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Subject: Activity in Case 1:24-cv-00594-JLH-CJB National Steel Car Limited v. FreightCar America, Inc. et al Order on Motion to Stay
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U.S. District Court

District of Delaware

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Case Name: National Steel Car Limited v. FreightCar America, Inc. et al

Case Number: [1:24-cv-00594-JLH-CJB](#)

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ORAL ORDER: The Court, having reviewed Defendants' motion to stay pending *inter partes* review ("IPR") ("Motion"), (D.I. [183]), the briefing related thereto, (D.I. [184]; D.I. [189]; D.I. [190]), and having considered the three stay-related factors, see *Contour IP Holding, LLC v. GoPro, Inc.*, Civil Action No. 15-1108-LPS-CJB, 2016 WL 4474340, at *2 (D. Del. July 14, 2016), hereby ORDERS that the Motion is DENIED for the reasons that follow: (1) The simplification factor is a little unusual here. Typically, in a situation like this—i.e., where there are two patents-in-suit, and the Patent Trial and Appeal Board ("PTAB") has instituted IPR on all asserted claims of both such patents, this factor would squarely favor a stay. That is because there would seem to be at least a decent chance of all (or most) asserted claims being ultimately invalidated at the PTAB, and because of all of the other potential opportunities whereby the Court could learn from or benefit from the PTAB's review of Defendants' validity challenges. (D.I. [184] at 1-2) But here, we have a rare situation where in granting review of the claims of one of the two patents (the 515 patent), the PTAB seemed to go out of its way to communicate that aside from one asserted claim (claim 24, a claim that Plaintiff has now disclaimed, along with dependent claims 25-31, (D.I. [186])), the PTAB did *not* think there was a reasonable likelihood that the remainder of the patent's claims would ultimately be found invalid. (See D.I. [189] at 1 (citing D.I. [185], ex. 2 at 25, 28-29, 32)) So based on what the PTAB seems to have intimated, it currently appears likely that after the

IPRs conclude: (a) the 515 patent's remaining asserted claims will emerge unscathed, (D.I. [189] at 2); and (b) some or all claims of the other asserted patent (the 892 patent) may be found invalid. If one asserted patent's claims are invalidated after a stay but the other asserted patent's claims are not, that outcome would provide for lesser efficiency gains than are optimal. *Cf. Smart Mobile Techs. LLC v. Samsung Elecs. Co.*, 6:21-CV-00701-ADA, 2023 WL 11999028, at *5 (W.D. Tex. Oct. 24, 2023); *USC IP P'ship, L.P. v. Facebook, Inc.*, 6-20-CV-00555-ADA, 2021 WL 6201200, at *2 (W.D. Tex. Aug. 5, 2021) (“[T]he PTAB specifically noted in its institution decisions that it cannot say that the merits [of Facebook’s IPR petitions] are particularly strong.... Thus, Facebook has not shown that the PTAB is likely to invalidate all asserted claims.”) (internal quotation marks and citation omitted). Plus, as Plaintiff notes (and as Defendants don’t really seriously dispute), the simplification factor here may be a bit more diluted than usual, since such a large percentage of the prior art arguments at issue in this case will revolve around system art, which Defendants will not be estopped from raising at trial, despite the existence of the IPR proceedings. (D.I. [189] at 2-3; D.I. [190] at 2 n.2) In light of this, the Court finds this factor to be about neutral. *Cf. NEC Corp. v. Peloton Interactive, Inc.*, Civil Action No. 22-987-CJB, D.I. 210 at 1-3 (D. Del. Apr. 9, 2024) (finding the simplification factor to “favor [the movant’s] position a bit” where, *inter alia*, only two of the three asserted patents were in IPR, but where the non-instituted patent was deeply related to an asserted patent in the IPR proceedings, and where there was no indication from the PTAB that any claims at issue were unlikely to be found invalid).; (2) With regard to the status of the case factor, it is true, as Defendants note, (D.I. [184] at 2-3), that as of the time of the Motion’s filing, fact depositions and expert discovery (and all that comes after), were still ahead of the parties. But it is also true that at that same time, a motion to dismiss had been resolved, document discovery was nearly complete, a *Markman* hearing had been held, claim construction decisions had issued, and the Court had either resolved a number of other disputes, or had then pending before it certain disputes that would have been expected to soon be resolved (and were in fact resolved thereafter). (D.I. [38]; D.I. [45]; D.I. [49]; D.I. [170]-72; D.I. [218]; D.I. [223]-24) When you weigh the work that is still ahead against all of the work the Court and the parties have already put into the case, this factor is also just about neutral (and if it were to slightly favor any party, that would be Plaintiff, not Defendants). *Cf. NEC Corp.*, D.I. [210] at 3-4 (finding this factor to be about neutral, where document discovery was nearly complete and the Court had done significant work in the case, but no *Markman* decisions were issued); *Tonal Systems, Inc. v. iFIT Inc.*, Civil Action No. 20-1197-GBW-CJB, D.I. 188 (D. Del. Feb. 9, 2023) (finding this factor to slightly favor the movant, where the case was near the close of fact discovery, but where no *Markman* decision had yet issued).; (3) As to the undue prejudice factor, normally, the fact that the parties are direct competitors in what is asserted to be a small (railcar manufacturing) market would weigh squarely in favor of no stay. But here, Defendants assert that there was only one occasion in which the accused products were sold and that they have no plans to sell any such products in the future. (D.I. [184] at 3) Plaintiff counters that there may have been some conveyed sales that occurred thereafter (though it is not clear to the Court

whether those sales are at issue in this case). (D.I. [189] at 4-5) None of the other arguments the parties make as to the timing of this Motion, Defendants' filing of the IPRs, or Plaintiff's diligence in seeking discovery in the case move the needle on this factor. (See D.I. [184] at 3; D.I. [189] at 4-5; D.I. [190] at 2) In the end, this factor might slightly work against a stay, as there is perhaps some chance that alleged infringement could occur during a stay that might hurt Plaintiff as a direct competitor in ways that are difficult to remedy with money. But that chance seems much less pronounced than it might normally be, and so the factor is close to being neutral too. *Cf. Knauf Insulation, LLC v. Johns Manville Corp.*, Case No. 1:15-cv-00111-TWP-MJD, 2020 WL 4261814, at *12 (S.D. Ind. July 24, 2020); *TDY Indus. Inc. v. Ingersoll Cutting Tool Co.*, Civil Action No. 10-790, 2010 WL 3950789, at *1 (W.D. Pa. Oct. 7, 2010).; (4) Adding it all up, each of the stay factors are about neutral, and if they favor anybody, it is Plaintiff, who opposes a stay. In sum, this is a case where: (a) the PTAB has given a strong hint that the asserted claims of at least one of two patents-in-suit will go forward in the future in district court; (b) the Court and the parties have invested substantial time already in litigating this case; and (c) the parties are (or have been) direct competitors. As a result, we should keep this case moving forward.; and (5) In light of the Court's ruling, Plaintiff's motion for leave to file a sur-reply brief in opposition to the motion, (D.I. [203]), is DENIED as MOOT. Ordered by Judge Christopher J. Burke on 03/17/2026. (sam)

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