

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 B2)
IPR2025-01047 (Patent 8,132,515, B2)
IPR2025-01048 (Patent 8,132,515, B2)¹

Before HYUN J. JUNG, NEIL T. POWELL, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

ORDER

Granting and Dismissing Petitioner's Motions to Correct Exhibit 1004
37 C.F.R. § 42.104(c)

¹ This Order addresses issues that are the same in the identified cases. The Board exercises its discretion to issue one Order to be filed in each case. The parties are not authorized to use this caption without express permission from the Board.

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With our authorization, Petitioner filed a Motion to Correct Exhibit 1004. Paper 17 (“Motion” or “Mot.”); Ex. 3001. In its Motion, Petitioner argues that the as-filed copy of Exhibit 1004 has low resolution due to a clerical error, such that we should allow correction under 37 C.F.R. § 42.104(c). Mot. 2, 5. Rule 104(c) provides, in relevant part, that “[a] motion may be filed that seeks to correct a clerical or typographical mistake in the petition.”

Patent Owner opposes Petitioner’s Motion. Paper 21 (“Opposition” or “Opp.”). Patent Owner argues that Exhibit 1004 is fundamental to Petitioner’s case, yet Petitioner deliberately filed an indecipherable copy of it. *Id.* at 1.

I. BACKGROUND

Petitioner filed its Petition for *inter partes* review of the ’892 patent on May 27, 2025. Paper 1 (“Petition” or “Pet.”). On September 18, 2025, Patent Owner filed a Preliminary Response, in which Patent Owner argued we should not institute *inter partes* review. Paper 10 (“Preliminary Response” or “Prelim. Resp.”).

In its Petition, Petitioner argues that certain claims are unpatentable as anticipated and/or obvious over certain prior art, including a publication titled “1946 Car Builders’ Cyclopeda,” which the parties refer to as the “1946 Cyclopeda.” *E.g.*, Pet. 8, 13–14, 17–86. With the Petition, Petitioner filed a Declaration of Mehdi Ahmadian, Ph.D., along with Exhibit 1004, which includes excerpts from the 1946 Cyclopeda. Exs. 1003, 1004. Dr. Ahmadian’s Declaration and the Petition include a number of images

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ostensibly reproduced from the 1946 Cyclopedia. *E.g.*, Ex. 1003 ¶¶ 47–71; Pet. 17–86.

In its Preliminary Response, Patent Owner argued that these images in Dr. Ahmadian’s Declaration and the Petition must have been produced using “computer-generated vector graphics” and the interpretations of Dr. Ahmadian and Petitioner. Prelim. Resp. 20–21. Patent Owner explained that those images in the Petition that are allegedly from the 1946 Cyclopedia are much higher resolution than the copy of the 1946 Cyclopedia filed as Exhibit 1004. *Id.* As an example, Patent Owner’s Preliminary Response compares the resolution of an image in the Petition to the resolution from a corresponding portion of Exhibit 1004, as reproduced below.



Petition at 51; Ex. 1004 at 27.

Id. at 21. Patent Owner’s comparison shows (1) on the left, an image ostensibly reproduced from the 1946 Cyclopedia in the Petition and (2) on the right, the corresponding portion of Exhibit 1004. Patent Owner suggests that the poor quality in Exhibit 1004 vitiates Petitioner’s patentability challenges based on the 1946 Cyclopedia. *Id.*

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II. PETITIONER'S MOTION

Following entry of Patent Owner's Preliminary Response, Petitioner sought and we granted leave for Petitioner to file the present Motion. Ex. 3001. In its Motion, Petitioner represents that Patent Owner's Preliminary Response prompted Petitioner's counsel to investigate why the copy of the 1946 Cyclopedia filed as Exhibit 1004 has low resolution. Mot. 3. Petitioner contends that it discovered "[d]ue 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." *Id.* at 2. Petitioner explains that it initially prepared a 197 MB version of the 1946 Cyclopedia as Exhibit 1004, but the paralegal tasked with filing the document "reduced the exhibit's file size using Adobe's default 'Optimize PDF/Reduce File Size' function" when the paralegal discovered that the original 197 MB document "exceeded the 25 MB size limit for documents uploaded through PACTS." *Id.* at 2. Petitioner supports these contentions with a declaration of one of its representatives, Justin J. Gillett, regarding his investigation of how the as-filed version of Exhibit 1004 was modified to a smaller file size, resulting in lower resolution. Ex. 1051.

Petitioner argues that its "inadvertent clerical error is suitable for correction under 37 C.F.R. § 42.104(c)." Mot. 5. Petitioner asserts that "the Petition and supporting declaration were prepared using accurate scans of the prior-art book." *Id.* at 1-2. Petitioner indicates that correction would not prejudice Patent Owner, arguing that "the petitions and supporting

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declarations already contain high-quality images of the prior art publication—it is only EX1004 that would be corrected.” *Id.* at 3

III. PATENT OWNER’S OPPOSITION

Patent Owner argues that “Petitioner’s Motion seeks to retroactively correct a strategic filing decision that has already prejudiced the Patent Owner and undermined the fairness of these proceedings.” *Opp.* 3. Patent Owner contends that Petitioner deliberately relied on a deficient version of Exhibit 1004 and should have sought correction sooner. *Id.* at 1. Patent Owner argues that it alerted Petitioner to problems with the resolution of the 1946 Cyclopaedia “in the parallel district court litigation in April, before Petitioner initiated this IPR.” *Id.* at 5.

According to Patent Owner, “Petitioner also disregarded the objections of Patent Owner’s expert to the quality of Exhibit 1004, raised in connection with the Petition[.]” *Id.* at 1 (citing Ex. 2001 ¶ 41). Patent Owner suggests that Petitioner’s counsel could have avoided this problem by taking certain additional measures, including following certain procedures for filing large files in the Board’s record. *Id.* at 7–9.

Patent Owner also objects that Petitioner has neither submitted its corrected version of Exhibit 1004 nor explained its provenance, such as whether it matches the version referenced by Petitioner’s witnesses. *Id.* at 2. Patent Owner suggests that there should be additional briefing, arguing that “Petitioner’s strategic choice to submit a visibly deficient Exhibit 1004 has prejudiced Patent Owner in preparing its Requests for Discretionary Denial and Preliminary Responses” and “[t]he proposed substitution . . . would materially alter the evidentiary foundation of the Petition[.] and should have

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been included at the time of filing.” *Id.* at 2, 10. According to Patent Owner, Petitioner seeks a substantive change, rather than a correction to a clerical mistake. *Id.* at 9–10

IV. DISCUSSION

Petitioner persuades us that it made a clerical mistake filing its Petition, not a strategic decision to withhold the substance of the 1946 Cyclopeda, as Patent Owner suggests. *E.g.*, Mot. 2–3. Petitioner provides undisputed evidence that persuades us the copy of the 1946 Cyclopeda submitted as Exhibit 1004 inadvertently had its resolution reduced during the ministerial process that Petitioner’s paralegal undertook when filing the exhibit. Ex. 1051 ¶¶ 1–9. Although we recognize Patent Owner is correct that there are ways the mistake could have been avoided, we do not find it appropriate under these circumstances to deny Petitioner’s request to correct the mistake. *See* Opp. 7–9.

Contrary to Patent Owner’s suggestion, the record does not show that the mistake has unfairly prejudiced Patent Owner by preventing Patent Owner from fairly responding to the Petition. Opp. 2–3, 7, 9. Both Dr. Ahmadian’s Declaration and the Petition extensively reproduce clear, high-resolution images allegedly present in the 1946 Cyclopeda that Petitioner and Dr. Ahmadian contend show various limitations of the ’892 patent’s challenged claims. *E.g.*, Ex. 1003 ¶¶ 47–72; Pet. 17–86. The images in the Petition and Declaration provide fair notice to Patent Owner of Petitioner’s positions regarding the content of the 1946 Cyclopeda. Patent Owner apparently found those images sufficiently clear to argue extensively in the Preliminary Response about the substance of Petitioner’s challenges.

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E.g., Prelim. Resp. 22–43. And Patent Owner has not identified any portion of the 1946 Cyclopedia that was not allegedly reproduced by Petitioner or Dr. Ahmadian in the Petition and Declaration that would affect the substance of the parties’ disputes. *See generally* Prelim. Resp.; Opp.

Additionally, we do not agree with Patent Owner’s suggestion that allowing Petitioner to correct the mistake would unfairly prejudice Patent Owner. For example, we do not find persuasive Patent Owner’s concerns about the new exhibit’s provenance and similar issues. Opp. 2, 10–11. Patent Owner will have fair opportunities to address such concerns if an *inter partes* review is instituted. For example, Patent Owner would have an opportunity to object to the exhibit and move for its exclusion.

V. IPR2025-01047

In this proceeding, Petitioner cites to Exhibit 1004 for only one challenge against dependent claims. Paper 1, 19, 104–123. Petitioner filed an identical motion to correct Exhibit 1004 in IPR2025-01047. Paper 17. Patent Owner also filed an identical opposition. Paper 21.

Because the arguments and cited evidence are the same, our discussion above regarding IPR2025-01046 applies to this proceeding.

VI. IPR2025-01048

Petitioner also filed the same motion to correct Exhibit 1004 in IPR2025-01048. Paper 17. In this proceeding, the Director denied institution under 35 U.S.C. § 314(a). Paper 20. In view of the Director’s denial, we dismiss Petitioner’s motion as moot.

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It is

ORDERED that Petitioner's Motions in IPR2025-01046 and IPR2025-01047 are *granted*;

FURTHER ORDERED that Petitioner's motion in IPR2025-01048 is dismissed as moot;

FURTHER ORDERED that, by December 16, 2025, in IPR2025-01046 and IPR2025-01047, Petitioner shall file a corrected version of the 1946 Cyclopedia with an exhibit number other than Exhibit 1004;

FURTHER ORDERED that, except for the change in exhibit number and having higher resolution, the corrected version of the 1946 Cyclopedia shall be the same as Exhibit 1004;

FURTHER ORDERED that, all citations to Exhibit 1004 in documents currently of record in IPR2025-01046 and IPR2025-01047 will be understood to correspond also to the corrected version of the 1946 Cyclopedia; and

FURTHER ORDERED that, Exhibit 1004 shall remain in the record of IPR2025-01046 and IPR2025-01047.

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