



Submission date: 22nd April 2016

## 2016 – Study Question (General)

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**Security interests over intellectual property**

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Date	22-04-2016

### I. Current law and practice

You are reminded that **IPRs** refers to patents, trademarks and registered designs only.  
If more than one type of security interest is available under your Group's current law, please answer the questions for each type of security interest, as applicable.

#### Availability of security rights

1) Does your Group's current law provide for the possibility of creating security interests over IPRs?  
yes  
Please explain:

If yes, please answer Questions 2) to 14) inclusive before proceeding to question 15) and following.  
If no, please proceed directly to question 15).

2) Are the available types of security interests defined by specific provisions relating to security interests over IPRs or by general commercial law principles (e.g. specific provisions in your Group's patent legislation rather than general commercial provisions that are applicable to tangible personal property as well as to patents)?

yes  
Please explain:

3) Under your Group's current law, what types of security interests are available for IPRs?  
In addressing the questions in sub-paragraphs a) to c) below, please specify briefly the main characteristics and differences of the available types of security interests.

a) Does your law provide for security interests which are characterized by the full assignment of the

underlying IPR to the security taker? For example, an assignment of the IPR for the purpose of security or authorization to dispose/use fully in the event of default.

no

Please explain:

b) Does your law provide for security interests that authorize the security taker to realize the security interest only in the event of default? For example, a pledge over an IPR that authorizes the pledgee to liquidate the pledged IPR in the event of default (but not to otherwise dispose of the IPR).

yes

Please explain:

c) Does your law provide for security interests that authorize the security taker to use the underlying IPR? For example, usus fructus rights that authorize the creditor to use and/or realize proceeds from the exercise of the IPR only during the term of encumbrance. Is any right to use the encumbered IPR conditional upon default of the security provider?

no

Please explain:

Specific rules on use by creditor of the underlying IP so this would be governed by general commercial and contract law. Such an agreement would probably be acceptable as a license but could be questionable on grounds of duress.

4) If more than one type of security interest is available under your Group's current law, what types are commonly used for IPRs? Please also specify if certain types of security interests are exclusively used for certain types of IPRs in your country. For example, patents may commonly be encumbered with pledges, while trademarks may commonly be assigned to the security taker.

Only pledges are used and not too widely. We are not aware of any Patents to have been used as security.

#### Effects of security interests

5) Is the security provider restricted in their right to use their IPR after providing a security interest over that IPR? For example, in respect of their right to grant licenses, or the right to use the protected subject matter. Please answer for each available type of security interest.

no

Please explain:

6) May encumbered IPRs be assigned to third parties by the security provider?

yes

Please explain:

7) If yes:

a) under what conditions may an IPR be assigned (e.g. obligation to obtain consent from the security taker, public notification or registration)?

Consent of security taker is needed.

b) does the IPR remain encumbered with the original security interest for the benefit of the security taker?

yes

Please explain:

8) What are the rights of the security taker before default (e.g. entitlement to damages, injunctions against infringers, or license fees)?

The security taker may take the necessary steps to keep the IPR alive (i.e.: annuity payments, defenses against invalidity/nullity actions).

9) Who of the security provider or the security taker is responsible for maintenance and defence of the IPR provided as collateral?

As provided in the agreement. In any event, the security taker may take the necessary steps to keep the IPR alive.

10) What are the legal consequences if the underlying IPR expires or is revoked? For example, the security right lapses simultaneously; the creditor has a compensation claim against the security provider.

If the underlying IPR is lost the security remains devoid of any value to the security taker who may ask for compensation only if damages arise from this action.

11) Can any of these effects of security interests over IPRs before default be modified by contractual provisions between the parties? If so, which effects?

no

Please explain:

#### Applicable law

12) Does your Group's current law provide for conflicts of laws as to the availability and effect of security interests over IPR portfolios containing foreign as well as national IPRs?

no

Please explain:

13) Which national law applies as to creation, perfection and effect of security interests over foreign IPRs? For example, where a US patent is provided as collateral in respect of a financial transaction in Europe.

Law where the agreement was executed or the law which the parties choose to apply as long as "public order" is not violated.

14) Can a choice of law provision in a security interest agreement over IPRs overrule the applicable law as to availability and effect?

yes

Please explain:

Yes for availability but probably not for effects.

Additional question

15) Regardless of your Group's current law relating to security interests over IPRs, is it possible to create a solely contractual regime for security interests over IPRs (i.e. beside the types of security interests defined by law) that is enforceable between the contracting parties?

yes

Please explain:

It may be possible to some extent as long as public order is not violated. For example it may not be possible to take possession of the secured IPR in the event of default. Also, a regime outside of the given rules would not create an effective restriction to a transfer of the IPR to a bona fides third party.

**II. Policy considerations and proposals for improvements of the current law**

16) Is your Group's current law regarding security interests over IPRs sufficient to provide certainty and predictability to the parties?

yes

Please explain:

Yes, but the obligation to use the special templates for recordal make it very difficult to record agreements with IPR in multiple jurisdictions including Argentina. This is because the recordal template requires to insert the secured amount and a stamp tax and a recordal tax is due on such an amount the total of which is 1,2%. This represents a problem in a global transaction where the value of the local IPR cannot be readily apportioned.

17) Under your Group's current law, is there an appropriate balance between the rights between security takers and security providers? For example:

a) are there situations in which the rights of security takers should be limited or extended (e.g. if assignment of an encumbered IPR is possible by the security provider without involvement of the security taker)?

no

Please explain:

b) are there situations in which the rights of security providers should be limited or extended (e.g. if the security taker is authorized to dispose of existing licenses without involvement of the security provider)?

no

Please explain:

18) Are there any aspects of these laws that could be improved? Are there any other changes to your Group's current law that would promote transactions involving IPRs as collateral? If yes, please briefly explain.

yes

Please explain:

As per answer of question 16 our law should allow more flexibility regarding what templates may be submitted for recordal.

### III. Proposals for harmonisation

19) Does your Group consider that harmonization of laws concerning security interests over IPRs is desirable?

yes

If yes, please respond to the following questions without regard to your Group's current law. Even if no, please address the following questions to the extent your Group considers your Group's laws could be improved.

#### Security system regarding IPRs

20) Should there be specific provisions regulating security interests over IPRs (i.e. separate from security interests over tangible property) generally?

yes

Please explain:

21) If no, should there be general commercial law principles that also apply to IPRs? If not, why?

yes

Please explain:

Yes, as second best.

22) What types of security interests should be available as minimum standard in all countries?

Pledges.

23) Should the law be applied differently depending on the type of IPR? For example, should patents be encumbered exclusively with pledges, should trademarks be assigned to the security taker for the purpose of security?

no

Please explain:

No. Even if the nature of the IPR may be different the purpose of creating a security is the same.

#### Effect of security interests

24) Should the security provider be restricted in their right to use their IPR after providing a security interest over that IPR (e.g. in respect of their right to grant licenses, or to use the protected subject matter)? If so, how?

no

Please explain:

They should not be limited to the extent that any use should not be detrimental to the IPR itself. Any use, licenses, authorizations should be at a par with that of a diligent IPR owner.

25) Should the security provider be able to assign encumbered IPRs to third parties?

yes

Please explain:

Yes, provided the secured party agrees.

26) What should the rights of the security taker be before default (e.g. entitlement to damages, injunctions against infringers, or license fees)?

Only the necessary rights to keep the IPR alive.

27) Should the security provider or the security taker be responsible for maintenance and defence of the IPR provided as collateral?

yes

Please explain:

Security provider should be responsible at its cost but taker should also be authorized to act in protection of the IPR at the cost of provider.

28) What should the legal consequences be if the underlying IPR expires or is revoked (e.g. the security right lapses simultaneously; creditor gains a compensation claim against security provider)?

Both. Compensation only if damages arise. (i.e provider may still pay debt in a timely manner).

29) Should it be possible to modify these effects of security interests over IPRs before default by contractual provisions?

yes

Please explain:

Yes, if not against public order.

#### Applicable law

30) Which law should apply as to the availability and the effects of security interests where a foreign IPR is provided as collateral? Why?

Security interests are useful and work only if a specific registration and effects system exists. As far as creation, validity and assignment of a foreign IPR this is today regulated by the foreign law of the IPR and ruled by the courts thereof. Therefore availability and effects of the security should also be regulated by foreign law, unless a treaty provides otherwise.

31) Should a choice of law provision in a security interest agreement over IPRs overrule the applicable law? If yes, why?

no

Please explain:

Not in respect of post-default effects. Yes, regarding pre-default effects. Whilst freedom of choice

should be the principle in commercial law, such freedom cannot be exercised in circumstances where the debtor may be perceived to act under duress or in circumstances where the IPR holder undergoes bankruptcy procedures and the secured transaction must compete with other privileged creditors (i.e. in bankruptcy proceedings).

Additional considerations and proposals

32) To the extent not already stated above, please propose any other standards your Group considers would be appropriate to harmonize laws relating to security interests over IPRs.

33) Please comment on any additional issues concerning any aspect of security interests over IPRs you consider relevant to this Study Question.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Summary