

On behalf of **FreightCar America, Inc.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREIGHTCAR AMERICA, INC.,
Petitioner,

v.

NATIONAL STEEL CAR LIMITED,
Patent Owner.

IPR2025-01046
Patent 8,166,892

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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EXHIBIT LIST

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1001	U.S. Patent No. 8,166,892 (“the ’892 patent”)
1002	File History of the ’892 patent
1003	Declaration of Mehdi Ahmadian, Ph.D.
1004	Excerpts from <i>1946 Car Builders’ Cyclopedia</i> , 17th ed. (“1946 Cyclopedia”)
1005	U.S. Patent No. 1,321,928 (“Lindström”)
1006	U.S. Patent No. 4,941,411 (“Wong”)
1007	<i>Excerpts from Lancashire & Yorkshire Wagons, Vol. II</i> , by Noel Coates, Copyright 2006 (“Coates”)
1008	U.S. Patent No. 992,192 (“Hart”)
1022	Declaration of Sylvia Hall-Ellis
1023	U.S. Patent No. 2,030,748 (“Gilpin”)
1025	Sotera Stipulation
1026	Presidential Executive Order, June 13, 2025
1027	U.S. Steel Press Release, June 18, 2025
1028	<i>Rebuilding U.S. Zinc Capacity in an Era of Global Competition Center for Strategic and International Studies</i> , by Grace Baskaran and Meredith Schwartz, Center for Strategic and International Studies, May 2025
1029	Made in America website, https://www.madeinamerica.gov/
1030	<i>CN purchases iron-ore cars, enhances U.S. Steel Partnership</i> , by Jeff Stagl, RailPrime Article, April 11, 2024
1031	Investor Relations Presentation, The Greenbrier Companies, August 2025
1032	Investor Day 2024 Presentation, Trinity Industries, June 25, 2024

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1033	Declaration of Michael Selapack
1034	Pagevault capture of Partnerships - Sustainability.ussteel.com - United States Steel, https://sustainability.ussteel.com/innovation/partnerships , captured September 9, 2025
1035	Pagevault capture of <i>Duluth, Missabe, and Iron Range Railway records</i> University of Minnesota Archival Finding Aids, https://archives.lib.umn.edu/repositories/22/resources/8318 , captured September 17, 2025
1036	<i>Publication of a Report on the Effect of Imports of Steel on the National Security: An Investigation Conducted Under Section 232 of the Trade Expansion Act of 1962, as Amended</i> , Department of Commerce, Bureau of Industry and Security, Federal Register, Vol. 85, No 129, July 6, 2020
1037	Excerpts from <i>Car Builders' Cyclopedia, 1957 (Twentieth)</i> Edition ("1957 Cyclopedia")
1038	Excerpts from <i>Car Builders' Cyclopedia, 1957 (Twenty First)</i> Edition ("1961 Cyclopedia")
1039	Excerpts from <i>Car and Locomotive Cyclopedia, 1966</i> Edition ("1966 Cyclopedia")
1040	Memorandum Order Granting Motion to Stay, <i>NEC Corporation v. Peloton Interactive, Inc.</i> , 1-22-cv-00987, Dkt. 210 (D. Del. Apr. 9, 2024)
1041	Oral Order Granting Motion to Stay, <i>The Nielsen Co. (US), LLC v. TVision Insights, Inc.</i> , 1-22-cv-01345 Dkt. 106 (D. Del. Apr. 1, 2024)
1042	Oral Order Granting Motion to Stay, <i>ImmerVision, Inc. v. Apple Inc.</i> , 1-21-cv-01484 Dkt. 159 (D. Del. Oct. 17, 2023)
1043	Oral Order Granting Motion to Stay, <i>GAN (UK) Ltd. v. MGM Resorts Int'l</i> , No. 1-22-cv-00361, Dkt. 88 (D. Del. Mar. 29, 2023)

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1044	Memorandum Order Granting Motion to Stay, <i>WSOU Investments, LLC d/b/a Brazos Licensing and Development v. Netgear, Inc.</i> , 1-21-cv-01117, Dkt. 97 (D. Del. Nov. 30, 2022)
1045	Oral Order Granting Motion to Stay, <i>Speyside Medical, LLC v. Medtronic CoreValve LLC</i> , 1-20-cv-00361, Dkt. 155 (D. Del. Sept. 30, 2021)
1046	Oral Order Granting Motion to Stay, <i>Midwest Energy Emissions Corp. v. Arthur J. Gallagher & Co.</i> , 1-19-cv-01334, Dkt. 253 (D. Del. Dec. 10, 2020)
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I. INTRODUCTION

Discretionary denial of the Petition is unwarranted for several reasons. First, *inter partes* review of the challenged '892 patent is necessary to correct an error by the Office during prosecution. The '892 patent is directed to a hopper car whose side walls are reinforced by a two-part stiffener with a lower, interior portion and an upper, exterior portion. The two parts have “web continuity”: they lie in the same vertical plane and overlap, such that a portion of the side wall lies between the bottom of the upper part and the top of the lower part.

During prosecution, the patent examiner allowed the claims because he believed the claimed two-part sidewall stiffener with web continuity was an improvement over the prior art. However, in granting the '892 patent, the patent examiner overlooked numerous prior-art hopper cars with the claimed sidewall stiffener. One of these references predates the '892 patent by a century. Another overlooked reference shows Patent Owner's own ore car from the 1940s, which Patent Owner never submitted to the Office. Correcting the Office's error in granting the '892 patent is an appropriate and worthwhile use of Board resources, notwithstanding any settled expectations Patent Owner may have.

The strong merits of the Petition also counsel against discretionary denial. The Petition does not merely show that the claimed stiffener design was present in

the prior art. The Petition demonstrates that, by the 1940s, the claimed stiffener had become the standard way to reinforce ore-car sidewalls. Thus, the Petition shows that the allegedly novel feature of the '892 patent was well known and widely used *sixty years* before 2009, when Patent Owner claims to have invented it. Moreover, because none of the references cited in the Petition were before the Office during prosecution, Patent Owner's reliance on § 325(d) is unavailing.

The country's strong national security and economic interests in the U.S. steel industry also counsel against discretionary denial. The Commerce Department and the President have both determined that a strong domestic steel industry is vital to the country's economy and national security. Petitioner FCA is one of only three American manufacturers of the ore cars that transport iron ore from U.S. mines to U.S. steel mills.¹ However, NSC has accused FCA's ore cars of infringing a patent that claims exclusive rights in hopper-car features that have been in the public domain for decades. Review of the '892 patent is necessary to ensure that FCA can continue to build the accused rail cars, and to reduce the U.S. steel industry's dependence on foreign-made ore cars.

¹ The other two U.S. manufacturers are TrinityRail and Greenbrier. Patent Owner NSC is not on this list because NSC is a Canadian company.

Finally, trial has been set for January 2027 in the related district-court litigation—approximately a month after the expected final written decision in December 2026. *Inter partes* review of the '892 patent therefore has the potential to conserve judicial resources. For all of these reasons, review of the '892 patent would be an appropriate and worthwhile use of the Board's resources. The Director should decline Patent Owner's request for discretionary denial.

II. INTER PARTES REVIEW OF THE '892 PATENT WOULD BE AN APPROPRIATE AND WORTHWHILE USE OF BOARD RESOURCES

A. IPR Is Necessary To Correct A Material Error By The Patent Examiner

1. The Office Granted The '892 Patent Because It Believed The Prior Art Lacked The Claimed Two-Part Sidewall Stiffener

The '892 patent² is directed to a railway hopper car whose side walls are reinforced with vertically oriented web stiffeners that have two portions: a lower portion on the exterior of the side wall and an upper portion on the interior of the side wall. Figure 1 shows the lower, exterior portion of the stiffener of one side wall; and the upper, interior portion of the stiffener of the other side wall.

² The '892 patent shares a common specification with U.S. Patent No. 8,132,515, which Petitioner has challenged in IPR2025-01047 and IPR2025-01048.

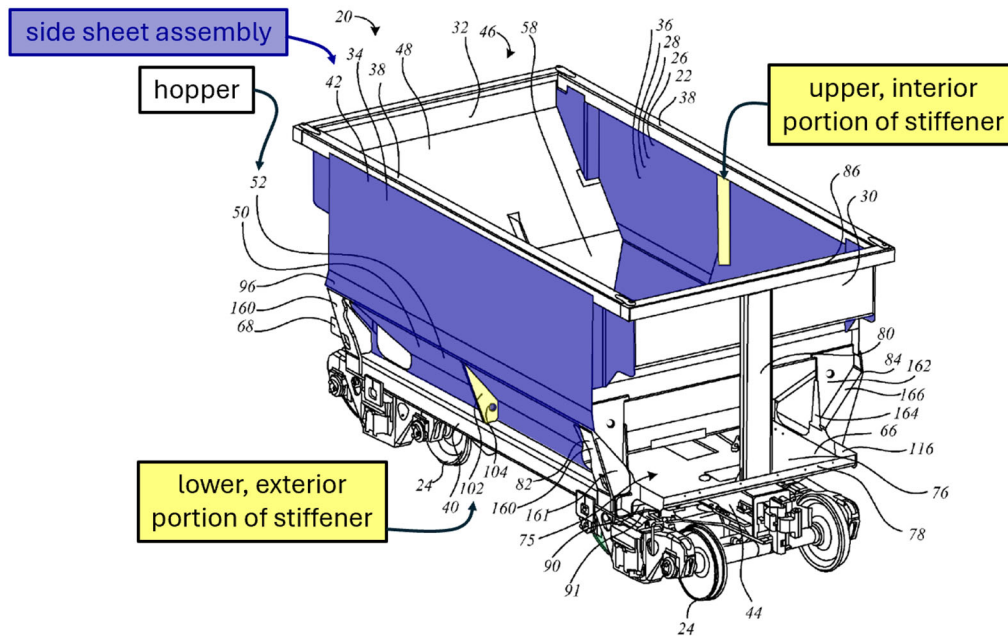
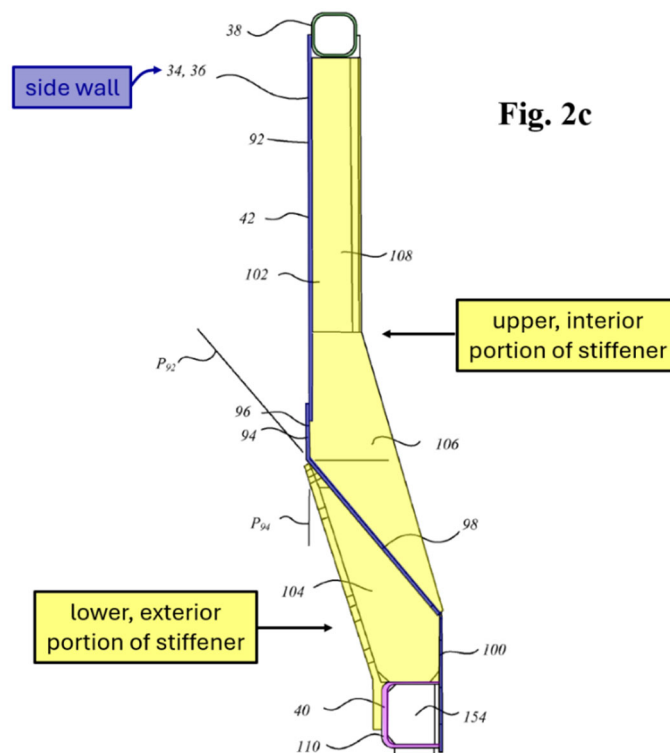


Figure 2c, an end view of one side wall, shows both parts of the sidewall stiffener 102. The two parts overlap and are aligned in a vertical plane in an arrangement the patent refers to as “web continuity.” *Id.* at 15:44–46.



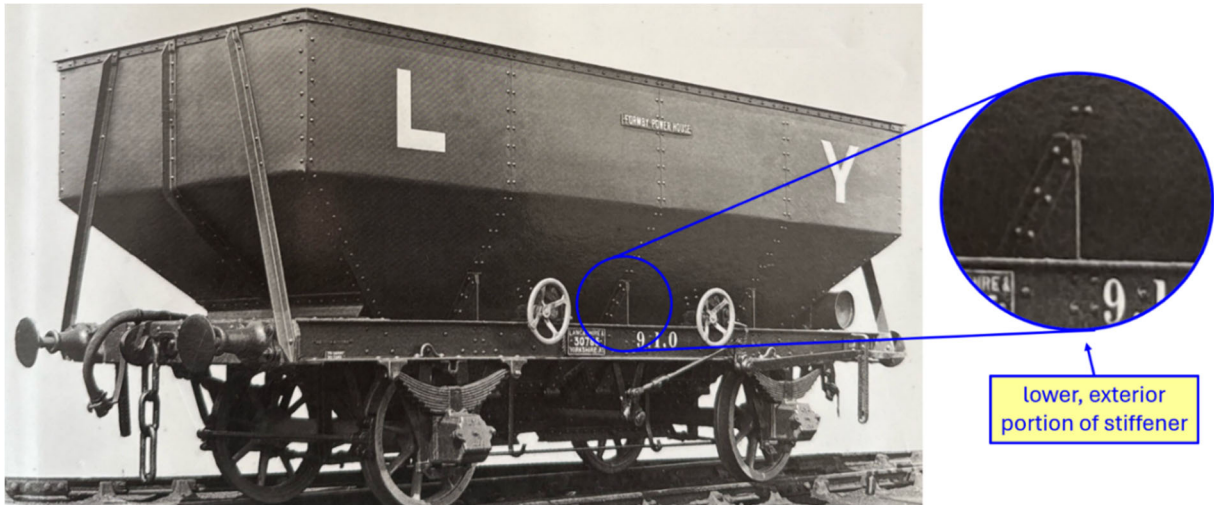
During prosecution, the patent examiner allowed the claims of the '892 patent because he believed the prior art did not disclose a side-wall stiffener with web continuity, *i.e.*, with interior and exterior portions aligned in a vertical plane. The examiner allowed the claims without ever rejecting them over the prior art. EX1002 at 400–407, 411–17. In his Reasons for Allowance, the Examiner stated:

The following is an examiner's statement of reasons for allowance: The sidewall stiffener having web continuity between the first and second portions along with the first portion of the sidewall stiffener being laterally outboard of the first region and the second portion of the sidewall stiffener being laterally inboard of the second region is seen as an unobvious improvement over the art of record.

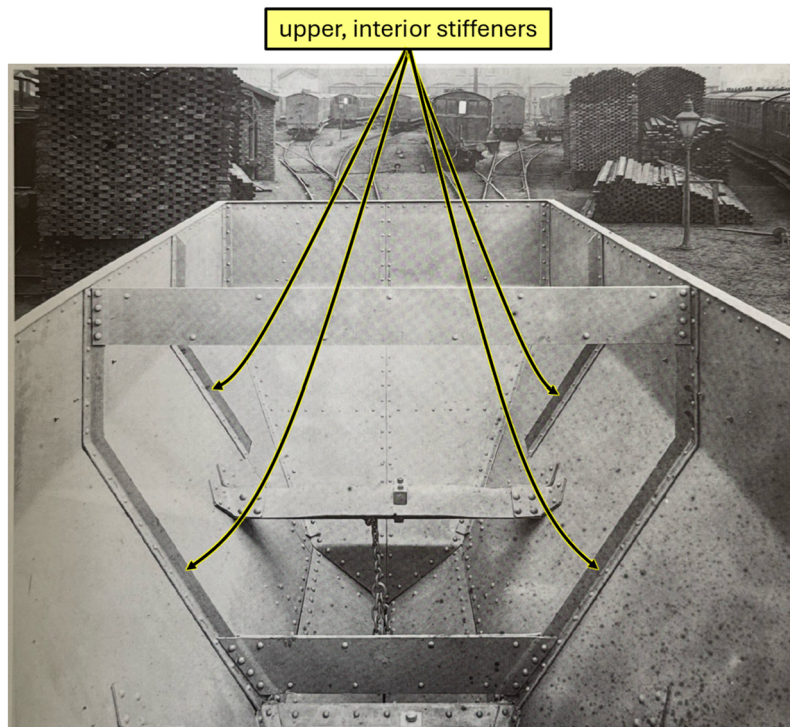
Id. at 416. All claims of the '892 patent require this sidewall stiffener.

2. The Examiner Erred By Overlooking Prior Art Hopper Cars With The Claimed Two-Part Sidewall Stiffener

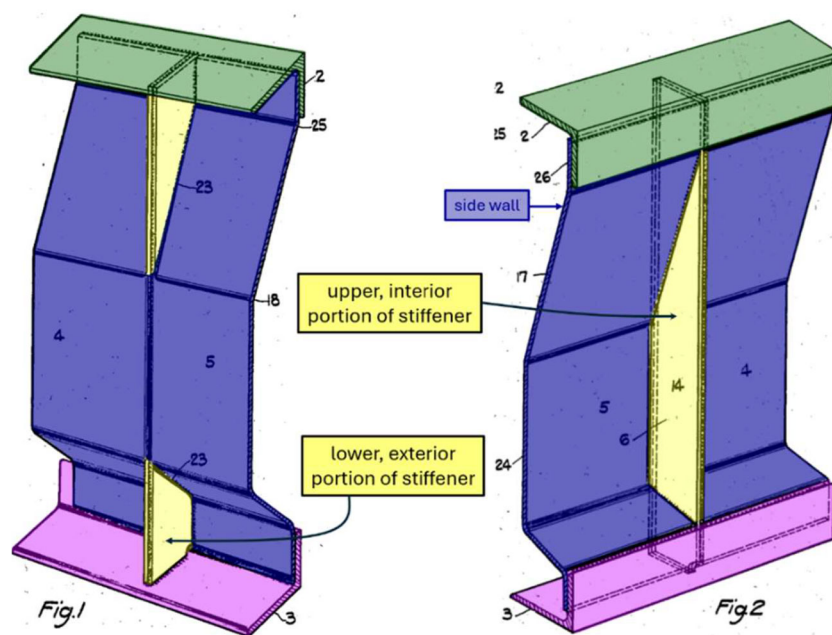
However, two-part sidewall stiffeners with web continuity were common in prior-art hopper cars. For example, Coates shows photos of a hopper car produced by the Lancashire & Yorkshire Company in 1904. EX1007 (Coates) at front cover (“L&Y Hopper Car”).



Each side wall of the L&Y Hopper Car comprised four panels. As shown above, the lower exterior of the side wall was reinforced by three triangular web stiffeners, one at each juncture of adjacent panels. And as seen below, the interior of the L&Y Hopper Car had stiffeners at these same junctures. *Id.* at 263. Thus, the L&Y Hopper Car had interior and exterior stiffeners aligned in a vertical plane.



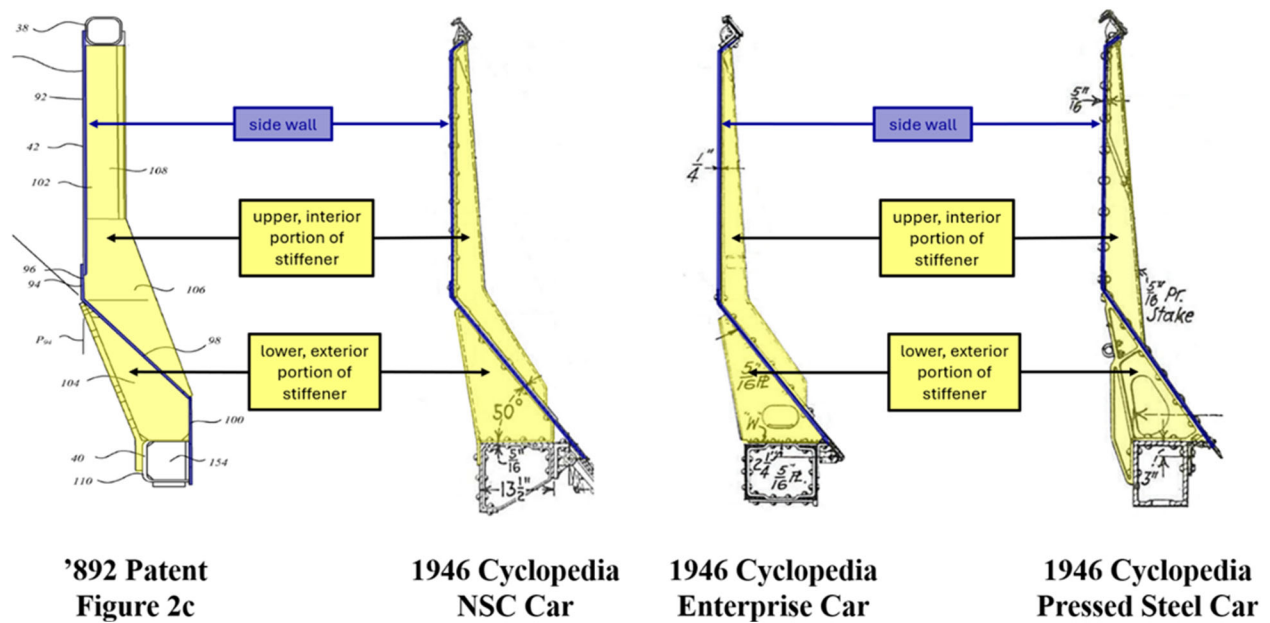
The stiffeners of the L&Y Hopper Car were riveted to the rail car's steel sidewalls with L-brackets. However, the rail industry quickly devised other methods of securing or providing such stiffeners. In 1936, Garth Gilpin received a patent on rail-car side walls with web stiffeners formed by bending the side edges of each side-wall panel. EX1023. Figures 1 and 2 of the Gilpin patent, shown below, show the exterior and interior, respectively, of Gilpin's side wall. As the figures demonstrate, Gilpin's stiffeners had exterior and interior portions arranged in the same vertical plane. *Id.* at Figs. 1–2.



Gilpin Patent

By the 1940s, two-part side-wall stiffeners with web continuity were standard in hopper cars used to transport iron ore. For example, three of the four schematics in the ore-car section of the 1946 Cyclopedia, a handbook for rail car manufacturers, disclose two-part side-wall stiffeners with web continuity. EX1004

at 290, 292, 294. Indeed, as shown below, the relevant portions of those schematics—the end views that show both the interior and exterior portions of the stiffener at once—are almost identical to Figure 2c of the '892 patent. *Id.* Thus, far from being novel, the side-wall stiffeners of the '892 patent had become commonplace over sixty years before the '892 patent application was filed in 2009.



EX1001 at Fig. 2c; EX1004 at 294 (NSC); 292 (Enterprise); 290 (Pressed Steel).

The Office can materially err “by overlooking something persuasive” in the prior art or “in evaluating such art.” *Advanced Bionics, LLC v. MED-EL*

Elektromedizinische Geräte GmbH, No. IPR2019-01469, Paper 6 at 10–11 (PTAB Feb. 13, 2020). In granting the '892 Patent, the examiner erred by overlooking prior art hopper cars having two-part sidewall stiffeners with web continuity. *See Crowdstrike, Inc. v. Gosecure, Inc.*, IPR2025-00070, Paper 28 at 17–18 (PTAB

Aug. 13, 2025) (finding the examiner erred by overlooking the teachings of the cited reference); *Motorola Mobility LLC v. Multifold Int'l Inc. Pte. Ltd.*, No. IPR2025-00040, Paper 10 at 31–34 (PTAB May 21, 2025) (“we conclude the Office erred by overlooking the disclosures of at least Yook”); *Apple Inc. v. Smith Interface Techs., LLC*, IPR2024-01084, Paper 7 at 29–31 (PTAB Jan. 28, 2025).

In *Apple*, the examiner relied on the absence of a specific limitation—limitation [1.j]—in allowing the claims. *Apple*, Paper 7 at 31. Figures 2 and 3 of the prior art Shiplacoff reference disclosed limitation [1.j], but the examiner overlooked it. *Id.* (“although Shiplacoff was cited in an IDS, the Examiner did not reject the claims over Shiplacoff”). The Board found that “the Examiner's reliance on limitation [1.j] as the reason for allowing claim 1 without addressing Figures 2 and 3 of Shiplacoff constitutes an error material to patentability.” *Id.*

Similarly here, the patent examiner specified that his reason for allowing the claims was the supposed novelty of the claimed two-part sidewall stiffener with web continuity. EX1002 at 416. Because the examiner overlooked both cited and uncited references which disclose that feature, the Office materially erred in granting the '892 patent. *See Apple*, Paper 7 at 31.

Patent Owner argues discretionary denial is appropriate because the '892 patent issued thirteen years ago, creating settled expectations that the patent would not be challenged. *See, e.g., Mot.* at 2. However, correcting a material error by the

Office is an appropriate and worthwhile use of Board resources, even where the Patent Owner argues it had settled expectations. *See Xencor, Inc. v. Merus N.V.*, IPR2025-00605, Paper 12 (PTAB July 17, 2025); *Anthony Inc. v. ControlTec LLC*, IPR2025-00559, Paper 12 (PTAB July 16, 2025); *Activision Blizzard, Inc. v. Milestone Entm't, LLC*, IPR2025-00708, Paper 13 (PTAB August 14, 2025); *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 (PTAB July 31, 2025).

Xencor and *Anthony* are particularly pertinent. One of the patents challenged in *Xencor* had “been in force for approximately nine years, creating strong settled expectations for Patent Owner.” *Xencor*, Paper 12 at 2. However, the patent examiner allowed the challenged claims because they did not teach or suggest a specific claim limitation, overlooking that the limitation was disclosed by another prior art reference (Lazar). *Id.* at 3. The Office concluded that “discretionary denial under 35 U.S.C. § 325(d) is not appropriate because the Office materially erred during prosecution of the challenged patent.” *Id.* at 2–3.

Similarly, the patents challenged in *Anthony* had been in force for approximately seventeen or eighteen years. *Anthony*, Paper 12 at 2. The Office nevertheless refused the patent owner’s request for discretionary denial because “the patent examiner erred by overlooking the teachings of” a prior art patent (Carter). *Id.*

Like the examiners in *Xencor* and *Anthony*, the examiner who allowed the '892 patent erred by overlooking the many prior art hopper cars that had two-part sidewall stiffeners with web continuity. He never discussed any of these references or any other prior art reference. Instead, he simply allowed the claims because he believed the claimed sidewall stiffener—a commonplace feature by the 1940s—was “an unobvious improvement” in 2009. Correcting the examiner’s material error in overlooking the most relevant prior art is an appropriate and worthwhile use of Board resources, notwithstanding any settled expectations the Patent Owner may have had. *See Xencor*, Paper 12; *Anthony*, Paper 12; *Activision*, Paper 13; *Skullcandy*, Paper 9.

3. Patent Owner Incorrectly Argues The Examiner Did Not Overlook Prior Art With The Claimed Stiffener

Patent Owner repeatedly argues that the examiner did not overlook prior art references disclosing the claimed sidewall stiffener, but considered and discounted those references. For example, Patent Owner argues that “the Petition relies on asserted art *previously considered by the Office during prosecution*.” Mot. at 5. Patent Owner’s assertion is simply wrong—none of the references in the Petition were before the Office. For example, the Petition relies on two primary references: the 1919 Lindström patent and the 1946 Cyclopedia’s disclosure of the NSC ore car. Neither one was before the Office during prosecution of the '892 patent.

That the Office had no publication showing Patent Owner’s 1940s-era ore car is troubling. As the Petition demonstrates, NSC’s ore-car design indisputably possesses each element of claim 1 of the ’892 patent, including the claimed two-part sidewall stiffener with web continuity. Pet. at 19–33 (showing the 1946 Cyclopedia’s disclosure of the NSC ore car anticipates claim 1). Patent Owner could have submitted the 1946 Cyclopedia or some other publication showing its ore car, but it did not. Patent Owner never explains why it failed to disclose its own ore car to the Office. Nor does Patent Owner explain why it remained silent about its ore car even after the examiner expressed his belief that the application’s claims were patentable because the claimed sidewall stiffener was a “nonobvious improvement” over the prior art.

Implicitly recognizing that Lindström and the NSC ore car were not before the Office, Patent Owner argues that “Petitioner’s asserted art is also cumulative to what has already been considered by the Examiner during prosecution.” Mot at. 3. In support, Patent Owner points to excerpts of various Cyclopedias that it submitted to the Office during prosecution. *Id.* at 46–64. These excerpts show a number of ore cars, including two that Patent Owner emphasizes: the Enterprise ore car and the Pressed Steel ore car. *Id.* at 57–64. Patent Owner cites its expert to argue that these rail cars had “the exact same design features” as the NSC ore car and the Lindström patent. *Id.* (quote at page 58).

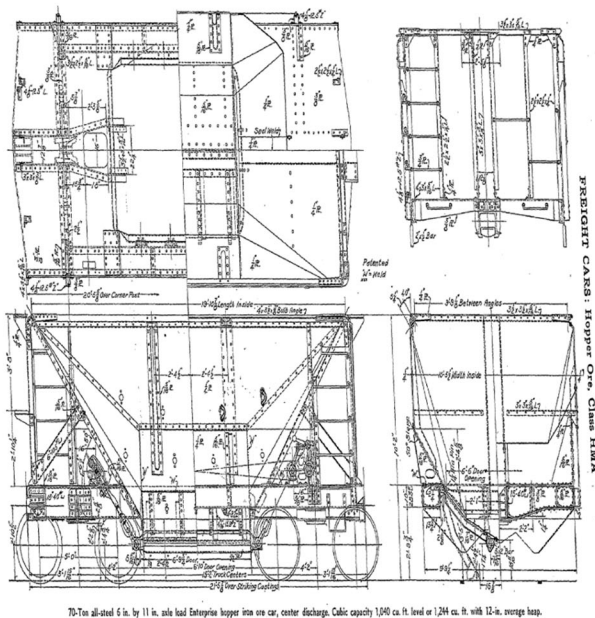
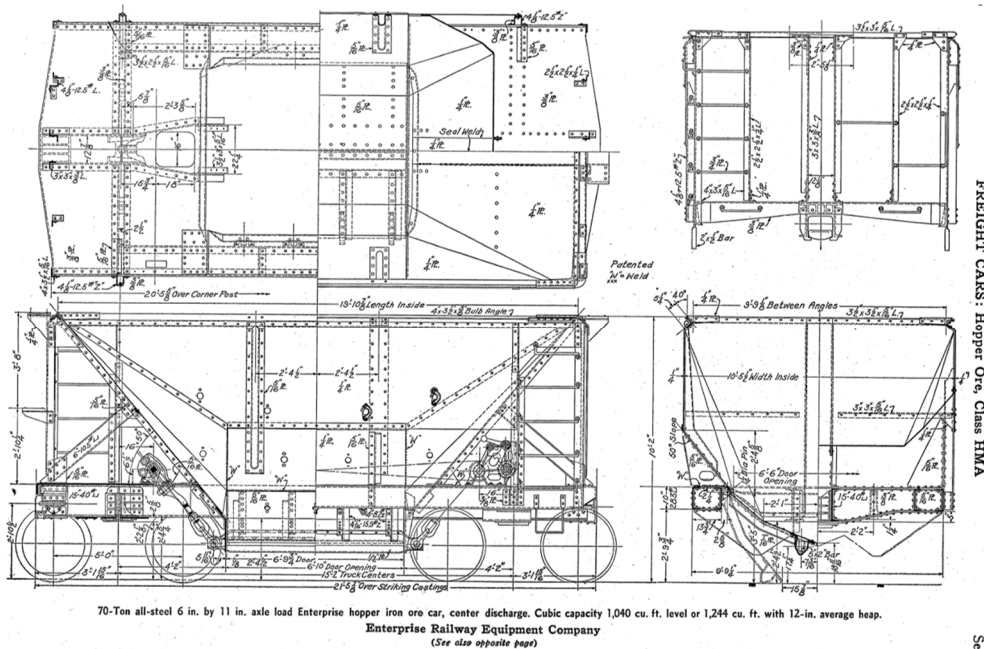
Patent Owner is correct that the Enterprise ore car, Pressed Steel ore car, NSC ore car and Lindström patent all show the same two-piece sidewall stiffener with web continuity. The Petition itself established this beyond reasonable dispute. Pet. at 14 (juxtaposing images of the NSC car, the Enterprise car, the Pressed Steel car, and Fig. 2c of the '892 patent); 69 (juxtaposing images of Lindström and the NSC car); 92 (juxtaposing images of Lindström and Fig. 2c of the '892 patent). The prevalence of the claimed sidewall stiffener comes as no surprise. By the 1940s, this type of stiffener was the most common method of reinforcing an ore car's side walls. Pet. at 13–14 (showing that three of four ore-car schematics in the 1946 Cyclopedia had the claimed stiffener).

However, the presence of the Enterprise and Pressed Steel cars in an IDS does not undermine the conclusion that the examiner erred. A patent examiner may err “in evaluating the art” or by “misapprehending or overlooking specific teachings of the relevant prior art.” *Advanced Bionics*, Paper 6 at 8, 8 n.9. Misapprehending or overlooking a material reference is error even where the reference was before the Office during prosecution. *See Xencor*, Paper 12 (concluding the examiner erred by overlooking a cited reference, and referring the petition to the Board); *Crowdstrike*, Paper 28 at 17–18 (finding the examiner erred by overlooking a reference that was before the Office); *Motorola Mobility*, Paper 10 at *31–34 (ruling the examiner erred in overlooking the disclosures of the cited

Yook reference); *Apple*, Paper 7 at 29–31 (finding the examiner erred by overlooking figures of a cited reference and combinations of that reference with uncited art); *Google LLC v. Dialect*, No. IPR2024-00752, Paper 11, at 39 (P.T.A.B. Oct. 23, 2024) (“the Examiner erred in overlooking specific teachings of [two cited references] when allowing the ’652 patent to issue”).

Here, the Petition explains in detail how claim 1 of the ’892 patent is anticipated by the Lindström patent and by the 1946 Cyclopedia’s disclosure of the NSC ore car. Pet. at 19–33 (NSC car), 86–98 (Lindström). In allowing the claims of the ’892 patent, the patent examiner overlooked these uncited prior art references as well as the cited references that disclose the Enterprise and Pressed Steel cars with the same two-part sidewall stiffeners. This was a material error by the Office that should be corrected. See *Xencor*, Paper 12; *Anthony*, Paper 12 at 2; *Crowdstrike*, Paper 28 at 17–18; *Motorola Mobility*, Paper 10 at 31–34; *Apple*, Paper 7 at 29–31; *Google*, Paper 11 at 14–15.

The examiner’s error in overlooking the Enterprise and Pressed Steel cars was understandable, as Patent Owner submitted compressed and distorted versions of the diagrams of these cars. For example, below are the diagrams of the Enterprise car as they appear in the 1961 edition of the Cyclopedia juxtaposed with the distorted version submitted by Patent Owner with its IDS.



Enterprise Car As It Appears In
 The 1961 Cyclopedia

Distorted Version In Patent
 Owner's PTO Submission

EX1038 (1961 Cyclopedia) at 246; Ex. 1002 (file history) at 368. Every schematic from a Cyclopedia that Patent Owner submitted to the office was distorted in this same manner, making them difficult to read. Compare, e.g., EX1037 (1957 Cyclopedia) at 266; EX1038 (1961 Cyclopedia) at 246; EX1039 (1966 Cyclopedia) at 194; with EX1002 at 362, 368, 382.

Patent Owner contends that Petitioner has not shown error by the Office because the Petition “fails to take into consideration any single challenged claim as a whole” and “provides no motivation to attempt, much less make, the sweeping, wholesale changes to the asserted art references...” Mot. at 66. On the contrary, the Petition addresses claim 1 “as a whole” by showing that the claim is anticipated by both the NSC ore car and the Lindström patent. Pet. at 19–33 (NSC car), 86–98 (Lindström). The Petition therefore established a material error by the Office during prosecution. *See Motorola Mobility*, Paper 10 at 31–34 (finding error where the petition “demonstrated a reasonable likelihood that at least claim 1 of the ’756 patent is unpatentable as anticipated by Yook,” but the “Examiner did not cite or reference [Yook] in any office action, interview summary, or notice”).

Finally, Patent Owner criticizes the sidewall stiffeners of the 1904 L&Y Hopper Car because their upper, inside portions were attached to the sidewall using rivets and a perpendicular flange, in the manner of an L-bracket. Mot. at 67–68. Patent Owner’s criticisms are misplaced for two reasons.

First, nothing in the claims (or the examiner’s reasons for allowance) specifies how the sidewall stiffener must be attached to the sidewall. The stiffeners in the 1904 L&Y Hopper Car therefore embody the *claimed* stiffeners that the examiner believed was an improvement in 2009.

Second, Patent Owner raises the L&Y Hopper Car to argue that, rather than overlooking the prior art, the examiner considered and discounted it because its sidewall stiffeners had the form of L-brackets. Mot. at 69. This argument is flawed because the sidewall stiffeners in most of the overlooked prior art—*e.g.*, Lindström, the NSC ore car, the Enterprise car, and the Pressed Steel car—do not have the form of a L-bracket. Patent Owner never argues otherwise. Thus, even if the L&Y Hopper Car’s sidewall stiffeners were somehow outside the scope of the claims, the examiner still would have erred by overlooking the teachings of the other references that disclose the claimed stiffener.

In view of the Office’s material error during prosecution of the ’892 patent, the Office should refuse Patent Owner’s request for discretionary denial. *See Xencor*, IPR2025-00605, Paper 12; *Anthony*, IPR2025-00559, Paper 12; *Activision Blizzard*, IPR2025-00708, Paper 13; *Skullcandy*, IPR2025-00690, Paper 9.

B. The Petition’s Strong Merits Support Institution

Discretionary denial is also unwarranted because the Petition presents a particularly strong case of obviousness. The Petition shows that by the 1940s, it had become common to reinforce hopper-car side walls with the claimed stiffeners, so much so that three of the four schematics in the ore-car section of the 1946 Cyclopedia show this feature. Pet. at 13–14; *see supra* § II(A)(2).

The Petition is also strong because claim 1 is anticipated by ***both*** of the Petition’s primary references—Lindström and the 1946 Cyclopedia’s disclosure of the NSC ore car. Pet. at 19–33 (NSC car), 86–98 (Lindström). The Petition also shows that the allegedly novel feature of the challenged claims had been used a century before the ’892 patent, in the 1904 L&Y Hopper Car and the 1919 Lindström patent.

In addition, the Petition shows that the remaining features recited in the challenged claims are basic freight-car features that had become standard features decades before Patent Owner filed its patent application. For over a century, features such as draft sills, strikers, shear plates and bolsters have figured in hopper-car patents and have been defined in railcar dictionaries. *See, e.g.*, Pet. at 40–47. Thus, the Petition not only demonstrates that the ’515 patent would have been obvious in 2009—it demonstrates that the patent would have been obvious decades earlier. The Petition therefore presents a particularly strong case of obviousness.

The obviousness issues raised in the Petition are well-suited for resolution in *inter partes* review. The ’892 patent involves a simple mechanical device embodying century-old technology. The challenged claims merely collect standard railcar features, utilizing them in the claimed hopper car just as they were used in

the prior art. The patent and prior art will therefore be readily understood by the Board without the need to lean heavily on expert testimony.

Patent Owner faults the references in the Petition for being “ancient.” Mot. at 27, 28. But the age of the Petition’s references does not disqualify them as prior art. On the contrary, the large number of very old references showing the allegedly novel feature of the ’892 patent highlights the gravity of the examiner’s mistake. The age of the prior art also underscores the unfairness of allowing Patent Owner to have exclusive rights in a set of railcar features that long ago passed into the public domain. This is a petition that should be considered on its merits.

C. Review of the ’892 Patent Is Important to Critical Economic And National-Security Interests In The American Steel Industry

Inter partes review of the ’515 patent would serve important U.S. economic and national-security interests because Petitioner is one of just three domestic producers of the freight cars that transport iron ore for the U.S. steel industry. Allowing an invalid patent to impede Petitioner’s ability to produce freight cars would impair the already-fragile domestic supply chain of the American steel industry, an industry that is vital to the country’s economy and national defense.

In a report on the domestic steel industry, the Commerce Department made formal findings that (i) “steel is important to U.S. national security”; (ii) “steel is required for U.S. critical infrastructure”; and (iii) “domestic steel production is essential for national security applications.” EX1036, Fed. Reg., Vol. 85, No. 129

at 40209–10 (capitalization altered). The report explained that the “U.S. Department of Defense (DoD) has a large and ongoing need for a range of steel products that are used in fabricating weapons and related systems for the nation’s defense,” and that steel is important to “chemical production, communications, dams, energy, food production, nuclear reactors, transportation systems, water, and waste water systems.” *Id.* Recently, demand for steel has been “precipitously rising” due to the needs of the nuclear, energy and automotive industries. EX1028 at 4. Steel is also critical to the power transmission and energy infrastructure needed to supply power to the nation’s new artificial-intelligence data centers. *Id.*

“[A]cross decades and Administrations, there has been consensus that domestic steel production is vital to national security.” EX1036 at 40210. Most recently, President Trump issued an executive order on June 13, 2025, that placed restrictions on Nippon Steel’s proposed purchase of U.S. Steel. EX1026. There the President determined that an unrestricted acquisition by Nippon Steel would threaten to impair the national security of the United States. *Id.* at 2.

Domestic steel-production capabilities are critical to the nation’s ability to respond to an unexpected military conflict or national emergency:

In fact, it is the ability to quickly shift production capacity used for commercial products to defense and critical infrastructure production that provides the United States a surge capability that is vital to national

security, especially in an unexpected or extended conflict or national emergency.

EX1036 at 40225. Foreign imports of steel threaten not only steel producers, but also the supply chain that supports those producers:

The continued rising levels of imports of foreign steel threaten to impair the national security by placing the U.S. steel industry at substantial risk of displacing the basic oxygen furnace and other steelmaking capacity, and *the related supply chain needed to produce steel for critical infrastructure and national defense.*

Id. at 40224 (emphasis added).

Petitioner is an important part of the domestic supply chain supporting the U.S. steel industry. Iron ore mined in the U.S. is transported from the mines in gondola-type freight cars, typically open-top hopper cars. EX1033, ¶ 2. However, as shown below, the only three U.S. producers of such freight cars are Petitioner, Oregon-based Greenbrier, and Texas-based TrinityRail.

In an August 2025 investor presentation on the Greenbrier website, the company lists the four competitors in the gondola-car market and the open-top-hopper-car market: Greenbrier (ticker symbol GBX), Petitioner (ticker symbol RAIL), TrinityRail (ticker symbol TRN) and Patent Owner (NSC):

Description	GBX	RAIL	TRN	NSC	UTLX
Auto Rack	●		●		
Boxcar	●	●	●		
Refrigerated	●		●		
Flatcar	●		●	●	
Covered Hopper	●		●	●	
Gondola	●	●	●	●	
Intermodal	●		●	●	
Open-Top Hopper	●	●	●	●	
Tank Car	●		●		●

● Primary Position ● Secondary Position

One of four

EX1031 at 7. A 2024 TrinityRail investor presentation identifies the same four companies in a chart listing freight car manufacturers. EX1032 at 11. However, only three of these are U.S. companies, as Patent Owner is a Canadian company.

The FCA hopper cars at issue in the parties’ district court case were manufactured to carry iron ore on the Duluth, Missabe and Iron Range Railway (DMIR). EX1033 ¶ 3. This iron ore is mined domestically, in Minnesota, and then transported on FCA-manufactured hopper cars to docks in Michigan, where it is shipped to mills operated by U.S. Steel. *Id.*; EX1034 (U.S. Steel website describing a partnership with FCA and CN that will “step up shipments of iron ore throughout northern Minnesota’s Iron Range”); EX1035 (University of Minnesota Duluth Archives) (describing the DMIR). Thus, Petitioner’s hopper cars are an important part of the domestic supply chain that produces American iron ore for the U.S. steel industry. Indeed, as the Greenbrier investor presentation

acknowledges, Petitioner occupies the “primary position” among the four North American producers of open-top hopper cars. EX1031 at 7.

A foreign company should not be allowed to leverage a U.S. patent—especially one that claims rights in century-old technology and that only issued because of an examiner mistake—to interfere with the efforts of U.S. companies to supply American iron ore to the U.S. steel industry. The country’s vital economic and national-security interests in a strong domestic steel industry militate in favor of *inter partes* review and against Patent Owner’s request for discretionary denial.

D. Patent Owner Incorrectly Argues That The *Fintiv* Factors Support Discretionary Denial

Patent Owner argues that the *Fintiv* factors support discretionary denial. Mot. at 15–27. On the contrary, those factors favor institution or are neutral.

Fintiv Factor 1 addresses whether the related district-court litigation will be stayed. Here, the district court will likely grant a stay if the requested IPRs are instituted. And because the Petitions address all claims of all asserted patents, the stay would be very effective in conserving judicial resources.

A review of the district court’s cases with co-pending IPRs since 2020 shows that, when an IPR was instituted, Judge Burke granted a stay in all but one contested case. *NEC Corp. v. Peloton Interactive, Inc.*, No. 1-22-cv-00987 (D. Del. Apr. 9, 2024) (EX1040); *The Nielsen Co. (US), LLC v. TVision Insights, Inc.*, No. 1-22-cv-01345 (D. Del. Apr. 1, 2024) (EX1041); *ImmerVision, Inc. v. Apple Inc.*,

No. 1-21-cv-01484 (D. Del. Oct. 17, 2023) (EX1042); *GAN (UK) Ltd. v. MGM Resorts Int’l*, No. 1-22-cv-00361 (D. Del. Mar. 29, 2023) (EX1043); *WSOU Invs., LLC d/b/a Brazos Licensing & Dev. v. Netgear, Inc.*, No. 1-21-cv-01117 (D. Del. Nov. 30, 2022) (EX1044); *Speyside Med., LLC v. Medtronic CoreValve LLC*, No. 1-20-cv-00361 (D. Del. Sept. 30, 2021) (EX1045); *Midwest Energy Emissions Corp. v. Arthur J. Gallagher & Co.*, No. 1-19-cv-01334 (D. Del. Dec. 10, 2020) (EX1046); *VLSI Tech. LLC v. Intel Corp.*, No. 1-18-cv-00966 (D. Del. May 8, 2020) (stay granted as to patents at issue in the IPR) (EX1047).

In the one case where Judge Burke declined to order a stay, he found a stay would not have significantly simplified the case because the defendant made “strategic choices” to file IPR petitions on a subset of the asserted patents. *Tonal Systems, Inc. v. iFIT Inc.*, No. 1-20-cv-01197 (D. Del. Feb. 9, 2023) (EX1048). Here, Petitioner has requested review of both patents asserted in district court and will seek a stay as soon as the IPRs are instituted. This factor favors institution.

Fintiv Factors 2 and *6* address the proximity of trial and the resources spent preparing for it. Trial is set for January 11, 2027. Because the Petition is strong and final written decisions are due before trial, allowing the IPR to proceed will eliminate the need for trial and conserve judicial resources. Moreover, because the district court is likely to stay the case shortly after the IPRs are instituted, a stay would preserve months of judicial resources. These factors favor institution.

Fintiv Factor 3 addresses the investment in the district court case. This has been relatively small so far. The district court has not held a claim construction hearing, and the parties have not begun taking depositions or conducting expert discovery. The investment to date is far less than the savings a stay would provide, particularly if the patent is invalidated in a final written decision. This factor does not favor discretionary denial.

Fintiv Factor 4 addresses the overlap of issues between the IPR and the district court litigation. Institution of *inter partes* review would avoid the presentation at trial of issues better decided by the Board. For example, as noted above, institution of an IPR would result in a stay of the district court case, preventing any overlap. Even without a stay, the IPR proceeding would conclude before trial, triggering IPR estoppel for those issues addressable in an IPR. In *Tanklogix v. Sitepro*, IPR2025-00650–653, Paper 10 at 2 (PTAB July 31, 2025), this factor weighed in favor of institution when trial was scheduled a mere 10 days after the due date for a final written decision in the related IPR. Moreover, in the unlikely event IPR estoppel does not apply because, *e.g.*, the trial is continued, Petitioner’s *Sotera* stipulation would eliminate any risk of relitigating IPR issues in district court.

Patent Owner cites *Ingenico* and *SAP America* to argue that Petitioner’s *Sotera* stipulation is insufficient to avoid an overlap of issues. Mot. at 20–23.

These cases do not support Patent Owner’s position. Petitioner’s *Sotera* stipulation is standard in mirroring IPR estoppel, extending broadly to every ground that ***could have been raised*** in the IPR. A stipulation of this scope was determined to weigh strongly in favor of institution in the precedential *Sotera* case itself. *Sotera Wireless v. Masimo*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (Precedential as to § IIA). To the extent the documentary evidence supports non-IPR theories like on-sale bar or public use, those theories would involve presentation of significant additional evidence—beyond the act of publication—and are better suited for resolution in district court.

Patent Owner cites *Samsung Electronics* to argue that Petitioner’s *Sotera* stipulation would allow it to make “more expansive” invalidity arguments based on physical systems that embody designs in the IPR prior art. Mot. at 23–25.

However, if the IPR petitions are instituted but ultimately unsuccessful, Petitioner’s only primary references in district court would be its own prior art systems: four Bethlehem Steel rail cars produced between 1954 and 1965.

Petitioner will rely on its unpublished engineering drawings to show the structure of the car and on other documents from its internal files to show the cars were sold, in public use and publicly known. As Patent Owner acknowledges, the Bethlehem Steel cars are never even mentioned in Petitioner’s IPR petitions. Mot. at 24.

Patent Owner attempts to show an overlap of issues by pointing to a chart of prior art systems in Petitioner’s invalidity contentions. Mot. at 24. However, four railcars in the chart are Petitioner’s own Bethlehem Steel cars, and no reference in the Petition shows any of those cars. Most of the remaining railcars in the chart are relevant to Petitioner’s contentions concerning the U.S. Patent No. 8,132,515, the other patent asserted in the district court case. For example, a dozen references in the chart show open machinery spaces, the allegedly novel feature of the ’515 patent’s claims. Thus, the chart does not indicate that Petitioner intends to rely on these references to make invalidity arguments concerning the ’892 patent.

In any event, as stated above, Petitioner’s primary references in district court will not include any reference in the Petition or any physical system that has the same design as a reference in the Petition. Patent Owner’s professed concern—that Petitioner will rehash its IPR arguments in district court—is unfounded. Because there is no risk of an overlap of invalidity theories, *Fintiv* Factor 4 weighs against discretionary denial.

Fintiv Factor 5 addresses overlap between the parties. This factor does not weigh in favor of denial. Because the parties are the same, the combination of estoppel and Petitioner’s *Sotera* stipulation eliminates the risk that the same invalidity theories will be raised in the IPR and in district court.

E. Patent Owner's Reliance On § 325(d) Is Misplaced

Patent Owner argues that the Petition should be denied under § 325(d). Mot. at 45–69. However, § 325(d) “reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8–9 (PTAB Feb. 13, 2020) (precedential). Neither the 1946 Cyclopedia’s disclosure of the NSC ore car nor Lindström—the two primary references in the Petition—were before the Office during prosecution of the ’892 patent. Indeed, **none** of the references cited in the Petition were before the Office, and the patent examiner did not analyze any of the references that were of record. The file history therefore includes ***no evaluation of the evidence of record*** that could be accorded deference. Accordingly, discretionary denial under § 325(d) is unwarranted.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) identified six factors that bear on discretionary denial under § 325(d) (“BD Factors”). These factors were grouped into a two-part framework in *Advanced Bionics*:

(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and

(2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics at 8. BD Factors (a), (b), and (d) are subsumed within Part (1), BD Factors (c), (e), and (f) within Part (2).

The first part of the *Advanced Bionics* analysis considers whether the art or arguments raised in the Petition were presented during prosecution. As none of the art or arguments are the same, *Advanced Bionics* Part 1 strongly favors institution.

Advanced Bionics Part 2 considers whether the Office erred in a manner material to patentability. As discussed in Section II(A) above, the patent examiner materially erred by overlooking the many prior art references disclosing two-part sidewall stiffeners with web continuity. Accordingly, Part 2 of the *Advanced Bionics* analysis also weighs against discretionary denial. *See Oticon Medical AB et al. v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 19 (PTAB Oct. 16, 2019); *Adobe v. RAH Color Techs.*, IPR2019-00627, Paper 41 at 20 (PTAB Sept. 10, 2019) (“The Examiner did not consider any of these new arguments and evidence presented in the Petition. Thus, we consider these facts to also weigh heavily against denying institution.”).

The Director’s and the Board’s recent decisions show that, where a § 325(d) analysis reveals a material error by the Office, Board resources are properly used to correct it. *See Xencor*, Paper 12 (finding that overlooking prior art was a

material error under § 325(d), and refusing to discretionarily deny a petition challenging a nine-year-old patent); *Anthony*, Paper (finding that overlooking an uncited reference was error under § 325(d), and refusing to discretionarily deny a petition challenging an 18-year-old patent); *Alliance Laundry Systems v. Payrange*, IPR2025-00573, Paper 11 at 2 (PTAB July 17, 2025) and Paper 7 at 9–27 (July 7, 2025) (denial under § 325(d) was inappropriate where the examiner overlooked cited and uncited references); *Apple v. Smith Interface*, Paper 7 at 29–31 (denial under § 325(d) was unwarranted where the examiner overlooked figures in cited art and combinations of cited and uncited art).

F. The Petition Satisfies 35 U.S.C. § 312(a)(3)

Patent Owner argues that the Petition is weak and fails to satisfy 35 U.S.C. § 312(a)(3). Mot. at 27–45. As explained in § II(B) above, however, the merits of the Petition are strong. Moreover, Patent Owner’s specific criticisms of the Petition are baseless.

1. The Petition’s Grounds Are Not Voluminous Or Excessive

Patent Owner argues that the Petition’s grounds are “voluminous or excessive.” Mot. at 30. But the Petition’s length is dictated by the length of the ’892 patent’s claims. Each independent claim recites a long list of standard railcar features such as draft sills, strikers, shear plates and bolsters. As a result, the claim language alone runs a full 1,533 words—almost a tenth of an IPR petition’s

14,000-word limit. The Petition provides two invalidity grounds for each claim.

This is not excessive, especially given the abundance of art from the last century.

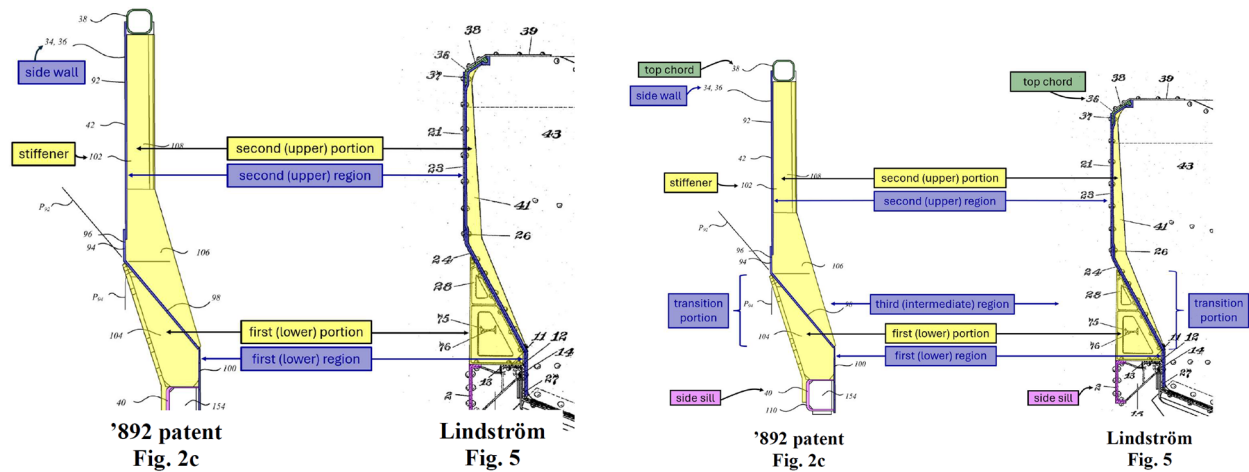
2. The Petition Specifies Where The Claimed Elements Are Located

Patent Owner also argues that the Petition lacks particularity, has “underdeveloped arguments,” requires the Board to “guess” at Petitioner’s case, and fails to specify where the claimed elements are located in the prior art. Mot. at 31–35. These arguments ignore the detailed, annotated images, illustrations, and figures in the Petition that identify claim elements.

For example, Patent Owner argues that the labeling in the Petition is confusing because sidewall stiffeners are sometimes included in the blue-colored sidewall, and sometimes labeled or colored differently (*e.g.*, with yellow). Mot. at 33–36. However, the ’892 patent explains that the stiffener is part of the sidewall. EX1001 col. 15:21–24 (“sidewall 34 or 36 also includes a central post, or web stiffener, 102”). Thus, where the Petition refers to the side wall as a whole, it reasonably colors the entire side wall blue.

In another example, Patent Owner argues that the Petition is “silent” regarding sidewall stiffeners being “positioned in vertical-transverse planes,” a limitation of claim 15. Mot. at 37. A vertical transverse plane is a vertical plane that is transverse to the longitudinal axis of the rail car, *i.e.*, transverse to the railroad tracks. EX1001 at 11:60–65. Each figure on pages 115 and 116 of the

Petition is a sectional view looking along the car, *i.e.*, a sectional view taken along a vertical-transverse plane of the car:



Pet. at 115–116. As shown above, the '892 patent uses the same sectional view to illustrate this structure.

Patent Owner argues that the Petition conflates two different NSC car designs and “ignores that the schematics [Figure 2,670] and the picture [Figure 2,673] are two distinct pieces of prior art.” Mot. at 32–33. Not so. The schematics in Figure 2,670 and the photo in Figure 2,673 show the same ore car. This is apparent from the figures and confirmed by the fact the figures cross-reference each other. As shown below, the schematics in Figure 2,670 on page 294 has a caption stating “*See also Fig. 2,673,*” and the photograph on page 295 states “*See also page 294.*” EX1004 at 27, 28 (annotations added in red).

Fig. 2,670—Plan, elevation and sections of Canadian Pacific 50-Ton center discharge ore car.
Builder, National Steel Car Corporation, Ltd.
Series 114,100-114,349
(See also Fig. 2,673)

Fig. 2,673—Canadian National 50-ton center discharge ore car for use at Steep Rock mining operations. Built by National Steel Car Corporation, Ltd.
Light weight, 40,600 lb.; load limit, 128,400 lb.; capacity, 825 cu. ft.; length inside, 19 ft. 8 in.
(See also page 294)

3. The Petition Cross-References Appropriately

Patent Owner argues that the Petition’s internal cross-referencing is improper and shows its arguments are “cumulative and redundant.” Mot. at 38. On the contrary, Patent Owner’s lengthy claims recite the same features multiple times, often using verbatim language. Any redundancy in the Petition is due to the redundancy of the claims. Where a limitation appears in multiple claims, it would be redundant to repeatedly show where the same limitation is found in the same prior art. Patent Owner therefore has it backwards. The Petition’s cross-references do not create redundancy—they *avoid* redundancy.

Patent Owner criticizes the cross-reference in the Petition’s analysis of limitation [1j], which requires web continuity. Mot. at 38. But there the Petition merely cross-references earlier portions of the Petition that had previously shown, using annotated schematics, that the NSC car has web continuity. Pet. at 98. The cross-reference is unremarkable: “the 1946 Cyclopedia’s NSC ore car drawings

disclose two part side-wall stiffeners with web continuity, as discussed above. *See supra*, at §§ IV.A.1.j, IV.B.2, and IV.B.3.” *Id.* Patent Owner’s criticisms of the Petition’s straightforward cross-references are without merit.

4. The Petition’s Grounds Are Complete

Patent Owner further argues that “the grounds are incomplete” because the Petition does not reiterate the analysis of independent claims in connection with each dependent claim. Mot. at 39–40 (citing dependent claim 15). But no petition regurgitates the analysis of the independent claim for every dependent claim. This would only force the Board to repeatedly read the same text. The Board will readily understand that the analysis of an independent claim applies to its dependent claims.

5. The Petition’s Citations To The Expert Report Are Not Ambiguous

Patent Owner asserts that the Petition’s citations to Dr. Ahmadian’s expert report are ambiguous, in particular EX1003, ¶¶ 52, 55–57, and 88–89. Mot. at 40–41. Due to a typographic error, the Petition’s citations to those paragraphs are off by one digit. They should refer to the immediately preceding paragraph (*e.g.*, citations to ¶ 52 should be to ¶ 51). This typo does not create the significant ambiguity argued by Patent Owner.

G. Patent Owner’s Remaining Arguments For Discretionary Denial Are Meritless

Patent Owner’s lengthy memorandum contains a number of additional arguments for discretionary denial. None have merit.

For example, Patent Owner argues that its settled expectations were “even stronger and more settled” because the parties had previously executed a settlement agreement that required the parties to talk “prior to initiating litigation.” Mot. at 13. On the contrary, because the settlement agreement expressly contemplates future disputes, Patent Owner was well aware that its patents might be challenged in future litigation.³ In any event, *inter partes* review of the ’892 patent is warranted to correct the Office’s error during prosecution, even if Patent Owner had settled expectations that its patent would not be challenged. *See Xencor*, Paper 12; *Anthony*, Paper 12; *Activision*, Paper 13; *Skullcandy*, Paper 9.

In an attempt to cast Petitioner in an unfavorable light, Patent Owner suggests that Petitioner is a willful infringer because its employees saw Patent

³ Oddly, Patent Owner accuses Petitioner of breaching the parties’ settlement agreement. Mot. at 13. But Patent Owner is the party guilty of “initiating litigation” without saying a word to Petitioner, let alone complying with the agreement’s requirement that the parties “consult and negotiate” for at least 45 days before filing a lawsuit. EX2027 at ¶ 21.

Owner’s rail cars marked with the words “U.S. AND OTHER PATENTS PENDING.” Mot. at 7–8. But this general phrase does not identify any specific patent or even the patent owner. This vague marking did not notify anyone of any particular patent rights.

Patent Owner also asserts that the Petition never states that the Office “made any mistake in granting the ’892 Patent.” Mot. at 14. But the Petition described the examiner’s mistake in great detail, even if it never used the word “mistake.” Pet. at 10–14. Moreover, whether the Office made an error pertains to discretionary denial, not the merits of the Petition. The PTAB’s guidelines state: “A petitioner should raise any discretionary issues in its opposition to a patent owner’s discretionary denial brief The petition should not address discretionary issues.”⁴ Patent Owner cites no authority for its position that, in addition to showing the unpatentability of the ’892 patent’s 15 claims in view of the prior art, the Petition also should have addressed the issues raised in Patent Owner’s 73-page brief on discretionary denial.

⁴ "U.S. Patent & Trademark Office, *Interim Director Discretionary Denial Process*", <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (accessed Aug. 26, 2025).

Finally, Patent Owner argues that the Petition “over-relies” on expert testimony. Mot. at 41–45. Patent Owner first points to the length of Dr. Ahmadian’s declaration and the number of times it is cited. Mot. at 41–42. But Dr. Ahmadian’s declaration is useful for interpreting the very old technical drawings of the prior art, which are governed by conventions that are no longer commonly used. EX1003, ¶¶ 41–46. Dr. Ahmadian also explains the reasons and motivations to combine the prior art. For example, he explained that a skilled artisan in 2009 would have wanted to modify and modernize the 1946 Cyclopedia’s NSC ore car to add a door-opening mechanism like Lindstrom’s, including the door actuator. *Id.* ¶ 59–60. According to the Office’s guidance, these are proper uses of expert testimony in an IPR petition.⁵

Patent Owner relies on *Xerox* and *Wowza*. Mot. at 42. But in those cases the Board did not fault the petitioner for relying on a declaration—the declaration was problematic because it failed to resolve a deficiency in the petition. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15–17 (PTAB Aug. 24, 2022); *Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 12 (PTAB Apr. 8, 2013).

⁵ PTAB Consolidated Trial Practice Guide November 2019, pp. 34–36.

Patent Owner also points to language and figures that appear in both the Petition and the Ahmadian declaration. Mot. at 43–44. But this merely shows that Dr. Ahmadian agrees with, provided, or confirmed the analysis in the Petition. Patent Owner has no basis for its claim that Dr. Ahmadian’s declaration is improper.

III. CONCLUSION

For the reasons set forth in the Petition and herein, *inter partes* review of the ’892 patent would be an appropriate use of Board resources. Petitioner respectfully requests that the Director deny Patent Owner’s motion for discretionary denial.

Dated: September 18, 2025

By: / Philip M. Nelson /

Philip M. Nelson (Reg. No. 62,676)

Ted M. Cannon (Reg. No. 55,036)

Justin Gillett (Reg. No. 71,099)

KNOBBE MARTENS OLSON & BEAR, LLP

Attorneys for Petitioner
FreightCar America, Inc.

CERTIFICATE OF COMPLIANCE

The undersigned certifies that the foregoing PETITIONER’S OPPOSITION TO PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL contains 7,665 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 14,000-word type-volume limit specified by the Memorandum Form Acting Director Stewart, *Interim Processes for PTAB Workload Management* (March 26, 2025).

Dated: September 18, 2025 By: / Philip M. Nelson /

Philip Nelson (Reg. No. 62,676)
Ted M. Cannon (Reg. No. 55,036)
Justin Gillett (Reg. No. 71,099)
KNOBBE MARTENS OLSON & BEAR, LLP

Attorneys for Petitioner
FreightCar America, Inc.

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Patent Owner, a true and correct copy of PETITIONER’S OPPOSITION TO PATENT OWNER’S MOTION FOR DISCRETIONARY DENIAL is being served electronically on September 18, 2025, to the e-mail addresses shown below:

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