

**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.

CONFERENCE COMMITTEE REPORT

MADAM PRESIDENT:

Your Conference Committee appointed to confer with a like committee from the House 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,**

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

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

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

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

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

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

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

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

22 (i) mark is placed in any manner on the good, a container
23 for the good, a display associated with the good, or a tag or
24 label affixed to the good; or

25 (ii) nature of the good makes placement of the mark as
26 described in item (i) impracticable and the mark is placed
27 on a document associated with the good or with the sale of
28 the good; and

29 (B) if the good described in clause (A) is sold or transported
30 in Indiana.

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

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

40 ~~(a)~~ (1) consists of or comprises immoral, deceptive, or scandalous
41 matter;

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

43 (A) disparage or falsely suggest a connection with:

44 (i) persons living or dead;

45 (ii) institutions;

46 (iii) beliefs; or

47 (iv) national symbols; or

48 (B) bring ~~them~~ into contempt or disrepute:

49 (i) persons living or dead;

- 1 (ii) institutions;
 2 (iii) beliefs; or
 3 (iv) national symbols;
 4 (c) (3) consists of or comprises the flag, or coat of arms, or other
 5 insignia of:
 6 (A) the United States;
 7 (B) or of any a state or municipality;
 8 (C) or of the United Nations; or
 9 (D) of any a foreign nation; or any simulation thereof;
 10 (d) (4) consists of or comprises the name, signature, or portrait of
 11 any identifying a particular living individual, except with his
 12 unless the individual provides written consent; or
 13 (e) consists of (5) is a mark which: that:
 14 (1) when applied to (A) if used on or in connection with the
 15 goods or services of the applicant, is merely descriptive or
 16 deceptively misdescriptive of them the goods or services;
 17 (2) when applied to (B) if used on or in connection with the
 18 goods or services of the applicant, is primarily geographically
 19 descriptive or deceptively geographically misdescriptive of them
 20 the goods or services; or
 21 (3) (C) is primarily merely a surname.
 22 Provided, however, that nothing in This subdivision shall does not
 23 prevent the registration of a mark that is used in this state Indiana
 24 by the applicant which and has become distinctive of the
 25 applicant's goods or services. The secretary of state may accept
 26 proof of continuous use of a mark by the applicant in Indiana
 27 for the five (5) years immediately preceding the date on which
 28 the claim of distinctiveness is made as evidence that the mark has
 29 become distinctive, as applied to used on or in connection with
 30 the applicant's goods or services; proof of substantially exclusive
 31 and continuous use thereof as a mark by the applicant in this state
 32 or elsewhere for the five (5) years next preceding the date of the
 33 filing of the application for registration; or
 34 (f) consists of or comprises (6) is a trademark mark which that so
 35 resembles a trademark mark registered in this state Indiana or
 36 deemed registered in this state; as provided for by section 16 of this
 37 chapter; a mark or trade name previously used by another
 38 person in Indiana and not abandoned, as to be likely, when
 39 applied to if used on or in connection with the goods or services
 40 of the applicant, to cause deception, confusion, or mistake. or to
 41 deceive: unless there shall be filed with the secretary of state the
 42 written consent of the registrant of such trademark; signed and
 43 verified under oath by the registrant or one (1) of its officers or
 44 partners.

45 SECTION 4. IC 24-2-1-4 IS AMENDED TO READ AS FOLLOWS
 46 [EFFECTIVE JULY 1, 2006]: Sec. 4. (a) Subject to the limitations set
 47 forth in of this chapter, any a person who adopts and uses a trademark
 48 in this state mark in Indiana may file in the office of the secretary, of
 49 state; on a form to be furnished by the secretary of state; in a manner

1 **that complies with the requirements of the secretary**, an application
 2 for registration of ~~that trademark setting the mark. The application~~
 3 **must forth, but not limited to, include** the following information:

4 ~~(a)~~ **(1)** The name and business address of the person applying for
 5 ~~such~~ registration **of the mark**, and:

6 **(A)** if **the applicant is** a corporation, the state of incorporation;

7 **(B)** if **the applicant is a partnership, the:**

8 **(i)** state in which the partnership is organized; and

9 **(ii)** names of the general partners, as specified by the
 10 **secretary; or**

11 **(C)** if **the applicant is another form of legal entity, the**
 12 **jurisdiction in which the legal entity was organized.**

13 ~~(b)~~ **(2)** The:

14 **(A)** goods or services **on or in connection with which the mark**
 15 **is used; in connection with which the mark;**
 16 **is used; and the**

17 **(B)** mode or manner in which the mark is used **on or in**
 18 **connection with ~~such~~ the goods or services; and the**

19 **(C)** class in which ~~such~~ the goods or services fall.

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

24 ~~(d)~~ **(4)** A statement **that:**

25 **(A)** ~~that~~ the applicant is the owner of the trademark **mark;**

26 **(B)** **the mark is in use;** and ~~that no other~~

27 **(C)** **to the knowledge of the person verifying the application,**
 28 **another person: ~~has~~**

29 **(i)** **has not registered the mark, either federally or in**
 30 **Indiana; or**

31 **(ii)** **does not have** the right to use ~~such~~ trademark in this state
 32 **the mark** either in the identical form ~~thereof~~ or in such near
 33 resemblance ~~thereto~~ **to the form** as might be calculated to
 34 deceive or to be mistaken therefor; however, this statement
 35 shall not be required if written consent is obtained in the
 36 manner provided for in section 3(f) of this chapter: **to be**
 37 **likely, if applied to the goods or services of the other**
 38 **person, to cause deception, confusion, or mistake.**

39 **(b)** The secretary may also require on an application:

40 **(1)** a statement indicating whether an application to register a
 41 mark, parts of a mark, or a composite of a mark, has been filed
 42 by the applicant or a predecessor in the interest of the
 43 applicant in the United States Patent and Trademark Office. If
 44 an application has previously been filed in the United States
 45 Patent and Trademark Office, the applicant must provide full
 46 particulars with respect to the previous application, including
 47 the:

48 **(A)** filing date and serial number of each application;

49 **(B)** status of each application; and

- 1 **(C) reason or reasons for the refusal of the application or the**
 2 **nonregistration of the mark if an application to register the**
 3 **mark was finally refused registration or if an application to**
 4 **register the mark has not resulted in a registration; and**
 5 **(2) a drawing of the mark that complies with the requirements**
 6 **of the secretary.**
- 7 **(c) The application shall must be signed and verified under oath,**
 8 **affirmation, or declaration subject to perjury laws by:**
- 9 **(1) the applicant; or by**
 10 **(2) a member of the applicant firm or applicant limited liability**
 11 **company; or**
 12 **(3) an officer of the applicant corporation, or association,**
 13 **applying- or other form of legal entity.**
- 14 The application shall must be accompanied by three (3) specimens or
 15 facsimiles of such trademark and shall contain a brief description of
 16 such trademark as it appears on such specimens or facsimiles: **showing**
 17 **actual use of the mark.** The application for registration shall must be
 18 accompanied by a filing fee of ten dollars ~~(\$10)~~ **an application fee**
 19 payable to the secretary. ~~of state.~~
- 20 SECTION 5. IC 24-2-1-4.5 IS ADDED TO THE INDIANA CODE
 21 AS A NEW SECTION TO READ AS FOLLOWS [EFFECTIVE
 22 JULY 1, 2006]: **Sec. 4.5. (a) If a person files an application for**
 23 **registration of a mark and pays the application fee, the secretary**
 24 **may examine the application for conformity with this chapter.**
- 25 **(b) An applicant must provide additional information requested**
 26 **by the secretary, including a description of a design mark.**
- 27 **(c) An applicant may make or authorize the secretary to make**
 28 **reasonable amendments to an application that are requested by the**
 29 **secretary or are considered by the applicant to be advisable to**
 30 **respond to a rejection or an objection.**
- 31 **(d) The secretary may require an applicant to submit a new**
 32 **application if the secretary determines amendments to the**
 33 **application are necessary and the applicant does not make or**
 34 **authorize the secretary to make amendments under subsection (c).**
- 35 **(e) The secretary may require an applicant to disclaim a**
 36 **component of a mark that is not eligible for registration, and an**
 37 **applicant may voluntarily disclaim a component of a mark for**
 38 **which registration is sought. A disclaimer does not prejudice or**
 39 **affect the applicant's rights:**
- 40 **(1) existing at the time of application or arising after the**
 41 **application in the disclaimed matter; or**
 42 **(2) on another application if the disclaimed matter is or**
 43 **becomes distinctive of the applicant's goods or services.**
- 44 **(f) If an applicant is not entitled to registration of a mark under**
 45 **this chapter, the secretary shall advise the applicant of the reason**
 46 **the applicant is not entitled to registration of the mark. The**
 47 **applicant has a reasonable time specified by the secretary:**
- 48 **(1) to reply to the reason the applicant is not entitled to**
 49 **registration; or**

- 1 (2) to amend the application.
- 2 **If the applicant replies to the secretary or amends the application**
- 3 **within the reasonable time, the secretary shall reexamine the**
- 4 **application.**
- 5 **(g) The procedure under subsection (f) may be repeated until:**
- 6 **(1) the secretary finally refuses registration of the mark; or**
- 7 **(2) the applicant fails to reply or amend the application within**
- 8 **the time specified by the secretary, at which time the secretary**
- 9 **shall consider the application to have been withdrawn.**
- 10 **(h) If the secretary issues a final order refusing the registration**
- 11 **of a mark, an applicant may bring a civil action in a court with**
- 12 **jurisdiction to compel the registration of the mark. A court may**
- 13 **order the secretary to register a mark, without costs to the**
- 14 **secretary, on proof that all statements in the application are true**
- 15 **and the mark is entitled to registration.**
- 16 **(i) If two (2) or more applications are concurrently processed by**
- 17 **the secretary for registration of the same or confusingly similar**
- 18 **marks for the same or related goods or services, the secretary shall**
- 19 **grant priority to the applications in order of filing. If a previously**
- 20 **filed application is granted a registration, the other application or**
- 21 **applications must be rejected. A rejected applicant may bring an**
- 22 **action for cancellation of the previously registered mark based**
- 23 **upon previous or superior rights to the mark under section 10 of**
- 24 **this chapter.**
- 25 SECTION 6. IC 24-2-1-5 IS AMENDED TO READ AS FOLLOWS
- 26 [EFFECTIVE JULY 1, 2006]: Sec. 5. (a) ~~Upon compliance by the~~ **If an**
- 27 **applicant complies** with the requirements of this chapter, the secretary
- 28 **of state shall cause issue and deliver** a certificate of registration ~~to be~~
- 29 **issued and delivered** to the applicant. The certificate of registration ~~shall~~
- 30 **must** be issued under the signature of the secretary ~~of state~~ and the seal
- 31 of the state of Indiana. ~~and it shall show~~ **The certificate of registration**
- 32 **must include all of the following:**
- 33 **(1) The name and business address and, if of the person claiming**
- 34 **ownership of the mark. If the person claiming ownership of the**
- 35 **mark is:**
- 36 **(A) a corporation, the certificate of registration must show the**
- 37 **state of incorporation; of the person claiming ownership of the**
- 38 **trademark;**
- 39 **(B) a partnership, the certificate of registration must show**
- 40 **the state in which the partnership is organized and the names**
- 41 **of the general partners, as specified by the secretary; or**
- 42 **(C) another form of legal entity, the certificate of registration**
- 43 **must show the jurisdiction in which the legal entity is**
- 44 **organized.**
- 45 **(2) The date claimed for the first use of the trademark in the United**
- 46 **States and this state; mark anywhere and the date claimed for**
- 47 **the first use of the mark in Indiana.**
- 48 **(3) The class of goods or services and a description of the goods or**
- 49 **services on or in connection with which the trademark mark is**

- 1 used.
- 2 **(4) A reproduction of the mark.**
- 3 **(5) The registration date. and**
- 4 **(6) The term of the registration. One (1) specimen or facsimile of**
- 5 **the trademark supplied under section 4 of this chapter shall be**
- 6 **attached to and made a part of the certificate of registration:**
- 7 **(b) Any A certificate of registration issued by the secretary of state**
- 8 **under the provisions of subsection (a) or a copy thereof duly of a**
- 9 **certificate of registration certified by the secretary of state shall be is**
- 10 **admissible in evidence as competent and sufficient proof of the**
- 11 **registration of such trademark the mark in any an action or judicial**
- 12 **proceedings proceeding in any a court of this state- Indiana.**
- 13 SECTION 7. IC 24-2-1-6 IS AMENDED TO READ AS FOLLOWS
- 14 [EFFECTIVE JULY 1, 2006]: Sec. 6. **(a) Registration of a trade-mark**
- 15 **hereunder shall be mark under this chapter is effective for a term of**
- 16 **ten (10) five (5) years from the date of registration. and upon**
- 17 **(b) If a person who registers a mark under subsection (a) files an**
- 18 **application filed within not more than six (6) months prior to before**
- 19 **the expiration of such the five (5) year term, on a form to be furnished**
- 20 **by the secretary of state, in a manner complying with the**
- 21 **requirements of the secretary, the registration may be renewed for a**
- 22 **like term an additional five (5) year term commencing at the end of**
- 23 **the expiring five (5) year term.**
- 24 **(c) A renewal fee of ten dollars (\$10.00); payable to the secretary of**
- 25 **state; shall must accompany the application for renewal of the**
- 26 **registration.**
- 27 **(d) A trade-mark registration may be renewed for successive periods**
- 28 **of ten (10) five (5) years in like the manner described in subsection**
- 29 **(b).**
- 30 **(e) The secretary of state shall notify the registrants of trade-marks**
- 31 **marks of the necessity of renewal within the year next preceding the**
- 32 **expiration of the ten (10) five (5) years from the date of the registration**
- 33 **by writing to the last known address of the registrants.**
- 34 **(f) An application for renewal under this chapter for a mark**
- 35 **registered under this chapter or a mark registered under a prior**
- 36 **law, must include:**
- 37 **(1) a verified statement that the mark has been and remains in**
- 38 **use; and**
- 39 **(2) a specimen showing actual use of the mark on or in**
- 40 **connection with the good or service.**
- 41 SECTION 8. IC 24-2-1-7 IS AMENDED TO READ AS FOLLOWS
- 42 [EFFECTIVE JULY 1, 2006]: Sec. 7. **Any A registration in force on**
- 43 **March 8, 1955, shall expire March 8, 1956, unless July 1, 2006,**
- 44 **continues in full force and effect for the unexpired term of the**
- 45 **registration and may be renewed by:**
- 46 **(1) filing an application for renewal with the secretary; of state on**
- 47 **a form furnished by him and**
- 48 **(2) paying the renewal fee;**
- 49 **described in the manner described in section 6 of this chapter within**

1 **not more than** six (6) months ~~prior to~~ **before** the expiration of the
2 registration.

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

7 (1) good will of the business in which the ~~trademark mark~~ is used;
8 or ~~with that~~

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

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

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

12 **(b) An assignment:**

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

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

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

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

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

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

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

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

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

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

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

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

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

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

49 ~~(1) after March 8, 1956, all registrations under prior statutes which~~

1 have not been renewed in accordance with this chapter;
 2 ~~(2) any (1) a registration concerning for~~ which the secretary of state
 3 ~~shall receive~~ **receives** a voluntary request for cancellation thereof
 4 from the registrant or the assignee of record;
 5 ~~(3) (2) all registrations granted under this chapter and not renewed~~
 6 ~~in accordance with the provisions under section 6~~ of this chapter;
 7 ~~(4) any (3) a registration concerning for~~ which a court of competent
 8 jurisdiction ~~shall find:~~ **finds that:**

- 9 (A) ~~that~~ the registered trademark **mark** has been abandoned;
 10 (B) ~~that~~ the registrant is not the owner of the trademark; **mark;**
 11 (C) ~~that~~ the registration was granted improperly; ~~or~~
 12 (D) ~~that~~ the registration was obtained fraudulently; ~~and~~
 13 **(E) the registered mark is or has become the generic name**
 14 **for the good or the service, or a part of the good or the**
 15 **service, for which the mark was registered; or**
 16 **(F) the registered mark is so similar to a mark registered by**
 17 **another person on the principal register in the United States**
 18 **Patent and Trademark Office as to be likely to cause**
 19 **deception, confusion, or mistake between the marks, and the**
 20 **mark registered in the United States Patent and Trademark**
 21 **Office was filed before the filing of the application for**
 22 **registration by the registrant under this chapter. However,**
 23 **a mark may not be canceled under this clause if the**
 24 **registrant proves that the registrant is the owner of a**
 25 **concurrent registration of a mark in the United States Patent**
 26 **and Trademark Office covering an area including Indiana;**
 27 **or**

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

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

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

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

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

- 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 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**, or
 34 advertising of ~~any~~ goods or services; **or**

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

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

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

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

48 ~~is liable to in~~ a civil action **brought** by the owner of ~~such registered~~
 49 ~~trademark~~ **registrant** for ~~any or all of~~ the remedies provided in ~~section~~

1 ~~14~~ of this chapter, except that under subdivision ~~(b)~~ **(2)** the registrant
 2 ~~shall is not be~~ entitled to recover profits or damages unless the acts have
 3 been committed with ~~knowledge~~ that such trademark is intended to be
 4 ~~used the intent~~ to cause **deception**, confusion, or mistake. ~~or to~~
 5 ~~deceive:~~

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

11 **(b) An owner of a mark that is famous in Indiana is entitled,**
 12 **subject to the principles of equity and terms a court considers**
 13 **reasonable, to an injunction against another person's commercial**
 14 **use of the mark or trade name if the other person's use begins after**
 15 **the mark has become famous and the other person's use causes**
 16 **dilution of the distinctive quality of the mark, and to other relief**
 17 **provided in this section. In determining whether a mark is**
 18 **distinctive and famous, a court may consider factors such as:**

19 **(1) the degree of inherent or acquired distinctiveness of the**
 20 **mark in Indiana;**

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

23 **(3) the duration and extent of advertising and publicity of the**
 24 **mark in Indiana;**

25 **(4) the geographical extent of the trading area in which the**
 26 **mark is used;**

27 **(5) the channels of trade for the goods or services with which**
 28 **the mark is used;**

29 **(6) the degree of recognition of the mark in the trading areas**
 30 **and channels of trade in Indiana as it relates to the use of the**
 31 **mark by the:**

32 **(A) mark's owner; and**

33 **(B) person against whom the injunction is sought;**

34 **(7) the nature and extent of use of the same or a similar mark**
 35 **by a third party; and**

36 **(8) whether the mark is the subject of a:**

37 **(A) registration in Indiana;**

38 **(B) federal registration under the Act of March 3, 1881;**

39 **(C) federal registration under the Act of February 20, 1905;**
 40 **or**

41 **(D) registration on the principal register.**

42 **(c) In an action brought under this section, the owner of a famous**
 43 **mark is entitled only to injunctive relief unless the person against**
 44 **whom the injunctive relief is sought willfully intended to trade on**
 45 **the owner's reputation or to cause dilution of the famous mark. If**
 46 **willful intent is proven, the owner of the famous mark is entitled to**
 47 **the other remedies set forth in this section, subject to the discretion**
 48 **of the court and the principles of equity.**

49 **(d) A court may require a defendant to pay to the owner of a**

1 **mark all profits derived from and damages suffered by reason of**
 2 **the use of the mark in violation of this section and, in exceptional**
 3 **cases, may award reasonable attorney's fees to the prevailing**
 4 **party.**

5 **(e) The following are not actionable under this section:**

6 **(1) Fair use of a famous mark by another person in**
 7 **comparative commercial advertising or promotion to identify**
 8 **the competing goods or services of the owner of the famous**
 9 **mark.**

10 **(2) Noncommercial use of the mark.**

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

12 SECTION 17. IC 24-2-1-14 IS AMENDED TO READ AS
 13 FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 14. (a) ~~Any~~ **An** owner
 14 of a ~~trademark~~ **mark** registered under this chapter may ~~proceed by suit~~
 15 **bring an action** to enjoin the ~~use of any mark in violation of section~~
 16 **13 of this chapter and the** manufacture, ~~use~~, display, or sale of any
 17 ~~counterfeits or imitations thereof~~, **goods or services identified by the**
 18 **mark** and ~~any a~~ court of competent jurisdiction may grant ~~injunctions~~
 19 **an injunction** to restrain ~~such the use of the mark and the~~
 20 manufacture, ~~use~~, display, or sale **of the goods or services** as ~~may be~~
 21 ~~by the said court deemed~~ **considers** just and reasonable. ~~and~~

22 **(b) A court may:**

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

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

25 **(B) damages suffered by reason of;**
 26 ~~such the~~ **wrongful manufacture, use, display, or sale of the goods**
 27 **or services; and such court may also**

28 **(2) order that any such counterfeits the goods or item bearing the**
 29 **mark or imitations** in the possession or under the control of ~~any a~~
 30 defendant in ~~such the~~ case be delivered to an officer of the court or
 31 to the complainant to be destroyed.

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

34 **(1) an amount not to exceed the greater of:**

35 **(A) three (3) times the profits derived from; or**

36 **(B) three (3) times the damages suffered by reason of;**
 37 **the intentional use of a counterfeit mark, knowing it to be a**
 38 **counterfeit in connection with the goods or services for which**
 39 **the mark is registered; and**

40 **(2) in exceptional cases, reasonable attorney's fees to the**
 41 **prevailing party.**

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

45 SECTION 18. IC 24-2-1-14.5 IS ADDED TO THE INDIANA
 46 CODE AS A NEW SECTION TO READ AS FOLLOWS
 47 [EFFECTIVE JULY 1, 2006]: Sec. 14.5. (a) **An action for**
 48 **cancellation of a mark registered under this chapter or an action**
 49 **to compel registration of a mark under this chapter must be**

- 1 brought in a court with jurisdiction in Indiana.
- 2 (b) In an action for cancellation of a mark, the secretary:
- 3 (1) may not be made a party to an action;
- 4 (2) must be notified of the filing of a complaint in an action by
- 5 the clerk of the court in which the complaint is filed; and
- 6 (3) is entitled to intervene in an action for cancellation of a
- 7 mark.
- 8 (c) In an action brought against a nonresident registrant, service
- 9 may be effected upon the secretary as agent for service of the
- 10 registrant in accordance with the procedures established for
- 11 service upon nonresident corporations and business entities.
- 12 SECTION 19. IC 24-2-1-15 IS AMENDED TO READ AS
- 13 FOLLOWS [EFFECTIVE JULY 1, 2006]: Sec. 15. ~~Nothing herein~~
- 14 ~~shall~~ **This chapter does not** adversely affect the rights or the
- 15 enforcement of rights in ~~trade-marks~~ **a mark** acquired in good faith at
- 16 any time at common law.
- 17 SECTION 20. IC 24-2-1-15.3 IS ADDED TO THE INDIANA
- 18 CODE AS A **NEW** SECTION TO READ AS FOLLOWS
- 19 [EFFECTIVE JULY 1, 2006]: **Sec. 15.3. (a) The secretary shall**
- 20 **adopt rules under IC 4-22-2 to establish:**
- 21 (1) an application fee;
- 22 (2) a renewal fee;
- 23 (3) a recording fee; and
- 24 (4) fees for related services.
- 25 (b) A fee is nonrefundable unless otherwise specified in the rules
- 26 adopted by the secretary under subsection (a).
- 27 SECTION 21. THE FOLLOWING ARE REPEALED [EFFECTIVE
- 28 JULY 1, 2006]: IC 24-2-1-1; IC 24-2-1-16.
- 29 SECTION 22. [EFFECTIVE JULY 1, 2006] **This act does not**
- 30 **affect a legal proceeding or appeal initiated under IC 24-2-1 before**
- 31 **July 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