

Jamaica

Local pharmaceutical companies win temporary relief from Pfizer

Through a long-awaited ruling under Jamaica's archaic Patent Law of 1857, local pharmaceutical companies Medimpex Jamaica Limited and Lasco Distributors Limited emerged victors over pharmaceutical giant Pfizer Limited when judgment was handed down in their favour on July 29 2009.

What started out in 2002 as a simple quest by Pfizer to enforce its local patent in salts of amlodipine (amlodipine besylate) against Jamaican importers/distributors of the generic form of the drug turned into a major issue about the validity of Pfizer's Jamaican patent.

Medimpex and Lasco import and distribute the drugs Normodipine and Las Amlodipine, respectively, both of which contain amlodipine besylate and which compete against Pfizer's drug Norvasc, also containing amlodipine besylate. In March 2005 Pfizer was successful in its application for an interim injunction restraining these companies and another local distributor, Mac's Pharmaceuticals, from importing, selling, supplying and distributing Normodipine and Las Amlodipine in Jamaica. While Mac's Pharmaceuticals did not contest Pfizer's claim, Medimpex and Lasco challenged the claim and applied for a stay of the injunction, which was dismissed. This did not end the matter, as the substantive issues which would determine whether the court would grant a permanent injunction and award damages to Pfizer for infringement of its patent had to be fully aired at trial.

The central issue was whether the Jamaican patent in respect of which Pfizer was the assignee was valid based on the fact that Pfizer held a number of patented inventions for amlodipine besylate in different countries and at least one of those patents had expired before the Jamaican patent was granted.

Facts

Back in August 1992, further to instructions from Pfizer its Jamaican attorney at law filed a patent application for amlodipine besylate on its behalf. The attorney proceeded to file the application in his own name, which

is permissible under Section 3 of the Patent Act. This states that any person, being the true and first inventor of patentable subject matter in Jamaica, can – whether by himself or *in absentia* through his attorney – apply for a grant of letters patent in Jamaica. According to settled practice in Jamaica, the attorney, upon submitting the documents for filing, made a declaration pursuant to Section 7 of the Patent Act to the effect that the invention was communicated to him from abroad. Pfizer's local attorney also declared himself to be “the true and first inventor thereof” pursuant to Section 7 of the Patent Act, which states that “[b]efore any person shall obtain or receive any Letters Patent under this Act, such person, or if he be an absentee, his attorney, shall make statutory declaration, in writing, before a Justice in this Island, that he doth verily believe that he is the true inventor, or discoverer, of the art, machine, composition of matter, or improvement, for which he solicits Letters Patent”.

Letters patent were issued in January 2002, almost a decade after the Jamaican application was filed. On March 26 2002, shortly after the letters patent were duly recorded with the registrar, the attorney assigned the letters patent to Pfizer. The Jamaican patent was granted on January 22 2002 and, according to Section 3 of the Patent Act, would be in effect for a period of 14 years from the date of grant. Hence, on the face of it, Pfizer obtained a valid patent that would expire on January 22 2016.

However, Pfizer's Egyptian patent in amlodipine besylate expired on March 31 1997, almost five years before the grant of the Jamaican patent. The local distributors contended that by virtue of Section 29 of the Patent Act, Pfizer's Jamaican patent was not valid and they therefore needed no licence from Pfizer to distribute the drugs in Jamaica. However, Pfizer, argued that Section 29 did not apply.

The law

Section 29 of the Patent Act states that: “No applicant

shall be deprived of his right to a patent in this Island upon the like proceedings being had in all respects as in case of an original application for his invention by reason of his having previously taken out Letters Patent therefor in any other country.”

This is subject to the following three provisos:

- “(i) such invention shall not have been introduced into public and common use in this Island prior to the application for a patent therein;
- (ii) the patent granted in this Island shall not continue in force after the expiration of the patent granted elsewhere; and where more than one such patent or like privilege is obtained abroad, then immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges, the patents granted in this Island shall cease to be in force;
- (iii) no Letters Patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained elsewhere, and which shall be granted in this Island after the expiration of the term for which such patent or privilege was granted or was in force shall be of any validity.”

The inferences that can be drawn from a literal reading of Section 29 are as follows:

- A foreign patentee can obtain letters patent in Jamaica for its invention notwithstanding the fact that it already holds a patent for the same invention overseas.
- The invention must have been new to Jamaica, in that it must not have been introduced into public and common use in Jamaica before the Jamaican patent application is made.
- Once granted, the Jamaican patent will be valid only for the period that the foreign patent remains in force.
- If the invention is the subject of more than one foreign patent, then the Jamaican patent will expire upon the expiration or determination of the term of the first granted foreign patent.
- Any letters patent granted in Jamaica after the expiration of any such foreign patent will be deemed invalid.

Arguments

It was agreed that when the application was filed, amlodipine besylate was new to Jamaica. The court therefore focused on the following two issues:

- Was the local attorney the “true and first inventor” within the meaning of Section 3 of the Patent Act?

- Is the Jamaican patent granted to the local attorney and assigned to Pfizer valid and subsisting within the meaning of Section 29 of the Patent Act?

Counsel for the local distributors argued that although the local attorney described himself as the true and first inventor thereof, it was Pfizer and not the attorney that was in fact the true and first inventor. The attorney was in effect “the alter ego of the true and first inventor” and Section 3 created “a legal fiction merely to facilitate the application from the foreign inventor”. Counsel further argued that since patents owned abroad by Pfizer for the same invention had expired before that grant of the Jamaican patent, the Jamaican patent would be invalid by virtue of the third proviso under Section 29.

Counsel for Pfizer argued that the local attorney was the “true and first inventor” within the meaning of Section 3 of the act and therefore Section 29 would not apply as the applicant for the earlier foreign patent was different from the applicant of the Jamaican patent. They argued that the agent was the ‘discoverer’ of the invention and was to be treated as the true and first inventor who was entitled to apply for the patent in his own right. They further argued that the correct interpretation of the provisos should be governed by the commencing lines of Section 29. Counsel reasoned that it would follow that “it is only where the same Applicant has obtained the patent for the same invention elsewhere prior to his application in Jamaica, that the Jamaican patent will be limited in operation of time to the expiry of the earliest patent obtained by the Applicant elsewhere; or will be void if the patent obtained elsewhere had expired before the grant of patent in Jamaica”.

Decision

With a patent statute dating back to the mid-19th century and very little adjudication on the same, the presiding judge based his ruling on the interpretation of relevant sections of the statute by reference to the annals of English law as directed by Section 41 of the Patent Act. Section 41 provides that in case of doubt arising as regards construction, “the Act may be construed by analogy to the laws now or hereafter to be in force in England relating to the granting of Letters Patent for inventions, so far as the provisions of such laws shall be applicable”.

Relying on, among other references, the first edition of *Halsbury’s Laws of England* (1912), which states that the words ‘true and first inventor’ have always been construed to include ‘first and true importer’, Justice

“ It seems indisputable that the intent of Section 29 is to enable a foreigner to obtain a local patent even where that person already holds letters patent for the same invention abroad ”

Jones upheld the arguments of Pfizer’s counsel that the attorney was the first and true inventor within the meaning of Section 3 of the Patent Act.

The law considered by the judge as analogous and applicable to Section 29 of the Patent Act was the English Patent Law Amendment Act of 1852 and in particular Section 25, which states that where letters patent are granted in the United Kingdom for an invention which was first invented in a foreign country and was the subject of a patent or like privilege/ monopoly in that country before the UK grant, the UK patent would cease immediately on the expiration or other determination of the foreign patent or the first of such foreign patents to expire, “provided always that no Letters Patent for or in respect of any Invention for which any such Patent or like Privileges as aforesaid shall have been obtained in any Foreign Country and which shall be granted in the said United Kingdom after the Expiration of the Term for which such Patent or Privilege was granted or was in force shall be of any Validity”.

Holding that Section 25 of the UK act was the genesis of Section 29 of the Jamaican Patent Act of 1857, the judge considered that the opinion of Pfizer’s counsel was “untenable and leads down a slippery slope”, and that “its acceptance would be a mockery of the purpose and intent of the law governing patents”. Relying on *Daw v Eley* as to the purpose and objects of Section 25, Jones concluded that: “on a proper construction of Section 29 of the Jamaican Patent Act:

- Letters Patent can co-exist with Letters Patent issued in a foreign country where the invention is the same in both Jamaica and in the foreign country
- the Jamaican Patent for the invention should not continue in force or be valid if the foreign Patent for the invention has expired

- the second and third provisos to section 29 apply to Letters Patent obtained elsewhere in respect of any invention irrespective of who is the patentee or applicant for the foreign patent
- the third proviso makes it clear that a Jamaican patent is not valid and subsisting if granted after a patent for the same invention has expired elsewhere in the world.”

The judge held that Pfizer’s Jamaican patent was not valid and subsisting, as Egyptian letters patent for the same substance expired before the Jamaican letters patent was granted. Judgment was ordered in favour of the local distributors and an order was made for an inquiry as to the damages suffered by them further to the interim injunction granted to Pfizer.

Implications

Local distributors have much to celebrate, although Pfizer has filed an appeal which is scheduled for hearing in March 2010. The judgment has far-reaching implications for the pharmaceutical industry and, if upheld on appeal, could result in several local patents for foreign pharmaceutical companies being invalidated, consequently freeing up local distributors to market generics.

Questions may arise about the judge’s analysis of the proper construction of Section 29. The section, unlike Section 25 of the UK act, clearly focuses on the applicant not being deprived of its right to a Jamaican patent just because it had previously been granted a patent for its invention in another country. However, it seems indisputable that the intent of Section 29 is to enable a foreigner to obtain a local patent even where that person already holds letters patent for the same invention

abroad and, irrespective of whether the person holds either patent as the original applicant or an assignee, to ensure that the latter patent's existence and validity is dependent on the subsistence of the earlier patent.

Even if the appellate court were to place greater weight on the commencing lines of Section 29, it is questionable whether this would change the effect of lower court's ruling.



Dianne Daley
Partner
Tel +876 927 4371
Email daley@fogadaley.com
Foga Daley
Jamaica

Dianne Daley is Foga Daley's IP partner. She is a member of the International Association for the Advancement of Teaching and Research in Intellectual Property and the International Trademark Association and honorary secretary of the Jamaican Copyright Licensing Agency. Ms Daley holds an LLM in comparative law from McGill University and an LLB from the University of the West Indies (UWI) and has been an adjunct lecturer in IP law at UWI.



Nicole Foga
Partner
Tel +876 927 4371
Email foga@fogadaley.com
Foga Daley
Jamaica

Nicole Foga is Foga Daley's managing partner. Her practice areas include communications law, information technology and intellectual property. She holds an LLM in commercial law from Aberdeen University and an LLB and a BA from the University of the West Indies. Ms Foga chairs the Technology, Broadcasting and Telecommunications Committee of the Jamaican Bar Association and is a member of Jamaica's Copyright Tribunal and former general counsel of the Office of Utilities Regulation.