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On behalf of **FreightCar America, Inc.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FREIGHTCAR AMERICA, INC.,  
Petitioner,

v.

NATIONAL STEEL CAR LIMITED,  
Patent Owner.

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Case IPR2024-01047

Case IPR2024-01048

Patent 8,132,515

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**PETITIONER'S NOTICE OF RANKING AND EXPLAINING MATERIAL  
DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW  
OF U.S. PATENT NO. 8,132,515**

FreightCar America v. National Steel Car  
IPR Petition – U.S. Patent No. 8,132,515

Petitioner FreightCar America, Inc. filed two concurrent *inter partes* review (“IPR”) petitions against U.S. Patent No. 8,132,515 (“the ’515 Patent”). The following chart identifies the grounds asserted in both petitions.

<b>IPR-2025-01047</b>		
<b>GROUND</b>	<b>CLAIMS</b>	<b>OBVIOUSNESS REFERENCES</b>
<b>1</b>	1–2	<b>Hart</b> and 1906 Cyclopedia
<b>2</b>	3	<b>Hart</b> , 1906 Cyclopedia, and Schuller
<b>3</b>	4	<b>Hart</b> , 1906 Cyclopedia, Schuller and Karig
<b>4</b>	5–6	<b>Hart</b> , 1906 Cyclopedia, and Campbell ’652
<b>5</b>	7–16, 20–23, 24–28, 30–31	<b>Hart</b> , 1906 Cyclopedia, and Wong
<b>6</b>	17–19	<b>Hart</b> , 1906 Cyclopedia, Wong and Campbell ’051
<b>7</b>	21–22, 29	<b>Hart</b> , 1906 Cyclopedia, Wong and Schuller
<b>8</b>	32–34	<b>Lindström</b> , Wong, Ratcliffe and Hart
<b>9</b>	35–44	<b>Lindström</b> , Wong, Ratcliffe, Hart and 1946 Cyclopedia

<b>IPR-2025-01048</b>		
<b>GROUND</b>	<b>CLAIMS</b>	<b>OBVIOUSNESS REFERENCES</b>
<b>1</b>	1, 2, 5, 6, 20, 23	<b>1946 Cyclopedia</b> and Coates or 1922 Cyclopedia
<b>2</b>	3 and 21–22	<b>1946 Cyclopedia</b> , Coates or 1922 Cyclopedia, and Schuller

<b>3</b>	4	<b>1946 Cyclopedia</b> , Coates or 1922 Cyclopedia, Schuller, and Karig
<b>4</b>	7–16, 18–19, 24–27, 30–35, 38–42	<b>1946 Cyclopedia</b> and Wong
<b>5</b>	17	<b>1946 Cyclopedia</b> , Wong, and Campbell '051
<b>6</b>	28	<b>1946 Cyclopedia</b> , Wong, and Coates or the 1922 Cyclopedia
<b>7</b>	29	<b>1946 Cyclopedia</b> , Wong, Coates or 1922 Cyclopedia, and Schuller
<b>8</b>	36–37	<b>1946 Cyclopedia</b> , Wong, and Schuller
<b>9</b>	43–44	<b>1946 Cyclopedia</b> , Wong, and Lindstrom

## I. Differences Between the Petitions

	<b><u>IPR 2025-01047</u></b>	<b><u>IPR 2025-01048</u></b>
Primary Reference	Hart (claims 1–31) Lindström (claims 32–44)	1946 Cyclopedia (claims 1–44)
Date of primary references	Hart (1911) Lindström (1919)	1946 Cyclopedia (1946)
Total references in grounds	10	9
Number of claims addressed in two main grounds	2 (Ground 1) 21 (Ground 5)	6 (Ground 1) 27 (Ground 4)

The differences between the petitions noted in the chart above are not intended to be exhaustive.

## **II. Both Petitions Demonstrate That The Claims Are Unpatentable, In Materially Different Ways**

Both petitions present compelling evidence that every claim of the '515 patent is unpatentable. However, because the '515 patent's lengthy claim set includes different variants of the claimed inventions, two petitions are warranted to present different arguments relying on materially different primary references to present the strongest unpatentability argument for each variant of the claimed invention. The differences between the two petitions arise from two sources: (1) the different *dates* of the primary references; and (2) the different *roles* played by the primary references in the respective petitions.

The first-ranked petition relies on the **Hart** reference from 1911 as its primary reference. Hart discloses the allegedly novel aspect on which the patent owner relied to secure allowance of the patent: a machinery space below the hopper car's slope sheet that is "free of primary structure." Hart demonstrates that this is not new. Hart dates to the dawn of metal freight cars, and as a result it lacks some of the claimed features that became standard hopper-car features decades before the patent owner filed for the '515 patent in 2009. Thus, the first-ranked petition also relies on secondary references listed in the Grounds table above, which disclose certain later-developed hopper-car features, along with all other claimed features.

The second-ranked petition relies on the **1946 Cyclopedia** as its primary reference. The 1946 Cyclopedia demonstrates that the numerous standard hopper-

car features recited in the '515 patent's lengthy claims were not novel, even collectively. This reference was published decades after Hart and therefore discloses certain claimed hopper-car features that became commonplace after 1911. The second-ranked petition relies on the secondary references listed in the Grounds table above, which disclose a machinery space below the hopper car's slope sheet that is "free of primary structure," along with all other claimed features.

Accordingly, while both petitions prove all claims unpatentable, the petitions rely on materially different prior art to present the strongest unpatentability argument for each variant of the claimed invention. In view of the compelling and non-cumulative arguments presented in each petition, Petitioner respectfully requests that the Board should exercise its discretion to institute both petitions.

### **III. The Patent Owner Has Asserted A Large Number of Claims In Litigation**

In *National Steel Car Limited v. FreightCar America, Inc. et al.*, No. 1:24-cv-00594 (D. Del.), the patent owner has asserted a large number of claims. In particular, claims 1 and 3–44 have all been asserted, of which 1, 7, 18, 20, 24, and 32 are independent. Thus, a total of 43 claims, and 6 independent claims have been asserted. Because of the large number of asserted claims—and the fact that the claims themselves are more than 4,000 words long—it is impractical for Petitioner to present both its Hart grounds and its 1946 Cyclopedia grounds in a single petition.

Accordingly, the Board should exercise its discretion to institute both petitions to have the benefit of both the Hart and 1946 Cyclopedia grounds.

#### **IV. Ranking of Petitions**

Petitioner requests that the Board institute both petitions and consider them in the following order:

<b><u>Rank</u></b>	<b><u>Petition</u></b>	<b><u>Primary References</u></b>	<b><u>Claims</u></b>
1	IPR2025-01047	<b>Hart</b> (claims 1–31) <b>Lindström</b> (claims 32–44)	1–44
2	IPR2025-01048	<b>1946 Cyclopedia</b>	1–44

Dated: May 27, 2025

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on the date below a copy of this Notice Ranking Petitions was sent by FedEx to the Patent Owner at the correspondence address of record for the subject patent as follows:

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A courtesy copy has been sent by email on this day to Patent Owner's counsel of record in the matter identified in Section I.B of the Petition as follows:

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