

Fed. Circ. In Oct.: Spotlight On Wording Beyond Patent Claims

By **Sean Murray and Jeremiah Helm** (December 4, 2025)

This article is part of a monthly column that highlights an important recent patent appeal. In this installment, we examine the Federal Circuit's ruling in Barrette Outdoor Living v. Fortress Iron.

A company's patent attorney plays a central role in the development of its patent portfolio. When it comes time to enforce the company's patents, the specific words used by the patent attorney are critical and often disputed. The wording of the patent's claims is the quintessential example.

The claims are the rock stars of patent litigation — they typically receive the lion's share of attention from both the parties and the courts, and rightly so. Virtually every issue of liability and damages depends on the scope of the asserted claims.

Sometimes, however, the focus of a litigation can shift away from the claims to the words the attorney used in the patent's specification or in communications with the U.S. Patent and Trademark Office. A pertinent example is Barrette Outdoor Living Inc. v. Fortress Iron LP, a dispute the U.S. Court of Appeals for the Federal Circuit **addressed** on Oct. 17.

Barrette provides useful guidance on specification disclaimer and prosecution disclaimer, doctrines often used by defendants to narrow the scope of patent claims and avoid infringement.

Familiarity with the decision will help patent prosecutors know how they can disparage the prior art in a patent's specification without triggering specification disclaimer, and when they should refrain from making arguments to the USPTO that could lead to prosecution disclaimer.

Barrette sued Fortress for infringement of four patents directed to fencing used on sloped surfaces. The fencing's pickets and rails rotate relative to one another so that the pickets can all remain vertical even as the rails are angled to extend generally parallel to the sloped ground below them.

Barrette's patents teach that the rails and pickets are rotatably connected using connectors with bosses that are inserted into holes in the pickets. Figure 5 from U.S. Patent No. 8,413,332 shows a segment of the fencing with rails 30 and vertically oriented pickets 20.



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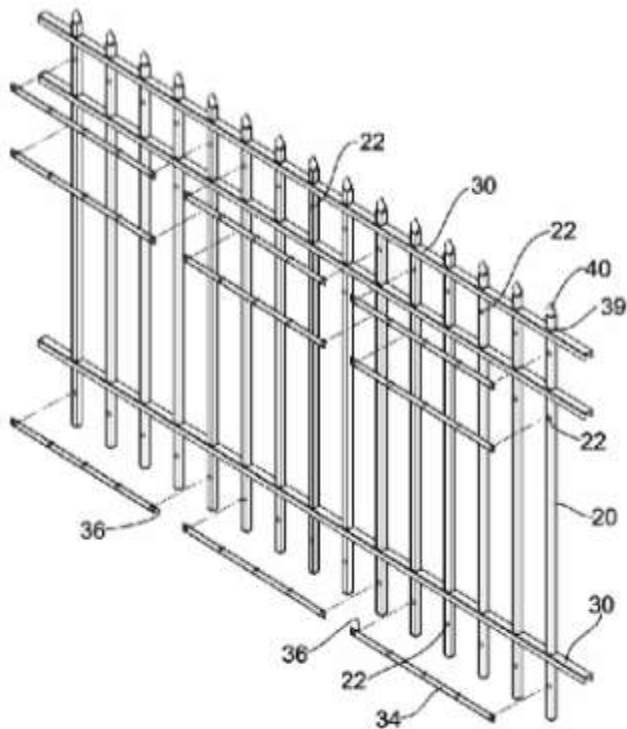


FIG. 5

During prosecution, the USPTO granted the first two patents, but then rejected the third patent over a patent application to Sherstad. In response, Barrette argued that Sherstad disclosed conventional rail-picket connectors, in which a loose pin extended into the picket's hole, not connectors with the claimed integral boss.

However, Barrette's decision to narrow the claim to integral bosses was ineffective. The USPTO maintained the rejection because it found that Sherstad disclosed both nonintegral and integral bosses.

The USPTO ultimately allowed Barrette's third patent, but only because Barrette canceled all of the rejected claims and added new claims with language similar to the two previously granted patents.

However, Barrette's success proved to be a pyrrhic victory. In the litigation with Fortress, the U.S. District Court for the Northern District of Texas found that Barrette's prosecution argument about Sherstad disclaimed nonintegral bosses, limiting the claims of all four asserted patents to connectors with integral bosses.

The district court also found that Barrette's statements in the patents' shared specification disclaimed connectors that used fasteners to attach the bosses to the pickets. The court focused on language criticizing prior art fencing with such fasteners as "time consuming to install."

The district court ruled that this was a disclaimer of bosses with fasteners, limiting the patent claims to fastenerless bosses. The district court then entered judgment of noninfringement, as it was undisputed that Fortress' bosses were neither integral nor

fastenerless.

On appeal, the Federal Circuit disagreed with the district court's ruling that specification disclaimer limited the claims to fastenerless bosses, but agreed that prosecution disclaimer limited the claims to integral bosses.

In addressing specification disclaimer, the Federal Circuit noted that the specification criticized the prior art not only for being slow to install, but also for allowing only limited rotation between the rails and pickets, a feature known in the industry as racking.

Because bosses with fasteners could solve one of the two problems in the prior art, i.e., poor racking, the specification's criticism that fasteners make installation slow did not disclaim all bosses with fasteners. The court stressed that every embodiment of the patented invention need not embody every advance over the prior art.

Turning to prosecution disclaimer, the Federal Circuit agreed with the district court's conclusion that Barrette disclaimed nonintegral bosses when it distinguished Sherstad's connectors from the claimed integral boss.

Relying on the Federal Circuit's 2009 decision in Ecolab Inc. v. FMC Corp. and its progeny, Barrette argued that it made no clear and unmistakable disclaimer of claim scope because the examiner was unpersuaded by Barrette's attempt to distinguish Sherstad, and Barrette later abandoned the argument by canceling the pending claims.

The Federal Circuit was unpersuaded. Unlike in Ecolab, where the examiner rejected the patent applicant's argument about the scope of the claims, in this case the examiner determined that Sherstad disclosed both integral and nonintegral bosses and therefore invalidated the pending claims even under Barrette's narrow construction that limited the claims to integral bosses.

Because Barrette's narrow construction was not rejected by the examiner, Barrette was bound by its disclaimer even though it subsequently canceled its claims.

Finally, the Federal Circuit agreed with the district court that Barrette's disclaimer during prosecution of its third patent applied to all other patents in the family with the same claim term, even the two patents that issued before Barrette made its argument about Sherstad.

The Barrette decision offers many insights for patent prosecutors.

First, it provides clear guidance on how to avoid specification disclaimer: The specification should discuss multiple insufficiencies in the prior art, not just one.

This approach is superior to avoiding all criticism of the prior art. That ultraconservative strategy makes it difficult for the patent to show that its invention is an advance in the field. And describing such an advance is, of course, important for persuading the USPTO and juries that the claimed invention is patentable.

Barrette is also a cautionary tale about the risks of prosecution disclaimer. It is hazardous to distinguish prior art with an argument that limits the claims unless the prosecuting attorney is certain the argument will overcome the examiner's rejection.

Attorneys should never be content to narrow pending claims in a way that merely distinguishes the prior art reference's preferred embodiment or figures. If the narrowed

claims are disclosed by any embodiment in the prior art, even one only mentioned in passing in the written description, the examiner could accept the proposed narrow construction of the claims and still maintain the rejection.

The Barrette decision is another reminder that prosecuting attorneys must choose their words carefully, and not just when drafting the all-important language of the claims.

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