



HSM IP Patent Client Guide

BRITISH VIRGIN ISLANDS

Registration

A patent can be registered in the British Virgin Islands (BVI) pursuant to the *Registration of United Kingdom Patents Act (Cap. 156)* which provides for applications to extend rights under a UK registration or a European patent (EP (UK)) registration within three years from the date of registration in the UK.

Whilst the *Patents Act* also provides for local patent applications the statute is not currently operative due to the lack of a local examiner.

For a UK or EP (UK) based application the following information and documentation is required:

1. certified copy of the UK or EP (UK) Certificate
2. Declaration of owner (notarised)
3. Authorisation of Agent (two witnesses) (notarised)

It usually takes about four months for the Registrar to process an application for registration. Paris Convention priority cannot be claimed. Once the registration is complete the Registrar will issue a Certificate of Registration.

Patent Cooperation Treaty

The BVI are not a signatory to the Patent Cooperation Treaty (PCT). National phase filing of a PCT patent is not possible.

Searches

It is generally not necessary to conduct a search in the BVI to ascertain that there will be no difficulty with the application for registration as the application will be based on a pre-existing UK or EP (UK) registration. If, however, a search is required, the result can usually be provided within five working days.

Annuity Payments

Once a patent has been registered in the BVI there is an annuity payable to the BVI Government each year.

UK or EP (UK) based patent annuities are payable from the anniversary of the fourth year of filing in the UK. A certified copy of the UK or EP (UK) Certificate must be submitted to the Registrar each year from the fourth to nineteenth year with the fee. Once the annuity has been paid the Registrar will issue a Certificate of Renewal.

Expiry

A UK or EP (UK) based patent registration is valid for the same period as specified on the underlying UK or EP (UK) registration on which it is based.

Abandonment

Please inform us as soon as possible if you wish to abandon your patent or allow it to lapse so that we can update our records and advise the Registrar accordingly. This will avoid us sending out unnecessary Reminder Notices.

Assignment

Please inform us as soon as possible if the patent has been assigned so that we can file an application to record the assignment in the BVI (and the UK if necessary).

To record the assignment of a UK or EP (UK) based patent registration the only documentation required is a certified copy of the UK or EP (UK) Certificate showing the assignment,

It usually takes six months or less for the Registrar to process an application to record an assignment. Once the recording is complete the Registrar will issue a Certificate of Registration of Subsequent Proprietor.

Change of Particulars

Please inform us as soon as possible if there is any change to the registration so that we can file an application to record the change in the BVI (and the UK if necessary).

To record a change of name and/or address for a UK or EP (UK) based patent registration the only documentation required is a certified copy of the UK or EP (UK) Certificate showing the change.

It usually takes six months or less for the Registrar to process an application to record a Change of Particulars. Once the recording is complete the Registrar will issue a Certificate of Recording showing the change.

Our Firm

HSM IP Ltd. provides worldwide intellectual property services. Based in the Cayman Islands and independently owned and operated, our experienced team of attorneys and paralegals deliver first class service to a broad client base which includes major Fortune Global 500 brand owners, international law firms and other specialist IP practices. Our broad perspective, practical approach and international experience allow us to offer clients a unique insight into IP issues.

The success and growth of our firm is due to our keen understanding of our clients' needs for a comprehensive "one-stop shop" which encompasses a wide range of services from the initial consultation process to searches, registrations, annuity payments and monitoring and renewals. Our interactive database helps us to proactively manage each client's portfolio efficiently and cost-effectively in an environmentally friendly and substantially paperless workplace. It also allows us to fulfil our clients' specific reporting and invoicing requirements, including multi-currency invoicing and e-billing. We offer a competitive schedule of fixed fees, inclusive of both disbursements and official fees, which means we can provide clients with an accurate estimate of their project costs before embarking on a global filing programme for their portfolio.

As a leader in the field, HSM IP understands the value of long-term business relationships. We have a wealth of knowledge and specialise in the Caribbean, Central and Latin America and other offshore jurisdictions. Our staff regularly contribute to leading IP publications and we also publish a range of country-specific IP Client Guides which are available on our website.

Supported by HSM Chambers, an offshore law firm with experienced attorneys admitted in multiple jurisdictions, we have substantial experience in taking action to address the infringement of trade marks and patents and in the conduct of passing-off actions. We are also able to offer investigative services to identify the source of, and distributors of, infringing goods, working closely with police and customs officials as necessary.

Memberships: INTA, ASIPI, CITMA, MARQUES and IPCA.

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HSM IP Ltd. is a Law Firm recognised under the Legal Practitioners (Incorporated Practice) Regulations, 2006 (as amended).

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