



James L. Bikoff

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Areas of Practice

Intellectual Property | Trademark Law | Copyright Law | Internet Law | Intellectual Property Litigation | International Practice | Customs & International Trade | Customs & Border Protection (CBP) Intellectual Property Remedies | Entertainment

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. Mr. Bikoff has also 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 a member of the Council of the Intellectual Property Section of the American Bar Association, Membership Board, a member of the European Community Trademark Association (Anticounterfeiting Committee), the International Trademark Association (Internet Committee), the New York Intellectual Property Law Association (Trademark and

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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 anti-cybersquatting action for the NCAA involving the first freeze of assets against an offshore 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. 2000 Olympic.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 Anti-cybersquatting Consumer Protection Act ("ACPA"). He is the author and co-author of numerous articles on trademark, copyright and domain name issues including "Supporting Liability for Online Marketplaces that Allow Third-Party Seller to Offer Defective and/or Counterfeit Products" SGR Website and *Trust the Leaders* (May 2021); "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); "The Uniform Rapid Suspension System—A New Weapon in the War Against Cybersquatters" *LANDSLIDE* (January/February 2014); "TTAB Cancels Mark For Being Highly Descriptive" *World Trademark Review Daily* (July 30, 2013)(Annapolis Tours Case); "Federal Circuit Provides Trademark Owners Tool To Prevent Repeated Attacks" *World Trademark Review Daily* (Jan. 28, 2013); "Legislation Targets Theft of US Property by Rogue Websites" *World Trademark Review* (Feb/March 2012); "Hauling In the Middleman: Contributory Trademark Infringement in North America" *Oxford University Press, Journal of Intellectual Property Law & Practice* (February 2010); "No Place to Hide: The Effect of a Data Breach on Brand Value" *INTA Bulletin* (2019); "Supreme Court Rules that Bankruptcy Does Not Revoke a Trademark License" SGR Website (2019).

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

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Admissions

District of Columbia

District of Columbia Federal and State Courts

Trademark Trial and Appeal Board

U.S. Court of Appeals for the 9th Circuit

U.S. Court of Appeals for the Federal Circuit

Pro Hac to various Federal District and appellate courts throughout the U.S.

Memberships

- Member, Council of the American Bar Association Section of Intellectual Property Law (2020-2024)
- Member, American Bar Association Section of Intellectual Property Law Membership Board
- Co-chair of New Member Recruitment/Engagement, American Bar Association Section of Intellectual Property Law.
- Chair, Trademarks & Unfair Competition Division Committee of the American Bar Association Section of Intellectual Property Law (2019-2020)
- Member, Data Protection Committee Subcommittee on Legislation (2019-2021)
- Liaison to the ICANN- Intellectual Property Constituency of the American Bar Association Section of Intellectual Property Law
- Council Liaison to American Bar Association IPL Section Trademarks & Unfair Competition Division
- Liaison to Intellectual Property Associations on Trademark issues
- Member, American Bar Association IPL Section Trademark Modernization Act Task Force
- Chair, Trademark Legislation Committee, Intellectual Property Section of the American Bar Association (2017)
- Chair, Trademark Litigation Committee, Intellectual Property Section of the American Bar Association (2018)
- Member, European Community Trademark Association (Anticounterfeiting Committee) (Since 1990)
- Chair, Internet Committee Subcommittee on Whois and Privacy Issues of the International Trademark Association (2017-2018)
- Member, Trademark and Internet Committees, New York Intellectual Property Law Association
- Member, Fellows of the American Bar Foundation
- Former Co-Chair, Intellectual Property Committee, DC 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, Internet Committee, International Trademark Association (INTA) (2022-2023)