

**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

ZURN INDUSTRIES, LLC,)	
)	
Plaintiff,)	
)	
v.)	CASE NO. _____
)	
MIFAB, INC.,)	
)	
Defendant.)	

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff Zurn Industries, LLC (“Zurn”) files this Complaint and demand for a jury trial seeking relief for patent infringement by Defendant MiFab, Inc. (“MiFab”). Plaintiff states and alleges the following:

THE PARTIES

1. Zurn is a limited liability company organized and existing under the laws of the State of Delaware, with its principal place of business located at 511 Freshwater Way, Milwaukee, Wisconsin 53204.

2. On information and belief, Defendant MiFab is a corporation organized and existing under the laws of the State of Delaware, with its principal place of business located at 1321 West 119th Street, Chicago, Illinois 60643.

NATURE OF THE ACTION

3. This is a civil action for infringement of Zurn’s United States Patent Nos. 7,784,242 (the “242 Patent”) and 8,006,449 (the “449 Patent”) (collectively, the “Asserted Patents”).

JURISDICTION AND VENUE

4. This is an action for patent infringement arising under the laws of the United States, 35 U.S.C. §§ 1 et seq. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a).

5. On information and belief, this Court has personal jurisdiction over MiFab because MiFab's principal place of business is in Illinois, it regularly conducts business in this District and therefore has substantial and continuous contacts with this District, because it has a regular and established place of business in this District, and/or because it has committed acts of patent infringement in this District.

6. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b) and (c) and 1400(b).

ZURN AND THE ASSERTED PATENTS

Plaintiff Zurn

7. As a trusted leader in the commercial plumbing industry for over 100 years, Zurn provides the widest breadth of advanced water solutions spanning from backflow prevention to behind-the-wall plumbing systems and front-of-the-wall fixtures to building and site drainage. Zurn engineers products that deliver sustainability, accessibility, and water conservation, as well as services that contribute to streamlined specification, lean construction, and compliance.

8. Today, Zurn is a recognized leader in commercial, municipal, healthcare, and industrial markets. Zurn offers the largest breadth of engineered water solutions, including a wide spectrum of sustainable plumbing products. Zurn delivers total building solutions for new construction and retrofit applications that enhance any building's environment.

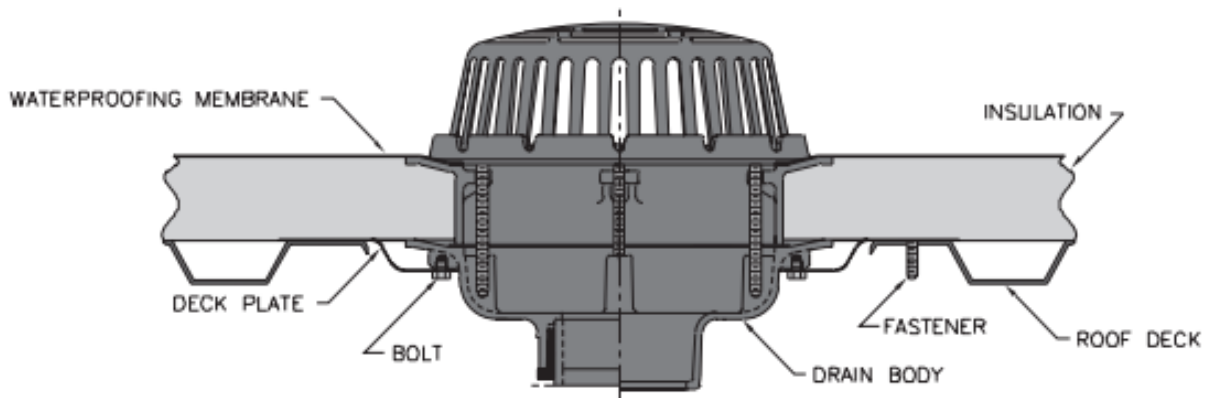
The '242 Patent and '449 Patent

9. Deck plate roof drains are commonly installed in building roofs to prevent rainwater from accumulating.

10. In a common building roof, a deck is overlaid with building materials such as waterproofing membranes, insulation, or concrete. The roof drain is connected to the deck.

11. When installing a traditional drain assembly, installers cut an opening in the deck and placed the body of the drain in the opening from the top. The installers then had to enter the building to securely fasten the drain body to the deck from underneath the deck. This installation method required the installers to have installation expertise to properly install the drain. This installation method also increased installation time by requiring the installers to fasten both the top and bottom of the structure.

12. As a solution to these problems, Zurn introduced its Top-Set® line of roof drains to the market. An example of which is depicted below.



13. Zurn's Top-Set® roof drains include a novel combined drain support plate and under deck clamp assembly, which reduces the drain installation time and expense by eliminating a bottom installation of a drain and allowing installers to install the drain from the top.

14. The inventor of Zurn's Top-Set® roof drains was awarded two patents for his novel and innovative design and related installation method.

15. On August 31, 2010, the '242 Patent, entitled "Drain Support Plate/Under-Deck Clamp," was duly and legally issued by the United States Patent and Trademark Office. Zurn owns the entire right, title, and interest in the '242 Patent by assignment. A true and correct copy of the '242 Patent is attached as **Exhibit 1**.

16. On August 30, 2011, the '449 Patent, entitled "Drain Support Plate/Under-Deck Clamp," was duly and legally issued by the United States Patent and Trademark Office. Zurn owns the entire right, title, and interest in the '449 Patent by assignment. A true and correct copy of the '449 Patent is attached as **Exhibit 2**.

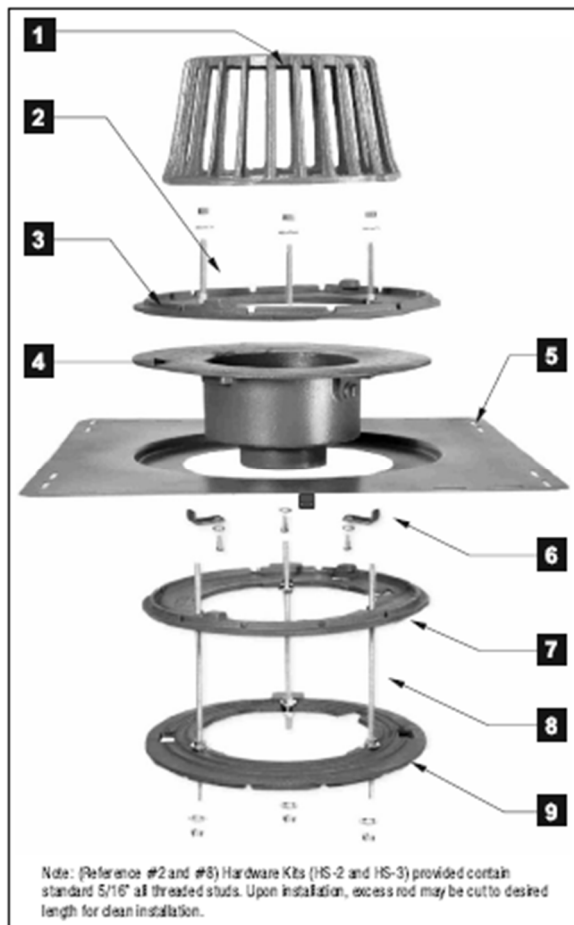
17. The '449 Patent is a continuation of the '242 Patent.

18. The '242 Patent and '449 Patent relate to a combined drain support plate and under-deck clamp for mounting and securing a drain assembly to the roof deck of a building and a method of installing the same.

MIFAB'S INFRINGING ACTS

19. MiFab is engaged in the business of designing, manufacturing, and selling engineered plumbing and drainage products in the non-residential construction industry and is a competitor of Zurn in the non-residential plumbing and drainage product market.

20. After Zurn introduced its Top-Set® drains, MiFab began selling drain and deck plate assemblies (the "MiFab Deck Plate Assemblies"), including its A2-BP Roof Drain Sump Receiver and A2 Roof Drain, which are depicted below.



A true and correct copy of an excerpt from MiFab's 2019 Catalog is attached as **Exhibit 3**.

21. MiFab advertises that the advantages of the MiFab Deck Assemblies include easy assembly, eliminating the costly underdeck clamp, and eliminating the labor required to install in the underdeck clamp. *See e.g., id.*

MiFab's Knowledge of the Asserted Patents

22. On information and belief, MiFab has had actual knowledge of the Asserted Patents through competitive analysis.

23. In addition, Zurn has provided MiFab with written notice of the Asserted Patents and requested that MiFab cease infringing its patent rights.

24. In August 2021, Zurn sent a letter to MiFab identifying the '242 Patent and the '449 Patent and providing formal written notice to MiFab that it has infringed and continues to infringe the patents. The letter requested that MiFab immediately cease infringement of the '242 Patent and the '449 Patent. A true and correct copy of the letter to MiFab is attached as **Exhibit 4**.

25. Included with Zurn's August 2021 letter to MiFab were infringement claim charts that identify how the '242 Patent and the '449 Patent read on the MiFab Deck Plate Assemblies and methods of installing the same. True and correct copies of the claim charts are attached as **Exhibit 5**.

26. In its letter, Zurn requested that MiFab provide written confirmation that it will cease infringing Zurn's patent rights. Notwithstanding this notice, MiFab has not ceased infringing the Asserted Patents.

COUNT I – INFRINGEMENT OF THE '242 PATENT

27. Zurn realleges and incorporates by reference as if fully set forth herein the allegations contained in paragraphs 1 through 26.

28. On information and belief, MiFab has been, and continues to be, directly infringing, either literally or under the doctrine of equivalents, at least claim 18 of the '242 Patent by making, using, selling, importing, and/or offering for sale within the United States the MiFab Deck Plate Assemblies and by assembling and installing the MiFab Deck Plate Assemblies.

29. A non-limiting example of one of the infringing MiFab Deck Plate Assemblies is pictorially represented as follows:

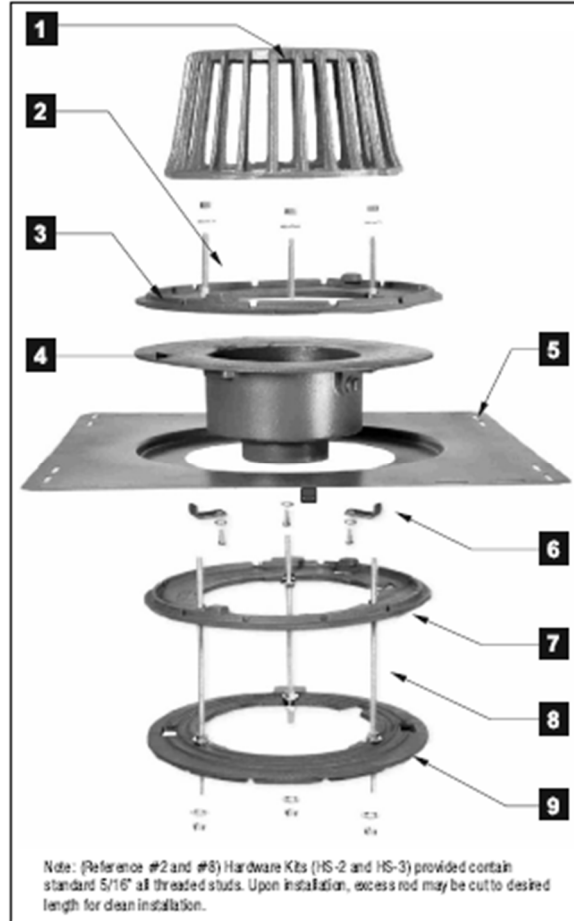


Exhibit 3.

30. A claim chart detailing how exemplary MiFab Deck Plate Assemblies infringe claim 18 of the '242 Patent is attached as **Exhibit 5**.

31. MiFab's actions constitute infringement under 35 U.S.C. § 271(a).

32. Additionally or in the alternative, MiFab has been, and continues to be, indirectly infringing, either literally or under the doctrine of equivalents, at least claim 18 of the '242 Patent by inducing third-party infringement of the '242 Patent.

33. Third-party installers are and continue to directly infringe the '242 Patent by assembling the roof drain and roof drain sump receiver of the MiFab Deck Plate Assemblies

manufactured and sold by MiFab. Third-party installers are and continue to directly infringe the '242 Patent by assembling and installing the MiFab Deck Plate Assemblies.

34. MiFab has intentionally induced others to infringe the '242 Patent by encouraging others to use its infringing products to assemble and install MiFab Deck Plate Assemblies that can only be obtained through use of the patented apparatuses and the practice of the patented methods. MiFab induced infringement of the '242 Patent by encouraging and facilitating infringing use of the accused MiFab Deck Plate Assemblies by users of the accused MiFab Deck Plate Assemblies in the United States by taking active steps to encourage and facilitate others' direct infringement of the '242 Patent with knowledge of that infringement.

35. For example, MiFab intentionally instructed third parties to make, use, and install MiFab Deck Plate Assemblies, including by instructing third parties to form and subsequently install a drain assembly by assembling the bolts into the tappings on the underside of the A2 body flange and securing the A2-BP to the underside of the A2 body flange with the three cast iron brackets at the same time, resulting in a roof drain secured to the A2-BP and also to the roof deck. *See, e.g., Exhibit 3*; MIFAB University, *MIFAB University Product Training: Roof Drains*, YouTube (Feb. 28, 2013), <https://www.youtube.com/watch?v=uEkEgTUQpOQ> (last visited Nov. 15, 2022).

36. Additional affirmative acts of inducement include, without limitation, advertising, marketing, promoting, offering for sale and/or selling the accused MiFab Deck Plate Assemblies as shown at <https://www.mifab.com/>. On information and belief, MiFab further provides instructions, user manuals, advertising, and/or marketing materials that facilitate, direct, or encourage direct infringement in the United States as shown at <https://www.mifab.com/>. An additional non-limiting example of such information is attached as **Exhibit 3**.

37. MiFab had actual or constructive knowledge of the '242 Patent at least as early as the August 2021 letter. *See Exhibit 4.*

38. On information and belief, MiFab knew or should have known that the acts of the third parties it encouraged by its inducing acts would result in direct infringement and had a specific and actual intent to cause the acts which constitute the infringement by its inducing acts.

39. MiFab's actions indicate an intent to actively induce infringement, and, thus, constitute active inducement under 35 U.S.C. § 271(b).

40. Additionally or in the alternative, MiFab has been, and continues to be, indirectly infringing, either literally or under the doctrine of equivalents, at least claim 18 of the '242 Patent by contributing to third-party infringement of the '242 Patent.

41. MiFab continues to and has made, sold, imported, and/or offered for sale in the United States MiFab Deck Plate Assemblies for use in practicing the claims of the '242 Patent knowing that its MiFab Deck Plate Assemblies were especially made or adapted for use in the infringement of the '242 Patent.

42. The components of the MiFab Deck Plate Assemblies are material parts of the patented invention and not staple articles capable of a substantial non-infringing use.

43. MiFab's actions constitute contributory infringement under 35 U.S.C. § 271(c).

44. MiFab's infringement of the '242 Patent has caused, and continues to cause, damage to Zurn in an amount to be proven at trial.

45. On information and belief, MiFab's infringement has been intentional, willful, and in reckless disregard of Zurn's rights.

46. On information and belief, MiFab will continue to infringe the '242 Patent causing immediate and irreparable harm to Zurn, for which Zurn has no adequate remedy at law, unless and until this Court enjoins and restrains MiFab's infringing activities.

COUNT II – INFRINGEMENT OF THE '449 PATENT

47. Zurn realleges and incorporates by reference as if fully set forth herein the allegations contained in paragraphs 1 through 46.

48. On information and belief, MiFab has been, and continues to be, directly infringing, either literally or under the doctrine of equivalents, at least claim 16 of the '449 Patent by making, using, selling, importing, and/or offering for sale within the United States the MiFab Deck Plate Assemblies.

49. A non-limiting example of the MiFab Deck Plate Assemblies, is pictorially represented as follows:

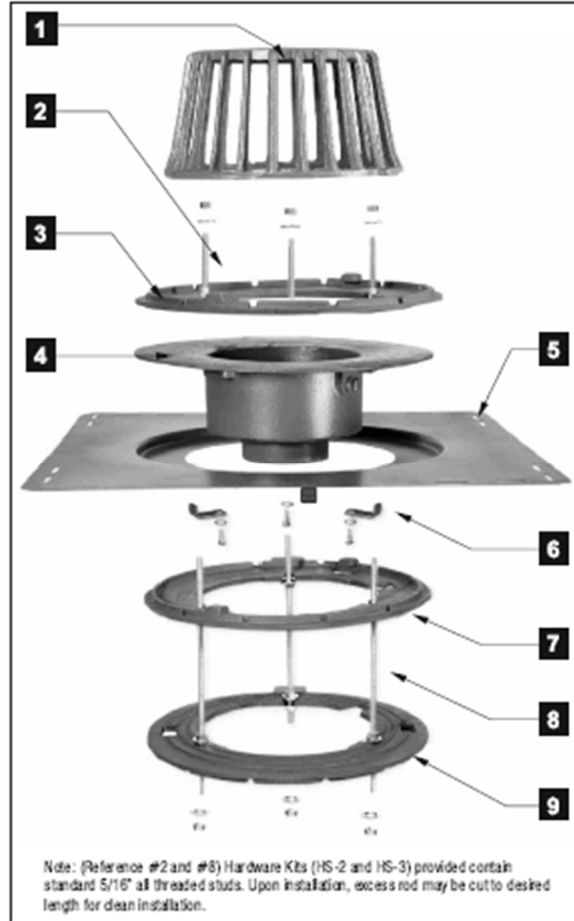


Exhibit 3.

50. A claim chart detailing how the exemplary MiFab Deck Plate Assemblies infringe claim 16 of the '449 Patent is attached as **Exhibit 5**.

51. MiFab's actions constitute infringement under 35 U.S.C. § 271(a).

52. Additionally or in the alternative, MiFab has been, and continues to be, indirectly infringing, either literally or under the doctrine of equivalents, at least claim 16 of the '449 Patent by inducing third-party infringement of the '449 Patent.

53. Third-party installers are and continue to directly infringe the '449 Patent by assembling the drain body and deck plate of the MiFab Deck Plate Assemblies manufactured and

sold by MiFab. Third-party installers are and continue to directly infringe the '449 Patent by assembling and installing the MiFab Deck Plate Assemblies.

54. MiFab has intentionally induced others to infringe the '449 Patent by selling MiFab Deck Plate Assemblies to others with materials and instructions for operation in a manner that can only be obtained through infringing the patented assembly, with the specific intent and knowledge that the materials direct, teach, or assist others to infringe the '449 Patent. MiFab induced infringement of the '449 Patent by encouraging and facilitating infringing use of the MiFab Deck Plate Assemblies by users of the MiFab Deck Plate Assemblies in the United States by taking active steps to encourage and facilitate others' direct infringement of the '449 Patent with knowledge of that infringement.

55. For example, MiFab intentionally instructed third parties to make, use, and install MiFab Deck Plate Assemblies, including by instructing third parties to form and subsequently install a drain assembly by assembling the bolts into the tappings on the underside of the A2 body flange and securing the A2-BP to the underside of the A2 body flange with the three cast iron brackets at the same time, resulting in a roof drain secured to the A2-BP and also to the roof deck. *See, e.g., Exhibit 3*; MIFAB University, *MIFAB University Product Training: Roof Drains*, YouTube (Feb. 28, 2013), <https://www.youtube.com/watch?v=uEkEgTUQpOQ> (last visited Nov. 15, 2022).

56. Additional affirmative acts of inducement include, without limitation, advertising, marketing, promoting, offering for sale and/or selling the accused MiFab Deck Plate Assemblies as shown at <https://www.mifab.com/>. MiFab further provides instructions, user manuals, advertising, and/or marketing materials on MiFab's website that facilitate, direct, or encourage

direct infringement in the United States as shown at <https://www.mifab.com/>. A non-limiting example of such information is attached as **Exhibit 3**.

57. MiFab had actual or constructive knowledge of the '449 Patent at least as early as the August 2021 letter. *See* **Exhibit 4**.

58. On information and belief, MiFab knew or should have known that the acts of the third parties it encouraged by its inducing acts would result in direct infringement and had a specific and actual intent to cause the acts which constitute the infringement by its inducing acts.

59. On information and belief, MiFab's actions indicate an intent to actively induce infringement, and, thus, constitute active inducement under 35 U.S.C. § 271(b).

60. Additionally or in the alternative, MiFab has been, and continues to be, indirectly infringing, either literally or under the doctrine of equivalents, at least claim 16 of the '449 Patent by contributing to third-party infringement of the '449 Patent.

61. MiFab continues to and has made, sold, imported, and/or offered for sale in the United States MiFab Deck Plate Assemblies for use in the apparatus claimed in the '449 Patent knowing that the MiFab Deck Plate Assemblies were especially made or adapted for use in the infringement of the '449 Patent.

62. On information and belief, the components of the MiFab Deck Plate Assemblies are material parts of the patented invention and not staple articles capable of a substantial non-infringing use.

63. MiFab's actions constitute contributory infringement under 35 U.S.C. § 271(c).

64. MiFab's infringement of the '449 Patent has caused, and continues to cause, damage to Zurn in an amount to be proven at trial.

65. On information and belief, MiFab's infringement of the '449 Patent has been intentional, willful, and in reckless disregard of Zurn's rights.

66. On information and belief, MiFab will continue to infringe the '449 Patent causing immediate and irreparable harm to Zurn, for which Zurn has no adequate remedy at law, unless and until this Court enjoins and restrains MiFab's activities.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Zurn Industries, LLC respectfully requests that this Court:

A. Enter judgment that Defendant has infringed one or more claims of the '242 Patent and '449 Patent directly, by intentional inducement and/or contributorily;

B. Enter an order preliminarily and permanently enjoining Defendant and its officers, agents, employees, attorneys, and all persons in active concert or participation with any of them, from infringing the '242 Patent and '449 Patent;

C. Award Zurn damages in an amount sufficient to compensate it for Defendant's infringement of the '242 Patent and '449 Patent, together with pre-judgment interest and costs, and all other damages permitted under 35 U.S.C. § 284;

D. Award Zurn an accounting for acts of infringement not presented at trial and an award by the Court of additional damage for any such acts of infringement;

E. Treble the damages awarded to Zurn under 35 U.S.C. § 284 by reason of Defendant's willful infringement of at least one claim of the '242 Patent and '449 Patent;

F. Declare this case to be "exceptional" under 35 U.S.C. § 285 and award Zurn its attorneys' fees, expenses and costs incurred in this action; and

G. Award Zurn such other and further relief as this Court deems just and proper.

JURY TRIAL DEMAND

Zurn demands a jury trial on all issues so triable.

Dated this 16th day of November, 2022.

Respectfully submitted,

/s/ Kristin Graham Noel

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