



ERIK W. KAHN

Partner

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BIOGRAPHY

Erik Kahn has broad experience in complex technology deals and intellectual property protection, transactions, and litigation. He represents clients in diverse industries, including software and computer-related technologies, consulting, telecommunications and telephony, financial services, Internet, retail, consumer brands, healthcare, security, aviation, entertainment, publishing, and fashion.

Erik advises clients on all aspects of technology development, acquisition, licensing and transfer; global brand protection strategies and enforcement programs; content and brand licensing; intellectual property in corporate transactions; intellectual property audits; celebrity endorsements; and evaluation and vetting of entertainment properties. He litigates cases involving trademark and trade dress infringement, domain name disputes, copyright infringement, intellectual property licensing, and defamation.

Erik has been recommended by The World Trademark Review in New York since 2018, commenting that: “Erik Kahn knows how to smooth out multi-layered technology transactions to fully exploit the value of IP assets; he is also a dab hand at sophisticated litigation.” They also noted, “Erik Kahn, Bryan Cave’s Global IP Chief, is an incredibly smart attorney who is always three steps ahead of potential obstacles; his strategic advice ensures protection of portfolios in the long term.” Additionally, Erik is listed in the Best Lawyers in America and New York Super Lawyers.

Erik previously served on the firm’s executive committee and was the leader of the firm’s global Intellectual Property practice group.

Representative clients include: AgerPoint, AIP Publishing, Belstar Group, CiDRA Holdings, ERA Helicopters, Everyday Health, MagicJack Vocaltec, New York City Police Department, New York eHealth Collaborative, New York Presbyterian Hospital, Public Health Solutions, MSA Security, Seacor Holdings, Avaya Holdings, Verint Systems, and Wireless Telecom Group.

CIVIC INVOLVEMENT & HONORS

- IP Stars – New York, Managing Intellectual Property Magazine, 2014-2023
- *WTR 1000: The World’s Leading Trademark Professionals*, 2016-2024
- New York Super Lawyers, 2007-2023
- Public Health Solutions – Board of Directors
- Partnership for New York City – Corporate Partner
- NYC Leadership Academy – Board of Directors
- Pilobolus Dance Theater – Board of Directors
- The Best Lawyers in America, 2018-2021
- David Rockefeller Fellowship, 2007-2008

PROFESSIONAL AFFILIATIONS

- American Bar Association – Sections on Intellectual Property and Litigation
- International Trademark Association
- Copyright Society of the USA

ADMISSIONS

- New York, 1993
- United States Supreme Court
United States Courts of Appeals for the Second and Ninth Circuits
United States District Courts for the Eastern and Southern Districts of New York

EDUCATION

Benjamin N. Cardozo School of Law, J.D., 1992

Hobart and William Smith Colleges, B.A., with Honors, 1987

RELATED PRACTICE AREAS

- Intellectual Property and Technology
- Entertainment & Media
- Commercial Contracts
- Media & First Amendment
- Litigation & Dispute Resolution
- AdTech
- PropTech
- BCLP Data Breach Hotline
- Regulation, Compliance & Advisory
- Corporate
- Trademarks: Litigation
- Business Speech
- Trademarks: Counseling, Prosecution & Practical Business Services
- Copyrights
- Trade Secrets

EXPERIENCE

Recent IP Licensing, Technology Transactions and IP Asset Monetization Experience

Advise board of a technology company in connection with devising strategies for licensing company's industry transformative intellectual property assets; and conduct intellectual property portfolio audit and provide strategic portfolio advice.

Represent largest police department in US in first-of-its-kind transaction involving a municipality licensing proprietary counter-terrorism technologies to law enforcement agencies throughout the world.

Provide strategic intellectual property advice to public telecom company, including the evaluation and negotiation of LTE assets as part of client's acquisition of a strategic partner.

Represent one of the largest institutional alternative asset managers in acquisition of intellectual property and other assets throughout the United States.

Structured the acquisition of digital video distribution company for a leading video game retailer.

Provide strategic intellectual property advice to global hotel company in a \$1.9 billion dollar sale of a hotel chain.

Represent largest government consulting firm in US in \$80 million dollar intellectual property development deal with City of New York.

Represent publishing company in negotiation of all of its worldwide publishing, electronic storage and distribution agreements.

Represent agribusiness technology company in protecting and monetizing its intellectual property.

Advise and negotiate deal for internationally known artist arising from dispute over film rights.

Represent leading law firm in intellectual property protection including advice regarding proprietary technology system developed by client's in-house technology team.

Recent Patent and Trademark Litigation and Enforcement Experience

Represent hotel chain in intellectual property licensing dispute with a consortium of restaurant brands.

Represent accounting firm in defamation proceeding against television broadcast station in the United States, resulting in a successful settlement.

Represent technology company in patent litigation against a Fortune 50 competitor in case involving the defendant's core technology.

Represent technology company in breach of restrictive covenant litigation against former key employee.

Represent golf and lifestyle company in long-running dispute over intellectual property rights in China (strategic advice resulted in successful outcome for client).

Represent aviation company in trademark litigation, resulting in successful settlement for client.

Advise largest hospital in New York City regarding intellectual property enforcement matters.

Enforce intellectual property rights for retail companies with brands valued at over \$1 billion dollars, including litigation in federal courts throughout the United States (including New York, Texas, Florida, Delaware, California, and Massachusetts); and prosecute over 200 opposition proceedings in the United States and jurisdictions throughout the world.

RESOURCES

PUBLICATIONS

Books:

- "Recent Decisions in IP Law: An Analysis of Trends and Strategic Considerations," in *Litigation Strategies for Intellectual Property Cases* (Thomson-Reuters/Aspatore, 2011 ed.), co-authored with Joseph Richetti
- "Trademark License Agreements Line By Line: A Detailed Look At Trademark License Agreements And How To Change Them To Meet Your Needs," Thomson-Reuters/Aspatore, 2009

Other Recent Publications:

- "Delebs' and Postmortem Right of Publicity," *Landslide*, co-authored with Pou-I "Bonnie" Lee (January/February 2016)
- "The Importance of Family - An Analysis of the Family of Marks Doctrine," *Intellectual Property Today*, co-authored with Pou-I "Bonnie" Lee (May 2012)
- "Nontraditional Trademarks: The Flavor of the Month," *The Intellectual Property Strategist*, Vol. 13, No. 3, Dec. 2006, co-authored with Patricia Werner

RELATED INSIGHTS

News

Apr 01, 2024

BCLP Recognized as a Leading Trademark Group by World Trademark Review

Events

Jul 14, 2023

Partners present on ChatGPT and future AI legislation

News

Jun 14, 2023

Cross-firm BCLP team advises Wireless Telecom Group in merger with Maury Microwave

News

Jun 08, 2023

Partner quoted in 'Wall Street Journal' on risk of right of publicity violations and defamation by AI powered celebrity chatbots

Awards

Feb 18, 2021

World Trademark Review – WTR 1000

Awards

Aug 20, 2020

The Best Lawyers in America© 2021

Awards

Aug 15, 2019

The Best Lawyers in America© 2020

Awards

Aug 15, 2018

The Best Lawyers in America© 2019