

Filed October 8, 2025

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

By: Philip Nelson (Reg. No. 62,676)
Ted M. Cannon (Reg. No. 55,036)
Justin Gillett (Reg. No. 71,099)
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502
FCAIPR-515-048@knobbe.com
FCAIPR-515-047@knobbe.com
FCAIPR-892@knobbe.com

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)

IPR2025-01048 (Patent 8,132,515)

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

TABLE OF CONTENTS

	Page No.
I. INTRODUCTION	1
II. THE IMAGES IN THE PETITIONS AND DECLARATIONS ARE ACCURATE REPRODUCTIONS OF THE PRIOR ART.....	2
III. THE MISTAKE IN PREPARING EX1004 WAS A CLERICAL ERROR THAT MAY BE CORRECTED UNDER § 42.104(C).....	3
IV. CONCLUSION.....	5

TABLE OF AUTHORITIES

Page No(s).

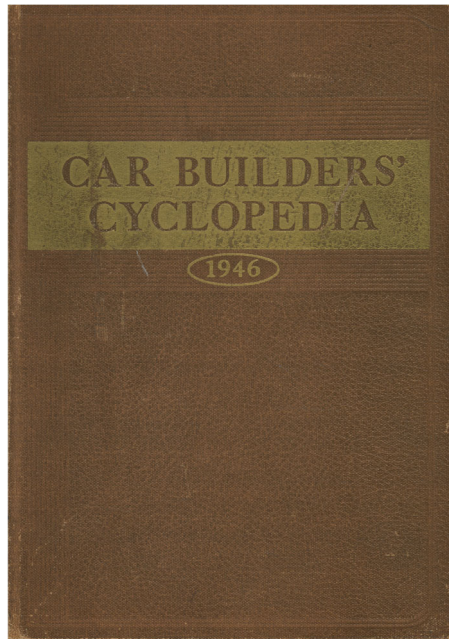
<i>Apple Inc. et al. v. Memory Integrity, LLC,</i> IPR2015-00163, Paper 16 (PTAB April 9, 2015)	3, 4
<i>Ariosa Diagnostics v. Isis Innovation Ltd.,</i> IPR2012-00022, Paper 46 (PTAB July 22, 2013)	3
<i>Everi Payments Inc. v. Sightline Payments LLC,</i> IPR2022-00614, Paper 9 (PTAB May 27, 2022)	3

OTHER AUTHORITIES

37 CFR § 42.104	2, 3, 4, 6
-----------------------	------------

I. INTRODUCTION

The '046 and '048 petitions rely on portions of a 1444-page book containing photographs and technical drawings of rail cars from the 1940s: the “1946 Cyclopedia.” Petitioner electronically submitted relevant excerpts of this prior-art publication as EX1004.



1946 Car Builders' Cyclopedia Of American Practice

Definitions and Typical Illustrations of Railroad and Industrial Cars, Their Parts and Equipment; Cars Built in America for Export to Foreign Countries; Descriptions and Illustrations of Shops and Equipment Employed in Car Construction and Repair

Seventeenth Edition—1946

First Edition—"Car Builders' Dictionary"—1879

Compiled and Edited

for the
Association of American Railroads—Mechanical Division
(Formerly Master Car Builders' Association)

Editors

EDY V. WRIGHT
Managing Editor Railway Age and
Editor Railway Mechanical Engineer

MANAGING EDITOR

ROBERT C. ANGLER
Managing Editor Locomotive Cyclopedic and
Associate Editor Railway Mechanical Engineer

EDITORS, SHOP SECTION

H. C. WILCOX

ASSOCIATE EDITOR, SHOP SECTION

C. L. COMBES

ASSOCIATE EDITORS

H. P. FOSTER

W. A. LUCAS

CONSULTING EDITORS

C. B. PECK

A. G. OEHLER

E. L. WOODWARD

A.A.R. ADVISORY COMMITTEE

J. R. JARVIS, Mechanical Engineer, A.A.R. Mechanical Division

T. P. BROWN, Engineer Car Construction, Chesapeake & Ohio Railway

E. P. MOSS, Engineer Rolling Stock, New York Central System

Published and Printed in U. S. A.

By
Simmons-Boardman Publishing Corporation

30 Church St., New York 7, N. Y.

Chicago, Ill. Cleveland, Ohio Washington, D. C. Seattle, Wash.
100 West Adams St. Terminal Tower 1901 Standard Plaza Bldg. 100 Third St.
San Francisco, Calif. San Angeles 15, Calif. San Diego, Calif.
300 Montgomery St. 300 West 10th St. 200 Water Ave.

EX1004 at 1–2. Those excerpts included drawings and a photo of a prior-art NSC ore car. *Id.* at 27–28. EX1004 was filed with the petitions on May 27, 2025.

In its POPRs filed on September 18, 2025, Patent Owner accused Petitioner of creating and relying on “computer-generated vector graphics” of the NSC ore car that were not present in EX1004. '046 POPR at 20–21; '048 POPR at 16–18. But Petitioner did not create vector graphics or fabricate evidence—the Petition and supporting declaration were prepared using accurate scans of the prior-art

book. Due to an inadvertent clerical error in preparing to file EX1004, the exhibit's resolution was reduced. Consequently, the exhibit no longer shows all of the detail present in the prior-art book.

The images from the 1946 Cyclopedia in the petitions and supporting expert declarations are not lower-resolution and therefore accurately reflect the images in the 1946 Cyclopedia. To be clear, the additional detail in the petitions and declarations was not computer-generated or fabricated—it is present in the prior art book itself. To correct the clerical error in preparing EX1004, Petitioner now moves under § 42.104(c) for leave to file a corrected version of the exhibit.

II. THE IMAGES IN THE PETITIONS AND DECLARATIONS ARE ACCURATE REPRODUCTIONS OF THE PRIOR ART

As described in the declaration of Justin Gillett, an attorney in this case, attorneys and staff at Petitioner's law firm, Knobbe Martens, photocopied portions of the 1946 Cyclopedia and assembled the images into a single PDF document. EX1051 ¶ 3. That electronic document was approximately 197 MB in size. *Id.* ¶ 3. Mr. Gillett asked Brandon Hernandez, a paralegal at Knobbe Martens, to prepare the document to be filed as EX1004. *Id.* ¶ 5. Upon discovering that 197 MB exceeded the 25 MB size limit for documents uploaded through PACTS, Mr. Hernandez reduced the exhibit's file size using Adobe's default "Optimize PDF/Reduce File Size" function. EX1052 ¶ 5. Although unnoticed at the time,

reducing the file size also reduced the document’s resolution enough to affect the technical drawings in the exhibit. EX1051 ¶¶ 7–8. Mr. Hernandez filed the exhibit through PACTS in connection with each of the three petitions. EX1052 ¶ 7.

Petitioner became aware of the clerical error when Patent Owner filed its POPRs and accused Petitioner of fabricating images in the petitions and supporting declarations. EX1051 ¶¶ 7–8. While investigating Patent Owner’s false accusations, Petitioner discovered that the filed version of EX1004 had a lower resolution than intended. *Id.* Petitioner promptly sought leave to correct the error by emailing the Board on September 30, 2025. EX1053.

III. THE MISTAKE IN PREPARING EX1004 WAS A CLERICAL ERROR THAT MAY BE CORRECTED UNDER § 42.104(C)

37 C.F.R. § 42.104(c) provides for correction of “a clerical or typographical mistake in [a] petition” without changing the filing date of the petition. The Board routinely grants motions to correct exhibits, including to permit a party to submit higher quality images. *See, e.g., Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, Paper 46 (PTAB July 22, 2013) (allowing a party to substitute exhibits to provide “clearer copies”); *Everi Payments Inc. v. Sightline Payments LLC*, IPR2022-00614, Paper 9 (PTAB May 27, 2022) (allowing a petitioner to improve the quality of the images in its petition). Here, the petitions and supporting expert declarations already contain high-quality images of the prior art publication—it is only EX1004 that would be corrected.

In a similar case, the Board granted an opposed motion to correct an exhibit where the moving party promptly requests leave and the opposing party would suffer no prejudice. *See, e.g., Apple Inc. et al. v. Memory Integrity, LLC*, IPR2015-00163, Paper 16 (PTAB April 9, 2015). In *Apple*, the patent owner argued in its preliminary responses that the petition should be denied because an entire chapter was omitted from an exhibit but relied on for obviousness. The Board allowed the petitioner to submit the missing chapter because its omission from the exhibit was “an inadvertent clerical error” resulting from petitioner’s effort to file only relevant portions of “a voluminous book.” *Id.* at 5. The patent owner suffered no prejudice in part because the petitions and a supporting declaration quoted the relevant portions of the omitted chapter, “thereby giving Patent Owner notice, from the initial filing of each case, of Petitioner’s intent to rely” on the omitted chapter. *Id.* at 6.

As in *Apple*, the clerical error here resulted from an effort to file relevant portions of a voluminous book. Further, the higher-resolution images in the petitions and declarations eliminated any risk of prejudice because they gave Patent Owner notice of the disclosures in the 1946 Cyclopedia on which Petitioner was relying. Indeed, Patent Owner relied on the higher-resolution images in the petitions and declarations to make substantive arguments about the patentability of the challenged claims. *See, e.g.,* ’046 POPR at 23, 39–43; ’048 POPR at 20, 26,

33, 35, 38, 50, 61. Petitioner respectfully submits that its inadvertent clerical error is suitable for correction under 37 C.F.R. § 42.104(c). *See Apple, LLC*, IPR2015-00163, Paper 16.

IV. CONCLUSION

For the reasons set forth above, Petitioner should be permitted to redress its clerical error by filing a corrected, higher-resolution version of EX1004.

Dated: October 8, 2025

By: / Philip M. Nelson /

Philip Nelson (Reg. No. 62,676)

Ted M. Cannon (Reg. No. 55,036)

Justin Gillett (Reg. No. 71,099)

KNOBBE MARTENS OLSON & BEAR, LLP

Attorneys for Petitioner FreightCar America, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PETITIONER'S MOTION UNDER 37 CFR § 42.104(c) is being served on October 8, 2025, via email on counsel of record for Patent Owner at the address below:

Safet Metjahic (Reg. No. 58,677)
Robert Keeler (Reg. No. 70,546)
ICE MILLER LLP
1500 Braodway, 29th Floor
New York, NY 10036
Safet.Metjahic@icemiller.com
Robert.Keeler@icemiller.com

Dated: October 8, 2025

By: / Philip M. Nelson /

Philip Nelson (Reg. No. 62,676)
KNOBBE MARTENS OLSON & BEAR, LLP