India's Controversial New Patent Regime: The End of Affordable Generics

Sierra Dean

Recommended Citation
https://scholar.smu.edu/til/vol40/iss3/7

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India’s Controversial New Patent Regime: The End of Affordable Generics?

SIERRA DEAN*

After almost three decades of relatively little patent protection, India recently adopted a modern patent regime that finally puts India in conformity with World Trade Organization (WTO) standards. These new laws signify a very dramatic shift in intellectual property policy in India and promise to impact India’s pharmaceutical industry significantly.

The new patent regime has been met with intense opposition as well as support. Indian government officials and pharmaceutical companies assure that the patent laws will improve national research and development, increase the export of generic drugs, and finally turn Indian pharmaceutical companies into major global players. On the other hand, various public health interest groups condemn the laws as signifying “the beginning of the end of affordable generics” by cutting off the supply of affordable medicines and stifling the competition that drives down the price of brand-name drugs. An examination of the Patent Act’s provisions and implications reveals that both sides of the debate have merit.

I. The Purposes of a Patent System

Patent laws recognize intellectual property rights relating to inventions. Patents allow inventors to exclusively use their inventions for a limited period of time in exchange for

*Sierra Dean is a Juris Doctor candidate at Southern Methodist University, Dallas, Texas. She graduated with magna cum laude honors from Texas A&M University in 2002 with a Bachelor of Science degree in Biochemistry and Genetics.


5. ICTSD—Patent Bill, supra note 3.


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their disclosure of the invention to the public. This system confers two advantages to society. First, public disclosures promote progress by ensuring that knowledge of inventions is acquired by others, who can then use this knowledge to make further improvements. Second, because developing new inventions requires extensive investment and risk, the promise of exclusive rights serves as an incentive to inventors to undertake their research and development efforts. Generally, for a new drug molecule, the cost of research and development is about $1 billion. Without a guarantee of exclusivity, innovative drug companies would be unable to generate enough revenue to overcome these high costs. Overall, the loss to society from the monopoly power granted to the inventor is significantly outweighed by the potential gains society receives from the acceleration of the technological process.

II. India’s Pharmaceutical Industry

India’s $7 billion drug market is the fourth in the world in terms of volume and thirteenth in terms of value. Its drug industry consists of 24,000 drug manufacturers, roughly 500,000 chemists, and over one billion people using medicines. Drug exports from India reach an estimated 200 countries globally. India is also a major supplier of the world’s generic medicines, exporting 66.7 percent of its products to developing countries.

Between 1970 and 1994, India only allowed patents on processes, called process patents, rather than on the products of the processes themselves, called product patents. This was seen as a compromise between India’s desire to encourage innovation and its desire to allow access to foreign pharmaceuticals that might otherwise be unavailable. Under the old regime, the period of patent protection was only seven years. Therefore, pharmaceutical

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9. Id.
10. Id.
11. Id.
13. Id.
18. Devraj, supra note 4.
22. Id.
companies could manufacture cheap copycat versions of patented drugs and sell the medicines at a fraction of the price, as long as a modified process was used.23 A huge Indian generic drug industry was thus built on reverse-engineering brand-name drugs through slightly modified processes.24 Every major drug in the world ended up in at least ten brands in India.25

It is for this reason that Indian drugs often cost 7 to 10 percent of what they do in the United States.26 Prices of AIDS anti-retroviral drugs made in India are reduced by as much as 98 percent.27 For example, India recently introduced a generic version of an AIDS anti-retroviral drug at $140 annually per person, which was significantly cheaper than the name-brand drug selling for $12,000 annually per person.28 Indian generic drug manufacturers now produce low-cost AIDS drugs for 50 percent of the 700,000 HIV patients taking antiretroviral medicines in developing countries.29

III. The TRIPS Agreement of 1994

India’s patent protection regime changed in 1994 when India signed the Trade Related Intellectual Property (TRIPS) agreement of the WTO.30 TRIPS, which came into effect on January 1, 1995, is considered to be “the most comprehensive multilateral agreement on intellectual property” to date.31 TRIPS sets out minimum standards of intellectual property protection that must be met by each WTO Member country.32 In addition, TRIPS contains a differentiated timetable of compliance for three different classes of nations: developed, developing, and least developed.33 Developed countries were required to immediately comply with the agreement.34 Developing countries, such as India, were given ten years, until January 1, 2005, to comply.35 The least developed countries, such as those in Africa, were given until 2016.36

Generally, TRIPS requires Member countries to make patents available for any inventions, whether products or processes.37 This essentially makes it illegal for domestic com-

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27. Health Gap, supra note 19.
32. Id.
33. Thakurdas, supra note 8.
34. Id.
35. Id.
panies to make generic copies of patented drugs. Under TRIPS, inventions in all fields of technology may be patented as long as they meet the tests of novelty, inventiveness, and industrial applicability. TRIPS also provides for a term of patent protection of twenty years from the filing date of the patent.

IV. The 2004 Ordinance

The initial product of India's efforts to comply with TRIPS was an Ordinance (the Ordinance), which is a temporary executive decree that is not debated in parliament. The Ordinance amended India's patent regime to include product patents and was passed on December 26, 2004, just days before the TRIPS January 1, 2005, deadline for compliance.

The Ordinance was met with heated opposition. Various groups heavily criticized the Ordinance for failing to incorporate certain public health flexibilities allowed by TRIPS. Specifically, opponents of the Ordinance believed it blatantly disregarded the 2001 Doha Declaration on public health, which states that "TRIPS should be interpreted and implemented in a manner supportive of WTO members' rights to protect health and promote access to medicine for all." In addition, critics believed the Ordinance did not incorporate the August 30, 2003, decision of the TRIPS General Council, which permits the grant of compulsory licenses for export purposes to countries with little or no manufacturing capabilities. Critics believed this strict regime under the Ordinance would lead to more expensive essential drugs, thereby hurting those needing access to cheap medicines while also hurting India's pharmaceutical industry, which relies heavily on generic drug production.

V. The 2005 Patent Amendments Act

The 2005 Patent Amendments Act (the Patent Act) was driven by requirements of TRIPS compliance as well as by India's recognition that an innovative, proprietary patent system was now necessary to becoming a global technology player. The Patent Act replaced the Ordinance of 2004, and several provisions of the Ordinance were amended to satisfy critics who feared increased drug prices. The lower house of parliament passed the Patent Act on March 22, 2005, and the upper house made it law the following day.
A. Elements of the Patent Act

The Patent Act includes significant changes in protection of intellectual property in India. While the Patent Act covers various aspects of intellectual property, only a few significant provisions are currently in controversy; these provisions, discussed below, relate to mailbox application procedures, compulsory licensing, pre-grant oppositions, and scope of patentability.

1. Mailbox Application Procedures

While India had until January 1, 2005, to implement a new patent regime that complied with TRIPS specifications, Indian drug companies were allowed to apply for product patents as early as January 1, 1995, the effective date of the Patent Act. India created a mailbox for filing product patent applications on products invented after this date. The applications filed between 1995 and 2005, called mailbox applications, were held pending examination until the January 1, 2005, effective date of the Act. The current number of pending mailbox applications is estimated to be from 4,700 to 12,000.

The Ordinance did not contain a provision allowing for continued manufacture of currently produced drugs after the grants of the mailbox patents. Critics feared that this provision would cause drugs currently produced by Indian companies, for which patent applications were still pending in the mailbox, to go off the market once the patents were granted. This could lead to a dramatic price increase for these drugs, as was seen in 2003 with an anti-cancer drug called Glivec, where the cost of the medication increased tenfold.

The Patent Act remedied this provision by allowing Indian companies already producing these drugs to continue to produce them even after the drugs are patented, as long as a royalty is paid to the company owning the patent. Specifically, the provision explains that the patentee's rights begin from the date of the grant of the patent, rather than from the date of application. The patentee is only entitled to receive "reasonable royalties" from those companies that have made significant investments and have been producing and marketing the drug prior to January 1, 2005, and that continue to manufacture the drug on the date of the patent grant. Under this provision, no infringement suits are allowed against these companies once royalties are paid.

53. Id.
54. Id.
56. ICTSD—TRIPS Compliance, supra note 20.
57. Hsi, supra note 2.
58. ICTSD—TRIPS Compliance, supra note 20.
60. Id.
61. Id.
62. Id.
64. The Patents (Amendment) Act, No. 15 of 2005; India Code (2005), v. 71, at § 10(c), available at http://indiacode.nic.in/.
65. Id.
66. Id.
2. Compulsory Licensing

Compulsory licenses allow the production of patented material without authorization from the patent holder.\(^{67}\) With compulsory licenses, a government may allow patents to be broken if cheaper generic drugs are required in a health emergency.\(^{68}\)

The Ordinance allowed for exports of patented drugs under compulsory licenses to developing countries with no manufacturing ability.\(^{69}\) While this was consistent with the Doha Declaration and subsequent August 30, 2003, TRIPS General Council decision, the Ordinance added a new provision that required the importing country to first issue its own compulsory license to Indian drug makers.\(^{70}\) This provision was heavily criticized because countries cannot issue compulsory licenses for products to which they do not extend patent protection.\(^{71}\) Since, under TRIPS, least developed countries are not required to provide patents for products until 2016, those countries in need of cheap medicine would not be able to import from India until their patent regime is finally implemented.\(^{72}\)

The Patent Act expanded the compulsory licensing provisions.\(^{73}\) The provision was amended to provide that countries with little or no manufacturing ability can import patented drugs under compulsory licenses from India as long as they give notification of importation or otherwise authorize importation.\(^{74}\) This is in addition to a country's ability to obtain compulsory licenses.\(^{75}\)

In addition, prior to the Patent Act, there had been widespread concern that the grant of compulsory licenses would take too long if the Patent Controller had too much time to consider issuance of compulsory licenses after the licenses were denied by patent holders.\(^{76}\) The Patent Act addresses this by specifying that a reasonable time period of up to six months will be given for the Patent Controller to consider issuance of the compulsory license.\(^{77}\)

3. Pre-grant Oppositions

Pre-grant oppositions allow members of the public to challenge potentially frivolous and invalid patent applications before the patent is granted.\(^{78}\) Critics believed that the Ordinance severely restricted pre-grant oppositions by reducing the number of grounds under which the patent could be opposed from nine to two and by deleting the clause which provided for hearings in person by the opposing party.\(^{79}\)

The Patent Act addresses these concerns by specifically providing for eleven different grounds for opposition and restoring the option of personal hearings for opponents.\(^{80}\) In


\(^{68}\) Devraj, *supra* note 23.

\(^{69}\) Memorandum from Amit Sen Gupta, *supra* note 59.

\(^{70}\) *Id.*

\(^{71}\) ICTSD—Patent Bill, *supra* note 3.

\(^{72}\) *Id.*

\(^{73}\) Hsi, *supra* note 2.


\(^{75}\) *Id.*

\(^{76}\) Memorandum from Amit Sen Gupta, *supra* note 59.

\(^{77}\) *Id.*


\(^{79}\) Memorandum from Amit Sen Gupta, *supra* note 59.

addition, the Patent Act extends the time for filing oppositions from three months to six months.\textsuperscript{81}

4. Scope of Patentability

Prior to the Patent Act, there were widespread concerns that the implementation of product patents in India would result in many patents being granted on frivolous grounds.\textsuperscript{82} There were also concerns that this would lead to "evergreening" of patents.\textsuperscript{83} Evergreening refers to renewals of expired patents by pharmaceutical companies by citing a new use for the same drug, thereby extending the patent monopoly.\textsuperscript{84} Evergreening delays the entry of generic drugs into the market.\textsuperscript{85}

The Ordinance addressed these concerns by restricting the scope of patents granted on frivolous claims.\textsuperscript{86} The Ordinance clarified that an inventive step must be a technical advance over previous inventions or one that has economic significance.\textsuperscript{87} A new invention is "any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification."\textsuperscript{88} A pharmaceutical substance must be a "new entity involving one or more inventive steps."\textsuperscript{89} The only truly controversial provision of the Ordinance was the use of the word "mere" in explaining that a mere new use of an old molecule or any new property of a known substance was not patentable.\textsuperscript{90} Critics objected to the use of the word "mere" because the provision was ambiguous about exactly what kind of new use is patentable.\textsuperscript{91} It could allow an applicant to claim a patent just by adding a new chemical reactant instead of developing completely new drugs.\textsuperscript{92} The word could also lead to endless litigation since it is susceptible to various interpretations.\textsuperscript{93}

The Patent Act addresses this concern by deleting the word "mere" to strengthen the provision.\textsuperscript{94} This serves to remove any doubt of the scope of patentability by narrowing the exceptions to inventions.\textsuperscript{95} All of the other provisions on patentability are left unchanged from the Ordinance.\textsuperscript{96} Therefore, under the Patent Act, new uses of a known substance are not patentable, and new dosage forms are patentable only if an unexpected result is found.\textsuperscript{97} Combinations of known substances can only be patented upon showing of enhanced ther-
apeutic efficacy, and pharmaceutical substances are only patentable upon showing of a syner-
gistic effect of the components. 98

B. REACTION TO THE ACT

1. Criticism

Under the Patent Act, thousands of medicines that were granted patent protection in
other countries between 1995 and 2005, as well as medicines that will become patent pro-
tected after January 1, 2005, will be considered for patent protection in India. 99 While the
generic production of pre-1995 versions of medicines is not enough to satisfy the treatment
needs of people in developing countries. 100 They argue that all new drugs required to replace
old, ineffective drugs will be patented and thus become unaffordable. 101

Opponents argue that the costs to consumers as a consequence of the Patent Act will be
untenable. 102 They insist the new laws will stifle routine generic competition for newer,
more expensive AIDS medicines and argue that twenty-year monopolies on drugs will drive
up cost of treatment until the world’s supply of generic HIV medicines disappears. 103 They
believe that the 5.1 million Indians suffering from HIV/AIDS will be unable to afford the
possible 99 percent increase in the cost of these medicines. 104 Similarly affected will be the
majority of African nations currently importing inexpensive generic drugs from India. 105

Analysts predict prices on patented breakthrough drugs in India could rise to nearly U.S.
levels, while prices on more common drugs should rise only moderately. 106 The Indian
government has said it will step in if price increases are excessive, but it remains to be seen
how exactly that will be implemented. 107 Dr. Hamied, chairman of Cipla, a company known
for supplying inexpensive AIDS cocktails, is strongly opposed to the new laws. “The passage
of the patent bill,” he was recently quoted as saying, “for me personally and for India as a
whole, is a very tragic and a very sad day. It will be the start of a predictable, long-term
tragedy for the country.” 108

Critics generally blame the compulsory licensing provisions of the Patent Act as being
too complicated to provide quick relief in the case of an epidemic. 109 They argue that
effective compulsory licensing procedures are absolutely necessary for ensuring access to
affordable medicines. 110 The Patent Act requires that, except during national emergencies,
generic manufacturers must wait three years after a patent is granted before they can apply
for a compulsory license to manufacture it, which critics believe is too long. 111 Other criti-

98. Id.
100. Id.
102. Health Gap, supra note 19.
103. Id.
104. Devraj, supra note 4.
105. Id.
107. Id.
108. Id.
110. ICTSD— Patent Bill, supra note 3.
111. Id.

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cisms of the compulsory licensing requirements are that they fail to set a limit on royalties to be paid to patent holders, they allow drug makers to oppose the granting of a compulsory license, and they fail to establish a fixed time limit after which a compulsory license must be issued to an applicant.112 Thus, critics argue, pharmaceutical companies can use these loopholes in the compulsory licensing procedures to delay the granting of compulsory licenses.113 They insist that generic manufacturers should be able to apply for compulsory licenses as soon as a patent is granted.114 "People in India and other developing countries have to have the right to license lifesaving drugs in a fast and easy manner, without the permission of the multinational pharmaceutical companies," said Priti Radhakrishnan, senior project officer with Lawyers Collective HIV/AIDS Unit.115

In addition, critics argue that product patents will be detrimental to small generic drug companies.116 Mergers are expected, with bigger pharmaceutical companies swallowing up smaller ones that cannot afford to undertake research and development.117 Opponents argue that these small companies might be priced out of the drug market and disappear.118 This happened in Italy following its 1984 institution of drug patents, where it went from being a major drug producer and exporter to a new importer of medicines.119

Opponents of the Patent Act also downplay the effect it will have on investment and research in India.120 They claim that profits generated by sales in India will not be substantial enough to affect the research and development agenda of multinational pharmaceutical companies.121 They also argue that foreign companies will comprise the vast majority of patent filers for India, who has not yet reached a standard of development where it will benefit from patent monopolies.122

2. Praise

Big pharmaceutical companies, on the other hand, hail passage of the Patent Act.123 They believe India’s strong pharmaceutical and biotechnology industries have a lot to gain from strengthened patent protection.124 They argue that India’s pharmaceutical firms have the scale, trained personnel, and technical capacity to develop new drugs, and this, combined with the availability of patents and the low cost of research and development in India, could help India’s pharmaceutical companies become very successful globally.125 Many Indian drug makers are optimistic that the new patent regime will increase investment in pharmaceutical research, which will enable Indian firms to start launching global low-cost drugs in four to five years.126 They insist that the Patent Act will lead to increased investment in

112. Id.
113. Id.
114. Id.
115. Id.
117. Devraj, supra note 23.
118. Rai, supra note 15.
120. Health Gap, supra note 19.
121. Id.
122. Id.
123. Rai, supra note 15.
125. Thakurdas, supra note 8.
the country as well as retention of Indian scientists and researchers, who might otherwise go to the United States. They argue that India is likely to become a major center for outsourced clinical trials under the Patent Act. Proponents of the Patent Act also argue that impact on India’s large generic drug makers will not be too severe because these companies generally make off-patent medicines as well as drugs protected with patents elsewhere.

Proponents also deny that prices of drugs will skyrocket. Shri Kamal Nath, Union Minister of Commerce and Industry, believes the Act contains enough safeguards, such as compulsory licensing provisions, to prevent price rise. This is because 97 percent of all drugs manufactured in India are off-patent and will thus remain unaffected. In addition, 100 percent of all essential drugs are currently not covered by patents. Prices of drugs patented before 1995, including very important HIV treatments, will not be affected as they will be ineligible for patents, and their generic production will continue.

“I expect that after the first of January 2005, when the patent law comes into play in India, what we will see is maybe one or two new drugs, patented drugs, being launched in the first few years—and later one, maybe five, six, or seven. So, it is not going to be a sudden or a huge change at all,” said Rajiv Gulati, general manager for Eli Lilly in New Delhi.

Proponents of the Patent Act also argue that the laws will not hurt the AIDS battle because compulsory licensing procedures allow India to deal with public health emergencies, where India can continue to produce significant AIDS treatments and export them to developing countries. Under these provisions, developing countries can issue compulsory licenses to manufacture generic versions of Indian drugs for less cost, and least developed countries with no manufacturing ability can obtain compulsory licenses to import cheaper generic drugs from India.

Additionally, proponents point out that most of the large global producers of AIDS treatments have dramatically lowered the prices of their drugs in developing countries already. Currently, the standard AIDS cocktail is available in Africa for just over $1 per day, which is a price close to that offered by Indian generic producers. They argue that it is not international patent laws that are preventing access to cheap drug therapies; it is the “crushing poverty of the nations most heavily affected with HIV/AIDS and the insufficiency of aid provided by developed countries.”

131. *Id.*
132. *Id.*
133. *Id.*
139. *Id.*
140. *Id.*

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3. U.S. Reaction

The U.S. pharmaceutical industry believes India's Patent Act falls short of India's WTO obligations under TRIPS. First, U.S. officials believe that India's treatment of mailbox applications violates TRIPS. Under Article 70.8 of TRIPS, companies that filed mailbox applications prior to January 1, 2005, are required to receive patent protection as long as the applications meet the basic criteria for protection. In addition, under Article 70.9 of TRIPS, products covered under the mailbox must be given five years of exclusive marketing rights in importing Member countries. U.S. sources say that India is in clear violation of both articles 70.8 and 70.9 because the Patent Act does not provide for five years of exclusive marketing rights nor does it provide patent holders under mailbox applications with any recourse to remove products that violate their patent from the market.

Second, U.S. sources argue that India's compulsory licensing requirements fall short of WTO rules. Aggressive compulsory licensing could destroy the very incentives that are created by a patent system and could even be illegal under TRIPS. Article 31 of TRIPS provides that a compulsory license should only be granted after efforts have been made to obtain authorization from the patent holder within a reasonable period of time. The Patent Act caps the reasonable period at six months. U.S. officials believe this time period is too short since licensing negotiations can often take a couple of years.

Third, the U.S. industry's view is that the Indian treatment of "new uses" is too strict. Article 27 of TRIPS recognizes patents for any inventions as long as they meet the requirements of novelty, inventiveness, and industrial application. However, the Patent Act requires that drugs that are slightly altered for different uses can only be protected if the drug has undergone a "significant innovative step." U.S. officials believe that this provision makes it too difficult for patent holders to obtain patent protection for drugs altered to treat different conditions.

Despite objections to certain provisions of the Patent Act, U.S. officials have not yet challenged the laws in the WTO. Industry sources revealed that U.S. companies are still studying the Patent Act and waiting to see how the Indian government implements it before taking action.

141. Inside U.S. Trade, supra note 67.
142. Id.
143. Id.
144. Id.
145. Id.
146. Id.
147. Thakurdas, supra note 8.
149. Id.
150. Id.
151. Id.
152. Id.
153. Id.
154. Id.
155. Id.
156. Id.
VI. The Future of Indian Patent Law

India's move toward conformity with TRIPS standards appears to promise considerable national benefits. 157 However, while India's new Patent Act contains several features designed to reduce potential hardship to public health and prevent drastic rise of drug prices, it is uncertain at this point whether these provisions will succeed as intended. 158 Conversely, while these provisions are desirable and perhaps necessary to protect public health, care must also be taken to ensure that they do not ultimately undermine the intended purposes of patent protection or violate the TRIPS standards set out by the WTO. 159 Ultimately, implementation and enforcement of the Patent Act remain surrounded by uncertainties. 160 Because the Patent Act is still subject to revision, this will be an area of continuing development in the future. 161 India's Patent Act ultimately must find a consistent balance between providing necessary benefits to innovators without compromising important national interests. 162

157. Thakurdas, supra note 8.
158. Id.
159. Id.
160. Hsi, supra note 2.
161. Id.
162. Gupta, supra note 12.