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**From:** Rich Wolfson [mailto:rwolfson@clarcor.com]

**Sent:** Tuesday, May 02, 2006 11:59 AM

**To:** AB93Comments

**Cc:** Norm Johnson; Sam Ferrise; Dan Schulte; Andrew J. Heinisch

**Subject:** CLARCOR Inc comments to proposed revision to 37 C.F.R. Sec 178

**Richard M. Wolfson**

Vice President – General Counsel and Corporate Secretary

May 2, 2006

**VIA ELECTRONIC MAIL**

Mr. Robert W. Bahr  
Mail Stop Comments -Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Re: CLARCOR Inc. comment to proposed revision to 37 C.F.R §1.78**

Dear Mr. Bahr:

I am writing you today to voice the support of CLARCOR, Inc. for the new "continuation proposal" of the U.S. Patent & Trademark Office (i.e. the proposed revision to 37 C.F.R §1.78).

CLARCOR Inc. is a publicly traded U.S. company (NYSE: CLC) and a large manufacturer of filtration and consumer packaging products. Through our several subsidiaries, we have obtained numerous patents from, and currently have numerous patent applications pending before, the U.S. Patent & Trademark Office. We pride ourselves on being innovative in our various industries and we recognize patent protection as an important tool for protecting our investments in technology and new designs.

That said, we have serious concerns that the patent laws are being misused, particularly in the area of continuation patents. We share the concerns voiced by the U.S. Patent & Trademark Office that too often companies intentionally delay prosecution of claims and repeatedly file continuation patent applications

without patentably distinct claims for the purpose of creating a “moving target” for their competitors and delaying the consideration of new claims through the sheer volume of their continuation applications. It is clear to us that parties in our industry use the current continuation practice as a strategic “block” rather than a legitimate tool to protect patentably distinct innovations.

We also share the U.S. Patent & Trademark Office’s view that the current continuation practice does not serve the public notice function. In our own experience, we have suffered several instances where we invested substantial amounts of time and money to pursue technologies that would not violate published patents, only to be “sandbagged” when the patent holders sought continuation patents after the fact in order to counterattack our own innovations. Ultimately, we believe that U.S. business and the public are better served when parties can rely on published patents to make their investment decisions, without having to intuit how a patent might ultimately be “continued”.

In light of the foregoing, we support the efforts of the U.S. Patent & Trademark Office to change the current continuation practice under the proposed revisions to 37 C.F.R §1.78.

Despite this support, we do offer the following editorial suggestion vis-à-vis the proposed amendment to 37 C.F.R §1.78. Currently, the proposed amendment states that second or subsequent continued examination filings, whether a continuation application, a continuation-in-part application, or a request for continued examination, “*be supported by a showing as to why the amendment, argument, or evidence presented could not have been previously submitted.*”

To make it clearer, we would suggest expressly including the term “new claim” to this passage, so that it would require “*a showing as to why the new claim, amendment, argument, or evidence presented could not have been previously submitted.*” (emphasis added.) While we believe that the intent of the current proposal is to include new claims, expressly addressing the concept would help resolve any potential ambiguity.

We applaud the initiative of the USPTO with respect to this matter and appreciate your consideration of our comments. Naturally, if you would like any additional information or input, please feel free to contact us.

Very truly yours,

Richard M. Wolfson  
Vice President, General Counsel and Corporate Secretary