (7) Cordage.
- 2 (8) Smokers' articles, not including tobacco products.
- 3 (9) Explosives, firearms, equipments, and projectiles.
- 4 (10) Fertilizers.
- 5 (11) Inks and inking materials.
- 6 (12) Construction materials.
- 7 (13) Hardware and plumbing and steam-fitting supplies.
- 8 (14) Metals and metal castings and forgings.
- 9 (15) Oils and greases.
- 10 (16) Paints and painters' materials.
- 11 (17) Tobacco products.
- 12 (18) Medicines and pharmaceutical preparations.
- 13 (19) Vehicles.
- 14 (20) Linoleum and oiled cloth.
- 15 (21) Electrical apparatus, machines, and supplies.
- 16 (22) Games, toys, and sporting goods.
- 17 (23) Cutlery, machinery, and tools, and parts thereof.
- 18 (24) Laundry appliances and machines.
- 19 (25) Locks and safes.
- 20 (26) Measuring and scientific appliances.
- 21 (27) Horological instruments.
- 22 (28) Jewelry and precious-metal ware.
- 23 (29) Brooms, brushes, and dusters.
- 24 (30) Crockery, earthenware, and porcelain.
- 25 (31) Filters and refrigerators.
- 26 (32) Furniture and upholstery.
- 27 (33) Glassware.
- 28 (34) Heating, lighting, and ventilating apparatus.
- 29 (35) Belting, hose, machinery packing, and nonmetallic tires.
- 30 (36) Musical instruments and supplies.
- 31 (37) Paper and stationery.
- 32 (38) Prints and publications.
- 33 (39) Clothing.
- 34 (40) Fancy goods, furnishings, and notions.
- 35 (41) Canes, parasols, and umbrellas.
- 36 (42) Knitted, netted and textile fabrics, and substitutes thereof.
- 37 (43) Thread and yarn.
- 38 (44) Dental, medical, and surgical appliances.
- 39 (45) Soft drinks and carbonated waters.
- 40 (46) Foods and ingredients of foods.
- 41 (47) Wines.
- 42 (48) Malt beverages and liquors.

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- 1 (49) Distilled alcoholic liquors.
- 2 (50) Cosmetics and toilet preparations.
- 3 (51) Detergents and soaps.
- 4 (52) Merchandise not otherwise classified.
- 5 (53) Miscellaneous.
- 6 (54) Advertising and business.
- 7 (55) Insurance and financial.
- 8 (56) Construction and repair.
- 9 (57) Communication.
- 10 (58) Transportation and storage.
- 11 (59) Material treatment.
- 12 (60) Education and entertainment.

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

16 SECTION 14. IC 24-2-1-12 IS AMENDED TO READ AS
 17 FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 12. ~~Any~~ **(a)** A person
 18 who shall for himself **or herself**, or on behalf of any other person,
 19 procure the filing or registration of any ~~trade-mark~~ **mark** in the office
 20 of ~~the secretary of state under the provisions hereof;~~ **this chapter** by
 21 knowingly making ~~any~~ **a** false or fraudulent representation or
 22 declaration **orally**, in writing, or by ~~any~~ other fraudulent means, ~~shall~~
 23 ~~be is~~ **be** liable to ~~pay for~~ all damages sustained in consequence of ~~such~~ **the**
 24 filing or registration. ~~to be~~

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

27 SECTION 15. IC 24-2-1-13 IS AMENDED TO READ AS
 28 FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 13. Subject to the
 29 provisions of section 15 of this chapter, ~~any~~ **a** person who: ~~shall:~~

30 ~~(a) use;~~ **(1)** uses, without the consent of the registrant, ~~any~~ **a**
 31 reproduction, counterfeit, copy, or colorable imitation of a
 32 ~~trademark~~ **mark** registered under this chapter:

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

35 **(B)** on or in connection with which ~~such~~ **the** use is likely to
 36 cause confusion, ~~or~~ mistake, or ~~to deceive as to result in~~
 37 **deception regarding** the source ~~or~~ of origin of ~~such~~ **the** goods
 38 or services; or

39 ~~(b) reproduce, counterfeit, copy;~~ **(2) reproduces, counterfeits, or**
 40 **copies a mark** or colorably imitate ~~any such trademark~~ **imitates**
 41 **a mark** and ~~apply such~~ **applies the** reproduction, counterfeit,
 42 copy, or colorable imitation to labels, signs, prints, packages,

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1 wrappers, receptacles, or advertisements intended to be ~~used upon~~
2 or used:

3 (A) in ~~conjunction~~ **connection** with the sale or other
4 distribution **of the goods or services** in this state of such
5 goods or services shall be **Indiana**; or

6 **(B) on the goods or services;**
7 is liable to ~~in~~ a civil action **brought** by the owner of such registered
8 **trademark registrant** for ~~any or all of~~ the remedies provided in ~~section~~
9 ~~14~~ of this chapter, except that under subdivision ~~(b)~~ **(2)** the registrant
10 shall ~~is~~ not be entitled to recover profits or damages unless the acts
11 have been committed with ~~knowledge~~ that such trademark is intended
12 to be ~~used~~ **the intent** to cause **deception**, confusion, or mistake. ~~or to~~
13 deceive.

14 SECTION 16. IC 24-2-1-13.5 IS ADDED TO THE INDIANA
15 CODE AS A NEW SECTION TO READ AS FOLLOWS
16 [EFFECTIVE JULY 1, 2006]: **Sec. 13.5. (a) This section applies only**
17 **to fanciful marks, except in cases where the other person's use**
18 **tarnishes the reputation of the famous mark.**

19 **(b) An owner of a mark that is famous in Indiana is entitled,**
20 **subject to the principles of equity and terms a court considers**
21 **reasonable, to an injunction against another person's commercial**
22 **use of the mark or trade name if the other person's use begins after**
23 **the mark has become famous and the other person's use causes**
24 **dilution of the distinctive quality of the mark, and to other relief**
25 **provided in this section. In determining whether a mark is**
26 **distinctive and famous, a court may consider factors such as:**

- 27 **(1) the degree of inherent or acquired distinctiveness of the**
28 **mark in Indiana;**
- 29 **(2) the duration and extent of use of the mark in connection**
30 **with the goods or services with which the mark is used;**
- 31 **(3) the duration and extent of advertising and publicity of the**
32 **mark in Indiana;**
- 33 **(4) the geographical extent of the trading area in which the**
34 **mark is used;**
- 35 **(5) the channels of trade for the goods or services with which**
36 **the mark is used;**
- 37 **(6) the degree of recognition of the mark in the trading areas**
38 **and channels of trade in Indiana as it relates to the use of the**
39 **mark by the:**
 - 40 **(A) mark's owner; and**
 - 41 **(B) person against whom the injunction is sought;**
 - 42 **(7) the nature and extent of use of the same or a similar mark**

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- by a third party; and
- (8) whether the mark is the subject of a:
 - (A) registration in Indiana;
 - (B) federal registration under the Act of March 3, 1881;
 - (C) federal registration under the Act of February 20, 1905; or
 - (D) registration on the principal register.

(c) In an action brought under this section, the owner of a famous mark is entitled only to injunctive relief unless the person 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 section, subject to the discretion of the court and the principles of equity.

(d) A court may require a defendant to pay to the owner of a mark all profits derived from and damages suffered by reason of the use of the mark in violation of this section, and in exceptional cases, may award reasonable attorney's fees to the prevailing party.

- (e) The following are not actionable under this section:
 - (1) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.
 - (2) Noncommercial use of the mark.
 - (3) All forms of news reporting and news commentary.

SECTION 17. IC 24-2-1-14 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 14. (a) ~~Any~~ **An** owner of a trademark ~~mark~~ registered under this chapter may ~~proceed by suit~~ **bring an action** to enjoin the ~~use of any mark in violation of section 13 of this chapter and the~~ manufacture, ~~use~~, display, or sale of any counterfeits or imitations thereof; **goods or services identified by the mark** and ~~any~~ **a** court of competent jurisdiction may grant ~~injunctions~~ **an injunction** to restrain ~~such~~ **the use of the mark and the** manufacture, ~~use~~, display, or sale **of the goods or services** 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 goods**

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1 or services; and such court may also
 2 (2) order that any such counterfeits the goods or item bearing
 3 the mark or imitations in the possession or under the control of
 4 any a defendant in such the case be delivered to an officer of the
 5 court or to the complainant to be destroyed.

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

- 8 (1) an amount not to exceed the greater of:
 9 (A) three (3) times the profits derived from; or
 10 (B) three (3) times the damages suffered by reason of;
 11 the intentional use of a counterfeit mark, knowing it to be a
 12 counterfeit in connection with the goods or services for which
 13 the mark is registered; and
 14 (2) in exceptional cases, reasonable attorney's fees to the
 15 prevailing party.

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

19 SECTION 18. IC 24-2-1-14.5 IS ADDED TO THE INDIANA
 20 CODE AS A NEW SECTION TO READ AS FOLLOWS
 21 [EFFECTIVE JULY 1, 2006]: Sec. 14.5. (a) An action for
 22 cancellation of a mark registered under this chapter or an action
 23 to compel registration of a mark under this chapter must be
 24 brought in a court with jurisdiction in Indiana.

- 25 (b) In an action for cancellation of a mark, the secretary:
 26 (1) may not be made a party to an action;
 27 (2) must be notified of the filing of a complaint in an action by
 28 the clerk of the court in which the complaint is filed; and
 29 (3) is entitled to intervene in an action for cancellation of a
 30 mark.

31 (c) In an action brought against a nonresident registrant, service
 32 may be effected upon the secretary as agent for service of the
 33 registrant in accordance with the procedures established for
 34 service upon nonresident corporations and business entities.

35 SECTION 19. IC 24-2-1-15 IS AMENDED TO READ AS
 36 FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 15. ~~Nothing herein~~
 37 ~~shall~~ This chapter does not adversely affect the rights or the
 38 enforcement of rights in ~~trade-marks~~ a mark acquired in good faith at
 39 any time at common law.

40 SECTION 20. IC 24-2-1-15.3 IS ADDED TO THE INDIANA
 41 CODE AS A NEW SECTION TO READ AS FOLLOWS
 42 [EFFECTIVE JULY 1, 2006]: Sec. 15.3. (a) The secretary shall adopt

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rules under IC 4-22-2 to establish:

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

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

SECTION 21. IC 32-36-1-1 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 1. (a) This chapter applies to an act or event that occurs within Indiana, regardless of a personality's domicile, residence, or citizenship.

(b) This chapter does not affect rights and privileges recognized under any other law that apply to a news reporting or an entertainment medium.

(c) This chapter does not apply to the following:

(1) **Except as provided in section 21 of this chapter**, the use of a personality's name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, or mannerisms in any of the following:

- (A) Literary works, theatrical works, musical compositions, film, radio, or television programs.
- (B) Material that has political or newsworthy value.
- (C) Original works of fine art.
- (D) Promotional material or an advertisement for a news reporting or an entertainment medium that:
 - (i) uses all or part of a past edition of the medium's own broadcast or publication; and
 - (ii) does not convey or reasonably suggest that a personality endorses the news reporting or entertainment medium.
- (E) An advertisement or commercial announcement for a use described in this subdivision.

(2) The use of a personality's name to truthfully identify the personality as:

- (A) the author of a written work; or
 - (B) a performer of a recorded performance;
- under circumstances in which the written work or recorded performance is otherwise rightfully reproduced, exhibited, or broadcast.

(3) The use of a personality's:

- (A) name;
- (B) voice;
- (C) signature;

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- 1 (D) photograph;
- 2 (E) image;
- 3 (F) likeness;
- 4 (G) distinctive appearance;
- 5 (H) gestures; or
- 6 (I) mannerisms;
- 7 in connection with the broadcast or reporting of an event or a
- 8 topic of general or public interest.

9 SECTION 22. IC 32-36-1-21 IS ADDED TO THE INDIANA
 10 CODE AS A **NEW SECTION TO READ AS FOLLOWS**
 11 [EFFECTIVE JULY 1, 2006]: **Sec. 21. A person's heirs, assigns, or**
 12 **estate may not claim a property interest in the right of publicity of**
 13 **a person if the publicity is related in whole or in part to the**
 14 **person's criminal involvement in a state or federal criminal**
 15 **offense.**

16 SECTION 23. THE FOLLOWING ARE REPEALED [EFFECTIVE
 17 JULY 1, 2006]: IC 24-2-1-1; IC 24-2-1-16.

18 SECTION 24. [EFFECTIVE JULY 1, 2006] **This act does not**
 19 **affect a legal proceeding or appeal initiated under IC 24-2-1 before**
 20 **July 1, 2006.**

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COMMITTEE REPORT

Mr. Speaker: Your Committee on Commerce, Economic Development and Small Business, to which was referred House Bill 1353, has had the same under consideration and begs leave to report the same back to the House with the recommendation that said bill do pass.

BORROR, Chair

Committee Vote: yeas 9, nays 0.

 HOUSE MOTION

Mr. Speaker: I move that House Bill 1353 be amended to read as follows:

Page 17, between lines 40 and 41, begin a new paragraph and insert:
 "SECTION 20. IC 32-36-1-1 IS AMENDED TO READ AS FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 1. (a) This chapter applies to an act or event that occurs within Indiana, regardless of a personality's domicile, residence, or citizenship.

(b) This chapter does not affect rights and privileges recognized under any other law that apply to a news reporting or an entertainment medium.

(c) This chapter does not apply to the following:

(1) **Except as provided in section 21 of this chapter**, the use of a personality's name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, or mannerisms in any of the following:

(A) Literary works, theatrical works, musical compositions, film, radio, or television programs.

(B) Material that has political or newsworthy value.

(C) Original works of fine art.

(D) Promotional material or an advertisement for a news reporting or an entertainment medium that:

(i) uses all or part of a past edition of the medium's own broadcast or publication; and

(ii) does not convey or reasonably suggest that a personality endorses the news reporting or entertainment medium.

(E) An advertisement or commercial announcement for a use described in this subdivision.

(2) The use of a personality's name to truthfully identify the

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personality as:

(A) the author of a written work; or

(B) a performer of a recorded performance;

under circumstances in which the written work or recorded performance is otherwise rightfully reproduced, exhibited, or broadcast.

(3) The use of a personality's:

(A) name;

(B) voice;

(C) signature;

(D) photograph;

(E) image;

(F) likeness;

(G) distinctive appearance;

(H) gestures; or

(I) mannerisms;

in connection with the broadcast or reporting of an event or a topic of general or public interest.

SECTION 21. IC 32-36-1-21 IS ADDED TO THE INDIANA CODE AS A **NEW SECTION TO READ AS FOLLOWS** [EFFECTIVE JULY 1, 2006]: **Sec. 21. A person's heirs, assigns, or estate may not claim a property interest in the right of publicity of a person if the publicity is related in whole or in part to the person's criminal involvement in a state or federal criminal offense."**

Renumber all SECTIONS consecutively.

(Reference is to HB 1353 as printed January 20, 2006.)

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COMMITTEE REPORT

Madam President: The Senate Committee on Judiciary, to which was referred House Bill No. 1353, has had the same under consideration and begs leave to report the same back to the Senate with the recommendation that said bill be AMENDED as follows:

Page 1, between the enacting clause and line 1, begin a new paragraph and insert:

"SECTION 1. IC 24-2-1-0.5 IS ADDED TO THE INDIANA CODE AS A **NEW SECTION TO READ AS FOLLOWS** [EFFECTIVE JULY 1, 2006]: **Sec. 0.5. This chapter is intended to provide a system of**

EH 1353—LS 7131/DI 110+



state trademark registration and protection that is consistent with the federal system of trademark registration and protection under the Trademark Act of 1946. A judicial or an administrative interpretation of a provision of the federal Trademark Act may be considered as persuasive authority in construing a provision of this chapter."

Page 1, line 5, delete "If the use of a mark has been discontinued with the" and insert "**The person who owns the mark has discontinued use of the mark and does not intend to resume use of the mark. A person's intent not to resume use of the mark may be inferred from the circumstances.**".

Page 1, delete line 6.

Page 1, line 7, delete "resume may be inferred from circumstances."

Page 1, line 9, delete "of abandonment of the mark." and insert "**that the use of the mark has been abandoned.**".

Page 1, line 10, delete "If the" and insert "**The**".

Page 1, line 10, delete "acts of" and insert "**an act or**".

Page 1, line 10, after "omission" insert ",".

Page 1, line 11, delete "and commission, causes" and insert "**has caused**".

Page 5, line 21, delete "set".

Page 5, line 21, strike "forth, but".

Page 5, line 21, delete "is".

Page 5, line 21, strike "not limited to," and insert "**include**".

Page 5, line 33, after "on" insert "**or in connection with**".

Page 5, line 33, delete "and the" and insert ",".

Page 5, line 34, delete "goods or services used".

Page 5, line 34, strike "in connection with".

Page 5, line 34, strike "the mark;".

Page 6, line 34, delete "by" and insert "**under**".

Page 7, line 31, delete "or reasons".

Page 7, line 33, delete "or reasons".

Page 7, line 37, delete "application must be reexamined." and insert "**secretary shall reexamine the application.**".

Page 7, line 41, after "which time" insert "**the secretary shall consider**".

Page 7, line 42, delete "is considered to be abandoned." and insert "**to have been withdrawn.**".

Page 8, line 1, delete "finally refuses" and insert "**issues a final order refusing the**".

Page 8, line 2, delete "seek a writ of mandamus" and insert "**bring a civil action in a court with jurisdiction**".

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Page 8, line 3, delete "writ" and insert "**court**".

Page 8, line 3, delete "be granted" and insert "**order the secretary to register a mark,**".

Page 8, line 3, after "secretary" insert ",".

Page 8, line 6, after "If" insert "**two (2) or more**".

Page 8, line 40, after "on" insert "**or in connection with**".

Page 8, delete lines 41 through 42.

Page 9, line 1, delete "(5)" and insert "**(4)**".

Page 9, line 2, delete "(6)" and insert "**(5)**".

Page 9, line 3, delete "(7)" and insert "**(6)**".

Page 11, line 36, delete "registered" and insert "**filed**".

Page 15, line 13, after "mark" insert ",".

Page 15, line 13, after "and" insert "**to**".

Page 17, line 12, delete "in mandamus".

Page 17, delete lines 14 through 15.

Page 17, line 16, delete "(c)" and insert "**(b)**".

Page 17, line 22, delete "(d)" and insert "**(c)**".

and when so amended that said bill do pass.

(Reference is to HB 1353 as reprinted January 24, 2006.)

BRAY, Chairperson

Committee Vote: Yeas 9, Nays 0.

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