

**UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF LOUISIANA
LAKE CHARLES DIVISION**

BACKOFF, LLC and NUTEC, INC., <i>Plaintiffs,</i> v. SAMOCO OIL TOOLS, INC., <i>Defendant.</i>	§ § § CIVIL ACTION NO. _____ § § § JUDGE _____ § § § MAGISTRATE JUDGE _____ § §
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COMPLAINT

NOW INTO COURT, through undersigned counsel, come Plaintiffs, Backoff, LLC (hereinafter “Backoff”) and NuTec, Inc. (hereinafter “NuTec”) (hereinafter collectively “Plaintiffs”), who hereby present this Complaint against Defendant, Samoco Oil Tools, Inc. (hereinafter “Defendant” or “Samoco”), and based upon actual knowledge as to themselves and their own actions, and upon information and belief as to all other persons and events, allege as follows:

NATURE OF THE ACTION

1. This Civil Action is brought pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2201, seeking a declaratory judgment of patent invalidity of Defendant’s U.S. Patent No. 9,841,343 for “BLOWOUT PREVENTER (BOP) TEST TOOL AND METHODS” (hereinafter “Samoco Patent”), which claims certain blowout preventer (hereinafter “BOP”) test tools well-known in the prior art, under the U.S. Patent Act, as amended by the Leahy-Smith America Invents Act, 35 U.S.C. § 1, *et seq.*, to enable Plaintiffs’ practice of their intellectual property related to BOP test

tools, particularly such tools that allow testing of BOP equipment in a single trip, without further interference and threat from Defendant. A true and correct copy of the Samoco Patent is attached hereto as Exhibit “A” and incorporated herein by reference.

THE PARTIES

2. Backoff is a limited liability company organized and existing under the laws of the State of Louisiana, registering its principal place of business at 3206 Dean Day Road, Sulphur, Louisiana 70663. Backoff owns all rights, title, and interest of its intellectual property described herein, and is Plaintiff here.

3. NuTec is a corporation organized and existing under the laws of the State of Alaska, registering its principal place of business in the State of Louisiana at 4800 Highway 90 East, Lake Charles, Louisiana 70615. NuTec is the exclusive licensee of all rights, title, and interest of Backoff’s intellectual property described herein, and is also Plaintiff here.

4. Samoco is a corporation organized and existing under the laws of the State of Texas, registering its principal place of business at 601 Century Plaza Drive, Houston, Texas 77073, and is made Defendant here.

JURISDICTION

5. This United States District Court may exclusively exercise original jurisdiction over the subject matter of this Civil Action pursuant to 28 U.S.C. §§ 1331 and 1338(a) for claims asserted herein arising under the U.S. Patent Act, as amended by the Leahy-Smith America Invents Act, 35 U.S.C. § 1, *et seq.*

6. This United States District Court may exercise original jurisdiction over the subject matter of this Civil Action based upon an actual controversy between the parties under the Declaratory

Judgment Act, 28 U.S.C. §§ 2201(a) and 2202, for the relief requested herein of declaratory judgment with respect to the invalidity of the Samoco Patent as described herein.

7. This United States District Court may exercise jurisdiction over Defendant on the ground that, *inter alia*, Defendant and/or Defendant's agents regularly conduct commerce in the State of Louisiana, deriving revenue and value therefrom, so as to purposefully avail itself of the privilege of conducting business within the State of Louisiana, and particularly in this District.

8. This United States District Court may exercise jurisdiction over Defendant on the ground that, *inter alia*, Defendant committed and continues to commit acts of imposing its invalid patent against Plaintiffs in the State of Louisiana, deriving revenue and value therefrom, so as to purposefully avail itself of the privilege of conducting business within the State of Louisiana, and particularly in this District.

9. This United States District Court may exercise jurisdiction over Defendant on the ground that, *inter alia*, the conduct of Defendant and/or Defendant's agents as alleged herein caused and continues to cause injury to Plaintiffs in the State of Louisiana, and particularly in this District.

10. Defendant expects its actions to be of consequence in the State of Louisiana and in this District.

VENUE

11. Venue is proper in this District, the Western District of Louisiana, under 28 U.S.C. §§ 1391(b) and 1391(c), on the ground that, *inter alia*, Defendant is subject to personal jurisdiction in this State and District.

CAUSE OF ACTION

Plaintiffs' Intellectual Property

12. Backoff is the sole assignee of the embodiments of the subsea BOP test joint assembly for testing different size diameter pipe against variable bore ram and annular subsea BOP in one trip into a wellbore, as disclosed by assignee Backoff in the United States Patent and Trademark Office (hereinafter "USPTO" or "Patent Office") on February 3, 2015 under Non-Provisional Utility Patent Application Serial No. 14/613,089 (hereinafter "'089 Application"). A true and correct copy of the Filing Receipt, as issued by the USPTO, is attached hereto as Exhibit "B" and incorporated herein by reference.

13. After a full and fair examination of the '089 Application, the Patent Office issued its Notice of Allowance, dated September 22, 2016, on all pending claims of the '089 Application. A true and correct copy of said Notice of Allowance is attached hereto as Exhibit "C" and incorporated herein by reference. The Notice of Allowance specifically confirmed that the '089 Application was duly examined and allowed for issuance as a United States Patent pursuant to federal law and regulations. *See Ex. C.*

14. U.S. Patent No. 9,506,312, entitled "BLOWOUT PREVENTER TEST JOINT ASSEMBLY, FOR TESTING VARIABLE BORE RAMS, SHEAR RAMS, AND ANNULARS" (hereinafter "'312 Patent"), arising from the '089 Application, was duly and legally issued on November 29, 2016 to assignee Backoff. A true and correct copy of the '312 Patent is attached hereto as Exhibit "D" and incorporated herein by reference.

15. All rights arising from the '312 Patent are in full force and effect under federal law.

16. All rights of priority that arise from the '312 Patent relate back to February 3, 2015, the date of filing of the '089 Application.

17. Backoff solely owns all rights, title, and interest in and arising from the '312 Patent.
18. NuTec is the exclusive licensee of all rights, title, and interest in and arising from the '312 Patent.
19. Backoff is the sole assignee of the embodiments of the subsea BOP test joint assembly for testing different size diameter pipe against variable bore ram and annular subsea BOPs, including blind and shear rams, in one trip into a wellbore, as disclosed by assignee Backoff in the USPTO on June 30, 2016 under Non-Provisional Utility Continuation Patent Application Serial No. 15/199,261 (hereinafter "'261 Continuation Application"). A true and correct copy of the Filing Receipt, as issued by the USPTO, is attached hereto as Exhibit "E" and incorporated herein by reference.
20. The invention disclosed in the '261 Continuation Application was a continuation of the then co-pending '089 Application.
21. The full disclosure of the '089 Application was incorporated by reference in the '261 Continuation Application.
22. The priority date of the '089 Application was claimed by its subsequent '261 Continuation Application.
23. After a full and fair examination of the '261 Continuation Application, the Patent Office issued its Notice of Allowance, dated July 13, 2017, on all pending claims of the '261 Continuation Application. A true and correct copy of said Notice of Allowance is attached hereto as Exhibit "F" and incorporated herein by reference. The Notice of Allowance specifically confirmed that the '261 Continuation Application was duly examined and allowed for issuance as a United States Patent pursuant to federal law and regulations. *See* Ex. F.

24. U.S. Patent No. 9,771,771, entitled “BLOWOUT PREVENTER TEST JOINT ASSEMBLY FOR TESTING VARIABLE BORE RAMS, SHEAR RAMS AND ANNULARS” (hereinafter “’771 Patent”), arising from the ’261 Continuation Application, was duly and legally issued on September 26, 2017 to assignee Backoff. A true and correct copy of the ’771 Patent is attached hereto as Exhibit “G” and incorporated herein by reference.

25. All rights arising from the ’771 Patent are in full force and effect under federal law.

26. All rights of priority that arise from the ’771 Patent relate back to February 3, 2015, the date of filing of the ’089 Application upon which the ’261 Continuation Application claimed its priority.

27. Backoff solely owns all rights, title, and interest in and arising from the ’771 Patent.

28. NuTec is the exclusive licensee of all rights, title, and interest in and arising from the ’771 Patent.

29. Backoff is the sole assignee of the blowout-preventer-stack one-trip test tool and method providing a solid test pin for sealing the test plug in the wellhead, a running tool for securely placing, separating from, reattaching, and removing the solid test pin, testing all fixed and variable rams and annulars and testing all blind and shear rams without damage to pipe, in one trip, and a fail-safe secondary provision for removing the solid test plug on a second trip with an emergency retrieval tool if necessary; as disclosed by assignee Backoff in the USPTO on May 5, 2015 under Non-Provisional Utility Patent Application Serial No. 14/704,646 (hereinafter “’646 Application”). A true and correct copy of the Filing Receipt, as issued by the USPTO, is attached hereto as Exhibit “H” and incorporated herein by reference.

30. After a full and fair examination of the ’646 Application, the Patent Office issued its Notice of Allowance, dated August 5, 2016, on all pending claims of the ’646 Application. A true and

correct copy of said Notice of Allowance is attached hereto as Exhibit “I” and incorporated herein by reference. The Notice of Allowance specifically confirmed that the ’646 Application was duly examined and allowed for issuance as a United States Patent pursuant to federal law and regulations. *See* Ex. I.

31. U.S. Patent No. 9,470,082, entitled “BLOWOUT-PREVENTER-STACK ONE-TRIP TEST TOOL AND METHOD” (hereinafter “’082 Patent”), arising from the ’646 Application, was duly and legally issued on October 18, 2016 to assignee Backoff. A true and correct copy of the ’082 Patent is attached hereto as Exhibit “J” and incorporated herein by reference.

32. All rights arising from the ’082 Patent are in full force and effect under federal law.

33. All rights of priority that arise from the ’082 Patent relate back to May 5, 2015, the date of filing of the ’646 Application.

34. Backoff solely owns all rights, title, and interest in and arising from the ’082 Patent.

35. NuTec is the exclusive licensee of all rights, title, and interest in and arising from the ’082 Patent.

Defendant and the Samoco Patent

36. On November 4, 2016, Defendant and its inventors, Michael Jeremy Hellail, Mahammad Aloudat, and Ranfis Miguel Ramirez, filed a non-provisional U.S. Patent Application under Serial No. 15/343,467, which claims a certain BOP test tool well-known in the prior art; and on December 12, 2017, the USPTO issued the Samoco Patent. The inventors of the Samoco Patent assigned all rights to Samoco. *See* Ex. A. Plaintiffs seek a declaratory judgment of patent invalidity and unenforceability of the Samoco Patent to enable Plaintiffs’ practice of their above-described intellectual property, namely the ’312 Patent, ’771 Patent, and ’082 Patent, related to BOP test

tools, particularly such tools that allow testing of BOP equipment in a single trip, without further interference and threat from Defendant.

37. During a meeting between representatives of Plaintiffs and Defendant on December 13, 2017 in Lake Charles, Louisiana, which Defendant initiated and requested, Defendant represented to Plaintiffs that Samoco is a company that engineers and manufactures, and thereafter markets, licenses, rents, sells, uses, and distributes, tools for the oil and gas industry, particularly in relation to offshore drilling operations, throughout the world. *See* true and correct copy of a PowerPoint presentation of Defendant outlining, among other things, its company, product lineup, marketing and growth strategy, as presented to representatives of Plaintiffs during said December 13, 2017 meeting in Lake Charles, Louisiana, attached hereto as Exhibit “K” and incorporated herein by reference.

38. Based on representations made by the Defendant’s representatives, Defendant’s product lineup includes a BOP test tool, entitled the “Blow Out Preventer (BOP) OneTrip Test Tool,” the “OneTrip Universal BOP Test Tool”, “UBTT”, “OneTrip”, among other similar variations, (hereinafter “Samoco Tool”) that enables the testing of a BOP with only one trip into a wellbore. *See* Ex. K, pgs. 4, 9, 10, and 14.

39. Defendant claims its Samoco Tool practices the Samoco Patent.

40. Defendant’s marketing and growth strategy is dependent upon the Samoco Tool, which derives its value from the Samoco Patent. *See* Ex. K, pg. 4.

41. During the aforementioned December 13, 2017 meeting, Michael Jeremy Hellail, the Chief Executive Officer of Samoco, and other representatives of Defendant, asserted its Samoco Patent against Plaintiffs, contending the coverage of the Samoco Patent over the Samoco Tool and other

similar BOP test tools, including the BOP test tools of NuTec, and the alleged validity and enforceability of the Samoco Patent.

42. During said meeting, Defendant's representatives expressed their desire and intent of a joint-venture, complete or partial merger, and/or licensing agreement between Plaintiffs, particularly NuTec, and Defendant, based solely upon the Samoco Tool and Samoco Patent.

43. Defendant, through the marketing and selling of its Samoco Tool, is attempting to capture a significant market share in the BOP test tool market, particularly in relation to fulfilling tests of BOPs in a single trip. In doing so, Defendant is attempting to coerce Plaintiffs into a joint-venture, complete or partial merger, and/or licensing agreement with Defendant by asserting the Samoco Patent against Plaintiffs.

44. Defendant's actions in relation to the Samoco Patent place a cloud of uncertainty and doubt over the practices of Plaintiffs, which actions will persist absent a resolution of determining the validity or invalidity of the Samoco Patent.

45. This controversy is amenable to specific relief through a decree from this Court.

46. The Samoco Patent is invalid by failing to meet the conditions for patentability.

47. Each claim of the Samoco Patent is invalid for lack of novelty.

48. For instance, and without limiting the grounds of invalidity that will be asserted in this action, claims 1 through 12 of the Samoco Patent are each anticipated by Backoff's '312 Patent. *See Ex. A and Ex. D.*

49. Each claim of the Samoco Patent is invalid as obvious in view of the prior art.

50. For instance, and without limiting the grounds of invalidity that will be asserted in this action, claims 1 through 12 of the Samoco Patent are each obvious over Backoff's '312 Patent in

view of U.S. Patent No. 4,862,976 (hereinafter “Meek”) and further in view of U.S. Patent No. 3,537,731 (hereinafter “Reddy”). *See* Ex. A, Ex. D, and, *infra*, Ex. L and Ex. M.

51. A true and correct copy of Meek is attached hereto as Exhibit “L” and incorporated herein by reference.

52. A true and correct copy of Reddy is attached hereto as Exhibit “M” and incorporated herein by reference.

53. Each claim of the Samoco Patent is invalid in view of existing prior art and the knowledge of a person of ordinary skill in the art.

54. Each claim of the Samoco Patent is invalid as being indefinite for failing to particularly point out and distinctly claim the subject matter that the inventors regard as their invention.

FEDERAL CLAIMS

Declaratory Judgment of Invalidity and Unenforceability of the Samoco Patent 28 U.S.C. § 2201(a), 2202

55. Plaintiffs hereby re-allege and incorporate by reference each and every preceding allegation contained in Paragraphs 1 through 54 hereof as if fully set forth herein.

56. Plaintiffs reasonably apprehend that Defendant may further assert the Samoco Patent against Plaintiffs.

57. The Samoco Patent is invalid because the purported inventions therein fail to meet the conditions for patentability specified in 35 U.S.C. § 101, including but not limited to 35 U.S.C. §§ 102, 103, and 112.

58. By way of example and without limiting the grounds of invalidity that will be asserted in this action, each claim of the Samoco Patent is invalid in view of prior art references and/or the knowledge of a person of ordinary skill in the art, and/or for failure to comply with the provisions of 35 U.S.C. § 112.

59. A declaratory judgment is both necessary and appropriate so that Plaintiffs may ascertain the purported rights under the Samoco Patent in view of the conduct and contentions of Defendant described herein.

60. A substantial and continuing controversy of sufficient immediacy and reality exists, constituting as a valid and justiciable controversy between the parties that requires issuance of a declaratory judgment under 28 U.S.C. §§ 2201(a) and 2202, and Fed. R. Civ. P. 57, that the Samoco Patent is invalid.

61. Plaintiffs are entitled to a judicial declaration that the Samoco Patent is invalid for failure to comply with one or more of the requirements of Title 35 of the United States Code.

62. Plaintiffs are entitled to a judicial declaration that the Samoco Patent is unenforceable under Title 35 of the United States Code.

63. Defendant's acts, as alleged herein, occurred with full knowledge of the well-known prior art, including but not limited to Backoff's '312 Patent, '771 Patent, and '082 Patent. Such acts constitute willful and intentional acts in derogation of Plaintiffs' rights in and to the aforementioned patents and make this case an exceptional case under 35 U.S.C. § 285, and thereby Plaintiffs are entitled to reasonable attorney fees on their claims of invalidity and/or unenforceability of the Samoco Patent.

PRAYER FOR RELIEF

WHEREFORE, Plaintiffs, Backoff, LLC and NuTec, Inc., respectfully pray that this Court enter judgment in their favor and against Defendant, Samoco Oil Tools, Inc., on all claims for relief asserted herein, as follows:

- A. Declaring the Samoco Patent invalid;
- B. Declaring the Samoco Patent unenforceable;

- C. Declaring that this case is exceptional under 35 U.S.C. § 285;
- D. Preliminarily and permanently restraining and enjoining Defendant and its officers, directors, employees, servants, agents, affiliates, attorneys, and all others acting in privity or in concert with it, and its parents, subsidiaries, divisions, successors, and assigns, from asserting and enforcing the Samoco Patent under the principles of equity, on such terms as the court deems reasonable, in accordance with 35 U.S.C. § 283;
- E. Awarding Plaintiffs their costs and attorney fees; and
- F. Granting Plaintiffs such other and further relief as this Court deems just and proper.

Respectfully submitted,

Dated: April 11, 2018

/s./ Matthew M. Mize

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