

# PAUL MAKI

ATTORNEY AT LAW  
AUGUST 1970 - PRESENT

May 5, 2003

## RESUME OF PAUL MAKI

My legal practice emphasizes the full scope of trademark and copyright law, including registration, vigilance, licensing and enforcement, both in the United States and throughout the world, and business and commercial litigation.

### EDUCATION:

Cornell University, Ithaca, New York  
B.A., 1968

The University of Michigan Law School,  
Ann Arbor, Michigan  
Juris Doctor, cum laude, 1971

### PROFESSIONAL:

#### Courts:

Supreme Court of the State of Hawaii  
Admitted March, 1972

United States District Court for the District of Hawaii  
Admitted March, 1972

United States Court of Appeals for the Ninth Circuit  
Admitted May, 1972

Supreme Court of the United States of America  
Admitted June, 1980

Memberships:

American Bar Association, Litigation and Intellectual Property Law Sections

Hawaii Bar Association, Intellectual Property Law Section

International Trademark Association, one of 55 attorneys appointed from throughout the United States on its Panel of Neutrals

American Intellectual Property Law Association

Association of Trial Lawyers of America

American Judicature Society

Judicial Conference of the United States District Court for the District of Hawaii, 2002 - 2004

HIGHLIGHTS OF LITIGATION EXPERIENCE

1. Love, et al. v. Marine Surf Waikiki, et al., Civil No. 71-3420 in the U. S. District Court for the District of Hawaii. Represented 2 of 3 defendants in class action suit claiming Rule 10b-5 violations in connection with sale of condominium apartments with management agreement. Jury found for defendants.
2. Vance, et al. v. Amfac, Inc., et al., Civil No. 72-3695 in the U. S. District Court for the District of Hawaii. Represented class action plaintiffs who purchased condominium units and limited partnership interests in the Maui Hilton, Kaanapali, Maui. Case settled.
3. Higa v. Mirikitani. Represented individual in claim of legal malpractice against former attorney. Appeal to Hawaii Supreme Court established applicable statute of limitations for such claims. See 55 Haw. 167, 517 P.2d 1 (1973)
4. Grand Jury Investigation of Possible Antitrust Violations in Tourist Industry, U. S. District Court for the District of Hawaii. Represented several individuals in connection with investigation by the U. S. Justice Department in the alleged anti-trust violations in the Hawaii tourist industry.

5. Securities and Exchange Commission v. Crown Corporation, et al., Civil No. 76-0093 in the U. S. District Court for the District of Hawaii. Acted as co-special counsel appointed by the Court, pursuant to a consent decree among the parties, in investigation of the business dealings of Crown Corporation and LTH, Ltd. (formerly Hawaii Thrift & Loan, Inc.).
6. The Hawaii Corporation Litigation. Represented former president and chief executive officer of The Hawaii Corporation in numerous lawsuits, including investor class actions, in both federal and state courts, arising from the demise of that corporation and THC Financial Corporation.
7. Securities and Exchange Commission v. MacDonald, et al., Civil No. 79-0283 in the U. S. District Court for the District of Hawaii. Represented one of several defendants accused by S.E.C. of violating certain provisions of federal securities laws in connection with sales of real property in Nevada. Claims against my client dismissed following trial. Court granted injunctive relief against other defendants.
8. Hawaiian Trust Company, Limited v. Cowan. Represented Hawaiian Trust Company in commercial lease dispute. Judgement in favor of Hawaiian Trust affirmed on appeal at 4 Haw. App. 166, 663 P.2d 634 (1983).
9. Heptachlor Litigation. Acted as lead counsel on behalf of Del Monte Corporation in multiple cases in various courts, including writ of mandamus and appeal before the Hawaii Supreme Court, relating to alleged heptachlor contamination of milk supply on Oahu. Supervised a staff of several attorneys and paralegals.
10. Fidelity National Mortgage Company v. Kainz, Civil No. 90-0366-02 in the Second Circuit, State of Hawaii. Represented one of two general partners in a partnership dissolution and mortgage foreclosure case relating to a large parcel of land in Kihei, Maui. We prevailed at trial, and our client became sole owner of the property.
11. Happy Shirts, Inc. v. Bearman, et al., Civil No. 89-00499 DAE in the U.S. District Court for the District of Hawaii. Represented the plaintiff in an action for trademark infringement. The case was settled after a 10 day jury trial.
12. Gilligan v. Stouffer Hotel Company, et al., Civil No. 91-2500-07 in the Circuit Court of the First Circuit, State of Hawaii. Successfully defended The Nippon Credit Bank, Ltd. in case where plaintiff was claiming a multi-million dollar commission from the sale of a hotel.

13. Kliban v. Chaitanya Saraswat Mandal, et al., Civil No. 93-00891 HMF in the United States District Court for the District of Hawaii. Represented copyright owner in successful action to seize goods bearing infringing designs and to stop further production and sale of such goods.
14. Happy Shirts, Inc., et al. v. Chaitanya Saraswat Mandal, et al., Civil No. 94-0023 SPK in the U.S. District Court for the District of Hawaii. Represented copyright and trademark owners in successful effort to seize goods bearing infringing designs and to stop further production and sale of such goods.
15. Marc Hotels & Resorts, Inc. v. Maui Eldorado Resort. Successfully obtained an arbitration award and judgement in favor of Marc Hotels & Resorts in dispute relating to improper termination of a management contract. When judgement debtor, which was a limited partnership, sought to avoid the judgment by improperly transferring assets, initiated an action in the Circuit Court of the Second Circuit which sought and obtained collection from the limited partners.
16. Star Markets, Ltd. v. Texaco Inc., Civil No. 95-01018 BMK in the U.S. District Court for the District of Hawaii. Represented Texaco in Lanham Act case (trademark infringement and dilution claims). Case ended with a confidential settlement agreement following the jury's verdict.
17. Reece v. DFS Group L.P., Civil No. 98-00021HG in the U.S. District Court for the District of Hawaii. Represented fine art photographer in copyright infringement action against major Hawaii retailer. Court granted our motion for preliminary injunction. Case settled just before trial. Terms of settlement are confidential.
18. Montoya, et al. v. Royal Aloha, Coffee, Tea and Spice Co., Inc.. Obtained an arbitration award and judgment in the amount of \$492,000 against the "The Bad Ass Coffee Co." franchisor arising from violations of the Hawaii Franchise Investment Law, Chapter 482E, Hawaii Revised Statutes.
19. Kohala Agriculture v. Deloitte & Touche, in the Circuit Court of the First Circuit, State of Hawaii. Represented a limited partnership in action asserting that Deloitte & Touche failed to properly conduct audits. After successful appeal [see Kohala Agriculture v. Deloitte & Touche, 86 Haw. 301, 949 P.2d 141 (App. 1997)], case was amicably resolved in early 2000.

20. Marc Hotels & Resorts, Inc. v. Western Apartment Supply and Maintenance Co. Obtained an arbitration award in excess of \$300,000 arising from the breach of a hotel management contract.
21. Rossi v. Motion Picture Association of America, Inc., et al., Civil No. 02-002239BMK in the U.S. District Court for the District of Hawaii. Successfully defended the Motion Picture Association of America in connection with claims arising from its enforcement efforts under the Digital Millennium Copyright Act.

#### COPYRIGHT AND TRADEMARK MATTERS

Represent clients in trademark and copyright matters, including applications for registration, licensing, vigilance and infringement claims, in the State of Hawaii, the United States and throughout the world. Representative clients include: Crazy Shirts, Inc., Happy Shirts, Inc., Hawaii's Own Corporation, , Honolulu Academy of Arts, Motion Picture Association of America, Inc., Kim Taylor Reece, Town & Country Surf Shop, Inc., The Sports Authority, Texaco Inc.

#### BUSINESS MATTERS

Have represented various companies through the years in various business dealings. Such representation has included negotiating and drafting of leases, management agreements and other types of contracts. Have negotiated, documented and closed mergers of corporate clients with publicly held corporations.

# COPY

Ms. Marie Ryan  
ADR Staff Liaison, INTA  
1133 Avenue of the Americas  
New York, New York 10036

Re: United States CPR/INTA  
Panel of ADR Neutrals

Dear Ms. Ryan:

I am, by this letter and its enclosures, requesting that I be considered for appointment to the United States CPR/INTA Panel of Neutrals for ADR Proceedings.

I am a principal in the law firm of Edmunds Maki Verga & Thorn, Attorneys at Law, a Law Corporation and am the vice president of the firm. Our firm is a member of INTA, and I am its designated representative.

My address, telephone and fax numbers are as set forth above. My e-mail address is [pmaki@emvt.com](mailto:pmaki@emvt.com).

The following are my responses to the subjects set forth in your questionnaire on this matter, with the paragraph numbers corresponding to the paragraphs in the questionnaire:

1. Past Business Affiliations

I have been practicing law in Hawaii since I was admitted to the Bar of the State of Hawaii in 1972. My firm affiliations during that period of time are shown on my resume which is enclosed.

2. Time Devoted to Trademark and Related Matters

During the past fifteen years (indeed, since about 1976), approximately 60% of my professional time has been spent dealing with Lanham Act and copyright matters. Such professional activities have included: Prosecution of trademark applications with the United States Trademark and Patent Office, prosecution and defense of trademark opposition proceedings with the USPTO, arranging for and coordinating trademark applications in virtually every other country in the World, negotiation and drafting of license agreements, trademark and copyright vigilance, and infringement litigation.

### 3. Lanham Act Litigation

I have initiated and defended many Lanham Act cases. I have tried two such cases, Happy Shirts, Inc. v. Bearman, et al., Civil No. 89-00499 DAE, and Star Markets, Ltd. v. Texaco Inc., Civil No. 95-01018 BMK, both in the U.S. District Court for the District of Hawaii, through jury verdict. (Both of those cases terminated with confidential settlement agreements following the jury verdict.)

In the Happy Shirts case, I represented the plaintiff. The issues involved in that case were likelihood of confusion, laches, damages and profits.

In the Star Markets case, I represented the defendant, Texaco. The issues in that case were again likelihood of confusion (with extensive survey evidence involving four survey experts and more than six surveys) and damages and profits. The case was also one of the first to raise and decide issues relating to the Federal Trademark Dilution Act of 1995. Some of the court's decisions in that case are reported at 1996 WL 780472 (D.Hi. 1996); 950 F.Supp. 1030 (D.Hi. 1996); and 945 F.Supp. 1344 (D.Hi. 1996).

As both the Happy Shirts and Star Markets cases were tried before juries, extensive preparation relating to both the law and facts was necessary. Such preparation included the drafting and arguing of motions in limine and jury instructions.

I have successfully litigated claims asserting use of counterfeit marks, obtaining seizure of the goods bearing such marks pursuant to Section 34(d) of the Lanham Act. I have been involved in several other trademark infringement cases over the years. Each of those cases was resolved prior to trial.

In 1998, I initiated a copyright infringement action against a major Hawaii retailer. Due to the nature of the infringement, the case involved significant issues of both copyright and trademark law. The plaintiff was a well known Hawaii photographer. We alleged in that case that the retailer had its graphic artist copy a photograph and used the resulting drawing as a trademark. The case involved an extensive review of trademark license agreements and royalty rates, with experts involved from both New York and California. The court granted our motion for preliminary injunction, and the case was subsequently settled, with the settlement terms confidential.

In 1998, I was asked by the Hawaii State Bar Association to present, and did present, a seminar on litigating intellectual property law claims. A copy of the paper I prepared for that presentation, entitled "Intellectual Property Litigation: When, Where, How", is enclosed.

During the December 1999 Hawaii State Bar Association Meeting, I made a presentation, on behalf of the Intellectual Property Section of the HSBA, on the

subject of trademark law for the general practitioner. Approximately 60-70 attorneys were present for that presentation.

#### 4. Mediation/Arbitration Experience

I have not as yet participated in any mediation or arbitration involving intellectual property law matters. I do, however, have a great deal of experience, as both a neutral and as an advocate, in such proceedings involving other legal disputes.

My experience with mediation began in 1977 or 1978 when I acted as co-special counsel, appointed by the court, in the case entitled Securities and Exchange Commission v. Crown Corporation, et al., Civil No. 76-0093 in the U. S. District Court for the District of Hawaii. I assisted U.S. District Court Judge Martin Pence in mediating the resolution of that case and several other cases that resulted therefrom.

In the early 1980s, when acting as lead counsel for Del Monte Corporation in several cases involving pesticide contamination in Hawaii, I participated in alternative dispute resolution proceedings to resolve the issues among Del Monte and two other major defendants. The resolution of these issues led to the successful conclusion of all of the cases.

I have subsequently participated in mediation proceedings to resolve other types of cases, including sexual harassment claims and claims of accounting malpractice.

I have also participated in numerous arbitration proceedings, as both an arbitrator and an advocate. I have been selected by the parties to act as an arbitrator (or as one member of an arbitration panel) in many types of commercial cases, including disputes relating to leases and construction contracts. I currently serve as an arbitrator in the Court Annexed Arbitration Program in the State of Hawaii which decides all personal injury cases having a perceived "probable jury award value" of less than \$150,000 (with the parties having the subsequent right to trial de novo before the court). I have acted as an arbitrator in this program in 3-4 cases per year during the last approximately 10 years.

I have represented parties in arbitration proceedings involving all types of claims. For example, a few years ago, I arbitrated substantial claims relating to a hotel management agreement. Approximately one year ago, I successfully arbitrated a claim asserting violations of Hawaii's Franchise Investment Law. That arbitration resulted in an award in favor of my client in the amount of \$465,000.

#### 5. References

Reference letters from the following individuals are enclosed:



A. James E. Duffy, Jr. (who is currently awaiting confirmation of his nomination to the bench of the U.S. Court of Appeals for the Ninth Circuit);

B. Howard J. Gravelle, Jr.; and

C. Michael K. Livingston.

6. Disciplinary Proceedings

I am currently a member in good standing of the Bars of the State of Hawaii (since 1972), the U.S. District Court for the District of Hawaii (since 1972), the United States Court of Appeals for the Ninth Circuit (since 1972), and the Supreme Court of the United States of America (since 1980). I am not now, and have never been, the subject of any disciplinary proceeding.

I believe that my education, background and extensive litigation experience (both in the courts and in ADR proceedings) qualify me for appointment to the Panel of Neutrals, and I appreciate your consideration of my application. If you should require any further information from me, please let me know.

Very truly yours,

Paul Maki