

Section 40: Amendment of complete specifications before acceptance

~~Amendment of complete specification before acceptance~~

~~(1) Before the acceptance of a complete specification, the applicant may, in the prescribed manner, amend that specification.~~

~~(2) Subsection 1. is subject to section 33(5).~~

~~(3) Subpart 8 applies in respect of amendments to a complete specification after the acceptance of the complete specification.~~

~~Regulation 58 Amendment of complete specification before acceptance~~

~~An amendment of a complete specification before acceptance under section 40 of the Act must include—~~

- ~~(a) the applicant's reasons for making the amendment;~~
- ~~(b) and a copy of the proposed completed specification as it would appear following amendment;~~
- ~~(c) and a copy of the marked up pages of the complete specification with the amendments clearly shown; and~~
- ~~(d) a statement setting out the specific part or parts of the original complete specification that supports each of the proposed amendments.~~

~~Scope of section 40~~

~~1. Amendments proposed under section 40 include all amendments to a complete specification document before acceptance of the application. Amendments to a complete specification generally arise as part of the examination process of an application, although they may be proposed prior to the examination process commencing e.g. at entry into the national phase under the PCT. Amendment of a complete specification may be made as a correction, which is also considered under section 40 (see section 202(5)).~~

~~2. Amendments made during international phase of an application which are to be examined in the national phase do not require a statement of support or marked up pages to be provided. However, an amended complete specification incorporating the amendments made in the international phase is required to meet the requirements of regulation 63(2). Any amendment which is proposed at the time of submitting a request to enter the national phase in New Zealand, or subsequently, will require a statement of support and marked up pages to be provided at the time of making the proposed amendment, in addition to meeting the other requirements for amendments.~~

3. Amendments made under section 40 are subject to section 33(5), which permits the Commissioner to direct that an application or specification be post-dated to the date of an amendment. This will be the case where for example an amendment adds matter to the original disclosure of the specification.

4. Further guidance on the application of regulation 58 can also be found in the examination manual at section 39.

Statement of support (r 58(d))

When is the statement of support required?

5. The statement of support should be submitted at the same time as submitting the corresponding amendments (see also paragraphs 21 and 22 below). Failure to provide the statement may result in a delay in examination of the application until the statement has been provided.

6. The statement is required whether or not the amendments are proposed in response to an objection raised in an examination report, or voluntary amendments prior to, or during examination.

7. Where an amendment is proposed to meet an objection raised in an examination report e.g. a lack of novelty objection, then the statement of support should include an explanation of how the proposed amendment overcomes the cited disclosure of the prior art base, and where support for the claimed subject matter can be found in the specification as originally filed (see section 39(2)(c)).

Form of the statement of support

8. The statement is a written indication filed with a response to an examination report, or where a voluntary amendment is proposed. The statement should identify where support for the proposed amendment can be found in the complete specification as it was originally filed. For a PCT national phase application, the specification as originally filed is the specification as at the international filing date, and not the specification filed at national phase entry.

9. The written statement may be supplemented by a table indicating where for example amended claims have correspondence with originally filed claims, and/or where support can be found within the description of the originally filed specification.

Reasons for making the amendment (r 58(a))

10. Reasons for making an amendment of a specification of an application under examination will generally fall into one of two categories:

- a.—to meet an objection raised in an examination report, or
- b.—that the amendment is a voluntary amendment i.e. not in response to an objection raised in an examination report.

11. Amendments which are not in response to a specific objection raised in an examination report will generally be considered to be voluntary amendments (see also Fees for amendments below).

12. Amendments to the description that are not filed at the same time as the corresponding amendment to the claims will be treated as voluntary amendments, and an amendment fee is payable.

13. Reasons for making amendments, such as “to comply with the requirements of NZ law” or to bring the claims into alignment with those of a corresponding application in another country will also be treated as voluntary amendments.

Reasons are required for each and every amendment

14. Reasons are required to be provided for each and every amendment which is proposed to be made to the complete specification. This includes all amendments proposed in response to objections raised in an examination report, and also those amendments where the applicant wishes to make a voluntary amendment e.g. to correct a mistake, correct grammar or other amendments.

15. Where a number of amendments are proposed for the same reason, it is acceptable to indicate that the specified amendments have been proposed to meet specific objections raised in an examination report, or for other specified reasons. For example, a common amendment is correction of typographical errors within the specification, and generally it would be sufficient to identify each of the misspelled word(s), state that there are typographical errors in the grouped words, provide the correct spelling for each word, and provide a list or table of where each instance of the typographical error occurs in the specification (in addition to meeting the other requirements for amendments).

16. Regulation 58 must be complied with in full prior to expiry of the period set out in regulation 80(1) i.e. before expiry of the period for placing an application in order for acceptance. Failure to meet this requirement risks the application being treated as abandoned.

Copy of proposed complete specification (r 58(b))

17. A copy of the full specification incorporating all of the proposed amendments should be submitted at the same time as proposing amendments to the complete specification. The specification should be a clean copy of the amended specification free of any marked-up indications or other extraneous matter. Failure to provide the full specification will fail to meet regulation 58(b), and may result in delay in examination or acceptance of the application.

Copy of the marked-up pages showing amendments (r 58(c))

18. A marked-up copy of every page of the complete specification which is proposed to be amended must be submitted at the same time as submitting the proposed amendments to the complete specification. Only those pages of the specification which are to be amended are required to be submitted. It is not necessary to provide a copy of the full specification, and no objection will be raised if a copy of the full specification is not provided. Failure to provide any marked-up page of the specification will fail to meet regulation 58(c), and may result in a delay in examination or acceptance of the application.

19. It should be made clear in any response or statement to the examiner which version of the complete specification forms the basis for the marked-up pages. For example, the marked-up pages

may be based on the originally filed complete specification, or they may be based on an earlier amended complete specification which has already been examined. Irrespective of which version of the specification is provided, any amendment must find support in the specification as originally filed, and any statements must be addressed with respect to the originally filed specification.

20. Where marked-up pages are not provided with a response to which the corresponding amendments have been submitted, then the applicant may be requested to provide the marked-up pages no later than with the response to the next examination report. Where the application may otherwise be in order for acceptance, then the statement must be provided in response to the examination report identifying the deficiency to allow the application to proceed to acceptance.

Statement of support not provided or inadequate

21. A statement of support is required in respect of every amendment to the specification. Where a statement of support and/or reasons for making the amendment are not provided for proposed amendments under examination, then the examiner may elect to proceed with examination on the matters not subject to the proposed amendments, and require the applicant to provide a statement with the next response.

22. Alternatively, the examiner may choose to curtail or halt examination of the application and specification until the applicant has provided a statement of support. This latter option may be chosen where for example it appears that the nature and scope of the amendments are substantial or extensive; or the applicant has not provided a statement of support for earlier amendments; or an earlier statement of support was inadequate and the inadequacy has not since been addressed. Where the application is otherwise in order for acceptance, the application will not proceed to acceptance unless the requirement of regulation 58(a) has been met prior to expiry of the period regulation 80(1).

Fees for amendments

23. A fee for proposing an amendment to a complete specification is required after examination has been requested, and where the amendment is a voluntary amendment e.g. not in response to a specific objection raised in an examination report.

24. The fee for amendments is due at the time of filing of the proposed amendment. Where the fee is not paid, or is later found to be required, then the applicant will be required to pay the outstanding fee at the time of filing the next response, or before acceptance if it is the sole matter outstanding.

25. Note – the fee for amendment of a specification relates only to the complete specification. The Act and Regulations are silent on amendment of a provisional specification.

Introduction

1. This guideline outlines IPONZ practice for requests to amend the complete specification of a patent before acceptance under s 40, which reads:

40 Amendment of complete specification before acceptance

- (a) Before the acceptance of a complete specification, the applicant may, in the prescribed manner, amend that specification.
- (b) Subsection (1) is subject to section 33(5).
- (c) Subpart 8 applies in respect of amendments to a complete specification after the acceptance of the complete specification.

Amendments under s 40

2. The following amendments to a complete specification fall directly under s 40:

- Amendments (except those mentioned in paragraph 3) made, or proposed, prior to the commencement of examination including amendments made to the description, claims and drawings of a Treaty application prior to the commencement of the national phase.
- Amendments made during examination, including during any period for which acceptance is postponed.
- Correction of an error to a complete specification – see s 202(5).

Amendments that don't qualify under s 40

3. For Treaty applications the following amendments don't fall under section 40:

- correction of defects in the description, claims and drawings at the invitation of the receiving office under Rule 26 of the PCT Regulations, and
- rectification of an obvious mistake under Rule 91.1 of the PCT Regulations,

For more information see guideline: Amendment of description, claims and drawings of Treaty applications.

Examination of the amended specification

4. Section 69(1) requires an amended specification to be examined in the same manner as the original specification.

5. The examiner will check that amendments have been correctly performed and that the amended specification meets the requirements of the Act and regulations in all respects. Any deficiencies or objections will be reported in the next examination report.

Requirements for a request to amend a complete specification

6. The 'prescribed manner' for requesting amendment of a complete specification under s 40 is set out in regulation 58:

58 Amendment of complete specification before acceptance

An amendment of a complete specification before acceptance under section 40 of the Act must include—

- (a) the applicant's reasons for making the amendment; and
- (b) a copy of the proposed completed specification as it would appear following amendment; and
- (c) a copy of the marked-up pages of the complete specification with the amendments clearly shown; and
- (d) a statement setting out the specific part or parts of the original complete specification that supports each of the proposed amendments.

Purpose of regulation 58

7. By complying with regulation 58 the applicant assists the examiner to understand what has been amended, the reasons for the proposed amendments, and to quickly identify and access the parts of the original complete specification that provide support for the amendments.

8. If the amendment request doesn't meet the requirements of regulation 58, the examiner may refuse the request outright and insist that the deficiencies are rectified in a fresh request. Alternatively, the examiner may continue examination as though the amendments have been accepted so long as a review of the information provided in the request and the documents already on file together indicate that the reasons for the amendment, and support within the disclosure, are self-evident. Nonetheless, the applicant may be still required to rectify any deficiencies in the amendment request, as noted by the examiner, in their next response.

9. If the examiner considers the request is deficient they will notify the applicant and provide them with an opportunity to provide the missing information prior to the expiry of the period set out in regulation 80(1) - the period for placing the application in order for acceptance. Failure to do so will risk the application being treated as abandoned.

Reasons for making the amendment – regulation 58(a)

10. Reasons for an amendment of a specification generally fall into two categories:

- to address an objection in an examination report; or
- voluntary amendments.

11. The amendments are categorised in this way because 'voluntary amendments' are subject to payment of a fee whereas amendments made in response to an objection are not.

12. Reasons must be provided for each and every amendment irrespective of the category of the amendment (as defined above). If several amendments are performed for the same reason, then a single statement of that reason will be sufficient with regard to those amendments. If amendments are performed for different reasons, then a statement of the reasons for each should be provided. The statement of reasons does not necessarily have to be in the form of a separately identified statement; the reasons might be included in the applicant's general submissions regarding the amendment or in the statements of support for example.

13. Although an indication of the root cause of the amendment would be helpful to the examiner, for example, that an amendment has been performed ‘to distinguish the claimed invention from the prior art base’, the applicant is not obliged to mention root causes in the reasons for amendment; for example, the reason that the amendments are made ‘in answer to the examiner’s objection’ will be sufficient.

14. If a primary amendment that is made in response to an examination objection necessitates secondary amendments, the secondary amendments will generally also be considered to be amendments in response to an objection.

Examples of ‘necessitated’ secondary amendments:

- Renumbering of claims and altering dependency references in claims when a claim is deleted.
- Amending ‘consistency clauses’ in the disclosure of the specification to correspond to claims that have been amended to address an objection. However, requesting amendment of the consistency clauses during the ‘acceptance postponement period’ (once the acceptance report has been issued) will be considered to be a voluntary amendment and will attract an amendment fee.

15. Any amendments not made in response to a specific objection raised in an examination report will generally be considered to be ‘voluntary amendments’.

16. In particular, if the only stated reason for making amendments is “to comply with the requirements of NZ law and/or practice” or “to bring the claims into alignment with those of a corresponding application in another country” or similar, and no other reason for making the amendments is evident then these amendments will be treated as voluntary amendments.

Copy of amended complete specification – regulation 58(b)

17. When proposing amendments applicants must provide a clean copy of the full specification incorporating all of the proposed amendments.

18. The examiner will check that the clean specification includes all of the pages, drawings, sequence listings and other details. Applicants must ensure that the entire complete specification document is provided and that no parts are missing. The examiner will raise an objection under regulation 58(b) if the applicant fails to incorporate all of the proposed amendments into the clean specification, does not provide all the parts of specification in the clean specification document, or omits to file the clean specification document.

Copy of the marked-up pages showing amendments - regulation 58(c)

19. A marked-up copy of the pages of the complete specification clearly indicating all of proposed amendments must be provided. The examiner uses the marked-up pages to identify and examine the proposed amendments. The marked-up amendments should be consistent with the amended specification.

20. The mark-up should be clear and legible with the amendments clearly and unambiguously distinguished, for example by underlining or colouring additions and striking through deletions.

21. By itself a 'pseudo mark-up', being, for example, the striking through of whole swaths of original claims and presenting fresh unmarked amended claims without any mark-up of the amendments that have been made to the original claims is not generally considered to comply with regulation 58(c). If it is impractical to provide a detailed mark-up then an explanation of the amendments sufficient for the examiner to identify the proposed amendments in detail should be provided along with the pseudo mark-up.

22. The applicant should also advise the version of the complete specification from which the pages have been marked-up. For example, the marked-up pages may be from the originally filed pages, or from earlier amended pages which have already been examined.

Statement of support – regulation 58(d)

23. Regulation 58(d) requires the applicant, if they are to rely on support for an amendment in the original specification, to provide a statement specifying the specific part or parts of the original specification that supports each of the proposed amendments.

24. The statement of support is required irrespective of whether the proposed amendments are in response to an objection made in an examination report or are voluntary amendments, and must be submitted at the same time as the proposed amendments.

25. The statement of support must identify where support for the proposed amendments can be found within the original complete specification. For a Treaty application entered into the national phase, the specification as originally filed corresponds, excepting corrections under Rule 26 and rectifications under Rule 91, to the description, claims, and drawings at the international filing date.

26. The statement of support may be supplemented by, or be arranged as, a table indicating where, for example, amended claims have correspondence with originally filed claims, and/or where support can be found within the description of the originally filed specification.

27. The requirement that support must be found in the originally filed specification does not preclude the applicant from practically referring, in the statement of support, to the paragraph and line numbers of the version of the complete specification document immediately preceding the amended document, so long as the support can be traced back to a specific part or parts of the original complete specification. This does not contradict the requirements of paragraphs 25 and 26, but accounts for the practicalities of tracking the amendments through several versions of the complete specification document.

28. If specific support for a proposed amendment is not present in the original complete specification then clearly the applicant will be unable to comply with regulation 58(d) for that amendment. Regulation 58(d) does not impose a substantive requirement that there must be specific support in the original specification for every proposed amendment, and will not prevent consideration by the examiner of an amendment for which it is not possible to provide a specific statement of support. ¹

29. For amendments which have 'explicit textual support' or direct and clear support in, for example, the drawings of the specification, the statement of support can be likewise direct and specific.

30. An amendment may find 'support' in the original complete specification if a skilled person having regard to the original specification and the 'common knowledge' at the filing date, would have understood the matter in the amended specification to have been disclosed at the filing date of the original. Therefore, the original specification may support an amendment even though it does not include explicit textual support or direct support from the drawings for the amendment. In this case the 'statement of support' should be provided in the form of a statement of the rationale by which specific parts of the specification can be combined with the common knowledge to provide specific support for the amendment.

31. Examples of amendments which may lack explicit textual or drawing support but for which applicants nonetheless do need to provide a statement of support are listed in paragraphs 32 and 33 below.

32. Disclosure amendments (including disclosure within the claims):

- Correcting errors where the only sensible way a skilled person could read the expression as having support is to consider the corrected version. These errors are generally, though not necessarily, 'obvious mistakes' in the sense of being immediately evident from within the document, and with the correction also evident. The rationale given should carefully explain the nature of the error and the original intent.
- Amending terminology to correctly, consistently, or more accurately relate to the features of the described invention without adding anything new. An explanation of the amendment and why it does not introduce new material should be provided.
- Converting unit quantities into metric measure to comply with regulation 32(a). Support is provided by the imperial units converted and the standard conversion factors and this is what should be stated in the statement of support.
- Correcting indexing in the drawings or written part of the specification. Explanation as for correction should be provided.
- Making corrections to bring the specification into compliance with a regulation, e.g. removing dimensioning from the drawings as per regulation 28(d).
- Inserting a reference to an associated New Zealand case such as a divisional or parent application.
- Amending or augmenting references to prior art or co-pending cases already present in the specification to refer to a New Zealand equivalent or a more readily available equivalent. See E.R. Squibb & Sons Inc [1977] NZIPOPAT 10 (1 December 1977).
- Correcting the description of a drawing, or the construction or performance of the invention, that is clearly incorrect and for which the correct description can be deduced from the original specification by the person skilled in the art at the filing date of the original specification.
- Amending the title of an invention in the complete specification or application so as to be compatible with the invention disclosed and claimed.

33. Claim amendments in particular:

- Replacing claims defining subject matter that is explicitly excluded from being patentable in New Zealand by claims that define subject matter that is not excluded and which are

nonetheless supported by the original disclosure. For example, medical treatment claims may be replaced by “Swiss-type” claims if the original specification disclosed the limitations (the compound used, disease treated, dosage used etc.) of the proposed Swiss-type claims. If original method claims recited the limitations the statement of support should reference those claims. If the original claims did not recite the limitations then the statement of support will need to reference the appropriate portions of the original specification in which the limitations are disclosed.

- Converting a ‘standardised’ or rule prescribed claim format to a different format without ostensibly affecting the scope of the claim. For example, claims using the “characterised in that ...” format may be amended to the “wherein ...” format or vice-versa, and references in claims to the drawing indices, as required in some jurisdictions, may be deleted from claims so long as the amended claims remain clear or are grammatically adjusted to be clear when the drawing indices are removed.
- Adding so called ‘omnibus’ claims that are directed to specific embodiments or examples of the invention disclosed, and that fall within the scope of the main inventive claims. The additional claims may be dependent or independent.
- Restructuring claim numbering and appendices after claim amendments to maintain the dependency structure supported by the original claims. A justification, for example, “The subject matter of Claim 3 has been incorporated into claim 1 and the claim numbering and dependencies have been adjusted accordingly”, should be provided.

Correct filing of documents

34. When amendments are submitted into the IPONZ case management facility, distinct and separate response documents, using the appropriate document type selected from the pick-list provided in the document upload page, should be uploaded. Using the correct document type will ensure the amendments can be examined efficiently and the latest amended clean complete specification document correctly identified on the register.

- A letter replying to objections and/or detailing the reasons and support for amendments should be loaded as a document of the type: **National Entry PCT Objection Response** (for PCT applications) or **Complete Patent Objection Response** (for non-PCT applications).
- The document showing the marked up pages showing the amendments should be loaded as the type: **Description of the amendments proposed**.
- Most importantly, the clean amended complete specification document should be loaded as a document of the type: **Complete specifications**.

Fee for voluntary amendments

35. A ‘voluntary amendment’ for which a fee is payable is defined in Part 1 of the Schedule of the Patent Regulations 2014 as:

Amendment by applicant of complete specification before acceptance (other than in response to an objection raised in a report issued by the Commissioner under section 65 or 97 of the Act)

36. IPONZ will not require an amendment fee if applicants propose amendments to their complete specification before examination is requested as this generally reduces the examination effort required.

Circumstances where fee is not required

37. Examples of voluntary amendments which may reduce subsequent examination effort and for which the amendment fee will not be required:

- correct a mistake in the complete specification which is a correction that would be, or could reasonably have been, requested by the examiner;
- amendments that have been proposed in response to objections raised in an examination report on a substantially equivalent application by another patent examination authority or office;
- replacing 'medical treatment claims' with Swiss type claims;
- narrowing the scope of claims to overcome 'prior art' objections;
- clarifying the definition of the invention as claimed.

Circumstances where fee is required

38. A fee is payable if after requesting examination but either before examination or during examination the applicant proposes amendments to:

- convert a 'standardised' or rule prescribed claim format to a different format;
- add so called 'omnibus' claims;
- insert statements that assert that the invention is in some way generally useful without actually defining a specific, credible and substantial utility of the invention;
- broaden the scope of the claims;
- add new independent claims;
- amend the specification in any way which does not have the effect of reducing the examination effort that would otherwise have been required.

39. Once examination has been requested the fee may be paid voluntarily by the applicant at the time the amendment is proposed.

40. The examiner may consider the merit of an amendment proposed before the fee has been paid. If the fee is then found to be required the applicant will be required to pay the outstanding fee at the time of filing the next response, or before acceptance if it is the sole matter outstanding. The amendment can be withdrawn but the fee remains payable.

Post-dating of application or specification – s 33(5)

41. Section 40 allows for a wide range of amendments subject to the possibility of post-dating under section 33(5) where 'added matter' is introduced.

42. While s33(5) itself does not specify when the Commissioner will direct post-dating, it is settled practice that where the proposed amendment 'adds matter' (describes matter that was not in substance disclosed at the filing date of the complete specification) the applicant will only be entitled to the date of the amendment, not the original or earlier date². The Commissioner has the discretion to direct post-dating.³

43. If the applicant does not supply the examiner with a statement of support and the information on the file does not otherwise indicate that the amendment is in fact supported, the amended specification evidently requires post-dating under s 33(5). The applicant will be advised that the Commissioner may direct that the application or specification (or both) be post-dated to the date that the amendment was first filed.

Approach for determining if post-dating is required

44. When assessing whether the amended specification 'adds matter' or 'describes matter that was not in substance disclosed in the specification at the original filing date' the examiner will follow the approach set out in *Novo Therapeutisk Laboratorium* [1967] NZIPOPAT 1:

Amendment before acceptance is at the discretion of the Commissioner and an application to amend a complete specification may be decided in one of three ways according to the extent of the new material proposed to be introduced into, or substituted for, the original specification:

- (1) An amendment, to remedy an obvious defect which is not substantial, which is limited to the minimum necessary for a satisfactory specification, and which does not introduce any matter not justified by the original description may be allowed without penalty.
- (2) Where the amendment is one that modifies or adds to the matter originally disclosed whether made in response to an examiner's objection or on the initiative of the applicant, the specification must be post-dated.
- (3) Finally, where in the previous case the applicant is unwilling to postdate, or where the amendment has the effect of including a further invention, the application cannot proceed but the amending matter may form the subject of a new application and be antedated to the date of filing the new material.

45. For PCT national phase applications, if matter that goes 'beyond the disclosure in the international application as filed' has been added to the specification, then post-dating may be required. Both an observation made in an international report or the examiner's comparison of the amendments made during the international phase with the original description, claims and drawings, may indicate that matter has been added by way of amendment during the international phase.

When post-dating will be directed for 'added matter'

46. Simply adding (or deleting) material from a complete specification is not necessarily an amendment that will be considered to be the addition of matter that requires post-dating of the specification.

47. However 'added matter' that:

- incorporates new information into the complete specification that is directly concerned with the description of the features and the performance of the invention; and
- presents a person skilled in the art, and in possession of the common general knowledge relating to the field of the invention, with information which is not clearly and unambiguously derivable from the originally filed complete specification,⁴ will be the subject of a Commissioner's direction to post-date the application/specification under section 33(5).

48. Broadly such amendments may be proposed in order to:

- Overcome an objection that the original complete specification does not 'disclose the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art and to disclose the best method of performing the invention that is known to the applicant and for which there is an entitlement to claim protection'.
- Attempt to limit claimed subject matter by extracting a specific feature in isolation from a set of features originally disclosed only in the context of an interworking combination of features forming the invention.
- Remove a specific constraint disclosed in the complete specification, the removal of which has the effect of broadening the disclosure although no explicit addition of material is evident.

49. More specific examples of 'added matter' type amendments for which the Commissioner would generally direct post-dating under section 33(5) are listed below:

- Adding new examples or embodiments of the invention to the disclosure as distinct from making explicit what would have been implicit to the person skilled in the art.^{5,6}
- Inserting matter originally disclosed only in the abstract that accompanied the complete specification and not in the original specification itself.
- Inserting matter into a complete specification from a provisional specification or basic convention application specification that was not present in the complete specification at its filing date.⁷
- In so far as the claims are read as forming part of the disclosure of the invention, broadening claims in such a way that they imply that the invention may be performed in ways that are not described in the original complete specification.
- Replacing or removing from a claim a constraint or limitation apparently disclosed in the original specification to be an essential feature of the invention. The approach to be taken when evaluating the amendment is to ask whether the skilled person would be able to recognise directly and unambiguously (i) that the feature was not explained as essential in the original disclosure and (ii) that it was not, as such, indispensable for the function of the invention in light of the problem it served to solve, and (iii) that its replacement or removal required no real modification of other features to compensate for the change.^{8,9}

- Amending the dependency structure of claims so as to claim combinations of features that were not disclosed as being combined in the original complete specification.¹⁰
- Replacing a particular expression in the original specification with a general expression extending beyond what would be implicit to a person skilled in the art reading the original.
- Removing an essential restrictive qualification from the original complete specification.
- Entering a disclaimer not presented in the original specification which is or becomes relevant for the assessment of inventive step or sufficiency of the disclosure of the invention. Disclaimers that only restore novelty to a claim, or exclude unpatentable subject matter from a claim, are permitted without post-dating but a disclaimer that does more than this will require post-dating.
- Inserting a statement that the invention has a specific, credible, and substantial utility that was not originally disclosed either explicitly or by implication.
- Inserting a clause directed to defining a specific technical objective to be achieved by use of the invention that was not originally disclosed either explicitly or by implication.
- Inserting references to documents or descriptions of matter which are not incontrovertibly established to be within the prior art base. This includes descriptions of prior art that are not commensurate with the actual content of prior art to which reference is made. To avoid post-dating the applicant must establish that the matter to which a reference is proposed to be inserted is indeed part of the prior art base.
- Seeking to redefine the meaning of an expression or word in the specification beyond what would be commonly understood by persons skilled in the art.
- Substituting allegedly synonymous terms when justification for the substitution is not evident from the original specification, or when the applicant cannot justify that the terms are commonly held to be synonymous by persons skilled in the art.
- Asserting that information or a document described in the specification as being within the prior art base is not common knowledge. If the veracity of the assertion is not justified by the applicant then it is merely a matter of opinion, the matter may indeed be common knowledge, and the assertion may be false.
- Taking a feature from a specific embodiment and introducing that feature, stripped of its context, into a claim in circumstances where it would not be apparent to the skilled person that it has any general applicability to the invention, or that the other features of the embodiment were not necessary to carry out the claimed invention. Put another way, it must be apparent to the skilled person that the selected feature is generally applicable to the claimed invention absent the other features of that embodiment.¹¹

Amendments for which post-dating will not generally be directed

50. The Commissioner will not generally direct post-dating for pre-acceptance amendments of the following types, provided they do not go beyond the scope of the original disclosure:

- Inserting statements that assert that the invention is in some way generally useful without actually defining a specific, credible and substantial utility of the invention. The object clause 'or provide the public with a useful choice' is an example of this sort of insertion.

- Inserting references to background prior art, similarly to what is required under Rule 5 of the PCT Regulations. Justification that the reference is indeed within the prior art base should be provided.
- Removal of references to background prior art found in the original complete specification for the purpose of complying with the rules of jurisdictions outside New Zealand. Applicants should be aware that the removal of such references may have the unintended effect of removing disclosure of the invention that is essential for the sufficiency of the disclosure in accordance with s 39(1)(a).
- Introducing a definition of 'comprising' as a non-exhaustive term, and/or 'consisting' as an exhaustive term, where this is consistent with the original disclosure.
- Adding a general clause to the effect that variations and modifications that fall within the claims are contemplated.
- Prior art disclaimer statements to the effect that the prior art noted is not an admission of common general knowledge.

51. Amendments such as the above are considered as voluntary amendments, and will attract a fee if the amendment is submitted after examination has been re

Footnotes

¹ CNH Industrial Belgium NV [2018] NZIPOPAT 7 (30 April 2018)

² Novo Terapeutisk Laboratorium [1967] NZIPOPAT 1 (27 July 1967)

³ Shionogi & Company Limited's Application [1967] RPC 623 at 627

⁴ Novo Terapeutisk Laboratorium [1967] NZIPOPAT 1 (27 July 1967), Biocon Limited [2018] NZIPOPAT 2 (15 January 2018), and Biocon Limited [2018] NZIPOPAT 5 (10 April 2018)

⁵ Pantext Pty Ltd [1996] NZIPOPAT 6 (13 June 1996)

⁶ Shionogi & Company Limited's Application [1967] R.P.C. 623

⁷ Marrick Manufacturing Co.Ltd.'s Application (Practice P.A.T) [1967] R.P.C at 606

⁸ Imperial Chemical Industries Limited (Jones') Application [1969] R.P.C. 622

⁹ Nokia Corporation v IPCOM GMBH & CO KG (No.3) [2013] R.P.C. 5

¹⁰ Charles Caulder Bree [2017] NZIPOPAT 16 (19 July 2017)

¹¹ Nokia Corporation v IPCOM GMBH & CO KG (No.3) [2013] R.P.C. 5