

How to register your Patent in Mexico



1. Patents in Mexico

Patents are exclusive rights granted over inventions, i.e. technical solutions to problems, which could consist in a product, process or use, as far as they are considered:

New, and thus not included in the state of the art. The state of the art comprises everything that has been made available to the public by written or oral description, by use or marketing or by any other mean, prior to the filing date of the Patent application or, where appropriate, the recognised priority date.

Inventive: if, for an expert with average skills in the technical field concerned, the said invention is neither obvious nor obviously derived from the state of the art.

Industrially applicable: when its subject matter can be produced or used in any type of industry. In this context, industry includes all productive activity, including services.

The Mexican Institute of Industrial Property (IMPI) is the Mexican IP Office in charge of applications and registrations of inventions, Industrial Designs and Utility Models (a kind of petty Patents whose inventiveness is not examined). Some IMPI's 2016 figures:

- *Patent applications filed in 2016*: 17,413.
- *Top 3 Applicants by country*: United States (8,262), Mexico (1,310) and Germany (1,153).
- *Top EU applicants by country*: Germany (1,153), France (594), United Kingdom (319), Italy (301) and Spain (204).
- *Patents granted*: 8,657.
- *Top three technology areas for granted applications*: Consumer goods (3,003), Industrial Techniques (1,698) and Chemistry & Metallurgy (1,231).

Should you be considering consider protecting your invention in Mexico, you might be interested in this Factsheet. If you need further information, we invite you to use our Helpline service that is free, fast and confidential.

THE COMBINED USE OF DIFFERENT IPRs

The most relevant texts when dealing with Patent applications in Mexico are:

- Industrial Property Law (IPL): Regulates Industrial Property in Mexico. Title II of the IPL regulates Patents, Utility Models and Industrial Designs.
- Regulations of the Industrial Property Law: which implement the IPL.
- Agreement for Filing Patent Applications Before the IMPI: Guidelines for the correct drafting and submission of a Patent application.

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2. Patent application in Mexico

Whenever you are considering protecting an invention in Mexico, it is important to bear in mind that beside Patents, there is also the option of filing an application for a figure called Utility Model. In accordance with Mexican law, the following can be registered as Utility Model: items, tools, utensils or appliances when, as a result of a modification of the structure, configuration or the way in which they are arranged, they acquire a different function or present an advantage regarding their use.

Utility models differ from Patents mainly in two aspects. First, the requirement of inventive step (non-obviousness) is not required when examining a utility model application; second, the term of protection, provided by law, for Utility Models is of 10 years.

As for the application process, it is similar for both of them, although with some slight differences with regard to publication of the application and the observations of third parties (see table below).

The applicant may turn its patent application into a Utility Model or Industrial Design one and vice versa, when the content of the application is not consistent with the title of protection applied for. The applicant may make such a conversion only within three months from the filing date or within the three following months from IM-PI's request to make such a conversion, unless the application has been abandoned. If the applicant does not convert the application within schedule, the application shall be considered abandoned.

The following table depicts the main differences and similarities between Patents and Utility Models:

	PATENTS	UTILITY MODELS
Protection	Right granted by the State	Right granted by the State
Requirements	Novelty	Novelty
	Inventive Step (Non-Obvious)	N/A
	Industrial application	Industrial application
Subject matter	Compositions, compounds, substances Apparatus, mechanisms, machines, tools, instruments, devices Procedures, methods	Objects, utensils, apparatus, tools, mechanisms, machines, instruments, artifacts
Grace Period	12 months	12 months
Application	An application is required before IMPI	An application is required before IMPI
PCT Application National Phase	30 months	30 months
Publication	Required	N/A
Third parties observation period	6-month period after publication	N/A
Specification	Title Field of the invention Background of the invention Object of the invention Brief description of the invention Figures Detailed description of the invention Examples Claims Summary of the invention	Title Field of the invention Background of the invention Object of the invention Brief description of the invention Figures Detailed description of the invention Examples Claims Summary of the invention
Validation	20 years	10 years
Approximate duration of the process	3 - 5 years	1.5 years
Cost	Higher than a Utility Model application prosecution	Less than a Patent application prosecution

A. What can I patent in Mexico?

In common with Europe, the Mexican IPL contemplates a series of exceptions to patentability:

- essentially biological processes to obtain, reproduce and propagate plants and animals;
- biological and genetic material as found in nature;
- animal breeds;
- the human body and the living matter constituting it; and
- plant varieties.

In addition, there are some areas of knowledge that cannot be considered inventions, and consequently cannot be protected as Patents.

- theoretical or scientific principles;
- discoveries that consist in revealing something that already existed in nature, even though it was previously unknown to man;
- diagrams, plans, rules and methods for carrying out mental processes, playing games or doing business, and mathematical methods;
- computer programs (see below);
- methods of presenting information; and
- aesthetic creations, artistic or literary works.
- methods of surgical, therapeutic or diagnostic treatment applicable to the human body and to animals;
- juxtaposition of known inventions or mixtures of known products, or alteration of the use, form, dimensions or materials thereof, except where in reality they are so combined or merged that they cannot function separately, or where their characteristic qualities or functions have been so modified as to produce an industrial result or use not obvious to a person skilled in the art.

Patentability criteria regarding software is currently evolving to a more receptive view: a case-by-case analysis is recommended before drafting, filing or even discarding applying for a Patent in Mexico. Generally speaking, software patentability relies on the ability to demonstrate that the software truly solves a technical problem. In addition, the inclusion of a physical support (i.e. hardware) within the invention or the application of the software within a patentable process will definitively help to obtain Patent protection in Mexico. For instance, a food delivery system from your smartphone might not be patentable; however, a system and a method to identify and count the number of white cells within the bloodstream implemented by means of software might have more chances of being considered patentable subject matter.

Mexican criteria differ from European's when it comes to the acceptance of software related claims. Software claims must be justified as a method to solve a technical problem, and words like software, computer, code, pseudo-code or any other word related to software must be avoided. Examiners in Mexico will give more priority to how the parts of the system (hardware) interact between them according to a method (in this case, the software) to deliver a particular result.

SECOND MEDICAL USE PATENTS

Contrary to other countries in the region, Mexico protects Patents over second medical uses of already known substances. The strategies that have shown to be successful in protecting such inventions are:

- a) A claim drafted to protect a product limited by the medical purpose of the same, defined as 'the composition, formulation, product or active substance FOR ITS USE in the treatment of' a particular disease.
- b) A claim drafted as a Swiss-type in which THE USE of the composition, formulation or active substances is useful for the preparation of a medication for the treatment of a disease.

Should you have additional queries on second use Patents, please contact our free, fast and confidential [Helpline](#).

B. Using International Treaties to apply for a Patent

Mexico is member of the [Paris Convention](#) and the [Patent Cooperation Treaty](#) (PCT). Both international treaties imply certain advantages for your application. Thanks to the Paris Convention, EU applicants will benefit from a 12-months priority period. This consists in the right to file subsequent applications for the same invention at other National IP Offices while maintaining the date of the first application, as priority date -which will be taken into account at the effects of evaluating the novelty and inventiveness of the application-.

Besides directly filing a Patent with the IMPI, EU SMEs could also opt to extend their international patent application via PCT; apart from extending the priority period to 30 months, PCT simplifies the proceedings and management of the application. If you want to know more about PCT, visit [WIPO PCT website](#) or contact our free and confidential [Helpline](#) in English, Spanish, Portuguese, German or French.

C. How much does it cost?

APPLICATION	IMPI FEES (€)	IMPI FEES (€)
Filing application via Paris convention	€ 366,00	€ 105,00
Filing application via PCT chapter I	€ 298,00	€ 105,00
Filing application PCT chapter II	€ 184,00	€ 67,00
Claiming priority rights (Per each)	€ 48,00	€ 48,00
PROCEEDINGS		
Answering an official requirement (Formality examination)	€ 16,00	€ 16,00
Answering an official requirement (Substantive examination)	€ 31,00	€ 31,00
Answering an official requirement Filing within the two-month extension of time (per month)	€ 7,00	€ 7,00
Filing a voluntary amendment	€ 16,00	€ 16,00
GRANTING & MAINTENANCE		
Granting fee	€ 150,00	€ 32,00
Submitting the granting fee within the two-month extension of time (per month)	€ 7,00	€ 7,00
Annuities 1- 5 (patents; per each)	€ 56,00	N/A
Annuities 6 - 10 (patents; per each)	€ 66,00	N/A
Annuities 11 - 20 (patents; per each)	€ 74,00	N/A
Annuities 1 – 3 (Utility models; per each)	N/A	€ 53,00

D. Applying for a Patent

A proper submission of a Patent application should be accompanied by the following documents:

- a) **Patent Application:** An official form duly signed and executed which shall include the title of the invention; name, address and nationality of the applicant(s) and inventor(s); a Mexican address to receive official communications from the IMPI; priority information (Paris Convention or PCT); and the number of pages accompanying the application. Signature must be handwritten.
- b) **Specification:** See below.
- c) **Power of Attorney:** A simple Power of Attorney (per applicant).
- d) **Assignment:** This document must be filed in the case that the applicant is a different person than the inventor(s) and the application is being filed either by Paris Convention or if it is a Mexican application (in the case of a PCT application, it already includes the assignment).
- e) **Payment:** Proof of payment of the corresponding fee.
- f) **Apostille or legalization (see Glossary):** Some of the foreign documents must be legalized. If your country of origin is member to the Hague Convention, an apostille will suffice. Please contact our Helpline if you want to know which documents must be legalized in your specific case.

IMPORTANT: All the documents in a language other than Spanish must be accompanied with its proper translation. There is no need for a sworn translation; however, the Mexican examiner is entitled to require an additional translation if the first one is deemed to be poor or non-understandable.

PRIOR ART SEARCH

It is always recommended to perform a prior art search in the relevant technical field of the application before applying for a Patent. Such a search will provide you with details of the state of the art and will be very useful to draft the Patent application. In addition, the search will allow you to identify potentially conflicting Patents. For more detail information, please read our guide on [How to conduct a patent search: the basics](#).

You can access IMPI's Patent database [here](#).

E. Facing a Patent specification

A Mexican Patent specification does not substantially differ from other countries' Patents: do not forget to file it carefully, since the specifications will define the scope of your protection and determine how authorities will enforce it:

Title: Clear and related to subject matter the invention.

Field of the Invention: Short description of the technological field concerned.

Background of the Invention: A brief disclosure of the closest prior art and its limitations, restrictions and/or inconveniences to solve the technical problem that the application solves.

Object of the Invention: Describe in a brief, plain and simple form, the object of the invention, with special reference to its innovative character and/or technical contribution.

Brief Description of the Invention: It should include a general overview of the invention, that will be used by the examiner to understand the technical problem(s) raised in the Background of the Invention and a brief description of the proposed solution(s) described in the Object of the Invention.

Figures: In some cases, the use of figures is needed to provide a better understanding of the invention. If this is the case, a brief description of the figures must be included to ensure a full understanding of the invention.

Detailed Description of the Invention: All the elements (in the case of a system), parts (in the case of a device), steps and stages (in the case of a method or process), features and other important information must be disclosed in detail. Numerical references are often used to link the description to the figures. It should include in that order the following elements: technical area, background information, best method and how it can be produced/used.

Examples: Examples serve to illustrate the technical features of the invention and are often used to describe the best method to reproduce or embody it. Experimental data, tables and formulas can be part of the examples and there is no limitation on the number of examples that can be included in the specification.



Claims: They are the most important part of the specification, since they define the Patent's scope of protection –i.e. only the technical features included in this section will be taken in consideration as the protected subject matter-. According to IMPI's practices, claims are structured in three parts:

- *Preamble:* Indicates the object of the invention and the technical features that are already known in the state of the art (a device, a molecule, an apparatus, etc.). Sometimes, the preamble matches the title of the invention.
- *Expression of transition:* for example 'comprising of', 'including...', 'containing' and 'characterized in...'; followed by the body.
- *Body:* includes all the technical features whose protection is claimed.

Summary of the Invention: A brief overview (between 100 and 200 words) concerning the technical field of the invention and its most important features. Where applicable, you must include the chemical formula. The summary of the invention is published in the Official Gazette.

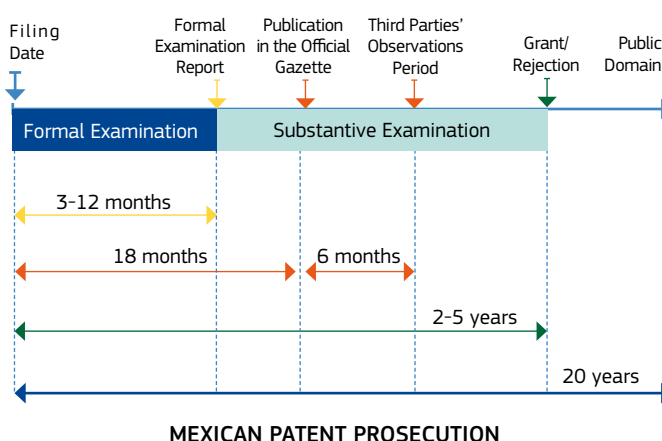
Drawings: Drawings should not contain text other than key words needed to understand them and must be numbered in consecutive order with Arabic numbers.

Sequence listings: If nucleotide/amino acid sequences are included within the application.

Where applicable, certificate of deposit of biological material.

3. Patent proceedings in Mexico

Once you file your Patent application, by online means or in paper, IMPI will start the granting procedure. You should be proactive during this phase and be aware of any incidence related to your application in order to rectify any deficiency and answer any official action raised by the IMPI. Hiring a specialised Patent Attorney will be very helpful to manage this process.



MEXICAN PATENT PROSECUTION

DEALING WITH OFFICIAL ACTIONS

If IMPI raises an Official Action –e.g. grant payment, clarification or amendments- at any stage of the proceedings, you will have a 2-months period to respond to the action. Such period could be extended by two additional months upon payment of extra fees.

Although IMPI is currently migrating to a more “on-line” prosecution system, the process is still on going and at its early stage. Thus, it is important to consider that so far there are two ways for an office action to be duly notified: i) a qualified agent is periodically monitoring office actions directly at IMPI; and ii) IMPI can notified directly the office action to the established and certified address within Mexican territory. This is why, it is important to have a qualified patent attorney to watch over the prosecutions of applications in Mexico.



A. Formal examination

During the formal examination stage, IMPI will assess whether or not your application fulfills all the formal requirements, and if it includes all the documents listed above.

If any one or more of these requirements is not duly satisfied, the IMPI will issue an official action requesting you to make the proper additions, corrections and/or amendments to the submitted documents. Only two office actions could be issued during the formal examination, and failing to comply with the IMPI's formal requirements after the second action will result in the rejection of the application. Therefore, we advise you to be very careful at this stage.

IMPI has 3 months to issue the first Official Action. Formal examination usually takes 3 to 12 months depending on the number of official actions issued.

EXAMPLE 1: Official action raise during formal examination

Patent No.	MX 305210 B
Issue	The application was filed without Power of Attorney. The examiner issued an official action on 2/Jun/2011 requesting the applicant submitting this document; otherwise, the application would be abandoned.
Nationality	French
Actions taken	Applicant filed a response submitting a duly executed Power of Attorney 22/Jul/2011.
Outcome	A Formality Examination Completion Report was issued on 11/Aug/2011. The application was examined in the substantive examination stage and was granted on 13/Nov/2012.
Link	http://vidoc.impi.gob.mx/ViDoc/siga.do?usr=SIGA&texp=SI&tdoc=E&id=MX/a/2011/005035

B. Publication

By law, every Patent application that passes the formal examination is published in the Official Gazette 18 months after its filing date. After publication, the content of the application will become part of the state of the art. Therefore, it will be taken into account to assess the novelty and inventive step of any future Patent application.

C. Third parties' observations

Third parties have a 6-month period after publication to file observations against the Patent application; however, the examiners are neither bound by the content of the observations nor need to respond to their arguments. In other words, examiners are free to decide whether or not they will take the observations into account.

Notwithstanding the above, IMPI will open a 2-months period during which the applicant can file his/her response to the observations.

D. Substantive examination

At this stage, the examiner will perform an analysis to evaluate if a Patent application complies with the novelty, inventive step and industrial applicability requirements (See Section 1), as well as with other requirements, such as the following ones:

Unity of Invention: Article 43 of the Mexican IPL states that a Patent application must claim only one sole invention or a group of inventions linked by one specific technical concept. The IMPI will request the applicant to divide the application if it contains more than one invention or inventive concept. Divisional applications can be filed for each of the remaining technical concepts or inventions, and the filing date for each of these divisional applications will be the same as the originally filed application (the so-called "mother application").

Sufficiency of disclosure: The specification must be complete and clear so that it can be fully understood and reproduced by a person skilled in the art (See Glossary). The examiner can issue an official action, requesting the clarification of some aspects, which cannot extend the scope of the original application.

Claim Support: All the technical features in the claims must be fully supported either in the specification or in the drawings. An examiner can issue an official action requesting the applicant to identify where a specific characteristic from a claim is supported, or otherwise to delete the same.

There is no established period of time within which IMPI has to issue an Official Action; it will depend on the number of applications pending to be examined. However, a maximum of four official actions can be issued during this stage to offer the applicant the opportunity to provide arguments and evidence of the patentability of the application. After the fourth action has been responded, the IMPI will either grant the Patent or reject the application.

GRACE PERIOD

Mexican Legislation provides a 12-months grace period from an early disclosure date to file an application. Early disclosure includes national or international exhibitions, showcases or congresses, disclosures or scientific publications of the invention. Documentation proving this early disclosure has to be filed along with the application; otherwise, own disclosure could be considered as prior art, which may affect the novelty of the invention.



EXAMPLE 2: Substantive Examination

Patent No.	MX 347687 B
Issue	Office action issued on 30/11/2016 informing the applicant that claims 1, 14 and 15 lack of novelty in light of the US application 2009/0043253 A1 found within the state of the art. The examiner requested the applicant to point out the technical differences between the cited document and the present invention.
Nationality	French
Actions taken	The applicant filed a response as requested, pointing out the technical differences between the cited document and the invention. The applicant even made reference in the response to the figures in order to make it easier for the examiner to understand the arguments. The applicant paid one month of time extension in order to file the response on 15/02/2017.
Outcome	Granted on 9/May/2017.
Link	http://vidoc.impi.gob.mx/ViDoc/siga.do?usr=SIGA&texp=SI&tdoc=E&id=MX/a/2015/000625

SPEEDING-UP THE SUBSTANTIVE EXAMINATION

In Mexico, it is possible to speed-up your Patent examination in two ways:

Via article 54 IPL: In order to accelerate examination and granting, an examiner can request the applicant to amend the claims to adapt it to the scope of a Patent that has been granted by another IP office, based in an identical application with the same priority date. This via will only be accepted by IMPI if the criteria of the granting office matches with IMPI's ones. Particularly, IMPI usually accepts the examinations coming from EU and US offices.

Via Patent Prosecution Highway (PPH): PPH are agreements addressed to enhance cooperation between IP offices in Patent examination. Any applicant that has already been granted a Patent by any of the following offices could request its accelerated examination in Mexico in the same terms approved by the foreign office.

The IP Offices that have signed the PPH program with Mexico are: Australia (APO), Alianza del Pacífico (Colombia, Peru, Chile), Portugal (INPI), European Patent Office (EPO), Canada (CIPO), China (SIPO), Spain (OEPM), Japan (JPO), United States of America (USPTO), Korea, and Singapore.



E. Granting and maintenance of the Patent

Once a Patent application has fulfilled the substantive examination stage, the IMPI will issue an official action requiring the applicant to proceed with the payment of the granting fee and the first five-years period maintenance fees. Once that proof of payment has been submitted, the application will be granted. Failing to submit the payment within the 2-months period (extendable by 2 additional months) will result in the rejection of the application.

Remaining annuities must be paid each five years; failing to pay the maintenance fees implies the abandonment of the application and its subsequent expiration. There is a 6-months grace period to submit the annuities payment, and an additional 12-months period to submit a restitution request, which entails the payment of additional fees.

4. Exploitation

In Mexico, the term of a Patent is extended for a period of 20 years starting from the filing date or, if it is the case, the international filing date. You can exploit your invention directly or monetize it by means of transfer or license. In such cases, it is strongly advised to register the assignment of the ownership or the right to use the Patent before the IMPI to ensure that the licensee or assignee is entitled to fully benefit from the transferred rights.

COMPULSORY LICENSE DUE TO LACK OF USE

Make sure that you exploit your Patent by importing, producing and/or commercializing it in Mexico. Otherwise, after three years from the date granting date, or four years from the filing date of the application (whichever the later), any person may apply for a compulsory license on the basis of non-use of the invention, unless there are duly justified reasons for such non-use.



5. Glossary

Apostille: Certification provided under the Hague Convention of 1961 for authenticating documents for use in foreign countries.

Person skilled in the art: an expert with knowledge and experience in the technical field of the invention.

6. Related links & additional information

Mexican Institute of Industrial Property (IMPI):
<http://www.gob.mx/impi>

User's guide to filing a patent and utility model application
https://www.gob.mx/cms/uploads/attachment/file/54264/GDU_Patentes.pdf

IMPI in figures:
<https://www.gob.mx/impi/documentos/instituto-mexicano-de-la-propiedad-industrial-en-cifras-impi-en-cifras>

Mexican Industrial Property Law:
http://www.diputados.gob.mx/LeyesBiblio/pdf/50_010616.pdf

Agreement for Filing Patent Applications Before the IMPI:
http://cinvestav.mx/Portals/0/SiteDocs/Sec_Conocenos/Reglamentacion/1617/003.pdf

Regulations of the Industrial Property Law:
http://www.diputados.gob.mx/LeyesBiblio/regley/Reg_LPI_161216.pdf

Guidelines for Examination in the European Patent Office:
<https://www.epo.org/law-practice/legal-texts/guidelines.html>

Mexican Government Fees:
<http://www.gob.mx/impi/acciones-y-programas/servicios-que-ofrece-el-impi-tarifas>

IMPI User's guides and documents
<http://www.gob.mx/impi/documentos/coleccion-guia-de-usuarios>

Version: August 2017

All the requirements hereby are updated to the Law in force at this date.
Amounts are expressed in Euros and may vary according to the exchange rate and/or ulterior modifications of the regulation in force



LATIN AMERICA IPR SME HELPDESK

www.latinamerica-ipr-helpdesk.eu

MANAGE YOUR INTELLECTUAL PROPERTY IN LATIN AMERICA

ABOUT LATIN AMERICA IPR SME HELPDESK:

The Latin America IPR SME Helpdesk offers free of charge, first-line support on IP and IP rights matters to facilitate the expansion of European SMEs (EU SMEs and SMEs from the Associated countries) already established at, or working with entities in Latin America as well as those potentially interested in establishing commercial and R&D activities and ventures in these countries.

SERVICES

Helpline: Ask our experts any IP related questions in Latin America! We provide professional IP advice – customized, straightforward, and free of charge. Our Experts will answer your question within three working days.

Newsletter: Keep track of the latest news on IP in Latin America relevant to your business.

Multi-lingual Webportal: Browse our multilingual web portal for a broad range of information and training materials on IPR in Latin America in English, Spanish, Portuguese, French and German.

Training: Attend our trainings (online and on-site) and learn more about the key aspects of IPR protection and enforcement issues for doing business in Latin America.

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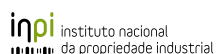
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Project implemented by:



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www.youtube.com/channel/UCXHB4TqVVMudvZHSQ3GJV8A

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