

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)

PATENT OWNER'S PRELIMINARY SUR-REPLY

On behalf of National Steel Car Limited

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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).

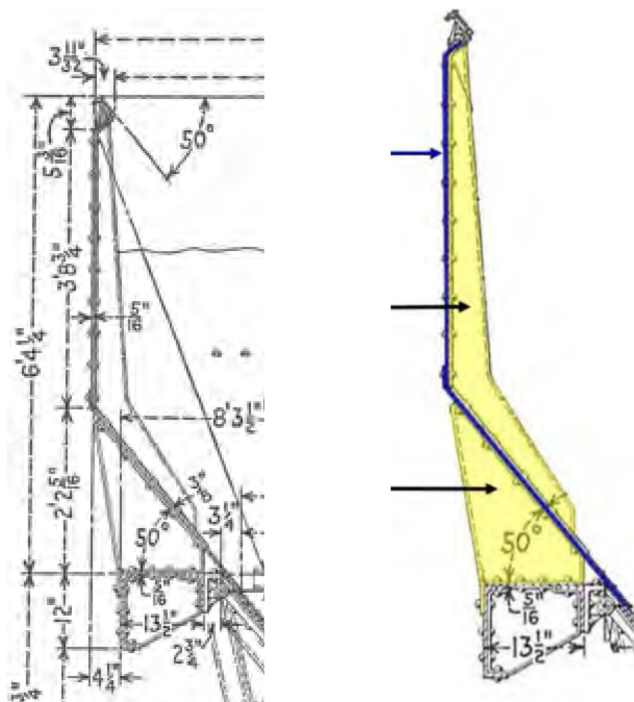
First, Petitioner seeks to replace Exhibit 1004 with a new version containing additional detail absent from the originally filed exhibit. Contrary to Petitioner’s characterization of this as a clerical error (Paper 17), the proposed substitution introduces substantive changes that prejudice both the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

Second, Petitioner’s expert declaration is deficient because 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. Petitioner’s Arguments Rely on Material Absent from the Record Version of Exhibit 1004

Petitioner’s Reply attempts to justify reliance on images in the Petition and Dr. Ahmadian’s declaration that contain visual details not present in the filed version of Exhibit 1004. For example, the geometry of the lower portion of the sidewall is

more discernable in the Petition and Dr. Ahmadian’s declaration than in Exhibit 1004:



Ex. 1004 at 294; Petition at 106; Dr. Ahmadian Decl. ¶¶ 53, 57, 137, 139.

This discrepancy is unsurprising, as Petitioner admits to using a higher-resolution version of the 1946 Cyclopedia that was not filed as Exhibit 1004. There is no dispute that the exhibit of record lacks the high-resolution detail relied upon 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

¹ Contrary to Petitioner’s assertion, Patent Owner did not accuse Petitioner of fabricating evidence. Rather, Patent Owner stated that Petitioner and Dr. Ahmadian

patents and printed publications, but cannot substitute for disclosure in the prior art 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 the 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.

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

Dr. Ahmadian’s declaration is deficient because he fails to analyze the majority of claim elements in the ’515 Patent when assessing obviousness. Petitioner cites only the “Applicable Legal Standards” section (Exhibit 1003 at 6) to suggest that Dr. Ahmadian considered the claims “as a whole,” but this is insufficient.

offered their interpretation of the evidence, appropriately characterized as attorney and expert argument. *See* Paper 12 at 2.

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.

IV. Conclusion

For the foregoing reasons, institution should be denied.

Respectfully Submitted,

Date: October 17, 2025

/Safet Metjahic/

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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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