

Powell, Neil

From: Trials
Sent: Tuesday, September 30, 2025 4:14 PM
To: Philip Nelson; IM-NSClit@icemiller.com; FCAIPR-892; Safet.Metjahic@icemiller.com; FCAIPR-515-047; FCAIPR-515-048; Robert.Keeler@icemiller.com
Cc: Trials
Subject: RE: Request for Submission under rule 42.104 and for Replies to POPRs - IPR2025-01046, -47, and -48

Counsel,

In each proceeding, Petitioner is authorized to file the requested motion and five-page preliminary reply, limited to the subjects identified in Petitioner's email. Petitioner's motion and preliminary reply is due Wednesday, October 8. In each proceeding, Patent Owner may file by Friday, October 17 an opposition to Petitioner's motion, along with a five-page preliminary sur-reply.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Philip Nelson <Philip.Nelson@knobbe.com>
Sent: Tuesday, September 30, 2025 1:32 PM
To: Trials <Trials@USPTO.GOV>
Cc: IM-NSClit@icemiller.com; FCAIPR-892 <FCAIPR-892@knobbe.com>; Safet.Metjahic@icemiller.com; FCAIPR-515-047 <FCAIPR-515-047@knobbe.com>; FCAIPR-515-048 <FCAIPR-515-048@knobbe.com>; Robert.Keeler@icemiller.com
Subject: Request for Submission under rule 42.104 and for Replies to POPRs - IPR2025-01046, -47, and -48

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Dear Board:

I write on behalf of Petitioner FreightCar America, Inc. to request authorization to file (1) a motion under 37 CFR § 42.104(c) to submit a higher-resolution version of EX1004 and (2) five-page preliminary replies to the Patent Owner Preliminary Responses filed September 18, 2025, in IPR2025-01046, IPR2025-01047, and IPR2025-01048 to address three incorrect assertions by Patent Owner NSC:

1. NSC asserts that the Petition contains "computer-generated vector graphics" that show small structures not present in the excerpts of the prior-art Cyclopedia treatise that were submitted

as EX1004 ('046 POPR at 20-21; '048 POPR at 16-18). Petitioner's reply would explain that, due to PTAacts limits on the file size of uploaded exhibits, Petitioner compressed certain exhibit files before uploading them; however, Petitioner has the original prior-art book that shows the small structures reproduced in the Petition and supporting declaration. Good cause exists for a reply because Petitioner could not have foreseen that Patent Owner would accuse Petitioner of fabricating evidence.

The Petition and supporting expert declaration use accurate, higher-resolution images of the prior art that were not altered except to: (1) excerpt / annotate/or highlight features; or (2) illustrate proposed obviousness "modifications," as labeled. Petitioner seeks authorization to file a motion to submit a higher-resolution version of EX1004 in a manner directed by the Board, e.g., by providing a sharefile link, or sending a USB drive or the book itself by overnight courier. Petitioner believes Patent Owner has physical copies of all the Cyclopedias cited in the Petition, as Patent Owner has previously submitted excerpts of many Cyclopedias to the Patent Office. However, a higher-resolution version can also be provided to Petitioner if desired.

2. NSC asserts that the Petition erroneously treats a schematic and a photograph in different figures in EX1004 as the same design ('046 POPR at 17-18; '048 POPR at 14-15). Petitioner's reply would explain that the captions of the two figures cross-reference each other and depict the same design. Good cause for a reply exists because Petitioner could not have foreseen that Patent Owner would ignore cross-references that establish the figures show the same design.
3. NSC asserts that the declaration of Petitioner's expert, Dr. Ahmadian, is deficient because it does not address every element of every claim ('046 POPR at 19-20; '047 POPR at 13-14; '048 POPR at 15-16). Petitioner's reply would state that an expert declaration need not address claim elements that judges with a technical background can identify in the prior art without the assistance of an expert. *See* PTAB's archived [FAQ no. 22](#) (explaining that, because PTAB judges have technical and legal expertise, "it is not necessary for an expert to explain every aspect of the prior art"). Good cause exists for a reply because Petitioner could not have anticipated that Patent Owner would make arguments contrary to PTAB policies and practices.

Petitioner has conferred with Patent Owner, and Patent Owner opposes Petitioner's requests. The parties are available for a conference call today for the remainder of the afternoon or Thursday, October 2, after 1:00 p.m. EDT.

Sincerely,
Philip Nelson
Counsel for Petitioner

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