

INSTRUCTIONS ON FILING A PETITION FOR REVOCATION OF TRADE NAME, TRADEMARK OR SERVICE MARK

If you have decided that you wish to file a petition seeking the revocation of a registered name or mark, you should first determine whether you are trying to revoke the registration (A) because it is not being used ("nonuse") or (B) because you feel you owned the name or mark first ("prior ownership"). You can of course proceed on both grounds at once in which case you should follow both sets of instructions.

A. The name or mark is not being used.

If you believe the trade name is not being used by the party who registered it, you may file a petition for revocation on the grounds of nonuse. Essentially, by filing for revocation, you are asking the Department of Commerce and Consumer Affairs to revoke the current owner's registration of the trade name so that you may register the trade name yourself. Before you file though, there are two matters you should check into first.

First, you must check whether or not the party holding the registration (the "respondent") has used the trade name within the past 365 days. According to the Hawaii Revised Statutes, Section 482-6, the party must not have used the trade name for 365 consecutive days, counting backwards from the day you file for revocation. By checking on the use within the past year, however, you should have some indication as to whether the trade name is in use at all. Usually if the registered party has not used the name within the year prior to your investigation, it is unlikely they will use it after you file for revocation. If they do start using the trade name after you file the petition, it will still be considered as abandoned. In any case, it is best to move promptly and file the petition for revocation as soon as possible. Places to check whether the name is being used or not include the current and previous telephone directories and the State Department of Taxation. Where you should check depends on the type of business or product involved. The goal should be to check those sources where you would expect someone in that business to be listed, registered, advertised, etc.

Second, you must prove that the name has not been registered with the United States Patent Office. If the name is so registered, even if it is not being used locally, you cannot proceed with the revocation process. However, if the name is not so registered, you will be able to prove the second qualification needed in a nonuse trade name case. In order to verify whether a trade name is registered with the U. S. Patent Office, you may check the "*Official Gazette of the U. S. Patent Office.*" Copies are located in the main branch of the public library system and at the University of Hawaii's Hamilton Library. Firms that plan to market nationally or internationally may also want to have a private company conduct a more thorough trade name search.

Remember that you must be able to prove both that the trade name has not been in use 365 days before your filing a petition for revocation and that the trade name is not registered with the U.S. Patent Office.

B. You believe you have the rights to a name which is registered to someone else.

If you believe that you are the owner of a trade name that has been registered to some other party, you may file a petition for revocation on the grounds of prior ownership. Essentially, by filing for revocation you are alleging that you have made longer continuous

use of the name than the party who has the registration. Where there is evidence that both parties have used the name, the issue is which party made the first and continuous active use of the name. Your responsibility is to gather evidence of your use of the name and compare it with the other party's use of the name.

As you review the evidence remember that the Department defines "use" as the active use of a trade name to identify a business, vocation or occupation in the marketplace. (For a trademark, "use" is the active use of a trademark affixed to a product which is sold in the marketplace.) By using the word "active," there must be actual adoption and use of the trade name in the marketplace.

C. Filing of a petition.

The format for the petition is attached at the back as well as two sample petitions. Once you have completed it, you should bring it to the Department's Hearings Office to be filed. At that time, the Hearings Office will check to ensure that the petition is in proper form.

You must also keep in mind that the party who files the petition for revocation ("the petitioner") has the burden of proof. This means that the petitioner in nonuse cases will have to prove that "the respondent" has not used the trade name during the 365 days before the filing of the petition for revocation and that the name is not registered with the U.S. Patent Office. In prior ownership cases, the petitioner must prove earlier ownership of the name. If the petitioner fails to meet the burden of proof, the petition will be denied because it is up to the petitioner to show why the revocation is justified. Of course, the respondent would not rely on the petitioner failing to fulfill his burden of proof and should come to the hearing prepared to show use of the name or to explain why the respondent is the owner of the name rather than the petitioner.

This material can be made available for individuals with special needs. Please call the Division Secretary, Business Registration Division, DCCA, at 586-2744, to submit your request.

REQUIREMENTS FOR HAWAII REVISED STATUTES
CHAPTER 482 PETITIONS FOR TRADEMARK AND
TRADE NAME REVOCATION

1. The proper petition caption is as follows:

In the Matter of the)	
)	
Trademark [or Trade Name])	TM [or TN] <u>[leave blank]</u>
)	
"[fill in registered name]")	
_____)	

2. The petition shall:

- a. State the name, telephone number and mailing address of the petitioner.
 - b. State the name and current address of the respondent (registrant). Do not merely list the address that appears on the certificate of registration. You must attempt to find the current whereabouts of the respondent and determine the address at which service can be achieved. If you are unable to do so, you may be required to satisfy the service by publication requirement of HRS §91-9.5.
 - (1) If the registrant is a corporation, also list the name and current address of the president.
 - (2) If the registrant is a dissolved corporation, also list the name and current address of the trustee.
 - (3) If the registrant is bankrupt, also list the name and current address of the trustee in bankruptcy.
 - (4) If the registrant is deceased, also list the name and address of the personal representative.
 - c. State the date the certificate of registration for the subject trademark or trade name was issued to the respondent and the certificate number under which it was issued.
 - d. Cite the statutory sections(s) relied upon for revocation--HRS §482-6 (nonuse) and/or HRS §482-8 (ownership).
 - e. State the facts in support of the statutory section(s) relied upon in the petition.
3. The petition shall be verified upon oath of the petitioner.
4. The original and two copies of the petition shall be filed with the Department of Commerce and Consumer Affairs ("DCCA") Hearings Office, Penthouse, 1010 Richards Street, Honolulu, Hawaii.
5. A copy of the respondent's certificate of registration should be attached to the petition.
6. Consult the "Uniform Rules of Administrative Procedure for Chapter 482 (Title 16, Chapter 201)" for additional filing requirements--pay particular attention to §§16-201-9 and 16-201-26. You may purchase a copy of the Uniform Rules from the DCCA cashier.

7. Please remember that you have the right to legal counsel at all stages of these proceedings.

BUSINESS REGISTRATION DIVISION
DEPARTMENT OF COMMERCE AND CONSUMER AFFAIRS
STATE OF HAWAII

In the Matter of the)
)
Trade Name) TN- _____
)
"HARRY'S HUMMING HIPPOS")
_____)

Petition For Revocation (nonuse)

The petitioner, HENRY'S HIPPOS, INC., hereby petitions the Department of Commerce and Consumer Affairs for revocation of the trade name "HARRY'S HUMMING HIPPOS."

1. HENRY'S HIPPOS, INC., a Hawaii corporation has its principal place of business at 1234 Hippo Drive, Honolulu, Hawaii 99999, telephone number (808)999-9999.

2. The name and current address of the respondent (registrant) is:

HARRY'S HUMMING HIPPOS, INC.
111 Hum-Along Road
Honolulu, Hawaii 55555

*If the registrant is a corporation

The name and current address of the registrant is:

HARRY'S HUMMING HIPPOS
111 Hum-Along Road
Honolulu, Hawaii 55555

The name and current address of the registrant's president is:

HARRY ZOO
222 Any Street
Honolulu, Hawaii 99999

*If the registrant is a dissolved corporation

The registrant, HARRY'S HUMMING HIPPOS, INC., formerly of 111 Hum-Along Road, Honolulu, Hawaii 55555, is a dissolved corporation. It has been determined that all dealings with HARRY'S HIPPOS should be taken up with its trustee. The name and current address of the trustee is:

MARY TRUSTEE
77 Financial Row
Honolulu, Hawaii 54321

*If the registrant is a partnership

The name and current address of the registrant is:

HARRY'S HUMMING HIPPOS
111 Hum-Along Road
Honolulu, Hawaii 55555

The name and current address of the partnership's general partner is:

HARRY ZOO
222 Any Street
Honolulu, Hawaii 99999

*If the registrant is bankrupt

The registrant has filed for bankruptcy with the U.S. Bankruptcy Court. All matters dealing with HARRY'S HUMMING HIPPOS should be referred to the trustee in bankruptcy. The name and current address of the trustee is:

MARY TRUSTEE
77 Financial Row
Honolulu, Hawaii 54321

*If the registrant is deceased

The registrant passed away on May 24, 1980. The personal representative handling the estate of Harry Zoo is:

SAM REPRESENTATIVE
50 Another Street
Honolulu, Hawaii 12345

3. The respondent was issued the certificate of registration for the trade name "HARRY'S HUMMING HIPPOS" on July 17, 1979. The certificate of registration number is 99999.
4. The statutory section relied upon for revocation is HRS §482-6 (nonuse).
5. Facts in support of this petition are as follows:
 - a. Since the date of registration, July 17, 1979, the respondent has failed to use the said trade name actively in the channels of commerce.
 - b. The said trade name has not been listed in the telephone for the city of Honolulu and the counties of Hawaii, Maui and Kauai.

c. There was no general excise tax license issued to the registrant or under the said trade name.

d. The trade name could not be located in any editions of Polk's City Directories.

e. The petitioner has determined that the respondent never registered the trade name "HARRY'S HUMMING HIPPOS" with the U.S. Patent Office.

WHEREFORE, Petitioner requests the Director of the Department of Commerce and Consumer Affairs to revoke certificate of registration no. 99999.

Signature of Petitioner

Plus verification

Plus copy of certificate of registration

BUSINESS REGISTRATION DIVISION
DEPARTMENT OF COMMERCE AND CONSUMER AFFAIRS
STATE OF HAWAII

In the Matter of the Application)
for the Trade Name) TN- _____
"FREDDIE'S DANCING FROGS")
_____)

Petition for Revocation (prior ownership)

The petitioner, "FREDDIE'S DANCING FROGS, INC.," hereby petitions the Department of Commerce and Consumer Affairs for revocation of the trade name "FREDDIE'S DANCING FROGS, INC."

1. "FREDDIE'S DANCING FROGS, INC." a Hawaii corporation has its principal place of business at 44 Dancing Frog Drive, Honolulu, Hawaii 90000, telephone number (808)987-6543.

2. The name and current address of the party who registered the trade name "FREDDIE'S DANCING FROGS" is:

JOHN DOE
99 Any Street
Honolulu, Hawaii 12345

3. The registrant was issued certificate of registration no. 99999 for the trade name "FREDDIE'S DANCING FROGS" on February 23, 1981.

4. The statutory section relied upon for revocation is HRS §482-8, prior ownership.

5. Facts in support of this petition are:

a. The respondent received certification for the registration of the trade name "FREDDIE'S DANCING FROGS" on or about February 23, 1981, and did not initiate use until April 15, 1981. Since that date, the respondent has used the trade name sporadically, not in accordance with the Department of Commerce and Consumer Affairs' requirement of active adoption and use in the marketplace.

b. Approximately seven years and four months prior to the respondent's use of the trade

name "FREDDIE'S DANCING FROGS," the petitioner commenced business under the

name "FREDDIE'S DANCING FROGS, INC." Since the initial use of "FREDDIE'S DANCING FROGS, INC." on January 3, 1974, the petitioner has continuously and actively used the name. Only recently when the petitioner received notice of rejection for the trade name "FREDDIE'S DANCING FROGS, INC." from the Business Registration Division did petitioner have knowledge of respondent and his use of "FREDDIE'S DANCING FROGS."

- c. Since entering the market in 1974, "FREDDIE'S DANCING FROGS, INC." have become synonymous with the dancing frog industry.
- d. "FREDDIE'S DANCING FROG, INC." currently holds a federal trademark, Ret. U.S. Patent Office 9,999,999.

WHEREFORE, Petitioner requests the Director of Commerce and Consumer Affairs to revoke certificate of registration no. 99999.

Signature of Petitioner

Plus verification

Plus copy of certificate of registration

VERIFICATION

_____))
_____))
_____)) SS.
_____))
_____)

_____, being first duly sworn, on oath deposes and says that s/he is the _____ of _____

_____,
that s/he has examined the attached petition and knows the contents thereof, and that the facts set forth therein are true to the best of his/her knowledge and belief.

Subscribed and sworn to before me this

_____ day of _____, 20_____

Notary Public, State of Hawaii
My commission expires: _____