

Catherine Zheng

Partner | Intellectual Property | Hong Kong

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Catherine is the Co-Head of Deacons' Intellectual Property Department.

A native Chinese speaker from Shanghai, Catherine studied law at Fudan University. She also holds an LLB degree from Osgoode Hall Law School, York University in Canada and a Bachelor of Science degree (Hons) in chemistry from Dalhousie University, Canada. She is qualified in Canada and Hong Kong and is also a member of the New York Bar.

Catherine specialises in China intellectual property protection strategy and contentious matters. Catherine's extensive experience covers all aspects of China IP ranging from IP litigation and enforcement, to IP portfolio management, trade mark, copyright and domain name protection, to trade secret protection, data privacy and cybersecurity, and IP-related commercial transactions, including IP exploitation, technology transfer, joint ventures and complex M&A. For the past 20 years, she has successfully represented a large number of local and international companies in litigation at all levels of the Chinese courts, and actions before the different levels of administrative bodies. Catherine advises on complex patent litigation matters, with a particular focus on patent validity and infringement issues, and has won high profile patent litigation cases in the Higher People's Court of Guangdong Province and the Supreme Court of China.

Catherine has acted on numerous complex commercial transactions including one of China's largest outbound technology transfer deals. With her chemistry background, Catherine has also advised many pharmaceutical and biotech clients on IP protection, enforcement and commercialisation in China, and is well-versed in the protection of plant variety rights, a fast-developing and strategically important area.

Catherine is a regular speaker on China IP issues and is a Committee Member of The International Trademark Association (INTA) and co-chair of the Designs Committee of the Asian Patent Attorneys Association (APAA).

She has received numerous awards and accolades and has been recognised by Chambers Asia Pacific as a Leading IP Individual in China (2016 – 2021), by Legal 500 as a Recommended Lawyer for Intellectual Property in China (2019 – 2021) and as a Highly Recommended Individual in Patent Litigation (2020) by IAM Patent 1000.

Highlights

- Advised a world leader in high performance sports optics on a complex Chinese trade mark enforcement programme including Customs administrative actions and handling online complaints.
- Acted for a German multinational lighting manufacturer on trade mark infringement matters and domain name disputes in Mainland China.
- Advised a world leading US-based agribusiness on Mainland China IP strategy, protection and commercialisation of plant variety rights (PVRs), as well as enforcement and litigation matters arising from PVR.
- Advised a global nanotech company on patent infringement and trade secret actions in Mainland China, including conducting investigations and collecting evidence relating to actions before local Intellectual Property Offices, court proceedings, and defending invalidations before the Patent Re-examination Board.
- Advised the subsidiary of a Chinese state-owned investment company on the US \$1.8 billion acquisition of the power amplifier business of a world leading producer of semiconductor products.
- Advised an Italian fashion company in connection with a merger and conducted due diligence exercise on relevant intellectual property rights.
- Advised a UK nanotechnology company with patent infringement court action and administrative actions, investigations and collection of evidence of infringement in preparation



Principal Areas

- Data Protection and Privacy
- Intellectual Property
 - Copyright
 - Designs
 - Enforcement and Litigation
 - IP Commercial Advisory
 - Patents
 - Trade Secrets and Confidential Information

Sectors

- Education
- FinTech
- Life Sciences and Healthcare
- Technology, Media and Telecom

Languages

- English
- Cantonese
- Mandarin
- Shanghaiese

Jurisdictions

- Hong Kong
- Canada
- New York (USA)

for a patent infringement and trade secret action against the infringers in China.

- Acted for a well-known UK automotive company in a landmark design invalidation action in China involving the determination of general consumers and design freedom, evaluation of the overall impression for innovative design features and common design features, the significance of the side view and front view of a car design, and the non-obviousness requirement of a patentable design.

More about Catherine Zheng

Accolades

- **Chambers**
 - Leading Individual, IP, China (incl Hong Kong) (International Firm) (2016–2023)
- **Legal 500**
 - Recommended Lawyer, IP, China (Foreign Firm) (2019–2023)
- **Managing IP**
 - World's Top 250 Women in IP (2016–2018, 2020–2021, 2023)
 - Patent Star, Hong Kong (2020–2023)
 - Trade Mark Star, Hong Kong (2020–2023)
 - Patent Star, China (2016–2019)
 - Trade Mark Star, China (2016–2019)
- **World Trademark Review 1000 (WTR 1000)**
 - Leading Individual, Prosecution and Strategy, Hong Kong (2016–2023)
 - Leading Individual, Enforcement and Litigation, Hong Kong (2019–2023)
 - Leading Individual, Transactions, Hong Kong (2019–2023)
- **IAM Patent 1000**
 - Gold Tier Individual, Patent Litigation, Hong Kong (2017–2023)
 - Gold Tier Individual, Patent Transactions, Hong Kong (2022–2023)
 - Silver Tier Individual, Patent Transactions, Hong Kong (2016–2021)
- **Who's Who Legal**
 - Thought Leader, Patent, Mainland China & Hong Kong SAR (2021–2023)
 - Global Leader, Patent (2021–2022)
 - National Leader, Patent, Mainland China & Hong Kong SAR (2022)
 - Leading Patents Lawyer, Hong Kong (2016–2020)
- **Asia IP**
 - IP Expert (2023)
- **Doyle's Guide**
 - Recommended Leading Lawyer, IP (2020)
- **Euromoney Legal Media Group's Expert Guides**
 - Leading Lawyer, Trade Mark, Hong Kong (2016–2022)
 - Leading Lawyer, Patents, Hong Kong (2017–2021)
 - Leading Women in Business Law, Hong Kong (2018)

Appointments/Memberships

- Co-chairperson of the Designs Committee, Asian Patent Attorneys Association (APAA) Hong Kong (2018 – 2021)
- Committee Member, The International Trademark Association (INTA)
- Committee Member, Asian Patent Attorneys Association (APAA) Hong Kong
- Ordinary Member, The Hong Kong Institute of Trade Mark Practitioners Limited
- Member, The American Intellectual Property Law Association (AIPLA)
- Member, The Pharmaceutical Trade Marks Group (PTMG)
- Member, The European Communities Trade Mark Association (ECTA)
- Member, The Law Society of Hong Kong
- Member, The Law Society of Upper Canada
- Member, The New York Bar
- Member, The Canadian Bar Association

Education

- LLB, Osgoode Hall Law School, York University, Canada, 1998
- BSc (Hons in Chemistry), Dalhousie University, Canada, 1995
- Law School of Fudan University, China, 1991

Publications

- “OEM after PRETUL – Beijing IP Court finds that OEM constitutes use in non-use cancellation proceedings”, *Expert Guides* (Aug 2016)
- Interviewed and shared views on “Beijing Higher People’s Court, Guidelines for the Hearing of Network-Related Intellectual Property Cases” by *China Law & Practice* (Jun 2016)
- “The Beijing IP Court – Review of the First Year”, *Bloomberg BNA World Intellectual Property Report* (Jun 2016)

Recent Activities

Catherine is a regular speaker on PRC IP issues and, in particular, has been actively involved in giving seminars to Mainland companies on expanding their businesses internationally and to foreign companies on China IP issues. She has also visited many major Chinese cities to speak at seminars organised by various Hong Kong and Chinese trade commissions to promote cross-border business opportunities and economic co-operation under CEPA.