

**CONFERENCE COMMITTEE REPORT
DIGEST FOR EHB 1353**

Citations Affected: IC 24-2-1.

Synopsis: Trademarks and service marks. Conference committee report for EHB 1353. 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. **(This conference committee report removes provisions prohibiting a person's heirs, assigns, or estate from claiming a property interest in the right of publicity of the person if the publicity is related to the person's criminal involvement in a criminal offense.)**

Effective: July 1, 2006.

Adopted

Rejected

CONFERENCE COMMITTEE REPORT

MR. SPEAKER:

Your Conference Committee appointed to confer with a like committee from the Senate upon Engrossed Senate Amendments to Engrossed House Bill No. 1353 respectfully reports that said two committees have conferred and agreed as follows to wit:

that the House recede from its dissent from all Senate amendments and that the House now concur in all Senate amendments to the bill and that the bill be further amended as follows:

- 1 Delete everything after the enacting clause and insert the following:
2 SECTION 1. IC 24-2-1-0.5 IS ADDED TO THE INDIANA CODE
3 AS A NEW SECTION TO READ AS FOLLOWS [EFFECTIVE
4 JULY 1, 2006]: **Sec. 0.5. This chapter is intended to provide a
5 system of state trademark registration and protection that is
6 consistent with the federal system of trademark registration and
7 protection under the Trademark Act of 1946. A judicial or an
8 administrative interpretation of a provision of the federal
9 Trademark Act may be considered as persuasive authority in
10 construing a provision of this chapter.**
11 SECTION 2. IC 24-2-1-2 IS AMENDED TO READ AS FOLLOWS
12 [EFFECTIVE JULY 1, 2006]: **Sec. 2. ~~As used in this chapter:~~ The
13 following definitions apply throughout this chapter:**
14 **(1) "Abandoned" means either of the following:**
15 **(A) The person who owns the mark has discontinued use of
16 the mark and does not intend to resume use of the mark. A
17 person's intent not to resume use of the mark may be
18 inferred from the circumstances. Three (3) consecutive years
19 without use of a mark constitutes prima facie evidence that
20 the use of the mark has been abandoned.**
21 **(B) The conduct of the owner, including an act or omission,
22 has caused the mark to lose its significance as a mark.**
23 **(2) "Applicant" means a person who files an application for**

- 1 registration of a mark under this chapter and the legal
 2 representatives, successors, or assigns of the person.
- 3 (3) "Dilution" means the lessening of the capacity of a famous
 4 mark to identify and distinguish goods or services, regardless
 5 of the presence or absence of:
- 6 (A) competition between the owner of the famous mark and
 7 other parties; or
- 8 (B) the likelihood of confusion, mistake, or deception.
- 9 (4) "Mark" means a trademark or service mark that is entitled
 10 to registration under this chapter, whether the mark is
 11 registered or not.
- 12 (5) "Person" means:
- 13 (A) a human being;
- 14 (B) a corporation;
- 15 (C) a partnership;
- 16 (D) a limited liability company; or
- 17 (E) any other entity or organization:
- 18 (i) capable of suing and being sued in a court of law;
- 19 (ii) entitled to a benefit or privilege under this chapter; or
- 20 (iii) rendered liable under this chapter.
- 21 (6) "Registrant" means a person to whom the registration of a
 22 mark under this chapter is issued and the legal representatives,
 23 successors, or assigns of the person.
- 24 (7) "Secretary" means the secretary of state or the designee of
 25 the secretary charged with the administration of this chapter.
- 26 (8) "Service mark" means a word, name, symbol, device, or
 27 combination of a word, name, symbol, or device that is used by
 28 a person to:
- 29 (A) identify a service, including a unique service, of a person
 30 and distinguish the person's service from the service of
 31 another person; and
- 32 (B) indicate the source of a service, even if the source is
 33 unknown.
- 34 Titles and character names and other distinctive features of
 35 radio or television programs used by a person may be
 36 registered as a service mark even though the radio or television
 37 programs may advertise the goods of the sponsor.
- 38 ~~(a) The term~~ (9) "Trademark" means any word, name, symbol, or
 39 device or any combination thereof adopted ~~and of a word, name,~~
 40 symbol, or device that is used by a person to:
- 41 (A) identify goods or services made, sold, or rendered by him
 42 and to distinguish them from goods or services made, sold, or
 43 rendered by others; and distinguish goods, including a unique
 44 product, of a person and distinguish the person's goods from
 45 goods manufactured or sold by another person; and
- 46 (B) indicate the source of the goods, even if the source is
 47 unknown.
- 48 ~~(b) The term "person" means any individual, firm, partnership,~~
 49 ~~corporation, limited liability company, association, union of~~
 50 ~~workingmen, or other organization.~~
- 51 ~~(c) The term "applicant" embraces the person filing an application for~~

1 registration of a trademark under this chapter, his legal representatives,
2 successors, or assigns.

3 (d) The term "registrant" embraces the person to whom the
4 registration of a trademark under this chapter is issued; his legal
5 representatives; successors; or assigns.

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

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

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

17 **(A) on or in connection with a good if the:**

18 **(i) mark is placed in any manner on the good, a container**
19 **for the good, a display associated with the good, or a tag or**
20 **label affixed to the good; or**

21 **(ii) nature of the good makes placement of the mark as**
22 **described in item (i) impracticable and the mark is placed**
23 **on a document associated with the good or with the sale of**
24 **the good; and**

25 **(B) if the good described in clause (A) is sold or transported**
26 **in Indiana.**

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

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

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

38 ~~(b)~~ **(2)** consists of or comprises matter ~~which~~ **that** may:

39 **(A)** disparage or falsely suggest a connection with:

40 **(i)** persons living or dead;

41 **(ii)** institutions;

42 **(iii)** beliefs; or

43 **(iv)** national symbols; or

44 **(B)** bring ~~them~~ into contempt or disrepute:

45 **(i) persons living or dead;**

46 **(ii) institutions;**

47 **(iii) beliefs; or**

48 **(iv) national symbols;**

49 ~~(c)~~ **(3)** consists of or comprises the flag, ~~or~~ coat of arms, or other
50 insignia of:

51 **(A)** the United States;

- 1 ~~(B) or of any a~~ state or municipality;
 2 ~~(C) or of~~ the United Nations; or
 3 ~~(D) of any a~~ foreign nation; or any simulation thereof;
 4 ~~(d)~~ (4) consists of or comprises the name, signature, or portrait of
 5 any **identifying a particular** living individual, ~~except with his~~
 6 **unless the individual provides** written consent; or
 7 ~~(e)~~ consists of (5) is a mark ~~which that~~:
 8 ~~(1)~~ when applied to (A) if used on or in connection with the
 9 goods or services of the applicant, is merely descriptive or
 10 deceptively misdescriptive of ~~them~~ **the goods or services**;
 11 ~~(2)~~ when applied to (B) if used on or in connection with the
 12 goods or services of the applicant, is primarily geographically
 13 descriptive or deceptively **geographically** misdescriptive of ~~them~~
 14 **the goods or services**; or
 15 ~~(3)~~ (C) is primarily merely a surname.
 16 ~~Provided, however, that nothing in~~ This subdivision ~~shall does not~~
 17 prevent the registration of a mark **that is used in this state Indiana**
 18 by the applicant ~~which and~~ has become distinctive of the
 19 applicant's goods or services. The secretary of state may accept
 20 **proof of continuous use of a mark by the applicant in Indiana**
 21 **for the five (5) years immediately preceding the date on which**
 22 **the claim of distinctiveness is made** as evidence that the mark has
 23 become distinctive, as ~~applied to used on or in connection with~~
 24 the applicant's goods or services; ~~proof of substantially exclusive~~
 25 ~~and continuous use thereof as a mark by the applicant in this state~~
 26 ~~or elsewhere for the five (5) years next preceding the date of the~~
 27 ~~filing of the application for registration; or~~
 28 ~~(f)~~ consists of or comprises (6) is a trademark ~~mark which that~~ so
 29 resembles a trademark ~~mark~~ registered in this state **Indiana** or
 30 deemed registered in this state, as provided for by section 16 of this
 31 chapter; ~~a mark or trade name previously used by another~~
 32 **person in Indiana and not abandoned**, as to be likely, ~~when~~
 33 ~~applied to if used on or in connection with~~ the goods or services
 34 of the applicant, to cause **deception**, confusion, or mistake. ~~or to~~
 35 ~~deceive. unless there shall be filed with the secretary of state the~~
 36 ~~written consent of the registrant of such trademark, signed and~~
 37 ~~verified under oath by the registrant or one (1) of its officers or~~
 38 ~~partners.~~
 39 SECTION 4. IC 24-2-1-4 IS AMENDED TO READ AS FOLLOWS
 40 [EFFECTIVE JULY 1, 2006]: Sec. 4. (a) Subject to the limitations set
 41 forth in of this chapter, any a person who ~~adopts and~~ uses a **trademark**
 42 in this state **mark in Indiana** may file in the office of the secretary, of
 43 state, on a form to be furnished by the secretary of state; ~~in a manner~~
 44 **that complies with the requirements of the secretary**, an application
 45 for registration of that trademark setting **the mark. The application**
 46 **must forth, but not limited to, include** the following information:
 47 ~~(a)~~ (1) The name and business address of the person applying for
 48 such registration of the mark, and:
 49 (A) if the applicant is a corporation, the state of incorporation;
 50 (B) if the applicant is a partnership, the:
 51 (i) state in which the partnership is organized; and

- 1 (ii) names of the general partners, as specified by the
2 secretary; or
- 3 (C) if the applicant is another form of legal entity, the
4 jurisdiction in which the legal entity was organized.
- 5 (b) (2) The:
- 6 (A) goods or services **on or in connection with which the mark**
7 **is used; in connection with which the mark;**
8 is used; and the
- 9 (B) mode or manner in which the mark is used **on or in**
10 connection with ~~such~~ **the** goods or services; and the
- 11 (C) class in which ~~such~~ **the** goods or services fall.
- 12 (c) (3) The date ~~when on which~~ **the trademark mark** was first used
13 in ~~the United States anywhere~~ and the date ~~of its on which the~~
14 **mark was** first ~~use used~~ in this state **Indiana** by the applicant or
15 his ~~the applicant's~~ predecessor in business.
- 16 (d) (4) A statement **that:**
- 17 (A) ~~that~~ the applicant is the owner of the **trademark mark;**
18 (B) **the mark is in use;** and ~~that no other~~
- 19 (C) **to the knowledge of the person verifying the application,**
20 another person: ~~has~~
- 21 (i) **has not registered the mark, either federally or in**
22 **Indiana; or**
- 23 (ii) **does not have** the right to use ~~such~~ **trademark in this state**
24 **the mark** either in the identical form ~~thereof~~ or in such near
25 resemblance ~~thereto to the form~~ as might be calculated to
26 deceive or to be mistaken therefor; however, this statement
27 shall not be required if written consent is obtained in the
28 manner provided for in section 3(f) of this chapter: **to be**
29 **likely, if applied to the goods or services of the other**
30 **person, to cause deception, confusion, or mistake.**
- 31 (b) The secretary may also require on an application:
- 32 (1) a statement indicating whether an application to register a
33 mark, parts of a mark, or a composite of a mark, has been filed
34 by the applicant or a predecessor in the interest of the
35 applicant in the United States Patent and Trademark Office. If
36 an application has previously been filed in the United States
37 Patent and Trademark Office, the applicant must provide full
38 particulars with respect to the previous application, including
39 the:
- 40 (A) filing date and serial number of each application;
41 (B) status of each application; and
42 (C) reason or reasons for the refusal of the application or the
43 nonregistration of the mark if an application to register the
44 mark was finally refused registration or if an application to
45 register the mark has not resulted in a registration; and
- 46 (2) a drawing of the mark that complies with the requirements
47 of the secretary.
- 48 (c) The application ~~shall~~ **must** be signed and verified **under oath,**
49 **affirmation, or declaration subject to perjury laws** by:
- 50 (1) the applicant; ~~or by~~
- 51 (2) a member of the **applicant** firm or **applicant** limited liability

1 company; or

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

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

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

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

17 **(c) An applicant may make or authorize the secretary to make**
 18 **reasonable amendments to an application that are requested by the**
 19 **secretary or are considered by the applicant to be advisable to**
 20 **respond to a rejection or an objection.**

21 **(d) The secretary may require an applicant to submit a new**
 22 **application if the secretary determines amendments to the**
 23 **application are necessary and the applicant does not make or**
 24 **authorize the secretary to make amendments under subsection (c).**

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

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

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

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

38 **(1) to reply to the reason the applicant is not entitled to**
 39 **registration; or**

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

41 **If the applicant replies to the secretary or amends the application**
 42 **within the reasonable time, the secretary shall reexamine the**
 43 **application.**

44 **(g) The procedure under subsection (f) may be repeated until:**

45 **(1) the secretary finally refuses registration of the mark; or**

46 **(2) the applicant fails to reply or amend the application within**
 47 **the time specified by the secretary, at which time the secretary**
 48 **shall consider the application to have been withdrawn.**

49 **(h) If the secretary issues a final order refusing the registration**
 50 **of a mark, an applicant may bring a civil action in a court with**
 51 **jurisdiction to compel the registration of the mark. A court may**

1 order the secretary to register a mark, without costs to the
2 secretary, on proof that all statements in the application are true
3 and the mark is entitled to registration.

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

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

21 (1) The name and business address ~~and; if of the person claiming~~
22 **ownership of the mark. If the person claiming ownership of the**
23 **mark is:**

24 (A) a corporation, **the certificate of registration must show** the
25 state of incorporation; ~~of the person claiming ownership of the~~
26 ~~trademark;~~

27 (B) a partnership, **the certificate of registration must show**
28 **the state in which the partnership is organized and the names**
29 **of the general partners, as specified by the secretary; or**

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

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

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

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

40 (5) The registration date. ~~and~~

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

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

50 SECTION 7. IC 24-2-1-6 IS AMENDED TO READ AS FOLLOWS
51 [EFFECTIVE JULY 1, 2006]: Sec. 6. (a) Registration of a ~~trade-~~mark

1 hereunder shall be **mark under this chapter** is effective for a term of
 2 ~~ten (10)~~ **five (5)** years from the date of registration. ~~and upon~~

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

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

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

16 **(e) The secretary of state shall notify the registrants of trade-marks**
 17 **marks of the necessity of renewal within the year next preceding the**
 18 **expiration of the ten (10) five (5) years from the date of the registration**
 19 **by writing to the last known address of the registrants.**

20 **(f) An application for renewal under this chapter for a mark**
 21 **registered under this chapter or a mark registered under a prior**
 22 **law, must include:**

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

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

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

32 **(1) filing an application for renewal with the secretary, of state on**
 33 **a form furnished by him and**

34 **(2) paying the renewal fee;**

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

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

42 **(1) good will of the business in which the trademark mark is used;**
 43 **or with that**

44 **(2) part of the good will of the business:**

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

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

47 **(b) An assignment:**

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

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

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

4 **(1) registration; or of the last**

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

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

10 **(1) after the date of the assignment; or**

11 **(2) before the subsequent purchase.**

12 SECTION 10. IC 24-2-1-8.5 IS ADDED TO THE INDIANA CODE
13 AS A NEW SECTION TO READ AS FOLLOWS [EFFECTIVE
14 JULY 1, 2006]: **Sec. 8.5. (a) A registrant or an applicant who**
15 **changes the name of the person to whom the mark is issued or for**
16 **whom an application is filed may record a certificate of change of**
17 **name of the registrant or applicant with the secretary upon the**
18 **payment of a recording fee.**

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

23 **(1) certificate of registration; or**

24 **(2) most recent renewal of the certificate of registration.**

25 SECTION 11. IC 24-2-1-9 IS AMENDED TO READ AS
26 FOLLOWS [EFFECTIVE JULY 1, 2006]: **Sec. 9. The secretary of**
27 **state shall keep for public examination a record of all trademarks**
28 **marks registered or renewed under this chapter as well as a record of**
29 **all instruments recorded under sections 8 and 8.5 of this chapter.**

30 SECTION 12. IC 24-2-1-10 IS AMENDED TO READ AS
31 FOLLOWS [EFFECTIVE JULY 1, 2006]: **Sec. 10. The secretary of**
32 **state shall cancel from the register in whole or in part:**

33 ~~(1) after March 8, 1956, all registrations under prior statutes which~~
34 ~~have not been renewed in accordance with this chapter;~~

35 ~~(2) any (1) a registration concerning for which the secretary of~~
36 ~~state shall receive receives a voluntary request for cancellation~~
37 ~~thereof from the registrant or the assignee of record;~~

38 ~~(3) (2) all registrations granted under this chapter and not renewed~~
39 ~~in accordance with the provisions under section 6 of this chapter;~~

40 ~~(4) any (3) a registration concerning for which a court of~~
41 ~~competent jurisdiction shall find: finds that:~~

42 ~~(A) that the registered trademark mark has been abandoned;~~

43 ~~(B) that the registrant is not the owner of the trademark; mark;~~

44 ~~(C) that the registration was granted improperly; or~~

45 ~~(D) that the registration was obtained fraudulently; and~~

46 **(E) the registered mark is or has become the generic name**
47 **for the good or the service, or a part of the good or the**
48 **service, for which the mark was registered; or**

49 **(F) the registered mark is so similar to a mark registered by**
50 **another person on the principal register in the United States**
51 **Patent and Trademark Office as to be likely to cause**

1 **deception, confusion, or mistake between the marks, and the**
 2 **mark registered in the United States Patent and Trademark**
 3 **Office was filed before the filing of the application for**
 4 **registration by the registrant under this chapter. However,**
 5 **a mark may not be canceled under this clause if the**
 6 **registrant proves that the registrant is the owner of a**
 7 **concurrent registration of a mark in the United States Patent**
 8 **and Trademark Office covering an area including Indiana;**
 9 **or**

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

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

16 **(1) a classification** of goods and services ~~are established~~ for
 17 convenience of administration of this chapter but not to limit or
 18 extend ~~the an~~ applicant's or registrant's rights; and

19 **(2) a single application for registration of a trademark mark that:**
 20 **(A) may include any or all goods or services each good** upon or
 21 **in connection which a mark is used;**

22 **(B) may include each service with which the trademark a mark**
 23 **is actually being used;**

24 **comprised in a single class; but in no event shall a single**
 25 **application include goods or services upon or in connection with**
 26 **which the trademark is being used which fall within different**
 27 **and**

28 **(C) must indicate the appropriate class or classes of the goods**
 29 **or services.**

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

33 (b) The said classes are as follows:

34 (1) Raw or partly prepared materials:

35 (2) Receptacles:

36 (3) Baggage; animal equipments; portfolio; and pocketbooks:

37 (4) Abrasives and polishing materials:

38 (5) Adhesives:

39 (6) Chemicals and chemical compositions:

40 (7) Cordage:

41 (8) Smokers' articles; not including tobacco products:

42 (9) Explosives; firearms; equipments; and projectiles:

43 (10) Fertilizers:

44 (11) Inks and inking materials:

45 (12) Construction materials:

46 (13) Hardware and plumbing and steam-fitting supplies:

47 (14) Metals and metal castings and forgings:

48 (15) Oils and greases:

49 (16) Paints and painters' materials:

50 (17) Tobacco products:

51 (18) Medicines and pharmaceutical preparations:

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

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

46 SECTION 14. IC 24-2-1-12 IS AMENDED TO READ AS
 47 FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 12. ~~Any~~ **(a)** A person
 48 who shall for himself **or herself**, or on behalf of any other person,
 49 procure the filing or registration of any ~~trade-mark~~ **mark** in the office
 50 of ~~the secretary of state~~ under the provisions hereof; ~~this chapter~~ **by**
 51 knowingly making ~~any~~ **a** false or fraudulent representation or

1 declaration **orally**, in writing, or by ~~any~~ other fraudulent means, ~~shall~~
 2 ~~be is~~ liable to pay for all damages sustained in consequence of ~~such the~~
 3 filing or registration. ~~to be~~

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

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

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

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

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

18 ~~(b) reproduce; counterfeit; copy;~~ **(2) reproduces, counterfeits, or**
 19 **copies a mark** or colorably imitate any such trademark ~~imitates a~~
 20 **mark** and ~~apply such~~ **applies the** reproduction, counterfeit, copy,
 21 or colorable imitation to labels, signs, prints, packages, wrappers,
 22 receptacles, or advertisements intended to be ~~used upon or used:~~

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

26 **(B) on the goods or services;**

27 is liable ~~to in~~ a civil action **brought** by the ~~owner of~~ such registered
 28 **trademark registrant** for ~~any or all of~~ the remedies provided in section
 29 ~~14 of~~ this chapter, except that under subdivision ~~(b)~~ **(2)** the registrant
 30 ~~shall is~~ not ~~be~~ entitled to recover profits or damages unless the acts
 31 have been committed with ~~knowledge that such trademark is intended~~
 32 ~~to be used the intent~~ to cause **deception**, confusion, or mistake. ~~or to~~
 33 ~~deceive.~~

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

39 **(b) An owner of a mark that is famous in Indiana is entitled,**
 40 **subject to the principles of equity and terms a court considers**
 41 **reasonable, to an injunction against another person's commercial**
 42 **use of the mark or trade name if the other person's use begins after**
 43 **the mark has become famous and the other person's use causes**
 44 **dilution of the distinctive quality of the mark, and to other relief**
 45 **provided in this section. In determining whether a mark is**
 46 **distinctive and famous, a court may consider factors such as:**

47 **(1) the degree of inherent or acquired distinctiveness of the**
 48 **mark in Indiana;**

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

51 **(3) the duration and extent of advertising and publicity of the**

- 1 **mark in Indiana;**
 2 **(4) the geographical extent of the trading area in which the**
 3 **mark is used;**
 4 **(5) the channels of trade for the goods or services with which**
 5 **the mark is used;**
 6 **(6) the degree of recognition of the mark in the trading areas**
 7 **and channels of trade in Indiana as it relates to the use of the**
 8 **mark by the:**
 9 **(A) mark's owner; and**
 10 **(B) person against whom the injunction is sought;**
 11 **(7) the nature and extent of use of the same or a similar mark**
 12 **by a third party; and**
 13 **(8) whether the mark is the subject of a:**
 14 **(A) registration in Indiana;**
 15 **(B) federal registration under the Act of March 3, 1881;**
 16 **(C) federal registration under the Act of February 20, 1905;**
 17 **or**
 18 **(D) registration on the principal register.**
 19 **(c) In an action brought under this section, the owner of a famous**
 20 **mark is entitled only to injunctive relief unless the person against**
 21 **whom the injunctive relief is sought willfully intended to trade on**
 22 **the owner's reputation or to cause dilution of the famous mark. If**
 23 **willful intent is proven, the owner of the famous mark is entitled to**
 24 **the other remedies set forth in this section, subject to the discretion**
 25 **of the court and the principles of equity.**
 26 **(d) A court may require a defendant to pay to the owner of a**
 27 **mark all profits derived from and damages suffered by reason of**
 28 **the use of the mark in violation of this section and, in exceptional**
 29 **cases, may award reasonable attorney's fees to the prevailing party.**
 30 **(e) The following are not actionable under this section:**
 31 **(1) Fair use of a famous mark by another person in**
 32 **comparative commercial advertising or promotion to identify**
 33 **the competing goods or services of the owner of the famous**
 34 **mark.**
 35 **(2) Noncommercial use of the mark.**
 36 **(3) All forms of news reporting and news commentary.**
 37 SECTION 17. IC 24-2-1-14 IS AMENDED TO READ AS
 38 FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 14. (a) ~~Any~~ **An** owner
 39 of a ~~trademark~~ **mark** registered under this chapter may ~~proceed by suit~~
 40 **bring an action** to enjoin the ~~use of any mark in violation of section~~
 41 **13 of this chapter and the** manufacture, ~~use,~~ display, or sale of any
 42 counterfeits or imitations thereof; **goods or services identified by the**
 43 **mark** and ~~any~~ a court of competent jurisdiction may grant ~~injunctions~~
 44 **an injunction** to restrain ~~such the use of the mark and the~~
 45 manufacture, ~~use,~~ display, or sale **of the goods or services as may be**
 46 by the ~~said court deemed~~ **considers** just and reasonable. ~~and~~
 47 **(b) A court may:**
 48 **(1) require the a** defendant to pay to ~~such the~~ **owner of a mark** all:
 49 **(A) profits derived from; and/or all and**
 50 **(B) damages suffered by reason of;**
 51 **such the** wrongful manufacture, ~~use,~~ display, or sale **of the goods**

1 or services; and such court may also

2 (2) order that any such counterfeits the goods or item bearing the
3 mark or imitations in the possession or under the control of any a
4 defendant in such the case be delivered to an officer of the court or
5 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 service
34 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
43 adopt rules under IC 4-22-2 to establish:**

44 (1) an application fee;

45 (2) a renewal fee;

46 (3) a recording fee; and

47 (4) fees for related services.

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

50 SECTION 21. THE FOLLOWING ARE REPEALED [EFFECTIVE
51 JULY 1, 2006]: IC 24-2-1-1; IC 24-2-1-16.

1 SECTION 22. [EFFECTIVE JULY 1, 2006] **This act does not affect**
2 **a legal proceeding or appeal initiated under IC 24-2-1 before July**
3 **1, 2006.**
 (Reference is to EHB 1353 as printed February 10, 2006.)

Conference Committee Report
on
Engrossed House Bill 1353

Signed by:

Representative Walorski
Chairperson

Senator Bray

Representative Crooks

Senator Broden

House Conferees

Senate Conferees