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Trademark Laws: Indiana

by Holiday W. Banta, Ice Miller LLP, with Practical Law Intellectual Property & Technology

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A Q&A guide to Indiana laws protecting trademarks. This Q&A addresses state laws governing trademark registration, infringement, dilution, counterfeiting, unfair competition, and deceptive trade practices. Answers to questions can be compared across a number of jurisdictions (see Trademark Laws: State Q&A Tool).

State Trademark Registration Statute

1. Does your state have a state trademark registration statute? If so, please:

- Identify the statute.
- Identify the state agency responsible for administering trademark applications and registrations.
- Describe the key substantive state trademark registration requirements.
- Describe the key benefits of state registration.

Indiana has a trademark registration statute that is substantially consistent with the registration provisions of the Lanham Act. The law is codified in Ind. Code §§ 24-2-1-0.1 to 24-2-1-15.3. Courts interpreting the Indiana statute may consider judicial or administrative decisions interpreting the Lanham Act as persuasive authority (Ind. Code § 24-2-1-0.5).

State Agency

The Indiana Secretary of State, Business Services Division, Trademark Division administers Indiana trademarks. It provides trademark and service mark registration forms and other information on its website.

Key Substantive Registration Requirements

Types of Marks Covered

The Indiana registration statute provides for registration of both:

- Trademarks.
- Service marks.

(Ind. Code § 24-2-1-2(4).)

Use Requirements and Intent-to-Use Applications

The Indiana registration statute:

- Requires that a mark be in bona fide use in the ordinary course of trade in Indiana to be eligible for registration. The term "in use" means:
  - for goods, that the mark is placed on any manner of good, or the good's container, display, tag, or document associated with the good; or
  - for services, that the mark is used or displayed in the sale or advertising of the service and the service is performed in Indiana.
- Does not authorize intent-to-use applications.

(Ind. Code §§ 24-2-1-2(11) and 24-2-1-4.)

Statutory Bars to Registration

The Indiana registration statute sets out substantially the same statutory bars to registration as those set out in Section 2 of the Lanham Act (Ind. Code § 24-2-1-3; 15 U.S.C. § 1052).

For a discussion of the Lanham Act statutory bars to registration, including provisions the US Supreme Court recently struck down as unconstitutional, see Practice Note, Acquiring Trademark Rights and Registrations: Eligibility for Trademark Registration under the Lanham Act.

Other Key Substantive Registration Requirements

The application for trademark registration, which must be filed electronically, must include:

- The applicant's:
  - name; and
  - business address.
- If the applicant is:
  - a corporation, the state of incorporation;
  - a partnership, the state in which the partnership is organized and the names of the general partners; or
  - another form of legal entity, the jurisdiction in which the legal entity was organized.
- The goods or services, including:
  - the mode or manner in which the mark is used on or in connection with the goods or services; and
  - the class in which the goods or services fall.
- The dates the applicant or predecessor in interest first used the mark:
  - anywhere; and
  - in Indiana.
- A statement that:
  - the applicant is the owner of the mark;
  - the mark is in use; and
  - no other person has registered the mark with the US Patent and Trademark Office or with the Indiana secretary of state, or has the right to use the mark in Indiana in connection with goods or services either in an identical form or one so similar as to be likely to cause confusion or mistake or to deceive.
- An application fee set by and payable to the Indiana secretary of state.
- The applicant's signature and verification.
- One sample image showing actual use of the mark.

(Ind. Code § 24-2-1-4.)

The Indiana secretary of state may also require the applicant to include:

- A statement stating whether the applicant or a predecessor in interest filed an application to register the mark, parts of the mark, or a composite of the mark with the US Patent and Trademark Office. If so, the applicant must provide information about the application, including:
  - the filing date and serial number of each application;
  - the application's status; and
  - the reason the application was denied or not registered, if applicable.
- A drawing of the mark.

(Ind. Code § 24-2-1-4(b).)

Key Benefits of State Registration

Procedural

In an action or judicial proceeding in an Indiana court, a certificate of registration is admissible as evidence of competent and sufficient proof of the mark's registration (Ind. Code § 24-2-1-5(b)).

Substantive

An Indiana trademark registration entitles the mark's owner to specified remedies for infringement of the mark (Ind. Code §§ 24-2-1-13 to 24-2-1-14). For more information on remedies, see Question 4: Remedies.

2. Indicate the term of a state trademark registration and the key registration renewal requirements.

Registration Term

An Indiana trademark registration:

- Has a term of five years.
- May be renewed for additional five-year periods if procedural and statutory renewal requirements are met (see Renewal Requirements).

(Ind. Code § 24-2-1-6.)

Renewal Requirements

An Indiana trademark registration may be renewed for successive five-year periods by, within six months before the expiration of the registration, both:

- Filing an electronic application for renewal.
- Paying a renewal fee.

(Ind. Code §§ 24-2-1-6(b), (c), and 24-2-1-7.)

The renewal application must include:

- A verified statement that the mark has been and remains in use in Indiana.
- An image of the mark on or in connection with the good or service.

(Ind. Code § 24-2-1-6(f).)

3. Describe the key requirements for assignment of state trademark applications and registrations.

An Indiana state trademark application or the registration of a trademark is assignable if the assignment is in a duly executed written instrument. The assignment of a trademark registered in Indiana may be recorded electronically with the Indiana secretary of state (ISOS) on payment of a fee (currently $10). (Ind. Code §§ 24-2-1-8(b) and 24-2-1-15.3). It is not possible to electronically record an assignment of a trademark that the owner did not register with the ISOS.

The ISOS website provides an online assignment form for registering Indiana state trademarks. Counsel may use the online form with an Access Indiana account (free). The online form must:

- Describe the mark to be assigned.
- Include:
  - the ISOS file number for the mark being assigned; and
  - the date of registration.
- Include contact information for the assignor and assignee and the assignee's domicile, if it is a corporation.
- Be signed by the assignor under penalty of perjury.
- Include a statement that the registration is being assigned with that part of the goodwill of the business represented by the mark and by its registration.

Under Indiana law, all trademark and service mark transactions, including assignments, must be submitted online at INBiz.in.gov. The assignee of a trademark should record it promptly with the ISOS. An assignment is void against a subsequent purchaser for valuable consideration without notice unless the assignment is recorded with the ISOS within three months either:

- After the date of the assignment.
- Before the subsequent purchase.

(Ind. Code § 24-2-1-8(d).)

After recording an assignment, the ISOS issues a new certificate of registration in the name of the assignee for the remainder of the term of the registration or of the most recent renewal of the registration (Ind. Code § 24-2-1-8(c)).

State Statutory and Common Law Trademark Infringement Causes of Action

4. Does your state have a statute that provides a trademark infringement cause of action? If so, describe:

- The elements of the cause of action.
- The available remedies.
- Any statutory defenses or exemptions.

Ind. Code § 24-2-1-13 provides a cause of action for infringement of state-registered marks.

Elements of the Cause of Action

The Indiana trademark statute provides a trademark registrant with a cause of action for trademark infringement if another person, without the registrant's consent, either:

- Uses a reproduction, counterfeit, copy, or colorable imitation of a mark registered in Indiana:
  - in connection with distributing, selling, offering to sell, or advertising goods or services; or
  - when the use is likely to cause confusion or mistake or result in deception about the source of origin of the goods or services.
- Reproduces, counterfeits, copies, or colorably imitates a mark registered in Indiana and applies

it to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended for use on the goods or services or in connection with selling or distributing the goods or services in Indiana.

(Ind. Code § 24-2-1-13.)

Remedies

The following remedies are available for infringement of a mark registered under the Indiana trademark registration statute:

- Injunctive relief.
- Damages and disgorgement of profits from the wrongful manufacture, display, or sale of the goods or services.
- An order for delivery of the infringing items to the court or the mark owner for destruction.
- Three times damages or profits, at the court's discretion, if the defendant intentionally used a mark knowing it to be counterfeit.
- Reasonable attorneys' fees to the prevailing party, in exceptional cases.

(Ind. Code § 24-2-1-14.)

Statutory Defenses or Exemptions

The Indiana trademark registration statute does not provide any specific statutory defenses or exemptions.

5. Does your state recognize a claim for common law trademark infringement? If so, describe:

- The elements of the cause of action.
- Any significant differences between the state common law claim and a claim for infringement of an unregistered mark under Section 43(a) of the Lanham Act.

The Indiana trademark registration statute expressly recognizes the right to enforce common law trademark rights. The trademark registration statute does not adversely affect common law rights. (Ind. Code § 24-2-1-15.) Indiana law also provides that judicial and administrative decisions interpreting a provision of the Lanham Act may be considered as persuasive authority when construing Indiana's state trademark statutes (Ind. Code § 24-2-1-0.5).

Elements of a Cause of Action

Indiana courts have not specifically addressed the elements of a claim of common law trademark infringement. However, the Indiana Supreme Court has stated the elements of a common law trade name infringement claim, which can be applied by analogy to a common law trademark infringement claim (*Keaton & Keaton v. Keaton*, 842 N.E.2d 816, 820-21 (Ind. 2006)).

To prevail on a claim of trade name infringement under Indiana common law, a plaintiff must show:

- A protectable trade name that is distinctive (has acquired secondary meaning).
- The defendant's use of that name is likely to cause confusion about the source of goods or services, regardless of whether the defendant has a subjective intent to deceive or confuse.

(*Keaton*, 842 N.E.2d at 820-21.)

Key Lanham Act Distinctions

There do not appear to be any significant differences between a state common law trade name (or trademark) infringement claim and a claim for infringement of an unregistered mark or name under Section 43(a) of the Lanham Act (*Keaton*, 842 N.E.2d at 820-21; 15 U.S.C. § 1125(a)(1)(A)).

State Anti-Dilution Law

6. Does your state have an anti-dilution statute or recognize a dilution cause of action under common law? If so, please describe for any statute or common law claim:

- Whether it protects both registered and unregistered marks.
- The nature of dilution protected against, including whether the law protects against any dilution by blurring or dilution by tarnishment.
- Whether distinctiveness, strength, or fame of the trademark is required for a mark to be protected in your jurisdiction.

Statute

Indiana's anti-dilution statute is Ind. Code § 24-2-1-13.5.

Registration Requirements

The Indiana anti-dilution statute protects:

- Fanciful marks.
- Famous marks in cases where another person's use tarnishes its reputation.

(Ind. Code § 24-2-1-13.5(a), (b).)

Nature and Types of Dilution Recognized

The Indiana statute recognizes dilution by:

- Blurring (a famous mark's capacity to identify and distinguish goods or services is reduced).
- Tarnishment.

(Ind. Code § 24-2-1-13.5.)

Dilution is recognized regardless of the presence or absence of:

- Competition between the owner of the famous mark and other parties.
- Likelihood of confusion, mistake, or deception.

(Ind. Code § 24-2-1-2(3).)

Distinctiveness, Strength, or Fame

The Indiana statute lists the following factors that a court may consider when determining whether a mark is distinctive and famous, including:

- The degree of inherent or acquired distinctiveness of the mark in Indiana.
- The duration and extent of use of the mark in connection with the goods and services.
- The duration and extent of advertising and publicity of the mark.
- The geographical extent of the mark's use.
- The channels of trade with which the mark is used.
- The degree of recognition of the mark in the trading areas where the mark is used.
- The use of the same or a similar mark by third parties.
- Whether the mark is registered under Indiana or federal law.

(Ind. Code § 24-2-1-13.5(b).)

Common Law

Indiana courts have not recognized a common law dilution cause of action (*Westward Coach Mfg. Co. v. Ford Motor Co.*, 258 F. Supp. 67, 79-80 (S.D. Ind. 1966)).

7. For the anti-dilution law listed in Question 6, please list the elements of a cause of action, including whether a claim requires any of the following:

- Actual or likelihood of dilution.
- Likelihood of confusion.
- Competition between the parties.

Statute

Actual or Likelihood of Dilution

A mark owner in Indiana has a cause of action against another's commercial use of the mark or trade name if:

- The owner's mark is famous.
- The use begins after the mark has become famous.
- The use causes dilution of the famous mark's distinctive quality.

(Ind. Code § 24-2-1-13.5(b).)

The statute defines dilution as "the lessening of the capacity of a famous mark to identify and distinguish goods or services," and not "the likelihood of lessening." Although there is no case law interpreting this provision, the statute suggests that actual dilution is required. The requirement that the third party's use must cause dilution further supports this interpretation. (Ind. Code §§ 24-2-1-2(3) and 24-2-1-13.5(b).)

Likelihood of Confusion

Indiana's anti-dilution statute does not require likelihood of confusion (Ind. Code §§ 24-2-1-2(3)(B) and 24-2-1-13.5).

Competition Between the Parties

Indiana's anti-dilution statute does not require competition between the parties (Ind. Code §§ 24-2-1-2(3)(A) and 24-2-1-13.5).

Common Law

Indiana courts have not recognized a common law dilution cause of action (*Westward Coach Mfg. Co.*, 258 F. Supp. at 79-80).

8. For the anti-dilution law listed in Question 6, please describe any tests set out in the statute or applied by courts to assess likely or actual dilution.

Statute

Indiana's anti-dilution statute does not set out a test to assess actual dilution, and there is no published court decision interpreting the law. However, Indiana's registration statute provides that a court may consider a judicial or administrative interpretation of a provision of the federal Trademark Act as persuasive (Ind. Code § 24-2-1-0.5).

Common Law

Indiana courts have not recognized a common law dilution cause of action (*Westward Coach Mfg. Co.*, 258 F. Supp. at 79-80).

9. For the anti-dilution law listed in Question 6, please describe any available remedies for violations.

Statute

Available relief for dilution claims includes:

- Injunctive relief.
- If the defendant willfully intended to trade on the owner's reputation or to cause dilution of the famous mark:
  - damages;
  - disgorgement of profits; and
  - attorneys' fees, in exceptional cases.

(Ind. Code § 24-2-1-13.5(c), (d).)

Common Law

Indiana courts have not recognized a common law dilution cause of action (*Westward Coach Mfg. Co.*, 258 F. Supp. at 79-80).

10. For the anti-dilution law listed in Question 6, what statutory exemptions or defenses are available to defend against these claims?

Statute

Indiana's anti-dilution statute provides the following exemptions and defenses:

- 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.
- Non-commercial use.
- News reporting or commentary.

(Ind. Code § 24-2-1-13.5(e).)

Common Law

Indiana courts have not recognized a common law dilution cause of action (*Westward Coach Mfg. Co.*, 258 F. Supp. at 79-80).

11. For the anti-dilution law in Question 6, please describe any significant distinctions between the applicable state law and the federal Trademark Dilution Revision Act, including differences in the available remedies.

Statute

Key distinctions from the Lanham Act include that the Indiana anti-dilution statute:

- Sets out more factors for courts to consider for determining fame.
- Seems to require actual dilution and not just a likelihood of it.
- Provides a dilution by blurring claim only for famous and fanciful marks.

(Ind. Code § 24-2-1-13.5; 15 U.S.C. § 1125(c).)

Common Law

Indiana courts have not recognized a common law dilution cause of action (*Westward Coach Mfg. Co.*, 258 F. Supp. at 79-80).

Anti-Counterfeiting Statute

12. Does your state have a civil anti-counterfeiting statute with a private right of action? If so, please identify the statute and describe:

- Standing requirements.
- Available remedies.
- Any statutory exemptions or defenses.

Indiana does not have a specific anti-counterfeiting statute with a private right of action. However, the Indiana trademark registration statute provides a civil cause of action for acts of counterfeiting in its trademark infringement provisions (Ind. Code § 24-2-1-13; see Question 4).

Standing Requirements

Only the owner of a mark registered under the Indiana trademark registration statute may sue under the anti-counterfeiting section of the Indiana statute (Ind. Code § 24-2-1-13).

Remedies

The Indiana trademark registration statute provides the following remedies for acts of counterfeiting:

- Injunctive relief against the use, manufacture, display, or sale of the counterfeits or imitations.
- If the acts were committed with the intent to cause confusion or mistake or to deceive:
  - damages; and
  - disgorgement of profits.
- An order for the delivery of the items bearing the counterfeit mark to the court or the mark owner for destruction.
- If the defendant intentionally used the counterfeit mark knowing it to be counterfeit, up to three times the amount of:
  - profits; or
  - damages.
- Reasonable attorneys' fees to the prevailing party, in exceptional cases.

(Ind. Code §§ 24-2-1-13 and 24-2-1-14.)

Statutory Exemptions or Defenses

The statute does not set out any specific exemptions or defenses.

State Unfair Competition and Deceptive Trade Practices Statutes

13. Does your state have any unfair competition or deceptive trade practices statutes with a private right of action? If so, please identify the statute(s) and describe for each:

- The types of acts or practices it prohibits.
- The standing requirements for a private action.
- The remedies available for violations.
- Any statutory exemptions or defenses to private claims.

Deceptive Consumer Sales Act: Ind. Code §§ 24-5-0.5-0.1 to 24-5-0.5-12

Prohibited Conduct

The Indiana Deceptive Consumer Sales Act (IDCSA) prohibits suppliers from committing an unfair, abusive, or deceptive act, omission, or practice in connection with a consumer transaction (Ind. Code § 24-5-0.5-3(a)). Under the IDCSA, the definition of a supplier includes:

- A seller, lessor, assignor, or other person who regularly engages in or solicits consumer transactions.
- A manufacturer, wholesaler, or retailer, whether or not the person deals directly with consumers.
- A debt collector.

(Ind. Code §§ 24-5-0.5-2(a)(3).)

Deceptive acts include, but are not limited to, a supplier representing that:

- Its product has sponsorship, approval, performance, characteristics, accessories, uses, or benefits that it does not have, and the supplier knows or should reasonably know that it does not have.
- Its product is of a particular standard, quality, grade, style, or model if it is not, and the supplier knows or reasonably should know that it is not.

- Goods are new or unused if they are not, and the supplier knows or reasonably should know that they are not.
- Goods will be supplied to the public in a greater quantity than the supplier intends or reasonably expects.
- Replacement or repair is needed when the supplier knows or should know that it is not.
- A specific price advantage exists when it does not, and the supplier knows or should reasonably know that it does not.
- The supplier has a sponsorship, approval, or affiliation in a consumer transaction that it does not have and that it knows or should reasonably know that it does not have.
- A warranty, disclaimer of warranties, or other rights, remedies, or obligations are involved or are not involved when the representation is false, and the supplier knows or reasonably should know that it is false.
- A consumer will receive a rebate, discount, or other benefit as an inducement for entering a sale or lease in return for receiving the names of prospective consumers, if earning the benefit is contingent on the occurrence of an event after the time the consumer agrees to the sale or lease.
- It can deliver or complete the subject of a transaction in a period of time in which the supplier knows or reasonably should know that it cannot.
- An advertised item that it does not intend to sell is available for purchase.
- A replacement or repair can be made for a given estimate if:
  - the cost exceeds the estimate by 10% or more;
  - the supplier did not receive written permission from the customer to complete the work;
  - the total cost for services and parts is more than $750; and
  - the supplier knew or reasonably should have known that the cost would exceed the estimate.
- A replacement or repair is needed when the supplier disposes of the part repaired or replaced sooner than 72 hours after both:
  - the customer has been told the work has been completed; and
  - the part repaired or replaced has been made available for examination on request of the customer.

(Ind. Code § 24-5-0.5-3(b).)

The IDCSA also prohibits suppliers from:

- Engaging in the replacement or repair of the subject of a consumer transaction if:
  - the consumer has not authorized it; and
  - the supplier knows or should reasonably know that it is not authorized.
- Misrepresenting their geographic location in a telephone directory by listing an alternate name.
- Listing an alternate business name or an assumed business name in a local telephone directory or directory-assistance database under circumstances that misrepresent the supplier's geographic location.
- Knowingly selling or reselling a recalled product unless the product has been repaired or modified to correct the defect that was the subject of the recall.
- Violating various other state and federal laws concerning consumer transactions.

(Ind. Code § 24-5-0.5-3(b).)

Standing Requirements for a Private Action

Before bringing an action under the IDCSA if the deceptive act is curable, a consumer must give written notice to the supplier within the sooner of:

- Six months after discovery of the deceptive act.
- One year following the relevant consumer transaction.
- Any time limitation of at least 30 days for any warranty period applicable to the transaction.

The notice must fully state the nature of the alleged deceptive act and the actual damage the consumer suffered as a result. (Ind. Code § 24-5-0.5-5(a).)

No such notice is required if the deceptive act is incurable (Ind. Code § 24-5-0.5-5(a)).

A person may then bring an action or a class action under the IDCSA based on a deceptive act that is:

- Uncured, meaning the consumer has given notice and either:
  - has not received an offer to cure within 30 days of the notice; or

- the deceptive act has not been cured within a reasonable time after the consumer's acceptance of the offer to cure.
- Incurable, meaning that the scheme was undertaken with the intent to defraud or mislead.

(Ind. Code §§ 24-5-0.5-2(a)(7), (8), and 24-5-0.5-4(a), (b).)

An offer to cure under the IDCSA must be an offer that considers the value of the attorney's fees, expenses, and other costs that a consumer may incur in relation to the deceptive act, so the offer both:

- Is reasonably calculated to remedy a loss claimed by the consumer.
- Includes a minimum additional amount that is the greater of:
  - 10% of the value of the reasonably calculated remedy, but not more than $4,000; or
  - $500.

(Ind. Code § 24-5-0.5-2(a)(6).)

Remedies

Available remedies under the IDCSA include:

- The greater of actual damages or $500.
- For a willful deceptive act, damages of up to the greater of:
  - three times actual damages; or
  - $1,000.
- Reasonable attorney's fees.

(Ind. Code § 24-5-0.5-4(a).)

Statutory Exemptions or Defenses to Private Claims

The IDCSA:

- Excludes an act when a supplier shows by a preponderance of the evidence that:
  - the act resulted from a bona fide error; and
  - the supplier-maintained procedures reasonably adopted to avoid the error.
- Provides a defense if the supplier:
  - made the representation constituting an alleged deceptive act in good faith, without knowledge that it was false, and in reliance on the oral or written representations of the manufacturer, the person from whom the supplier acquired the product, any testing organization, or any other person; and
  - disclosed the source to the consumer.

(Ind. Code § 24-5-0.5-3(d), (e).)

A private action under the IDCSA is time barred if it is brought more than two years after the occurrence of the deceptive act. The attorney general may bring an action to enjoin a deceptive act within five years of the act. (Ind. Code § 24-5-0.5-5(b).)

14. For each statute listed in Question 13, please describe the elements of a cause of action.

Deceptive Consumer Sales Act: Ind. Code §§ 24-5-0.5-0.1 to 24-5-0.5-12

A plaintiff has a cause of action under the Indiana Deceptive Consumer Sales Act when a supplier engages in prohibited conduct under the statute (Ind. Code §§ 24-5-0.5-2(a)(7), (8), and 24-5-0.5-3(a), (b); see Question 13: Prohibited Conduct and Standing Requirements for a Private Action).

A claim arises when a good or service is other than what the seller represented and either:

- The consumer gives notice of the problem to the supplier and the supplier either:
  - does not respond within 30 days of the notice with an offer to cure the problem; or
  - does offer to cure but does not complete the cure in a reasonable time after the consumer accepts the offer.
- The defect or deceptive act was done by a supplier as part of a scheme, artifice, or device with intent to defraud or mislead (notice is not required in this instance).

(*Perry v. Gulf Stream Coach, Inc.*, 814 N.E.2d 634, 646-47 (Ind. Ct. App. 2004).)

15. For each statute listed in Question 13, please describe the statute's applicability to trademark infringement and dilution claims.

Deceptive Consumer Sales Act: Ind. Code §§ 24-5-0.5-0.1 to 24-5-0.5-12

The Indiana Deceptive Consumer Sales Act (IDCSA) has not been applied by a court to a claim of trademark infringement or dilution. The IDCSA protects against consumer deception, which may apply to trademark infringement cases (Ind. Code §§ 24-5-0.5-2(a)(7), (8), and 24-5-0.5-3).

16. Please identify the principal common law unfair competition causes of action in your state that are available to trademark owners and for each cause of action describe:

- The elements of the cause of action.
- Any significant distinctions between claims under state common law and claims under Section 43(a) of the Lanham Act.

Elements of a Common Law Unfair Competition Cause of Action

Indiana common law does not define unfair competition as a single course of conduct or tort with a specific number of elements (*Felsher v. Univ. of Evansville*, 755 N.E.2d 589, 598 (Ind. 2001)). Instead, it describes an open-ended category in which any number of torts may be recognized by the courts, including wrongful interference with a contract or business relationship and predatory price cutting (*Keaton*, 842 N.E.2d at 820; *Bartholomew Cty. Beverage Co. v. Barco Beverage Corp.*, 524 N.E.2d 353, 358-59 (Ind. Ct. App. 1988)).

Indiana courts have held that unfair competition is the attempt to create confusion concerning the source of the unfair competitor's goods (*Westward Coach Mfg. Co. v. Ford Motor Co.*, 388 F.2d 627, 633 (7th Cir. 1968)). This may include:

- Palming off or passing off, which occurs when a competitor misleads or deceives the public into buying its goods believing they are the goods of another.
- Reverse palming off, which occurs when a defendant misappropriates the goodwill in a plaintiff's goods or services by removing the name or trademark from genuine goods or services and selling those genuine goods or services under the defendant's brand.

(*Beacham v. Macmillan, Inc.*, 837 F. Supp. 970, 976-77 (S.D. Ind. 1993) (applying Indiana law).)

In alleging unfair competition, the plaintiff does not need to show actual deception, but only that deception is the "natural and probable consequence" of the defendant's actions (*Hammons Mobile Homes, Inc. v. Laser Mobile Home Transp., Inc.*, 501 N.E.2d 458, 461 (Ind. Ct. App. 1986)).

Key Lanham Act Distinctions

Federal courts have found that there is no substantial difference between a claim of unfair competition under the Lanham Act and one under Indiana common law (*Dwyer Instruments, Inc. v. Sensocon, Inc.*, 873 F. Supp. 2d 1015, 1040 (N.D. Ind. 2012)).

Other Significant State Statutory and Common Law Trademark-Related Claims

17. Please describe any significant statutory or common law causes of action in your state available to trademark owners that are not already described in the preceding questions (for example, false advertising and trade libel).

Misleading Trade Names: Ind. Code §§ 24-2-2-1 to 24-2-2-4

The Misleading Trade Names statute prohibits individuals and entities from falsely indicating that goods, wares, or merchandise come from the US government or its agencies or armed services (Ind. Code §§ 24-2-2-1 and 24-2-2-2).

Recourse for a violation of the Misleading Trade Name statute may include:

- Injunctive relief.
- Reasonable attorneys' fees.
- Criminal penalties for a class C misdemeanor if the violation was reckless.

(Ind. Code §§ 24-2-2-3 and 24-2-2-4.)

Cloth Product Trademarks: Ind. Code §§ 24-4-5-1 to 24-4-5-8

Indiana's Cloth Product Trademark law (ICPTL) prohibits the following in connection with any circulating product or delivery container that is marked with or by any name, mark, or device, without the registrant's written consent:

- Sell, buy, rent, launder, clean, give, take, or otherwise traffic in.
- Erase, obliterate, or otherwise cover up, conceal, or remove the registered name, mark, or device.
- Fill or refill.

(Ind. Code § 24-4-5-2.)

The law does not apply to persons who have bought the product or container from a registrant (Ind. Code § 24-4-5-2(a)).

Available remedies for a violation of the ICPTL include:

- Actual damages.
- Costs.
- Reasonable attorneys' fees.

(Ind. Code § 24-4-5-7.)

A violation of the ICPTL is a class B infraction (Ind. Code § 24-4-5-7).

18. For each statute or common law claim identified in Questions 4, 5, 6, 12, and 13, identify any applicable statute of limitations and how it is calculated.

Statutory and Common Law Trademark Infringement

There is no specific statute of limitations period for Indiana statutory and common law infringement claims. However, the US District Court for the Northern District of Indiana, analyzing Indiana law, applied a two-year limitations period to trademark claims based on other similar statutes (*Dwyer Instruments, Inc. v. Sensocon, Inc.*, 2012 WL 3207254, at *18 (N.D. Ind. March 23, 2012)).

Additionally, Indiana law provides a general limitation period of two years from when a cause of action accrues for injury to person or character or to personal property (Ind. Code § 34-11-2-4(a)).

Dilution

There is no specific statute of limitations for claims arising under the Indiana anti-dilution statute. However, Indiana law provides a general limitation period of two years from when a cause of action accrues for injury to person or character or to personal property (Ind. Code § 34-11-2-4(a)).

Counterfeiting

There is no specific statute of limitations for counterfeiting claims. However, Indiana law provides a general limitation period of two years from when a cause of action accrues for injury to person or character or to personal property (Ind. Code § 34-11-2-4(a)).

Unfair Competition and Deceptive Trade Practices

There is no specific statute of limitations for a common law claim of unfair competition. However, Indiana law provides a general limitation period of two years from when a cause of action accrues for injury to person or character or to personal property (Ind. Code § 34-11-2-4(a)).

Deceptive Consumer Sales Act: Ind. Code §§ 24-5-0.5-0.1 to 24-5-0.5-12

A consumer must bring a claim within two years of the occurrence of the deceptive act (Ind. Code § 24-5-0.5-5(b)).

State Criminal Trademark Laws

19. Does your state have any criminal trademark protection statutes? If so, please show the statute and describe the offense.

A person may be criminally liable in Indiana for trademark claims under the following statutes prohibiting counterfeiting, forgery, conversion, and theft. In certain circumstances involving mismarking of recordings, a person may be criminally liable for fraud.

Counterfeiting or Forgery: Ind. Code § 35-43-5-2

In Indiana, it is a criminal offense to make or possess a written instrument that misrepresents its source (Ind. Code § 35-43-5-2(a), (b)).

A "written instrument" means a paper, a document, or other instrument containing written matter and includes trademarks or other objects or symbols of value, right, privilege, or identification (Ind. Code § 35-43-5-1(s); see *An-Hung Yao v. State*, 975 N.E.2d 1273, 1279-80 (Ind. 2012) (toy guns are written instruments); *Jacobs v. State*, 640 N.E.2d 61, 64 (Ind. Ct. App. 1994) (t-shirts with fake Guess, Nike, and Polo logos)).

A person commits counterfeiting, a level 6 felony, by knowingly or intentionally:

- Making or uttering a written instrument in a manner that it purports to have been made:
  - by another person;
  - at another time;
  - with different provisions; or
  - by authority of one who did not give authority.
- Possessing more than one written instrument knowing that the instruments purport to have been made:
  - by another person;
  - at another time;
  - with different provisions; or
  - by authority of one who did not give authority.

(Ind. Code § 35-43-5-2(a).)

A person commits forgery, a level 6 felony, by making, uttering, or possessing a written instrument with the intent to defraud in a manner that it purports to have been made either:

- By another person.
- At another time.
- With different provisions.
- By authority of one who did not give authority.

(Ind. Code § 35-43-5-2(b).)

Conversion or Theft by Encumbrance of a Trademark: Ind. Code §§ 35-43-4-2(a) and 35-43-4-3(a)

When a trademark is infringed, the infringer may be liable for conversion or theft due to the loss of value in the trademark caused by the infringement (see *An-Hung Yao*, 975 N.E.2d at 1282; *Curtis v. State*, 987 N.E.2d 523, 524 (Ind. Ct. App. 2013)).

It is a class A misdemeanor to knowingly or intentionally obtain, take, carry, sell, conceal, convey, encumber, or possess a trademark, service mark, or other source indicator or to secure, transfer, or extend a right to a trademark, service mark, or other source indicator when:

- Another person owns the trademark, service mark, or other source indicator.
- The activity is undertaken:
  - without the other person's consent;
  - in a manner or to an extent other than that to which the other person has consented;
  - by transferring or encumbering other property while not disclosing a lien, adverse claim, or other legal impediment to the enjoyment of that trademark, service mark, or other source indicator;
  - by creating or confirming a false impression in the other person;
  - by not correcting a false impression that the person knows is influencing the other person, if the person stands in a relationship of special trust to the other person;
  - by promising performance that the person knows will not be performed; or
  - by expressing an intent to damage the trademark, service mark, or other source indicator or impair the rights of any other person.

(Ind. Code §§ 35-43-4-1(a), (b), and 35-43-4-3(a).)

A person commits theft, a class A misdemeanor, when conversion is committed knowingly or intentionally with intent to deprive the other person of any part of the value or use of the trademark, service mark, or other source indicator (Ind. Code § 35-43-4-2(a)).

However, the offense is a level 6 felony if either:

- The fair market value of the property or the cost to replace the property within a reasonable time after the offense was committed (if the fair market value cannot be satisfactorily determined) between $750 and $50,000.
- The property is a motor vehicle or component part of a motor vehicle.
- The person has a prior unrelated conviction for theft or criminal conversion of property under this law.

(Ind. Code § 35-43-4-2(a)(1).)

The offense is a level 5 felony if either:

- The fair market value of the property or the cost to replace the property within a reasonable time after the offense was committed (if the fair market value cannot be satisfactorily determined) is at least $50,000.
- The property that is the subject of the theft is a valuable metal, its absence creates substantial risk of bodily injury, and it:
  - relates to transportation safety;
  - relates to public safety; or
  - is taken from a hospital or other health care facility, telecommunications provider, public utility, or key facility and the absence of the property creates a substantial risk of bodily injury to a person.
- The property is a motor vehicle or component part of a motor vehicle, and the person has a prior unrelated conviction for theft of a motor vehicle or component part.
- The property is a firearm.

(Ind. Code § 35-43-4-2(a)(2), (3).)

Pending Legislation

20. Please describe any legislation pending in your state that would materially impact civil trademark enforcement and protection.

There is no relevant legislation pending in Indiana. However, the federal Trademark Modernization Act of 2020 (Consolidated Appropriations Act, Pub. L. No. 116-260, 134 Stat 1182, Sec. 221-228 (2020)) will provide persuasive authority for Indiana courts going forward concerning whether trademark claims enjoy a presumption of irreparable harm.

Additionally, the Supreme Court's decision *in U.S. Patent and Trademark Office v. Booking.com* may alter how Indiana deals with ".com" trademarks (140 S. Ct. 2298 (2020)).