

Extension of the list of Service Agreements that can be paid by Brazilian companies without the need of a prior registration with the BPTO

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Brazilian law requires that international know-how agreements must be previously registered before the BPTO - Brazilian Patent and Trademark Office, in order for Brazilian companies to be allowed to remit payments abroad. Moreover, the BPTO of registration also enables Brazilian companies to treat the payment as an “operational expense” for corporate income tax purposes, among other effects.

According to the law, there is no doubt that know-how agreements are submitted to this kind of proceedings. However, the law is not clear concerning agreements for rendering technical assistance services, since, in these cases, the technology transfer may, or may not be present.

Historically, the BPTO has always required that such service agreements be registered, something that generates more costs and bureaucracy for companies, as well consumes the time needed to obtain the legal permission for making payments. It is also worth mentioning that the prior registration of these agreements before the BPTO is commonly required in order for foreign technicians to be able to obtain temporary work visas to come to Brazil, whenever the service must be rendered locally, in this country.

In an effort to mitigate such inconveniences, the BPTO had already created, several years ago, a list of services that could be paid without the need of a prior registration before the BPTO. The previous list was very limited and, because of that, was criticized.

Recently, on December 1st, 2015, the BPTO published the Resolution No. 156, extending the list of Service Agreements that are exempt of registration so as to include the following:

- Preventive maintenance services for equipment and/or machines of any kind;
- Repair, fixing, adjustment, calibration, review, inspection, reform and recovery service for equipment and/or machines of any kind;
- Assembling supervision services, assembling, dismantling, installation and start operation for equipment and/or machines.

As consequence, international service agreements related to the aforementioned activities become completely effective as of their execution by the parties, without the need of a prior approval by the BPTO, and payments that must be made by Brazilian companies became easier. The new updated list of services exempt of a prior approval by the BPTO is herewith attached.



FEDERAL PUBLIC SERVICE
MINISTRY OF DEVELOPMENT, INDUSTRY AND FOREIGN TRADE
NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

PRESIDENCY 11.09.2015

RESOLUTION No. 156/2015

Subject: Technical assistance services exempted from registration by the Office of Contracts, Geographic Indications and Records – DICIG, as provided in article 211 of Act No. 9,279, of May 14th, 1996.

THE PRESIDENT OF THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY – INPI and the **DIRECTOR OF THE OFFICE OF CONTRACTS, GEOGRAPHIC INDICATIONS AND RECORDS – DICIG**, exercising their powers pursuant to articles 136, 159 and 161 of the Annex of Ordinance No. 149 of May 15th, 2013, and

WHEREAS the provisions in the head of article 211 of Act No. 9,279/96,

WHEREAS INPI is responsible for issuing an opinion in regards to legal matters in industrial property and regulate them by means of Resolutions and

WHEREAS the purpose of granting transparency to the analysis process prepared by the Office of Contracts, Geographic Indications and Records,

IT IS DECIDED:

Art. 1 To disclose the list of contracts of Scientific and Technical Assistance Services that may not be registered, since they do not result in transference of technology:

- I. Agency in purchasing including logistics services (shipping support, management activities related to customs clearance);
- II. Services performed abroad without the presence of technical personnel of the Brazilian company that do not generate any documents and/or reports (beneficiation of products);
- III. Preventive maintenance services in equipment and/or machines of any kind;
- IV. Repair, fixing, adjustment, calibration, overhaul, inspection, refurbishing and recovery services performed in equipment and/or machines of any kind;
- V. Assembly supervision, assembly, disassembly, installation and startup services performed in equipment and/or machines of any kind;
- VI. Approval and certification of the quality of goods;
- VII. Finance consulting;
- VIII. Trade consulting;
- IX. Legal consulting;
- X. Consulting for participating in bidding processes;
- XI. Marketing services;
- XII. Remote consulting without producing documents;

- XIII. Support, maintenance, installation, implementation, integration, implantation, customization, adaptation, certification, migration, setting, parameterization, translation or software localization services;
- XIV. Training services for the final user or other software training;
- XV. Software license;
- XVI. Software distribution;
- XVII. Acquisition of sole copy of software.

Art. 2 Resolution No. 54, of March 18th, 2013, is hereby revoked.

Art. 3 This Resolution shall be in force at the date of its publication in the Industrial Property Electronic Magazine (RPI)

LUIZ OTÁVIO PIMENTEL

President

BRENO BELLO DE ALMEIDA NEVES

Director of Contracts, Geographic Indications and Records