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2016 – Study Question (General)

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Security interests over intellectual property

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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:

The Industrial Property Law No. 20-00 establishes the possibility of creating security interests over patents, industrial designs and trademarks. (Art. 137)

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:

The Rules of the Industrial Property Law No. 20-00 (as amended by the Presidential Decree

180-03) mandates the applicability of the Commercial Code concerning enforcement of security interests over IPRs. Consequently, IPRs are regarded as any other security interest, apart from the registration requirement before the Industrial Property National Office (Oficina Nacional de Propiedad Industrial, ONAPI) which involves presenting the pertinent agreement or legal document between the IPRs holder (debtor) and creditor.

- 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:

Since the applicable enforcement is under the general movable property provisions, there are not special types or procedure. Nonetheless, it has been admitted that the correspondent security interests should be “non-possessory pledges”.

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:

Following the provision on “non-possessory pledges”, the enforcement shall begin when the debtor has not paid within 90 days following the expiration of a credit or loan. This enforcement is the seizure of the asset for its sale on a public auction.

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:

It does not expressly authorize. However, since there is no prohibition either, such use may be agreed by the parties.

- 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.

It has been acknowledged that the correspondent security interests should be “non-possessory pledges”.

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:

There are no limitations to the holder of the IPR (security provider) on this regard, as long as the use is according to the nature of the asset. Nonetheless, an agreement could restrict certain actions.

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

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)?

The holder may assign the encumbered IPRs with the explicit agreement of the creditor.

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

yes

Please explain:

Yes, same obligations remain.

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

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

There is no special provision. Nevertheless, the security provider as the holder of the IPR is the one entitle of keeping and defending the assets. Furthermore, according to the “non-possessory pledges” provisions, the debtor must safeguard the object given as collateral.

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.

The security right lapses simultaneously, in the following cases:

- a. **If the creditor confirms falsehood in the information given by the debtor**
- b. **If the debtor fails to pay**
- c. **If the debtor mismanages the object or there is a justified assumption that the debtor will destroy or hide the object. If the investment plan cannot be carry out.**
- d. **If the debtor uses the funds for an unauthorized purpose**

- e. **If the debtor concealed any defect or vice in the object, or any circumstance affecting its pacific property, domain or possession that may constitutes a cause for termination**
- f. **If the debtor does not allow the inspection of the object or does not grant periodic reports regarding the object as requested by the creditor**
- g. **If the debtor does not inform to the creditor about extraordinary detriment or any other issue which diminishes the value of the object or affect its property or jeopardize its domain. If the object has partially loss its value, the debtor may reinforce the pledge or provide cash payment of the corresponding quantity (within 15 days)**
- h. **If the creditor has not provided the entirety of the loan, he/she/it may suspend payment if any of the aforementioned circumstances occurs.**

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:

There is no express provision against or in favor of modifying these effects.

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?

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.

The applicable law will be according to the place of registration. Since, only registered IPRs with registered security interest documents before the Dominican authority may be enforced.

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:

If the parties do not register the agreement before the Dominican authority, it will not be enforceable.

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?

no

Please explain:

There is no express provision against or in favor of such a regime.

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?

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:

Since the current pledges were decided for tangible goods, many contractual or general issues involving IPRs are not regulated.

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:

A special procedure for IPRs should be provided, which allows for different sort of security interests and a clear enforcement path.

III. Proposals for harmonisation

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

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?

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

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

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?

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?

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

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

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

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)?

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

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?

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

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