

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)

PATENT OWNER'S PRELIMINARY SUR-REPLY

On behalf of National Steel Car Limited
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TABLE OF AUTHORITIES

Statutes

35 U.S.C. § 2532

Regulations

37 C.F.R. § 42.104(b).....1, 3
37 C.F.R. § 42.107(e).....1, 2

I. Introduction

Patent Owner National Steel Car Limited (“Patent Owner”) submits this sur-reply to address one new issue and three arguments raised for the first time in Petitioner FreightCar America Inc.’s (“Petitioner”) Reply (Paper 18).

First, Patent Owner has filed a disclaimer of claim 1 of the ’892 Patent. Accordingly, no *inter parties* review (IPR) may be instituted as to claim 1 pursuant to 37 C.F.R. § 42.107(e).

Second, Petitioner seeks to replace Exhibit 1004 with a new version containing additional detail absent from the originally filed exhibit. Contrary to Petitioner’s characterization of this as a clerical error (Paper 17), the proposed substitution introduces substantive changes that prejudice both the Board and Patent Owner, as detailed in Patent Owner’s concurrently filed Opposition to Petitioner’s motion.

Third, the Petition fails to establish that the schematic and photograph, depicting two distinct rail cars, represent the same design or embodiment, nor does it provide any rationale for combining the two. As a result, the Petition lacks clarity regarding the asserted grounds for review and fails to satisfy the requirements of 37 C.F.R. § 42.104(b).

Finally, Petitioner’s expert declaration is deficient. It overlooks the majority of claim elements in its obviousness analysis and offers motivations to combine that

fail to account for those claim elements. These shortcomings, compounded by the declaration's near-verbatim repetition of the Petition, render it unpersuasive and deserving of little or no weight.

II. Claim 1 of the '892 Patent is Disclaimed

Petitioner asserts that claim 1 of the '892 Patent is anticipated or obvious. Patent Owner has filed a statutory disclaimer under 35 U.S.C. § 253 disclaiming claim 1 (Exhibit 2046). Pursuant to 37 C.F.R. § 42.107(e), IPR cannot be instituted with respect to claim 1.

III. Petitioner's Arguments Rely on Material Absent from the Record Version of Exhibit 1004

There is no dispute that the filed version of the 1946 Cyclopedia (Exhibit 1004) lacks the high-resolution detail relied upon by Petitioner and Dr. Ahmadian in the Petition and expert report. This additional detail constitutes attorney and expert argument, not evidence.¹ As the Board has held, expert testimony may explain patents and printed publications, but cannot substitute for disclosure in the prior art

¹ Contrary to Petitioner's assertion, Patent Owner did not accuse Petitioner of fabricating evidence. Rather, Patent Owner stated that Petitioner and Dr. Ahmadian offered their interpretation of the evidence, appropriately characterized as attorney and expert argument. *See* Paper 10 at 20.

itself. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (August 24, 2022) (designated: February 10, 2023) (denying institution – holding declaration is entitled to little weight when it contains an exact restatement of the petition’s unsupported, conclusory assertions without any additional supporting evidence or reasoning).

Because both parties agree that Exhibit 1004 does not contain the referenced detail, the interpretations offered by Dr. Ahmadian and Petitioner are unsupported and should be disregarded. Petitioner’s attempt to replace Exhibit 1004 with a version containing new detail is not a clerical correction, but a substantive change that prejudices Patent Owner and the Board. For the reasons stated in Patent Owner’s Opposition, that motion to substitute should be denied.

IV. Petitioner Fails to Link Schematic and Photograph as the Same Design

The Petition fails to establish that the schematic and photograph depicting rail cars for “Canadian National” and “Canadian Pacific,” respectively, represent the same design or embodiment. Nor does it offer any expert evidence or rationale for combining the two. Petitioner’s reliance on “*see also*” notations is insufficient to support such a conclusion.

Absent a clear link or reason to combine, the Petition fails to meet the requirements of 37 C.F.R. § 42.104(b). Petitioner’s attempt to reframe its argument

in reply amounts to a last-minute do-over and should be rejected. The Petition is flawed, and trial should not be instituted.

V. Petitioner’s Expert Declaration Fails to Address Key Claim Elements

Dr. Ahmadian’s declaration is deficient because it fails to analyze the majority of claim elements in the ’892 Patent when assessing obviousness. Petitioner cites only the “Applicable Legal Standards” section (Exhibit 1003 at 5) to suggest that Dr. Ahmadian considered the claims “as a whole,” but this is insufficient.

The declaration lacks the necessary reasoning and analysis regarding how modifications to the prior art relate to the claim limitations. These deficiencies combined with the declaration’s parroting of the Petition undermine its credibility. The Board should afford the declaration little, if any, weight.

VI. Conclusion

For the foregoing reasons, institution should be denied.

Respectfully Submitted,

Date: October 17, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY SUR-REPLY** was served electronically in its entirety on the date noted below via electronic mail to the following attorneys of record:

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Respectfully Submitted,

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