

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

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FREIGHTCAR AMERICA, INC.,  
Petitioner,

v.

NATIONAL STEEL CAR LIMITED,  
Patent Owner.

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IPR2025-01046 (Patent 8,166,892 B2)  
IPR2025-01047 (Patent 8,132,515 B2)  
IPR2025-01048 (Patent 8,132,515 B2)

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Before COKE MORGAN STEWART, *Deputy Under Secretary of  
Commerce for Intellectual Property and Deputy Director of the United  
States Patent and Trademark Office.*

DECISION

Referring the Petitions in IPR2025-01046 and IPR2025-01047 to the Board  
and Denying Institution of *Inter Partes* Review in IPR2025-01048.

IPR2025-01046 (Patent 8,166,892 B2)  
IPR2025-01047 (Patent 8,132,515 B2)  
IPR2025-01048 (Patent 8,132,515 B2)

National Steel Car Limited (“Patent Owner”) filed a request for discretionary denial under seal (Paper 8) as well as a redacted public version (Paper 7, “DD Req.”) in the above-captioned cases, and FreightCar America, Inc. (“Petitioner”) filed an opposition (Paper 12, “DD Opp.”).<sup>1</sup> With authorization, Patent Owner filed a Reply (Paper 13), and Petitioner filed a Sur-reply (Paper 16).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in IPR2025-01046 and IPR2025-01047 but is appropriate in IPR2025-01048. This determination is based on the totality of the evidence and arguments the parties have presented.

The projected final written decision due date in these proceedings is December 18, 2026. DD Req. 3; DD Opp. 3. The district court’s scheduled trial date is January 11, 2027, and the time-to-trial statistics suggest trial will begin in January 2027. DD Req. 3, 16–17; DD Opp. 24; Ex. 2010, 1; Ex. 2011. As such, it is likely that a final written decision in these proceedings will issue before a district court trial occurs. In addition, Petitioner offers persuasive evidence that the district court is likely to stay its proceeding if the Board were to institute trial. DD Opp. 23–24. These considerations weigh against discretionary denial.

Additionally, for the patent challenged in IPR2025-01046, U.S. Patent No. 8,166,892 (“the ’892 patent”), Petitioner provides persuasive reasoning, supported by evidence, that the Office materially erred during prosecution

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<sup>1</sup> Citations are to papers in IPR2025-01046. The parties filed similar papers in IPR2025-01047 and IPR2025-1048.

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and, accordingly, discretionary denial is not appropriate. Specifically, during prosecution of the '892 patent, the patent examiner indicated that the claims were allowed because “[t]he sidewall stiffener having web continuity . . . is seen as an unobvious improvement over the art of record.” DD Opp. 5; Ex. 1002, 416. Petitioner presents evidence, however, that various editions of the *Car Builder’s Cyclopedias*,<sup>2</sup> references cited on an Information Disclosure Statement,<sup>3</sup> appear to teach cars having two-part sidewall stiffeners with web continuity. DD Opp. 12–17.<sup>4</sup> Thus, Petitioner persuasively demonstrates that the patent examiner overlooked certain teachings of the *Car Builder’s Cyclopedias* that appear to disclose the allowable features of the claims. *Id.* at 14–15; *see* Pet. 13–14. Accordingly, Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error.

The patent challenged in IPR2025-01047, U.S. Patent No. 8,132,515 (“the ’515 patent”), is a divisional of the ’892 patent, and it is an efficient use of Board resources to address the related patent under these circumstances.

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<sup>2</sup> *Car Builders’ Cyclopedias of Am. Practice* 313–320 (Roy v. Wright et al eds., 14th ed. 1937); *Car Builders’ Cyclopedias of Am. Practice* 281–289 (Roy v. Wright et al eds., 16th ed. 1943); *Car Builders’ Cyclopedias of Am. Practice* 264–272 (C. L. Combes et al eds., 20th ed. 1957); *Car Builders’ Cyclopedias of Am. Practice* 246–258 (C. L. Combes et al eds., 21th ed. 1961).

<sup>3</sup> Ex. 1002, 280 (Information Disclosure Statement).

<sup>4</sup> Petitioner also provides evidence that the 1946 edition of *Car Builders’ Cyclopedias of Am. Practice* (Roy v. Wright et al eds., 17th ed. 1946) (Ex. 1004) shows Patent Owner’s own design (“NSC car”), which also teaches this limitation. DD Opp. 8 (citing Ex. 1004, 290, 292, 294), 11–14; Pet. 13–14, 19–33.

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The Petition in IPR2025-01048 is the second petition filed by Petitioner against the '515 patent, and Petitioner ranks the Petition in IPR2025-01047 above the Petition in IPR2025-01048. *See* IPR2025-01047, Paper 2, 5. In view of this, and the determination to refer the Petition in IPR2025-01047 to the Board, discretionary denial of IPR2025-01048 is appropriate.

Although certain arguments are highlighted above, the determinations in this Decision are based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition in IPR2025-01048 is denied under 35 U.S.C. §314(a), and the Petitions in IPR2025-01046 and IPR2025-01047 are referred to the Board to handle the cases in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial in IPR2025-01048 is *granted*;

FURTHER ORDERED that the Petition in IPR2025-01048 is *denied* and no trial is instituted;

ORDERED that Patent Owner's requests for discretionary denial in IPR2025-01046 and IPR2025-01047 are *denied*;

FURTHER ORDERED that the Petitions in IPR2025-01046 and IPR2025-01047 are referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of the decision to deny Patent Owner's request for discretionary denial in IPR2025-01046 and IPR2025-01047 until the Board issues a decision on institution.

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