1. The automotive sector in Latin America

Automotive manufacturing is one of Europe’s most relevant industrial activities and involves collateral sectors accounting for millions of jobs, large sums of investments and a significant part of the region exports.

The sector has been affected worldwide by the recent economic crisis. In this regard, PwC’s ‘2016 Auto Industry trends’ report reflects the ‘dampening prospect for global automakers and suppliers’ in 2015. For instance, in 2015, car’s new registrations in Europe amounted to 12.6 million units, while in 2007 they amounted to 18 million units. On the other part of the Atlantic, in Brazil, sales volume went down by 30% in 2015 in comparison with sales in 2012; Chile, on the other hand, has been able to stabilize car sales.

According to some experts, since 2010, Latin America automobile industry is enjoying a prosper period: access to credit, economic stability, and low interest rates have increased consumers’ trust, leading to a boost in automobile sales. Brazil and Mexico are the strongest industries in the Region. Particularly, Brazil has been able to transform an industry focused on manufacturing and adaptations into a truly innovative one, whereas in Mexico companies are expanding their value chain locally to foster competitive advantages in order to expand their production and export capabilities (Source: The Automobile Industry in Latin America: assessment of the conditions for sustainable development).

Oliver Wyman’s South American Auto Manufacturing report also draws some relevant conclusions to be taken into account:

- Brazilian and Argentinean authorities have lured both foreign investors and other industries by creating a variety of incentives.
- As vehicle manufacturers establish operations in increasingly remote locations, they’re counting on their suppliers to provide comparable value to other regions. In South America, for example, 17% of major modules are assembled in supplier parks next to vehicle assembly plants.
- Protection policies in Brazil and Argentina are giving local suppliers further competitive advantage over suppliers located abroad.
- Finally, consumers have played a role in heightening South American OEM’s need for local supply base, as they want modern and high-quality products tailored to their lifestyles.
2. Why is IP important in the automotive sector?

It is undeniable that automotive is an innovative sector. Most companies involved on it devote an important part of their budget to R&D efforts and also to place their brand in the mind of consumers by creating attractive cars or catchy slogans.

Such research and marketing efforts are clearly reflected in the huge amounts that car manufacturers expend in some of the most reputed racing competitions in the world such as Dakar, F1 World Championship, 24h of Le Mans, FIM Road Racing World Championship or the World Rally Championship.

None of them would have spent such amounts if they have not been able to recoup their investments, and that is how Intellectual Property Rights (IPRs) could help companies in the automotive sector.

IPRs are exclusive rights that grant their owner the possibility of excluding third parties from using their inventions, brands, names or designs, among others, subject to certain conditions –namely, their registration-. In addition, registering your IPRs provide you with a wide range of exploitation alternatives such as licensing, selling or franchising them.

Since they are territorial rights, your registration in Europe will not extend the protection of your intangibles to Latin America. Hence, if you are planning to do business in Latin America, you might be interested in learning a bit more about IPRs in the region.

This Factsheet gives you some clues on the most relevant IPRs for the automotive sector: Patent, Designs, Trademarks and Trade Secrets, with a special focus on Brazil, Colombia, Mexico and Chile.

3. What and how to protect

A. Patents

The latest developments in electric and smart cars areas represent a boost in innovation barely comparable to any in the recent history of automotive industry and entail a series of challenges for IP management and protection derived from the need of interoperability. Should you need more information on specific challenges related to interoperability, please read our FS on IP and Internet of the Things (available soon).

Patent protection has been used all along the automotive history, from the very first combustion engines in late XIX century to the latest innovations in electric cars or self-driving, through other innovations during XX century such as windscreen wipers or safety systems like airbags or ABS.

During the period ranging from January 2010 to October 2015, more than 22,000 self-driving related patents -autonomous driving, driver assistance or telemetrics- were applied for. Toyota is the overall global leader in autonomous automotive innovation, followed by Bosch, Denso Hyundai and GM. (Source: The 2016 State of Self-Driving Automotive Innovation).

The automotive sector ranked 3rd in number of Patent applications, just behind computing and telecoms, and moreover shows the worldwide highest increase out of any sector in the period 2009 - 2013 (Source: The State of Innovation in the Automotive Industry 2015) including subsectors like propulsion, navigation, handling, safety & security and entertainment.

Thus, protecting your Patents in Latin America and avoiding infringing third parties’ Patents is key to succeed in the Latin American markets.
FREEDOM-TO-OPERATE

Having your supplies on time is almost mandatory in chain-production based industries. Therefore, in order to avoid the undesirable situation of your supplies being stopped or seized at customs, we strongly recommend you to conduct Freedom-To-Operate (FTO) analysis of your exports to Latin America.

A FTO is an analysis performed by an IP expert who assesses whether or not your products are likely to infringe third parties’ Patents.

Patent requirements

Patent protection is granted to inventions, i.e. technical solutions to problems, including products, processes or uses that fulfill the following requirements:

Novelty: An invention shall be considered new when it is 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 step: An invention shall be regarded as involving an inventive step 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.

Industrial applicability: An invention is deemed 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.

GRACE PERIOD

In contrast to Europe, many Latin American countries establish a 12 months grace period by law. This means that certain disclosures of the invention will not be taken into account when evaluating the novelty and inventiveness of your application. Should you need further information on grace period and its requirements, please contact our free, fast and confidential Helpline.

Apart from those substantive requirements, a Patent application has to meet other formal requirements:

Unity: the set of claims (see Glossary) has to be referred to the same invention. In case that two or more inventions are included in the same application, you will be requested to divide your applications into as many inventions are included within the application.

Clarity and sufficiency: avoid unclear or vague terms that could bring some uncertainty as to what it is the scope of protection pursued. At the same time, the application must include sufficient information in order to allow any third party to implement the claimed invention.

Support in the description: the claims should be based on the Patent description –i.e. the application could not claim protection for inventions not included within the description–; therefore, when planning to file Patent applications in different countries, please ensure that the description is broad enough to comprise the entire invention an also eventual modifications of the claims on each country.

Although, generally speaking, failing to comply with these formal requirements does not automatically render the Patent invalid, it might entail to amend your application or reduce the Patent scope, leading to overcosts and delays in the granting procedure.

Patent life

As a general rule, Patent life extents to twenty years counted from the application date. However, you have to take into account that Patents should be renewed –usually on a yearly basis– through the payment of maintenance fees.

Applying for a Patent

Inventors traditionally file at their National Offices and then subsequently abroad. Extending your protection to Latin American countries could be done by either of these two means:

• File a national Patent application in the countries of interest; or,

• File a Patent Cooperation Treaty (PCT) application. According to the World Intellectual Property Indicators 2016 in 2015, 217,231 PCT applications were filed which represents 1.4% growth on the previous year.
The PCT allows you to apply for registration simultaneously in every member country (more than 145) with a single application.

Benefits:

- **Time:** you would be provided with up to 30/31 months from the application date to decide whether you apply for Patent protection for your inventions in Latin American countries or not without the risk of jeopardizing your Patent’s novelty. In the meantime, you can find partners, financial resources and improve the business structure.

- **Proceedings:** the first part of the proceedings take place before WIPO and the second before each designated National Office, which simplifies the proceedings. By rightly filing your PCT application, you ensure that none of the National Offices will reject your application due to formal deficiencies.

- **Language:** you can apply for your Patent in German, Arab, Korean, Chinese, Spanish, English, French, Japanese and Russian. Depending on the receiving office, you might be requested to provide a translation to the language of receiving office.

Generally speaking, the more countries you aim to be covered by your Patent, the more interesting is filing a Patent, the more countries you aim to be covered by your Patent, the more interesting is filing a Patent, the more countries you aim to be covered by your Patent, the more interesting is filing a Patent, the more countries you aim to be covered by your Patent. Depending on the receiving office, you might be requested to provide a translation to the language of receiving office.

Should you need more information on Patents, take a look at our video IPR as a tool for internationalization: Patents, read our “Country Factsheets” on Argentina, Bolivia, Brazil, Colombia, Costa Rica, Dominican Republic, Ecuador, Mexico, Paraguay, Peru, Uruguay and Venezuela or contact our Helpline.

B. Industrial Designs

In the automotive industry, Industrial Design (or Design) rights are an important tool to protect not only the overall look of a car, but also spare parts (such as alloy wheels, bumpers or the grill of a car). The infringement of Design rights have led in many cases to litigation all over the world being the JEEP grill design infringement or the FERRARI and the HUMMER body design infringement some of the most sounded cases.

**3D PRINTERS: A CHALLENGE**

The availability of 3D printers, that could be used to print car parts and therefore simplifying their copy, makes even more important to rightly protect the external appearance of the key features and parts of your cars and vehicles by means of Designs.

**What is a Design?**

A Design is a right over the appearance of a product -in our case, a car or a part or component of it-, including the shape, patterns and even colours. In the automotive sector, you can protect the design for an automobile, vehicle wheel rims, seats, motor scooters, quads, motor vehicles, bumpers, grilles for automobiles, front combination lamps, dashboard panels, lighting equipment for vehicles or interior fittings, among other products.

**Some Tips on Designs in Latin America**

The term, requirements and their assessment slightly differs from country to country:

- **Novelty:** generally speaking, a Design shall be considered to be new if no identical Design has been made available to the public before the date of filing of the application for registration.  
- **Originality:** (in Brazil) a Design will be considered original when it has a distinctive visual configuration, compared to pre-existing objects.  
- **Industrial applicability:** (in Mexico) the object can be produced or used in any type of industry.
Should you need more information on Designs, take a look to our Factsheets on Designs in Uruguay and Designs in Brazil, read our “Country Factsheets” on Argentina, Bolivia, Colombia, Costa Rica, Dominican Republic, Ecuador, Mexico, Paraguay, Peru, and Venezuela or contact our Helpline.

### Application

None of the Latin American countries are members to the Hague Convention. Therefore, if your company is interested in applying for a Design in any of these countries, you will not be able to extend your international registration to them. In these cases, a separate national IPR registration will be needed.

### Requirements Novelty and originality Novelty Novelty Novelty and industrial applicability

### Substantive examination *

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<tr>
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<th>Brazil</th>
<th>Chile</th>
<th>Colombia</th>
<th>Mexico</th>
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<tr>
<td>Voluntary</td>
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### Maximum duration

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<tr>
<td>25 years</td>
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<td>10 years</td>
<td>10 years</td>
<td>15 years</td>
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### Grace period

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<tr>
<td>180 days</td>
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<td>12 months</td>
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### Length of registration proceedings **

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<th>Brazil</th>
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<tr>
<td>8-12 months (without substantive exam.)</td>
<td>18-24 months</td>
<td>15-20 months</td>
<td>10-18 months</td>
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* Through substantive examination IP offices assess whether or not the application fulfils the substantive requirements –i.e. novelty, originality and/or industrial applicability-.

** Based on practitioners’ experience

### Background

Biliandy, GmbH, a company in the automotive sector, filed and registered an industrial design for car lighter adapters before the European Union Intellectual Property Office (EUIPO) on 31/09/2013. Within the time limit of six month it extended its design to several countries in Latin America, including Brazil, Mexico, Chile and Colombia, among others.

Biliandy, GmbH, found out thanks to one of its distributors in Chile that a company from Peru (which has been in negotiation with the German company to sell these products in Chile) has recently been offering and selling a product in April 2017, which is identical to the registered industrial design.

After gathering the relevant evidence for the case, the EU company started legal actions against the Peruvian Company in Chile. On its counterclaim, the Peruvian company objected that the design was invalid due to a Biliandy’s self-disclosure on 15/04/2013 in Peru.

### Outcome

The Chilean Courts has to rule whether the industrial design was invalid as per the Peruvian disclosure or not before ruling about the infringement. In particular, it held that:

- The registered design was new and the differences between the earlier design and the registered design were enough to exclude the invalidity of the registered design. In addition, since the application in Chile was filed within 12 months from the disclosure, Biliandy could have also benefited from the 12 months grace period.
- As the registered design was valid and still in force, the court ruled that the claimant was entitled to stop the commercialization of the products and awarded damages.

### Lessons learned

Sign non-disclosure and a confidentiality agreements to prevent undue disclosures.

Designs protection, requirements and terms differ from country to country.

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**CASE STUDY**

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**Lessons learned**

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C. Trademarks

When you think of names such as BMW, Ferrari, Peugeot or Fiat, a bunch of ideas, characteristics, attributes or even emotions come to your mind. That is why it is important to protect your brand as a Trademark. This is not only true for vehicles’ manufacturers, but also for car parts (Pininfarina, Sparco or Michelin) and supplies (Castrol or Repsol).

In addition, the name or alias of some of the most iconic models -like Testarossa or Gullwing- also deserve Trademark protection. In recent times, some car manufacturers have used old models’ names and styles to produce new models inspired by them, such as VW Beetle, Mini Cooper or Fiat 500.

What is a Trademark?

A Trademark is a sign that identifies and distinguishes the products or services of one company from those coming from another company. They allow companies to prevent other competitors from using the same or a confusingly similar Trademark.

Trademark protection

A registered Trademark gives the owner an effective tool to prevent third parties from selling counterfeited parts or components in the Latin America countries.

We cannot forget that counterfeited automotive parts usually do not meet the technical specifications and requirements of the manufacturer, and might represent a risk for the health and safety of car users -just think in seat belts, wheels, diagnostic equipment or brake rotors, for example-. Hence, counterfeits are potentially not only harmful at a reputational level.

Once registered, a Trademark grants you 10 years of exclusivity, that can be indefinitely renewed by 10-years periods.

Applying for a Trademark

Before filing the Trademark application, conducting a search is advisable to assess if the sign is available for registration in the country in which the owner seeks protection. If you want to know more about Trademark Searches, you can take a look to our FS How to Conduct a Trademark Search in Brazil and How to conduct a Trademark Search in Chile or contact our fast, free and confidential Helpline.

SCOPE OF PROTECTION: CLASS 12

Although you can protect your Trademark for all types of products and services included within Nice Classification, each additional class entails an extra fee.

Class 12 of the Nice Classification is the most relevant one for the automotive sector, since it comprises vehicles, apparatus for locomotion by land, air or water as well as motors and engines for land vehicles, couplings and transmission components for land vehicles and air cushion vehicles. Other products, like air pumps, anti-glare devices for vehicles, anti-theft devices, automobile hoods, chains, chassis, windows, covers, wheels and tires are also covered by this class.

In Latin America, only Mexico, Colombia and Cuba are members to the Madrid System – the International Trademark System-. In the rest of countries, you will not be able to extend your International Trademark and, consequently, you will have to file your application on a country-by-country basis.

For more information on how to register your Trademark in a given Latin-American country, we strongly suggest you to take a look at our video IPRs as an internationalisation tool: Trademarks, check our “Trademark Registration Guides” in Argentina, Brazil, Chile and Uruguay and our “Country Factsheets” on Bolivia, Colombia, Costa Rica, Dominican Republic, Ecuador, Mexico, Paraguay, Peru and Venezuela.

D. Trade secrets

You could also consider to protect part of your innovative efforts as Trade Secrets, particularly those developments which you aim to Patent until the moment of filing your application, as well as other technical solutions that are difficult to copy through reverse engineering. Clients or providers’ lists or terms and conditions and know-how can also be protected as Trade Secret.

The main advantages of Trade Secrets is that their term is not limited in time, as far as the confidential information is not disclosed. In addition, Trade Secrets do not require registration and are enforceable in any part of the world where it is infringed.

Generally speaking, the requirements for its protection are:

1) The information should always be secret, which means that it should not be generally known or readily accessible to people outside the SMEs.
2) The information must have **commercial value** —or at least potential commercial value— for the SME because of its secrecy. This commercial value could be any economic, financial or commercial cost saving, benefit, or advantage that the secret information provides to the SME over its competitors. Brazil, however, do not require commercial value to protect the information by means of Trade Secret.

3) The information must have been "reasonably protected" by the SME. For example, if the Trade Secret is related to a production process, such process should take place out of non-company personnel’s sight. Likewise, it is highly recommended to sign a Non-Disclosure Agreement (NDA) with any person to whom all or part of the secret information is given (including employees, potential business partners, etc.) as well as taking further organizational and technical measures to restrict access to the information.

In Latin America, Trade Secret protection is governed by Unfair Competition, Tort, or Contract Law. Should you need to deepen in Trade Secrets protection, read our FS in Trade Secrets in Chile, Trade Secrets in Argentina and Trade Secrets in Brazil or contact our experts through our Helpline. They will be pleased support you in Spanish, English, German, French or Portuguese.

4. **Glossary**

**First to file system**: is the system which gives the right to a Patent or a Trademark to the first legal or natural person that files a Trademark or Patent application for protection of a sign or an invention.

**Claim**: Part of a Patent application or specification. Defines the matter for which protection is sought in terms of technical features.

**Non Disclosure Agreement (NDA)**: They are confidentiality agreements where parties commit not to disclose certain information, except under the agreed conditions. They are particularly relevant to protect trade secrets and patent and design's novelty and inventive step.

5. Related links & additional information

Find out more about Intellectual Property Rights in Latin America, visit the Latin America IPR SME Helpdesk website: [www.latinamerica-ipr-helpdesk.eu](http://www.latinamerica-ipr-helpdesk.eu)

**Links of interest**


**Factsheets**

Trade Secret in Brazil: [http://www.latinamerica-ipr-helpdesk.eu/content/trade-secrets-brazil-0](http://www.latinamerica-ipr-helpdesk.eu/content/trade-secrets-brazil-0)

Trade Secret in Argentina: [http://www.latinamerica-ipr-helpdesk.eu/content/trade-secrets-argentina](http://www.latinamerica-ipr-helpdesk.eu/content/trade-secrets-argentina)

Trade Secret in Chile: [http://www.latinamerica-ipr-helpdesk.eu/content/trade-secrets-chile](http://www.latinamerica-ipr-helpdesk.eu/content/trade-secrets-chile)

**IP Country Factsheet**

Argentina: [http://www.latinamerica-ipr-helpdesk.eu/content/argentina-ip-country-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/argentina-ip-country-factsheet)

Bolivia: [http://www.latinamerica-ipr-helpdesk.eu/content/bolivia-ip-country-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/bolivia-ip-country-factsheet)

Brazil: [http://www.latinamerica-ipr-helpdesk.eu/content/brazil-ip-country-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/brazil-ip-country-factsheet)

Colombia: [http://www.latinamerica-ipr-helpdesk.eu/content/colombia-ip-country-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/colombia-ip-country-factsheet)

Costa Rica: [http://www.latinamerica-ipr-helpdesk.eu/content/costa-rica-ip-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/costa-rica-ip-factsheet)

Dominican Republic: [http://www.latinamerica-ipr-helpdesk.eu/content/dominican-republic-ip-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/dominican-republic-ip-factsheet)

Ecuador: [http://www.latinamerica-ipr-helpdesk.eu/content/ecuador-ip-country-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/ecuador-ip-country-factsheet)

Mexico: [http://www.latinamerica-ipr-helpdesk.eu/content/mexico-ip-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/mexico-ip-factsheet)

Paraguay: [http://www.latinamerica-ipr-helpdesk.eu/content/paraguay-ip-country-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/paraguay-ip-country-factsheet)

Uruguay: [http://www.latinamerica-ipr-helpdesk.eu/content/uruguay-ip-country-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/uruguay-ip-country-factsheet)

Peru: [http://www.latinamerica-ipr-helpdesk.eu/content/peru-ip-country-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/peru-ip-country-factsheet)

Venezuela: [http://www.latinamerica-ipr-helpdesk.eu/content/venezuela-ip-country-factsheet](http://www.latinamerica-ipr-helpdesk.eu/content/venezuela-ip-country-factsheet)
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 IP 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.

For more information please contact the Helpdesk:
info@latinamerica-ipr-helpdesk.eu
helpline@latinamerica-ipr-helpdesk.eu

SPAIN
ADDRESS: University of Alicante, Campus San Vicente del Raspeig, Edificio Torre de Control, 03690 Alicante, Spain
TEL: +34 96 590 9684
E-MAIL: head_office@latinamerica-ipr-helpdesk.eu
WORKING HOUR: Monday - Friday 9:00 -16:30 (CEST)

BRAZIL
ADDRESS: Rua Marquês de Olinda, 70 – Botafogo, Rio de Janeiro, CEP 22251-040
TEL: +55 21 2237-8728
E-MAIL: brazil@latinamerica-ipr-helpdesk.eu
WORKING HOUR: 9h00 - 18h00 (GMT-3)

MEXICO
ADDRESS (1): c/del Puente 222 Ejidos de Huipulco, Tlalpan 14380, Ciudad de México, Distrito Federal
TEL: +52 (55) 5483-2252
E-MAIL: mexico@latinamerica-ipr-helpdesk.eu
WORKING HOUR: 9h30-18h30 (GMT-5)

ADDRESS (2): Avenida Eugenio Garza Laguera & Rufino Tamayo, Valle Oriente, San Pedro Garza García, 66269, Nuevo León, México
TEL: +52 (81) 86256000
E-MAIL: mexico@latinamerica-ipr-helpdesk.eu
WORKING HOUR: 9h00-17h30 (GMT-5)

CHILE
ADDRESS: Galvarino Gallardo 1690, Providencia, Santiago
TEL: (56-2) 2 787 8422 – 2 787 8400
E-MAIL: chile@latinamerica-ipr-helpdesk.eu
WORKING HOUR: 9h30-18h30 (GMT-3)

Disclaimer:
The Latin America IPR SME Helpdesk is a free service which provides practical, objective and factual information aimed to help European SMEs understand business tools for developing IPR value and managing risk. The services are not of a legal or advisory nature and no responsibility is accepted for the results of any actions made on the basis of its services. The content and opinions expressed are those of the authors and do not necessarily represent the views of the European Commission and/or the Executive Agency for Small and Medium-sized Enterprises or any other body of the European Union. Before taking specific actions in relation to IPR protection or enforcement all customers are advised to seek independent advice. Neither the European Commission nor the Agency may be held responsible for the use which may be made of the information contained therein.

Project implemented by: