

DEPT. OF COMMERCE  
AND CONSUMER AFFAIRS

2009 JUN -8 P 3: 53

HEARINGS OFFICE

BUSINESS REGISTRATION DIVISION  
OFFICE OF ADMINISTRATIVE HEARINGS  
DEPARTMENT OF COMMERCE AND CONSUMER AFFAIRS  
STATE OF HAWAI'I

In the Matter of the	)	CN 2008-2
	)	
Corporate Name	)	DIRECTOR'S FINAL ORDER
	)	
"CASH4GOLD CORPORATION DBA	)	
MAKI GOLD."	)	
	)	
	)	

DIRECTOR'S FINAL ORDER

On March 19, 2009, the duly appointed Hearings Officer submitted her Findings of Fact, Conclusions of Law and Recommended Order in the above-captioned matter to the parties.

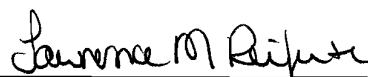
On April 20, 2009, Richard I. Dan ("Petitioner") by and through his attorney Paul Maki, Esq. filed written exceptions<sup>1</sup> to the Hearings Officer's recommended decision. Oral argument was not requested.

Upon review of the entire record of this proceeding, including Petitioner's exceptions, the Director adopts the Hearings Officer's findings of fact, but modifies the Hearings Officer's conclusions of law and concludes that the evidence presented was insufficient to establish that "Cash for Gold" had acquired the requisite secondary meaning. Secondary meaning is shown when a name has acquired consumer association and recognition. While Petitioner presented evidence regarding the degree and manner of advertising and the length and manner of use, factors to be considered in determining whether a name has acquired

<sup>1</sup> Footnote 1 of Petitioner's exceptions notes that the record of the hearing is deficient because the recording is unintelligible. The Director would note that the recording was intelligible and the misunderstanding occurred when the court reporter did not contact the Office of Administrative Hearings for assistance when it could not play the CD. Accordingly, Petitioner's request for a new hearing is denied.

secondary meaning, the evidence presented did not show “whether actual purchase[r]s of the product bearing the claimed trademark associate the trademark with the producer” and “whether use of the claimed trademark has been exclusive,” factors which must also be considered when determining whether a name has acquired secondary meaning. *See, Committee for Idaho’s High Desert, Inc. v. Yost*, 92 F.3d 814 at 822 (9<sup>th</sup> Cir. 1996), cited in Petitioner’s exceptions. Accordingly, the Director finds and concludes that Petitioner has not established by a preponderance of the evidence that Respondent’s corporate name “Cash4Gold Corporation dba Maki Gold” is substantially identical to Petitioner’s trade name “Cash for Gold” or that there is a likelihood of confusion from Respondent’s use of “Cash4Gold Corporation dba Maki Gold” and orders that Petitioner’s petition for an order of abatement be and hereby is dismissed.

DATED: Honolulu, Hawaii, June 5, 2008.



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LAWRENCE M. REIFURTH  
Director  
Dept. of Commerce  
and Consumer Affairs



DEPT. OF COMMERCE  
AND CONSUMER AFFAIRS

2009 MAR 19 A 11: 56

HEARINGS OFFICE

BUSINESS REGISTRATION DIVISION  
OFFICE OF ADMINISTRATIVE HEARINGS  
DEPARTMENT OF COMMERCE AND CONSUMER AFFAIRS  
STATE OF HAWAII

In the Matter of the	)	CN 2008-2
	)	
Corporate Name	)	HEARINGS OFFICER'S FINDINGS
	)	OF FACT, CONCLUSIONS OF
"CASH4GOLD CORPORATION	)	LAW AND RECOMMENDED
DBA MAKI GOLD."	)	ORDER
	)	
	)	

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HEARINGS OFFICER'S FINDINGS OF FACT  
CONCLUSIONS OF LAW AND RECOMMENDED ORDER

I. INTRODUCTION

On June 24, 2008, Paul Maki, Esq., on behalf of Richard I. Dan ("Petitioner") filed a petition requesting an administrative order of abatement against Cash4Gold Corporation, dba Maki Gold ("Respondent"). The Notice of Hearing and Pre-Hearing Conference was transmitted to the parties.

At the pre-hearing conference held on August 26, 2008, the parties agreed to reschedule the hearing from September 23, 2008 to November 6, 2008. On November 5, 2008, the parties agreed to reschedule the hearing to December 4, 2008.

On December 4, 2008, a hearing was conducted by the undersigned Hearings Officer. Mr. Maki appeared on behalf of Petitioner, who was also present. Respondent was represented by its President, Mr. Danilo Napala.

Having reviewed and considered the evidence and argument presented at the hearing, together with the entire record of this proceeding, the Hearings Officer renders the following findings of fact, conclusions of law and recommended order.

## II. FINDINGS OF FACT

1. On September 22, 1999, the Department of Commerce and Consumer Affairs issued Certificate of Registration No. 243075 to Petitioner for the trade name “Cash for Gold”. The purpose of Petitioner’s business is “pawn shop”. The registration expires on September 21, 2010.

2. Petitioner has been operating as a pawn shop (“Cash for Gold”) and a paycheck lending business (“Kamaaina Loan”) at 46 N. Market Street on Maui since 1983 or 1984. Petitioner advertises on Maui on television and radio, in the newspaper and in *Pennysaver* and hands out fliers, has mailers and sandwich signs. Petitioner also sells and repairs jewelry under “Cash for Gold”.

3. On March 13, 2007, Respondent was registered as a foreign profit corporation with the Department of Commerce and Consumer Affairs, File Number 36688 F1. The purpose of the business is “gold buyer, jewelry retail, second hand dealer.” Respondent is a Delaware corporation registered as Cash4Gold Corporation.

4. On May 18, 2008, the Department of Commerce and Consumer Affairs issued Certificate of Registration No. 4063096 to Respondent for the trademark “Cash4Gold Maki Gold”. According to Respondent’s application, the purpose of Respondent’s business is “precious metal and their alloys, gold and silver” and the trademark is to be used for packaging and advertising. The trade mark was first used on February 22, 2007 and first used in Hawai’i on May 4, 2007. The registration expires on May 17, 2013.

5. Respondent started business in March 2007 through a website on the internet. In August 2007, Respondent’s business was located at 1935 N. King Street, and Respondent currently does business at 1886 N. King Street.

6. By a letter dated March 31, 2008, Petitioner demanded that Respondent “immediately cease from any and all use in the State of Hawai’i of ‘Cash4Gold’ or any other name or mark that is likely to cause confusion[.]” Petitioner gave Respondent a deadline of April 8, 2008 to provide written confirmation that Respondent ceased use of “Cash4Gold”.

7. By a letter dated April 7, 2008, Respondent asked Petitioner for a 60 day extension to change things. Respondent stated that it was a mistake of the Department of Commerce and Consumer Affairs’ Business Registration Division to allow them to do

business under “Cash4Gold Corporation”. Respondent received an extension to April 30, 2008.

8. By a letter dated May 2, 2008, Petitioner noted that Respondent changed its name to “Cash4Gold Corporation dba Maki Gold” and while the effort was appreciated, the result was not. Petitioner again requested that Respondent delete “Cash4Gold” or any other name similar thereto from its corporate name.

9. By a letter dated May 15, 2008, Petitioner noted that Respondent had not changed its corporate name, and on April 22, 2008, Respondent had filed an application with the U.S. Patent and Trademark Office seeking to register “Cash4Gold” as a trademark.

10. By a letter dated May 19, 2008, Respondent informed Petitioner that they no longer use as a trade name within the State of Hawai'i “Cash4Gold” but that its trade name is “Maki Gold”.

11. “Cash 4 Gold” was registered with the United States Patent and Trademark Office as Reg. No. 3,503,336 as a service mark on September 16, 2008. The first use and in commerce use is listed as February 1, 2007.

12. Respondent believes that he is the owner of “Cash4Gold” because of the federal registration and that is why Respondent began using “Cash4Gold” in Hawaii as a trademark as of December 2008. However, Respondent testified that he is doing business as “Maki Gold”.

### III. CONCLUSIONS OF LAW

Petitioner has requested an order of abatement for the infringement of its trade name “Cash for Gold” pursuant to Hawai'i Revised Statutes (“HRS”) § 482-8.5 which provides:

**§ 482-8.5 Administrative order of abatement for infringement of trade name.** (a) Any individual or sole proprietor with a currently registered trade name in this State claiming that the name of any entity registered or authorized to transact business under the laws of the State is substantially identical to, or confusingly similar to, its trade name may file a petition with the director for an administrative order of abatement to address the infringement of its trade name. The petition shall set forth the facts and authority that support the petitioner's claim that further use of the name should be abated.

In order to prevail, Petitioner must prove by a preponderance of the evidence that “Cash4Gold Corporation dba Maki Gold” is substantially identical to “Cash for Gold” or that there is a likelihood of confusion among consumers as a result of Respondent’s use of “Cash4Gold Corporation dba Maki Gold.” *See*, HRS § 482-21.

Hawai’i Administrative Rules § 16-36-15 provides:

**§ 16-36-15 Registration of trademarks, service marks, prints, and labels; corporation names, partnership names, limited liability company names, and trade names.** (a) A proposed name or mark that is substantially identical to a registered name or mark shall be rejected and not accepted for registration.

. . .

(b) A name or mark is not ‘substantially identical’ if:

(1) A comparison of the name or mark reveals a difference from the names on file with the division, unless the name is likely to be confused upon oral communication. For example, ‘Ice Cream Shop, Inc.’ and ‘Ice Cream Sweet Shop, Inc.’[.]

Upon review of the standards for the registration of trade names and trademarks, the Hearings Officer concludes that “Cash for Gold” and “Cash4Gold Corporation dba Maki Gold” are not substantially identical.

Hawai’i Revised Statutes § 482-21(6) provides:

**§ 482-21 Registrability.** A mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others shall not be registered if it:

. . .

(6) Consists of a mark which so resembles a mark registered in this State or a mark or trade name previously used by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive[.]

The test for determining whether “Cash for Gold” and “Cash4Gold Corporation dba Maki Gold” are confusingly similar is “whether there is a likelihood of confusion in the mind of a reasonably prudent buyer.” *In re Kona’s Something Special*, TN 84-4 (Director’s Final Order August 8, 1984). “A likelihood of confusion exists when consumers would be likely to assume that the source of the products or services is the same as or associated with the source of a different product or service identified by a similar mark.” *Carrington v. Sears Roebuck & Company*, 5 Haw. App. 194, 683 P.2d 1220 (1984).

In *In re Kona’s Something Special*, *supra*, the Director adopted standards for determining the likelihood of confusion, modifying the eight factors set forth in the *Carrington* case to six factors which are: 1) similarity of the names, 2) similarity of businesses, 3) channels of trade, 4) evidence of actual confusion, 5) respondent’s intent in adopting the name, and 6) strength of the name.

Applying the foregoing criteria, the Hearings Officer finds that although the businesses are similar, “Cash for Gold” and “Cash4Gold Corporation dba Maki Gold” are not similar. Petitioner presented some evidence regarding channels of trade, and no evidence regarding actual confusion. As the evidence presented did not establish that Respondent adopted the corporate name with the intent to cause confusion, deceive the public or capitalize on Petitioner’s reputation and good will, the Hearings Officer finds that Respondent did not act with wrongful intent by registering the corporate name “Cash4Gold Corporation dba Maki Gold.”

The strength of the name determines the level of protection that will be provided to the name. Names that are descriptive are not entitled to protection in the absence of a showing of secondary meaning.<sup>1</sup> The Hearings Officer concludes that “Cash for Gold” is descriptive and only entitled to protection if secondary meaning is shown. However, there was no evidence presented to establish that “Cash for Gold” had acquired the requisite secondary meaning.


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<sup>1</sup> Secondary meaning refers to the mental association in the buyer’s mind between the name and a single source of the product. Secondary meaning is acquired when the name and the business become synonymous in the public’s mind.

IV. RECOMMENDED ORDER

For the reasons set forth above, the Hearings Officer recommends that the Director find and conclude that Petitioner has not established by a preponderance of the evidence that Respondent's corporate name "Cash4Gold Corporation dba Maki Gold" is substantially identical to Petitioner's trade name "Cash for Gold" or that there is a likelihood of confusion from Respondent's use of "Cash4Gold Corporation dba Maki Gold." Accordingly, the Hearings Officer recommends that Petitioner's petition for an order of abatement be dismissed.

DATED: Honolulu, Hawaii, MAR 19 2009.

  
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SHERYL LEE A. NAGATA  
Administrative Hearings Officer  
Dept. of Commerce  
and Consumer Affairs