



Submission date: 28th May 2016

2016 – Study Question (General)

by Sarah MATHESON, Reporter General
John OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General
Security interests over intellectual property

Responsible Reporter: Ralph NACK

National/Regional Group	Uruguay
Contributors name(s)	Gabriel PITTALUGA, Juan PITTALUGA and Gustavo FISCHER
e-Mail contact	gpittaluga@pittaluga.com
Date	27-05-2016

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:

Relevant statute is Law No. 17.228 dated January 7, 2000, providing for registrable pledge without dispossession ("Prenda sin Desplazamiento") over IPRs (among other rights and property). In addition, the Trademark Law (Law 17.011, of September 25, 1998, Establishing Provisions on Trademarks) and the Patent Law (Law No. 17.164 Regulating Rights and Obligations Relating to Patents, Utility Models and Industrial Designs of September 2, 1999), contain provisions regarding Registers of pledges over trademark and patent rights.

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:

Defined by a general commercial law applicable to pledges on various rights and property, rather than by a specific provision concerning IPRs.

- 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:

Security interest is established without dispossession of the pledge right or property of the pledgee.

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:

- 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.

N/A

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)?

IPRs may be assigned by the pledgee to third parties, but the legal delivery of the assigned IPRs will not be deemed to have been effected until the security taker has been paid in full by the pledgee, except by express consent of the security taker, of which due note must be taken when registering the change of owner in the corresponding Pledge Registry.

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 law does not provide for the security taker to be entitled to rights before default allowing for 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?

The pledgee. Furthermore, Law No. 17.228 provides that the pledgee is under the obligation to duly maintain the pledge property, under penalty of criminal sanctions.

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.

As mentioned above, if the pledged IPR expires and is not renewed by the pledgee, Law No. 17.228 provides for criminal penalties to be imposed over the pledgee. In addition to the right by the security taker to consider the pledgee in default. There are no provisions regarding revocation of the underlying IPR.

For example, the security right lapses simultaneously; the creditor has a compensation claim against the security provider.

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.

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

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:

While in principle such a contractual regime may be feasible, it would not bind *bona fide* third parties that may acquire the IPRs (if said IPRs are assigned or otherwise transferred by the party granting the security interest).

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:

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:

N/A

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:

N/A

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:

There should be express provisions regarding IPRs allowing for the security taker to maintain the IPRs if the pledgee fails to duly maintain or renew the same (e.g., by lack of renewal in trademarks, or annuity payment in patents).

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:

IPRs are specific in nature and specific provisions addressing the same are desirable.

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

no

Please explain:

N/A

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

Pledge of IPRs.

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:

Pledge of IPRs, if uniformly foreseen and designed, would suffice for all IPRs.

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?

yes

Please explain:

Security provider should be restricted in its right to grant licenses without the express consent of the security taker.

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

yes

Please explain:

Provided that the security taker is paid in full, or expressly consents to such assignment.

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

To be granted right to maintain the IPRs in the absence of maintenance by the security provider.

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

yes

Please explain:

Main responsibility should lie with the security provider, but security taker should be granted with express rights to maintain and defend the IPRs in the absence of action by the security 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)?

Security taker should be granted immediate right to claim for default of security provider, in addition to criminal penalties being imposed on the security provider for failing to maintain the IPR, if it was abandoned in bad faith.

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

no

Please explain:

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?

The law of the jurisdiction where the IPR is registered.

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

yes

Please explain:

Additional considerations and proposals.

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.

N/A

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

N/A

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

Summary