

From: [Director Discretionary Decision](#)
To: [Philip Nelson](#); [Director Discretionary Decision](#)
Cc: [FCAIPR-515-048](#); [FCAIPR-515-047](#); [FCAIPR-892](#); IM-NSClit@icemiller.com; Robert.Keeler@icemiller.com; Safet.Metjahic@icemiller.com
Subject: RE: Request for leave to file single sur-reply to Patent Owner's Reply in support of Discretionary Denial in IPR2025-01046, -01047 and -01048
Date: Monday, September 29, 2025 10:05:24 AM
Attachments: [image001.png](#)

Petitioner may file their sur-reply and exhibits today.

From: Philip Nelson <Philip.Nelson@knobbe.com>
Sent: Friday, September 26, 2025 7:56 PM
To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: FCAIPR-515-048 <FCAIPR-515-048@knobbe.com>; FCAIPR-515-047 <FCAIPR-515-047@knobbe.com>; FCAIPR-892 <FCAIPR-892@knobbe.com>; IM-NSClit@icemiller.com; Robert.Keeler@icemiller.com; Safet.Metjahic@icemiller.com
Subject: Request for leave to file single sur-reply to Patent Owner's Reply in support of Discretionary Denial in IPR2025-01046, -01047 and -01048

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Dear Honorable Director,

Pursuant to the Interim Discretionary Denial Process, Petitioner FreightCar America requests leave to file a single, three-page sur-reply to Patent Owner's reply filed earlier today in IPR2025-01046, -01047, and -01048.

Good cause exists for the sur-reply to correct several factual inaccuracies in the reply. Moreover, Patent Owner did not meet and confer with Petitioner prior to drafting and emailing its reply to the Board, so the attached brief provides Petitioner's position.

Petitioner's opposition briefs explained how in each case, material examiner error and failure to consider highly relevant prior art warrants institution of the IPR. Secondly, national security and economic interests also support institution. In arguing otherwise, Patent Owner makes several false or misleading allegations. For example, it falsely alleges that FCA "ceased operations in Johnstown, Pennsylvania." Patent Owner also ignores FCA's Chicago headquarters, ignores that FCA is a U.S. company subject to U.S. laws, and ignores that the products are assembled from U.S.-made components. The sur-reply corrects these and other errors in Patent Owner's reply.

A copy of Petitioner's proposed three-page sur-reply brief is attached, along with proposed new Exhibits 1049 and 1050.

Sincerely,

Philip Nelson

Philip.Nelson@knobbe.com

949-721-6383 Direct

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From: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>

Sent: Friday, September 26, 2025 11:33 AM

To: Safet.Metjahic@icemiller.com; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>

Cc: Trials <Trials@USPTO.GOV>; 2tmc <2TMC@knobbe.com>; 2pmn <2pmn@knobbe.com>; 2Jjg <2Jjg@knobbe.com>; FCAIPR-515-048 <FCAIPR-515-048@knobbe.com>; FCAIPR-515-047 <FCAIPR-515-047@knobbe.com>; FCAIPR-892 <FCAIPR-892@knobbe.com>; IM-NSClit@icemiller.com; Robert.Keeler@icemiller.com

Subject: RE: Request for leave to file single reply to Petitioner's Opposition to Patent Owner's Requests for Discretionary Denial in IPR2025-01046, -01047 and -01048

Your request is approved and you may file the documents today.

From: Safet.Metjahic@icemiller.com <Safet.Metjahic@icemiller.com>

Sent: Thursday, September 25, 2025 5:46 PM

To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>

Cc: Trials <Trials@USPTO.GOV>; 2tmc <2TMC@knobbe.com>; 2pmn <2pmn@knobbe.com>; 2Jjg <2Jjg@knobbe.com>; FCAIPR-515-048 <FCAIPR-515-048@knobbe.com>; FCAIPR-515-047 <FCAIPR-515-047@knobbe.com>; FCAIPR-892 <FCAIPR-892@knobbe.com>; IM-NSClit@icemiller.com; Robert.Keeler@icemiller.com

Subject: Request for leave to file single reply to Petitioner's Opposition to Patent Owner's Requests for Discretionary Denial in IPR2025-01046, -01047 and -01048

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Dear Honorable Director,

Pursuant to the Interim Discretionary Denial Process, Patent Owner National Steel Car, Ltd. requests leave to file a single reply to Petitioner FreightCar America Inc.'s Oppositions to Patent Owner's Requests for Discretionary Denial in IPR2025-01046, -01047, and -01048 (collectively, the "Oppositions").

Good cause exists for this request. Petitioner argues in the Oppositions that economic and national security interests support review of the '892 and '515 Patents at issue in IPR2025-01046, -01047, and -01048. Patent Owner could not have foreseen these arguments as there are

important facts that refute any such argument that will be material to the Honorable Director's assessment regarding whether to discretionarily deny the Petitions. For example, Petitioner claims it is a U.S. company, despite deliberately closing its U.S.-based manufacturing facilities and opening facilities in Mexico in 2008. It is the Mexican facility where the infringing rail cars were built that prompted the District Court Litigation and these IPRs. These facts are entirely ignored by Petitioner in its Oppositions. Thus, Patent Owner seeks to correct the record and demonstrate its own long-standing support of the U.S. steel industry, which Petitioner claims is the basis for its economic and national security interests.

Moreover, Patent Owner seeks to point out the existence of non-infringing alternatives that have been sold and used on the same railway as Patent Owner's practicing products and Petitioner's infringing products; and that the particular railway upon which the patent-practicing and infringing rail cars are used is only one of many in the steel transport industry. Thus, there is no legitimate concern relating to economic or national security issues since Petitioner is free to make and sell alternative non-infringing rail cars to move steel, and not the infringing rail cars that it copied from Patent Owner to within measurement tolerances.

Because the arguments raised by Petitioner are the same in each of the three IPRs, Patent Owner seeks to enter a single Reply brief to avoid over-burdening the Honorable Director.

A copy of Patent Owner's proposed Reply Brief is enclosed. Proposed new Exhibits 2036 and 2037 are also enclosed. Proposed new Exhibits 2038-2041 can be provided upon request because they contain information that will be designated under the Proposed Protective Order when filed.

Thank you,

Safet Metjahic | Partner

IceMiller

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