

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOWARD INDUSTRIES, INC.

Petitioner,

v.

CAPSA SOLUTIONS LLC

Patent Owner.

U.S. Patent No. 7,594,668

Filing Date: August 18, 2008

Issue Date: September 29, 2009

U.S Patent No. 8,215,650

Filing Date: July 20, 2011

Issue Date: July 10, 2012

Case Nos. IPR2023-01274, IPR2023-01275

**DECLARATION OF JAMES KWAK IN SUPPORT OF PATENT
OWNER'S RESPONSE TO '668 AND '650 IPR PETITIONS**

I, James L. Kwak, declare as follows:

1. I am a partner at the law firm Standley Law Group LLP (“SLG”), counsel for Patent Owner Capsa Solutions LLC (“Capsa”). I submit this declaration in support of the above-identified inter partes review proceeding involving U.S. Patent Nos. 7,594,668 (“the ‘668 Patent”) and 8,215,650 (“the ‘650 Patent”) (collectively, “the Patents-at-issue”). Unless stated otherwise, I have personal knowledge of the facts set forth below, and if called as a witness, could and would competently testify thereto.
2. Attached as **Attachment A**, is a true and accurate copy of an email sent by Connor McGregor, counsel for Petitioner, Howard Industries, Inc. (“Howard”), on October 13, 2023 agreeing to Patent Owner’s proposed definition of “compartment(s)” as “an enclosed space for containing an item.” *See, also* Exhibit 1012, Dkt. 42-1, Joint Claim Construction Chart, Exhibit 1031, Dkt. 45, Capsa’s Preliminary Claim Construction Brief, pg. 36.
3. This agreed-upon definition for “compartment(s)” was submitted to the U.S. District Court for the Southern District of Mississippi, in the on-going parallel litigation between the parties, which has been assigned Case No. 2:22-cv-00065-HSO-BWR. A *Markman* hearing related to the ‘668 and ‘650 Patents, has been fully briefed by the Parties and a hearing before an

appointed special master took place on October 18, 2023. The parties are awaiting a final claim construction order from the Court, which is expected at any time. It is presumed that the special master will accept the parties agreed upon definition of “compartment(s)” as “an enclosed space for containing an item.”

I declare under penalty of perjury that the foregoing is true and correct.

Executed on November 29, 2023 in Dublin, Ohio.

/James L. Kwak/
James L. Kwak

ATTACHMENT A

From: McGregor, Connor <Connor.McGregor@finnegan.com>
Sent: Friday, October 13, 2023 11:55 AM
To: F. Michael Speed; Mulcahy, John; Jeffrey Standley; DeAnna Barnett; James Kwak
Cc: Young, Michael; Ferrill, Elizabeth; Horn, Kelly; Liu, Yinan; Jordan, Dan; Smiley, Deanna; Rosenberger, Mark; Lew Yoder; mmiller@cctb.com
Subject: RE: Capsa Solutions LLC v. Howard Industries, Inc., Case No. 2:22-cv-00065-HSO-BWR - Markman Hearing
Attachments: Capsa v. Howard - Stipulation relating to 527 Patent.docx

Hi Mike,

Howard agrees to the proposed revision to the stipulation. A clean version of the stipulation is attached. Please confirm that we have permission to add your signature and file with the court.

Additionally, Howard is willing to accept Capsa's construction of "compartment(s)" for the '668 and '650 patents.

We will inform Mr. Woloson today regarding the joint stipulation and agreed construction. A draft email is below for your approval.

Best Regards,
Connor

__DRAFT FOR MR. WOLOSON__

Hi Mr. Woloson,

Earlier today, the parties agreed to a stipulation dismissing with prejudice U.S. Patent No. 8,109,527 (the '527 patent) from the litigation. Additionally, the parties have agreed to the proposed construction of the term "compartment(s)" as "an enclosed space for containing an item." Thus, the following terms are no longer at issue and do not need construction at the hearing next week:

'668 and '650 patents

8. "compartment(s)"

'527 patent

12. "track"

13. "platform"

14. "arm"

15. "substantially coextensive"

Best Regards,
Connor

__END DRAFT__

Connor McGregor
Associate
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP