

Title: **Disclaimer During Later Patent Prosecution Can Limit Earlier, Issued Family Members**

The recently decided case of *Barrette Outdoor Living, Inc. v. Fortress Iron, LP et al.*, No. 2024-1231 and 2024-1359, slip op. (Fed. Cir. October 17, 2025) addressed the effect of statements made during prosecution of a patent application on prior patents in the same patent family.

Barrette asserted infringement of four patents. During claim construction, Fortress argued that Barrette had disclaimed certain subject matter during prosecution of one of the patents in suit, U.S. Patent No. 9,151,075 (the '075 Patent). It was undisputed by the parties that, at the time of the alleged disclaimer, two of the other four asserted patents—U.S. Patent Nos. 8,413,332 and 8,413,965 (the Prior Patents)—had already been granted by the United States Patent and Trademark Office.

During prosecution of U.S. Patent Application No. 12/702,887 (which led to the '075 Patent), the Examiner rejected the claims on the grounds that the prior art “Sherstad” reference disclosed the claimed connector. In response to the rejection, Barrette attempted to distinguish its claimed connector on the ground that “Sherstad discloses ‘a conventional pivot hole and pivot pin assembly,’ and not ‘a slip-together connection with the claimed integral boss’” (Slip op. at 5). Barrette further contended that “‘there is no disclosure . . . to substitute in the pivot-pin assembly of Sherstad,’ and, even if there were, ‘the resulting structure would not include the claimed integral boss and as such would not provide the same slip-together functionality’” (Id). When the Examiner maintained the rejection, Barrette subsequently canceled the rejected claims and substituted other claims of a different scope. Notably, Barrette’s substituted claims recited more general “boss” language that was consistent with the Prior Patents but lacked an express “integral” requirement.

At the District Court, Fortress argued that the statements made by Barrette in the '887 Application constituted a disclaimer of non-integral bosses. Fortress contended that this disclaimer was not limited to the resultant '075 Patent, in which the statements were made, but extended to the claims in the Prior Patents, despite the fact that those claims had already issued at the time of the alleged disclaimer. Barrette disputed that there was a disclaimer, but in any case contended that any disclaimer could not be effective as to the Prior Patents.

The district court sided with Fortress, holding that the statements in the prosecution history of the '075 patent limited the “boss” terms in all of the asserted patents to integral structures. This limitation was effective even though the disclaimer occurred after the issuance of the Prior Patents.

On appeal, the Federal Circuit rejected Barrette’s contention that the purported disclaimer in the '075 patent’s prosecution history could not apply to the claims of the already issued Prior Patents. The Court held that “[a] statement made during prosecution of related patents may be properly considered in construing a term common to those patents, regardless of whether the statement pre- or post-dates the issuance of the particular patent at issue” (Slip op. at 16-17).

Barrette separately argued that its statements made in the '887 Application did not show “clear and unmistakable disclaimer” because the Examiner maintained the rejection in the face of Barrette’s arguments, and the claims at issue were subsequently cancelled. The Federal Circuit rejected that position as well, finding that a reasonable reading of the prosecution history did not show that the Examiner had rejected Barrette’s disclaimer. Instead, the Court found that the Examiner maintained the rejection based on a disagreement regarding the scope of the prior art, rather than the scope of the claims. In doing so, the Court cited an earlier

decision which held that a prosecution disclaimer analysis “focuses on what the applicant said, not on whether the representation was necessary or persuasive” (Slip op. at 15).

The Court acknowledged Federal Circuit precedent that applicants may rescind a disclaimer made during prosecution by putting the examiner on notice that previously examined prior art may need to be revisited (Slip op. at 16), but Barrette conceded during oral argument that it did not make such a rescission in this case.

Practice Tips:

When subject matter is surrendered during patent prosecution, applicants should consider whether it is appropriate to rescind any disclaimer of subject matter. In order to rescind a disclaimer, the rescission must be clear and on the record.

It is a useful practice, when filing a continuation application, to make a clear rescission at the time of filing the application. For example, the transmittal letter of a continuation application may contain the following rescission:

Examination of the claims presented in this present application should be considered independently from the prosecution of the claims of the parent application(s). Any disclaimer or characterization relating to the prior art or the claimed invention of a parent application relates solely to the claims of that parent application and is hereby rescinded, as Applicants do not intend to be limited to the assertions or arguments asserted during the prosecution of the parent application(s), unless expressly reasserted during the prosecution of the present application. The Examiner therefore must consider the presently claimed invention as independent and with no predisposition based upon the prosecution of the parent application(s). Any prior art distinguished in the parent application(s) may need to be reconsidered by the Examiner. The Examiner has access to the documents of the file wrappers of the parent application(s) cross-referenced as related in the present application, and Applicant does not believe it necessary to provide the Examiner with all the documents from the respective prosecution history. Applicant respectfully requests that the Office expressly advise the Applicant if it disagrees with the foregoing.

Finally, it is important to remember that narrowing statements made during prosecution of later applications can apply with equal force to the claims of prior, issued patents. Applicants should carefully consider any arguments or amendments made during prosecution of claims containing limitations found in earlier, issued patents in the same family. In Barrette, the defendant succeeded because the patentee submitted arguments during prosecution that diverged from the express claim language. This case serves as another reminder that arguments during prosecution should tightly track the actual claim language, particularly when that claim language is used in related patents.

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