



# Brazil: Early Production of Expert Evidence and Coordinated Expert Appointment as a Strategic Response to the Bifurcated Patent Litigation System

**Montaury Pimenta, Machado & Vieira de Mello**

**Brazil** | March 4 2026

Brazil's patent litigation framework operates under a structural feature that profoundly shapes strategy: infringement and validity are adjudicated in separate judicial spheres.

Infringement actions, grounded in section 42 of the Brazilian IP Law (Law No. 9.279/96), are typically heard before State Courts.

On the other hand, patent invalidity actions, pursuant to section 56 of the same statute, must be brought before Federal Courts, with the Brazilian Patent Office - BPTO as a mandatory co-defendant. This bifurcated structure prevents joint adjudication even when both proceedings concern the same patent and the same technological controversy.

While jurisdictionally coherent, bifurcation creates timing asymmetries.

An infringement action may advance rapidly, often accompanied by preliminary injunctions and daily fines, while federal nullity actions, where validity is examined, may still await technical development. In complex patent disputes, this gap may generate commercial pressure detached from definitive technical scrutiny.

It is precisely within this context that the anticipation of expert evidence has emerged as a decisive procedural instrument.

A leading development in this evolution just came from the 9<sup>th</sup> Federal Court of Rio de Janeiro, presided over by Hon. Judge Quezia Jemima Custodio Reis, who just recently expressly authorized the early production of expert evidence in a patent invalidity action running parallel with an infringement case.

Although early expert production is not traditionally standard practice in federal nullity proceedings, the Court recognized that the structural realities of bifurcation justified a more proactive stance. As the decision stated:

*“Although it is not this Court’s usual practice to anticipate judicial expert evidence, there is no impediment to granting the request, particularly in light of the circumstances presented in this case [...] a circumstance that recommends the prompt granting of the measure in order to avoid conflicting decisions and to ensure the effectiveness of judicial protection.”<sup>111</sup>*

This reasoning marks a significant shift from procedural sequencing to functional effectiveness. Rather than rigidly adhering to chronological formalism, the Court acknowledged that the coexistence of parallel proceedings involving the same patent demanded coordinated judicial management. The express concern with avoiding “conflicting decisions” reveals heightened sensitivity to systemic coherence within Brazil’s bifurcated patent regime.



Thus, the decision implicitly recognizes that validity is not ancillary, but foundational. Allowing early expert development narrows informational asymmetry and reduces the risk that commercial consequences in the infringement track will outpace technical clarity in the validity track. In doing so, the Court reinforced that **procedural tools must be interpreted through the lens of effectiveness and proportionality**.

Equally significant is the growing judicial openness to coordinate expert appointment. When the same patent is under scrutiny in both State and Federal Courts, **appointing the same expert may foster technical continuity without compromising judicial independence**.

An expert already familiar with the patent's claim structure, technological architecture, and prior art reduces duplication of effort and enhances analytical consistency across proceedings.

This coordinated approach aligns with the duty of cooperation enshrined in Article 6 of the Brazilian Civil Procedure Code. Cooperation in patent litigation transcends courtesy; it entails active judicial case management designed to reduce inefficiency, discourage procedural obstruction, and mitigate contradictory technical outcomes. In a system where consolidation is structurally unavailable, synchronization of expertise becomes the practical substitute for procedural unity.

From a business perspective, **early production of expert evidence is not a mere procedural refinement; it is a risk-control mechanism**. Patent disputes frequently carry operational, financial, and reputational consequences. When injunction pressure develops in one forum while validity remains technically undeveloped in another, **companies face uncertainty that extends well beyond litigation costs**.

**Anticipating expert evidence compresses this uncertainty window and provides a court-supervised technical record capable of informing licensing discussions, settlement strategy, product redesign decisions, and broader risk assessment**.

Moreover, coordinated expert appointment reduces the probability of divergent technical interpretations. Patent litigation is resource-intensive; fragmented expert analysis magnifies expense and unpredictability. A unified methodological framework, particularly one anchored in the BPTO's examination guidelines, strengthens analytical integrity and reinforces confidence in judicial outcomes.

Brazil's bifurcated patent litigation structure is unlikely to change. The strategic response, therefore, lies in procedural intelligence rather than institutional reform.

**The anticipation of expert evidence, coupled with cooperative expert coordination, transforms bifurcation from a source of imbalance into a manageable procedural architecture**. As illustrated by the 9<sup>th</sup> Federal Court's leading decision, **judicial willingness to prioritize effectiveness over rigid sequencing reflects a maturation of Brazilian patent litigation practice**.

In a system defined by jurisdictional separation, synchronization of expertise is emerging as the cornerstone of strategic equilibrium.

**Montaury Pimenta, Machado & Vieira de Mello** - Ana Paula Affonso Brito

Montaury Pimenta, Machado & Vieira de Mello is a Leading Brazilian Intellectual Property (IP) law firm, distinguished for its work in complex IP Litigation, IP Prosecution, and Enforcement. Click here to learn more about the firm <https://www.montaury.com.br/en/>