**Section 40 Amendment of complete specification**

**40 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)](http://www.legislation.govt.nz/act/public/2013/0068/latest/link.aspx?search=ts_act%40bill%40regulation%40deemedreg_patents_resel_25_a&p=1&id=DLM1419259" \l "DLM1419259).

1. [Subpart 8](http://www.legislation.govt.nz/act/public/2013/0068/latest/link.aspx?search=ts_act%40bill%40regulation%40deemedreg_patents_resel_25_a&p=1&id=DLM1419324" \l "DLM1419324) 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—

* 1. the applicant’s reasons for making the amendment;
  2. and a copy of the proposed completed specification as it would appear following amendment;
  3. and a copy of the marked-up pages of the complete specification with the amendments clearly shown; and
  4. 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 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?

1. The statement of support should be submitted at the same time as submitting the corresponding amendments. Failure to provide the statement may result in a halt in examination of the application until the statement has been provided.
2. 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.
3. 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

1. 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.
2. 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))

1. Reasons for making an amendment of a specification of an application under examination will generally fall into one of two categories:
   1. to meet an objection raised in an examination report, or
   2. that the amendment is a voluntary amendment i.e. not in response to an objection raised in an examination report.
2. 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).
3. 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.
4. 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

1. 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.
2. 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).
3. 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))

1. 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))

1. 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.
2. 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.
3. Where marked-up pages are not provided with a response to which the corresponding amendments have be 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

1. 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.
2. 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

1. 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.
2. 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.
3. Note – the fee for amendment of a specification relates only to the complete specification. The act or regulations are silent on amendment of a provisional specification.