3(d) View of India’s Patent Law: Social Justice Aspiration meets Property Rights in Novartis v. Union of India & Others

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ABSTRACT

Wherever the art of Medicine is loved, there is also a love of Humanity. Hippocrates 400 BC

Not many constitutional decisions from developing countries find themselves at the center of global debate like the Indian Supreme Court’s Novartis decision invalidating the Gleevec patent. The patent was invalidated under amended Section 3(d) of the Indian Patents Act, which was amended to address some of the concerns of imbalance between the maximalist and minimalist cultures in the pharmaceutical context. Section 3(d) of the Indian Patent Act introduced a new threshold of patent eligibility for pharmaceutical innovation that requires applicants to demonstrate enhanced efficacy of their products. The objective of this Article is to get beyond the reactionary reviews of the Indian patent regime and seek a nuanced view of its doctrinal trajectory. The Article achieves this by deconstructing Section 3(d) by focusing on its legislative intent, extracting its human rights dimension, and tracing its harmonizing elements. In the end, the Article serves to dispel the myth of Section 3(d)’s TRIPS incompatibility, unearths Section 3(d)’s human rights dimension, and rehabilitates India’s intellectual property regime amidst a global condemnation of its minimalist viewpoint.
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I. Introduction

Pharmaceutical companies have practiced the art of extending market exclusivity for much of the twentieth century. In the name of product life cycle management, these innovators seek to extract corporate monopoly rent, almost for


By “corporate monopoly rent-seeking,” I generally draw attention to the corporate practices where the corporate entity attempts to derive economic benefits by extracting economic rent via manipulating the existing socio-political landscape. In this context, rent-seeking occurs as the corporate entity extracts additional value by various means, such as imposing barriers to entry to other competitors or developing unilateral ability to fix a higher than normal market price. The term “monopoly” is included in the description to capture a unique dimension of such uncompensated value extraction in that the corporate entity enjoys monopoly privileges under the guidance of legal or regulatory framework. Originally introduced in 1967, the concept of “rent-seeking” was formalized in 1974 and identified as distinct from the basic profit-seeking behavior of economic agents. See generally Gordon Tullock, The Welfare Costs of Tariffs, Monopolies, and Theft, 5 W. ECON. J. 225 (1967) (introducing the idea of “rent-seeking”); Anne Krueger, The Political Economy of the Rent-Seeking Society, 64 AM. ECON. REV. 291 (1974) (formalizing the same concept). In the present context, I draw a distinction between profit-seeking and rent-seeking behaviors of biotechnology companies, where the former engages in mutually agreeable financial transactions within an efficient market environment, but where the later [sic] extracts abnormal profits in a skewed market environment by foreclosing other competitors’ meaningful opportunities to compete due to patent exclusivity for a significant period of time.

\[Id.\]
perpetuity, either through patent evergreening,\(^2\) or to a limited extent, through patent layering.\(^3\) By marketing the hackneyed rationale of commercial incentive for innovation, these companies have been advancing their market exclusivity strategies,\(^4\) while obfuscating the market impact of predatory pricing to poorer segments of humanity.\(^5\) Impacted asymmetrically by this quintessential dichotomy, countries have walked divergent paths in formulating their respective patent systems.\(^6\)

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\(^3\) Patent layering can be seen as different from patent evergreening, when multiple characteristics of a single drug is used to obtain market exclusivity, without altering the active ingredients of the drug itself. Patent layering can also be seen as a subset within the broader connotation of patent evergreening, which conveys the meaning of market exclusivity extending strategy in general. While patent evergreening can be seen as a continuation mechanism to perpetuate or evergreen a prior proprietary status, patent layering can be seen as creating a portfolio from a single source, by utilizing various inherent characteristics of the source. Developing such a portfolio allows the benefit of multiple sequential temporal segments such that the portfolio acts as an extension of the source, thereby extending the original temporal segment into a bigger temporal segment.


\(^6\) Here I draw attention to the maximalist versus minimalist debate in intellectual property law. The term “maximalist” is used to describe a position/theme and emphasis is placed on the
The better part of the twentieth century witnessed two diametrically discordant patent regimes in the world. Riding a maximalist rights culture, pharmaceutical patents exploded in the developed nations. At the same time, concern for wider access to medicine prompted the developing countries to allow the low priced generic drug industries to thrive. Failure to balance the rights of both the innovator and those of the end users has allowed pharmaceutical giants to reap financial bonanza, while a lack of access to life saving drugs has caused millions of people to perish. The arrival of the Agreement on Trade Related Aspects of Intellectual Property Rights (“TRIPS”) in 1995 and its progeny, International Intellectual Property...
Agreements (“IIPA”),\(^{12}\) have consolidated the patent protection landscape in favor of the pharmaceutical giants. This has directly impacted the developing nations’ fight against evergreening and patent layering, as one hundred and fifty-nine members of the World Trade Organization (“WTO”) became obligated to relax their patentability standards.\(^{13}\) Under the threat of TRIPS, Indian patent law also needed a facelift.

Following its TRIPS obligation, Indian legislators rose up to the challenge of recalibrating its patent regime. Indian lawmakers introduced an amendment to the Indian Patents Act in 2005, carrying the aspirations of billions of impoverished citizens, inside India and abroad.\(^{14}\) The lawmakers amended Section 3(d), which quickly gained worldwide notoriety.\(^{15}\) This notoriety has grown even more since the Swiss Pharmaceutical giant Novartis failed at its § 3(d) challenge in the Indian Supreme Court.\(^{16}\) Novartis’ legal battle in India started in 2005, when the Indian Patent Office rejected its Gleevec patent application,\(^{17}\) which the company challenged, citing § 3(d)’s unconstitutionality and incompatibility with TRIPS.\(^{18}\) By the time Novartis’ appeal trekked its way through the Madras High Court and eventually in front of the Supreme Court, more than seven years passed.\(^{19}\) Despite the delays, the Supreme Court upheld both the Patent Office’s and the High Court’s core findings.\(^{20}\) Mixed reactions have greeted the ruling since then. Legal scholars have both defended and condemned the decision.\(^{21}\) Pharmaceutical companies have


\(^{14}\) See The Patents (Amendment) Act, No. 15 of 2005, INDIA CODE (2005), § 3(d) [hereinafter Amendment Act of 2005].

\(^{15}\) See George Best & Photon Rao, Drug Patenting in India: Potentially Lucrative, but a Difficult Task, 8 PHARM. L. & INDUS. REP. 46, 46 (2010).


\(^{18}\) Novartis Supreme Court Decision, supra note 17, ¶ 172.

\(^{19}\) Id.; Novartis AG v. Union of India & Ors. [2007] 2007 A.I.R. 24759, 4 MLJ 1153 (India Madras H.C.) [hereinafter Novartis Madras H.C. Decision].

\(^{20}\) Id.

\(^{21}\) See Dhanalakshmi Iyer, Analysis of Section 3(d) of Indian Patent Act, IP FRONTLINE (Apr. 9, 2012), http://www.ipfrontline.com/depts/printabletemplate.aspx?id=26756 (stating that “section 3(d) encourages sequential developments of existing products or technologies that help bring in improved products” into the marketplace): Manoj Pillai et al., Patent Procurement in India, INTELL. PROP. OWNERS ASS’N 1, 25 (2007) (noting that Indian Patent Law is more restrictive when examining
threatened to pull out of their Indian businesses.22 Countries have threatened to impose trade sanctions on India.23 Taking a retrospective look, these reactions have been either reactionary24 or purpose-driven.25 The analyses are either narrowly tailored,26 or have missed the decision’s broader themes.27 The multinational pharmaceutical companies and the patent attorneys backing them have been plainly biased in their respective agendas.28 This Article seeks to deconstruct such false narratives surrounding § 3(d).

Not many constitutional decisions from developing countries find themselves at the center of global debate, especially not in the manner of a constitutional invalidation, like that of Novartis’ Gleevec patent.29 These debates include the quintessential tension between maximalist rights paradigm versus minimalist patent framework,30 innovation suppression versus wider access to medicine,31 and pharmaceutical patent applications and will “likely require evidence of significantly higher efficacy in order to be granted.”.32

23 See Suchin Parashar, *India-US Ties are Under Stress Again, this Time Over Trade and Investment*, Times of India (Feb. 23, 2014), http://timesofindia.indiatimes.com/business/india-business/India-US-ties-are-under-stress-again-this-time-over-trade-and-investment/articleshow/30915237.cms (explaining that India is a priority foreign country (“PFC”) and a PFC tag “can allow the US to impose unilateral sanctions against India for domestic laws which deny benefits to the US under any trade agreement.”).
24 See Staton, supra note 22.
26 See Iyer, supra note 21.
27 Id.
28 A misplaced notion of potential revenue loss from reduced prosecution and due diligence activities from scope reduction in the patentability criteria may have been one of the catalysts for opposing the Novartis decision. Although Novartis relied on Section 3(d) as this Article has established, Novartis is also about preferring a minimalist regime over its maximalist counterpart. Yet, an adequate understanding of the minimalist paradigm’s scope can hardly justify the pervasive condemnation by professionals and pharmaceutical companies in erecting a harder stance against minimalist patent regimes. See Boyle, supra note 6 (discussing scope of minimalist paradigm in gene patenting).
31 See id. The basic premise of a patent is that the innovator should be compensated for proprietary ideas conceived and formulated in the innovation. Taken to its logical extension, the proposition holds that, if the commercial impetus is taken away, the frequency of innovation will decrease. If the frequency of innovation is decreased, the ideas may not arrive at the market place, which in turn might stymie discovery of life saving drugs. On the contrary, if the innovation
corporate monopoly rent-seeking practices versus the collective utility of social welfare. This Article captures these issues through the Novartis legal saga in India. The objective of this work is to get beyond the reactionary reviews of the Indian patent regime and seek a nuanced view of its doctrinal trajectory. The Article achieves this by deconstructing § 3(d) by focusing on its legislative intent, extracting its human rights dimension, and tracing its harmonizing elements. Section 3(d) of the Indian Patent Act introduced a new threshold of patent eligibility for pharmaceutical innovation that requires applicants to demonstrate enhanced efficacy of their products. Failing to satisfy this § 3(d) threshold, first at the Patent Office and later before the Madras High Court on appeal, Novartis’ suit arrived at the Indian Supreme Court. Centered on two distinct threads, Novartis argued for invalidating § 3(d)’s heightened threshold on account of its TRIPS incompatibility and unconstitutionality under the Indian Constitution. This Article addresses the merits of both of these challenges and seeks to rehabilitate § 3(d) within the global intellectual property landscape by shedding revelatory light on its genesis and implications. Amidst a flawed condemnation of Indian intellectual property regime, this work further recasts the patentability debate by tracing the TRIPS’ colonialist root within the quintessential maximalist vs. minimalist debate. This debate has thus far ignored the harmonization requirement of global patent law.

In Part II of this Article, I delve into a background analysis of the Novartis case. Here, Gleevec’s patent history and chemical composition, in conjunction with a chronology of Novartis’ legal journey through the India legal landscape, provides a context for the core issues before the Supreme Court. From the anatomy of the case, I move on to deconstructing the contentious Section 3(d) in two parts in Part III. Analyzing the text, motivation, and legislative development of the amendments in § 3(d) allows me to decode the efficacy standard and its implication for

that, shared heritage of humanity and our civilization’s human rights commitment makes it incumbent upon us to ensure medicine can be widely accessed by all individuals regardless of their ability to pay, which in turn would argue for reducing the scope of patent to relax the exclusivity enjoyed by the pharmaceutical companies. Within this protectionist paradigm, it is argued, resides the driving force for continued innovation in science and technology. This is a flawed argument, as it is the spirit of cooperation and mutual learning that has advanced human construct incrementally towards acquiring more meaning from existing process and objects. Moreover, most of today’s scientists work in the academia under the paradigm of publish-or-perish. Therefore, the search for a new product for the benefit of mankind cannot stop if the number of patents gets reduced, or the scope of patenting becomes restrictive, rather too much power at the hands of a corporation that develops a predatory practice that excludes the majority of the end user from enjoying the fruits of labor, especially if the products are pharmaceutical or biological in nature.

By its monopoly rent-seeking behavior, holders of patent extracts additional value by various means, imposing barriers to entry to other competitors, while foreclosing wider access to patented product. Thus, by such deterministic principles of patentability, exclusivity is fostered within society, economic incentive remains restricted to a limited few, and the majority is deprived of the fruits of labor, such as access to medicine.

32 See Amendment Act of 2005, supra note 14, § 3(d).
33 Novartis Supreme Court Decision, supra note 17, ¶¶ 15, 18, 190.
34 Id. ¶ 15.
35 The emerging connectivity of our existence and the shared evolution of our ways of life make it difficult to navigate within individual jurisdictional idiosyncrasies, which invites us to examine the need for harmonization in law across the different jurisdictions.
pharmaceutical scope reduction. I then examine § 3(d) TRIPS’ compatibility in Part IV. Reviewing the genesis of TRIPS and its contentious history provides a backdrop to view India’s intellectual property aspirations within its patent amendment. This leads me to examine Novartis’ expanded meaning and future implications in Part V. The Article concludes in Part VI, by establishing the main objectives of the work—which are to dispel the myth of § 3(d)’s TRIPS incompatibility, to unearth § 3(d)’s human rights dimension, and to rehabilitate India’s intellectual property regime amidst a global condemnation of its minimalistic viewpoint.

II. PATH TO THE INDIAN SUPREME COURT

Evaluating Novartis’ position requires contextualizing 3(d)’s genesis with patent history of Gleevec. In the late 1990s, the team of Ciba-Geigy scientists, led by Nicholas Lydon, Elisabeth Buchdunger, and Jurg Zimmerman, invented imatinib. The first series of patents covering imatinib and its various salts were filed in Switzerland in 1992 and in the EU, U.S., and other countries in 1993. Upon formation of Novartis, out of Ciba-Geigy’s merger with Sandoz in 1996, a new patent application on a specific polymorphic form, a beta-crystalline version of imatinib, was filed in Switzerland. This beta crystalline form of imatinib mesylate forms the active ingredient of the anti-cancer drug Gleevec, also known as Glivec. Between the years of 1997 and 1998, Novartis filed more patents covering this beta crystalline form in various countries. The company received FDA approval and its U.S. patent in 2001.

Despite having been granted patents protection in many countries between 1993 and 1998, Novartis did not get the opportunity to file a patent in India. Instead, it filed a “mailbox application” for patent in 1998. Prior to 2005, Indian patent regime did not allow patent filing for pharmaceutical drugs. Interestingly, the expansion

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61 Ragavan, supra note 40, at 1 (cataloguing that Novartis had over 35 patents covering the polymorphic form of Gleevec in various countries).
63 Ragavan, supra note 40, at 1.
of patent protection for Gleevec coincided with a transformation within Indian patent regime. As a precondition to joining the WTO, India was required to amend its Patent Law to allow pharmaceutical patents, which prompted the need to reformat its patent regime in compliance with the intellectual property norms under TRIPS.

Meanwhile, all patent applications were held in a mailbox waiting to be processed once the amendments came into force in 2005. In the interim, the patent applicants were granted Exclusive Marketing Rights (“EMR”). This allowed them to sell their products, while preventing competitors from producing and selling generic version of the drugs. Novartis received its EMR in 2003.

Under the terms of the EMR, the applicant was to automatically lose its exclusive marketing privilege if its pending patent application was rejected. The legal battle began soon after Novartis was granted its EMR. Novartis filed infringement suit against the generic companies that were producing Gleevec’s generic versions in India prior to 2003. The injunction against the generic companies saw the price of Gleevec skyrocketing in India. Against price increases of 1000 percent, the generic drug makers, cancer patient advocacy groups, and legal rights organizations brought pre-grant motions opposing the Gleevec patent. In

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45 See Understanding WTO, supra note 13 (noting that by July 2008, 153 countries were Member States in the WTO, including, in addition to the United States, Canada, and the European Union, many developed and developing countries in Asia, Africa, Central and South America, and the Middle East (e.g., China, India, Brazil, Rwanda, and UAE)).

46 TRIPS, supra note 11, art. 27.1.

47 Id. art. 65.4.

48 Id. art. 70.8(a)–(c). The amendments added were (a)–(c). Id.

49 Id. art. 70.9.


52 TRIPS, supra note 11, art. 70.9.


54 Id.

55 See Novartis Case: Background and Update—Supreme Court of India to Recommence Hearing, LAWYERS COLLECTIVE (Sept. 6, 2011), available at http://www.lawyerscollective.org/
support of their position, these stakeholders cited Gleevec’s (i) lack of novelty under anticipation, (ii) lack of added “efficacy” under Section 3(d), (iii) obviousness and (iv) wrongful priority.56 Three years later, Novartis’ patent application was rejected by the Chennai Patent Examiner’s Office on multiple grounds, chiefly relying on Section 3(d) of the newly amended Indian Patent Act.57 Thus, conceived out of India’s TRIPS obligation to allow instances of Gleevec patents to be filed, Section 3(d) became instrumental in rejecting Novartis’ right of market exclusivity in India.58 

Contextualizing 3(d)’s place in the Gleevec’s patent denial calls for reviewing two important issues: (1) how 3(d)’s efficacy requirement presents a higher threshold than what the patent applicants were accustomed to, and (2) specifics surrounding the chemistry of Gleevec. Knowing the chemical composition, reactivity, and characteristics of Gleevec aids our understanding of how the functionality of “efficacy” can be linked to evaluating patent eligibility of the pharmaceutical product in question under the newly minted Section 3(d) of Indian Patent Act.59 It is important to note that, for patent eligibility review, structural differences exist amongst the various versions of imatinib. Of particular importance is the difference between imatinib’s free base form and its beta crystalline form imatinib mesylate.60 With patent protection on thirty-five different forms of imatinib under its belt, Novartis had filed its Indian patent application for a particular polymorphic version, which is a methanesulfonic acid salt of imatinib.61 The task before the Indian patent system was to determine whether the methanesulfonic acid version of imatinib conveys a significant inventive step to warrant patent protection. Guided by the Section 3(d)’s enhanced efficacy standard, the issue for the patent examiner was to adjudicate whether the applied product contains significantly enhanced efficacy compared its prior variants.62 

Upon rejection of its patent application by the assistant controller of Patents,63 Novartis AG, along with its Indian subsidiary, Novartis India, filed two writ petitions in the Madras High Court.64 The petitioners sought a reversal of the Assistant Controller’s order by finding Section 3(d) invalid.65 Petitioners based their contention

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57 Amendment Act of 2005, supra note 14, § 3(d).

58 Id.

59 Id.

60 Ragavan, supra note 40, at 2.

61 Id. at 1–2.

62 Amendment Act of 2005, supra note 14, § 3(d).

63 See generally Novartis Madras H.C. Decision, supra note 19. Novartis’ contention that Gleevec was a new substance was rejected by the Assistant Controller of Patents and Designs. Id. ¶ 3. Observing that, although the new beta drug can be more effectively absorbed into the bloodstream, this bioavailability did not meet the improvement in efficacy as required by Section 3(d), and as a result, the patent application did not present a new substance. Id.

64 See id.¶ 1.

65 Id.
on two grounds: unconstitutionality on grounds of arbitrariness on part of the patent examiner\(^{66}\) and lack of merit in violation of India’s TRIPS obligations.\(^{67}\) In 2007, before the High Court could form its opinion, Novartis’ first petition was transferred to the Intellectual Property Appellate Board (“IPAB”)\(^{68}\)—a specialist tribunal set up to deal with appeals from the various intellectual property offices across the country pursuant to the Section 117G of the Indian Patent Act.\(^{69}\) In 2009, the IPAB amended the decision of the Assistant Controller of Patents and Design in part by holding that the product in question did not violate the novelty and non-obviousness criteria,\(^{70}\) but failed the test of enhanced efficacy under 3(d).\(^{71}\) Empowered by the Special Leave Petition (“SLP”) under Article 136 of the Indian Constitution,\(^{72}\) Novartis was able to challenge directly to the Supreme Court in 2009,\(^{73}\) which eventually led to the landmark decision of Novartis v. Union of India and Others on April 1, 2013 (“Novartis”).\(^{74}\)

The legal battle over the Gleevec patent was fought over ten years, covering issues from constitutionality of the amendments to the patent regime’s TRIPS compatibility.\(^{75}\) However, as the case found its way from the IPAB to the Supreme Court, the relevance of Section 3(d) gained primacy.\(^{76}\) It is time now to take a comprehensive look at the Section 3(d) of the Indian Patent Act.

\(^{66}\) Id. ¶ 1.

\(^{67}\) Id.

\(^{68}\) Novartis Supreme Court Decision, supra note 17, ¶ 15.


\(^{70}\) Novartis IPAB Order, supra note 17, at 186.

\(^{71}\) Id. at 189 (finding that the Appellant has failed to satisfy the efficacy requirement for its beta crystalline form of imatinib mesylate pursuant to section 3(d) of the Act).

\(^{72}\) INDIA CONST. art. 136, amended by The Constitution (Ninety-sixth Amendment) Act, 2011 (stating that the “Supreme Court may, in its discretion, grant special leave to appeal from any judgment, decree, determination, sentence or order in any cause or matter passed or made by any court or tribunal in the territory of India”).

\(^{73}\) See Novartis AG v. Union of India and Others, SLP (Civil) Nos. 20539-20549 of 2009, LAWYERS COLLECTIVE (Nov. 23, 2010), http://www.lawyerscollective.org/access-to-medicine/atm-current-cases.html [hereinafter Novartis, LAWYERS COLLECTIVE]: Novartis Supreme Court Decision, supra note 17.

\(^{74}\) Novartis Supreme Court Decision, supra note 17, at ¶¶ 193–94. Here I draw attention to the long drawn saga of Novartis’ fight with the Indian patent regime, which “eventually” was decided against Novartis, after appealing all the way to the Indian Supreme Court regarding the composition of the panel. Id.


III. CONTEXTUALIZING SECTION 3(d): THROUGH MOTIVATION AND LEGISLATIVE HISTORY

Much before the 2013 decision by the Indian Supreme Court, Section 3(d) had already been subjected to a mixed review.\textsuperscript{77} Pharmaceutical companies condemned its higher threshold of patentability for fear of losing their extended market exclusivity.\textsuperscript{78} Scholars lauded its mechanism for preventing pharmaceutical companies from extending their market exclusivity strategies.\textsuperscript{79} 3(d)'s legislative history of formulation is quite extensive. It reveals the lawmakers' motivations, which are both shaped by the Indian Constitution's commitment to health and colored by the aspirations of the millions relying on India as the only source of life saving drugs.\textsuperscript{80} It is important, therefore, to review 3(d)'s development history, in which the legislators had to grapple with the quintessential schism between the twin strands of patentability—a western-centric maximalist property view, and the developing countries' public utilitarian minimalist perspective.\textsuperscript{81}

\textsuperscript{77} See Iyer, supra note 21 (noting that India strictly limits the patenting of known medicines); Manoj Pillai et al., supra note 21, at 24, 25 (emphasizing that Indian Patent Law is more restrictive in the pharmaceutical context because section 3(d) was introduced to prevent "evergreening of patents" and made pharmaceutical patents a focal point of international debate). The response to 3(d) has been mixed. Advancing a western centric viewpoint, some commentators criticized the higher threshold of patentability implied in 3(d).


\textsuperscript{79} See NIHCN Study, supra note 2, at 4; Cynthia M. Ho & Ann Weilbaecher, An Introduction—PATENTS versus PATIENTS: Must We Choose, 18 ANNALS OF HEALTH 1, 4 (2009), available at http://lawecommons.luc.edu/cgi/viewcontent.cgi?article=1110&context=annals.


\textsuperscript{81} See Ho, supra note 30, at 1049.
A. Motivation and Context of Section 3(d)

The latter part of the twentieth century witnessed pharmaceutical giants becoming successful in extending market exclusivity of their products in the developing countries predominantly via two pathways. In the first, a strict property rights paradigm took root within the various international trade agreements like TRIPS. In the second, a narrative of commercial impetus for incremental innovation as a precondition for wider access to life saving drugs has allowed companies to dictate patentability dialogues. This allowed pharmaceutical companies to shape patent regimes favoring market exclusivity extension mechanisms in many developing countries. The reality of life-saving drugs drifting out of reach for the poor has not gained much traction in these discussions. Dangling the carrot of membership to global trade organization was enough incentive for developing countries to acquiesce into asymmetric bargaining power through TRIPS. This in turn has allowed the imposition of strict property rights based on patentability regimes, where each incremental innovation has become subject to patent protection for the continuation of corporate monopoly rent-seeking. As such, evergreening and patent layering has now become the norm in patentability frameworks.

Evergreening is a term for corporate maneuvering where a product manufacturer continues to extract patent protection on an originally patented product for successive designated periods on more than one attribute, even though

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82 See Peter K. Yu, TRIPS and Its Discontents, 10 MARQ. INTELL. PROP. L. REV. 369, 370–79, 383 (2006) (“[I]t is no surprise that less developed countries have been concerned about the heightened protection required by the TRIPs Agreement and its deleterious impact in the areas of agriculture, health, environment, education, and culture.”). While the U.S. and the U.K. led the neo-liberal movement that imposed western strict constructionist view of property rights into the various free trade agreements, U.S. laws eventually shaped the TRIPS agreements by imposing its norms into the framework through the WTO mechanism. This view is corroborated by scholars who see TRIPS as a product of unequal bargaining between developed and developing countries, where instead of exchange of norms, asymmetric modalities have been coerced upon the developing countries in the name of global harmonization. Therefore, instead of being left out, developing countries accepted the requirement of the imposition of strong intellectual property rights within their domestic legal regimes in order to enjoy the benefits of international trade.

83 Id. at 390.

84 Maximalist viewpoint of patent protection has allowed pharmaceutical companies in the United States to utilize various market exclusivity extension strategies to maintain their patent protections. The National Institute of Health Care Management Research and Education Foundation conducted a study in May 2002 and found that, between 1989 and 2000, only 35% out of the 1035 new drugs approved by the USFDA entailed a new active principle. See NIHCM Study, supra note 2, at 3. In other words, pharmaceutical companies were able to extend the lives of nearly two-thirds of their already-patented drugs by making alterations to the drugs’ methods of production, forms, or uses.

such attributes can be linked to a single product. The U.S. National Institute of Health Care and Medicines took notice of this strategy as there was a concerted effort by some companies to patent even minor modifications of an original product: “[d]rug manufacturers patent a wide range of inventions connected with incremental modifications of their products, including minor features such as inert ingredients and the form, color, and scoring of tablets.” Section 3(d) was designed to prevent this, as the following discussion of the text and explanation of the statute would reveal. Section 3(d) reads as follows:

(d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

Explanation—For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy.

Thus, 3(d) establishes an extra layer of deterministic criteria in the patent eligibility framework. This specific layer stipulates that, only those pharmaceutical derivatives that can be demonstrated to exhibit significantly enhanced efficacy are eligible for patent protection. This added layer would be a step towards real innovation as opposed to claiming innovation on minor enhancement. Therefore, this extra layer requiring enhanced efficacy would help in preventing fraudulent or superfluous patent applications that are routinely sought through evergreening or patent layering.

Developments in both organic and inorganic chemistry, along with advancement in quantitative techniques, opened much larger possibilities of product formation via chemical reactions. By slight alteration of chemical bonds, or simple

87 NIHCM Study, supra note 2, at 16.
88 Amendment Act of 2005, supra note 14, § 3(d).
89 Id.
90 Id. (emphasis added).
91 Id. See also Novartis Supreme Court Decision, supra note 17, ¶ 103 (conducting a thorough review of prior, existing and emerging patent landscape of India and taking stock of the legislative history of the 2005 law, the Indian Supreme Court observed that Section 3(d) was meant to create a “second tier of qualifying standards” for chemical substances to combat “any attempt at repetitive patenting or extension of the patent term on spurious grounds”).
92 See infra Part IV.
modification in starting reactions, a range of derivative products can be obtained from an original product. Under a maximalist patent regime, pharmaceutical companies can obtain market exclusivity on a wide range of related products, from the original compound to its derivatives, which may arrive in varied chemical structures, such as salts, polymorphs, and isomers. As each subsequent variant of a compound is structurally equivalent to the original, either in their naturally existing forms, or as known pharmaceutical substances, it is more likely than not that these structurally similar substances are functionally equivalent. Therefore, 3(d)'s requirement of enhanced efficacy of the derivative is more effectively shown by observing its chemical interaction with other chemical compounds that offer the most significant reactivity.

The statute for 3(d) calls for a patent eligible product to be “efficacious,” or have the attribute of enhanced efficacy over a prior known form, regardless of whether the invention is incremental or groundbreaking. Here, 3(d) creates a “floor” in demonstrating “efficacy,” while charting a layered patentability framework for pharmaceutical products. Therefore, in order to claim patent, the onus of proving enhancement—that of improved and enhanced functionality—would fall on the patent applicant. Thus, imposition of this simple demonstrability barrier for claiming a patent should be recognized as a process or instrumentality of bringing improved chemical compounds to the market to make significant contributions as pharmaceutical agents. This efficacy step certainly can distinguish between patent applicants that arrive via evergreening and those that contain a rigorous inventive step. Therefore, by making it mandatory for derivatives of known substances to exhibit added efficacy, 3(d) encourages sequential development of improved products to address significant public health needs.

93 See Chandra, supra note 29, at 391.
94 Id.
95 Id.
96 Id.
97 See infra Part IV.
99 Id. at 238–39.
100 Amendment Act of 2005, supra note 14, § 3(d); Basheer & Reddy, supra note 98, at 239.
B. A Chemical Composition Analysis

From the chemistry of the products, Novartis’ Gleevec represents a transition from the discovery of the original free base to a polymorphic salt that is identified as a useful drug.\textsuperscript{102} To contextualize Gleevec’s chemical characteristics in light of 3(d)’s requirement, let us briefly review the highlighted steps in its U.S. Patent.\textsuperscript{103}

1. The product in question focuses on a derivative obtained via synthesis of the imatinib free base, a compound that was patented in the U.S., EU and several other countries between 1993 and 1998.\textsuperscript{104} As India did not provide product patents for pharmaceutical substances at that time, this could not be patented in India.\textsuperscript{105}

2. Imatinib mesylate was developed by adding methanesulfonic acid to the imatinib free base, which converted the drug from a free base to a salt.\textsuperscript{106}

3. The polymorphic form of imatinib, a beta crystalline variant of imatinib mesylate, has been recognized as the most stable form of the salt. Novartis filed its patent application for this particular product and it is this application that has been the focus of dispute in this patent saga.\textsuperscript{107}

4. The anti-cancer drug Gleevec is based upon the above beta crystalline form of imatinib mesylate.\textsuperscript{108}

The 3(d) framework would require Novartis to demonstrate that Gleevec—the beta crystalline form of imatinib mesylate—has an enhanced effectiveness over the original imatinib free base.\textsuperscript{109} However, doing so under the 3(d) criteria would require the applicant to first identify an appropriate benchmark to claim such effectiveness.\textsuperscript{109} In its application, Novartis submitted that the new beta crystalline form can be absorbed more easily into the blood stream,\textsuperscript{111} and this superior bioavailability can be used as a benchmark to measure enhanced efficacy.\textsuperscript{112} This

\textsuperscript{102} See Chandra, supra note 29, at 391.
\textsuperscript{103} U.S. Patent No. 5,521,184 (filed Apr. 28, 1994); see also E.P. Patent No. 0,564,409 (filed Mar. 25, 1993).
\textsuperscript{104} ’184 Patent, at [22], [30], [45].
\textsuperscript{105} Basheer & Reddy, supra note 98, at 239.
\textsuperscript{106} Id.
\textsuperscript{107} Id.
\textsuperscript{108} Id.
\textsuperscript{109} See Chandra, supra note 29, at 387 (stating that the “new Act’s section 3(d) limits patents only to chemical entities that employ at least one new reactant”).
\textsuperscript{110} Basheer & Reddy, supra note 98, at 238–39.
\textsuperscript{111} Novartis Supreme Court Decision, supra note 17, ¶ 188.
\textsuperscript{112} Here bioavailability refers to the absorption—a physical process where molecules of the original compound enters the spaces between the molecules of the solvent. It does not refer to a more transformative binding stage of the drug in question. Thus, it cannot be used as a benchmark for measuring efficacy of a drug. Id. ¶ 184; see also Lalitha, supra note 56, at 239.
line of argumentation lacks structural merit, as the heightened absorption—easier accumulation into the blood stream—does not meet the necessary criteria of increased efficacy under Section 3(d). This was duly noted by the Supreme Court in rejecting Novartis’ claim.

Let us impart additional color to the efficacy discussion. To achieve enhancement in a characteristic, the first step is to identify an appropriate benchmark. Therefore, to obtain an effective benchmark, in going from a prior product to a newer product, the applicant must address the difference between the original target outcome and the new intended target outcome. We present a hypothetical scenario to illustrate the point.

A pharmaceutical company PC, having enjoyed the exclusivity of patent protection for 18 years for its blood pressure medication BPR1, introduces in the market a new product BPR2. BPR2 is a derivative of BPR1 with the following results in random clinical trials prior to patent application: (i) the average decrease of blood pressure in switching from BPR1 to BPR2 has not been statistically significant; (ii) the average reduction of side effect from muscle pain in BPR2 is statistically more significant in comparison to BPR1. Could this be a demonstration of BPR2’s enhanced efficacy over BPR1 and thus, patent eligible?

To capture the essence of above illustration, it must be noted that, the idea of efficacy must revolve around improving the target condition for which the original drug obtained its patent. Thus, in the case of the beta crystalline form of Gleevec, merely showing an enhanced hygroscopic attribute of easier absorption cannot be determined as a criterion for enhanced efficacy. Similarly, a mere reduction of a side effect must not be construed as satisfying the heightened standard of 3(d).

This was the position held by the patent office and was subsequently upheld by the Supreme Court. However, the issue of efficacy is a loaded term that warrants further evaluation, as a series of questions can be raised.

For example, under what framework can we authenticate that the beta crystalline form lacked efficacy? What does the term efficacy mean? Can “therapeutic efficacy” be functionally equated with efficacy under Section 3(d)? What are some of the ways to construct benchmarks to measure efficacy for new inventions in pharmaceutical products space? Although the Novartis decision by the Supreme Court presented one view, the argument surrounding efficacy is not over yet. Efficacy was a vehicle that the lawmakers introduced to fulfill their objective of creating balance between a maximalist property rights framework and a wider utilitarian theme. Now is the time to retrace some of the legislative history and public sentiments that embodies Section 3(d).

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113 See Novartis Supreme Court Decision, supra note 17, ¶ 187.
114 Id. ¶¶ 187–88, 190, 191.
115 Id. ¶ 189, 195.
116 Id. ¶ 195.
117 Id. ¶ 180 (stating that efficacy means “that ability to produce a desired or intended result”).
C. Legislative History of Section 3(d)

Reviewing the landscape of the Indian Patent Act reveals that Section 3(d) is not a sudden trajectory reversal, nor has it been a reactionary response to an altered socio-political landscape. Rather, 3(d) should be seen more as an organic enhancement within the corpus of patentability within the broader Indian intellectual property movement. Several other sections and chapters within Indian Patent law have been the precursor of Section 3(d).

Multi-layer patent eligibility criteria are nothing new within the Indian patentability framework, as has already been enshrined in the statutory provisions within Section 2 of the Indian Patent Act. Section 3 instead provides clear guidance to delineate amongst invention, patentable inventions, and patentability for incremental inventions. The Indian Supreme Court duly corroborated this in noting that, “Section 3 of the Patent Act, which provided for exclusions from

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118 The 1970 Act, supra note 44, §§ 2(1)(j)(i–iii), 2(1)(l)(i–v), 3(a–i). Section 2 contained the definition and interpretation clauses. It also defined the terms “invention” and “medicine” in clauses (j) and (l) respectively as under subsection 1. Invention means any new and useful:

(i) art, process, method or manner of manufacture; (ii) machine, apparatus or other article; (iii) substance produced by manufacture, and includes any new and useful improvement of any of them, and an alleged invention.

Id. § 2(1)(j). Medicine or drug includes:

(i) all medicines for internal or external use of human beings or animals, (ii) all substances intended to be used for or in the diagnosis, treatment, mitigation or prevention of diseases in human beings or animals, (iii) all substances intended to be used for or in the maintenance of public health, or the prevention or control of any epidemic disease among human beings or animals, (iv) insecticides, germicides, fungicides, weedicides and all other substances intended to be used for the protection or preservation of plants; (v) all chemical substances which are ordinarily used as intermediates in the preparation or manufacture of any of the, medicines or substances above referred to.

Id. § 2(1)(l). Sections 1 and 2 comprised Chapter I, following which Chapter II was headed Inventions not patentable. Chapter II had three sections which, as originally framed, are as under Section 3:

What are not inventions. The following are not inventions within the meaning of this Act.—(a) an invention which is frivolous or which claims anything obviously contrary to well established natural laws; (b) an invention the primary or intended use of which would be contrary to law or morality or injurious to public health; (c) the mere discovery of a scientific principle or the formulation of an abstract theory; (d) the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant . . . .

Id. § 3.

119 See id.
patentability, was recast.”\(^{120}\) Furthermore, examination of the relationship between the current version of Section 3(d) and Section 83 of Chapter 16 (“hereinafter Section 83”), reveals a commitment for commercial incentive for innovation, which is punctuated with distinctions among classes of innovations along a patent eligibility framework.\(^{121}\) In general, Section 3 of the Patent Act provides various exclusionary provisions.\(^{122}\) Section 83 specifically addresses how patent law can be made consistent with a nation’s social justice obligations in encompassing a utilitarian theme by specifically adopting public welfare objectives.\(^{123}\) Unfortunately, this minimalist paradigm is in sharp contrast to the property rights-focused maximalist patent framework that came to embody the reformatting needs of developing countries under TRIPS in the 1990s.\(^{124}\)

Therefore, the condemnation of 3(d) has to be evaluated through multiple competing dimensions. First, 3(d) symbolizes a utilitarian themed patent paradigm that is inconsistent with the western viewpoint on intellectual property protection.\(^{125}\) Second, the neo-liberal drive to incorporate western property rights ideals within TRIPS’ process instrumentalities does not comport with the social justice-centric equality paradigm of 3(d).\(^{126}\) Yet the Indian lawmakers ensured that the social justice component remained an integral part and that corporate monopoly rent-seeking practices do not supersede broader public utility in their amendment to the Indian Patent Act.

Keeping in view Section 3(d)’s shared ancestry with Section 83, further reviewing its implications and objectives would not be out of place. Section 83 balances both fundamentals—India’s treaty obligations and India’s commitment to social and economic welfare for the masses.\(^{127}\) Section 83, therefore, provides for

\(^{120}\) See Novartis Supreme Court Decision, supra note 17, ¶ 73.


\(^{122}\) See Basheer & Reddy, supra note 98, at 238.

\(^{123}\) Amendment Act of 2002, supra note 121, § 83(d)–(g). Section 83 of Chapter 16, through items (d) through (g) stipulates the following:

(d) that patents granted do not impede protection of public health and nutrition and should act as instrument to promote public interest specially in sectors of vital importance for socioeconomic and technological development of India; (e) that patents granted do not in any way prohibit Central Government in taking measures to protect public health; (f) that the patent right is not abused by the patentee or person deriving title or interest on patent from the patentee, and the patentee or a person deriving title or interest on patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology; and (g) that patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public.

Id.

\(^{124}\) See Yu, supra note 82, at 370–80.

\(^{125}\) See infra Part IV.

\(^{126}\) Id.

\(^{127}\) Novartis Supreme Court Decision, supra note 17, ¶ 68.3. The Statement of Objects and Reasons for the Amendment Act of 2002 observes the following:
commercial impetus through a layered patentability criterion, where in specific subsections, it erects barriers for flawed extension of market exclusivity. This then ensures that the rights and obligations of all stakeholders are recognized within the patent regime. More specifically, the Section prohibits patents that would otherwise impede advancement in public health and nutrition.

Section 83 is very thorough in charting specific exclusionary guidelines in bringing to light an intellectual property regime committed to social justice in ensuring equality of all stakeholders. Thus, it refuses to provide a patentability umbrella for a range of products that includes: (i) product patents that might interfere with the federal government's actions in protecting public health, and (ii) product patents that might pose significant barrier towards making necessary drugs available to the low income people at reasonably affordable prices. Such social justice threads of Section 83 are the intellectual precursor to Section 3(d). Clearly, therefore, with the necessary ground already established, 3(d) has simply followed a predictable trajectory.

Now, to further contextualize Section 3(d), its relationship with the main Chapter 2 is worth recognizing. Within the Indian Patent Act, Chapters 2 and 3, taken in conjunction, create a framework that neatly delineates between inventions that are not patentable with those that are patentable. With the overall objective of Section 3 to provide guidelines for what are not inventions, additional clarity is introduced in 3(d). Both Chapters 2 and 3 also provide a nuanced linkage between inventions and patentable elements. When two dichotomous elements have been juxtaposed, they are granulated by distinguishing between (i) a class that recognizes

[while considering amendment to the Act, efforts have been made to make the law not only TRIPS complaint but also to provide therein necessary and adequate safeguards for protection of public interest, national security, bio-diversity, traditional knowledge, etc. Opportunity is also proposed to be availed of for harmonising the procedure for grant of patents in accordance with international practices and to make the system more user friendly.]


129 Carlos M. Correa, \textit{Public Health and Patent Legislation in Developing Countries}, 3 TUL. J. TECH. & INTELL. PROP. 1, 3 (2001) (noting that TRIPS type intellectual property regimes can have such pronounced impact on access to medicines revolving around "life-or-death consequences").

130 \textit{Id.} at 4.

131 See Amendment Act of 2002, \textit{supra} note 123: \textit{Novartis Supreme Court Decision, supra note 17, ¶ 17} (“We have borne in mind the object which the amending Act wanted to achieve namely, to prevent evergreening: to provide easy access to citizens of the country to life saving drugs and to discharge their constitutional obligation of providing good health care to its citizens.”).

132 \textit{Id.} \textit{Novartis Supreme Court Decision, supra note 17, ¶ 42.}

133 \textit{Id.} ¶¶ 45–46.

134 The 1970 Act, \textit{supra} note 44 (stating under Chapter II what inventions are not patentable, whereas Chapter III discusses how to apply for patents under the Act).

135 \textit{Novartis IPAB Order, supra note 17, at 186.}

136 \textit{Id.} at 179 (stating that the "patentability of an alleged invention is basically determined by establishment of novelty (anticipation), inventive step and industrial applicability of a product or a process [section 2(1)(j), and 2 (1) (l) of the Act] to the exclusion of inventions which are not patentable listed in section 3 and 4 of the Act.").
that certain products may not be deemed inventions, and (ii) the other class that indicates that despite being inventions, certain products may not be granted patents based on other considerations, such as lacking a specifically articulated criterion. Clearly, the exclusionary criterion enshrined in 3(d)'s efficacy test has its origin within the meaning of these sections of the Indian Patent Act. Combining this linkage with the legislative history behind 3(d) provides us with an important baseline through which to evaluate the historical viability, and thus, the constitutionality of Section 3(d) within the Indian constitutional framework.

The genesis of 3(d) is linked to Indian patent regime's obligation to the developing world. In the eyes of the developing and the least developed nations, India is a messianic figure that provides for life saving drugs to the millions of poor and uninsured. In recognizing India's status as the pharmacy for the world's poor, the legislators paid careful attention to the growing apprehension that abuse of product patent in medicine might lead to widespread deprivation of life saving medicine. Thus, prompted by their fear in extending excessive monopolies to pharmaceutical companies, the lawmakers debated over words and explanations that

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138 Novartis Supreme Court Decision, supra note 17, ¶ 76. Commenting on the legislative process prior to the enactment of 3(d) in its Patent Law, the Indian Supreme Court observed:

Parliament had an absolutely unenviable task on its hands. It was required to forge, within a very limited time, an Act that would be TRIPS compliant without, in any way, compromising on public health considerations. It is seen above that the TRIPS Agreement had aroused grave concerns about its impact on public health. India had learnt from experience the inverse relationship between product patents and the indigenous pharmaceutical industry, and its effects on the availability of essential drugs at affordable prices. It is also seen above that after the patent system in India barred the grant of patents for pharmaceutical and chemical substances, the pharmaceutical industry in the country scaled great heights and became the major supplier of drugs at cheap prices to a number of developing and under developed countries. Hence, the reintroduction of product patents in the Indian patent system through the TRIPS Agreement became a cause of alarm not only in this country but also for some international agencies.

Id. This sentiment was corroborated by the following excerpts from a letter from the HIV/AIDS Director of the World Health Organization (“WHO”), dated December 17, 2004, to the Minister of Health and Family Welfare, Government of India:

We would like to bring to your attention that several of our Member States have expressed their concern that in the future, generic antiretroviral drugs from India may no longer be available to them. Among other places, these concerns were expressed by the delegations of Ghana, Lesotho, Malawi, and Namibia at our recent Procurement & Supply Management (PSM) Workshop in Nairobi, Kenya (2–9 December, 2004), and by Bangladesh, Cambodia, China, Indonesia, Korea, Laos, Thailand, Papua New Guinea, and Vietnam at the Asian Regional Workshop on the WTO/TRIPS Agreement and Access to Medicines held in Kuala Lumpur, Malaysia (28–30 November 2004).

Id.
can carry lasting and impactful meaning for the amended Section 3(d). Thus, when the phrase “the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance” was added to the original Section, the focus was on life saving medicines and drugs, which also have constitutional imprimatur within the Indian context.

139 Id. ¶ 80. During the debate surrounding the passage of the bill in the Indian Parliament, one law maker observed:

India has benefited from the low cost generic industry to dominate 30 per cent of the low cost drugs in the world. Secondly, it (the bill) is vague about the evergreening effect in which companies extend their patent rights by switching from capsules to tablets, for instance. This extends monopolies. Parliament must make sure that it protects the rights of India to make these generic drugs. We should remove the provision that allows this evergreening. What should and what should not be patentable has also been left open to interpretation. Earlier, the new use for a substance could not be patented. Now this has been qualified to allow it by putting “mere new use” instead of “new use.”

Id. Similar sentiment was echoed by another lawmaker:

Sir, a company which obtains a patent by changing their chemicals, before the expiry of the patent, they will again apply for a patent and again get a patent. So, in this way, they will continue to get a patent for the same medicine. For example, the drug called ‘Glevic’ (sic Gleevec/Glivec), is used for the treatment of Leukaemia. It is patented by Novartis. This was originally patented in 1993. The cost of the drug for the treatment of this disease comes to about Rs.1,20,000 per month in India. At the same time, the generic versions are available in the country which cost only Rs.8,000 to Rs.10,000.

140 Id. ¶ 83. Unique in its statutory implication and unparalleled as a patentability criteria, Section 3(d) incorporates the widely used patent eligibility criteria of “innovativeness” by borrowing the drug regulatory term “efficacy” as a bright line rule for determining the patentability of pharmaceutical inventions. On the surface, the procedural instrumentality seems straightforward, but the application leaves open the possibility of interpretation due to the requirement of selecting measurement benchmark. “Efficacy” has been borrowed from the European Union Directive on drug regulation, which states:

a medicinal product which has the same qualitative and quantitative composition in active substances and the same pharmaceutical form as the reference medicinal product, and whose bioequivalence with the reference medicinal product has been demonstrated by appropriate bioavailability studies. The different salts, esters, ethers, isomers, mixtures of isomers, complexes or derivatives of an active substance shall be considered to be the same active substance, unless they differ significantly in properties with regard to safety and/or efficacy. In such cases, additional information providing proof of the safety and/or efficacy of the various salts, esters or derivatives of an authorised active substance must be supplied by the applicant.

141 THE CONSTITUTION OF INDIA, Nov. 26, 1949, Part IV, art. 47. Any development within the Indian legal system, India’s international treaty obligations must have to be balanced with its constitutional adherence to the promotion of health and human rights. Thus, reformatting its
The above provides a snapshot of legislators’ extensive due diligence and prolonged discussions in enacting 3(d). It also opens a window into the burdens legislators had to carry in structuring this amendment. Revealed in various letters and pleas, the amendments to Indian patent law carried with it the hopes of many developing countries, where purchasing life saving drugs at the world market prices continue to be beyond reach of the majority. Prompted by their responsibility to ensure a semblance of equality in public access to medicine, these lawmakers evaluated every word within the amended Section. By duly incorporating additional words, such as, “the mere discovery,” the legislators attempted to narrow the scope of patentability for highly specialized drugs, with a clear agenda to ensure that they never go beyond the reach of the poor.

The amended version of 3(d) is a product of legislative intent. And if the legislators are the representatives of the people of the country, the language of 3(d) represents the collective intent of its citizens. TRIPS incompatibility or asymmetric trajectory relative to the global corporate viewpoint should certainly be subservient to these sentiments.

D. Preventing Evergreening—The Primary Objective

Thrust upon the world scene with an objective of leveling the playing field for pursuing access to life saving drugs, Section 3(d) had an eventful arrival. Challenged by a very powerful pharmaceutical giant in its introductory invocation, 3(d) has already travelled a contentious road, a road rarely travelled by the maximalist patent paradigms. Yet, if Indian patent regime were to rise up to its obligation to its utilitarian fundamentals, the amendment must embody opposition to patent regime required balancing its TRIPS obligation with its constitutional mandate towards the protection of public health. For anecdotal examples of how the right to health has been a strong constitutional force in Indian courts, see generally Saby Ghoshray, Searching For Human Rights To Water Amidst Corporate Privatization In India: Coca-Cola V. Perumatty Grama Panchayat, 39 GEO. INT'L. ENVTL. L. REV. 643 (2007). Against this constitutional landscape, Article 47 and 39 (e)–(f)’s duty to improve public health must be taken into consideration to properly evaluate the genesis of Section 3(d) within India’s Patent law. See the “Directive Principles of State Policy” found in Part IV, that states, “The State shall regard . . . the improvement of public health as among its primary duties . . .” CONST. INDIA art. 47; see also CONST. INDIA art. 37, 39(e)–(f). However, the Supreme Court of India has declared, “it is now settled law that right to health is integral to right to life,” Punjab v. Chawla, A.I.R. 1997 S.C. 1225. With almost uncanny similarity to the United States’ Due Process clause, the relevant Section notes, “No person shall be deprived of his life or personal liberty except according to procedure established by law.” CONST. INDIA art. 21.

142 See supra notes 138–141.
143 See supra note 138 and accompanying text.
144 See Novartis Supreme Court Decision, supra note 17, ¶ 76.
145 See supra notes 138–141 and accompanying text.
146 Novartis Supreme Court Decision, supra note 17, ¶ 83.
147 See supra notes 138–141.
148 See Novartis Supreme Court Decision, supra note 17, ¶ 76.
149 See id., ¶ 15.
150 Id.
evergreening and patent layering.\textsuperscript{151} Section 3(d) presents such opposition; yet, it allows meaningful inventions to have commercial success. However, developing a robust definitional paradigm for meaningful innovation that is not contradictory to social justice principles is a challenge. And the answer to that challenge was introducing “efficacy.”\textsuperscript{152} Unfortunately, however, the requirement and significance of efficacy in the context of 3(d) has not been adequately evaluated.\textsuperscript{153}

Maximalist patent framework does not typically endorse an additional preventive layer of efficacy or a meaningful inventive step such that a broad range of innovations could be subject to patentability.\textsuperscript{154} A trifling change or minimal modification in the existing product could become subject to new patent claim.\textsuperscript{155} In this paradigm, a new coverage is envisaged by crafting simply a newer invention and the patentee could garner exclusive rights over such minor modification of the original.\textsuperscript{156} And the process can continue forever, as Figure 1 illustrates.

\textsuperscript{151} See id.

\textsuperscript{152} Novartis Madras H.C. Decision, supra note 19, ¶ 3.

\textsuperscript{153} Id.

\textsuperscript{154} Alan Devlin, Patent Law’s Parsimony Principle, 25 BERKELEY TECH. L.J. 1693, 1709 (2010) (stating generally that a maximalist approach provides patentees with the greatest level of protection for their innovation).


\textsuperscript{156} See id.
**Figure 1: Evergreening Delaying Wider Access to Medicine**

- **Original Drug:** 20-year patent awarded
  - Drug available at $26,000/year
  - **Modified Drug:** New Dosage
    - Additional patent awarded
  - **Modified Drug:** New Reactivity
    - Additional patent awarded
  - **Modified Drug:** New Formula
    - Additional patent awarded
  - Generic Drug allowed after 60 years
  - Drug available at $150.00/year
The scenario above could stymie competition, while the original patentee continues on extracting monopoly rent.\footnote{See Discussion, supra Part III.} This could also decimate the interests of other stakeholders within the framework.\footnote{See Discussion, supra Part III.} Therefore, in order to obtain a patent under the Indian patent regime, an applicant having an existing patent who may have incorporated a insignificant change or a minute enhancement is confronted with a second layer of eligibility criteria.\footnote{See Novartis Supreme Court Decision, supra note 17, ¶ 103. The court stated: The amended portion of section 3(d) clearly sets up a second tier of qualifying standards for chemical substances/pharmaceutical products in order to leave the door open for true and genuine inventions but, at the same time, to check any attempt at repetitive patenting or extension of the patent term on spurious grounds. Id. ¶ 100.} Section 3(d) specifically mentions, “a mere discovery of a new form of a known substance”\footnote{Id. ¶ 100.} is unable to ever meet the threshold of novelty and inventive step, pursuant to clauses j\footnote{Id.} and j(a)\footnote{Id.} of Section 2(l)\footnote{Id.} of the Indian Patent Act.

Residing within the deeper meaning of discovery is a spirit of heightened novelty threshold. The clauses j and j(a) of the Indian Patent Act have responded to this by requiring a specific inventive step. Because j and j(a) were incorporated prior to 3(d), the development of 3(d) should be seen within a continuum with these two clauses. Thus, 3(d)’s imposition of an extra layer of qualifying standard of patentability in the form of efficacy should be recognized as coming from continuity, not via arbitrary imposition.\footnote{See id.}

Arbitrariness was featured in Novartis’ challenge and therefore, requires further evaluation.\footnote{Novartis Madras H.C. Decision, supra note 19, ¶ 13 (stressing that under 3(d), patent applicants have to show increased efficacy especially if the discovery is only a derivative of a known substance): see also Novartis Supreme Court Decision, supra note 17, ¶ 104.} Novartis invoked arbitrariness to invalidate 3(d) by arguing its contradiction with the fundamental right of equality.\footnote{See Novartis Supreme Court Decision, supra note 17, ¶ 18; Madras High Court Dismisses Novartis’ Petitions, THE HINDU, Aug. 7, 2007, http://www.thehindu.com/todays-paper/tp-national/madras-high-court-dismisses-novartis-petitions/article1887489.ece [hereinafter High Court Dismisses].} Novartis submitted that efficacy has not been defined in the original patent act and thus, is subject to
capricious invocation by the patent controller.\textsuperscript{167} Clearly, the appellant has ignored the statutory history of how the extra layer has come to be codified within Indian law, and by which efficacy came to encapsulate the legislative intention of that development.

Section 3(d) simply puts a second layer of qualifying standards for pharmaceutical products.\textsuperscript{168} Yet it does not foreclose genuine inventions.\textsuperscript{169} This allows for true inventions to get the necessary patent protection, while rejecting any attempt at repeatedly patenting or extending the patent term on spurious grounds. Moreover, 3(d) sits at the intersection of patentability and invention.\textsuperscript{170} For example, if the clause (d) is decoupled from the remainder of Section 3,\textsuperscript{171} and the original legislative history of the Patent Act of 1970\textsuperscript{172} is forgotten, then Section 3(d) can be seen as an extension of the definition of invention. In such case, if the clauses j and j(a) of the Section 2(1) are combined with Section 3(d), on the superficial level, it might appear that the Act creates multiple layers with diverging standards for inventions for different product classes.\textsuperscript{173} However, if Section 3(d) is read in conjunction with the entire legislative history of the original Act,\textsuperscript{174} its 2005 amendment,\textsuperscript{175} and the relevant clauses of Section of 2(l),\textsuperscript{176} Section 3(d) is revealed in its cogent implications and robust applications.\textsuperscript{177}

\textit{E. Deconstructing Efficacy of 3(d)}

The word efficacy appears within both the text and explanation of 3(d).\textsuperscript{178} Linguistically, efficacy means, “the ability to produce a desired or intended result.”\textsuperscript{179}

\textsuperscript{167} \textit{Novartis} Madras H.C. Decision, supra note 19, ¶ 14: \textit{High Court Dismisses,} supra note 165.
\textsuperscript{168} \textit{Id.} ¶ 104.
\textsuperscript{169} Jitesh Kumar, \textit{The Glivec Case: Getting Beyond Efficacy, LIFE SCIENCES INTELL. PROP. REV.} (Feb. 19, 2014), \url{http://www.lifesciencesipreview.com/article/the-glivec-case-getting-beyond-efficacy}.
\textsuperscript{170} See infra, Part IV.
\textsuperscript{171} See \textit{Novartis} Supreme Court Decision, supra note 17, ¶ 104.
\textsuperscript{172} Id.; see also Shamnad Basheer, \textit{India’s Tryst with TRIPS: The Patents (Amendment) Act 2005,} 1 INDIAN J.L. & TECH. 15, 18 (2005), available at \url{http://www.nls.ac.in/students/IJLT/resources/1_Indian_JL&Tech_15.pdf} (citing N.R. AYYANGAR, COMMITTEE REPORT ON THE REVISION OF PATENTS LAW (1959)).
\textsuperscript{173} See infra, Part IV.
\textsuperscript{174} See \textit{Novartis} Supreme Court Decision, supra note 17, ¶ 104.
\textsuperscript{175} See \textit{id.} ¶¶ 102, 103.
\textsuperscript{176} \textit{Id.}
\textsuperscript{177} See \textit{id.} ¶¶ 102, 103.
\textsuperscript{178} \textit{Amendment Act of 2005,} supra note 14, § 3(d).
\textsuperscript{179} \textit{Novartis} Supreme Court Decision, supra note 17, ¶ 180. From the beginning, the Indian court system, construed the meaning of efficacy within a narrow spectrum to mean therapeutic efficacy. \textit{Id.} Beginning with Madras High Court, which examined the scope of § 3(d) and interpreted “efficacy” to convey only “therapeutic efficacy.” \textit{Id.} In this construction, the Court relied on the Dorland’s Medical Dictionary that defines efficacy as “the ability of a drug to produce the desired therapeutic effect.” \textit{Id.} ¶ 183. The Court further reasoned that the efficacy of a drug is independent of the potency of the drug. \textit{Id.} ¶ 180. Thus, by resorting to a narrow interpretation on the meaning of the expression “therapeutic,” the High Court observed that the patent applicant
Reading efficacy superficially might invite a wide range of possibilities for various products. If we are to take efficacy by itself and without designating a class of product, it might make for a perplexing regime. Implementation of efficacy, therefore, would depend on a slew of factors: the function, the utility, and the objective of the product under consideration. Could there be a robust way of measuring efficacy? This newly introduced term, “efficacy,” within such a narrow statutory construct, certainly leaves the door open for capricious determination by a patent examiner. Therefore, it would be instructive here to provide a nuanced analysis.

We can better appreciate the Supreme Court’s interpretation of efficacy by adopting a product-specific analysis. Here the Supreme Court applied efficacy specifically for pharmaceutical products. By introducing a new term, “therapeutic efficacy” to qualify the term, the Court developed a more robust framework surrounding the term “efficacy.” Arguing that the function of a medicine is to cure a disease, the Court reasoned that the testing for efficacy can be adequately performed by measuring therapeutic efficacy. Yet, the Court had recognized the difficulty of not having a standard or a consistent framework to measure therapeutic efficacy. This therefore, invites us to introspect on a series of questions: What shall the appropriate parameter for therapeutic efficacy be? What are the characteristics, advantages and benefits that can be brought forward for a substantive determination of the enhancement of therapeutic efficacy? Duly recognizing these procedural uncertainties, the Court introduced a nuanced framework for applying 3(d). This certainly has the desired effect of rescuing the somewhat tenuous trajectory of 3(d) from its statutory uncertainty by steering it toward a more robust application for pharmaceutical products. Thus, by embarking into a new procedural framework, the Court has recast the original efficacy into therapeutic efficacy. Introducing therapeutic efficacy still leaves open the issue of its appropriate measurement for consistent application to determine patentability for a wide-ranging product types.

From a definitional paradigm, efficacy gave life to 3(d), yet there is a missing element that the Court attempted to provide, which leads me to explore whether this automatically lends to judging therapeutic efficacy of a medicinal product strictly and narrowly? Given that the introduction of 3(d) into the patent act has already raised the bar much higher than before, does the argument for narrow and stricter interpretation of therapeutic efficacy hold water?

To determine whether pharmaceutical substances and medicinal products must receive a narrow and strict interpretation for their patent eligibility, a variety of factors must be evaluated. Looking at the language of the statute, the 2005 Amendment introduced the condition of “enhancement of the known efficacy.”

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180 See Novartis Madras H.C. Decision, supra note 19, ¶ 13.
181 Novartis Supreme Court Decision, supra note 17, ¶ 180.
182 Id.
183 Id.
184 Id. at ¶ 180.
This was further explained in the attendant explanation, which would require that, the derivative products “differ significantly in properties with regard to efficacy.”\[185\]

Although complex, the explanations can be distilled into specific observations. First, we must recognize that not all advantages or beneficial properties are relevant. Second, properties that can be identified for measuring efficacy must be carefully isolated. In the case of medicinal products, such characteristics should form the measurable parameters to demonstrate the therapeutic efficacy.

For the Novartis patent in question, various different products in many forms have been submitted in the application.\[186\] Each of these different forms is associated with a subset of properties that are strictly inherent to that form.\[187\] For example, solubility is a strictly inherent property of a salt,\[188\] like hygroscopic is characteristic to a polymorphous compound.\[189\] From its chemical composition, a salt and its polymorphous equivalent, when manufactured, can be claimed as different discoveries from the perspective of patent application. Yet, following the patentability standard of the current Indian regime would prompt us to apply the higher threshold of 3(d).\[190\] This in turn would require us to test whether there has been enhancement of therapeutic efficacy in achieving the cycle of discovery from the salt to the polymorphous compound.\[191\]

Application of the threshold test in this example, therefore, would require us to find an applicable property of the claimed product which has a measurable criterion for testing.\[192\] This would help determine whether the quantum of efficacy has increased from the prior patented product to the newly claimed product. In selecting an applicable property, however, great care must be taken to identify only those properties that can be both (i) measure effectively to demonstrate efficacy and, (ii) are significantly different with respect to the specific efficacy being sought. Here, unless the efficacy is shown to have increased significantly, a patent is rejected.\[193\] A mere change of form or inconsequential differences in form, from one type of property to another, must not qualify as showing increased efficacy. Therefore, therapeutic

\[185\] Id. (emphasis in original).
\[186\] Id. ¶ 8 n.1.
\[187\] Id. ¶ 181.
\[188\] Id. Id.
\[189\] Id.
\[190\] Id. ¶ 180 n.1 (citing Oxford Dictionary of English). The Court in Novartis has construed the operational meaning of efficacy “the ability to produce a desired or intended result.” Id. This led the Court to conclude that, for pharmaceutical drugs, the desired result is to cure a disease, and thus “not all advantageous or beneficial properties are relevant, but only such properties that directly relate to efficacy, which in case of medicine, as seen above, is its therapeutic efficacy.” Id. ¶ 180.

Thus, when evaluating the efficacy of different compounds, say, between the alpha and the beta form of Gleevec, a slew of characteristics could be available for observation, such as, thermodynamic stability, lower hygroscopicity, enhanced bioavailability, etc. In the pre-3(d) patent regime, an applicant could get away with showing any properties, ranging from hygroscopicity, stability, bioavailability, for the purpose of patentability. Section 3(d), however, instituted an added layer—an enhanced threshold through which to examine patentability. Thus, in the opinion of the Court, the furnished properties did not meet the threshold to establish therapeutic efficacy. Id. ¶¶ 187–89.

\[191\] Id. ¶ 180.
\[192\] Id. ¶¶ 187, 192.
\[193\] Id. ¶ 180; see also Amendment Act of 2005, supra note 14, § 3(d).
efficacy has to be interpreted within a narrower spectrum and via a stricter procedural analysis. Yet, implementing such procedures comes with the sophistication rigor that any complex chemical measurement calls for.

IV. SECTION 3(d) AND THE TRIPS COMPATIBILITY

The twin threads of Novartis' challenge centered on 3(d)'s lack of constitutionality and TRIPS incompatibility.\(^\text{194}\) TRIPS incompatibility has garnered significant coverage, an area on which the Madras High Court has refrained from ruling, citing jurisdictional grounds.\(^\text{195}\) It is time to evaluate the issue of TRIPS compatibility within the broader rubric of Indian intellectual property regime.

The TRIPS framework sought to align global patentability regimes in line with predominantly U.S. standards, and the feasibility of achieving this was recognized early on.\(^\text{196}\) The resulting framework did not clearly define patentability criteria, nor did it articulate a bright line of distinction between invention and patentability. In many ways, the TRIPS agreement created a multi-layer exception paradigm that has taken into account the different starting points from which member States began their journey towards industrialization. Therefore, the only hurdle Section 3(d) might face is if under a broader WTO panel evaluation the efficacy barrier is eventually found to be in direct contravention of TRIPS.\(^\text{197}\) Here, the deterministic benchmark would be to evaluate whether a required demonstration of efficacy invites one of the two outcomes—either imposing an undue burden on the innovator, or the

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\(^\text{194}\) Novartis Madras H.C. Decision, supra note 19, ¶ 1. Novartis' constitutionality argument focused on challenging 3(d)'s imposition of efficacy allowed patent examiner unfettered power of arbitrariness. \(\text{Id.} \) ¶ 3 (arguing this to be in violation of Article 14 of the Constitution, INDIA CONST. art. 14: “The State shall not deny to any person equality before the law or the equal protection of the laws within the territory of India”). Novartis sought to invalidate 3(d)'s efficacy threshold. The Court found “a broad distinction between discretion which has to be exercised with regard to a fundamental right guaranteed by the Constitution and some other right which is given by the statute.” \(\text{Id.} \) ¶ 34. Concluding that the statutory patent rights in question fall into the latter category, the Court in essence, foreclosed the issue of constitutionality in the case. In addition, I have shown elsewhere in this Article, see supra Part III, the deeper constitutional adherence given to the protection of public health within the policy objective certainly closes the book on any issue of unequal protection, as argued by Novartis.

\(^\text{195}\) Novartis Madras H.C. Decision, supra note 19, ¶ 4.


\(^\text{197}\) As discussed thus far in this Article, I have articulated the need for balancing pharmaceutical companies' right to obtain market exclusivity for their innovation with the widespread apprehension about price of life saving drugs going outside the means of the millions. This sentiment is found in the TRIPS agreement, as Article 7 mandates member States to work towards a “balance of rights and obligations” that is “to the mutual advantage of producers and users of technological knowledge and . . . conducive to social and economic welfare.” TRIPS, supra note 11, art. 7 (“Objectives”). India’s legislative debates and subsequent introduction of Section 3(d) is a testament to countries’ difficulties in crafting the right balance between two competing interests, while ensuring both innovation and wider access to the drugs. In this context, the international agreements clearly favor the pharmaceutical giants, as when and if, drug companies perceive existential danger within patent law in India, they are free to both file challenges through the WTO and withdraw from the Indian market.
The patentability framework in the target jurisdiction is subject to arbitrary determination. However, given its clear articulation,\textsuperscript{198} well established legislative history,\textsuperscript{199} associated due diligence in its crafting,\textsuperscript{200} and a highly nuanced judicial deterministic paradigm,\textsuperscript{201} Indian patent regime’s efficacy framework can no longer be recognized as narrowly construed for TRIPS violation. Rather, it is of significant value to trace the flexibility guidelines provided within TRIPS in formulation of 3(d).

Article 27 of TRIPS\textsuperscript{202} asserts that, “patents shall be available for any inventions, provided that they are new, involve an inventive step and are capable of industrial application.”\textsuperscript{203} Lack of precise language leaves the door open for member States to fill the gaps left in the guidance. Here, neither the term “inventive step”\textsuperscript{204} nor, the term “capable of industrial application” has been clearly defined in the TRIPS documents. This would prompt member States to define their own patentability criteria pursuant to their specific national interests. From a comparative perspective, the term “inventive step”\textsuperscript{204} can be recognized as synonymous with the term non-obvious.\textsuperscript{205} And, the term “capable of industrial application”\textsuperscript{206} can be seen as conveying the meaning useful.\textsuperscript{207}

TRIPS’ language reveals aspects of interconnectedness and diversity that the agreement sought to embody within member States’ patent regimes.\textsuperscript{208} As countries progressed through the cycle of civilization and arrived at respective industrial development phases, they arrived at different times.\textsuperscript{209} In this diverging chronology, technology posed differing advantages and challenges to the States.\textsuperscript{210} Responding to specificities of situations impacting them, member States have historically crafted their patentability criteria, both by responding to their unique challenges and by utilizing their specific advantages.\textsuperscript{211} Uniqueness has been more pronounced in certain fields, necessitating accommodation of bespoke and case specific concerns.\textsuperscript{212} The language of TRIPS recognizes this and therefore, allows member States the flexibility to define patentability criteria in a manner that suits their specific national interests.\textsuperscript{213} Western countries have periodically utilized such flexibility.

\textsuperscript{198} See supra Part III; Amendment Act of 2005, supra note 14, § 3(d).
\textsuperscript{199} See supra Part III.C; Amendment Act of 2002, supra note 123, § 83.
\textsuperscript{200} See supra Part III.C.
\textsuperscript{201} Id.; see Novartis Supreme Court Decision, supra note 17, ¶ 104.
\textsuperscript{202} TRIPS, supra note 11, art. 27.1.
\textsuperscript{203} Id.
\textsuperscript{204} Id. art 27.1 n.5.
\textsuperscript{205} Id.
\textsuperscript{206} Id.
\textsuperscript{208} See id.
\textsuperscript{209} See id.
\textsuperscript{210} Id. at 10–11 (inferring that the scope of patentability differs amongst WTO members due to a number of variables); see also TRIPS, supra note 11.
\textsuperscript{211} Arcuri & Castro, supra note 207, at 10–11.
\textsuperscript{212} See id.
\textsuperscript{213} Id. at 11; TRIPS, supra note 11, art. 8.
For example, in 2001 the U.S. Patent and Trade Office ("USPTO") revised its utility guidelines for biotechnology.214 Similarly, Germany recently introduced a provision to restrict patent monopolies on a gene sequence.215 Therefore, if Section 3(d) follows a trajectory similar to its U.S. and German counterparts and introduces refinement, why must there be differing responses? Moreover, taking an expansive meaning of the term, enhanced therapeutic efficacy could be recognized as synonymous to non-obviousness in Section 103 of the U.S. Patent Act.216 The robustness of 3(d)'s nuanced approach can be recognized through its premise, which presumes most forms of existing pharmaceutical substances are deemed obvious unless they exhibit enhanced and substantive therapeutic efficacy.217

Article 27 of TRIPS endows a member State with the option to exclude certain inventions from patentability, if their commercial exploitation is contrary to the national interest or inconsistent with the settled law of the land.218 This exception allows flexibility to member States in crafting their patentability framework to be in line with their own interests. Moreover, members are also allowed to exclude various method patents that are consistent with providing essential health and human services to its citizens.219 Thus, the TRIPS agreement embodies a commitment to public health and societal welfare. This commitment has also found resonance in various WTO agreements and conferences. Most importantly, in the 4th WTO Ministerial Conference in Doha on November 14, 2001,220 the following was adopted:

1. We recognize the gravity of the public health problems afflicting many developing and least-developed countries, especially those resulting from HIV/AIDS, tuberculosis, malaria and other epidemics.

2. We stress the need for the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) to be part of the wider national and international action to address these problems.


217 See supra Part III.
218 See TRIPS, supra note 11, § 27.
219 Id.
220 World Trade Organization, Ministerial Declaration of 14 November 2001, WT/MIN(01)/DEC/1, 41 I.L.M. 746 (2002). This is also when they decided to extend exemptions for pharmaceutical patent protection for LDN until 2016.
3. We recognize that intellectual property protection is important for the
development of new medicines. We also recognize the concerns about its
effects on prices.

4. We agree that the TRIPS Agreement does not and should not prevent
Members from taking measures to protect public health. Accordingly, while
reiterating our commitment to the TRIPS Agreement, we affirm that the
Agreement can and should be interpreted and implemented in a manner
supportive of WTO Members’ right to protect public health and, in
particular, to promote access to medicines for all.  

Furthermore, TRIPS provide the following flexibility to its member States:

(a) In applying the customary rules of interpretation of public international
law, each provision of the TRIPS Agreement shall be read in the light of the
object and purpose of the Agreement as expressed, in particular, in its
objectives and principles.

(b) Each member has the right to grant compulsory licences and the
freedom to determine the grounds upon which such licences are granted.

(c) Each Member has the right to determine what constitutes a national
emergency or other circumstances of extreme urgency, it being understood
that public health crises, including those relating to HIV/AIDS, tuberculosis,
malaria and other epidemics, can represent a national
emergency or other circumstances of extreme urgency.

(d) The effect of the provisions in the TRIPS Agreement that are relevant to
the exhaustion of intellectual property rights is to leave each Member free
to establish its own regime for such exhaustion without challenge, subject to
the MFN and national treatment provisions of Articles 3 and 4.

In evaluating TRIPS compatibility of a member State’s legal jurisdiction, we
must bear in mind the fundamental precept—a member State has flexibility to create
an individual paradigm that is resonant with its internal aspirations. The TRIPS
agreement has empowered its member States to craft their own patentability regimes
that reflect their diverging starting points from an agrarian way of life towards
industrialization. Thus, while TRIPS ensures that innovators have commercial
impetus, nowhere in the agreements does it advocate the granting of unfettered right

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221 World Trade Organization, Declaration on the TRIPS agreement and public health,
minist_e/min01_e/mindecl_trips_e.htm [hereinafter WTO Declaration on TRIPS Agreement].

222 Id. ¶ 5(a)–(d).

223 Id. ¶ 4.
of evergreening to pharmaceutical companies.\textsuperscript{224} Rather, despite its history of origin being steeped in discontent among member States, its robust framework reveals a commitment towards allowing member States to effectively combat corporate monopoly rent-seeking behavior.\textsuperscript{225}

Under the emerging rubric of Section 3(d), pharmaceuticals can no longer shape the market exclusivity in their favor, nor, can they subsume broader public interest within the predatory property rights framework.\textsuperscript{226} This is consistent with the various flexibilities offered to the member States by the Articles 7,\textsuperscript{227} 8,\textsuperscript{228} and 27 of the TRIPS agreement, in conjunction with paragraphs 4,\textsuperscript{229} 5,\textsuperscript{230} and 6\textsuperscript{231} of the Doha Declaration. As member States are allowed to control their patent regimes in a manner consonant with their broader national objectives, 3(d) encapsulates India’s social justice goals, while giving primacy to public health.\textsuperscript{232} This is also in line with the United Nations’ primary objective in structuring various conferences and protocols to ensure any development towards adverse impact on public health is effectively prevented. Thus, the Union of India is within its rights under the TRIPS agreement to adjust its patentability criteria and set higher standards for patent protection. And it is therefore TRIPS compliant. It is important to note that Indian law must be judged and interpreted not by the colonialist prescription imposed by the western world, but through the lens of its treaty obligation that allows it to set its own goals and aspirations.

V. Broader Dimensions and Future Implications of Novartis

The chief contribution of the Novartis decision is to introduce a new law—Section 3(d) of the Indian Patent (Amendment) Act. By unleashing 3(d) on to the global intellectual property landscape, Novartis signaled an effective provision against market exclusivity extension mechanisms of pharmaceutical giants,\textsuperscript{233} while declaring war against strict property rights based intellectual property frameworks. Despite becoming a subject of sharp criticism for venturing into the unchartered territory of structural revision in patentability,\textsuperscript{234} Novartis is laudable as one of the path-breaking cases to arrive in 2013. It’s laudable for introducing a model for

\textsuperscript{225} Id.
\textsuperscript{226} Id.
\textsuperscript{227} See TRIPS, supra note 11, art. 7.
\textsuperscript{228} Id. art. 8.
\textsuperscript{229} See WTO Declaration on TRIPS Agreement, supra note 221.
\textsuperscript{230} Id.
\textsuperscript{231} Id.
\textsuperscript{233} See India’s Novartis Decision, N.Y. TIMES (Apr. 5, 2013) (noting that “India decided to prevent drug companies from getting monopoly protection on updated drugs that did not represent a major advance over previous versions—a practice often referred to as ‘evergreening’”).
\textsuperscript{234} Id.
erecting a bulwark against corporate monopoly rent-seeking practices. It’s path-breaking for its long-standing implications on at least four areas.

First, retrenching from novelty and non-obviousness line of reasoning, Novartis reduced the scope for pharmaceutical products, while staying within applicable patentability framework for pharmaceuticals. This is a new development. Prior to 2005, pharmaceutical products could not be patented in India.235 This Amendment has brought pharmaceuticals under patent eligibility, but developed a layered deterministic paradigm to reduce the scope of pharmaceutical patents.

Second, by rejecting the seductive urge for conformity with western laws, Novartis blazed a divergent path in formulating 3(d) that resonated with the social justice and utilitarian themes of equality. By reconciling India’s treaty obligations with its human rights imperatives, 3(d) imposed a human rights component into the market-driven intellectual property framework.236 Responding to the aspirations of billions that rely on India’s generic drug market for survival,237 Novartis sought to level the playing field in the procurement of humanity’s basic survival needs.238

Third, recognizing TRIPS’ contentious origin and long simmering discontent of the developing regimes,239 3(d) can be recognized as a model of patentability for developing nations to follow. If evaluated without bias, 3(d) can be utilized as a much needed hybrid framework that can bridge the schism between the maximalist and minimalist paradigms of patentability.

Fourth, Novartis signals a judiciary interest in seeing harmonization of patent regimes across the globe. While the contours of such harmonization might not be as clear-cut, viewing Novartis in conjunction with some of the earlier cases, we can certainly conceptualize a future where laws of Nations may be showing tendencies to merge. Next, I discuss these four threads in detail.

A. Scope Reduction of Patentability via 3(d)

Novartis narrowed the scope of patents by reasoning that novelty and non-obviousness considerations should not form the core necessary requirement in determining patentability.240 The Court needed a new requirement, a layer of proving therapeutic efficacy, for going beyond the novelty and non-obvious considerations.241 Therapeutic efficacy can be seen as having the same impact on patentability of pharmaceuticals that the “markedly different characteristics”242 of Diamond vs. Chakrabarty243 had on the patentability of biological products when that

235 See Amendment Act of 2005, supra note 14, § 2(h).
236 Id. § 3(d).
238 Id.
239 Id.
240 See Novartis Supreme Court Decision, supra note 17, ¶¶ 102–04.
241 Id.
243 Id. at 309–10 (upholding the patentability of man-made bacteria that devours oil droplets in the ocean).
seminal case arrived on the scene. With the introduction of 3(d), the novelty and non-obviousness characteristics can neither hold primacy nor stand alone in their deterministic objective, thereby attenuating the force of their requirement in the framework. Thus, by enhancing the force of therapeutic properties of the invention in determining patentability, the Court may have signaled that the novelty and non-obviousness characteristics have lesser patentability value than the newly introduced efficacy requirement.244

A discussion of some aspect of the comparative nuances of the two patent regimes might be helpful in adequately contextualizing the 3(d) consequences. Despite their similarities on many aspects, the Indian patent regime and the U.S. patent regime differ significantly. The U.S. patent office could consider the validity of a patent if the invention contained some of the desired therapeutic properties, even if they lacked markedly different distinguishable characteristics, although the paradigm has shifted somewhat in the post-Myriad landscape.245 Within the U.S. context however, in a competition between the markedly different characteristics and the therapeutic properties, the latter could win even if the markedly different characteristic is conspicuous by its absence in the invention.246 As if by following the cue from the post-Myriad framework in the U.S., the Indian Supreme Court has narrowed the older paradigm’s expansive limits. By specifically observing the framework to be unnecessarily encompassing, the Court prevented patentability criteria to be vaguely amenable to all kinds of claims.247 The fundamental question is therefore whether therapeutic efficacy can be used as a patentability threshold to measure the diagnostic utility of the drug in question and whether this diagnostic aspect in of itself invokes similar transformative idea as contained in markedly different characteristics paradigm. Thus, 3(d)’s synonymous application of the markedly different characteristics seems to have the potential to invalidate patentability of many pharmaceutical products with just incremental changes and less therapeutic value.

B. Dissecting Novartis’ Human Rights Dimension

The scope restriction in Novartis should be recognized as the judiciary’s attempt to introduce functional efficiency in the patentability doctrine.248 Technology’s advancement has allowed pharmaceuticals companies to make constant changes in the original product in an effort to claim inventions for perpetuity. Within a decidedly maximalist paradigm, this could mean pharmaceutical companies could prolong their control of market exclusivity for decades, leaving access to life saving drugs out of reach for most. Looking at the explosion of patents in the last three decades under an overtly inclusive patent paradigm, the right to health for all humanity has, therefore, become a fleeting afterthought. Lost in this frenzy are the

244 See Novartis Supreme Court Decision, supra note 17, ¶¶ 102–04.
245 See Ghoshray, supra note 1, at 523–24.
246 Id.
247 See Novartis Supreme Court Decision, supra note 17, ¶¶ 102–04, 191–92.
248 See Basheer & Reddy, supra note 98, at 239.
interests of various stakeholders. Section 3(d) recalibrated such contour of patentability by encapsulating diverging stakeholder interests: the multi-national companies, the domestic pharmaceutical industry, and the consumers. Here, 3(d) elevates the “floor” by limiting patent protection to new chemical entities and their derivatives on condition of substantive enhancement of therapeutic efficacy, which in turn allows the rights of more individuals to be recognized within the patent discourse.249

Western patent paradigms provide a dynamic lens through which to see the interplay between bounty and suffering. This paradox has to be evaluated through its inherent dichotomy within the global patent landscape. Patentability doctrines have evolved through the quintessential tension between the two frameworks, one predicated on the idea of state supervision and the other premised on monopoly rent based corporate ownership of natural resources. Maximalist patent paradigms are antithetical to the human rights dimensions of various UN declarations that promote fundamental rights to health and longevity.250 Woven within the real life background of Novartis is the narrative of human sufferings borne out of delayed medical care and lack of access to drugs.251 The Court’s ruling, therefore, invites us to take a retrospective inquest at searching for patent law’s legal lineage under mankind’s common heritage. More than 150 years ago, the U.S. Supreme Court recognized the abstract fundamentals of human invention by tracing its roots in a shared humanity in observing that:

The Supreme Court has recognized that scientific principles and laws of nature, even when for the first time discovered, have existed throughout time, define the relationship of man to his environment, and, as a consequence, ought not to be the subject of exclusive rights to any one person.252

Therefore, Novartis’ scope reduction must appropriately be seen through a human rights lens. 3(d)’s imposition of a new patentability layer imposes a human rights obligation on the part of the State to ensure human rights concerns are carefully balanced with the innovator’s right to extract commercial incentive for innovation. This is especially significant, as technology’s advancement has allowed pharmaceutical companies to engage in excessive experimentation of random isolation and purification of chemical compounds. Either by data mining or by using computer algorithms, pharmaceutical companies can generate a wide range of products, most of which can be subject to patent application. By making simple changes in the original drug, companies can strive for patent eligibility for eternity, in the process preventing the access to essential drugs for the masses. Novartis

249 See Novartis Supreme Court Decision, supra note 17, ¶¶ 104, 191–92.
250 See Ghoshray, supra note 1, at 525.
251 See Novartis, LAWYERS COLLECTIVE, supra note 73.
252 In re Meyer, 688 F.2d 789, 795 (C.C.P.A. 1982).
foreclosed this human rights abuse within the Indian context, a model that certainly can be followed by other developing countries.\footnote{253}{See, e.g., Lissett Ferreira, Access to Affordable HIV/AIDS Drugs: The Human Rights Obligations of Multinational Pharmaceutical Corporations, 71 FORDHAM L. REV. 1133, 1137 (2002) (concluding that the high cost of HIV/AIDS drugs due to patent protection is a human rights violation).}

C. Rebalancing TRIPS Discontent in The Shadow of Patentability Schism

To comprehend Novartis is to review the genesis of 3(d) within the context of developing nations’ obligation to reformat their patent regime. While elucidating the virtues of the TRIPS agreement in comporting to the flexible needs of its member States,\footnote{254}{See TRIPS, supra note 11.} we certainly cannot overlook its predatory genesis.\footnote{255}{Peter Drahos, Developing Countries and International Intellectual Property Standards: setting, COMMISSION ON INTELLECTUAL PROPERTY RIGHTS 29, http://www.iprcommission.org/papers/ pdfs/study_papers/sp8_drahos_study.pdf (last visited May 10, 2014).} Despite its U.S.-led property rights-centric origin and TRIPS’ contentious history of discontents and disagreements has been subsumed under a coercive imposition of western-centric perspectives. Section 3(d)’s layered imposition of heightened patentability is a path forward towards restoring balance in the international patent regime.\footnote{256}{See generally Novartis Supreme Court Decision, supra note 17, ¶¶ 102–04, 180.}

Thus, viewed through such an evolutionary response lens,\footnote{257}{Id.} 3(d) can be seen as a legitimate evolution of developing countries’ aspirations towards equality and social justice. The innovative force of Section 3(d) not only helps realign patent framework’s asymmetric contour, it also extricates global intellectual property norm from the inertia of old world order.

Section 3(d) sits at the confluence of two conflicting priorities. On one side is the asymmetry in income and economic viability calling for intervention towards making access to essential drugs a universal reality. On the other side, seduction to industrialization prompting developing countries to become obligated to join WTO, despite their discontents.\footnote{258}{With its explicit provision to align the interest of all stakeholders, 3(d) can be used as a prototype for the emerging economies of the world. In an era where developing countries are finding it difficult to incorporate anti-evergreening or anti-patent layering within their patent regimes, 3(d) could act as a benchmark for others to follow. Moreover, as developed countries continue to forge coalition against patent regimes with such evergreening laws,\footnote{259}{following India’s lead might help in building a coalition of patent regimes with human rights sentiments.\footnote{260}{Not only will this help in making a level playing field in a deeply}{See generally World Trade Org., 2007 WTO PUBLIC FORUM: HOW CAN THE WTO HELP HARNESS GLOBALISATION? 135 (2008), available at http://www.wto.org/english/res_e/booksp_e/ public_forum07_e.pdf.}{The Complete Text of the U.S. Proposal for the TPP IPR Chapter, KNOWLEDGE ECOSYSTEM INTL (Feb. 10, 2011), available at http://keionline.org/node/1091.}{See e.g., Ryan Abbott, Of Evergreening and Efficacy, Part III, HARVARD LAW PETRIE-FROM CTR. (April. 16, 2013), https://blogs.law.harvard.edu/billofhealth/2013/04/16/of-evergreening-and-}}
divisive intellectual property landscape, it might rebalance the original discontent countries felt at the asymmetric imposition of TRIPS on their respective intellectual property regimes.

D. Examining Novartis’ Harmonizing Dimension

An expanded meaning of Novartis opens up some illuminating aspects. Viewing Novartis within a broader corpus made of select opinions from diverging regimes may signal an undercurrent of harmonization. There is a paradox in law at play here. Strictly speaking, the global intellectual property landscape is divided between a maximalist and a minimalist paradigm. Yet, globalization calls for conformity and convergence in Nations’ laws. It is not ideal for a maximalist framework to be the model for others to follow, simply because it lacks a human rights dimension and is predominantly based on a strict property rights dimension. Therefore, any variants of minimalist patent paradigm could be used as models for harmonizing global patent law.

Evaluating Novartis in light of some other cases from the U.S. and the U.K., we might be witnessing a newer thought process percolating amongst the judiciary. Although Novartis falls within a continuum in the annals of Indian constitutional decision, the Indian Supreme Court’s opinion in Novartis acquires a superior interpretative gloss if further dissected through the patentability thresholds established in Monsanto Tech. LLC v. Cefetra BV (“Cefetra”) and Eli Lilly & Co. v. Human Genome Sciences (“Eli Lilly”). A newer patentability threshold for the DNA sequence in Cefetra was established by requiring a direct connection between the invention and the function it was designed for. In Eli Lilly, the patentability threshold was pegged at responding to a two-step inventive step—whether the patentable sequence should disclose its function, and whether this function has concrete and immediate benefit. Similarly, by examining the questions raised by Judge Sweet in Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office (“Myriad”), a patentability threshold was set at determining whether the claimed invention is fundamentally different. By placing Novartis’ new threshold of

efficacy-part-iii/ (stating countries such as Argentina and the Philippines have incorporated provisions similar to Section 3(d) of India’s provision and predicting that “in the aftermath of [the Novartis] case, it is more likely other countries will follow India’s lead” that [the Novartis case] “may be a signal regarding changing political attitudes toward the demands of multinational corporations”) (referring to Novartis Madras H.C. Decision, supra note 19).


263 See Cefetra, supra note 261 at ¶ 79.

264 See Eli Lilly, supra note 262 at 99.


266 Id. at 226.
determining whether the compound demonstrate enhanced efficacy within the corpus of these three cases, it can be argued that there may be a convergence of thought process developing among the judiciaries. The similarity underscores a growing consensus towards restricting the scope of patentability for biological and pharmaceutical products that have implications for human health and longevity. As Novartis embarks on a decidedly minimalist patent paradigm, its shared ideals with patent cases from other jurisdiction are an encouraging indication for both the shared heritage of humanity and their human rights sentiments.

VI. Conclusion

This Article opens a window into the maximalist-minimalist schism of patentability centering on the Indian Supreme Court’s Novartis case. Viewing Novartis’ reduced scope of patentability for pharmaceutical innovation through the prism of the amended Section 3(d), Indian intellectual property paradigm’s misplaced condemnation is re-examined. Deconstructing the criticism surrounding 3(d) required an evaluation of its genesis, which proceeded in three major segments.

First, understanding the context and prevailing landscape of criticism further corroborated global patent paradigm’s deep schism and maximalist framework’s decoupling from social justice values. Second, contextualizing 3(d) through its roots and development allowed for an adequate and comprehensive appreciation of its constitutionality and TRIPS compatibility. Third, going beyond rehabilitating 3(d), this Article sought an expanded meaning of Novartis, which is not only laudatory but, also path-breaking.

Contemporary wisdom placed Indian intellectual property regime in a wide-ranging criticism from troubled to inefficient to inadequate. Riding the similar wave of condemnation, the Novartis decision has been criticized for its reliance on Section 3(d). Evaluating the logic behind the court’s conclusion, this Article basks in the excitement of Novartis’ arrival on the global patent landscape, while rehabilitating Section 3(d) in multiple steps.

By charting through its legislative history and its placement in the continuum of India’s constitutional jurisprudence, 3(d) is seen both as a natural progression in law and a revitalization of human rights element in the global stage. Moreover, 3(d)’s nuanced framework in delivering a multi-layer approach to patentability is evaluated with rigor to place it on firmer footing. Finally, 3(d)’s TRIPS compatibility is reviewed and found to be robust.

Going beyond the patentability discussion, this Article sought the expanded meaning of Novartis and identified four broader themes. First, retrenching from the novelty and non-obviousness line of reasoning, Novartis reduced the scope for

269 See supra Part V.
pharmaceutical products, while staying within applicable patentability framework for pharmaceuticals.\textsuperscript{270} Second, by rejecting the seductive urge for conformity within western laws, \textit{Novartis} blazed a divergent path in formulating 3(d) that resonated with the social justice and utilitarian themes of equality.\textsuperscript{271} Third, recognizing TRIPS’ contentious origin and long simmering discontent among the developing regimes, 3(d) can be recognized as a model of patentability framework for other Nations.\textsuperscript{272} Fourth, \textit{Novartis} signals a judiciary interest in seeing harmonization in patent regimes across the globe.\textsuperscript{273}

Finally, this Article is about recalibration, it is about deconstructing a false narrative. It is about challenging the myth percolating through the corporate dominated patent paradigm that has become the driving force in the western patent framework. Despite corporate reluctance, perhaps in the not so distant future, the path to patentability may begin to straddle some of the humanistic contours identified here. In such traversal, our ethical compass must be guided by the realm of sacred, a sacred borne out of our longing for human rights of all mankind and fundamentals of distributive justice.

\begin{footnotesize}
\begin{itemize}
  \item\textsuperscript{270} See supra note 14 and accompanying text.
  \item\textsuperscript{271} See supra note 237 and accompanying text.
  \item\textsuperscript{272} See \textit{Novartis} Supreme Court Decision, supra note 17.
  \item\textsuperscript{273} See supra Part V.
\end{itemize}
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