

JAMAICA

IN THE COURT OF APPEAL

SUPREME COURT CIVIL APPEAL NO 56/2009

**BEFORE: THE HON MR JUSTICE PANTON P
THE HON MR JUSTICE HARRISON JA
THE HON MR JUSTICE DUKHARAN JA**

BETWEEN	PFIZER LIMITED	APPELLANT
AND	MEDIMPEX JAMAICA LIMITED	1ST RESPONDENT
AND	NMF PHARMACEUTICALS LIMITED	2ND RESPONDENT
AND	LASCO DISTRIBUTORS LIMITED	3RD RESPONDENT

Mrs Denise Kitson and Mrs Suzanne Ridsen-Foster instructed by Grant Stewart Phillips & Co for the appellant

Dr Lloyd Barnett and Ian Robins instructed by Tenn Russell Chin Sang Hamilton & Ramsay for the 1st respondent

Vincent Chen and Leonard Green instructed by Chen Green & Co for the 3rd respondent

3 and 4 March 2010 and 31 May 2012

PANTON P

[1] The notice and counter-notices of appeal herein indicate the involvement of three respondents. However, that is not so because the 2nd respondent was not represented at the trial or at the hearing before us. The formal order indicates that

after a hearing on 27, 28 and 30 April 2009, Jones J dismissed the appellant's claim and gave judgment in favour of the 1st and 3rd respondents. In so doing, he refused the appellant's application for certain declarations as well as for injunctions in respect of the respondents' use of a patented product known as besylate salt of amlodipine (amlodipine besylate). The learned judge gave answers to two agreed issues that were placed before him for determination. The appellant is aggrieved by one of those answers, hence the appeal. The respondents are not pleased with the other answer and so they filed counter-notice of appeal that are in identical terms.

The claim

[2] The appellant is a manufacturer and exporter of pharmaceutical products. On 22 January 2002, letters patent no. 3247 were sealed and granted to Maurice Courtenay Robinson in respect of an invention for besylate salt of amlodipine and pharmaceutical compositions thereof. On 26 March 2002, the right, title and interest in the invention and the letters patent were assigned and transferred to the appellant by Mr Robinson. The appellant duly recorded the assignment in the office of the Registrar of Companies. According to the appellant, the patent is valid and subsisting and expires on 22 January 2016.

[3] In an amended statement of claim filed on 1 September 2003, the appellant alleged that the respondents had infringed the patent, and so sought declarations to that effect as well as injunctions to restrain the respondents, their directors, officers, employees, servants or agents from further infringement. The appellant also sought an

order for the destruction of any product into which the patented product had been incorporated, and an inquiry as to damages payable for the infringement.

[4] The infringement complained of was that the respondents had been importing into Jamaica and selling, supplying and distributing to pharmacies in Jamaica drugs which have, as an active ingredient in them the patented product. In the case of the 1st and 2nd respondents, the drug being imported is known as normodipine whereas in the case of the 3rd respondent, the drug is known as las amlodipine.

The defence

[5] The 1st and 3rd respondents denied that the appellant had a valid and subsisting patent. They said that at all material times the letters patent had been invalid as they had expired on 31 March 1997. They further said that the process of production, and use of the said salt of amlodipine was published in journals and made available for public and common use in Jamaica from October 1986.

[6] The respondents denied that amlodipine besylate is the subject of the appellant's patent. In the case of the 1st respondent, it said that normodipine varies significantly in its composition from the product specifications set out in the appellant's application for letters patent. In the case of the 3rd respondent, it said that las amlodipine varies significantly in its composition from the product specifications set out in the appellant's application for letters patent therefor. Both respondents asserted alternatively that the patent was neither an invention nor a new invention within the meaning of the Patent Act.

The reply

[7] In its reply, the appellant said that the expiration of patents elsewhere in the world does not affect the validity of letters patent no. 3247. It denied that the publication in 1986 was such as would place within the public knowledge sufficient details on the manufacturing process of amlodipine besylate. It also said that there was no difference between normodipine or las amlodipine and the product covered by the specifications annexed to letters patent no. 3247.

The evidence

[8] Witness statements were recorded from the following persons:

- Laszlo Bakon, managing director of the 1st respondent;
- Janice Gordon, financial controller of the 1st respondent;
- Lester Woolery, pharmacist and director of the 3rd respondent in charge of pharmaceutical products and medical devices;
- Geta Mae O'Sullivan, general manager of the 3rd respondent;
- Ronald Camps, regional sales manager of Pfizer Caribbean which along with the appellant are wholly owned subsidiaries of Pfizer Inc.; and
- Maurice Courtenay Robinson, the assignor of the invention.

[9] Maurice Robinson, in a witness statement, said that he is an attorney-at-law admitted to practice in Jamaica in 1959. For many years, he said, his principal area of practice has been in the field of intellectual property with his specialty being the

registering of trademarks and letters patent. In August 1992, he petitioned the Governor-General for letters patent in respect of an invention for salt of amlodipine. He declared that he was the first and true inventor of the salt of amlodipine which he believed to be of great public utility and which was communicated to him from abroad. Having been granted the letters patent, he assigned and conveyed all his right, title and interest in the invention to the appellant for a consideration of \$2.00.

[10] In their witness statements, Mr Laszlo Bakon and Mr Lester Woolery said that the process of production, and use of amlodipine besylate or salt of amlodipine was published in journals and made available for public and common use in Jamaica as early as October 1986 and prior to the application in Jamaica for grant of letters patent (pages 265 and 281 respectively of the record). Notwithstanding this, but in keeping with the appellant's reply, the parties, in an agreed statement of facts, said that prior to the application for the grant of the said letters patent no. 3247, this invention had not been known or introduced into public and common use in Jamaica.

[11] According to records produced by Miss Janice Gordon, the 1st respondent had total sales of its product normodipine amounting to approximately \$45.2m for the period 2001 to 2005. Mr Woolery, in his witness statement, said that las amlodipine was made available by the 3rd respondent to "the poor people of Jamaica" at an affordable price for the treatment of various hypertensive illnesses. Total sales of that product amounted to approximately J\$24,300,000.00 for the period May 2002 to December 2005. The difference in revenue earnings (and presumably product cost) in respect of the respondents' products is glaring when compared with the sales of the

appellant's product, known as norvasc. Mr Ronald Camps, stated that in 2001 the appellant's revenues from the product in Jamaica amounted to US\$1,200,000.00. After the introduction of the "infringing products", that is, those imported and sold by the respondents, revenue fell to US\$481,000.00 in 2002. However, sales rose to US\$517,000.00 in 2003 and to US\$614,000.00 in 2004. In 2005 after the grant of the injunction against the respondents, the appellant's revenue increased to US\$1,100,000.00 then to US\$2,400,000.00 in 2006, US\$2,500,000.00 in 2007 and decreased slightly to US\$2,200,000.00 in 2008.

[12] Earlier, reference was made to the fact that the parties agreed a statement of facts. It was agreed that the appellant is registered and resident in England while the respondents are registered and resident in Jamaica. It was also agreed that Mr Maurice Robinson, an attorney-at-law, resident and practising in Jamaica, had applied to the Governor-General for letters patent stating that he was in possession of an invention of salt of amlodipine, which invention he believed would be of great public utility, that the said invention had been communicated to him from abroad by Pfizer Limited of Kent in Great Britain, and that he was the true and first inventor of the product, which to the best of his knowledge was not in use by any other person. The practice of obtaining letters patent in Jamaica for inventions by means of communication of the invention from the overseas inventor was agreed to be a settled practice with widespread usage in Jamaica.

[13] The parties further agreed that Mr Robinson had not applied for letters patent in respect of the product in any other country whereas the appellant had obtained letters

patent for it in several countries and such patents had expired in some of those countries prior to the grant of letters patent no. 3247 in Jamaica.

[14] Finally, the parties agreed that the respondents have both marketed or dealt with the patented product, in that normodipine (in the case of the 1st respondent) and las amlodipine (in the case of the 3rd respondent) contain amlodipine besylate.

[15] The issues, as agreed, for the learned judge to decide were:

- (i) Did Maurice Courtenay Robinson apply for letters patent as attorney for the appellant?
- (ii) Did the expiration of other letters patent for the said invention obtained by the appellant in other countries result in the invalidity of letters patent no. 3247, in circumstances where Maurice Courtenay Robinson pursuant to a communication from overseas from the appellant had applied for and had been granted the letters patent no. 3247, and thereafter assigned same to the appellant?

Following on the determination of these issues, the learned judge was also asked to determine the quantum of damages payable to the successful party or parties.

The judge's findings

[16] Jones J made the following findings:

- (i) On a construction of section 3 of the Patent Act, Maurice C Robinson was the "true and first inventor" of salts of amlodipine/amlodipine besylate in Jamaica.
- (ii) Letters patent no. 3247 issued in Jamaica is not valid and subsisting because letters patent no. 18266 filed in Egypt on 31 March 1987 in respect of the same product expired on 31 March 1997, that is, prior to the grant of patent no. 3247.

[17] In arriving at his finding in relation to the first issue placed before him, the learned judge considered sections 3, 7, 8 and 41 of the Patent Act. He also referred to the English cases of *Cloth Workers of Ipswich Case* (1615) 78 ER 147, *Edgeberry v Stephens* (1691) 2 Salkeld 477 and *Beard v Edgerton et al* (1846) 136 ER 39. In the end he concluded that as a matter of law on a construction of section 3 of the Patent Act, Maurice C. Robinson was "the true and first inventor" of "salts of amlodipine/amlodipine besylate in Jamaica". For ease of reference, Section 3 of the Patent Act is set out at this point. It reads:

"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, ... to direct Letters Patent ... to be issued; which Letters Patent shall recite the allegations and suggestions of the said petition...and shall therein give a short description of the said invention or discovery or improvement; 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; ...”

[18] So far as it concerns the finding that the patent had expired, the learned judge was clearly guided by his interpretation of section 29 of the Patent Act. That section reads thus:

“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."

Jones J took the view that section 25 of the Patent Act in England was the genesis of section 29 of the Jamaican Act, pointing out that whereas section 25 of the English Act refers to "application", section 29 of the Jamaican Act refers to the "applicant". He also noted in his judgment that the proviso to section 25 was in the same terms as the last proviso to section 29. The learned judge referred to a publication, **Handbook of Patent Law of all Countries** (18th ed.) (1920), making particular reference to pages 107 and 211-212. The quoted passage at page 107 reads:

"Jamaica with Turks and Caicos Islands...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."

The passage at pages 211-212 reads:

"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.”

[19] In ruling against the submissions of counsel for the appellant at the trial, the learned judge, as said earlier, relied on his interpretation of section 29 of the Patent Act, particularly the last proviso. He gave as his opinion that acceptance of counsel’s interpretation would mean that the “true and first inventor” of an invention “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, his reasoning continued, the inventor could cumulatively maintain the benefit of patent protection for an unlimited period worldwide for a single invention.

Notice of appeal

[20] The complaint by the appellant is that the learned judge had erred in fact and in law in deciding that letters patent no. 3247 had expired. Consequently, the appellant is asking this court to say that the letters patent is valid and subsisting and continues in force until 22 January 2016, thereby entitling the appellant to the declarations and injunctions sought in the claim.

The counter-notices of appeal filed by the respondents

[21] The grounds of appeal on which each counter-notice of appeal is based may be summarized as follows:

- (i) The learned judge erred in law and on the facts in concluding that Maurice Courtenay Robinson had applied on his own behalf under the Patent Act.

- (ii) The learned judge erred in law and on the facts in relation to the evidence that Maurice Courtenay Robinson was not the inventor and he himself admitted that the invention was communicated to him from abroad by the appellant.

The submissions and arguments

[22] The appellant submitted that the judge, having found that Maurice Robinson was the true and first inventor of the product, ought to have gone on to find that the patent was valid and subsisting, given that the applicant in Jamaica had not applied for letters patent in any other country. The appellant contended that section 3 of the Patent Act (see para. [17] above) gives an individual the right to apply for a patent if that individual invented or discovered an invention that was "not heretofore known or used within this Island". It is immaterial, it was submitted, that the invention may have been known elsewhere in the world or may have been first discovered by another person outside the island. The Patent Act does not require that the invention be one that is new in the absolute sense throughout the world.

[23] In respect of the finding that letters patent no. 3247 is not valid, it was submitted on behalf of the appellant that the learned judge erred in his interpretation of section 29 of the Patent Act and in comparing it with section 25 of the English Patent Act. The appellant contended that whereas section 29 places emphasis on the “applicant” and his applications elsewhere, section 25 of the English legislation is aimed at the “application” or “invention”. There was therefore no basis, it was submitted, for any comparison to be made of the two statutes.

[24] The appellant is of the view that the determination of this matter did not require the learned judge to consider section 25 of the English legislation or the cases which that section has given rise to. Rather, it was submitted, what was required was a consideration of section 29 of the Patent Act, construing its ordinary and plain language which emphasizes the applicant rather than the application or invention. Section 29, it was submitted, focuses on the applicant, not the assignee. It is only patents obtained by an applicant elsewhere that serve to limit the term of the patent that the same applicant has taken out in Jamaica. In the instant case, the applicant held the letters patent in his own right and has not taken out any patent elsewhere in the world. That being so, the appellant contended that the judge’s finding in this regard is flawed.

[25] In their response to the appellant’s submissions, and in advancing their counter appeal, the respondents contended that the learned judge erred in that as far as the first issue for determination is concerned, he answered the wrong question. The issue, they said, was not whether Maurice Robinson was the true and first inventor for the purpose of the application for the patent; rather, the issue was whether he had applied

for the patent as attorney for the appellant. According to the respondents, it is well known that overseas inventors have for many years communicated inventions to Jamaican attorneys for the purpose of making the application for patents and in those circumstances, the attorney is treated as the true and first inventor in Jamaica. However, when Maurice Robinson received the grant of letters patent he did so as the agent or alter ego of the appellant who was the real owner of the invention and stood in his shoes. He, therefore, held the grant as a trustee for the appellant and the assignment was done in fulfillment of the trust. Maurice Robinson was not free to assign it to any other party or deal with the grant except in accordance with the directions of the appellant.

[26] According to the respondents, section 3 of the Patent Act creates two categories of applicants – first, the applicant who is either the original inventor or has learnt about an existing foreign invention and applies in his own right, and secondly, the applicant who is an absentee and applies by his attorney. The question asked of the court required a decision as to which of the two categories applied to Maurice Robinson. The respondents submitted that Maurice Robinson, in light of his declared position in the petition and the declaration supporting the application, falls in the second category contemplated by section 3. Therefore, the respondents concluded, the answer to the first question is wrong and ought not to be allowed to stand.

[27] Contrary to the position taken by Mrs Denise Kitson on behalf of the appellant, Dr Lloyd Barnett representing the 1st respondent submitted that on a proper construction of section 29 of the Patent Act, the provisos to that section apply to the

invention and not the owner or the assignee of the original inventor or the applicant. According to Dr Barnett, section 29 has three different provisions, each of which is independently fatal to the appellant's case. Section 29 of the Patent Act, he said, complements section 3 in that it permits a patent to be granted in Jamaica although the product is neither original nor novel in that a patent for it had previously been applied for in another country. However, there are three specific limitations:

1. The patent granted in Jamaica shall not continue in force after the expiration of the patent granted elsewhere.
2. Where more than one patent is obtained abroad then immediately upon the expiration of a foreign term, the Jamaican patent ceases to be in force when the first foreign patent comes to an end.
3. No letters patent for or in respect of any invention for which any such patent has been obtained elsewhere and which shall be granted in Jamaica after the expiration of the term for which such patent was granted or was in force shall be of any validity.

[28] The respondents submitted that the provisions of section 29 would be rendered nugatory if they could be circumvented merely by paying an agent to make the application. In their view, neither a literal nor purposive interpretation of the Act would permit what they regard as a stilted construction.

[29] The respondents further submitted that if there are any doubts as to the construction of section 29, then in accordance with section 41 of the Act it may be construed in accordance with “the laws now or hereafter to be in force in England relating to the granting of Letters Patent for inventions”. Therefore, in their opinion, the learned judge was correct to examine the English legislation and the authorities thereon. The case of *Daw v Eley* (1867) LR Eq 496 (referred to by the learned judge), in their view, provided guidance as to the purpose and objects of section 25 of the English Act which contains the third proviso to the Jamaican statute verbatim. The judgment of Vice-Chancellor Sir W. Page Wood explains the purpose, in that, he said:

“The object, I say, is to prevent the English manufacturer from being fettered while the foreigner remains free.”

The focus, according to the respondents, is the invention, not the original inventor, owner, assignee or importer (referred to sometimes as ‘the true and first inventor’). If the invention has been patented abroad and then brought into Jamaica, either by one claiming in his own right to be the true and first inventor, or as the attorney of someone who is an absentee, the patent for that invention in Jamaica expires when the foreign patent expires.

Decision

[30] I am of the respectful view that since the parties had agreed that Mr Robinson was the true and first inventor of the product, the judge's finding as such was therefore neither here nor there, as he was not asked to make such a finding. He had been asked to determine whether Mr Robinson had applied for letters patent as attorney for the appellant. That is the determination that the learned judge was required to make on what has been described as the first issue.

[31] It seems clear to me that Mr Robinson did apply for letters patent in respect of the product in his capacity as attorney for the appellant. I have come to this position because of the following. It was an agreed fact that the invention was communicated to him from abroad by the appellant. It was after that communication that he applied for letters patent. Presumably, had there been no such communication, he would not have been in a position to make such an application. Having succeeded in his application, he then assigned the letters patent to the appellant for a mere \$2.00. This invention is of vast proportions, given the evidence as to its medicinal importance as well as the relatively huge sums of money that the appellant has indicated that it earns from sales of the product in Jamaica. It is difficult to appreciate why Mr Robinson would have assigned the letters patent in respect of such a valuable commodity to the appellant for the stated consideration, had he not been acting as attorney for the appellant. It defies logic to think otherwise. So, I have concluded that he must have been acting as attorney for the appellant. In my view, the learned judge ought to have answered the question in those terms.

[32] As regards the second issue, it will be recalled that the learned judge found that letters patent no. 3247 was invalid as letters patent no. 18266 filed in Egypt in respect of the same invention on 31 March 1987 had expired on 31 March 1997. In arriving at his conclusion, the learned judge drew parallels with the English legislation. However, in examining section 29 of the Patent Act quoted in paragraph [18] above, it is my view that there was no need to look at the English Act. For ease of reference, the first sentence of that section is reproduced thus:

“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:”

I have interpreted those words to mean that a patentee is not deprived of his right to a patent in respect of his invention merely because he previously obtained letters patent for the same invention in another country.

[33] However, there are qualifications on that broad statement. Those qualifications come in the form of the provisos that follow in section 29. The provisos read:

“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."

[34] I interpret these provisos to mean the following:

- The invention must not have been introduced into public and common use in Jamaica prior to the application for a patent therein.
- If the patent has expired elsewhere, the patent cannot continue in force in Jamaica.
- Where more than one patent has been obtained abroad, then immediately upon the expiration of the term of the one to first expire, the patent granted in Jamaica ceases to be in force.
- If a patent for an invention has been obtained elsewhere but the term for that patent has expired, no letters patent granted in Jamaica after the expiration of that term in respect of that invention shall have any validity.

[35] In my view, the occurrence of any of the circumstances in the provisos will result in the loss of the validity of the patent. In the instant case, as indicated in paragraph [13] herein, the parties agreed that the appellant had obtained letters patent in respect of the product in several countries and such patents had expired in some of those countries prior to the grant of patent no. 3247 in Jamaica. The learned judge was therefore correct in my view in concluding that the grant of letters patent no. 3247 was invalid. In my view, there was no need for him to have gone on to make comparisons with England in order to arrive at his decision. Section 29 is clear. However, he has shown without a doubt that there are other sources that have interpreted the provision in the way he has done.

[36] In the circumstances, I would dismiss the appeal and allow the counter appeal in respect of the first question that was posed for the judge's consideration. I would therefore affirm the judgment entered in favour of the 1st and 3rd respondents with costs to be agreed or taxed. I would also direct that an inquiry be conducted into the damages payable to the respondents consequent on the undertakings given for the grant of the injunction against them.

HARRISON JA

Introduction

[37] The appellant is owner of the invention salts of amlodipine/amlodipine besylate (amlodipine) which was patented in several jurisdictions throughout the world. The

compound amlodipine is well-known globally, and is important to and is the active ingredient in tablets used for the control and treatment of hypertension and heart ailments. It is used by the appellant in the tablet manufactured and marketed under the trademark "norvasc".

[38] On 22 January 2002, Jamaican Patent No 3247 was issued to Maurice Courtenay Robinson (MCR), an attorney-at-law. He subsequently assigned the letters patent to the appellant. The appellant claimed that its patent was infringed by the respondents and commenced an action in the Supreme Court for its breach. The trial was conducted before Jones J, who on 30 April 2009 made the orders set out at paragraph [42] hereunder.

[39] The two main issues for determination by Jones J were:

"I. Whether in obtaining the said Letters Patent, Maurice Courtenay Robinson had applied as attorney for the Claimant within the meaning of the Patent Act and;

II. Whether the expiration of other Letters Patent for the said invention obtained by the Claimant in other countries resulted in the Letters Patent No. 3247 having no validity in circumstances where Maurice Courtenay Robinson pursuant to a communication from overseas from the Claimant had applied for and had been granted the Letters Patent No. 3247, and thereafter assigned the same to the Claimant."

[40] Despite the precise and unambiguous wording of issue one, Jones J, decided that issue by substituting the words, "is a true and first inventor or agent" for "had applied as attorney for the claimant". At paragraph 34 of his judgment he stated:

"...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."

[41] In relation to issue two he held at paragraphs 51 and 52 of the judgment:

"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 concludes 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 [sic] Salts of Amlodipine to Maurice C Robinson is not valid and subsisting. The reason that it is not valid and subsisting is that Letter of Patent [sic] 18266 for the same substance Salts of Amlodipine/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.”

[42] Jones J dismissed the claim and signed a formal order containing the following:

"1. In relation to Question 10.1:

Answer: That Maurice Courtenay Robinson applied on his own behalf under the Patents Act 1857 (Jamaica) within the meaning of the said Patents Act-1857 (Jamaica).

2. In relation to Question 10.2:

Answer: That Letters Patent 3247 issued in Jamaica in respect to [sic] Salts of Amlodipine to Maurice Courtenay Robinson is not valid and subsisting for the reason that Letters of [sic] Patent 18266 for the same substance Salts of Amlodipine filed in Egypt on March 31, 1987, expired on March 31, 1997, a date prior to the grant of Letters Patent 3247 for Salts of Amlodipine to Maurice Courtenay Robinson in Jamaica on January 22, 2002. The Letters Patent 3247 issued to Maurice Courtenay Robinson was subsequently assigned to the Claimant, Pfizer Limited on March 22, 2002.

3. The Claimant's applications for declarations, a permanent injunction and other orders in respect of the 1st and 3rd Defendants are hereby refused.
4. Accordingly, there shall be judgment for the 1st and 3rd Defendants with costs to be agreed or taxed. Written reasons to be provided at a later date.
5. The court will conduct an enquiry into damages payable to the 1st and 3rd Defendants pursuant to the Claimant's undertaking as to damages given upon the grant of the interlocutory injunction by McIntosh J on March 25, 2005. This is set for May 8, 2009, at 10:00 am at the Supreme Court.
6. Interim injunction to remain in place until May 8, 2009.”

[43] An appeal was lodged in the registry of the Court of Appeal as a consequence of the above orders.

The Agreed Statement of Facts and Main Legal Issues

[44] Prior to the commencement of the trial, the parties agreed to certain legal issues contained in a document headed Agreed Statement of Facts and Issues.

"AGREED STATEMENT OF FACTS

1. This action concerns a claim by the Claimant, Pfizer Limited against the Defendants for infringement of Letters Patent No. 3247. The said Letters Patent were granted by the Governor General of Jamaica on the 22nd day of January 2002 to Maurice Courtenay Robinson and protect the invention 'Salts of Amlodipine /Amlodipine Besylate'.

2. The Claimant is a company incorporated in and resident in England, whereas the 1st and 3rd Defendants are companies registered and resident in Jamaica.

3. Maurice C. Robinson, who is an attorney-at-law resident and practising in Jamaica, applied by a Petition dated August 18, 1992 to the Governor-General stating 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, CT13, 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.' In applying for the Letters Patent, Maurice Courtenay Robinson also made a Statutory Declaration on the 18th day of August 1992 a copy of which is contained in the Agreed Bundle of documents, in which he indicated that the invention was communicated to him from overseas by the Claimant. The parties agree that obtaining Letters Patent in Jamaica for inventions by means of communication of the invention from the overseas inventor is a settled practice with widespread usage in Jamaica.

4. Maurice Courtenay Robinson had not previously taken out an application for Letters Patent for the product Salts of Amlodipine /Amlodipine Besylate in any other country. He subsequently assigned all his rights and interest in the said Letters Patent to the Claimant on the 22nd day of March 2002.

5. The Claimant has obtained Letters Patent abroad for the said Salts of Amlodipine /Amlodipine Besylate which patents have expired in several countries, including the Dominican Republic, Argentina, New Zealand, Australia, Canada, Spain, Bangladesh, Poland, Germany and Egypt prior to the grant of the Jamaican Patent No. 3247.

6. The Claimant manufactures and sells and distributes in Jamaica the drug 'Norvasc' which contains Salts of Amlodipine /Amlodipine Besylate.

7. The 1st, and 3rd Defendants have both marketed or dealt in the said patented product in the following manner, namely:

I. The 1st Defendant imported into Jamaica and sold and distributed a product known as 'Normodipine' which contains Amlodipine Besylate,

II. The 3rd Defendant imported into Jamaica and sold and distributed a product known as 'Las Amlodipine' which contains Amlodipine Besylate.

8. Prior to the application for the grant of the said Letters Patent no. 3247, the invention covered by the said Letters Patent had not been known or introduced into public and common use in Jamaica.

9. Neither the 1st nor 3rd Defendant has a licence or any form of permission from the Claimant to deal in Salts of Amlodipine /Amlodipine Besylate in the manner stated.

MAIN LEGAL ISSUES BETWEEN THE CLAIMANT AND THE 1st AND 3rd DEFENDANTS

10. The main legal issues between the Claimant and the Defendants are:

I. Whether in obtaining the said Letters Patent, Maurice Courtenay Robinson had applied as attorney for the Claimant within the meaning of the Patent Act.

II. Whether the expiration of other Letters Patent for the said invention obtained by the Claimant in other countries resulted in the Letters Patent No. 3247 having no validity in circumstances where Maurice Courtenay Robinson pursuant to a communication from overseas from the Claimant had applied for and had been granted the Letters Patent No. 3247, and thereafter assigned the same to the Claimant.

11. As a result the following consequential issues arise for determination at the trial:

I. Whether Letter [sic] Patent No. 3247 is valid and subsisting and continues in force until the 22nd January 2016.

II. If the answer to the question contained in paragraph 11(I) hereof is in the affirmative, the quantum of damages payable to the Claimant by each Defendant, the Defendants having admitted that they engaged in the importation, sale and distribution of Normodipine, Amlopres 5 and Las Amlodipine, without any licence or permission from the Claimant; and whether in the circumstances this Honourable Court ought to grant a permanent injunction restraining the sale by the Defendants of the products containing the invention the subject hereof.

III. If the answer to the question contained in paragraph 11(I) hereof is in the negative, the quantum of damages payable to the Defendants by the Claimant pursuant to the Claimant's undertaking as to damages given upon the grant of the Interlocutory Injunction herein.

Dated the 24th day of APRIL 2009."

The Grounds of Appeal by Pfizer and the Orders Sought

[45] The following are the grounds of appeal, orders sought and counter notice of appeal.

- “1. The learned Judge erred in law and in fact in his decision in relation to Question 10.2.
2. The learned Judge erred in law and in fact in refusing to grant the Claimant's applications for declarations, a permanent injunction and damages in respect of the 1st and 3rd Defendants.
3. The learned Judge erred in law and in fact in granting Judgment for the Defendants with costs to be agreed or taxed.

The Orders Sought

1. In relation to Question 10.2:

That Letters Patent 3247 issued in Jamaica in respect to Salts of Amlodipine to Maurice Courtenay Robinson and assigned to the Claimant are valid and subsisting and continue in force until January 22, 2016.
2. The Claimants applications for declarations, a permanent injunction and damages in respect of the 1st and 3rd Defendants are granted.
3. Judgment for the Claimant with costs to be agreed or taxed.”

Counter Notice of Appeal by the 1st and 3rd Respondents

"TAKE NOTICE that the 3rd Respondent hereby appeals to the Court of Appeal against the decision of the Honourable Mr. Justice Roy Jones contained in the order dated the 27th , 28th and 30th days of April 2009 in respect of which the Appellant has filed a Notice of Appeal dated the 8th day of May 2009.

1. The details of the order appealed are:

That Maurice Courtney [sic] Robinson applied on his own behalf under the Patents Act 1857 (Jamaica) within the meaning of the said Patents Act 1857 (Jamaica).

Attached hereto is a copy of the Formal Order in its entirety pursuant to Court of Appeal Rule 2.2 (2).

2. The following finding of fact and of law is challenged:

Maurice Courtney Robinson acted on his own behalf when he applied for Patent No. 3247.

3. The Grounds of Appeal

- a) The learned Judge erred in law and on the facts in his decision in relation to Question 10.1 in that there was no credible evidence to support such a conclusion.
- b) The learned Judge erred in law and on the facts in relation to the evidence that Maurice Courtney Robinson was not the inventor and he himself admitted that the invention was communicated to him from abroad by the Claimant/Appellant.
- c) The Claimant/ Appellant did not disclose any document with respect to the relationship between the said Maurice Courtney Robinson and the Claimant/Appellant or the terms in which or on which the invention was communicated to him.

4. Order Sought

In relation to Question 10.1

That Maurice Courtenay Robinson acted as the Attorney for the Claimant/Appellant within the meaning of the Patent Act when he applied to the Minister for grant of the patent.

In relation to Question 10.2

Affirmation of the orders of the Court below that:

Letters Patent NO. 3247 issued in Jamaica in respect to [sic] Salts of Amlodipine to Maurice Courtney Robinson and assigned to the Claimant is not valid and subsisting.

Affirmation of the refusal of the Claimant's application for permanent injunctions and other orders in respect of the 1st & 3rd Defendant/ Respondent.

Affirmation of the Judgment for the 1st & 3rd Defendant/Respondent with cost to be agreed or taxed.

5. Any specific power which the court is asked to exercise: Affirmation of the direction that the court conducts an enquiry into damages under the undertaking given upon the grant of the interlocutory injunction by McIntosh J on March 25, 2005."

The Current Statute, Legislative Background and Case Law

[46] The Patent Act (the Act) has been on the statute books in Jamaica since 1857.

Minor amendments were made to this Act in 1974 and 1975. The following sections of the Act are relevant to this appeal:

"3. 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; which Letters Patent shall recite the allegations and suggestions of the said petition so to be preferred as aforesaid, and shall therein give a short description of the said invention or discovery or improvement; 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; and such Letters Patent shall be signed by the Governor-General, and shall be good and available to the grantee therein named by force of this Act:

Provided, that it shall be lawful for the Governor-General, if he should deem it expedient, to insert in any such Letters Patent a provision extending the operation thereof for a further term of seven years.

4. Every applicant shall in his application give a postal address within the Island, to which any notice or communication may be addressed, and any notice or communication duly sent by post addressed to the applicant at such address shall be deemed to have been duly given or made.

...

7. Before 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; and that such invention, or discovery, or improvement, hath not, to the best of his knowledge or belief, been known or used in this Island; which declaration shall be delivered together with the petition for such Letters Patent.

...

8. Before any person shall receive or obtain any Letters Patent as aforesaid, such person or his attorney, shall also deliver, together with such petition and declaration as aforesaid, a written description or specification of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms as to distinguish the same from all other things before known or used in this Island, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same; and in case of any machine shall explain the principle and the several modes in which such person hath contemplated the application of that principle, or character by which it may be distinguished from other inventions; and shall accompany the whole with drawings and written references, where the nature of the case admits of drawings or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description or

specification shall be signed by such person or his attorney as aforesaid so applying for such Letters Patent, and attested by two witnesses.

...

24. After application has been duly made for Letters Patent under this Act, and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, or the refusal of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date when the petition was lodged with the Minister as provided by section:

Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

...

29. 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.

...

41. 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."

[47] I will turn now to briefly examine some basic principles of patent law. Dr Barnett has set out in paragraphs 25 - 27 of his written submissions some useful material which I have adopted in this judgment:

"25. It is the universal and long established principle that letters Patent are granted only for limited periods. Thus the Jamaican Patent Act which was enacted in 1857 provides that the basic term of the grant should not exceed 14 years. Similarly, the English Patent Act of 1852 provided in section XXV that Letters Patent obtained in the United Kingdom for patented foreign inventions should not continue in force after the expiration of the foreign patent. In several jurisdictions the Patents relating to this particular product had a limited life span. The first rationale of this underlying policy is that the inventor should be allowed a limited but reasonable time to enjoy the exclusive right to exploit his invention so as to be compensated for his inventiveness and the time and expenses he had utilized in its development. The second rationale is that the public should not be deprived of the benefit of the invention being competitively produced and distributed. To obtain a grant of Letters Patent it is normally necessary to demonstrate novelty as well as usefulness to the public. These factors are particularly important in the field of medicine where an inventor, if permitted an indefinite monopoly, could deprive the public of life saving or health enhancing drugs.

26. This limitation on exclusiveness accords with the ancient legal restrictions on monopolies as well as the modern principles of free trade. Thus, the grant of exclusivity for a limited but substantial period is fair both to the inventor and the public. Otherwise, a life-saving drug would have limited access

especially in developing and poor countries, long after it had become widely available in the developed countries.

27. Accordingly, where the Court or an authority has the statutory power to extend the term of a patent, the onus is placed on the patentee to show that he or his predecessor in title has not been already adequately remunerated. In *Hopkinsons' Patent* Lord Hobhouse in giving the decision of the Privy Council, in refusing an application to extend the term of a Patent stated:

'It cannot be seriously contended that an assignee, who may have purchased a patent at a late period of its life, can, if he has lost money, come here alleging that he is by statute a patentee who has been inadequately remunerated...Their Lordships consider that they would be departing both from authority and from sound principle if they were to hold that this company occupies the position of an inventor who has been inadequately remunerated. The company entered on a purely commercial speculation which unluckily for them, has up to the present time proved unremunerative. They purchased it, or at least the beneficial interest, out and out, from a prior assignee of the inventor, who has, in one way or another, been well paid, and has now no claim or interest to ask for an extension.' "

[48] **The Marsden v Saville Street Foundry and Engineering Company Ltd** 3

Ex D 203 delivered 27 March 1878, examines the background to the grant of English letters patent. I find this case quite instructive. Jessel MR stated, inter alia, at page 205:

"It has been argued that before the statute of James, such patents were valid and were allowed by the judges, and that the statute merely restricts the duration of the patent, and does not destroy the right as it previously existed. Even supposing that were so, the statute defines who are considered to be worthy recipients of the grant of such a monopoly, as it was then called, and the definition so given has been followed ever

since. It is difficult to say a priori on what principle a person who did not invent anything, but who merely imported from abroad into this realm the invention of another, was treated by the judges as being the first and true inventor. I have never been able to discover the principle, and although I have often made inquiry of others, and of some who are more familiar with the patent law than even I am, although I cannot pretend not to possess a considerable familiarity with it, I could never get a satisfactory answer. The only answer was, It has been so decided, and you are bound by the decisions. But it is an anomaly as far as I know, not depending on any principle whatever. It has never been declared by any judge or authority that there is such a principle, and, not being able to find one, all I can say is, that I must look upon it as a sort of anomalous decision which has acquired by time and recognition the force of law.

The grounds upon which it is put we do know. In the **Clothworkers of Ipswich** Case [Godb. pp. 252, 254] we have this said about it: "The king granted unto B. that none besides himself should make ordnances for battery in the time of war: such grant was adjudged void. 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." Therefore the decision goes no further than this - that at that time, considering the difficulty which then attended communication from abroad, a man who brought in anything from abroad did it at the peril of his life (for travelling was not without danger in the time of Henry VIII.) and consumption of his estate and stock, and it was therefore such a meritorious service done to this kingdom, that the king might lawfully grant him a monopoly. That is the ground it is put upon. Now, there is some reason in that. It does not make him the true and first inventor, but it does shew a meritorious consideration which warranted an exception from the general rule that monopolies could not be granted..."

At pages 206 -207 he continues:

"Another case referred to by patent lawyers as declaring the law upon this subject, although it is only a statement in argument of the old decided cases, is the case of **Darcy v. Allin** [Noy, 173]. The passage I am going to read is at p. 182. It is a statement by counsel in argument of what the decisions were, and is equivalent to a report therefore of what those decisions were. "Now therefore I will shew you how the judges have heretofore allowed of monopoly patents, which is that where any man by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm; that in such cases the king may grant to him a monopoly patent for some reasonable time, until the subjects may learn the same, in consideration of the good that he doth bring by his invention to the commonwealth, otherwise not." He is to bring it into the realm. Then he cites his authorities: "In the 9th Eliz. there was a patent granted to Mr. Hastings of the Court - that in consideration that he brought in the skill of making of frisadoes as they were made in Harlem and Amsterdam beyond the seas, being not used in England, that therefore he should have the sole trade of the making and selling thereof for divers years, charging all other subjects not to make any frisadoes in England during that time upon pain to forfeit the same frisadoes by them made, and to forfeit also 100/, the one moiety thereof to the Queen's Majestie, the other to Mr. Hastings. Upon which patent Mr. Hastings, about twenty years past, exhibited an information in the Exchequer against certain clothiers of Coxfall for making of frisadoes contrary to the intent of this patent." Then the defence was that they used to make them before the patent and that was allowed. "Another monopoly patent was granted to Mr. Matthey, a cutler at Fleet Bridge, in the beginning of this queen's time, which I have here in Court to shew, by which patent it was granted unto him the sole making of knives with bone hafts and plates of lattin, because, as the patent suggested, he brought the first use thereof from beyond seas." That was the form of the patent. Then he gives a third patent which has no bearing on this case because it was a patent granted to a man for an invention within the realm. That was "a monopoly patent granted to one Humphrey of the Tower for the

sole and only use of a sieve or instrument for melting of lead, supposing that it was of his own invention and therefore prohibited all others to use the same for a time." Now of the three examples, two of them had been brought beyond the seas and the third was the man's own invention. He gives them as examples of his own proposition that those are the only two cases in which the Crown had the right to grant a monopoly. No doubt it was that user which induced the judges, after the passing of the statute of James, to treat the man who brought the invention from beyond the seas as being in the same position as the first and true inventor, or as being in an equivalent position, and gradually the language seems to have been changed and he was treated as the true and first inventor.

Now that is the origin of the decisions..."

[49] **Linoleum Manufacturing Co v Nairn** (1878) 7 Ch D 834, 47 LJ Ch 430, 26

WR 463, 38 LT 448, [1874-80] All ER Rep Ext 1662 is also quite instructive. It held:

"Where the inventor of a new substance has given to it a name, and, having taken out a patent for his invention, has during the continuance of the patent, alone made and sold the substance by that name, he is nevertheless not entitled to the exclusive use of that name after the expiration of the patent."

[50] **Dominion Cotton Mills Company Ltd. and Others v General Engineering**

Company of Ontario Ltd [1902] AC 570, which is an appeal from the Supreme Court of

Canada to the Privy Council held inter alia:

"By the true construction of s. 8 of the Canadian Patent Act, c. 61 of the Revised Statutes of Canada, as amended by Canadian Act 55 & 56 Vict. c. 24, s. 1, a Canadian patent expires as soon as any foreign patent for the same invention existing at any time during the continuance of the Canadian patent expires. A British patent is a foreign patent within the meaning of the Canadian Patent Act.

Section 8 of the Canadian Patent Act (as amended) states:

"8. Any inventor who elects to obtain a patent for his invention in a foreign country before obtaining a patent for the same invention in Canada, may obtain a patent in Canada, if the same be applied for within one year from the date of the issue of the first foreign patent for such invention; and if within three months after the date of the issue of a foreign patent, the inventor gives notice to the Commissioner of his intention to apply for a patent in Canada for such invention, then no other person having commenced to manufacture the same device in Canada during such period of one year, shall be entitled to continue the manufacture of the same after the inventor has obtained a patent therefor in Canada, without the consent or allowance of the inventor; and, under any circumstances, if a foreign patent exists, the Canadian patent shall expire at the earliest date on which any foreign patent for the same invention expires."

[51] The material facts and dates in the **Dominion** case are as follows:-

1. On March 1, 1892, a Mr. Jones, an American, obtained a patent in the United States for improvements in boiler and other furnaces. On the same day Mr. Jones applied in Canada for a Canadian patent and in England for a British patent for the same invention.
2. On July 12, 1892, the British patent was granted for fourteen years from March 1, 1892, but its duration for that period depended on the payment of the necessary fees.
3. On October 15, 1892, the Canadian patent was granted for eighteen years from October 15, 1892.
4. On March 1, 1897, the British patent expired, the fees necessary for keeping it subsisting not having been paid.
5. On September 1, 1898, the owners of the Canadian patent, i.e., respondents in this appeal, brought an action against

the appellants for infringing that patent, and the plaintiffs were successful and obtained judgment in the action.

6. Afterwards the defendants in the action obtained leave to amend their pleadings in order to plead that before the commencement of the action the Canadian patent had expired by reason of the expiration of the British patent, and also by reason of the expiration of an Italian patent, to which, however, it is unnecessary now to allude.

7. A new trial was directed, and took place before Burbidge J., who had tried the action, and judgment was given for the defendants, i.e., the present appellants, on the ground that the amended defence was proved. From this decision (which is referred to as the judgment of the Exchequer Court) the plaintiffs appealed to the Supreme Court, and the judgment was reversed.

8. The defendants appealed to the Privy Council and the judgment of the Supreme Court was reversed.

[52] I now turn to the issues which arise in the instant appeal and cross-appeal.

The Issues

[53] The two legal issues that were agreed to in the court below are very much relevant in the appeal and cross-appeal. For emphasis I will set them out below:

I Whether in obtaining the Letters Patent, MCR had applied as attorney for the Claimant within the meaning of the Patent Act.

II Whether the expiration of other Fetters Patent for the said invention obtained by the Claimant in other countries resulted in the Fetters Patent No. 3247 having no validity in circumstances where MCR pursuant to a communication from overseas from the Claimant had applied for and had been granted the Letters Patent No. 3247, and thereafter assigned the same to the Claimant.

The appeal concerns issue two whereas the cross-appeal is concerned with issue one.

The submissions in relation to issue two

[54] I am most grateful to the very detailed and well researched submissions that were made by counsel on both sides. I must confess that I had no great knowledge of the law pertaining to patents before this appeal was heard.

[55] Mrs Denise Kitson, for the appellant, has submitted orally in this court that the outcome of the appeal is very important because it concerns how patent law has been practised in Jamaica for the past 100 years. The decision, she said, would greatly impact on several patents that have been granted over the years.

[56] Mrs Kitson submitted that the learned judge was in error when he found that the Jamaican Letters Patent No. 3247 had expired at the time of the appellant's application because letters patent for the same invention had expired elsewhere in the world and there was no further application for the letters patent in any other country. At paragraphs 14 and 15 of her written submissions she states:

"14. The Appellant therefore asserts that Maurice Robinson, as the Applicant for Letters Patent No. 3247, falls within the ambit of section 3 of the Act, because he applied for the patent in his own right in respect of an invention that was not previously known or used in the Island. Further, section 30 of the Act recognizes that Letters Patent, once granted, can be assigned. Letters Patent No. 3247 was properly assigned to the Appellant in keeping with the Act. The Appellant asserts that section 29 of the Patent Act, focuses on the Applicant, not the assignee. It is only patents obtained by an Applicant elsewhere that serve to limit the term of the patent that the same Applicant has taken out in Jamaica. The Appellant insists that section 3 of the Act does not limit the definition of the person entitled to obtain Letters Patent

of an invention or discovery not before known within the island to the first manufacturer of the same. Indeed the Appellant submits that it also includes the person who first invented or discovered some useful art, machine, manufacture or composition of matter not previously known or used in this Island. In this regard, Maurice Robinson, having been in possession of an invention communicated to him from abroad of which he claims to be the first and true inventor, to wit, Amlodipine Besylate in Jamaica, and which had not been previously known or used in the Island, is a proper person to apply for the grant of the Letters Patent and that grant having been made to him, is valid for all intents and purposes and is in strict compliance with the Act. The Patent Act is plain in allowing the patenting of inventions introduced into Jamaica even where the inventions are known in other countries. This is clear from numerous sections of the Patent Act. As indicated previously, section 3 of the Patent Act allows issuance of a Patent for inventions 'not heretofore known or used within this Island,' section 29 which allows the issuance of the Patent provided that 'such invention shall not have been introduced into the public and common use in this Island prior to the application for a Patent therein...' Section 25 permits the court to revoke Letters Patent when the invention 'is not a new invention as to the public use and exercise thereof within this Island...'

15. Thus the Patent Act does not require that the invention be one that is new in the absolute sense throughout the world. The invention can in fact have been well known for an unlimited amount of time in other countries but be the proper subject for a Patent in Jamaica if the invention was not known or used or was not in public and common use "in this Island". Accordingly, the Applicant in Jamaica may have learned of an invention that had been widely used for an unlimited time outside Jamaica but obtain a Patent here as the first to bring the invention to this country."

[57] Mrs Kitson submitted that on a review of well established authorities it is clear that where the language being construed in a statute is clear and unambiguous in meaning there is no need to look at earlier statutes. She submitted that having regard

to the language of section 29 it is evident that the intention of the Jamaican legislature was to place emphasis on the applicant and his applications elsewhere and thus veer substantially from the language and the intendment of section 25 of the English Patent Law (Amendment) Act which places emphasis on any application or invention. Accordingly, she submitted that it was inappropriate in these circumstances for the learned judge to have resorted to section 41 of the Act as the clear and unambiguous language of section 29 did not admit of any doubt as to its construction. Further, she submitted that even if there was doubt there is no basis to construe section 25 of the English Act as being applicable by analogy to section 29 of the Jamaican Patent Act as the two Acts are not in pari materia as would be required by an ordinary meaning of the term "by analogy".

[58] Mrs Kitson therefore submitted that the life of Jamaican a letters patent is only co-existent with the life of a patent issued elsewhere in the world where there is the same applicant for the letters patent in Jamaica and for that patent issued elsewhere. She submitted that where that does not obtain, the provisos to section 29 of the Act are inapplicable and the patent continues to be valid and subsisting for the duration of the 14 years, notwithstanding the expiration of some other patent elsewhere relating to the patented product in Jamaica. She therefore submitted that the appeal should be allowed and the court grant the orders sought by the appellant in the terms of the amended notice of appeal filed.

[59] In his oral submissions, Dr Barnett submitted that the literal rule of construction was subject to a number of qualifications in the modern cases. He argued that the literal rule is never applied to produce an absurdity. Secondly, if there were two possible interpretations arising out of the language of the statute, then that interpretation which advanced the purpose and objective is to be preferred to that which defeated the purpose or objective.

[60] Dr Barnett submitted in writing that on a proper construction of section 29 of the Act, the provisos to that section apply to the invention and not the owner, the assignee, the original inventor or the applicant. He argued that the Act must be construed as a whole. He submitted as follows from paragraph 46 onwards:

"46. Section 29 has three different provisions each of which is independently fatal to the Claimant's/Appellant's case. Section 29 is complimentary to Section 3 in that it permits a patent to be granted in Jamaica although the product is not original or novel in that a patent for it had previously been applied for in another country. However, there are three specific limitations:

(1) the patent granted in Jamaica shall not continue in force after the expiration of the patent granted elsewhere;

(2) where more than one patent or the like privilege is obtained abroad then immediately upon the expiration of a foreign term, the Jamaican patent ceases to be in force when the first foreign patent comes to an end;

(3) no letters patent for or in respect of any invention for which any such patent or like privilege has been obtained elsewhere and which shall be granted in Jamaica after the expiration of the term for which such patent or privilege was granted or was in force shall be of any validity.

47. Section 29 permits a patent to be granted in Jamaica although it is not a novel product since the invention has been patented elsewhere. But although it permits a patent to be granted for such an invention, it provides that it should not continue in force or be valid if that foreign grant has expired. In any event the second and third limbs of section 29 by their clear terms apply to Letters Patent or like privileges obtained elsewhere in respect of any invention irrespective of who is the patentee or applicant for the foreign patents. The third limb which is contained in the final proviso of the section deprives a Jamaican patent 'of any validity' if granted after a patent for the same invention which was granted elsewhere has expired.

48. Since in most cases applications for patents are made by agents, the provisions of section 29 would be rendered nugatory, if they could be circumvented merely by paying an agent to make the application. Neither a literal nor purposive interpretation of the Act can permit such a stilted construction.

49. If there are any doubts as to the construction of section 29, then in accordance with section 41 of the Act it may be construed 'in accordance with the law now hereafter to be in force in England relating to the granting of Letters Patents for inventions'. The learned Judge therefore correctly examined the English statute and authorities and the Appellant is in error in its criticism of him on this grounds [sic].

50. It is clear that the learned Trial Judge looked at the Patent Act against the background of conditions existing at the time of its creation. It was passed in 1857 shortly after the passage of the English Act in 1852. The case of **Daw v Eley** to which he refers at paragraph 48 was decided just 10 years after the Jamaican Act and he relies upon it to obtain guidance as to the purpose and objects of Section 25 of the English Act which contains the third proviso to the Jamaican statute verbatim. The learned Trial Judge quotes from the judgment of Vice-Chancellor Sir W. Page Wood in that case and it is convenient to refer to a short extract from that quotation to emphasise the purpose of the reference by the judge: '...The object, I say, is to prevent the English manufacturer from being fettered while the foreigner remains free'."

[61] Dr Barnett therefore submitted that the focus is on the invention, not the original inventor, owner, assignee or importer (referred to sometimes as "the true and first inventor"). If the invention has been patented abroad and then brought into Jamaica either by one claiming in his own right to be the true and first inventor (Category one) or as the attorney of someone who is an absentee (Category two) the same period applies, the patent for that invention in Jamaica expires when the foreign invention expires. He therefore submitted that the appellant was in error in focusing on the application in the analysis of section 29 and consequently in relying on authorities that relate to the comparison of earlier or foreign legislation to qualify the true meaning of the words used in the Jamaican statute. The wording and intent, he said, of sections 3 and 29 of the Act are clear and unambiguous and can be applied consistently with its intendment and purpose.

The submissions in relation to Issue 1

[62] Mr Chen submitted that the learned judge fell into error in that he answered the wrong question. It was submitted that the issue between the parties was not whether MCR was the true and first inventor of the invention for the purposes of the application under the Act because that was an agreed and accepted position between the parties. The live issue, it was said, between the parties, was whether MCR in applying for and obtaining the grant of Letters Patent No. 3247 did so as the agent of the overseas communicator of the invention, the appellant.

[63] Counsel also submitted that at no time did the respondents question or challenge the right of MCR to apply for and obtain the letters patent. Indeed, he argued that this was conceded and agreed. He submitted that when MCR obtained the grant of letters patent he did so as the agent or alter ego of the appellant who was the real owner of the invention and stood in his shoes. He therefore submitted that the grant was as trustee for the appellant and the assignment was done in fulfilment of the said trust. In the circumstances, it was argued that MCR could not assign it to any other party or deal with the grant except in accordance with the directions of the appellant.

[64] Mrs Kitson in her response to the submissions made with respect to the cross-appeal submitted in her written submissions that the learned judge did not answer the wrong question and he did not answer the question incorrectly. She submitted that the judge's answer was to be found in the formal order, that is, "That Maurice Courtenay Robinson applied on his own behalf under the Patents Act 1857 (Jamaica) within the meaning of the said Patents Act 1857 (Jamaica)". In her oral submissions, she submitted that what is contained in the formal order reflected what was said in the learned judge's oral judgment.

[65] Mrs Kitson further submitted that contrary to the assertion of the respondents, MCR did not apply for the letters patent as attorney for the appellant. She argued that sections 3 and 7 of the Act referred to an applicant who being an absentee, applies for letters patent by his attorney. She submitted that this is a clear reference to an attorney of fact which could only occur if MCR was the donee of a power of attorney from the appellant. She further argued that section 51 of the Conveyancing Act requires that

Powers of Attorney must be registered at the Island Records Office to be completed and effective and that no Power of Attorney was given by the appellant to MCR. Instead, she argued, that he had applied in his own name through communication from abroad, that he had received the letters patent in his own right and could properly have assigned it to the appellant.

[66] Accordingly, Mrs Kitson submitted that the application of MCR was not that of the appellant. Rather, she submitted that the statute facilitated this procedure and that the patent regime in Jamaica has operated by means of this settled practice with widespread usage for years without challenge. In the circumstances, she submitted that the learned trial judge correctly determined this issue by being guided by the statutory framework as it has operated lawfully in Jamaica for decades.

The discussion

[67] The Act was brought into operation in 1857. As it now stands, inventors and assignees may be granted a 14-year patent monopoly, with the possibility of a seven-year extension - see section 3 of the Act. Patents are granted on the basis of local novelty as opposed to universal novelty, so it is possible for a patent to be granted in Jamaica for an invention which already exists elsewhere. What is abundantly clear from The Agreed Statement of Facts, is that the appellant had held a number of patented inventions for "amlodipine" in several countries, the last of which had expired, prior to the grant of the Jamaican patent.

[68] The crucial issue in relation to issue no. two (in the appeal) lies in the interpretation and construction of section 29 of the Act. The learned judge had relied on section 25 of the English Patent Act of 1852 and held that this section "is the genesis of section 29 of the Jamaican Patent Act 1857" and that the proviso to section 25 is in the same terms as the last proviso to the Jamaican Act. Perhaps it would be useful if I were to set out the provisions of section 25 of the English Act which states:

"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 obtained abroad, immediately upon the Expiration or 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." [Emphasis added]

[69] Section 29 of the Act states:

" **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 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." [Emphasis supplied]

[70] The learned judge had concluded at paragraph 48 of his written judgment:

"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."

[71] Was he in error in so concluding? It seems clear to me that the judge had looked at the Act against the background of the conditions which existed at the time of its creation. The Act was passed in 1857 shortly after the passage of the English Act in 1852. He stated that the English Act was in his 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 41 of the Jamaican statute reads as follows:

" 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."

[72] The learned judge had relied on the case of **Daw v Eley** (1867) L R Eq 496 and seemed to have obtained guidance as to the purpose and objects of section 25 of the English Act which contained the proviso to the Jamaican statute verbatim. Vice-Chancellor Sir W. Page Wood in delivering the judgment of the court stated:

"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."

[73] The learned judge had also referred to the work of WP Thompson, a noted English Patent Agent in a Handbook of Patent Law of all Countries 18th Edition (1920), who outlined the customary patent practice and usage in Jamaica some 50 years after the passing of the Act of 1857. At page 107 he stated:

"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."

[74] The learned author David Fulton, in his 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) stated at pages 211-212:

"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."

[75] It is therefore my considered view that there is merit in the arguments and submissions made by Dr Barnett when he submitted that the focus in relation to section 29 is "the invention, not the original inventor, owner, assignee or importer (referred to sometimes as "the true and first inventor")". I also agree with him when he submitted that "on a proper construction of section 29 of the Patent Act the provisos to that section apply to the invention and not the owner..."

[76] In the circumstances, I respectfully disagree with the submissions made by Mrs Kitson that the interpretation of the provisos to section 29 should be governed by the words, "No applicant shall be deprived of his right to a patent..." I also find it quite unacceptable, as Counsel submitted, 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.

[77] I fully agree with the learned judge's construction of section 29. Both sections 29 and 3 ought to be considered when one comes to determine the true intention of Parliament. It is therefore my view, on a proper construction of section 29, that the following apply:

- (a) 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.

(b) 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.

(c) Once granted, the Jamaican patent will be valid only for the period that the foreign patent remains in force.

(d) 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.

(e) Any letters patent granted in Jamaica after the expiration of any such foreign patent will be deemed invalid.

[78] I therefore conclude that the learned judge was correct in his findings and answer, to issue no. two. I hold that the Jamaican patent ceased and was determined on the first expiration of any of the foreign patents. The foreign patent having expired prior to the application for the Jamaican patent, the Jamaican grant has no validity. I further hold that the construction of section 29 by the learned judge is consistent with the terms of the statute as well as the overall objective of the legislature and the jurisprudence of patent law. The appeal ought to be dismissed with the usual order for costs to the 1st and 3rd respondents.

[79] In relation to issue no. one, I do agree with the submissions made on behalf of the respondents that the question in the Agreed Statement of Facts had nothing to do with whether MCR had applied as the "true and first inventor". The question, as Dr Barnett submitted, is what was the status of MCR? Did he apply as an attorney and in applying for and obtaining the grant did he do so as the alto ego, agent or attorney of the person who had communicated the invention to him? It seems clear to me that based on the facts, the initiative for bringing the drug into Jamaica was taken by the appellant. It seems also clear that without the instructions of the appellant that MCR could not have obtained the registration. Section 3 of the Act specifically states:

"3. 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 granted by 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; which Letters Patent shall recite the allegations and suggestions of the said petition so to be preferred as aforesaid, and shall therein give a short description of the said invention or discovery or improvement; 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; and such Letters Patent shall be signed by the Governor-General, and shall be good and available to the grantee therein named by force of this Act:

Provided, that it shall be lawful for the Governor-General, if he should deem it expedient, to insert in any such Letters Patent a provision extending the operation thereof for a further term of seven years." [Emphasis supplied]

[80] Section 3, as Dr Barnett puts it, creates two categories of applicants, first the applicant who is either the original inventor or has learnt about an existing foreign invention and applies in his own right and secondly, the applicant who is an absentee, and applies by his attorney. The question which was agreed between the parties for the judge below to decide was which of the two categories did MCR belong. It was submitted by the respondents, and I agree, that MCR could only be regarded as the "true and first inventor" in a representative capacity contemplated by the statute. It is for this reason that section 7 of the Act expressly requires the attorney of an absentee owner of the invention to make a statutory declaration to the effect that "he verily believes that he is the true inventor...". This is exactly what MCR deponed to in the Statutory Declaration on 18 August 1992 which stated that the invention was communicated to him from overseas by the appellant. I should add that section 51 of the Conveyancing Act, which Mrs Kitson relied on, has no relevance where section 3 of the Act is concerned.

[81] It is therefore my considered view that MCR had acted in accordance with the interest of the appellant by assigning to it all his rights in Patent No. 3247 on 26 March 2002 for the nominal sum of \$2.00. This therefore signified that MCR had no true

personal proprietary interest in the patent. I would agree with the respondents that the learned trial judge had answered the first question wrongly.

Conclusion

[82] The appeal should therefore be dismissed and the cross-appeal ought to succeed and an inquiry be conducted into the damages payable to the respondents. It is further my view that this 1857 Act needs urgent legislative intervention. I have gathered that a draft Bill was done some years ago with a view to modernize this statute but to date nothing has materialized. It is universally accepted that the existence of patents in the pharmaceutical industry limits the supply of alternative drugs for quite a number of years so steps should be taken by the relevant authorities in order to bring about the well-needed changes.

DUKHARAN JA

[83] I agree. I too would dismiss the appeal and allow the counter appeal and affirm the judgment entered in favour of the 1st and 3rd respondents.

PANTON P

ORDER

Appeal dismissed. Counter appeal allowed. Judgment entered in favour of the 1st and 3rd respondents affirmed, with costs to be agreed or taxed. Inquiry to be conducted as regards damages payable to the respondents consequent on the undertakings given for the grant of the injunction against them.