

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
SAN ANTONIO DIVISION

FILED

OCT 19 2021

CLERK, U.S. DISTRICT CLERK
WESTERN DISTRICT OF TEXAS
BY RG

M-I LLC,

Plaintiff,

v.

FPUSA, LLC,

Defendant.

CIVIL ACTION NO. 5:15-CV-00406-DAE DEPUTY

VERDICT FORM

INFRINGEMENT

Direct Infringement of U.S. Patent No. 9,004,288 ("the '288 Patent")

1. Has M-I proven that it is more likely than not that FPUSA's Vac Screen systems directly infringe any of the Asserted Claims of the '288 Patent?

Answer "Yes" or "No" for each product listed and each claim listed.

Answering "Yes" below indicates a finding for M-I.

Answering "No" below indicates a finding for FPUSA.

'288 Patent Claim	Vac-Screen "Drop In" Version	Vac-Screen "Bolt On" Version
Claim 16	yes	yes
Claim 17	yes	yes
Claim 18	yes	yes

Direct Infringement of U.S. Patent No. 9,074,440 ("the '440 Patent")

2. Has M-I proven that it is more likely than not that FPUSA directly infringed Claim 11 of the '440 Patent?

Answer "Yes" or "No" for each product listed.

Answering "Yes" below indicates a finding for M-I.

Answering "No" below indicates a finding for FPUSA.

'440 Patent Claim	Vac-Screen "Drop In" Version	Vac-Screen "Bolt On" Version
Claim 11	yes	yes

Induced Infringement of U.S. Patent No. 9,004,288 ("the '288 Patent")

3. Has M-I proven that it is more likely than not that FPUSA induced infringement of any of the Asserted Claims of the '288 Patent?

Answer "Yes" or "No" for each product listed and each claim listed.

Answering "Yes" below indicates a finding for M-I.

Answering "No" below indicates a finding for FPUSA.

'288 Patent Claim	Vac-Screen "Drop In" Version	Vac-Screen "Bolt On" Version
Claim 16	yes	yes
Claim 17	yes	yes
Claim 18	yes	yes

Induced Infringement of U.S. Patent No. 9,004,440 ("the '440 Patent")

4. Has M-I proven that it is more likely than not that FPUSA induced infringement of claim 11 of the '440 Patent?

Answer "Yes" or "No" for each product listed and each claim listed.

Answering "Yes" below indicates a finding for M-I.

Answering "No" below indicates a finding for FPUSA.

'440 Patent Claim	Vac-Screen "Drop In" Version	Vac-Screen "Bolt On" Version
Claim 11	yes	yes

Contributory Infringement of U.S. Patent No. 9,004,288 ("the '288 Patent")

5. Has M-I proven that it is more likely than not that FPUSA contributed to a third party's infringement of any Asserted Claim of the '288 Patent?

Answer "Yes" or "No" for each product listed and each claim listed.

Answering "Yes" below indicates a finding for M-I.

Answering "No" below indicates a finding for FPUSA.

'288 Patent Claim	Vac-Screen "Drop In" Version	Vac-Screen "Bolt On" Version
Claim 16	yes	yes
Claim 17	yes	yes
Claim 18	yes	yes

Contributory Infringement of U.S. Patent No. 9,004,440 ("the '440 Patent")

6. Has M-I proven that it is more likely than not that FPUSA contributed to a third party's infringement of any Asserted Claim of the '440 Patent?

Answer "Yes" or "No" for each product listed and each claim listed.

Answering "Yes" below indicates a finding for M-I.

Answering "No" below indicates a finding for FPUSA.

'440 Patent Claim	Vac-Screen "Drop In" Version	Vac-Screen "Bolt On" Version
Claim 11	yes	yes

INVALIDITY

Anticipation of the '288 Patent by U.S. Patent No. 5,122,262 ("Summers")

7. Did FPUSA prove by clear and convincing evidence that any of the following claims of the '288 Patent are invalid because they are anticipated by Summers?

Answer "Yes" or "No" for each claim listed.

Answering "Yes" below indicates a finding for FPUSA.

Answering "No" below indicates a finding for M-I.

'288 Patent Claim	Summers
Claim 16	NO
Claim 17	NO
Claim 18	NO

Anticipation of the '440 Patent by U.S. Patent No. 5,122,262 ("Summers")

8. Did FPUSA prove by clear and convincing evidence that claim 11 of the '440 Patent is invalid because it is anticipated by Summers?

Answer "Yes" or "No."

Answering "Yes" below indicates a finding for FPUSA.

Answering "No" below indicates a finding for M-I.

'440 Patent Claim	Summers
Claim 11	NO

Obviousness of the '288 Patent

- 9 Did FPUSA prove by clear and convincing evidence that Summers alone, or the combination of Summers with U.S. Patent Application Publication 2005/0082236 ("Derrick"), renders any of the following claims of the '288 Patent obvious?

Answer "Yes" or "No" for each claim listed and each prior art reference listed.

Answering "Yes" below indicates a finding for FPUSA.

Answering "No" below indicates a finding for M-I.

'288 Patent Claim	Summers	Summers + Derrick
Claim 16	NO	NO
Claim 17	NO	NO
Claim 18	NO	NO

Obviousness of the '440 Patent

10. Did FPUSA prove by clear and convincing evidence that Summers alone, or the combination of Summers with U.S. Patent Application Publication 2005/0082236 ("Derrick") renders claim 11 of the '440 Patent obvious?

Answer "Yes" or "No" for each prior art reference listed.

Answering "Yes" below indicates a finding for FPUSA.

Answering "No" below indicates a finding for M-I.

'440 Patent Claim	Summers	Summers + Derrick
Claim 11	NO	NO

Non-Enablement of the '288 Patent

11. Has FPUSA proven by clear and convincing evidence that the specification of the '288 Patent does not contain a description of any of the Asserted Claims that is sufficiently full and clear to enable persons of ordinary skill in the art to make and use the invention?

Answer "Yes" or "No" for each claim listed.

Answering "Yes" below indicates a finding for FPUSA.

Answering "No" below indicates a finding for M-I.

'288 Patent Claim	Non-Enablement
Claim 16	NO
Claim 17	NO
Claim 18	NO

Non-Enablement of the '440 Patent

12. Has FPUSA proven by clear and convincing evidence that the specification of the '440 Patent does not contain a description of claim 11 that is sufficiently full and clear to enable persons of ordinary skill in the art to make and use the invention?

Answer "Yes" or "No."

Answering "Yes" below indicates a finding for FPUSA.

Answering "No" below indicates a finding for M-I.

'440 Patent Claim	Non-Enablement
Claim 11	NO

“Effective Filing Date” or “Priority Date” of the Asserted Patents

13. Has FPUSA proven by clear and convincing evidence that the effective filing date for any of the following claims is March 18, 2013, and not September 2007 or earlier?

Answer “Yes” or “No” for each claim listed.

Answering “Yes” below indicates a finding for FPUSA.

Answering “No” below indicates a finding for M-I.

'288 Patent Claim	Priority Date of March 18, 2013
Claim 16	NO
Claim 17	NO
Claim 18	NO

'440 Patent Claim	Priority Date of March 18, 2013
Claim 11	NO

On-Sale Bar of the '288 Patent

14. Did FPUSA prove by clear and convincing evidence that any of the following claims of the '288 Patent are invalid because the claimed invention was sold or offered for sale in the United States at least one year prior to the effective filing date of the patent application?

Answer "Yes" or "No."

Answering "Yes" below indicates a finding for FPUSA.

Answering "No" below indicates a finding for M-I.

'288 Patent Claim	On-Sale Bar
Claim 16	NO
Claim 17	NO
Claim 18	NO

On-Sale Bar of the '440 Patent

15. Did FPUSA prove by clear and convincing evidence that any of the following claims of the '440 Patent are invalid because the claimed invention was sold or offered for sale in the United States at least one year prior to the effective filing date of the patent application?

Answer "Yes" or "No."

Answering "Yes" below indicates a finding for FPUSA.

Answering "No" below indicates a finding for M-I.

'440 Patent Claim	On-Sale Bar
Claim 11	NO

FINDINGS ON INEQUITABLE CONDUCT

16. Has FPUSA proven by clear and convincing evidence that Brian Carr intentionally withheld the Summers Patent for the purpose of deceiving the Patent Office into issuing the claims of the '360 Patent, '288 Patent, or '440 Patent?

Answer "Yes" or "No."

Answering "Yes" below indicates a finding for FPUSA.

Answering "No" below indicates a finding for M-I.

Patent	Intent to Deceive the Patent Office
'360 Patent	NO
'288 Patent	NO
'440 Patent	NO

17. Has FPUSA proven by clear and convincing evidence that the Summers Patent is material to any of the claims of the '360 Patent, '288 Patent, or the '440 Patent such that the claim would not have issued if the Summers Patent was disclosed to the Patent Office?

Answer "Yes" or "No."

Answering "Yes" below indicates a finding for FPUSA.

Answering "No" below indicates a finding for M-I.

Patent	Materiality of Summers
'360 Patent	NO
'288 Patent	NO
'440 Patent	NO

FINDINGS ON UNCLEAN HANDS

18. Has FPUSA proven by clear and convincing evidence that M-I's claims for patent infringement are barred by M-I's unclean hands?

Answer "Yes" or "No."

Answering "Yes" below indicates a finding for FPUSA

Answering "No" below indicates a finding for M-I.

NO

FINDINGS ON DAMAGES

You should only answer questions 19 and 20 if you found any claim of the '288 or '440

Patents was infringed and is not invalid.

19. What lost profits, if any, did M-I show it more likely than not suffered as a result of sales that it would with reasonable probability have made but for FPUSA's infringement? Any amount should be written in dollars and cents.

\$ 969,433.00

20. For those infringing sales for which M-I has not proved its entitlement to lost profits, what has it proved it is entitled to as a reasonable royalty? Any amount should be written in dollars and cents.

\$ 0



Foreperson

October 19, 2021

Date