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Mexico

PATENT LITIGATION

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This country-specific Q&A provides an overview of patent litigation laws and regulations applicable in Mexico.

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MEXICO

PATENT LITIGATION



1. What is the forum for the conduct of patent litigation?

Under the Federal Law for the Protection of Industrial Property (FLPIP), the only forum to discuss patent validity and infringement is the Mexican Patent and Trademark Office (Impi). The Mexican office has specialists on different subject matters relevant to patent issues.

The Office's rulings can be appealed either through an administrative review, before the examiner's hierarchical superior, or through an administrative appeal before the Federal Administrative Court's Specialized Chamber on Intellectual Property (Sepi).

Even if this collegiate court is specialized on intellectual property (IP) matters, they are experts on matters of law, but not on the technical aspects of patents, which is why offering technical expert opinions as evidence, is always advisable as evidence. Bear in mind that an administrative review is not procedurally necessary in order to file an administrative appeal. In fact, the ruling on an administrative review can later be challenged through an administrative appeal.

The decision issued by Sepi can later be challenged through a constitutional appeal before the Federal Circuit Courts, which are focused on administrative law matters, but not on industrial property. Only in the event that a constitutional interpretation – as opposed to legal interpretation – is proposed before in a Constitutional Appeal, the Circuit Court's ruling could be challenged before Mexico's Supreme Court, its admission will depend on the novelty and relevance of the case, as well as the existence of said interpretation.

Under FLPIP, patent validity cases will still be studied by Impi, however, infringement cases have 2 important considerations: Once there is a ruling of infringement by Impi through a different proceeding (incident of damages) the plaintiff will be able to request Impi to declare the damages consequence of the infringement. Other than that, there is a possibility to arrive to conciliation during the proceeding which will be

considered 'res judicata' and executable before a court if an economic payment or an obligation to refrain from using was agreed.

The plaintiff can choose to try an infringement and damages case directly before a Civil Court. This decision can be challenged before the Civil Higher Court, and it can later be challenged before a Federal Circuit Court on Civil matters.

Bear in mind that none of these courts has expertise on IP principles or technical aspects. This civil proceeding will be suspended on the first instance in the event that the defendant challenges the validity of the patent. If that is the case, the proceeding will be the same as the one described under the FLPIP. The Civil Court will lift the suspension once there is a definitive decision on the validity of the patent.

The advantages of choosing the administrative track through Impi is that it is an office with relevant technical background and knowledge, which does not avoid the need to provide technical expert's opinions, and should an infringement be declared, the defendant will have to pay an elevated sum as a fine to Impi, besides the damages that should be paid to the plaintiff. The disadvantage is that this can be, in some cases, a slower process as opposed to a Civil Court's decision where no challenge to the validity of the patent was filed.

The advantage of choosing a Civil Court, is that in the event that the validity of the patent is not challenged, this could be a more agile proceeding. The disadvantage of this choice can be found in the fact that there is no possibility to obtain a conciliation agreement certified by Impi, no fine will be imposed against the defendant, and in the event that the validity of the patent is challenged, the proceeding will be slower, as it will be suspended until there is a final ruling on that issue.

2. What is the typical timeline and form of first instance patent litigation

proceedings?

Under the FLPIP, an annulment action against the validity of a patent will usually take from 16 to 24 months to be finally resolved. It should be filed before Impi, with no time limitation to file.

On the initial writ the plaintiff must file all the relevant arguments and supporting evidence. Once the action is admitted, the defendant will have one calendar month to offer her defence arguments and supporting evidence, and the plaintiff will have 3 days from that to argue against that defence. After 12 to 14 months, Impi will call the parties to submit their final pleadings, and from 6 to 10 months after that it will issue a ruling.

As for infringement proceedings, they can be brought either before Impi or a Civil Court, and it will usually take from 16 to 24 months to be finally resolved. As for its form, it can begin with a request for precautionary measures before Impi or the Civil Court, and after the measures are imposed, the plaintiff has 20 days to file an infringement action offering the relevant evidence, or else she will be liable for the damages that the execution of the measure may have created on the defendant. Once the infringement writ is admitted, the defendant will have 10 days to file its writ of arguments and offer the relevant evidence.

At this point, the defendant will also have the chance to challenge the validity of the patent through an annulment proceeding, and should that be the case, on the administrative proceeding both cases will be studied together, providing priority to the invalidity claim. After 12 to 14 months, Impi will call the parties to submit their final pleadings, and from 6 to 10 months after that it will issue a ruling. Naturally, if the validity of the patent was challenged, the time frame may be extended approximately 12 months.

When the case is brought before a Civil Court instead of Impi., the validity and infringement will not be studied together, but instead, the validity will take priority and suspend the infringement until there is a definitive ruling on the issue of validity. If there is no challenge of validity, a Civil Court will take from 12 to 18 months to issue a ruling on the matter of infringement and damages.

Once the damages suit has been served to the defendant, she will have 9 days to offer her defence and later, a period of 30 days will be established for the parties to offer relevant evidence, and finally a hearing for final pleadings will be established by the court in order to provide its ruling in the following 10 days.

Under an administrative infringement, there is a

procedural step where the parties can resolve the matter through conciliation, where Impi will sanction that agreement between the parties and it will be enforceable before the courts.

3. Can interim and final decisions in patent cases be appealed?

Both interim and final decisions can be appealed. Interim decisions on proceedings before Impi are limited to the provision of precautionary measures, which can be appealed before a Federal District Judge. Final decisions by Impi can be appealed through an administrative review, and later, through an administrative appeal before the Sepi.

The appellant will have 30 business days to file its writ of appeal and must expressly request for the appealed ruling to be suspended.

As for cases brought before a Civil Court under FLPIP, a request for clarification can be filed in connection to an interim decision. Final decisions can be appealed before the Higher Court on twelve days if it is before a state court and 5 days if it is a federal court.

4. Which acts constitute direct patent infringement?

The following are considered patent infringement:

- Create the notion that the product is patented when the patent has lapsed or annulled.
- Manufacture products protected by a patent, utility model or industrial design without the patent owner's license or authorization.
- Sell or offer any product protected by a patent under the knowledge that they have been manufactured without the patent owner's license or authorization. Use a patented process without the patent owner's license or authorization.
- Sell or offer any product that is the result of the use of a patented process, without the patent owner's license or authorization. Imitation or reproduction of an industrial design.
- Acts which are against the good uses and customs on the specific industry which reflect unfair competition with strict relation to intellectual property.

Furthermore, the following behaviors are considered infringing, on the protection of trade secrets:

- Improper appropriation of information which constitutes a trade secret in order to obtain a competitive advantage.
- Manufacture, offer, sell, import, export or store products or services that use a trade secret without authorization.

- Private or academic use, with non-commercial purposes for technical or scientific research.
- Lack of evidence to prove infringement.
- Inadequacy of the conduct to the statutory infringement as described.
- Bolar clause.

5. Do the concepts of indirect patent infringement or contributory infringement exist? If, so what are the elements of such forms of infringement?

Such concepts are not expressly considered under Mexican IP law, nonetheless, acts of commerce and distribution are now considered as infringements, as well as all the steps on the distribution chain.

6. How is the scope of protection of patent claims construed?

The right conferred by a patent is determined by the approved claims and the description or in any such event the drawings will be only relevant for the interpretation of said claims. In light of the above, patent infringement is literal, and neither Impi. As a general matter the doctrine of equivalents has not been accepted, nonetheless, the First Circuit Court of the First Circuit has issued a non-binding criterion accepting such a theory, therefore it could at some point be developed into jurisprudence, but this has not yet happened.

7. What are the key defences to patent infringement?

Besides challenging the validity of the patent, noninfringement based on a limitation of the scope of protection.

In rare cases, legitimate use and reduction to practice prior to the filing of the application will also work as a relevant and solid exception to infringement.

Furthermore, arguments related to due process are always relevant, and it is important to consider that infringement proceedings, on the administrative track before Impi, should follow criminal proceeding principles under the concept of "punitive administrative law", therefore fundamental rights of a defendant will be of great importance.

Other important defences would be:

- Use or readiness to use an invention prior to its application or priority.

8. What are the key grounds of patent invalidity?

Causes for annulment comprise the following:

- Granting of a patent against the statutory requirements for such a protection, such as novelty, inventive step, industrial application, or statutory prohibitions, such as scientific or theory principles, nature's discoveries, business methods, games, mathematic methods, computer programs, forms of presenting information, and others.
- Granting of a patent against the law (this cause exists to consider other patentability prohibitions which are general bars for IP rights registrations, such as the alteration of public order or when it is contrary to moral).
- When the application was abandoned, but yet granted.
- When the granting was a consequence of a mistake or was granted to a person with no right to obtain it.
- The protected subject matter lacks novelty, inventive activity or industrial application,
- The patent does not disclose the invention in a sufficiently clear and complete manner for it to be reproduced by an expert.
- The patent claims exceed what was originally disclosed on the application as it was originally filed.
- The patent is the result of a divisional application and it includes claims which have been applied for without providing the necessary description claims or drawings; or without claiming an invention different to the one claimed on the original application or in other divisional; or after the specific term provided for its application.
- The protected subject matter was augmented through a limitation or rectification proceeding.
- The novelty or inventive step was reviewed incorrectly as a consequence of a mistakenly acknowledge priority.
- The patent exists against the principle of public domain, or double patenting of a same invention. The patent was granted to

someone who was not its rightful owner.

9. How is prior art considered in the context of an invalidity action?

Prior art is understood as the technical knowledge accessible to the public through its oral or written description, exploitation or any dissemination medium in the country or abroad before the patent application or its acknowledged priority. It is understood as an individual document, and the combination of prior art references is not allowed.

10. Can a patentee seek to amend a patent that is in the midst of patent litigation?

As a practical matter, Impi has allowed the amendment of the patent in order to limit its scope or correct errors. This is possible even during litigation; nonetheless, it would alter the issue under study.

11. Is some form of patent term extension available?

Under FLPIP, it is possible to request a complementary certificate which will have a maximum of 5 years and it can only be obtained when the delay on the granting of the patent is only imputable to Impi. This request should be based on the term, which is clearly imputable to the authority, and not to all of the prosecution term.

12. How are technical matters considered in patent litigation proceedings?

Impi counts with technical experts who will examine both infringement and invalidity cases, nonetheless, it is customary to provide support for any technical issue with an expert's opinion.

Both parties will have the opportunity to offer their expert's opinion on a written questionnaire and the counterpart will also have the chance to amplify the questionnaire to be resolved by its counterpart's expert.

Likewise, once the opinion of the experts is delivered, each of the parties will be able to offer arguments against them. Once both parties have expressed their opinions and arguments, Impi will issue an independent technical opinion, prior to delivering a ruling, which will take into account the expert's opinions provided by the parties. This opinion usually provides the direction of the ruling, and therefore the parties will have a time to argue against the opinion before Impi's decision is finally

delivered.

On appeal it is likely that the arguments against the ruling will challenge reasons of Impi's technical opinion, opposed to one provided by their expert. Unlike Impi, none of the appeal courts count with technical personnel, and thus they will support their reasoning on the expert's opinions provided by the parties on first instance.

Under FLPIP, should a party choose to file an infringement action before a Civil Court on first instance, all claims must be supported on technical opinion's by experts, since the court does not count with technical experts, nonetheless, the court will be able to appoint a neutral expert to facilitate the understanding of the technical issues.

13. Is some form of discovery/disclosure and/or court-mandated evidence seizure/protection (e.g. saisie-contrefaçon) available, either before the commencement of or during patent litigation proceedings?

On infringement cases there is no form of disclosure or discovery with the purpose to obtain information directly from the defendant. In fact, following criminal law principles, the defendant should be protected by the right to not incriminate herself and thus, not provide any element that could be damaging, and that should be provided by the plaintiff.

It is possible to request information to third parties, which may have knowledge of the infringing conduct. This request of information must be offered on the initial writ through a precise questionnaire that Impi will later serve the third party. On the field of precautionary measures, it is possible to seize infringing products if such a request is made by the plaintiff. A visit to a specific location (warehouse or distributor ex.) must be requested and the infringing products must be found by Impi's officers in said visit for them to be seized. In order to do so, the plaintiff must offer a bond to pay for the inflicted damages in the event that the products are found not infringing.

14. Are there procedures available which would assist a patentee to determine infringement of a process patent?

There is not a special proceeding in order to assist a patentee against an infringer on a process patent case, particularly considering the aforementioned protection

principles on presumption of innocence and no self incrimination.

Notwithstanding the above, inspection proceedings which can be offered as evidence are available can be useful to prove a process if it can be appreciated by Impi's officer during an inspection to the defendant's factory or warehouse.

15. Are there established mechanisms to protect confidential information required to be disclosed/exchanged in the course of patent litigation (e.g. confidentiality clubs)?

Yes, the parties can offer evidence and submit it to Impi requesting the Authority to consider it confidential, expressing the reasons why such documents must be considered as such.

The counterpart will still have the right to observe the confidential evidence offered, and express arguments in connection to it, but will not be able to copy it, document it or take notes. The counterpart will only be allowed to review it on Impi's offices.

16. Is there a system of post-grant opposition proceedings? If so, how does this system interact with the patent litigation system?

There is no post-grant opposition proceeding, and there is not a pre-opposition proceeding, but during the 2 months following the applications publication, there is a possibility for any third party to provide comments or evidence to Impi against the granting of said party. These arguments will not suspend the prosecution, nor will provide the third party of any legal standing on the prosecution, these documents will only be used by Impi if found relevant..

17. To what extent are decisions from other fora/jurisdictions relevant or influential, and if so, are there any particularly influential fora/jurisdictions?

Neither Impi nor the appeal courts are under any obligation to consider decisions of other jurisdictions on their own, when the facts of infringement have only happened in the Mexican territory. Nonetheless, in some situations, particularly when the issue is technically challenging, Impi or the courts may be open to hear the decisions of other jurisdictions in order to inspire their

resolutions. For both invalidity and infringement, the most influential jurisdictions are the United States Patent and Trademark Office (USPTO) and European Patent Office (EPO).

18. How does a court determine whether it has jurisdiction to hear a patent action?

It is a statutory matter and the track is clearly established. Impi has jurisdiction on infringement cases and exclusive jurisdiction validity cases on first instance.

When an infringement case was filed before IMPI, on the second instance, a specialized court was created for IP matters (Sepi), so that is the only court that holds jurisdiction to hear these cases on second instance.

On third instance Sepi's rulings could only be challenged before the Federal Administrative Circuit Courts.

If an infringement case was filed before a Civil Court, jurisdiction can be local or Federal, and it will be restricted to the infringement issue; in the event that the validity of the patent is challenged, Impi has exclusive jurisdiction, and therefore the issue on infringement must be suspended until Impi rules on the validity.

The jurisdiction of a specific Civil Court, will be determined by aspects such the address of the defendant, or a previously contractually agreed jurisdiction.

19. What are the options for alternative dispute resolution (ADR) in patent cases? Are they commonly used? Are there any mandatory ADR provisions in patent cases?

Alternative dispute resolution (ADR) proceedings are not commonly used in patent cases, but settlements can occur during the proceeding.

Under FLPIP, when the infringement proceeding is followed before Impi and not the Civil Court, it is possible to take part on a conciliation proceeding. In a conciliation proceeding, which will not suspend the main proceeding, one of the parties will propose a settlement to the other through Impi. The office will require both parties to appear before her in order to try to resolve the matter, here the authority will take an active part into helping the parties get to a solution.

If there is a conciliation agreement, Impi will terminate the case considering the issue as 'res judicata'. Furthermore, the agreement between the parties will be enforceable before the courts.

Another possibility is arbitration, since now it is clear that an arbitration proceeding will not be administered by Impi, and will follow the commercial code rules, which have already been well understood and reviewed by our courts, in order to acknowledge the validity of the arbitration proceeding and the enforceability of an eventual award.

Considering the elevated fines against the infringers (\$1,000,000 USD per claim, plus damages) that have been established through the FLPIP, it is more likely now that parties decide to agree on conciliation or arbitration in order to avoid the statutory fines, and reduce the issue exclusively to the damages.

It is worth taking into consideration that the arbitrability of the validity of a patent has not yet been studied by Mexican Courts, and therefore that is a place of uncertainty as it is on many countries.

20. What are the key procedural steps that must be satisfied before a patent action can be commenced? Are there any limitation periods for commencing an action?

In order to begin a litigious action before a civil or administrative Court, in Mexico there is no need to prepare and serve a cease and desist letter as part of the procedure, even though it is advisable in some cases.

Notwithstanding the above, in order to be able to request the imposition of precautionary measures and damages claims, there must have been a clear indication for public knowledge that the product or service was protected by a patent right, or else that through any other means such information was made of the public knowledge.

Furthermore, all documental or physical evidence to be provided must bear a date prior to filing of the action.

Technical questionnaires for experts must be prepared and offered with the initial writ.

The same goes for the Power Of Attorney (POA), which must follow the formalities of the country where it was granted and any of an international treaty related to POAs, such as the Protocol on Uniformity of Powers of Attorney Which are to Be Utilized Abroad, for the members of the Organization of American States (OAS). The POA must be duly notarized and apostilled for Mexico, before the date of filing.

21. Which parties have standing to bring a patent infringement action? Under which circumstances will a patent licensee have standing to bring an action?

Only the owner of the patent has the right to bring an infringement action against a third party violating the rights derived of such registration. In order for a patent licensee to be able to bring an action against the infringer, the patent owner should have not reserved that right for its own.

22. Who has standing to bring an invalidity action against a patent? Is any particular connection to the patentee or patent required?

On constitutional law, a criterion on legitimate standing has been developed to allow parties who do not have a direct link to a defendant to bring an action against her considering such a legitimate connection or interest on the plaintiff. Notwithstanding the above, the FLPIP expressly establish that an action may be initiated only by the person who has legal standing, as opposed to legitimate standing, meaning that only a person whose rights are being limited on a direct, precise an immediate connection by the patent will have such a standing.

23. Are interim injunctions available in patent litigation proceedings?

Interim injunctions are available under the FLPIP and they can also be requested before a Civil Court.

These injunctions allow the plaintiff to request the authority or court to order:

- i. the withdraw from commerce of any infringing product as well as any advertisement related to it,
- ii. the prohibition of the commercialization or use of the infringing products,
- iii. the seizure of infringing products,
- iv. suspension of any imports or exports if such constitutes a violation of the Law,
- v. the closure of the place where the products are manufactured if other injunctions are not enough to prevent the continuance of the infringement.

In order to request these injunctions, the authority must review that their granting will not harm public order nor affect the interests of the general public.

Furthermore, the plaintiff must provide the necessary information to identify the infringing products and the place where they should be found, as well as proving ownership of the patent and any of the following:

1. An imminent violation to its right.
2. The possibility to suffer an irreparable damage.
3. The possibility that relevant evidence is destroyed, hidden, lost or altered. The plaintiff must also file a bond which is broad enough to cover any harm or damage inflicted upon the defendant if the infringement is not finally proved.

Impi will usually take around 2 weeks to grant these injunctions, an depending on the location of the manufacturing facilities, they can be executed promptly after its granting.

These injunctions can be lifted by the defendant if he offers a counter bond, but Impi must also consider aspects such the defendant's good standing on the matter, as well a balanced reasoning considering if the damage caused with this measures is greater for the defendant than the damage caused to the plaintiff.

Furthermore, the defendant will have 10 days to argue against such measures and Impi could alter them if it seems necessary.

A defendant can also file a constitutional appeal before a District Judge to try to lift the injunctions.

24. What final remedies, both monetary and non-monetary, are available for patent infringement? Of these, which are most commonly sought and which are typically ordered?

An infringement ruling will usually resolve the following:

- An order against the infringer to not continue with any such act declared as infringing on the ruling.
- A maximum fine of \$21,500,000 MXN (\$1,023,800 USD) for each claim if infringement effectively proven (ex. Unfair competition and reproduction of patented product may be 2 different causes).
- An additional fine of \$86,000 MXN (\$4,095 USD) for every day that the infringement continues.
- If the infringement continues, and it is declared as such, said incidence will be

considered a criminal offense as well.

- Temporary closure of the infringers company for up to 90 days.
- Payment of damages of at least 40 % of the public sale price of the infringing product or service.

It must be considered that it is unlikely that the Authority declares de maximum fine against the infringer. Nonetheless, Impi it is now obliged to consider each cause of infringement independently and declare an individualized fine for each infringing conduct.

Furthermore, the authority will be able to combine monetary fines with the closure of the company if the infringer conducts during the proceeding and on the execution of the infringement deserves it. **These remedies leave the damages claims untouched.**

Under Civil litigation, only the damages reparation with a statutory sanction of at least 40% of the public sale price is available.

25. On what basis are damages for patent infringement calculated? Is it possible to obtain additional or exemplary damages?

- Damages are established on a statutory
- Minimum of 40% of the product's value. Under FLPIP, the following aspects are considered:
- the value of the infringed products calculated by its market price,
- the profits that the patent owner did not obtain due to the infringement,
- the profits made by the infringer,
- and the price that the infringer would have had to pay in order to obtain a license.

26. How readily are final injunctions granted in patent litigation proceedings?

The injunctions ordered on the infringement declaration by Impi are considered permanent. The defendant could request an injunction against them on appeal, but it is unlikely that such an injunction be granted, and if granted, the defendant would be required by the court to file a bond broad enough to cover both the fine and damages.

27. Are there provisions for obtaining declaratory relief, and if so, what are the legal and procedural requirements for obtaining such relief?

A declaratory relief is uncommon, and the closest to it under IP litigation in Mexico is a declaration of noninfringement which will be determined on a final decision of infringement, only when the decision studies and compares the claims of the patent against the infringing product.

28. What are the costs typically incurred by each party to patent litigation proceedings at first instance? What are the typical costs of an appeal at each appellate level?

The costs of litigation for any of the parties vary a lot depending on the complexity of the case, the location of facilities where the infringement is happening (considering the travel expenses and others in order to secure the infringing products with a precautionary measure), the value of the products (considering the bond to be paid if there are precautionary measures against it), among other elements.

On appeal, even if attorney's fees may be more significant than on first instance, due to the legal complexity involved, other costs are reduced since it is unlikely that more evidence would be admitted or even allowed.

29. Can the successful party to a patent litigation action recover its costs?

Attorney's fees, or expert opinion's fees are not possible to recover under FLPIP, on an administrative proceeding. Even on Civil Courts it is not common or even likely to recover the costs of litigation. Under FLPIP, conciliation brings the possibility create an agreement that may include the recovery of the litigation costs, but it is important to recall that conciliation can only happen before the ruling on first instance on the administrative track before Impi.

30. What are the biggest patent litigation growth areas in your jurisdiction in terms of industry sector?

Pharmaceutical industry has been and will continue to be the industry with the biggest litigation growth, considering the new possibilities provided by FLPIP in favour of generics companies.

31. What do you predict will be the most

contentious patent litigation issues in your jurisdiction over the next twelve months?

On both infringement and invalidity, it will most definitely be the pharmaceutical industry, particularly the following matters:

1. Infringement of patents he the patent term has not yet lapsed.
2. Infringement of patent for uses that should not be comprised under the Bolar clause.
3. Invalidity of new uses of formulations.
4. Invalidity of complementary term registrations

On the other hand, it is also possible to anticipate a lot of patent infringement cases against manufacturers, considering the new fines under FLPIP and the more agile possibility to collect damages, as well as the opportunity to conciliate before the first instance ruling.

32. Which aspects of patent litigation, either substantive or procedural, are most in need of reform in your jurisdiction?

The creation of a damage award system is essential. Following the implementation of FLPIP, the legal obligation for Impi to create a damage award system and bylaws was established, but until today it has not yet been created.

Furthermore, Impi, unfortunately has not been granted the resources to grow its human resources, and therefore timely resolution of patent cases are lacking. Before FLPIP, a more agile proceeding was needed in order to collect damages. The FLPIP seeks to provide a more agile proceeding and offer the possibility to grant the plaintiff two options, civil or administrative litigations, both of them with their advantages and disadvantages, the solution is not perfect, but there is hope that it will be better and provide more certainty to IP owners in Mexico.

33. What are the biggest challenges and opportunities confronting the international patent system?

Mexico needs to build a faster and enforcement efficient system for conflict resolution related to the protection of patents. It is not only about issuing rulings on a speedy manner, but also with a sophisticated study of the issue being resolved in order to build and construe relevant precedents, and strengthen an enforcement system that provides certainty to national and foreign IP owners, we consider that the FLPIP is a step on the right direction

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