

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FREIGHTCAR AMERICA, INC.,
Petitioner,

v.

NATIONAL STEEL CAR LIMITED,
Patent Owner.

IPR2025-01047
Patent 8,132,515 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER

Granting Director Review, Vacating the Decision Granting Institution, and
Denying Institution of *Inter Partes* Review

National Steel Car Limited (“Patent Owner”) filed a request for Director Review of the Decision granting institution (“Decision,” Paper 27) in the above-captioned case, and Freight Car America, Inc. (“Petitioner”) filed an authorized response to the request. *See* Paper 31 (“DR Request”); Paper 35 (“DR Resp.”).

In the request, Patent Owner argues that it has disclaimed the claims for which the Board found a reasonable likelihood of Petitioner prevailing, and that it would be an inefficient use of Board resources to proceed with this *inter partes* review (“IPR”) when Petitioner has failed to demonstrate a reasonable likelihood of prevailing with respect to any of the claims remaining in the IPR. DR Request 1. Petitioner responds that Patent Owner’s request should be denied because it does not identify an error in the Board’s Decision, and it relies on new evidence (Patent Owner’s post-institution disclaimer of certain claims). DR Resp. 3, 5–6.

The Board determined that Petitioner had shown a reasonable likelihood that claim 24 of the challenged patent was unpatentable, but “question[ed] whether” or found that Petitioner “does not appear to show” that the remaining challenged independent claims (claims 1, 7, 18, 20, and 32) or their dependent claims were unpatentable. Decision 22–32. After institution, Patent Owner disclaimed claim 24, as well as claims 25–31, which depend from claim 24. *See* DR Request 1; Ex. 2046. As such, “the patent is viewed as though the disclaimed claims had never existed in the patent.” *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996).

Under these circumstances, where claims 24–31 are treated as though they never existed, and the Board has determined that Petitioner failed to show a reasonable likelihood that any remaining, non-disclaimed claim is

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unpatentable, maintaining this IPR is an inefficient use of Office resources.
Accordingly, the Decision is vacated, and institution is denied.

It is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Decision granting institution of *inter partes* review (Paper 27) is vacated; and

FURTHER ORDERED that the petition is denied, and no trial is instituted.

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