

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)

IPR2025-01047 (Patent 8,132,515)

**PATENT OWNER'S OPPOSITION TO MOTION TO CORRECT
EXHIBIT 1004 PURSUANT TO 37 CFR § 42.104(c)**

On behalf of National Steel Car Limited

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I. Introduction

Petitioner’s Motion to substitute Exhibit 1004 should be denied. Exhibit 1004, consisting of digitized excerpts from the 1946 Cyclopedia, is the foundational prior art reference underlying both Petitions challenging the ’892 and ’515 Patents.¹ Yet, the version Petitioner chose to file consists of low-quality scans that render critical details of the alleged prior art indecipherable.

Petitioner’s decision to rely on this deficient version was deliberate. In the parallel district court litigation, Petitioner produced the same deficient scans, even after Patent Owner explicitly requested higher resolution copies. *See* Exs. 2042, 2043 and 2044. Petitioner also disregarded the objections of Patent Owner’s expert to the quality of Exhibit 1004, raised in connection with the Petitions. *See* ’046 IPR, Ex. 2001 at ¶ 41 (“It should be noted that some of the figures used by Dr. Ahmadian in his analysis . . . are somewhat degraded in clarity . . . Accordingly, there is irreducible ambiguity in the interpretation of these figures and the identification of structures therein.”); *see also* ’047 IPR, Ex. 2001 at ¶ 41; ’048 IPR, Ex. 2001 at ¶ 41.

¹ IPR2025-01048 has been denied as part of the discretionary denial process. ’048 IPR Paper 20.

Now, through its Motion, Petitioner seeks to replace Exhibit 1004 with a purportedly higher-resolution version. Yet petitioner fails to provide that version to the Board. Petitioner offers no information regarding the provenance of the new version, including when it was created, who created it, or whether it matches the version experts, Dr. Ahmadian and Dr. Sylvia D. Hall-Ellis, relied on to form their opinions. This omission is particularly troubling given that the Petition and expert reports rely on demonstratives derived from the low-quality version originally filed.

Petitioner's strategic choice to submit a visibly deficient Exhibit 1004 has prejudiced Patent Owner in preparing its Requests for Discretionary Denial and Preliminary Responses. It has also compromised the integrity of the record before the Board, which must now evaluate institution based on incomplete and one-sided evidence. The proposed substitution, after institution decisions are pending, would materially alter the evidentiary foundation of the Petitions and should have been included at the time of filing.

Moreover, the nature and extent of the changes in the new exhibit remain unknown, as Petitioner has declined to provide the replacement with its Motion. This lack of transparency is inconsistent with Board precedent, which has rejected substitutions involving far less substantive changes. *See Zhongshan Broad Ocean Motor Co., Ltd., et. al. v. Nidec Motor Corporation*, Case IPR2014-01123, Paper 20

(PTAB, Jan. 21, 2015). (denying substitution to include an affidavit attesting to the accuracy of a translation because Lead Counsel made incorrect assumptions regarding the filing of the same).

In sum, Petitioner’s Motion seeks to retroactively correct a strategic filing decision that has already prejudiced the Patent Owner and undermined the fairness of these proceedings. The Motion should be denied.

II. Legal Standard

A petition seeking *inter partes* review must be complete at the time of filing, including the asserted grounds of unpatentability and the supporting evidence and analysis. *See* 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22, 42.104; *see also Patent Trial and Appeal Board Consolidated Trial Practice Guide* (Nov. 2019 “Consolidated Trial Practice Guide”), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>, at 42.

While the rules permit a party to file a motion to “correct a clerical or typographical mistake in the petition,” such corrections are limited in scope and do not extend to mere inadvertence or unintentional omissions. Importantly, these motions are not intended to substantively alter the petition or the exhibits submitted with it. *See* 37 C.F.R. § 42.104(c); *c.f. Netflix, Inc. v. Copy Protection, LLC*, Case IPR2015–00921, Paper 19 at 3–5 (PTAB, July 30, 2015) (allowing correction where

the petition consistently quoted from the intended reference, the two references were similarly worded, and no material difference was shown).

Rule 104(c), however, does not provide a mechanism for a petitioner to make substantive changes to the petition or its supporting evidence under the guise of a “correction.”

In evaluating whether to permit a correction, the Board has considered several non-exclusive factors, including: (1) the nature of the error and whether the requesting party a sufficient explanation of how the error occurred and was discovered; (2) the time elapsed between discovery of the error and the request for correction; (3) any prejudice to the opposing party resulting from the proposed correction; and (4) the potential impact of the correction on the proceeding. *Ivantis, Inc. v. Glaukos Corp.*, Case IPR2018-01180, Paper 14 at 9 (PTAB Dec. 6, 2018) (Institution Decision).

III. Petitioner’s Error is Prejudicial and Not a “Clerical Error”

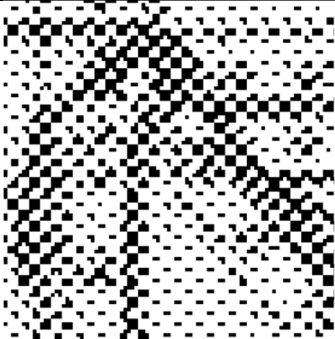
A. Petitioner Had over a Month to Bring its Alleged Clerical Error to the Board’s Attention (before Patent Owner’s Preliminary Response was Due) and Failed to Do So

Petitioner asserts that it only discovered the issue with Exhibit 1004 upon reviewing Patent Owner’s Preliminary Responses, which highlighted the disparity in image quality between the Petition (left) and Exhibit 1004 (right):

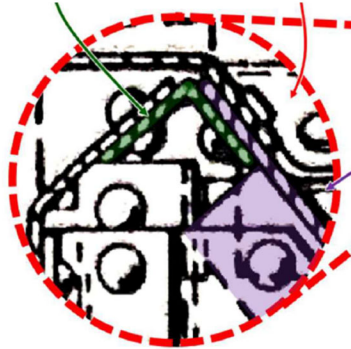


'046 POPR at 21; *see also* '047 POPR at 2.

However, the problems with the quality of Petitioner's prior art reproductions, including the 1946 Cyclopedia, were first identified by Patent Owner in the parallel district court litigation in April, before Petitioner initiated this IPR. The first-produced document was illegible, and the native file of the 1946 Cyclopedia subsequently produced was of similar poor quality to Exhibit 1004. *See* Exhibits 2042, 2043, and 2044. A comparison of the versions Petitioner has provided to Patent Owner is shown below:

Originally Produced (Ex. 2042 at FCA0000332)	Replacement Produced (Ex. 2043 at 294)	Exhibit 1004 at 27.
		

In contrast, the detail in the Petitioner’s demonstratives is significantly clearer:



See 046 Petition at 51, 78; *see also* 047 Petition at 105-106.

Patent Owner and its expert also raised concerns about the image quality of the exhibits in the Requests for Discretionary Denial, contrary to Petitioner’s claim that it only became aware of the issue upon reviewing the POPRs. *See* Exs. 2001 at 41. Petitioner waited over a month to move to replace Exhibit 1004, yet still seeks to retain its original filing date. This is not a clerical error but reflects a pattern of withholding and a failure to ensure the Petition is complete at the time of filing.

Upon receiving Exhibit 1004 with the Petition, Patent Owner reasonably assumed that Petitioner did not possess a higher quality scan of the 1946 Cyclopedia, particularly given Petitioner’s prior representations in the district court litigation. Patent Owner does not have its own copy of the 1946 Cyclopedia and relied on Petitioner to provide the evidence upon which its Petition is based – *as required by the IPR rules*. *See* Exhibits 2045.

Petitioner’s decision to now seek substitution of Exhibit 1004 with a version it admits was in its possession prior to filing is highly prejudicial. It deprived Patent Owner of the opportunity to fully develop its arguments against one of Petitioner’s central exhibits. Moreover, Petitioner’s failure to provide the replacement version with its Motion further compounds the prejudice, as Patent Owner is unable to assess or articulate the full extent of the harm caused.

B. Petitioner’s Explanation for How the Error Occurred and How the Error was Discovered is Lacking

Petitioner’s explanation of how the error occurred is insufficient. Attorney Gillett does not state that he – or lead counsel or backup counsel (Messrs. Nelson and Cannon) – reviewed Exhibit 1004 prior to its filing. This is not a clerical error correctable under Rule 104(c). Mr. Gillett’s declaration also fails to indicate that any of Petitioner’s attorneys reviewed Exhibit 1004 after Patent Owner’s expert raised concerns about the image quality. *See* ’046 IPR, Ex. 2001 at ¶ 41 (“It should be noted that some of the figures used by Dr. Ahmadian in his analysis . . . are somewhat degraded in clarity . . . Accordingly, there is irreducible ambiguity in the interpretation of these figures and the identification of structures therein.”); *see also* ’047 IPR, Ex. 2001 at ¶ 41; ’048 IPR, Ex. 2001 at ¶ 41.

Moreover, Patent Owner previously raised concerns regarding the quality of Petitioner’s prior art in the district court litigation. Despite this, Petitioner failed to ensure that the version of the Cyclopedia it submitted met the necessary standards. Petitioner was therefore on notice that if it intended to rely on high-resolution copies, it should have filed them with the Petitions.

Petitioner also failed to follow the guidance provided by the USPTO in the Patent Trial and Appeal Case Tracking System Frequently Asked Question (FAQs). FAQ No. A8 states:

A8. What is the megabyte limit for a document upload?

A single uploaded file may not exceed 25 megabytes in size.

If you need to file a document that exceeds 25 megabytes, please follow the instructions below.

You can reduce the file size by:

Splitting a large file into multiple smaller files;

and/or

Converting Microsoft Word documents into searchable PDF files, rather than printing documents and scanning them in as flat PDF files.

Patent Trial and Appeal Case Tracking System Frequently Asked Question (FAQs) Version 2.0 October 7, 2022, available at https://www.uspto.gov/sites/default/files-/documents/p-tacts_faqs_20221007.pdf.

Petitioner and its counsel offer no explanation as to why they failed to ensure compliance with the USPTO’s guidance regarding document submission through the P-TACTS system.

**C. Petitioner’s Decision to File a Low-Resolution Version of the 1946
Cyclopedia is Substantive, Not Clerical, Prejudicing Patent Owner
and Impacting these Proceedings**

Petitioner’s error materially alters the quality of the images relied upon in support of its Petitions. This is a **substantive addition**, not a clerical correction. The extent of the change remains unknown because Petitioner has failed to provide the replacement exhibit it seeks to file. As a result, both Patent Owner and the Board are left at a disadvantage—precisely the type of prejudice the Rules are designed to prevent.

The prejudice here is analogous to that in *Sweegen, Inc. v. Purecircle SDN BHD*, Case PGR2020-00070, Paper 9 (PTAB Sept. 22, 2020). In *Sweegen*, the petitioner attempted to introduce additional data into its expert reports that constituted “substantive new evidence,” not a “mere clerical error.” *Id.* at 6. The Board emphasized that “[a]lthough clerical or typographical errors can be corrected under 37 C.F.R. § 42.104(c), this rule does not give a petitioner recourse to make substantial alterations to the petition or the evidence supporting the petition.” *Id.* at 7. As in *Sweegen*, Petitioner’s attempt to replace its chosen exhibit would

“substantially affect Petitioner’s arguments and could have an impact on the proceedings.”

Petitioner cites *Apple Inc. et al. v. Memory Integrity, LLC*, Case IPR2015-00163, Paper 16 (PTAB April 9, 2015) to argue that no prejudice would result from its proposed substitution. But *Apple* is distinguishable. There, the patent owner did not dispute that the error was clerical. *Id.* at 4. Moreover, the correction involved an omitted chapter from a book, not the replacement of an entire exhibit with a higher-resolution version that included details not discernible in the originally submitted exhibit. Here, Petitioner withheld the higher-resolution version of the 1946 Cyclopedia, and its error affects not just Petitioner’s grounds for two dependent claims, but Petitioner’s grounds for the entirety of the ’892 Patent and claims 35-44 of the ’515 Patent.

Additionally, in *Apple*, the Board permitted supplemental briefing to address the new chapter. *Id.* at 6. Petitioner makes no such request here, presumably because discretionary denial has been decided and the current schedule does not allow for additional briefing prior to institution. This further underscores the prejudice and distinguishes *Apple* from the present case.

Petitioner offers no explanation regarding the impact of the higher-resolution version on Dr. Ahmadian’s opinions. It is unclear whether Dr. Ahmadian had access

to the higher-resolution version. Patent Owner was denied the opportunity to address these issues in its POPRs.

Likewise, Petitioner fails to explain whether its librarian expert, Dr. Sylvia D. Hall-Ellis, reviewed the higher-resolution version or the low-quality version. Patent Owner was similarly denied the opportunity to respond to Dr. Hall-Ellis' opinions in its POPRs.

IV. Conclusion

For the foregoing reasons, Petitioner's motion 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
OPPOSITION TO MOTION TO CORRECT EXHIBIT 1004 PURSUANT TO
37 CFR § 42.104(c)** was served electronically in its entirety on the date noted below
via electronic mail to the following attorneys of record:

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