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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 REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

I. INTRODUCTION

Petitioner FreightCar America submits this reply to correct three misstatements in the POPR. First, Patent owner wrongly accuses Petitioner of fabricating "computer-generated vector graphics" to cure a "deficiency" in the prior-art 1946 Cyclopedia. POPR at 20–21. In fact, the supposedly fabricated graphics in the Petition and supporting expert declaration are present in the prior art book itself. The discrepancy between these documents and EX1004, which contains excerpts of the 1946 Cyclopedia, is due to a clerical error in which the resolution of EX1004 was inadvertently reduced. Petitioner has filed a motion to correct EX1004 under 37 CFR § 42.104(c). Second, Patent Owner incorrectly asserts that the Petition erroneously treats a schematic and a photograph in the Cyclopedia as the same design. *Id.* at 17–18. But this is not an error. The figures containing the photograph and the schematic expressly cross-reference one another. Finally, Patent Owner argues that Petitioner's expert declaration is deficient because it ignores claim elements. *Id.* at 19–20. This argument conflicts with the Office's guidance that expert declarations need not address claim elements the Board can readily identify in the prior art without expert assistance.

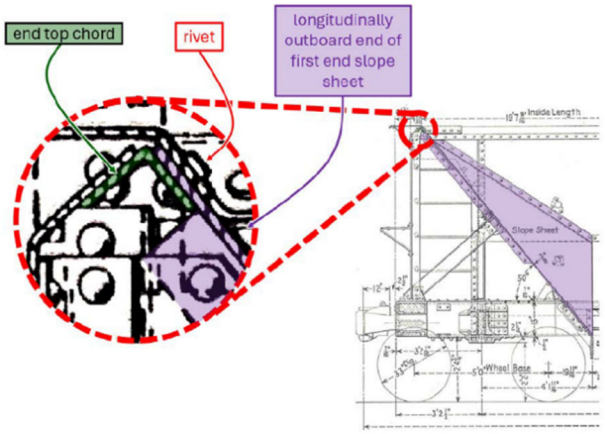
II. PETITIONER PROVIDED ACCURATE EVIDENCE OF THE PRIOR ART 1946 CYCLOPEDIA

The Petition relies on the 1946 Cyclopedia, a 1444-page book containing photographs and technical drawings of rail cars from the 1940s. Patent Owner

claims Petitioner created "computer-generated vector graphics" because EX1004, which contains excerpts of this book, does not contain certain graphical details shown in the Petition and supporting declaration. POPR at 20–21. However, these details were not "generated" by Petitioner with a computer or otherwise—they are in the 1946 Cyclopedia itself. The detail views in the Petition and declaration are accurate reproductions of the book's contents. The discrepancy with EX1004 is due to a clerical error in which the resolution of that exhibit was inadvertently reduced when it was prepared for filing. EX1051; EX1052. Petitioner has moved for leave to file a corrected version of EX10004 under 37 CFR § 42.104(c).

Petitioner filed EX1004 with the petition on May 27, 2025. Rather than promptly raising its concerns with Petitioner or the Board, Patent Owner waited until it filed its POPR on September 18, 2025, to raise the issue. Once Petitioner learned Patent Owner had accused it of fabricating evidence, it promptly informed Patent Owner that it would seek leave to correct EX1004 and file this reply.

Patent Owner argues the Board should deny institution because some claim elements are not visible in the (uncorrected) EX1004. However, even if Petitioner is not permitted to correct EX1004, the Petition would be adequately supported by the declaration of Dr. Ahmadian, which contains accurate images from the 1946 Cyclopedia. For example, the image shown here from Dr. Ahmadian's declaration contains the graphical detail present in the actual prior art book.



EX1003 at 44 (¶56). Thus, the Petition is supported by adequate evidence of the disclosure of the 1946 Cyclopedia, even if EX1004 is not corrected.

III. PETITIONER CORRECTLY USED A PHOTOGRAPH AND A SCHEMATIC DIAGRAM TO ILLUSTRATE THE SAME DESIGN

Patent Owner argues that the Petition improperly conflates a schematic drawing of an NSC ore car with a photograph of a different ore car with a different design. POPR at 17–18. But the 1946 Cyclopedia presents the schematic and the photograph as the same design by captioning each with an express cross-reference to the other. EX1004 at 27–28. Figure 2,670 on page 294 contains the schematics and references the photograph on page 295 with the caption "*See also Fig.* 2,673." *Id.* at 27. Figure 2,673 in turn references the schematics of Figure 2,670 with the caption "*See also page* 294." *Id.* at 28. These captions are shown below.

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)

Id. (annotations added in red). This is a pattern repeated throughout the 1946 Cyclopedia. *See, e.g.*, *id.* at 13–14 (showing cross-referenced figures containing a photo and schematics of a Norfolk & Western 55-ton hopper car).

That Figures 2,670 and 2,673 show the same design is confirmed by the railcar numbers in the schematics and photograph. Figure 2,670 indicates that the schematics shown in the figure were used to manufacture "Series 114,100-114,349"—250 railcars for Canadian National (CN) with those serial numbers. *Id.* at 27. The railcar in the photograph in Figure 2,673 is one of those 250 railcars:

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)

Id. at 28 (annotation added in red). Thus, it is beyond reasonable dispute that Figures 2,670 and 2,673 show the same railcar design.

IV. PETITIONER'S EXPERT DECLARATION PROVIDES SUFFICIENT DETAIL, CONSISTENT WITH PTAB PRACTICE AND GUIDANCE

Patent Owner argues that Dr. Ahmadian reaches the ultimate conclusion of obviousness without considering every claim element, such as the claimed sidewalls of limitation 1[b]. POPR at 19–20. Based on this incorrect assumption,

Patent Owner argues that Dr. Ahmadian did not consider the differences between the prior art and the challenged claims "as a whole." *Id.* But Dr. Ahmadian did consider the claims as a whole. EX1003 ¶¶17, 24. And he did not ignore the sidewalls of limitation [1b]—his declaration labels them in seven different figures when addressing limitations [1d]–[1e]. *Id*. ¶¶ 49–50.

Patent Owner argues that Dr. Ahmadian ignored limitations because his declaration does not contain sections devoted to those limitations.[1] But he was not required to devote entire sections to limitations plainly present in the prior art, such as hopper side walls. The Office has explained that experts need not discuss claim elements that technically educated Board judges will readily recognize. *See* PTAB Consolidated Trial Practice Guide (Nov. 2019) at 34–36. Dr. Ahmadian explained the conventions that apply to very old prior-art railcar schematics. EX1003, ¶¶ 54–59. He also identified claim elements that might not be immediately apparent to the Board and explained the reasons and motivations to combine prior art. All of this is proper expert testimony. Patent Owner's criticisms of Dr. Ahmadian are inconsistent with the Office's policies and guidance and should be disregarded.

[1] Patent Owner elsewhere argues, inconsistently, that the Petition should be denied because it relies too heavily on expert testimony. Paper 8 at 41–45.

Dated: October 8, 2025 By: / Philip M. Nelson /

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE is being served on October 8, 2025, via email on counsel of record for Patent Owner at the address below:

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