

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

IPR2025-01047

Patent 8,132,515

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

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1001	U.S. Patent No. 8,132,515 (“the ’515 patent”)
1002	File History of the ’515 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”)
1009	Excerpts from <i>The Car Builders’ Dictionary, 1906 Edition</i> (“1906 Cyclopedia”)
1010	Excerpts from <i>Car Builders’ Dictionary, 1912 (Seventh) Edition</i> (“1912 Cyclopedia”)
1011	Excerpts from <i>Car Builders’ Cyclopedia of American Practice</i> , Tenth Edition—1922 (“1922 Cyclopedia”)
1012	U.S. Patent No. 1,537,051 (“Campbell ’051”)
1013	U.S. Patent No. 1,999,652 (“Campbell ’652”)
1014	U.S. Patent No. 3,710,729 (“Schuller”)
1015	U.S. Patent No. 4,348,962 (“Smith”)
1016	Excerpts from <i>COAL CARS: The First Three Hundred Years</i> , by Martin Robert Karig III, Copyright 2007 (“Karig”)
1017	Excerpts from <i>Modern Private Owner Wagons on British Rail</i> , by David Ratcliffe, Copyright 1989 (“Ratcliffe 1”)

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1018	Excerpts from <i>Private-Owner Wagons in Colour, For the Modeller and Historian</i> , by David Ratcliffe, Copyright 2009 (“Ratcliffe 2”)
1019	Excerpts from <i>Wagons of the Final Years of the British Railways</i> , By David Larkin, Copyright 2008 (“Larkin 1”)
1020	Excerpts from <i>Working Wagons</i> , Vol. 3 1980–1984, by David Larkin, Copyright 2001 (“Larkin 2”)
1021	Excerpts from <i>Wagon Recognition</i> , Vol. 1 Carkinds – B to W, by Martin Buck and Mark Rawlinson (“Buck”)
1022	Declaration of Sylvia Hall-Ellis
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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
1033	Declaration of Michael Selapack
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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
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)
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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)
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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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1047	Oral Order Granting Motion to Stay, <i>VLSI Tech. LLC v. Intel Corp.</i> , 1-18-cv-00966, Dkt. 615 (D. Del. May 8, 2020)
1048	Oral Order Denying Motion to Stay, <i>Tonal Systems, Inc. v. iFIT Inc.</i> , 1-20-cv-01197, Dkt. 188(D. Del. Feb. 9, 2023)

I. INTRODUCTION

Discretionary denial of this Petition is unwarranted for several reasons. First, *inter partes* review of the challenged '515 patent is necessary to correct an error by the Office during prosecution. The '515 patent is directed to a hopper car whose angled hopper walls, or “slope sheets,” are supported by reinforcement beams extending along the undersides of the sheets. The beams obviate the need to use other support structures under the slope sheets, such as support plates or struts, which would obstruct the “machinery space” under the slope sheet.

During prosecution, Patent Owner distinguished prior art cited by the patent examiner because, while the rejected claims required “an unobstructed machinery space,” the slope sheet of the prior-art car was supported by plates that “rather obstruct the machinery space in question.” Patent Owner’s argument succeeded in overcoming the examiner’s rejection. However, in granting the '515 patent, the patent examiner overlooked numerous prior-art hopper cars that supported their slope sheets with reinforcement beams, leaving the machinery space completely unobstructed. Some of these references predate the '515 patent by a century. Correcting this error 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 cites *ten* references showing cars with reinforcement beams and open

machinery spaces, four of which predate 1915. Thus, the Petition shows that the allegedly novel feature of the '515 patent was well known a century before the patent issued. The Petition also shows that the other features recited in the claims of the '515 patent had become standard hopper-car features decades before Patent Owner filed its application. Even the few modern features recited in the challenged claims—such as pneumatic door openers for the hopper doors—predated the '515 patent by *forty years*. The Petition is strong because it shows the challenged claims would have been obvious not just in 2009, when the Patent Owner filed its patent application—they would have been obvious decades earlier. 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

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.

of infringing a patent that claims exclusive rights in hopper-car features that have been in the public domain for decades. Review of the '515 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.

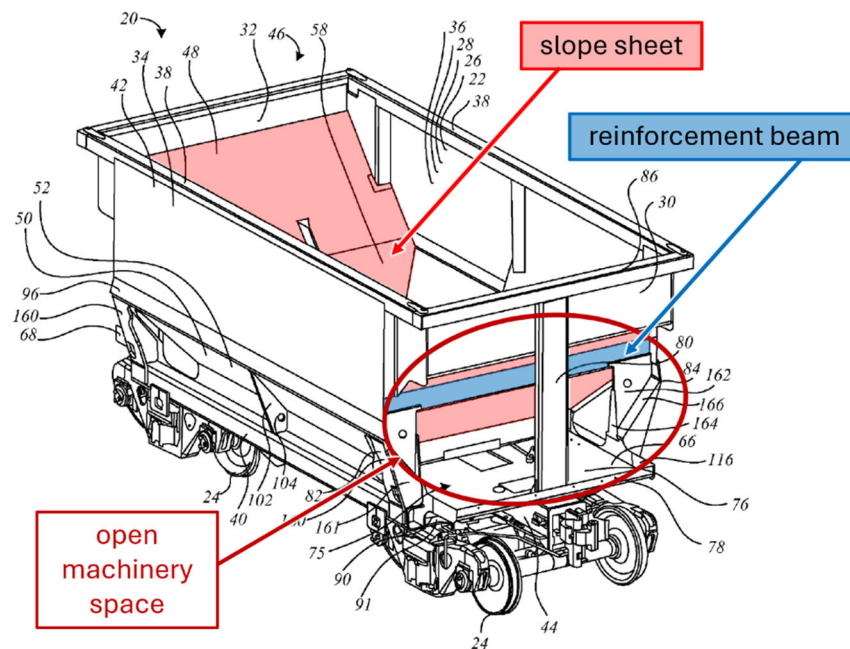
Finally, trial has been set for January 2027 in the related district-court litigation—approximately a month after the expected final written decision in December 2026. *Inter partes* review of the '515 patent would therefore have the potential to conserve judicial resources. For all of these reasons, review of the '515 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 '515 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. Patent Owner Overcame The Examiner's Rejection By Arguing The Prior Art Lacked An Unobstructed Machinery Space

The '515 patent discloses a railway hopper car with inclined interior walls called "slope sheets." The patent describes reinforcing the underside of a slope sheet with transverse beams so that the "machinery space" below the slope sheet is unencumbered by other structure for supporting the slope sheet.



During prosecution, the patent examiner rejected original Claim 1 over U.S. Patent No. 4,348,962 (Smith). EX1002 at 83–87. Smith disclosed vertical gusset plates 106 that “serve to reinforce the inclined slope sheet 34 to resist longitudinal forces imposed by car buff and impact loading.” EX1015, col. 6:25–27.

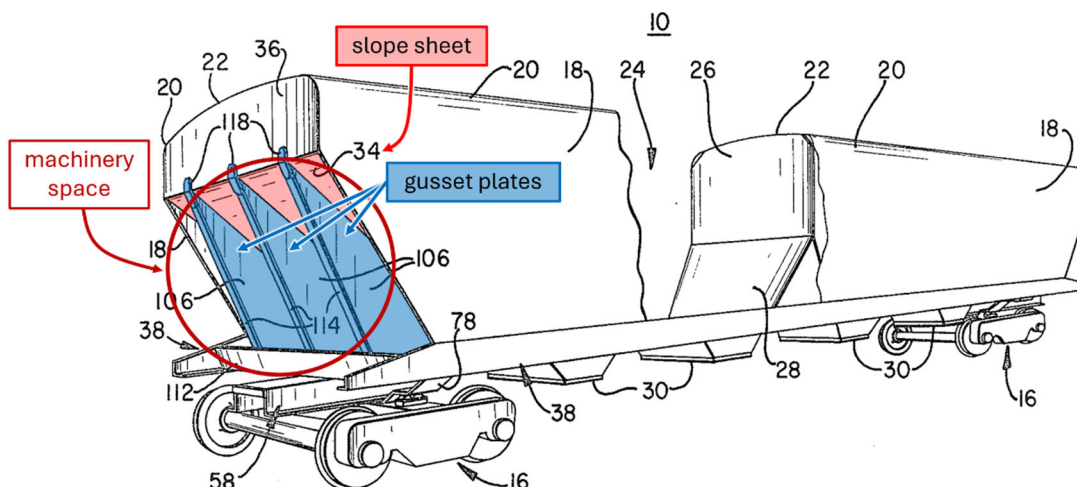


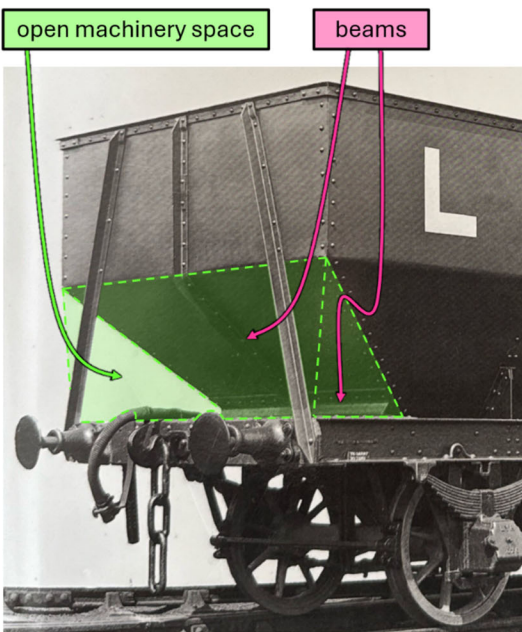
FIG. 1 **Smith Patent—Cited by Examiner**

Patent Owner overcame the rejection by relying on Claim 1’s open-machinery-space limitation. EX1002 at 112–113, 125. That limitation required the hopper car to be “*free of primary structure directly above said shear plate* of said first end section *under said overhang of said first end slope sheet* of said hopper.” *Id.* at 101 (emphasis added). Relying on this limitation, Patent Owner argued that “Claim 1 is directed toward a car that has an *unobstructed machinery space...*” and that Smith’s “gussets 106, being primary structure, rather obstruct the machinery space in question.” *Id.* at 112–113 (emphasis added).

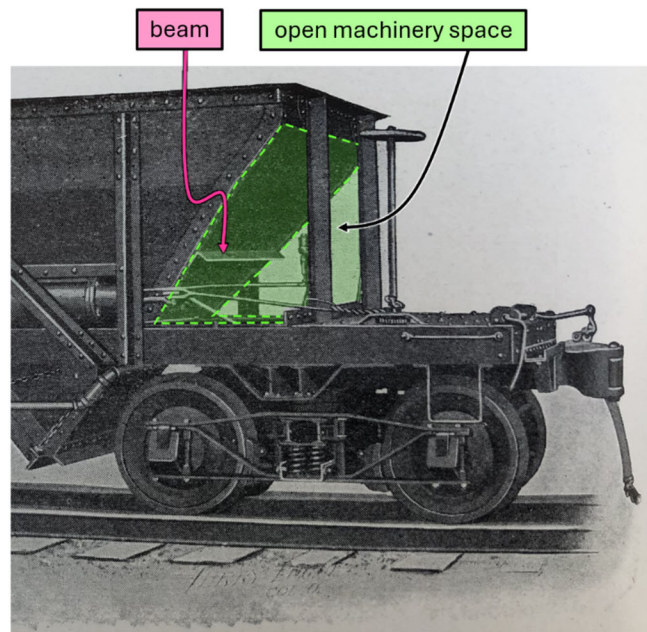
Patent Owner’s argument succeeded: the examiner promptly allowed Claim 1 and its dependent claims in the next office action. *Id.* at 125. Patent Owner then moved Claim 1’s limitations to Claim 6 (*id.* at 273) and amended each of the three remaining independent claims (25 and 27) to add a limitation requiring the hopper car to be “free of longitudinally oriented elephant ears” below the slope sheet (*id.* at 276, 278, 279). Finally, Patent Owner added a new independent claim 33, which also contained the “free of elephant ears” limitation. *Id.* at 281. The examiner allowed these claims as well. *Id.* at 309. As a result, all claims of the ’515 patent require a machinery space that is free of elephant ears or free of all primary structure.

2. The Examiner Erred By Overlooking Prior Art Hopper Cars With Open Machinery Spaces

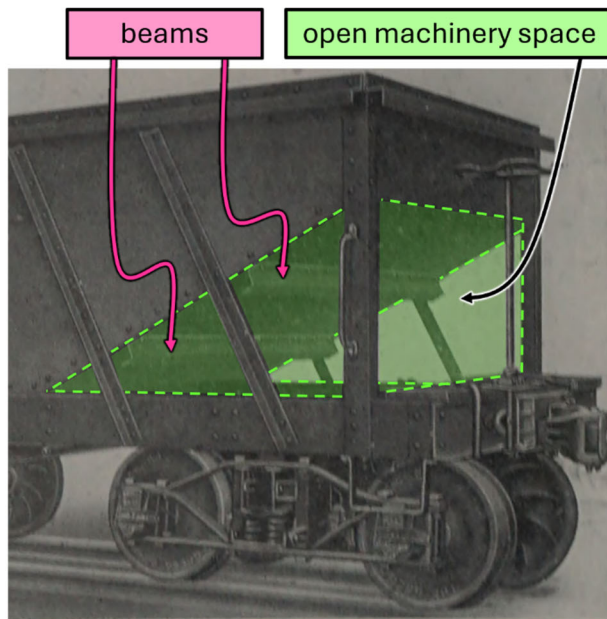
However, hopper cars with unobstructed machinery spaces abound in the prior art. Like the car in the '515 Patent, these prior art cars created open machinery spaces by positioning support beams on the underside of the slope sheet, oriented either transversely or longitudinally, thereby obviating the need for support plates or struts in the machinery space. A sampling of such prior art hopper cars is shown below.



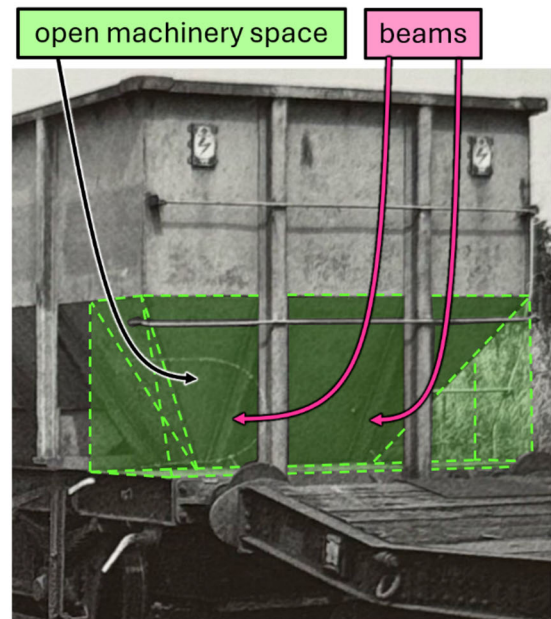
L&Y Hopper Car (1904)



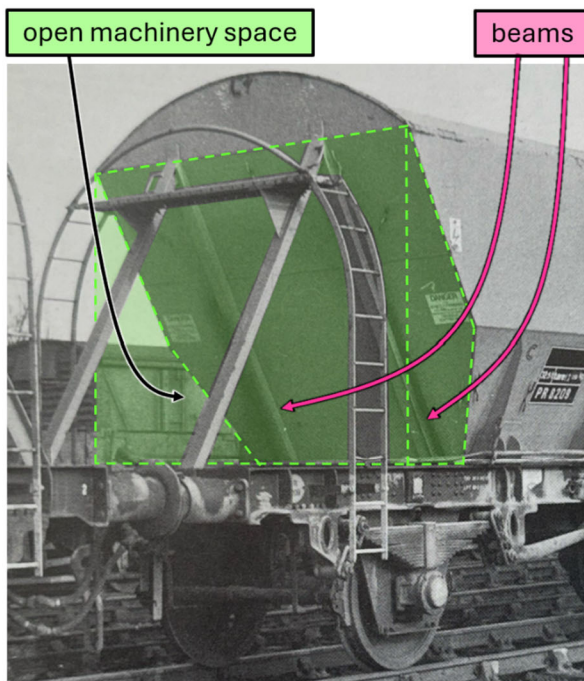
Kilbourne & Jacobs Hopper Car (1912)



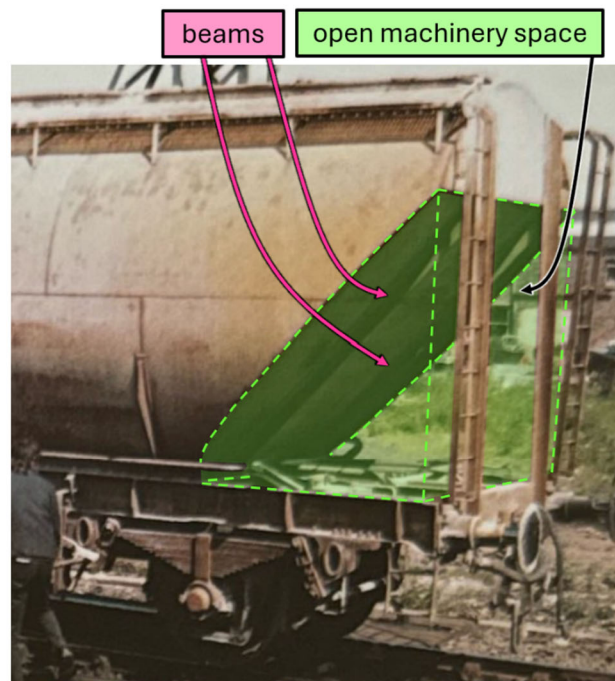
Gregg Co. Hopper Car (1922)



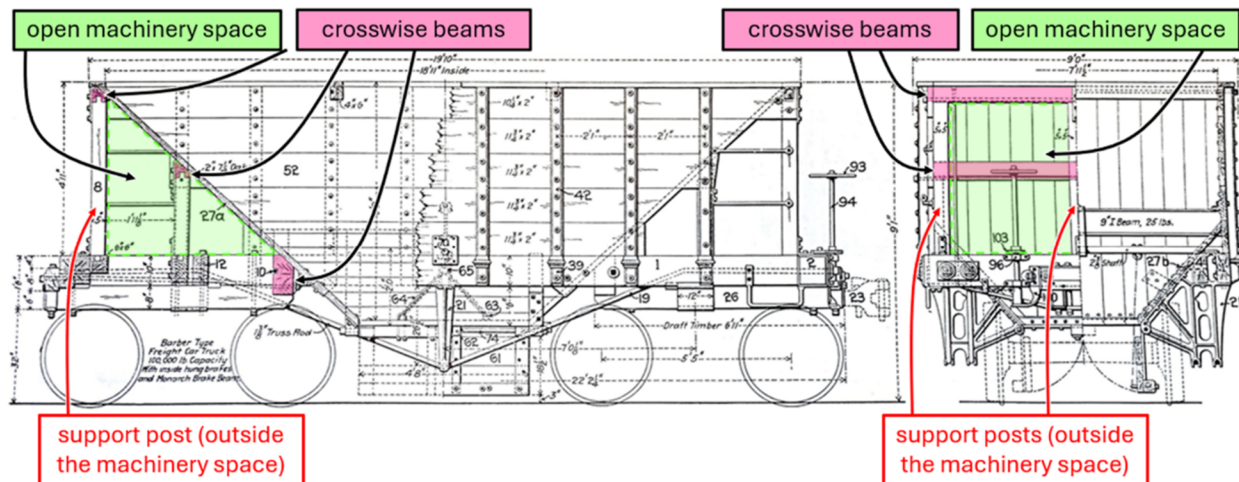
BR Shildon Hopper Car (1963)



BP Chemicals Hopper Car (1971)



British Steel Hopper Car (1971)



M&SP Ore Car – 1906 Cyclopedia

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*, IPR2019-01469, 2020 WL 740292, at 4 (PTAB Feb. 13, 2020). In granting the ’515 Patent, the examiner erred by overlooking prior art rail cars with open machinery spaces. *See Crowdstrike, Inc. v. Gosecure, Inc.*, IPR2025-00070, Paper 28 at 17–18 (PTAB Aug. 13, 2025) (finding examiner error because the limitation the examiner believed missing from the prior art cited in the office action was present in another reference); *Motorola Mobility LLC v. Multifold Int’l Inc. Pte. Ltd.*, 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) (“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”). The Office should refuse Patent Owner’s request for discretionary denial and allow the Board to correct this material error.

Patent Owner argues discretionary denial is appropriate because the ’515 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) that was not cited in the file history. *Anthony*, Paper 12 at 2; Paper 9 at 15.

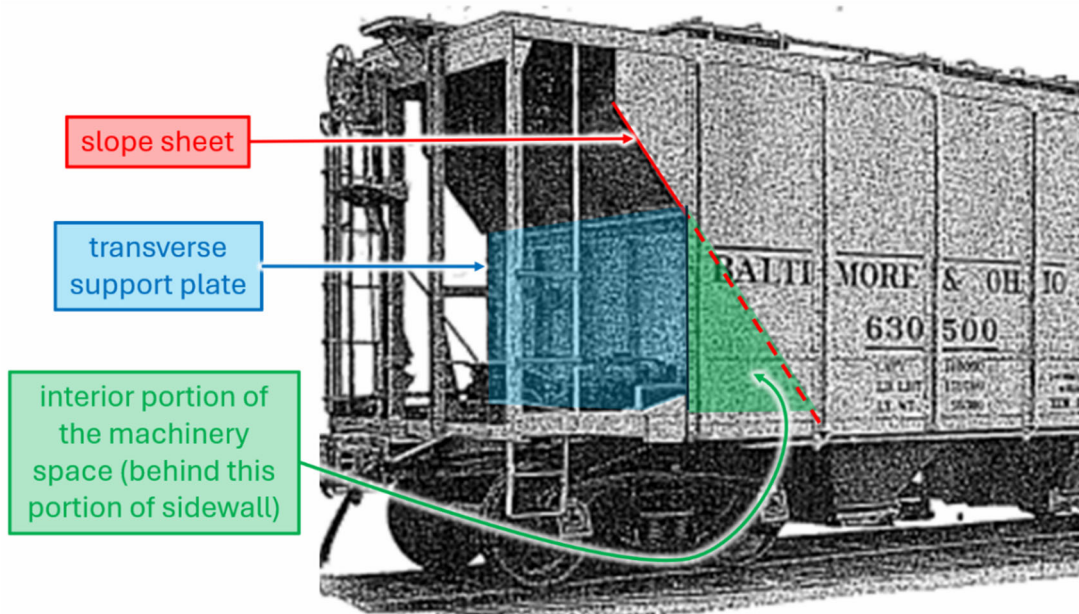
Like the examiners in *Xencor* and *Anthony*, the examiner who allowed the ’515 patent erred by overlooking the many prior art hopper cars with open machinery spaces. Instead of citing one of these references, the examiner rejected original Claim 1—which expressly required an open machinery space—over an irrelevant reference that disclosed a machinery space encumbered by three large support plates. 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 on the part of Patent Owner. *See Xencor*, Paper 12; *Anthony*, Paper 12; *Activision*, Paper 13; *Skullcandy*, Paper 9.

3. Patent Owner Incorrectly Argues That The Cited Art Includes Rail Cars With Open Machinery Spaces

Patent Owner suggests that overlooking open-machinery-space references was harmless because Patent Owner provided the Office with “rail cars that are the

same or substantially the same as those in the asserted art.” Mot. at 47.² On the contrary, none of the rail cars that Patent Owner discusses in its brief has an open machinery space. In each case, the car’s machinery space is encumbered either by a transverse support plate or an angled support strut.

For example, Patent Owner points to a car made for the Baltimore & Ohio Railroad. *Id.* at 53. As the image below shows, that car has a transverse plate for supporting the slope sheet. *Id.* The transverse support plate passes laterally through the machinery space from one side of the car to the other, dividing the machinery space into interior and exterior portions.

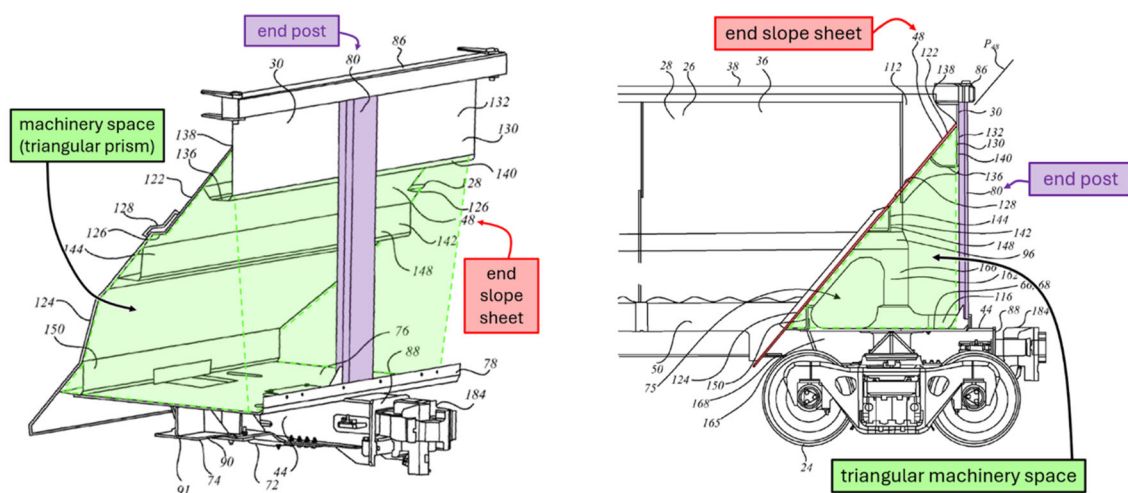


² Patent Owner made this argument in requesting discretionary denial under § 325(d).

Because the exterior portion of the machinery space (*i.e.*, the portion longitudinally exterior of the transverse support plate) contains no primary support structure, the machinery space at first glance appears open. However, the '515 patent explains that the machinery space is a ***triangular prismatic space*** below the slope sheet and above the shear plate:

Car 20 has an end of car machinery space, indicated generally as 75, that is bounded by shear plate 76 on the bottom, the sloped end wall assembly 30 or 32 of the car on the top, main vertical central end post 80, and main side posts 82, 84 at the ends of main bolster 90. This space may be referred to as ***having the shape, generally, of a triangular prism*** and is substantially unobstructed by the primary structure of the car.

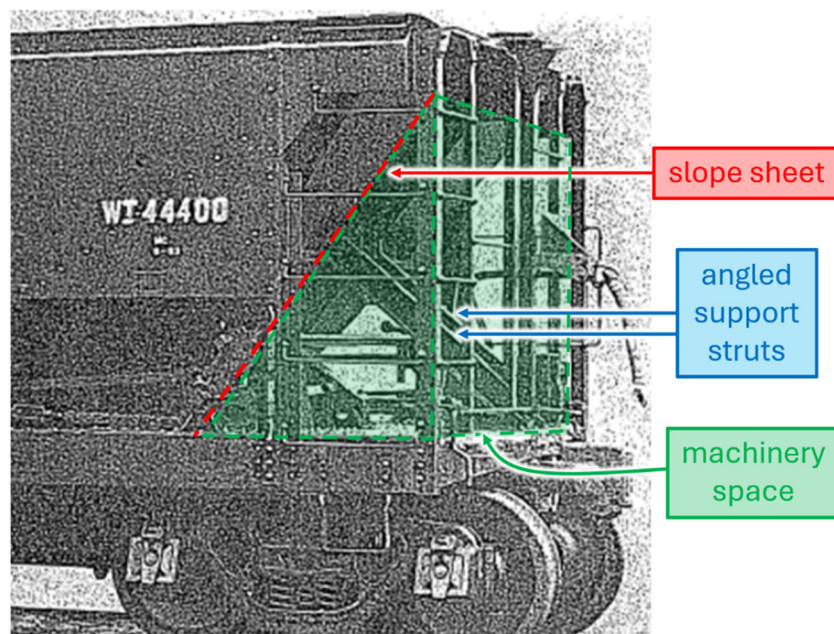
EX1001 at 14:43–50. This triangular prismatic shape may be seen in the following figures from the '515 patent:



'515 Patent Figs. 3a & 3b

Thus, the machinery space in the Baltimore & Ohio hopper car is the entire triangular prismatic space below the slope sheet and above the shear plate. Because the transverse support plate passes through and bisects that space, the car's machinery space is not free of primary structure. The same is true of the other rail cars with transverse support plates that were before the examiner during prosecution of the '515 patent. *See, e.g.*, Mot. at 49 (QIT hopper car).

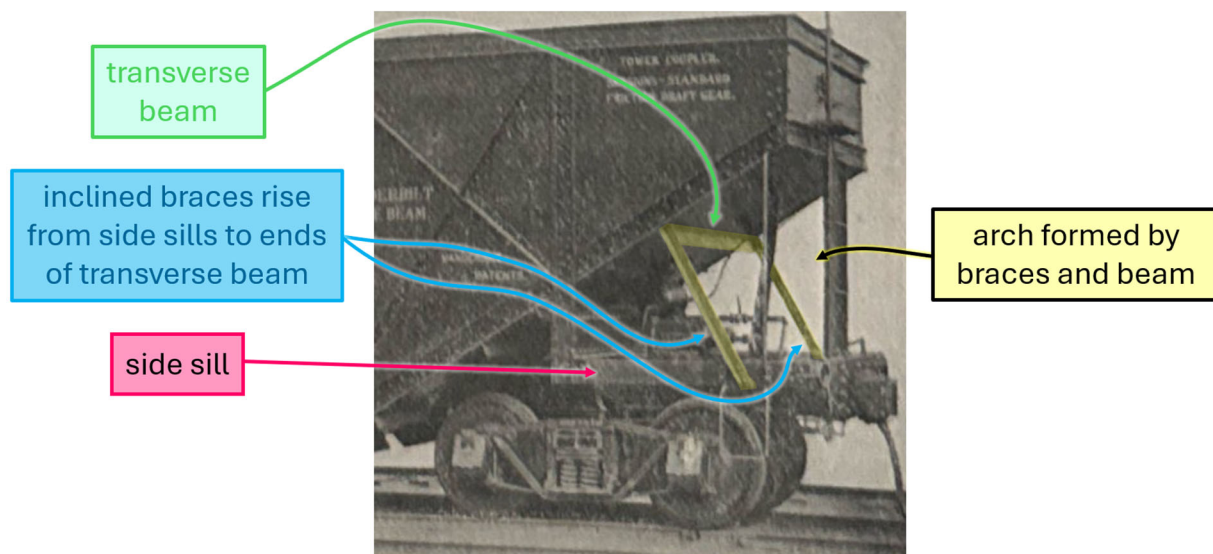
Other rail cars that Patent Owner characterizes as “substantially similar to those in the asserted art” have angled struts in their machinery space. One such car is shown on page 54 of Petitioner's brief and reproduced below. *Id.* at 54. At the center of the machinery space are two angled struts that support the slope sheet.



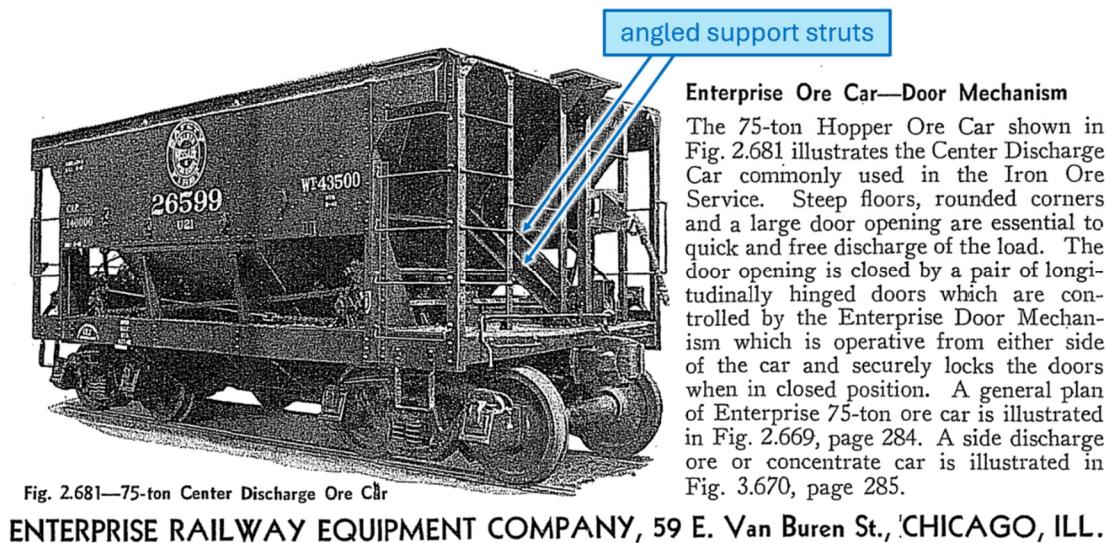
Id. Angled support struts such as these are common in the prior art submitted by Patent Owner. *See, e.g., id.* at 49, 50, 51, 52 and 53.

None of the references Patent Owner calls “substantially similar to those in the asserted art” discloses an *open* machinery space. They each disclose either a transverse support plate or an angled support strut.

Relatedly, Patent Owner argues that Hart, the principal reference in the Petition, is cumulative of the Enterprise Car, which was before the Office during prosecution. Mot. at 57–66. However, as explained in the Petition, Hart discloses an open machinery space supported by transverse beams. Pet. at 36–41. The ends of one transverse beam are supported by posts on each side of the car. *Id.* at 40. The posts do not extend laterally inward into the machinery space, but combine with the transverse beam to form an arch-shaped structure that leaves the machinery space free of support structure. *Id.* Hart does not include a perspective view, but the following photograph of the Cambria Steel car (1906) shows the same type of arch-like support disclosed in the Hart patent. *Id.*



Hart is not cumulative of the Enterprise Car because the latter does not have an open machinery space—it has angled struts in that space. While these struts may be seen in the technical schematics in Fig. 2.669 on page 284 of the 1943 Cyclopedia, they are more easily seen in the photo of the same car in Fig. 2.681:

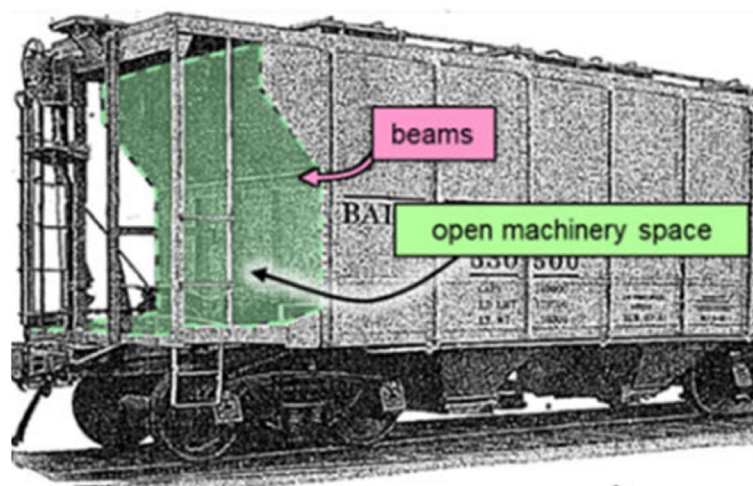


EX1002 at 241 (Fig. 2.669), 244 (Fig. 2.681). This perspective view shows that the Enterprise Car’s struts are not above the side sills; instead, they occupy the machinery space directly under the slope sheet.

Patent Owner asserts that the “Petition mistakenly attempts to make it seem like ‘open machinery spaces’ would be a new concept to the Office (Petition at 24–28) but rail cars with open ends were cited to, and considered by, the Examiner during prosecution....” Mot. at 65. Patent Owner points to three rail cars to support its claim that the examiner considered open-machinery-space art: the Bulk

Commodity Covered Hopper Car, the Quebec Ore Transport Car, and the Chicago & North Western 70-Ton Capacity Hopper Ore Car (“the Chicago & North Western car”). *Id.* at 66. However, none of these prior art cars has an open machinery space.

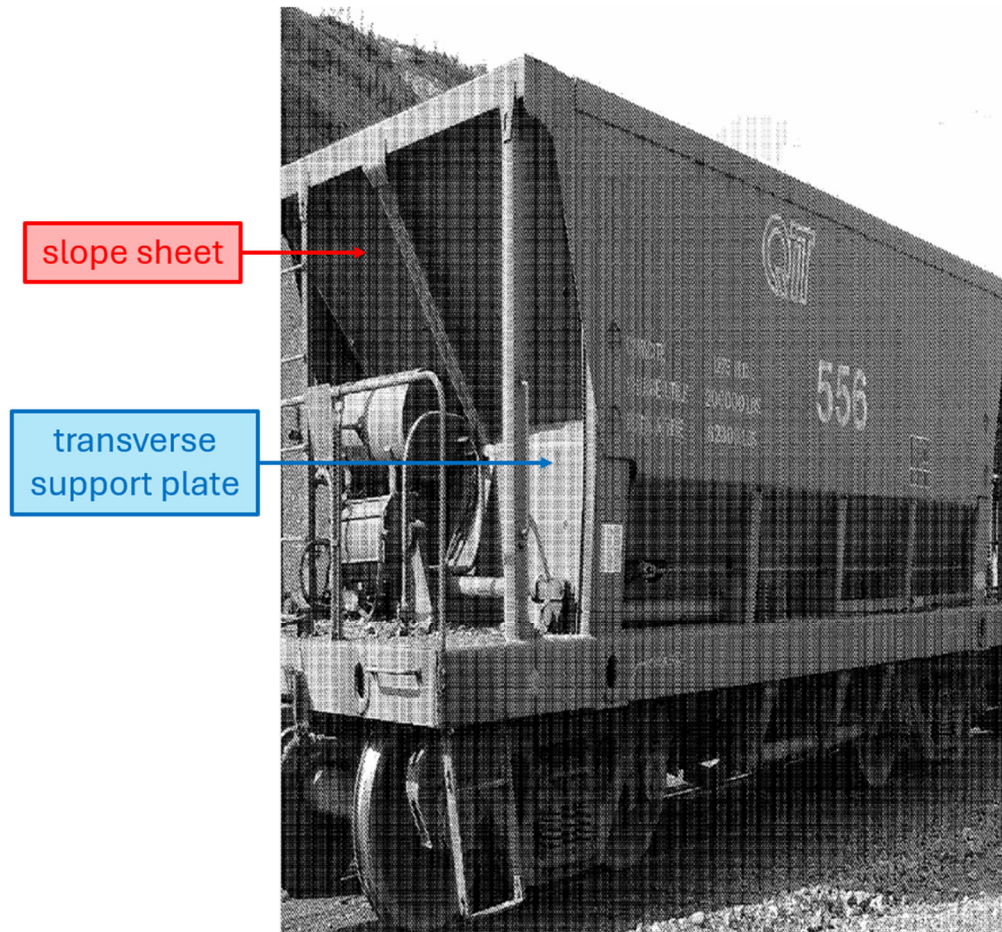
The Bulk Commodity Covered Hopper Car has a transverse support plate that divides its machinery space into two sections, similar to the Baltimore & Ohio car discussed above. Patent Owner’s annotated image of the car is shown below. *Id.* As discussed above, the ’515 patent defines the machinery space as the triangular prismatic space below the slope sheet and above the shear plate. What Patent Owner labels as “open machinery space” is only the exterior portion of that space. The remainder of the machinery space is hidden by the transverse support plate that extends laterally through and bisects the machinery space.



**Bulk Commodity Covered
Hopper Car (1943)**

(Patent Owner’s Annotations)

Patent Owner's second example—the Quebec Ore Transport Car—also has a transverse support plate that extends laterally through the machinery space. *Id.* The support plate is shown in the image below, a photograph in the file history taken from a different angle from the image on page 66 of Patent Owner's brief.



EX1002 at 219.

Patent Owner's third example—the Chicago & North Western car—also fails to support its claim that the examiner had open-machinery-space art. Patent Owner relies on a photograph of the Chicago & North Western car in Fig. 411 of

the 1937 Cyclopedia, but that photograph does not show the machinery space in detail. Mot. at 66. However, the file history also includes Fig. 412, which contains diagrams of the same ore car. EX1002 at 234. As shown below, the lower left diagram in Fig. 412 shows a generally triangular support plate (blue) in the center of the machinery space. *Id.* A label on the support plate (3/8" Plt) indicates that the plate is 3/8 inches in thickness. *Id.*

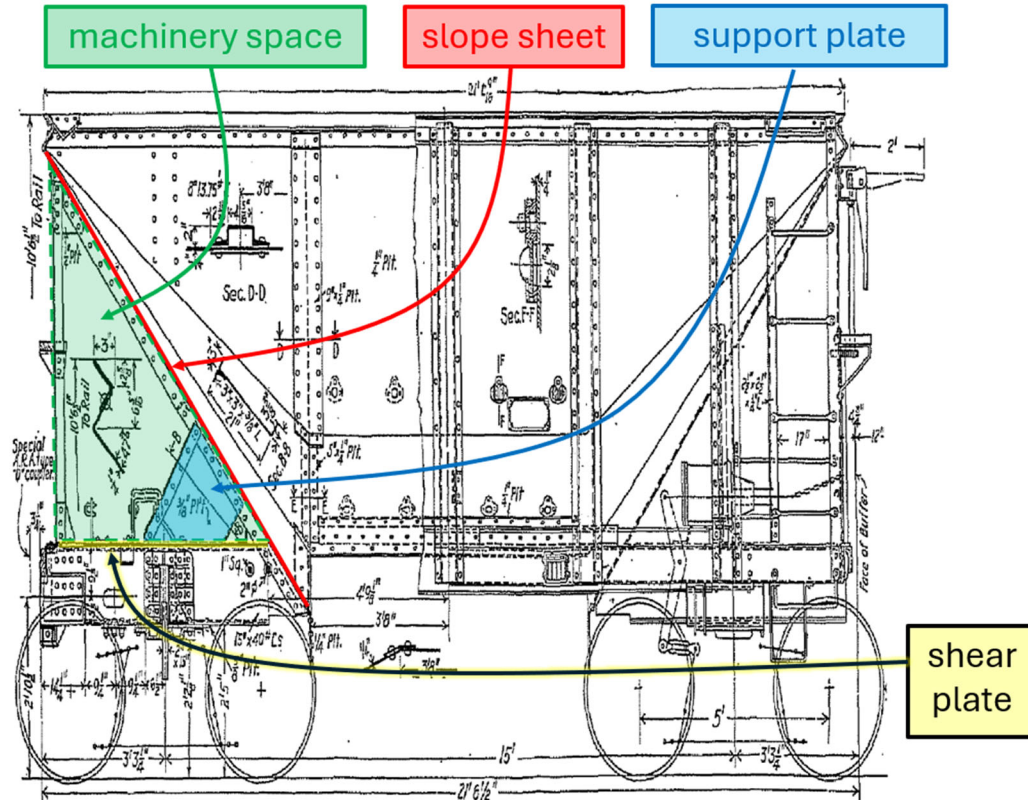


Fig. 412—Plan, Elevation and Sections of Chicago & North Western 70-Ton Capacity Hopper Ore Car.
(See also Fig. 411 and Section 3 for Details of Door Operating Mechanism)

The diagrams in Fig. 412 show that the generally triangular support plates are positioned in the center of the machinery space, and not at the sides of the hopper

car above the side sill.³ *Id.* This central location is confirmed by the photograph of Fig. 411, which shows that the support plates are **not** on the sides of the car. If the support plates were located on the side sills, rather than in the machinery space, they would be visible in the Fig. 411 photograph below. *Id.* at 233.

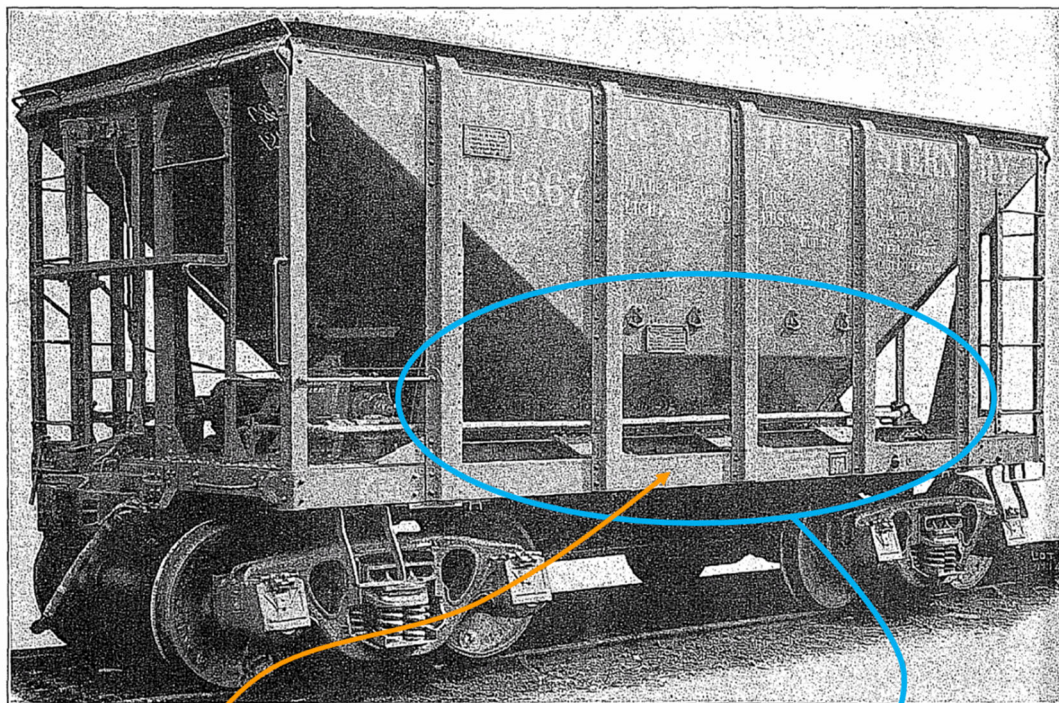


Fig. 411—Chicago & North Western 70-Ton Capacity Hopper Ore Car.

Capacity.....	140,000 lb.—975 cu. ft.	Length inside.....	21 ft. 2½ in.
Light weight.....	39,300 lb.	Length over striking faces.....	21 ft. 6½ in.
Load limit.....	170,700 lb.	Truck centers.....	15 ft. 0 in.
Door opening.....	39 sq. ft.	Height of side.....	10 ft. 6½ in.

(See also Fig. 412)

side sill

no triangular support plates on the side of the car

Patent Owner has not identified any prior art submitted during prosecution that discloses an open machinery space, let alone any discussion of such art by the

³ The diagrams shows that the support plate is riveted to a protruding flange that extends longitudinally down the center of the slope sheet. Fig. 412.

examiner. There is simply no merit to Patent Owner’s claim that the examiner did not err, but “explicitly considered” rail cars with open machinery spaces “and concluded that each claim as a whole is patentable over” that prior art. Mot. at 68. In fact, the patent examiner overlooked the many prior art references in the Petition that disclose open machinery spaces.

Finally, even if the cited art included cars with open machinery spaces, the examiner still would have erred by overlooking it. Overlooking important prior art is material error even where the art was submitted to the Office. *See Motorola Mobility*, IPR2025-00040, Paper 10 at 32–34 (“we find the Examiner overlooked at least the material disclosure and teachings of [a cited reference] as set forth in the Petition, which was material error by the Office”); *accord Smith Interface*, IPR2024-01084, Paper 7 at 13 (“the Examiner’s allowance of claim 1 without considering the combined teachings of [a cited reference] and [an uncited reference] constitutes an error material to patentability”).

In view of the Office’s material error during prosecution of the ’515 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

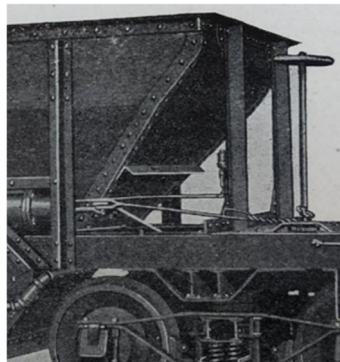
Discretionary denial is also unwarranted because the Petition presents a particularly strong case of obviousness. The petition presents ten prior art references disclosing rail cars with slope-sheet support beams and open machinery spaces, the allegedly novel feature of the ’515 patent. Pet. at 23–28 (reproduced below). Thus, the petition does not merely show that the rail car features recited in the challenged claims appear somewhere in the prior art. It establishes that the allegedly novel feature of the ’515 patent was commonly used and well known in the field, many decades before the ’515 patent application was filed.

1904



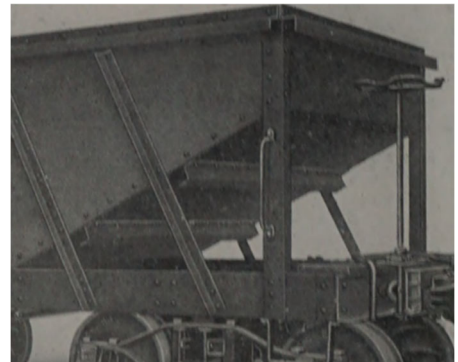
L&Y

1912



Kilbourne & Jacobs

1922



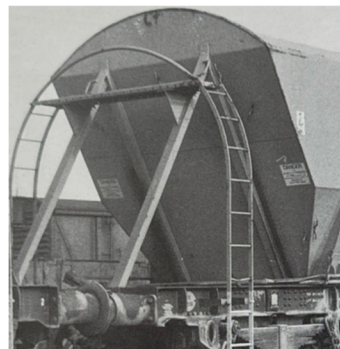
Gregg Co.

1963



BR Shildon

1971

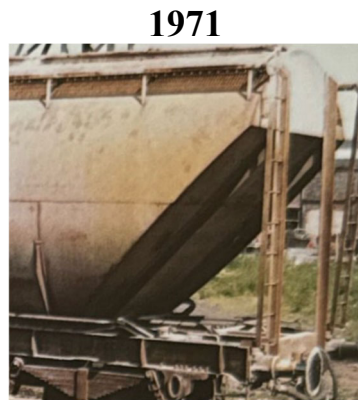


BP Chemicals

1971



Steetley



British Steel



Marcroft

Id.

The petition also shows that using reinforcement beams is one of just three known ways to support a slope sheet. *Id.* at 23–29. This is confirmed by the numerous images of prior-art rail cars from the petition that Patent Owner reproduced in its brief. In each such image with a visible slope sheet, the slope sheet is supported by one or more of (i) support beams on the underside of the slope sheet, oriented either longitudinally or transversely; (ii) vertical plates, oriented either longitudinally or transversely; or (iii) posts/struts, either vertical or angled. By showing that the allegedly novel feature of the '515 patent is one of just three known ways to support a slope sheet, the petition makes a strong case for the obviousness of the challenged claims.

In addition, the petition shows that the remaining features recited in the challenged claims are basic freight-car features that became standard features decades before Patent Owner filed its patent application. For many years, features

such as draft sills, bolsters, end posts and corner posts have figured in hopper-car patents and have been defined in railcar dictionaries. *See, e.g.*, Pet. at 93, 77, 48. Even the most modern feature recited in the claims—the claimed pneumatic door opening mechanism—was in use forty years before the ’515 patent issued. *Id.* at 51–52. 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 ’551 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, such as the 1911 Hart patent, for being “ancient.” Mot. at 27, 29, 31. 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 ’515 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 have long been in the public domain. This is a petition that should be considered on its merits.

C. Review Of The '515 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.

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 10. 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 in 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 all the district court’s cases with co-pending IPRs since 2020 shows that, when an IPR proceeding had been 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) (stay granted) (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 Investments, LLC d/b/a Brazos Licensing and Development v. Netgear, Inc.*, No. 1-21-cv-01117 (D. Del. Nov. 30, 2022) (EX1044); *Speyside Medical, LLC v. Medtronic CoreValve LLC*, No. 1-20-cv-

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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 to prepare for trial. Trial is set to begin on January 11, 2027. Because the Petition is strong and the IPR’s final written decision is 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, the 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, 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 ten 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 23–26. But Petitioner is not aware of any physical system that corresponds to the 1911 Hart patent or the 1919 Lindström patent, the two primary references in the petition, nor has Patent Owner identified any such system. Thus, Petitioner will be unable to make any invalidity argument in district court using the Hart design or the Lindström design as a primary reference. The arguments Petitioner makes in district court will necessarily rely on different primary references and will be substantively different from the arguments in the petition.

Specifically, if Petitioner’s 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 would rely on its unpublished engineering drawings to show the structure of the prior-art railcars 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. No reference in the Petition shows any of these Bethlehem Steel cars. Twelve other railcars in the list are relevant to show that open machinery spaces were common in the prior art. In its invalidity contentions in district court, Petitioner relies on these machinery-space references to show that reinforcement beams and open machinery spaces were common and well known in the field, and that it would have been obvious to modify Petitioner's own Bethlehem Steel hopper cars to incorporate these features. No such argument appears in Petitioner's IPR petitions, which never even mention a Bethlehem Steel car.

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 the 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 45–72. 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 1911 Hart patent nor the 1919 Lindström patent—the two primary references in the petition—were before the Office during prosecution of the ’515 patent. Indeed, *none* of the references cited in the petition were before the Office. Nor did the Office have any cumulative references showing open machinery spaces. The file history therefore includes *no evaluation of the evidence of record* that could be accorded deference. 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) (the “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). *Id.*

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 open machinery spaces. 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 31–45. 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 33. But the petition’s length is dictated by the length of

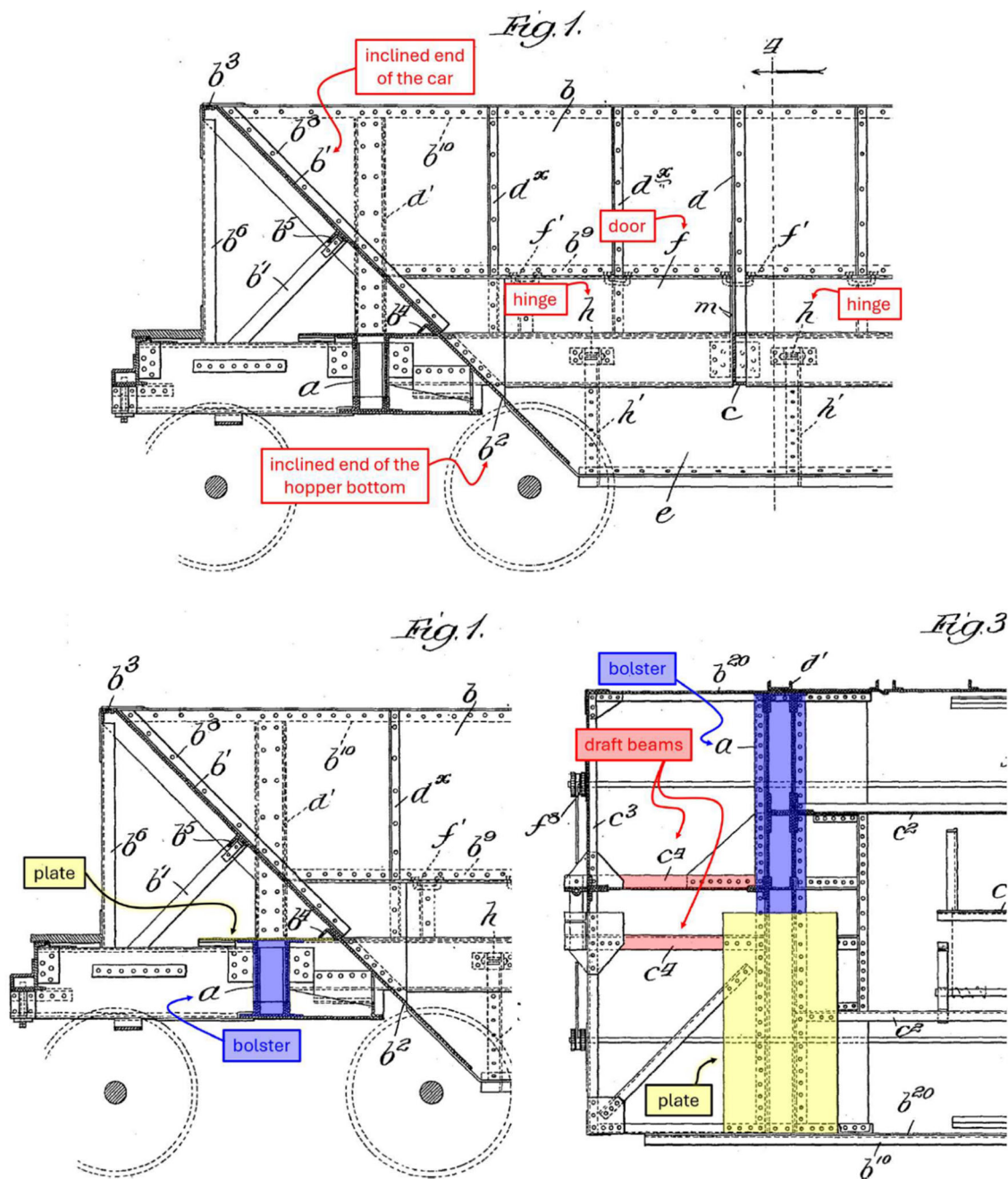
the '515 patent's 44 claims. The independent claims all include a long list of standard railcar features such as side walls, end walls, end posts, and corner posts. As a result, the claim language alone runs a full 4,700 words—over a third of an IPR petition's 14,000-word limit. The Petition provides a single ground of invalidity for each claim. This is not excessive, especially given the abundance of relevant 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 32–36. These arguments ignore the detailed, annotated images, illustrations, and figures in the Petition that identify claim elements.

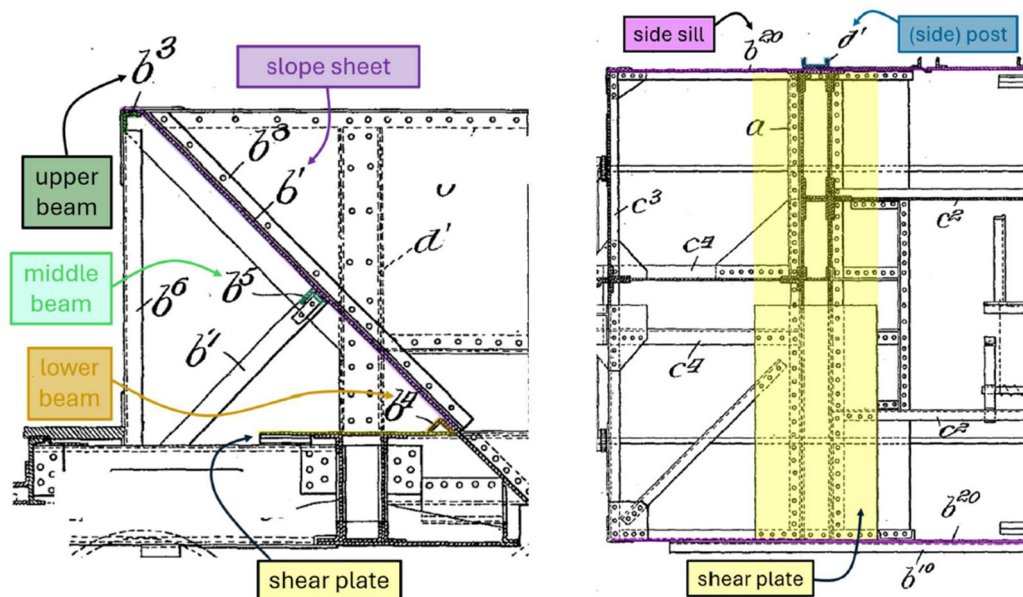
For example, Patent Owner attacks Petitioner's treatment of limitation [1d], which requires that the slope sheet (recited in limitation [1b]) overhang the shear plate (recited in limitation [1c]). Patent Owner criticizes the petition for stating that limitation 1[d] is “shown above.” Mot. at 36. But the petition previously identified the slope sheet as the “inclined end of the car” *b'*, and previously identified the shear plate by pointing to the relevant plate in Hart's Fig. 3. Pet. at 33–36. The annotated figures “shown above” in the petition show that the slope

sheet (inclined end b') overhangs the shear plate. The relevant figures have been reproduced below as they appear in the petition.



Pet. at 34, 36. Thus, Patent Owner’s critique—that the petition leaves the Board to “guess” at what is shown—is without merit.

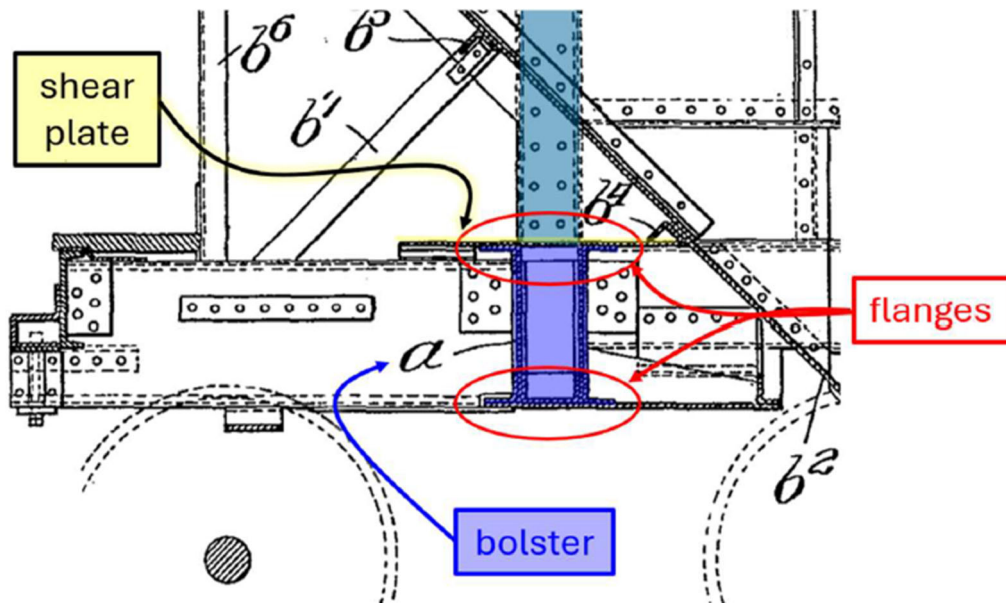
For limitation [1i], Patent Owner argues that inclined brace b^7 is laterally inward of the corner posts d' , and therefore technically within the machinery space. Mot. at 36–37. This is a substantive dispute about the disclosure of the prior art that the Board should address after institution. In any event, Patent Owner is incorrect because inclined braces b^7 and corner posts d' both rise directly up from the side sills b^{20} , leaving the entire space below the slope sheet and above the shear plate unobstructed.



Pet. at 38, 39.

Patent Owner also attacks the Petition's treatment of limitations [5a] and [5b], which recite a bolster with upper and lower flanges and a shear plate mounted on the bolster that define its upper flange. Mot. at 38–39. Once again, Patent Owner prematurely argues the merits of what Hart discloses. Patent Owner is also wrong on the merits. The Petition provides the following annotated figure showing

that the bolster (blue) has a lower flange, and that the shear plate (yellow) is mounted to the bolster and forms an upper flange of the bolster.



Pet. at 55.

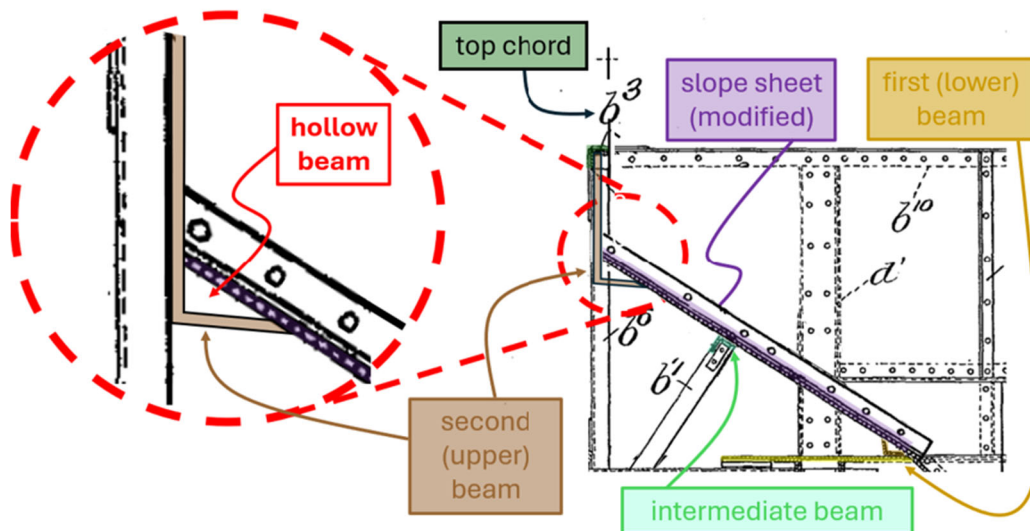
Patent Owner’s criticisms of the Petition’s treatment of limitations 1[h] and [32h] (Mot. at 36, 39) are similarly flawed because they prematurely argue the merits of the petition and ignore information provided in the Petition’s labeled and colored figures.

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 31, 40. 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 Petition’s cross-reference in connection with claim 33, which requires “a third beam ... mounted across said first end slope sheet intermediate said first and second beams.” Mot. at 41. But in addressing independent claim 32, the Petition explained that Hart discloses two crosswise reinforcement beams. Pet at. 95–97, 101–02. Then, in addressing dependent claim 33, the Petition explains that it would have been obvious to modify Hart to add a third crosswise beam as in Wong. *Id.* at 102–03. The cross-referenced figure, shown below, shows the obvious modification of Hart. *Id.* at 103. It shows the location of Hart’s intermediate beam b⁵, labeled and colored green, in the previously discussed modification of Hart:



Id. Such cross-references are appropriate, not grounds for discretionary denial.

4. The Petition's Grounds Are Complete

Patent Owner further argues that “the stated grounds in the Petition are incomplete” because the petition does not reiterate the analysis of independent claims in connection with each dependent claim. Mot. at 42 (citing dependent claim 3). 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. Nor is an express cross-reference required for a dependent claim.

While a cross-reference can be helpful when the same claim limitation appears in two different claim sets, the Board will readily understand that the analysis of an independent claim applies to its dependent claims. A cross-reference to the independent claim is unnecessary.

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 has 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 12. 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.⁴ In any event, *inter partes* review of the ’515 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.

⁴ 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.

In an attempt to cast Petitioner in an unfavorable light, Patent Owner suggests that Petitioner is a willful infringer because its employees saw Patent 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 ’515 Patent.” Mot. at 14. But the petition described the examiner’s mistake in great detail, even if it never used the word “mistake.” *See, e.g.*, 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.”⁵ Patent Owner cites no authority for its position that, in addition to showing the unpatentability of the ’515 patent’s 44 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.

⁵ <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 42–45. Patent Owner first points to the length of Dr. Ahmadian’s declaration and the number of times it is cited. Mot. at 42–43. 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, ¶¶ 54–59. 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 replace the manual door opener in the 1911 Hart patent with a more modern system, such as the pneumatic mechanism disclosed in the 1973 Schuller patent. *Id.* ¶ 97. According to the Office’s guidance, these are proper uses of expert testimony in an IPR petition.⁶

Patent Owner relies on *Xerox* and *Wowza*. Mot. at 43. 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).

⁶ 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 44–45. 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 ’515 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

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that the foregoing PETITIONER’S OPPOSITION TO PATENT OWNER’S MOTION FOR DISCRETIONARY DENIAL contains 7,896 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).

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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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