

IN THE SUPREME COURT OF JUDICATURE OF JAMAICA

IN THE CIVIL DIVISION

CLAIM NO. 2002 P040

BETWEEN	PFIZER LIMITED	CLAIMANT
AND	MEDIMPEX JAMAICA LIMITED	1 ST DEFENDANT
AND	NMF PHARMACEUTICALS LIMITED (Trading as Mac's Pharmaceuticals)	2 ND DEFENDANT
AND	LASCO DISTRIBUTORS LIMITED	3 RD DEFENDANT

Hillary Phillips Q.C and Denise Kitson instructed by Grant, Stewart and Phillips for the Claimant

Lloyd Barnett and Ian Robbins instructed by Tenn, Russell, Chin Sang and Hamilton for the 1st Defendant

Lloyd Barnett and Vincent Chen instructed by Chen and Green for the 3rd Defendant

Patent Act 1857-- Section 3--Whether local applicant" true and first inventor" on receiving a communication from abroad for invention or just agent of foreign inventor-- Section 29--Whether grant of Letters Patent for invention in Jamaica void because an expired overseas patent for same invention existed at time when Letters Patent granted in Jamaica—Whether section applies to inventor or invention.

Heard: April 28, 29, 2009 and July 29, 2009

JONES J:

INTRODUCTION

[1] To the victor, the spoils. This is a winner takes all legal battle between Pfizer Limited (reputedly the world's largest pharmaceutical company) Medimpex Jamaica Limited and Lasco Distributors, two local generic drug providers. Sometimes there need not be a loser, but that is not how the main contenders see it.

Pfizer Limited protest that the Defendants have infringed Letters Patent No. 3247. This patent was granted by the Governor General of Jamaica on the January 22, 2002, to Maurice Courtenay Robinson and assigned to them for the protection of the invention "Salts of Amlodipine / Amlodipine Besylate".

[2] Pfizer Limited manufactures, sells and distributes "Norvasc" in Jamaica, which contains Salts of Amlodipine / Amlodipine Besylate. Pfizer Limited filed an action in this court in 2005 against Medimpex Jamaica Limited, NMF Pharmaceuticals Limited and Lasco Distributors Limited for infringement of Letters Patent No. 3247. One of the Defendants, NMF Pharmaceuticals has not challenged Pfizer's claim.

[3] Medimpex imported, sold and distributed into Jamaica "Normodipine" which contains Amlodipine Besylate. Lasco Distributors imported, sold and distributed "Las Amlodipine" which also contains Amlodipine Besylate. There is no dispute that neither Medimpex nor Lasco Distributors has a licence or any form of permission from Pfizer Limited to deal in Salts of Amlodipine / Amlodipine Besylate

[4] Medimpex Jamaica Limited and Lasco Distributors complained bitterly of Pfizer's highhanded and intimidatory behaviour in pursuing an infringement claim (treble times the actual loss for unlawful use

of the patented product) against them. Metaphorically, Pfizer Limited lined up the local distributors of Salts of Amlodipine/Amlodipine Besylate and fired a shot. The rest of the local distributors cowered at the other end of the line.

[5] Apart from Pfizer's intimidatory behaviour, they complain that Maurice C. Robinson is not the true and first inventor of "Salts of Amlodipine" and that when he obtained Letters Patent for the substance in Jamaica, the patent had expired in several foreign countries and therefore has no legal effect in Jamaica. .

ISSUES

[6] From the din of battle between Pfizer Limited, Medimpex Jamaica Limited and Lasco Distributors, two hotly contested issues emerge:

- a) **True and First inventor or Agent?** - Section 3 of the Patent Act allows any person, or in his absence, his attorney, to apply for a patent for a new invention not known before in Jamaica. Maurice C. Robinson, an attorney-at-law resident in Jamaica, applied for a new invention "SALTS OF AMLODIPINE" which was communicated to him from abroad by PFIZER LIMITED in Great Britain, as "the true and first inventor". Did Maurice C. Robinson obtain Letters Patent in Jamaica as attorney for Pfizer or as the "true and first inventor" within the meaning of Section 3 of the Patent Act?

b) **Prior Expired Overseas Patent** - Section 29 of the Patent Act

allows an applicant for a patent in Jamaica to simultaneously have an unexpired patent for the same invention abroad.

Maurice C. Robinson was granted Letters Patent in Jamaica on January 22, 2002, for "SALTS OF AMLODIPINE" and subsequently assigned all his rights and interests to Pfizer Limited of Ramsgate England on March 22, 2002. Pfizer Limited had previously obtained Letters Patent for "SALTS OF AMLODIPINE" in Egypt on March 31, 1987, which expired on March 30, 1997, five years prior to the grant of the Jamaican Patent. Is Jamaican Patent No. 3247 granted to Maurice C. Robinson and assigned to Pfizer Limited valid and subsisting within the meaning of Section 29 of the Patent Act?

AGREED FACTS

[7] Pfizer Limited is a company incorporated in and resident in England.

Medimpex Jamaica Limited and Lasco Distributors are companies registered and resident in Jamaica. Pfizer Limited obtained Letters Patent in a number of countries outside of Jamaica for Salts of Amlodipine / Amlodipine Besylate. In particular, Letters Patent No. 18266 was granted to Pfizer Limited in Egypt on March 31, 1987, for a period of ten years. This patent expired on March 30, 1997, prior to the grant of the Jamaican patent.

[8] Maurice C. Robinson, an attorney-at-law, resident and practising in Jamaica applied to the Governor-General on August 18, 1992, under Section 3 of the Patent Act that he:

"is in possession of an invention of SALTS OF AMLODIPINE which invention he believes will be of great public utility; and that the said invention has been communicated to him from abroad by PFIZER LIMITED of Ramsgate Road, Sandwich, Kent, O-13, 9NJ, Great Britain, and that he is the true and first inventor thereof and that the same is not in use by any other person or persons to the best of his knowledge and belief".

[9] It is common ground between the parties to this action that:

- a) obtaining Letters Patent in Jamaica for inventions by way of communication from an overseas inventor is a settled practice in Jamaica.
- b) the invention of Salts of Amlodipine in the Letters Patent granted to Maurice C. Robinson had not been known or introduced into public and common use in Jamaica prior to the application.

[10] Some ten years passed since the application for the patent was made. No reason was provided to this court for this lengthy delay. However, on January 22, 2002, the Governor-General of Jamaica granted Letters Patent No. 3247 to Maurice C. Robinson as the "true and first inventor" of "Salts of Amlodipine".

[11] On March 12, 2002, Maurice C. Robinson filed the grant with the Registrar of Companies and on March 26, 2002, he assigned all his

rights and interest in the Letters Patent to the person who communicated the invention to him, namely, Pfizer Limited of Ramsgate Road, Sandwich, Kent, O-13, 9NJ, Great Britain.

[12] Pfizer Limited manufactures sells and distributes in Jamaica a drug by the name of "Norvasc". This contains Salts of Amlodipine / Amlodipine Besylate. Medimpex Limited imports and sells in Jamaica "Normodipine" which contains Amlodipine Besylate and Lasco Distributors imports and sells in Jamaica "Las Amlodipine" which also contains Amlodipine Besylate. Medimpex Limited and Lasco Distributors admit that they have no licence or any form of permission from Pfizer Limited to import or sell Salts of Amlodipine /Amlodipine Besylate in Jamaica. They say that none is required as the patent granted to Pfizer Limited is not valid by virtue of Section 29 of the Patent Act.

BACKGROUND TO THE PATENT ACT 1857

[13] The first record of an invention in England was issued by King Edward III in favour of an alleged discovery of the "philosopher's stone". It is said that the King took the view that he was entitled as part of his prerogative to grant monopolies to anyone whom he approved of.

[14] History records that these monopolies were granted in abundance; they also became harsh and oppressive; and after

much public protest, King James the first of England withdrew all existing monopolies and decreed that they were only to be used for "projects of new invention". This decree was incorporated into the Statute of Monopolies in which the English Parliament provided a special exception to monopolies for the:

"sole working or making of any manner of new manufactures within the realm to the true and first inventor and inventors of such manufactures which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law or mischievous to the state by raising prices of commodities at home or hurt of trade or generally inconvenient"

[15] For well over five hundred years this single condition has remained as the cornerstone of the entire law of Letters Patent for inventions. In Jamaica, the Patent Act was passed in 1857 with the provision in Section 2 that:

"invention", "discovery" and "improvement" respectively shall mean any manner of new manufacture or new mode of manufacture the subject of Letters Patent and grant of privilege within the meaning of the United Kingdom Act of the twenty-first year of the reign of King James the First, chapter three;"

[16] In lieu of an interpretation section in the Patent Act 1857, the Jamaican Parliament provided by Section 41 the key for its interpretation. It says that:

"If any doubts shall arise in the construction of this Act, the same 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"

[17] This court is grateful to Counsel for Pfizer, Medimpex and Lasco Distributors for their archive hunting and the cogency of their arguments during the presentation of this case. Their arguments and submissions were as clear as a mountain stream and with the same tumbling energy.

Issue One:

Did Maurice C. Robinson obtain Letters Patent as attorney for Pfizer or as the "true and first inventor" within the meaning of Section 3 of the Patent Act?

[18] Section 3 of the Patent Act provides that:

"Whenever any person whosoever shall, by himself, or if he be an absentee, by his attorney, apply to the Governor-General, by way of petition, alleging that he hath invented or discovered some new and useful art, machine, manufacture, or composition of matter, not heretofore known or used within this Island, or some improvement in any such invention or discovery, and praying to obtain an exclusive property in such new invention and discovery or improvement, and that Letters Patent be granted for the same, it shall be lawful for the Governor-General, in the name of and on behalf of Her Majesty, to direct Letters Patent, under the Broad Seal of this Island, to be issued... and thereupon shall grant to such person so applying for the same, his executors, and administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, and using, and vending to others to be used, the said new invention or discovery or improvement"

[19] Dr Barnett and Ian Robbins (hereinafter called Counsel for Medimpex Limited) and Dr Barnett and Vincent Chen hereinafter called (Counsel for Lasco Distributors) raised two arguments before this court. First, they contend that on a strict textual reading of Section 3 of the Patent Act, Maurice C. Robinson is not the "true and

first inventor" of Salts of Amlodipine in Jamaica, as the invention was communicated to him by Pfizer Limited from abroad. Counsel for both Medimpex Limited and Lasco Distributors contend that Section 3 of the Patent Act allows an absentee person to apply by "his attorney" for the grant of Letters Patent in Jamaica. This application, they say, is for a foreign inventor who has no Jamaican address as required by Section 4. Section 3, they argue creates a legal fiction merely to facilitate the application from the foreign inventor.

[20] Counsel for both Medimpex Limited and Lasco Distributors also contend that the Jamaican Patent Act could not intend that the attorney should make a false declaration that he is the "true and first inventor" when he is just an agent. In sum, at the core, the argument is that Maurice C. Robinson was the "alter ego" of the "true and first inventor", Pfizer Limited.

[21] In support of this argument, the court was referred to **Stroud's Judicial Dictionary (3rd ed.) Vol. 1, p. 235** which states that:

"Attorney' is an ancient English word, and signifieth one that is set in the turne, stead, or place of another; and of these some be private (whereof our author here speaketh, Litt. S. 66), and some be publike, as attorneys at law, whose warrant from his master is, *ponit loco suo falem attornatum suum*, which setteth in his turne or place such a man to be his attorney" (Co. Litt. 51b).

- [22] Support was also sought by reference to the **Shorter Oxford English Dictionary (3rd ed.)** which defines attorney as "one appointed to act for another; an agent, deputy, commissioner".
- [23] The second argument raised by Counsel for both Medimpex Limited and Lasco Distributors is that Section 8 of the Patent Act requires the inventor or his attorney to provide specifications of the invention sufficient to allow persons skilled in the art to make the product. They contend that this can only make sense if the specifications were to be provided by the "true and first inventor" and not his attorney.
- [24] The court is not persuaded by these arguments. First, Pfizer Limited has not claimed that Maurice C. Robinson was the original inventor of Amlodipine Besylate. What they have said is that he is the "true and first inventor" in Jamaica.
- [25] Section 3 of the Patent Act makes it clear that one may apply for a patent if he invented or discovered an invention that was "not heretofore known or used in this Island". On the other hand, what is not so clear is whether or not the invention may have been known elsewhere in the world or first discovered by another person outside of Jamaica.
- [26] Section 7 of the Patent Act requires the applicant to make a declaration that he is the "true and first inventor" of the patented

product which to the best of his knowledge or belief has not been known or used in Jamaica. Section 8 of the Act requires the applicant to provide Specifications –to be lodged with the Declaration – providing a written description of the invention. These two sections of the Act do not answer the question raised. For this, we have to go to Section 41 of the Act which allows us to construe the Act "by analogy to the law now or hereafter to be in force in England relating to the granting of Letters Patent for inventions". In order to do this, I must first examine the early common law cases at the time of the first grants of Letters Patent in England.

[27] So we begin with the **Cloth Workers of Ipswich Case (1615) 78 ER 147** where the common law recognized the right to an invention communicated from abroad. In that case the following passage appears:

"But if a man hath brought in a new invention and a new trade within the kingdom, in peril of his life, and consumption of his estate or stock &c, or if a man hath made a new discovery of anything, in such cases the King, of his grace and favour in recompense of his costs and travail, may grant by charter unto him, that he only shall use such a trade or trafique for a certain time; because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired the King cannot make a new grant thereof"

[28] In the case of **Edgeberry v Stephens(1691)2 Saikeld [447]**at page 387 the following summary appears:

"A grant of a monopoly may be to the first inventor by the 21 Jac. 1; and if the invention be new in England, a patent may be granted, though the thing was practised beyond sea before; for the statute speaks of new manufactures within this realm; so that if they be new here, it is within the statute; for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study, it is the same thing".

[29] The learned authors of the 1st edition of **Halsbury's Laws of England (1912)** at paragraph 279 sums up the state of the law regarding the "true and first inventor" in the following passage:

"The fact that an invention has been communicated to a person by another within this realm is a fatal objection to the grant of a patent to that person as true and first inventor. But the matter is otherwise if the communication is made without the realm and the person so receiving it is the first to import the invention into the realm. At common law he who is in peril of his life and consumption of his estate or stock, brought in a new invention ... within the kingdom was equally entitled to a patent with him who had made a new discovery of anything... the words true and first inventor has always been construed to include "first and true importer".

[30] In **Beard v Edgerton et al (1846)136 ER 39** the court took the view that the applicant for the patent need not be a meritorious importer; he may be merely the clerk or agent to whom the communication was made for any special purpose by the foreign inventor, and as trustee for him for the purpose of enabling him to take out the patent for the benefit of the foreigner. Chief Justice Tindal in delivering the judgment of the Court (in a rather long passage that I will quote in extenso) said at page 127:

"The fifth plea states, in substance, that, before the granting of the letters-patent, one Daguerre had invented

the new and improved method which was the subject of the letters-patent, and that he and one Niepce, before and at the time of granting the same, had knowledge of, and practised the said invention in France; that Daguerre and Niepce were aliens born out of the allegiance of the Queen, and were at the time resident and domiciled in France; that they retained and employed Miles Berry, as their agent, to procure the letters-patent to be granted to him in his own name, but upon trust for their use and benefit, and not for himself; and that he accepted such retainer. The plea then goes on to state, that, to enable him to obtain such letters-patent, they communicated to him the nature and particulars of the said invention, and he thereupon introduced the knowledge of the invention into the United Kingdom, and was the first person who brought it there; and the plea then alleges "that Miles Berry was no otherwise than as aforesaid the true and first inventor of the said invention in the said declaration mentioned." It then states that Berry, being a subject of our Lady the Queen, under such retainer, obtained the letters-patent to be granted to him upon trust for Daguerre and Niepce, so being aliens and resident and domiciled as aforesaid, and not for the use or benefit of himself, and, until the making of the assignment to the plaintiff, had so always held them; "wherefore," the plea concludes, "the letters-patent are void."

The plaintiff demurred specially to this plea; but we think it unnecessary to advert to the causes assigned by him for demurrer, as we think the plea bad in substance. The defendants contended, that, upon the facts disclosed in this plea, the letters-patent are void, upon one of two grounds, viz. either that Berry was not the true and first inventor within the meaning of the statute of James; or that a patent taken out in England by an Englishman in his own name, in trust for foreigners residing abroad, is void in law.

As to the first objection, it was not denied, on the part of the defendants, that a person who has learned an invention abroad, and imported it into this country, where it was not used or known before, is the first and true inventor within the statute. The cases decided before the statute proves that grants by the crown to persons who have brought any new trade into the realm, were good at common law: see the case of Monopolies (*Darcy v. Allen*, Noy. Rep. 178, 11 Co. Rep. 84), and the case of The

Clothworkers of Ipswich (Godbolt, 252). And the exception contained in the 6th section of the statute, in favour of grants of privilege for the sole working of any new manufacture within the realm, was made in affirmance of the common law, introducing no other alteration than the restriction in point of time for which such grants might extend. And, further, the case of *Edgeberry v. Stephens*, which was decided long after the statute was passed, is an express authority that the statute "intended to encourage new devices useful to the kingdom; and, whether learned by travel or by study, is the same thing."

But the argument on the part of the defendants has been, that Berry was not a person who imported this invention into England, within the meaning of the statute. It was argued, that, to come within the statute, the person who takes out the patent should be the meritorious importer, not a mere clerk or servant or agent, to whom the communication was made for any special purpose, by the foreign inventor, as, for the purpose of enabling him to take out the patent for the benefit of such foreigner. No authority is cited for such distinction. So far as the public are concerned in interest, no such distinction is necessary. Berry is an Englishman, to whom the invention is communicated by a foreigner residing abroad; and Berry first brings the invention into England, and makes it public there. So far, therefore, as relates to the interest of the public, Berry has all the merit of the first inventor. If he has been guilty of any breach of faith in his mode of obtaining the communication, or in the mode of using it in English, he may or may not be made responsible to his employers abroad; but such misconduct seems to have no bearing upon the question, - as between him and a stranger [FN9]. - whether the patent is void or valid. Indeed, it appears upon the plea itself that no fraud was committed upon his employers; for, it is expressly stated in the plea, that he was directed to take out the patent in his own name, in trust for them, and that in fact he had so done, and had held it for a certain time for their benefit. "

- [31] More recently (in the early twentieth century) it was held that the circumstances under which the invention was communicated abroad by an inventor will not be enquired into: see **Pilkington v**

Yeakley Vacuum Hammer Co. (1901) 18 RPC 459 and In the Matter of Jameson's Patent (1902) RPD 246

[32] The custom and practice of eminent Patent practitioners at the time of the passing of the Patent Act 1857 can be of considerable assistance in its interpretation. Lord Denning said "in such a matter as this, when Parliament has given no guidance, we can do no better than look at the reputation of the concern amongst intelligent men of commerce": see **United Dominions Trust Limited v Kirkwood [1966] 2 Q.B 431 at 454**. David Fulton in his insightful work on a **Practical Treatise on Patents Trade Marks and Designs, With a Digest of Colonial and Foreign Patent Laws The Text of the Patents, Designs and Trade Mark Acts 1883 to 1888 (Consolidated)** provides the following note at Pages 211-212 – under section dealing with Foreign and Colonial Patents and referring to (Jamaica) Law 15 of 27th May 1891. He says:

"Patentee – The intention of the Act is evidently to confine the grant of letters patent to the true and first inventor or his authorised attorney. But with the widening of the meaning of the term "inventor" it is the custom for assignees and first importers to apply for patents of which they are in no sense the authors. There is however no decision to the effect that letters patent so granted are invalid."

[33] By way of analogy to the laws governing Letters Patent in England, this court has no doubt that the English common law and practice at the time when the Jamaican Patent Act 1857 was

passed, recognized the existence of the right to an invention communicated from abroad. This practice is settled with extensive usage in Jamaica. In this case, the Petition and Declaration submitted by Maurice C. Robinson makes it clear that his application for a grant of Letters Patent was based on the possession of an invention communicated to him from abroad by Pfizer Limited of Ramsgate England.

[34] Consequently, on a construction of Section 3 of the Patent Act, this court concludes as a matter of law that Maurice C. Robinson was the "true and first inventor" of Salts of Amlodipine/Amlodipine Besylate in Jamaica. Accordingly, he was fully permitted to make the statutory declaration under Section 7 and to provide the specifications under Section 8 of the Jamaican Patent Act 1857.

Issue Two:

Is Jamaican Patent No. 3247 granted to Maurice C. Robinson and assigned to Pfizer Limited valid and subsisting within the meaning of Section 29 of the Patent Act?

[35] Section 29 of the Patent Act provides 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:

Provided, that such invention shall not have been introduced into public and common use in this Island prior to the application for a patent therein; and that the patent granted in this Island shall not continue in force

after the expiration of the patent granted elsewhere; and that 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:

Provided further, that 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".

[36] Miss Phillips Q.C (hereinafter called Counsel for Pfizer Limited)

contends that Letters Patent No. 3247 for the Besylate Salt of Amlodipine in Jamaica granted to Maurice C. Robinson is still valid and subsisting. She makes this argument while conceding that Letters Patent for the same invention have expired elsewhere in the world prior to the grant of the Jamaican patent. Her central thesis is that Maurice C. Robinson, the Applicant for the Letters Patent in Jamaica, had not applied for Letters Patent in any other country.

[37] She asserts that Section 29 of the Jamaican Patent Act refers to foreign patents obtained by the same Applicant as in Jamaica. In other words, the Jamaican Letters Patent can co-exist with Letters Patent issued in a foreign country where the applicant is the same in both Jamaica and in the foreign country. Where the applicant in Jamaica and the foreign country are different, the various provisos to Section 29 cannot apply. She argues that the provisos must be construed in relation to the "applicant". In addition, the last proviso

to Section 29 refers to "such patent" which she contends means the patent taken out in the foreign country by the Applicant. Indeed, the learned authors of **Cross on Statutory Interpretation** make the point that "a proviso is frequently not an aid to construction, although the terms of the provision to which it is a proviso are usually of considerable aid to its construction: See **Cross on Statutory Interpretation, 3rd Edition page 121.**

[38] Counsel for Pfizer Limited argues that Section 25 of the English Patent Law Amendment is not similar to Section 29 of the Jamaican Patent Act as it emphasises similarity of invention, while the Jamaican Act emphasises similarity of applicant. Here, her arguments are well-rehearsed and finely honed. She points out that once a Patent for a foreign invention has expired outside of the United Kingdom, the UK Patent to that invention is invalid. This, she says, is not the position in Jamaica.

[39] Counsel for Pfizer Limited, makes the point that a challenge to Letters Patent granted in Jamaica cannot be made by placing reliance on cases and statutory provisions which are not similar to the Jamaican Patent Act. She makes reference to Lord Neuberger's reference in **Generics UK Limited [2009] UKHL Civ 311** to Lord Walkers observation in **Synthon BV v SmithKline Beecham plc [2005] UKHL 59** that "the law of patents is wholly statutory...it is salutary to be reminded, from time to time, that the general

concepts which are the common currency of patent lawyers are founded on a statutory text, and cannot have any other firm foundation."

[40] I wholeheartedly agree. It is with that in mind that we look at the legislative framework governing the grant of Letters Patent in Jamaica.

[41] The Jamaican Patent Act was passed in 1857. At the time of its passing, Section 25 of the English Patent Law Amendment Act 1852 (15 & 16 Vic. Cap 83) was in existence. This Act of the UK Parliament was, in my view, clearly contemplated by Section 41 of the Jamaican Patent Act as the law being "in force in England relating to the granting of Letters Patent for inventions" and therefore relevant to its interpretation. Section 25 of the English Act is as follows:

"xxv.. Where, upon any Application made after the passing of this Act, Letters Patent are granted In the United Kingdom for or in respect of any Invention first invented In any Foreign Country or by the Subject of any Foreign Power or State. and a Patent or like Privilege for the Monopoly or exclusive Use or Exercise of such Invention in any Foreign Country is there obtained before the Grant of such Letters Patent In the United Kingdom. all Rights and Privileges under such Letters Patent shall (notwithstanding any Term in such Letters Patent limited) cease and be void Immediately upon the Expiration or other Determination of the Term during which the Patent or like Privilege obtained in such Foreign Country shall continue in force. or where more than One such Patent or like Privilege is r obtained abroad, Immediately upon the Expiration Determination of the Term which shall first expire or be determined of such

several Patents or like Privileges:. 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"

[42] Facing a frontal attack by Counsel for Pfizer Limited on the construction of Section 29 of the Patent Act, Counsel for both Medimpex Limited and Lasco Distributors took a pragmatic approach. They assert that the provisions of section 29 would be nonsense if interpreted in the way suggested by Counsel for Pfizer Limited. For example, they argue, it would mean in effect that the section could be avoided by having an agent make an application for the foreign inventor. They contend that neither a literal nor purposive interpretation of the Act should allow for such an incongruous interpretation.

[43] This court is clearly of the opinion that the interpretation urged by Counsel for Pfizer Limited in relation to Section 29 of the Patent Act is untenable and leads down a slippery slope. Its acceptance would be a mockery of the purpose and intendment of the law governing patents, from the exception to the Statute of Monopolies, the exception to the exception, to the Jamaican Patent Act 1857. The original purpose of patent protection was to secure adequate returns for inventive endeavour in exchange for disclosure of the invention.

[44] Lord Oliver of Aylmerton in **Asahi Kasei Kogyo KK's Application [1991] RPC 485** provides us with the modern justification for patent protection in the following passage:

"The underlying purpose of the patent system is the encouragement of improvements and innovation. In return for making known his improvement to the public the inventor receives the benefit of a period of monopoly during which he becomes entitled to prevent others from performing his invention except by his licence".

[45] On the interpretation urged by Counsel for Pfizer Limited the "true and first inventor" of an invention or their assigns would be able to obtain patent protection for an invention in each country one after the other without regard for the expiration of the patent for the same invention in another country. By this means the "true and first inventor" or its assigns could cumulatively maintain the benefit of patent protection for an unlimited period worldwide for a single invention.

[46] The benefits flowing from patent protection (monopoly) in such circumstances would be far beyond an adequate return on investment, and beyond what is necessary for the "encouragement of improvements and innovation", which after all, is the rationale of patent protection. Such a lucrative return for a single invention would surely make "Croesus" blush.

[47] More to the point, though, this court takes the view that **Section 25 of the Patent Act 1852 (15 & 16 Vict. C. 83)**, is the genesis of

Section 29 of the Jamaican Patent Act 1857. The English Patent Act 1852 section 25 refers to the "application" while the Jamaican Patent Act 1857 section 29 refers to the "applicant". The proviso to section 25 of the English Patent Act 1852 is in the same terms as the last proviso to the Jamaican Patent Act 1857.

[48] For a proper purposive understanding of Section 29 of the Jamaican Patent Act 1857 it is of enormous assistance to examine the underlying objectives of section 25 of the English Patent Act 1852. In **Daw v. Eley (1867) L.R. Eq. 496**, Vice-Chancellor Sir W. Page Wood in delivering the judgment of the court described with uncanny perceptiveness the purpose and objects of **Section 25 of the Patent Act 1852 (15 & 16 Vict. C. 83)**. The following passage is taken from the judgment:

"Now, in looking at sect. 25, one sees at once that the object was to prevent the subjects of this kingdom from being fettered in their right to compete with each other in the production and manufacture of different articles, when it was open to foreigners to enter into such competition without being fettered by any exclusive rights claimed by an inventor and patentee, or by the additional price which must be imposed upon the article in consequence of the patent right. The object, I say, is to prevent the English manufacturer from being fettered while the foreigner remains free. The provision was, singularly enough, not pursued to its proper logical consequence in the Act, which only deals with the case in which a foreign patent has been granted and determined; whereas if no foreign patent has ever been granted any number of foreigners may be manufacturing the article abroad, while English manufacturers might be exposed, by the existence of a patent in this country, to the very difficulty from which this section professed to

relieve them. It does undoubtedly appear very harsh to prevent the English manufacturer from having the benefit of manufacturing that which all the rest of the world can manufacture at their pleasure, and yet to say that if it is protected for a certain limited time abroad, then, and then only, when that protection has ceased shall the English manufacturer become free."

[49] In addition to **Daw v Eley**, WP Thompson a noted English Patent

Agent in a **Handbook of Patent Law of all Countries 18th Edition**

(1920) outlined the customary patent practice and usage in

Jamaica some fifty years after the passing of the Jamaican Patent

Act 1857. This passage appears at page 107:

"Jamaica with Turks and Caicos Islands – Referring to Act 30 of 1857, Patents Law 15 of 1891 and Amendment of 1901 - Patents are granted for fourteen, and if considered expedient, twenty-one years, but limited by the duration of any prior foreign patent for the same invention, to the true and first inventor or his assigns, of an invention not hitherto known or used in the islands"

[50] The learned author David Fulton (already cited) confirms the

settled practice with regard to the expiry of foreign patents in

Jamaica. The following passage appears at **Pages 211-212 – under**

the section dealing with Foreign and Colonial Patents(Jamaica) Law

15 of 27th May 1891:

"Duration of Patent – Patents are granted for fourteen years and when prior foreign patents exist the patent in Jamaica expires with the foreign patent having the shortest term. As in the case of the United States and most other countries a valid patent cannot be obtained for an invention the foreign patent for which has expired. Patents of Addition are granted, which expire with the original patent"

[51] In my judgment, 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 invention is the same in both Jamaica and in the foreign country. Second, the Jamaican Patent for the invention should not continue in force or be valid if the foreign Patent for the invention has expired. Third, 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. Fourth, 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.

[52] This court concluded that the case for Pfizer Limited for an infringement of Jamaican Patent No. 3247 fails for the reason that Letter of Patent No. 3247 issued in Jamaica in respect to Salts of Amlodipine/ Amlodipine Besylate to Maurice C Robinson is not valid and subsisting. The reason that it is not valid and subsisting is that Letter of Patent 18266 for the same substance Salts of Amlodopine/ Amlodipine Besylate filed in Egypt on March 31, 1987, expired on March 31, 1997, prior to the grant of Letter Patent 3247 for Salts of Amlodipine/ Amlodipine Besylate in Jamaica on January 22, 2002. This was subsequently assigned to the Claimant Pfizer Limited on March 22, 2002.

[53] Thus, on April 29, 2009, for all the above reasons, this court refused the applications for declarations, a permanent injunction and other orders sought by Pfizer Limited in respect to Medimpex Limited and Lasco Distributors and gave judgment for Medimpex Limited and Lasco Distributors with costs to be agreed or taxed. At the time of the judgment the court also ordered an enquiry as to the damages suffered by Medimpex Limited and Lasco Distributors as a result of the interlocutory injunction granted to Pfizer Limited under their undertaking in damages.