

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

NATIONAL STEEL CAR LIMITED,

Plaintiff,

v.

FREIGHTCAR AMERICA, INC.,  
FREIGHTCAR NORTH AMERICA, LLC,  
JAC OPERATIONS INC., and FCA-  
FASEMEX, LLC

Defendant.

C.A. No 1:24-cv-00594-JLH-CJB

**FREIGHTCAR AMERICA, INC.'S  
INITIAL INVALIDITY CONTENTIONS**

Pursuant to Paragraph 4(d) of the Delaware Default Standard for Discovery, Including Discovery of Electronically Stored Information (“ESI”) (the “Default Standard”) and Paragraph 6(e) of the Scheduling Order (D.I. 38) entered in the above-captioned action, Defendant/Counterclaimant FreightCar America, Inc. (“FreightCar America”) hereby provides the following Initial Invalidity Contentions to Plaintiff/Counterdefendant National Steel Car Limited (“Plaintiff” or “NSC”) with respect to the claims of U.S. Patent Nos. 8,132,515 (“the ’515 patent”) and 8,166,892 (“the ’892 patent”) (together with any additional patent Plaintiff may assert in this case, the “asserted patents”). FreightCar America is contemporaneously producing with this submission the references required under Paragraph 4(d) of the Default Standard.

### **I. GENERAL STATEMENTS**

FreightCar America contends that all claims asserted against it are invalid under at least 35 U.S.C. §§ 102, 103, and/or 112 as described herein. FreightCar America provides exemplary prior-art citations and statements explaining the invalidity of the asserted claims in the following disclosure and claim charts, which are incorporated herein by reference. FreightCar America also provides exemplary combinations of prior art and the motivation to combine such references for purposes of FreightCar America’s obviousness defenses. FreightCar America’s invalidity positions in these contentions may be in the alternative and do not constitute any concession or admission by FreightCar America for purposes of invalidity, enforceability, claim construction, and/or infringement. *See, e.g., Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1366 (Fed. Cir. 2000); *Water Techs. Corp. v. Calco, Ltd.*, 850 F.2d 660, 665 (Fed. Cir. 1988).

FreightCar America reserves the right to rely on any combination or combinations of the prior art references cited or discussed in these disclosures and the development of additional arguments regarding motivation to combine and expectations of success as fact and expert discovery proceed. FreightCar America also reserves the right to rely on any prior art cited or

discussed in the prosecution histories of the '515 and '892 patents as well as any related patents and applications, and any prior art produced by Plaintiff in this action, as a basis for contending that the claims are invalid. FreightCar America further identifies as prior art upon which it may rely all statements in the specifications of the '515 and '892 patents admitted as being prior art to the claims of the '515 or '892 patents, as well as those references identified during prosecution of the '515 and '892 patents.

**A. Claim Construction**

Plaintiff has not yet provided its claim construction positions, and the Court has not yet construed the Asserted Claims. The claims of the asserted patents are invalid under any reasonable construction. FreightCar America reserves all rights to further supplement or modify the positions and information in these Initial Invalidity Contentions, including without limitation, the prior art and grounds of invalidity set forth herein regarding any claim at issue in this litigation, after the Court has construed any claim and to the full extent consistent with the Federal Rules of Civil Procedure, the Local Rules, the Default Standard, and any other applicable rule or order.

**B. Ongoing Discovery**

These Initial Invalidity Contentions are necessarily preliminary and may require subsequent amendment, alteration, or supplementation. Discovery in this case is in its early stages and FreightCar America's investigation, including its search for prior art, is ongoing. FreightCar America reserves the right to supplement or alter the positions taken and information disclosed in these Initial Invalidity Contentions including, without limitation, the prior art and grounds of invalidity set forth herein concerning any asserted claim and/or patent, to take into account information or defenses that may come to light as a result of these continuing efforts. FreightCar America reserves the right to supplement or amend these Initial Invalidity Contentions to the full extent consistent with the Federal Rules of Civil Procedure, the Local Rules, the Default Standard,

and any other applicable rule or order as additional information becomes available through discovery or otherwise.

Finally, the information set forth below is provided without in any manner waiving: (1) the right to object to the use of any information or document for any purpose, in this action or any other actions, on the grounds of privilege, relevance, materiality, or any other appropriate grounds; (2) the right to object to any request involving or relating to the subject matter of the statements herein; or (3) the right to revise, correct, supplement or clarify any of the statements provided below at any time.

## **II. IDENTIFICATION OF PRIOR ART**

It should be recognized that a person of ordinary skill in the art (“POSA” or “POSITA”) would generally read a prior art reference as a whole and in the context of other publications, literature, and general knowledge in the field. To understand and interpret any specific statement or disclosure in a prior art reference, a POSA would rely upon other information including other publications and general knowledge relevant to the subject matter of the ’515 and/or ’892 patents. FreightCar America therefore reserves the right to rely upon other unidentified portions of the prior art references, other publications, other relevant knowledge and expert testimony to provide context and to aid understanding and interpretation of any identified portions. FreightCar America also reserves the right to rely upon other portions of the prior art references, other publications, and the testimony of experts to establish that the alleged inventions were inherently disclosed in the prior art and/or would have been obvious to a POSA, including based on modifying or combining certain cited references.

FreightCar America hereby incorporates by reference any rejections made by the Patent and Trademark Office (“PTO”) during the prosecution of the applications leading to any asserted claim. FreightCar America reserves the right to assert any art cited in the prosecution histories of

any asserted patent as a basis for contending that any claim at issue in this litigation is invalid. FreightCar America further identifies as prior art upon which it may rely those references identified in Information Disclosure Statements during the prosecution of any asserted patent. FreightCar America also reserves the right to rely upon any admissions relating to prior art in any asserted patent or its prosecution history and those of related applications, such as those included in any priority claim or those that claim priority to an asserted patent. In addition, FreightCar America reserves the right to rely on any and all prior art and any and all evidence of the relevant state of the art produced by Plaintiff. FreightCar America incorporates in their entirety the proceedings in any *inter partes* reviews or other post-grant proceedings regarding an asserted patent (“PTAB proceedings”), including the petitions, expert declarations, and all other evidence and arguments submitted in each case.

FreightCar America further incorporates by reference, in full, all references cited in the following prior art references and their prosecution histories, where applicable. The citations provided are representative of the references and are not exhaustive. To the extent similar claim limitations occur in one or more claims, the disclosure below should be read to apply to all similar claim limitations. Moreover, many of the references discussed herein are representative of additional prior art references in the relevant field. Thus, it should also be recognized that the various concepts may be discussed in numerous references and that citation to one particular reference does not exclude later citation to other references discussing the same concept.

FreightCar America reserves the right to rely upon any related patents and patent applications, foreign patent counterparts and foreign patent applications of U.S. patents or applications identified in these Initial Invalidity Contentions, U.S. and foreign counterparts of foreign patents or foreign patent applications identified in these Initial Invalidity Contentions, or

U.S. and foreign patents or applications corresponding to articles and publications identified in these Initial Invalidity Contentions. For prior art patents and publications identified in these Initial Invalidity Contentions, FreightCar America reserves the right to rely on inherency, public use, offer for sale, and/or sale of the products described in those prior art patents or publications.

Subject to the above, FreightCar America identifies the following prior art references now known to it that anticipates at least one of the asserted claims under pre-AIA 35 U.S.C. §§ 102(a), (b), (e), and/or (g) and/or renders obvious at least one of the asserted claims under 35 U.S.C. § 103. The following patents, publications, and systems are prior art under at least pre-AIA 35 U.S.C. §§ 102(a), (b), (e), and/or (g). Defendants identify these references in addition to all the prior-art references appearing on the face of the Asserted Patents or in their file histories. Defendants may also rely on any of the identified references below to establish the state of the art and/or what was within the knowledge of a person of ordinary skill in the art.

**A. Definitions**

These Contentions, including Appendix A and Appendix B, may use the following definitions.

<b>Term</b>	<b>Definition</b>
Bethlehem Steel B.C.I.M. Ore Car (1954)	The physical 50 Ton Ore Car(s) that Bethlehem Steel produced corresponding to at least drawing nos. E-37211 and E-37224 and order no. DF-201.
1955 Bethlehem Steel I.C.O.M.I. Ore Car (1955)	The physical 70 Ton Ore Car(s) that Bethlehem Steel produced corresponding to at least drawing no. E-38399 and order no. DF-216.
1965 Bethlehem Steel I.C.O.M.I. Ore Car (1965)	The physical 70 Ton Ore Car(s) that Bethlehem Steel produced corresponding to at least drawing no. E-37355 and order nos. 204, 3400-415, 3400-250.

<b>Term</b>	<b>Definition</b>
Bethlehem Steel L.S.&I. Ore Car (1965)	The physical 85 Ton Ore Car(s) that Bethlehem Steel produced corresponding to at least drawing no. E-46070 and order no. 3400-444.
1909 Cyclopedia	The 1909 Car Builders' Dictionary
1912 Cyclopedia	The 1912 Car Builders' Dictionary
1922 Cyclopedia	The 1922 Car Builders' Cyclopedia
1940 Cyclopedia	The 1940 Car Builders' Cyclopedia
1946 Cyclopedia	The 1946 Car Builders' Cyclopedia
1953 Cyclopedia	The 1953 Car Builders' Cyclopedia
Enterprise 75-Ton Ore Car	The physical railcar(s) and publication(s) thereof shown at 1946 Cyclopedia Figs. 2.668 and 2.682 and 1953 Cyclopedia pages 238-39.
Pressed Steel DM&IR Ore Car	The physical railcar(s) and publication(s) thereof shown at 1946 Cyclopedia Figs. 2.665 and 2.667 and 1953 Cyclopedia page 240.
Cambria Steel Ore Car	The physical railcar(s) and publication(s) thereof shown at 1909 Car Builders' Dictionary Figs. 69 on page 19.
NSC 50-Ton Ore Car	The physical railcar(s) and publication(s) thereof shown at 1946 Cyclopedia Figs. 2.670 & 2.673 on pages 294 & 295.
M&SP Ore Car	The physical railcar(s) and publication(s) thereof shown at 1906 Car Builders' Dictionary Figs. 430-434 on page 118.
Kilbourne & Jacobs Hopper Car	The physical railcar(s) and publication(s) thereof shown at 1912 Car Builders' Dictionary Fig. 24 on page 208.
Gregg Co. Hopper Car	The physical railcar(s) and publication(s) thereof shown at 1922 Car Builders' Cyclopedia Fig. 2904 on page 1113.
Enterprise 75-Ton Ore Car	The physical railcar(s) and publication(s) thereof shown at 1946 Cyclopedia Figs. 2.668 and 2.682 and 1953 Cyclopedia pages 238-39.
Lindstrom I Patent (1915)	U.S. 1,124,479
Lindstrom II Patent (1919)	U.S. 1,321,928
Lindstrom III Patent (1911)	U.S. 1,002,856
Gilpin Patent (1934)	U.S. 2,030,748
Hart Patent (1911)	U.S. 992,192
Beaver Patent (1967)	U.S. 3,315,616
Campbell Patent (1935)	U.S. 1,999,652
Charles Patent (1966)	U.S. 3,240,168
Coulborn Patent (1989)	U.S. 4,875,417
Fischer Patent (1986)	U.S. 4,601,244

<b>Term</b>	<b>Definition</b>
King Patent (1904)	U.S. 774,967
Schuller Patent (1973)	U.S. 3,710,729
Stark Patent (1971)	U.S. 3,605,635
Summa Patent (1913)	U.S. 1,066,544
Sutter Patent (1970)	U.S. 3,509,827
Wong Patent (1990)	U.S. 4,941,411
BP Chemicals Hopper Car	The physical railcar(s) and publication(s) thereof shown at Working Wagons A Pictorial Review of Freight Stock on the B.R. System Volume 3. 1980-1984 page 62.
Tarmac PGA Stone Wagon	The physical railcar(s) and publication(s) thereof shown in Tarmac PGA Stone Wagons.
British Steel Hopper Car	The physical railcar(s) and publication(s) thereof shown at Private Owner Wagons in Colour For the Modeller and Historian on page 27.
L&Y Wagon	The physical railcar(s) and publication(s) thereof shown at Lancashire & Yorkshire Wagons Volume Two on the cover.
BR Shildon Hopper Car	The physical railcar(s) and publication(s) thereof shown at Wagons of the Final Years of British Railways A Pictorial Study of the 1962-1968 Period on page 39.
Marcroft Hopper Car (1993)	The physical railcar(s) and publication(s) thereof shown at Wagon Recognition on page 55.
Hart Patent (1911)	U.S. 992,192
Tomlinson Iron Ore Wagon	The physical railcar(s) and publication(s) thereof showing railcars of the type of bottom discharge Tomlinson Steel WA built ore wagons, available at the URL in the footnote. <sup>1</sup>
Steetley Hopper Car	The physical railcar(s) and publication(s) thereof shown at Private Owner Wagons (Volume 1) on page 27.
Comeng Mineral Hopper Wagon	The physical railcar(s) and publication(s) thereof shown at RT Railway Transportation February 1967.

## **B. Prior Art Patents and Published Patent Applications**

<b>Patent / Publication No.</b>	<b>Country / Jurisdiction</b>	<b>Issue / Publication Date</b>
3,315,616	U.S.	4/25/1967

<sup>1</sup> [https://pilbararailways.com.au/gallery/displayimage.php?album=224&pid=14630#top\\_display\\_media](https://pilbararailways.com.au/gallery/displayimage.php?album=224&pid=14630#top_display_media)

<b>Patent / Publication No.</b>	<b>Country / Jurisdiction</b>	<b>Issue / Publication Date</b>
1,999,652	U.S.	4/30/1935
3,240,168	U.S.	3/15/1966
4,875,417	U.S.	10/24/1989
4,601,244	U.S.	7/22/1986
2,030,748	U.S.	2/11/1936
992,192	U.S.	5/16/1911
774,967	U.S.	11/15/1904
1,124,479	U.S.	1/12/1915
1,002,856	U.S.	9/12/1911
1,321,928	U.S.	11/18/1919
3,710,729	U.S.	1/16/1973
3,605,635	U.S.	9/20/1971
1,066,544	U.S.	7/8/1913
3,509,827	U.S.	5/5/1970
4,941,411	U.S.	7/17/1990

**C. Prior Art Publications**

<b>Title</b>	<b>Publication Date</b>	<b>Author / Editor</b>	<b>Publisher</b>
The Master Car Builders' Association Car Builders' Dictionary 1906 Edition	1906	Rodney Hitt	The Railroad Gazette
The Master Car Builders' Association Car Builders' Dictionary 1909 Edition	1909	Francis E. Lister	The Railway Age Gazette
Car Builders' Dictionary Seventh Edition	1912	Roy V. Wright	Simmons-Boardman Publishing Company
Car Builders' Encyclopedia of American Practice Tenth Edition	1922	Roy V. Wright	Simmons-Boardman Publishing Company
Car Builders' Encyclopedia of American Practice Fifteenth Edition	1940	Roy V. Wright	Simmons-Boardman Publishing Corporation

<b>Title</b>	<b>Publication Date</b>	<b>Author / Editor</b>	<b>Publisher</b>
1946 Car Builders' Cyclopedia of American Practice	1946	Roy V. Wright	Simmons-Boardman Publishing Corporation
1953 Car Builders' Cyclopedia of American Practice	1953	C. B. Peck	Simmons-Boardman Publishing Corporation
1966 Car and Locomotive Cyclopedia of American Practice	1966	C. L. Combes	Simmons-Boardman Publishing Corporation
The Car and Locomotive Cyclopedia of American Practices Sixth Edition	1997	William W. Kratville	Simmons-Boardman Books, Inc.
Coal Cars The First Three Hundred Years	2007	Martin Robert Karig III	University of Scranton Press
Lancashire & Yorkshire Wagons Volume Two	2006	Noel Coates	Wild Swan Publications Ltd.
Tarmac PGA Stone Wagons	2006	P. R. Harrison	N/A [web page]
Wagons of the Final Years of British Railways A Pictorial Study of the 1962-1968 Period	2008	David Larkin	Kestrel Railway Books
Private Owner Wagons (Volume 1)	1989	Andrew Marshall	Metro Enterprises Ltd.
Working Wagons A Pictorial Review of Freight Stock on the B.R. System Volume 3. 1980-1984	2001	David Larkin	Santona Publications
Private Owner Wagons in Colour For the Modeller and Historian	2009	David Ratcliffe	Ian Allan Publishing
RT Railway Transportation	February, 1967	N/A	N/A
Wagon Recognition	2008	Martin Buck & Mark Rawlinson	Freightmaster Publishing

FreightCar America additionally identifies and relies on each of the additional patent or publication references that describe or are otherwise related to the prior art systems identified herein.

**D. Physical Prior Art**

<b>Prior Art System</b>	<b>Date of Offer for Sale / Information Became Known</b>
Enterprise 75-Ton Ore Car	1946 or earlier
Pressed Steel DM&IR Ore Car	1946 or earlier
Cambria Steel Ore Car	1909 or earlier
NSC 50-Ton Ore Car	1946 or earlier
Bethlehem Steel B.C.I.M. Ore Car (1954)	1954 or earlier
1955 Bethlehem Steel I.C.O.M.I. Ore Car (1955)	1955 or earlier
1965 Bethlehem Steel I.C.O.M.I. Ore Car (1965)	1965 or earlier
Bethlehem Steel L.S.&I. Ore Car (1965)	1965 or earlier
M&SP Ore Car	1906 or earlier
Kilbourne & Jacobs Hopper Car	1912 or earlier
Gregg Co. Hopper Car	1922 or earlier
Enterprise 75-Ton Ore Car	1946 or earlier
BP Chemicals Hopper Car	1984 or earlier
Tarmac PGA Stone Wagon	2004 or earlier
British Steel Hopper Car	1989 or earlier
L&Y Wagon	2006 or earlier
BR Shildon Hopper Car	1968 or earlier
Marcroft Hopper Car (1993)	2008 or earlier
Tomlinson Iron Ore Wagon	2004 or earlier
Steetley Hopper Car	1989 or earlier
Comeng Mineral Hopper Wagon	1967 or earlier

**III. ANTICIPATION AND OBVIOUSNESS CLAIM CHARTS**

The Asserted Claims are anticipated by and/or would have been obvious in view of the prior art identified herein. Appendices A-B to these contentions set forth a detailed basis for FreightCar America’s contentions that each of the Asserted Claims are anticipated and/or obvious. As shown by these appendices, the identified prior art individually or in combination discloses every limitation of the Asserted Claims.

In view of the prior art disclosures set forth in the appendices, the state of the prior art, and the knowledge of a POSA, each Asserted Claim would have been anticipated and/or obvious in view of at least the prior art combinations set forth below for each claim. The specific combinations identified herein, however, are merely exemplary and any of the identified prior-art references could be used as a primary and/or secondary reference to reach the claimed subject matter. Indeed, the identified references all contribute to the scope and content of the prior art, which is the appropriate analysis under *Graham* and *KSR*, and which does not require FreightCar America to identify which references may be primary and/or secondary.

Persons of ordinary skill in the art at the time of filing the applications for the patents-in-suit knew to read references as a whole and in the context of other publications, literature, and the general knowledge in the field. FreightCar America may rely on all such information as well as other portions of the prior art references cited in these Initial Invalidity Contentions, other references and documents, and expert testimony, to establish that a limitation is inherent; to establish enablement of a prior art reference; to provide context and as aids to understanding and interpreting the listed references; and/or to establish that it would have been obvious for a person of ordinary skill in the art to modify or combine any of the cited references.

#### **IV. MOTIVATION TO COMBINE PRIOR ART REFERENCES**

Any required motivation to combine the prior art references discussed in these Initial Invalidity Contentions is found, explicitly or implicitly, in one or more of the following:

- A person of ordinary skill in the art's own knowledge or common sense;
- The prior art references themselves;
- The subject matter acknowledged as prior art in the '515 or '892 patents;
- The interrelated teachings of the multiple prior art references identified herein;

- The nature of the problem purportedly solved by the '515 or '892 patents;
- The ability to implement the alleged invention as a predictable variation of the prior art;
- Improvements in similar products;
- Any needs or problems known in the field and purportedly addressed by the '515 or '892 patents;
- The number of predictable solutions to the problem(s) purportedly addressed by the '515 or '892 patents;
- Reasonable expectations of a person having ordinary skill in the art that known prior art elements would maintain their respective properties or functions when they were combined;
- Express or implied reasons known by a person having ordinary skill in the art to combine known prior art elements and knowledge of how to combine those known prior art elements;
- Expectation that known prior art elements were capable of being combined, as well as the expectation that the combinations would have worked for their intended purpose;
- Express and/or implied teachings from the prior art as to why a person of ordinary skill would have combined known elements; and
- It is obvious to try a combination of prior art elements where the options to solve a known problem were finite and predictable.

The above noted motivations are incorporated by reference in all obviousness combinations and claim charts.

## **V. ADDITIONAL INVALIDITY GROUNDS**

- The phrase “primary structure” renders Claims 1, 20 and 28 of the ’515 Patent (and their dependent claims) indefinite under 35 U.S.C. § 112.
- The phrase “free of any primary structure” renders Claims 1, 20 and 28 of the ’515 Patent (and their dependent claims) indefinite in violation of 35 U.S.C. § 112.
- The phrase “shear plate extending . . . cross-wise from side to side of said hopper car,” in view of the claim construction implicit in NSC’s infringement contentions, renders Claims 1, 7, 13, 18, 20, 24, and 32 28 of the ’515 Patent (and their dependent claims) indefinite and/or lacking in written description support in violation of 35 U.S.C. § 112.
- Claim 2 of the ’515 Patent is invalid for failing to narrow the scope of Claim 1, the independent claim from which Claim 2 depends.
- The phrase “said transition portion is located a distance above said first side sill that is in the range of  $\frac{1}{4}$  to  $\frac{2}{3}$  L” and similar phrases render Claim 5 of the ’892 Patent and Claim 44 of the ’515 Patent indefinite and/or lacking in written description support in violation of 35 U.S.C. § 112.
- The phrase “a continuous section between said first and second regions” and similar phrases render Claims 1 and 2 of the ’892 Patent and Claim 40 of the ’515 Patent ((and their dependent claims) indefinite and/or lacking in written description support in violation of 35 U.S.C. § 112.

## **VI. DOCUMENT PRODUCTION**

FreightCar America is producing or making available, or has already produced or made available for inspection, the related invalidating references. FreightCar America reserves the right to identify and produce additional documents.

April 10, 2025

PHILLIPS MCLAUGHLIN & HALL, P.A.

Of Counsel:

Justin J. Gillett (*Pro Hac Vice*)  
Sean M. Murray (*Pro Hac Vice*)  
Knobbe, Martens, Olson & Bear, LLP  
2040 Main Street, 14th Floor  
Irvine, CA 92614  
(949) 760-0404 Telephone  
(949) 760-9502 Facsimile  
justin.gillett@knobbe.com  
sean.murray@knobbe.com

Brian Horne (*Pro Hac Vice*)  
Knobbe, Martens, Olson & Bear, LLP  
1925 Century Park East, Suite 600  
Los Angeles, CA 90067  
(310) 551-3450 Telephone  
(310) 551-3458 Facsimile  
brian.horne@knobbe.com

By: /s/ David A. Bilson

John C. Phillips, Jr. (No. 110)  
David A. Bilson (No. 4986)  
1200 North Broom Street  
Wilmington, DE 19806  
(302) 655-4200 Telephone  
(302) 655-4210 Fax  
jcp@pmhdelaw.com  
dab@pmhdelaw.com

*Counsel for Defendant*

**CERTIFICATE OF SERVICE**

I, David A. Bilson, Esquire, hereby certify that on April 10, 2025, a true and correct copy of the foregoing document was served on the following counsel of record via electronic means:

John W. Shaw  
Andrew E. Russell  
SHAW KELLER LLP  
I.M. Pei Building  
1105 North Market Street, 12th Floor  
Wilmington, DE 19801  
jshaw@shawkeller.com  
arussell@shawkeller.com

Safet Metjahic  
Robert D. Keeler  
ICE MILLER LLP  
1500 Broadway, Suite 2900  
New York, NY 10036  
Safet.Metiahic@icemiller.com  
Robert.Keeler@icemiller.com

Kenneth Sheehan  
ICE MILLER LLP  
200 Massachusetts Ave NW, Suite 400  
Washington, DC 20001  
Ken.sheehan@icemiller.com

*/s/ David A. Bilson*

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David A. Bilson (#4986)