

James L. Bikoff

Partner | Washington, D.C.

James L. Bikoff is a Partner in the Intellectual Property Practice of Smith, Gambrell & Russell, LLP.

James L. Bikoff's practice focuses on formulating and implementing worldwide trademark and copyright protection and enforcement programs for clients in the consumer and industrial product sectors, as well as non-profits, and service providers such as banks and insurance companies. He also engages in Internet and domain name counseling and enforcement actions.

Mr. Bikoff has been active for over 40 years directing worldwide trademark and copyright protection, litigation and anti-counterfeiting enforcement. More recently, Mr. Bikoff has been active in Internet and domain name litigation. His clients have included the International Olympic Committee, the United States Olympic Committee, Major League Soccer, the Federation Internationale de Football Association, the American Red Cross, the National Grange and Tristar Insurance. He was in charge of enforcement for the 1994 World Cup Games, the 1996 Olympic Games in Atlanta, Georgia, and the 1999 and 2003 Women's World Cup Games. Mr. Bikoff also counsels a growing number of wineries and restaurants on trademark and copyright issues.

Mr. Bikoff is chair of the Trademark and Unfair Competition Division of the Intellectual Property Section of the American Bar Association and a member of the European Community Trademark Association (Anticounterfeiting Committee), the International Trademark Association (Data Protection Committee Subcommittee on Legislation), the New York Intellectual Property Law Association (Trademark and Internet Committees), and the Intellectual Property Constituency of ICANN. He has served as co-chair of the Intellectual Property Committee of the D.C. Bar Association. He is also a frequent contributor to several publications, including IP Litigator, International Quarterly, and World Trademark Review.

Mr. Bikoff was lead counsel in a landmark anticybersquatting action for the NCAA involving the first freeze of assets against an offshore



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Areas of Practice

Intellectual Property
Intellectual Property Litigation
Trademark Law
Copyright Law
Internet Law
Customs & International Trade
Cannabis Law

Bar Admissions

District of Columbia
U.S. District Court for the
District of Columbia
U.S. Court of Appeals for the
Federal Circuit
U.S. Court of Appeals for the
Ninth Circuit

Internet gambling website, and was lead counsel in a case involving the largest number of domain names ever joined as defendants: International Olympic Committee, United States Olympic Committee and Salt Lake Organizing Committee for the Olympic Winter Games of 2002 v. 2000Olympic.com, et al., Civ. No. 00-1018-A (E.D.Va. 2000). Mr. Bikoff has also achieved a string of victories in UDRP proceedings on behalf of the American Red Cross, the International Olympic Committee and other clients.

Mr. Bikoff has written and spoken frequently on intellectual property protection and enforcement in the United States and abroad, and has testified before Congress in support of intellectual property legislation. He was actively involved in the enactment of the Trademark Counterfeiting Act of 1984 and the Anticybersquatting Consumer Protection Act (“ACPA”). He is the author and co-author of numerous articles on trademark, copyright and domain name issues. Examples include: “Contributory trade mark infringement liability: a comparison of US and EU law” *Journal of Intellectual Property Law & Practice* (September 28, 2019); “The Evolution and Developments of Contributory Trade Mark Liability in the United States and the European Union”; “ICANN Updates: Access to Domain Name Registrant Data Post-Blacout”; “No Place to Hide - The Effect of a Data Breach on Brand Value” (August , 2019); “Supreme Court Rules that Bankruptcy Does Not Revoke a Trademark License”, *SGR IP Braintrust Blog* (May, 2019; Trademark Enforcement Hampered by Disappearance of Whois Data, *SGR IP Braintrust Newsletter* (Sept 20, 2018); “What’s The Next Play for the Redskins? What Blackhorse Really Means For the Football Team” *World Trademark Review Daily* (June 25, 2014); “Cancellation Action Based On Misrepresentation of Source Does Not Require Use of Mark In U.S. Commerce” *World Trademark Review Daily* (May 1, 2014) (Bayer FLANAX Case); and “The Uniform Rapid Suspension System--A New Weapon in the War Against Cybersquatters” *LANDSLIDE* (January/February 2014).

Mr. Bikoff graduated, cum laude, from the University of Cincinnati in 1962. He received his LLB from Columbia University School of Law in 1965 and obtained an LLM in trade regulation from the New York University School of Law in 1966.

Publications & Presentations

- Victory at the Trademark Trial and Appeal Board: National Grange Succeeds in Opposing NEWGRANGE PRESS Application Based on Prior Trademark Rights
- Internet Expansion: How This Affects Your Company - May 22, 2015
- Author, “Summary of Pending Legislation Affecting Trademarks” New York Patent Law Association, April/May, 2015

- Bikoff, J.L. & Heasley, D.K. & Sherman, V & Stripeland, J. (2015) Fake in 'til we make it: regulating dangerous counterfeit good. Oxford Journals, 10(4), 246-254
- Hail to the Redskins – For Now? Debating the Future of the NFL Team's Brand, World Trademark Review, April 9, 2015
- U.S. Patent and Trademark (PTO) Office Rules and Regulations Change
- Attorney Fees Awards in Lanham Act Cases
- U.S. Patent and Trademark Office Proposes Changes to the Trademark Trial & Appeal Board Rules of Practice
- Infringers Ignore Permanent Injunction Orders at Their Peril
- DOT.Insurance — The New Internet Place for the Global Insurance Community

Memberships

- INTA, Data Protection Committee, member
- Chair, Trademarks & Unfair Competition Division Committee of the American Bar Association Section of Intellectual Property Law (2018-2019)
- Liaison to the ICANN- Intellectual Property Constituency of the American Bar Association Section of Intellectual Property Law
- Former Co-Chair, Trademark Litigation Committee, Intellectual Property Section of the American Bar Association
- Member, European Community Trademark Association (Anticounterfeiting Committee)
- Former Chair, Internet Committee's Domain Dispute and Whois Subcommittee of the International Trademark Association
- Member, International Trademark Association
- Member, Trademark and Internet Committees, New York Intellectual Property Law Association
- Former Co-Chair, Intellectual Property Committee, D.C. Bar Association
- Member, Advisory Board, IP Litigator
- Member, Advisory Board, International Quarterly
- Member, Advisory Board, The University of Baltimore Intellectual Property Law Journal
- Member, Advisory Board, World eBusiness Law Report
- Member, Advisory Board, Law360, Intellectual Property Editorial Board