EXECUTIVE BENCH BRIEFING FOR FOREIGN PATENT COUNSEL

Two-Gate Inventive Step Architecture under Section 2(1)(ja) & TRIPS Footnote 5

Author: Gaurav Arora | Lead Counsel, Arora IP Counsel
Advocate, High Court of Delhi | Registered Indian Patent Agent (INPA-1900)

EXECUTIVE SUMMARY & KEY TAKEAWAY
Section 2(1)(ja) establishes a dual-threshold statutory test: technical advance OR economic significance over prior art. Proper prosecution requires decoupling Level 2 eligibility filters from Level 3 obviousness analysis.

1. The Three-Level Examination Sequence

Systemic rejection error before the Indian Patent Office stems from conflating Level 2 statutory subject-matter eligibility exclusions (Sections 3/4) with Level 3 prior art obviousness under Section 2(1)(ja).

- Level 1 (Section 2(1)(j)): Threshold statutory invention (novelty and industrial applicability).
- Level 2 (Section 3 Exclusions): Statutory subject-matter eligibility filters evaluated in vacuo without prior art mapping.
- Level 3 (Section 2(1)(ja)): Substantive inventive step and obviousness analysis over state of the art.

2. Rebutting Commercial Feature Exclusions & Technical Effect Synergy

Examiners frequently issue rejection notices asserting that commercial software features, user interface elements, or formula variations lack technical effect. Under established High Court IPD precedents (Agfa, Ferid Allani), technical advancement is established whenever a feature results in technical hardware control, improved processing efficiency, or non-additive chemical/functional synergy.

3. International TRIPS Footnote 5 Compliance

India's statutory definition of inventive step under Section 2(1)(ja) ('technical advance as compared to existing knowledge or having economic significance') must be harmonized with TRIPS Agreement Article 27.1 Footnote 5.

Footnote 5 explicitly recognizes that WTO Members may satisfy the inventive step requirement by demonstrating 'non-obviousness'. Demanding administrative hurdles beyond non-obviousness violates international Treaty commitments.

4. The 4-Step Response Matrix for Foreign Counsel

1. Isolate Technical Advance: Identify specific hardware interaction, algorithmic optimization, or compositional synergy.
2. Establish Prior Art Hindsight Bias: Demonstrate that combining cited references requires impermissible hindsight reconstruction.
3. Invoke TRIPS Footnote 5: Rebut non-statutory economic significance objections using international WTO standards.
4. Submit Comparative Matrix: File side-by-side technical advantage table demonstrating non-obvious superiority over cited prior art.

NEED STRATEGIC PROSECUTION OR APPELLATE REPRESENTATION IN INDIA?
Our practice provides foreign law firms, corporate IP directors, and technology leaders with conflict-free senior advocacy before the Indian Patent Office and Delhi High Court IP Division (IPD).
Direct Counsel Consultation: gaurav@aroraipcounsel.com | **Website:** www.aroraipcounsel.com