

IC 24-2

ARTICLE 2. TRADEMARKS, TRADE NAMES, AND TRADE SECRETS

IC 24-2-1

Chapter 1. Trademark Act

IC 24-2-1-0.1

Application of certain amendments to chapter

Sec. 0.1. The following amendments to this chapter apply as follows:

- (1) The addition of sections 0.5, 4.5, 8.5, 13.5, 14.5, and 15.3 of this chapter by P.L.135-2006 does not affect a legal proceeding or appeal initiated under this chapter before July 1, 2006.
- (2) The amendments made to sections 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, and 15 of this chapter by P.L.135-2006 do not affect a legal proceeding or appeal initiated under this chapter before July 1, 2006.

As added by P.L.220-2011, SEC.385.

IC 24-2-1-0.5

Intent; judicial or administrative interpretation

Sec. 0.5. This chapter is intended to provide a system of 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.

As added by P.L.135-2006, SEC.1.

IC 24-2-1-1

Repealed

(Repealed by P.L.135-2006, SEC.21.)

IC 24-2-1-2

Definitions

Sec. 2. The following definitions apply throughout this chapter:

- (1) "Abandoned" means either of the following:
 - (A) 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. Three (3) consecutive 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 registered as a service mark even though the radio or television programs may advertise the goods of the sponsor.

(9) "Trademark" means any word, name, symbol, or device or any combination of a word, name, symbol, or device that is used by a person to:

- (A) identify 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.

(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 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.

(Formerly: Acts 1955, c.174, s.2; Acts 1959, c.256, s.1.) As amended by P.L.152-1986, SEC.22; P.L.8-1993, SEC.338; P.L.135-2006, SEC.2.

IC 24-2-1-3

Registerability

Sec. 3. A mark by which the goods or services of an applicant may be distinguished from other goods or services may not be registered if the mark:

(1) consists of or comprises immoral, deceptive, or scandalous matter;

(2) consists of or comprises matter 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 into contempt or disrepute:

(i) persons living or dead;

(ii) institutions;

(iii) beliefs; or

(iv) national symbols;

(3) consists of or comprises the flag, coat of arms, or other insignia of:

(A) the United States;

(B) a state or municipality;

(C) the United Nations; or

(D) a foreign nation;

(4) consists of or comprises the name, signature, or portrait identifying a particular living individual, unless the individual provides written consent; or

(5) is a mark that:

(A) if used on or in connection with the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of the goods or services;

(B) if used on or in connection with the goods or services of the applicant, is primarily geographically descriptive or deceptively geographically misdescriptive of the goods or services; or

(C) is primarily merely a surname.

This subdivision does not prevent the registration of a mark that is used in Indiana by the applicant and has become distinctive of the applicant's goods or services. The secretary may accept proof of continuous use of a mark by the applicant in Indiana for the five (5) years immediately preceding the date on which the claim of distinctiveness is made as evidence that the mark has become distinctive, as used on or in connection with the applicant's goods or services; or

(6) is a mark that so resembles a mark registered in Indiana or a mark or trade name previously used by another person in Indiana and not abandoned, as to be likely, if used on or in connection with the goods or services of the applicant, to cause deception, confusion, or mistake.

(Formerly: Acts 1955, c.174, s.3; Acts 1959, c.256, s.2.) As amended by P.L.152-1986, SEC.23; P.L.135-2006, SEC.3.

IC 24-2-1-4

Application for registration

Sec. 4. (a) Subject to the limitations of this chapter, a person who uses a mark in Indiana may file in the office of the secretary, in a manner that complies with the requirements of the secretary, an application for registration of the mark. The application must include the following information:

- (1) The name and business address of the person applying for registration of the mark, and:
 - (A) if the applicant is a corporation, the state of incorporation;
 - (B) if the applicant is a partnership, the:
 - (i) state in which the partnership is organized; and
 - (ii) names of the general partners, as specified by the secretary; or
 - (C) if the applicant is another form of legal entity, the jurisdiction in which the legal entity was organized.
- (2) The:
 - (A) goods or services on or in connection with which the mark is used;
 - (B) mode or manner in which the mark is used on or in connection with the goods or services; and
 - (C) class in which the goods or services fall.
- (3) The date on which the mark was first used anywhere and the date on which the mark was first used in Indiana by the applicant or the applicant's predecessor in business.
- (4) A statement that:
 - (A) the applicant is the owner of the mark;
 - (B) the mark is in use; and
 - (C) to the knowledge of the person verifying the application, another person:
 - (i) has not registered the mark, either federally or in Indiana; or
 - (ii) does not have the right to use the mark either in the

identical form or in such near resemblance to the form as 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, parts of a mark, 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.

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

(1) the applicant;

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

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

The application must be accompanied by three (3) specimens showing actual use of the mark. The application must be accompanied by an application fee payable to the secretary.

(Formerly: Acts 1955, c.174, s.4; Acts 1959, c.256, s.3.) As amended by P.L.152-1986, SEC.24; P.L.8-1993, SEC.339; P.L.135-2006, SEC.4.

IC 24-2-1-4.5

Examination; additional information; new application; disclaiming component of mark; amending; civil action; priority

Sec. 4.5. (a) If a person files an application for registration of a mark and pays the application fee, the secretary may examine the application for conformity with this chapter.

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

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

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

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

- (1) existing at the time of application or arising after the application in the disclaimed matter; or
- (2) on another application if the disclaimed matter is or becomes distinctive of the applicant's goods or services.

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

- (1) to reply to the reason the applicant is not entitled to 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.

As added by P.L.135-2006, SEC.5.

IC 24-2-1-5

Certificate of registration

Sec. 5. (a) If an applicant complies with the requirements of this chapter, the secretary shall issue and deliver a certificate of registration to the applicant. The certificate of registration must be issued under the signature of the secretary and the seal of the state of Indiana. The certificate of registration must include all of the following:

- (1) The name and business address 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;
 - (B) a partnership, the certificate of registration must show the state in which the partnership is organized and the 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 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 mark is used.
 - (4) A reproduction of the mark.
 - (5) The registration date.
 - (6) The term of the registration.

(b) A certificate of registration issued by the secretary under subsection (a) or a copy of a certificate of registration certified by the secretary is admissible in evidence as competent and sufficient proof of the registration of the mark in an action or judicial proceeding in a court of Indiana.

(Formerly: Acts 1955, c.174, s.5; Acts 1959, c.256, s.4.) As amended by P.L.152-1986, SEC.25; P.L.135-2006, SEC.6.

IC 24-2-1-6

Duration and renewal

Sec. 6. (a) Registration of a mark under this chapter is effective for a term of five (5) years from the date of registration.

(b) If a person who registers a mark under subsection (a) files an application not more than six (6) months before the expiration of the five (5) year term, in a manner complying with the requirements of the secretary, the registration may be renewed for an additional five (5) year term commencing at the end of the expiring five (5) year term.

(c) A renewal fee payable to the secretary must accompany the application for renewal of the registration.

(d) A registration may be renewed for successive periods of five (5) years in the manner described in subsection (b).

(e) The secretary shall notify the registrants of marks of the necessity of renewal within the year next preceding the expiration of the five (5) years from the date of the registration by writing to the last known address of the registrants.

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

- (1) a verified statement that the mark has been and remains in use; and
- (2) a specimen showing actual use of the mark on or in connection with the good or service.

(Formerly: Acts 1955, c.174, s.6.) As amended by P.L.135-2006, SEC.7.

IC 24-2-1-7

Expiration of registration

Sec. 7. A registration in force on July 1, 2006, continues in full force and effect for the unexpired term of the registration and may be renewed by:

- (1) filing an application for renewal with the secretary; and
- (2) paying the renewal fee;

in the manner described in section 6 of this chapter not more than six (6) months before the expiration of the registration.

(Formerly: Acts 1955, c.174, s.7.) As amended by P.L.152-1986, SEC.26; P.L.135-2006, SEC.8.

IC 24-2-1-8

Assignment

Sec. 8. (a) A mark and the registration of a mark under this chapter are assignable with the:

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

(b) An assignment:

- (1) must be made by an instrument in writing duly executed; and
- (2) may be recorded with the secretary upon the payment of a recording fee to the secretary.

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

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

(d) An assignment of a registration under this chapter is void against a subsequent purchaser for valuable consideration without notice unless the assignment is recorded with the secretary not more than three (3) months:

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

(Formerly: Acts 1955, c.174, s.8.) As amended by P.L.152-1986, SEC.27; P.L.135-2006, SEC.9.

IC 24-2-1-8.5

Certificate of change of name; new certificate of registration

Sec. 8.5. (a) A registrant or an applicant who changes the name of the person to whom the mark is issued or for whom an application is filed may record a certificate of change of name of the registrant or applicant with the secretary upon the payment of a recording fee.

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

issue a new certificate of registration in the name of the assignee for the remainder of the term of the:

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

As added by P.L.135-2006, SEC.10.

IC 24-2-1-9

Records

Sec. 9. The secretary shall keep for public examination a record of all marks registered or renewed under this chapter as well as a record of all instruments recorded under sections 8 and 8.5 of this chapter.

(Formerly: Acts 1955, c.174, s.9.) As amended by P.L.152-1986, SEC.28; P.L.135-2006, SEC.11.

IC 24-2-1-10

Cancellation

Sec. 10. The secretary shall cancel from the register in whole or in part:

- (1) a registration for which the secretary receives a voluntary request for cancellation from the registrant or the assignee of record;
- (2) all registrations granted under this chapter and not renewed under section 6 of this chapter;
- (3) a registration for which a court of competent jurisdiction finds that:
 - (A) the registered mark has been abandoned;
 - (B) the registrant is not the owner of the mark;
 - (C) the registration was granted improperly;
 - (D) the registration was obtained fraudulently;
 - (E) the registered mark is or has become the generic name for the good or the service, or a part of the good or the service, for which the mark was registered; or
 - (F) the registered mark is so similar to a mark registered 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
- (4) a registration if a court of competent jurisdiction orders cancellation of the registration on any ground.

(Formerly: Acts 1955, c.174, s.10.) As amended by P.L.152-1986, SEC.29; P.L.135-2006, SEC.12.

IC 24-2-1-11

Classification; single application

Sec. 11. (a) The secretary shall adopt rules under IC 4-22-2 to establish:

- (1) a classification of goods and services for convenience of administration of this chapter but not to limit or extend an applicant's or registrant's rights; and
- (2) a single application for registration of a mark that:
 - (A) may include each good upon which a mark is used;
 - (B) may include each service with which a mark is used; 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) If a single application includes goods or services that fall within multiple classes, the secretary may require payment of a fee for each class.

(Formerly: Acts 1955, c.174, s.11; Acts 1959, c.256, s.5.) As amended by P.L.152-1986, SEC.30; P.L.135-2006, SEC.13.

IC 24-2-1-12

Damages for fraudulent registration

Sec. 12. (a) A person who shall for himself or herself, or on behalf of any other person, procure the filing or registration of any mark in the office of the secretary under this chapter by knowingly making a false or fraudulent representation or declaration orally, in writing, or by other fraudulent means, is liable for all damages sustained in consequence of the filing or registration.

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

(Formerly: Acts 1955, c.174, s.12.) As amended by P.L.135-2006, SEC.14.

IC 24-2-1-13

Infringement

Sec. 13. Subject to the provisions of section 15 of this chapter, a person who:

- (1) uses, without the consent of the registrant, a reproduction, counterfeit, copy, or colorable imitation of a mark registered under this chapter:
 - (A) in connection with the sale, offering for sale, distribution, or advertising of goods or services; or
 - (B) on or in connection with which the use is likely to cause confusion or mistake, or result in deception regarding the source of origin of the goods or services; or
- (2) reproduces, counterfeits, or copies a mark or colorably imitates a mark and applies the reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used:
 - (A) in connection with the sale or other distribution of the

goods or services in Indiana; or
(B) on the goods or services;
is liable in a civil action brought by the registrant for the remedies provided in this chapter, except that under subdivision (2) the registrant is not entitled to recover profits or damages unless the acts have been committed with the intent to cause deception, confusion, or mistake.
(Formerly: Acts 1955, c.174, s.13; Acts 1959, c.256, s.6.) As amended by P.L.152-1986, SEC.31; P.L.135-2006, SEC.15.

IC 24-2-1-13.5

Fanciful marks; famous marks; injunctive relief; remedies; attorney's fees

Sec. 13.5. (a) This section applies only to fanciful marks, except in cases where the other person's use tarnishes the reputation of the famous mark.

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

- (1) the degree of inherent or acquired distinctiveness of the mark in Indiana;
- (2) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (3) the duration and extent of advertising and publicity of the mark in Indiana;
- (4) the geographical extent of the trading area in which the mark is used;
- (5) the channels of trade for the goods or services with which the mark is used;
- (6) the degree of recognition of the mark in the trading areas and channels of trade in Indiana as it relates to the use of the mark by the:
 - (A) mark's owner; and
 - (B) person against whom the injunction is sought;
- (7) the nature and extent of use of the same or a similar mark 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.

As added by P.L.135-2006, SEC.16.

IC 24-2-1-14

Remedies

Sec. 14. (a) An owner of a mark registered under this chapter may bring an action to enjoin the use of any mark in violation of section 13 of this chapter and the manufacture, display, or sale of any goods or services identified by the mark and a court of competent jurisdiction may grant an injunction to restrain the use of the mark and the manufacture, display, or sale of the goods or services as the court considers just and reasonable.

(b) A court may:

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

(A) profits derived from; and

(B) damages suffered by reason of; the wrongful manufacture, display, or sale of the goods or services; and

(2) order that the goods or item bearing the mark in the possession or under the control of a defendant in the case be delivered to an officer of the court or to the complainant to be destroyed.

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

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

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

(B) three (3) times the damages suffered by reason of;

the intentional use of a counterfeit mark, knowing it to be a counterfeit in connection with the goods or services for which the mark is registered; and

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

(d) The invocation of a right or remedy in this chapter does not affect a registrant's right to prosecution under a penal law.

(Formerly: Acts 1955, c.174, s.14.) As amended by P.L.152-1986, SEC.32; P.L.135-2006, SEC.17.

IC 24-2-1-14.5

Cancellation; action to compel registration; jurisdiction

Sec. 14.5. (a) An action for cancellation of a mark registered under this chapter or an action to compel registration of a mark under this chapter must be brought in a court with jurisdiction in Indiana.

(b) In an action for cancellation of a mark, the secretary:

- (1) may not be made a party to an action;
- (2) must be notified of the filing of a complaint in an action by the clerk of the court in which the complaint is filed; and
- (3) is entitled to intervene in an action for cancellation of a mark.

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

As added by P.L.135-2006, SEC.18.

IC 24-2-1-15

Common law rights

Sec. 15. This chapter does not adversely affect the rights or the enforcement of rights in a mark acquired in good faith at any time at common law.

(Formerly: Acts 1955, c.174, s.15.) As amended by P.L.135-2006, SEC.19.

IC 24-2-1-15.3

Fees

Sec. 15.3. (a) The secretary shall adopt 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).

As added by P.L.135-2006, SEC.20.

IC 24-2-1-16

Repealed

(Repealed by P.L.135-2006, SEC.21.)