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19 *Midwest Industrial Supply, Inc.*

20 **UNITED STATES DISTRICT COURT**
 21 **IN AND FOR THE DISTRICT OF ARIZONA**

22 SOILWORKS, LLC, an Arizona
 23 corporation,
 24
 25 Plaintiff / Counterdefendant /
 26 Counterclaimant,

27 NO.: 2:06-CV-2141-DGC

28 v.
 29 MIDWEST INDUSTRIAL SUPPLY,
 30 INC., an Ohio corporation authorized to do
 31 business in Arizona,
 32
 33 Defendant / Counterclaimant /
 34 Counterdefendant.

35 **MIDWEST INDUSTRIAL SUPPLY,
 36 INC.'S MOTION *IN LIMINE* TO
 37 LIMIT SOILWORKS, LLC'S
 38 EVIDENCE OF MIDWEST'S
 39 ALLEGED FALSE ADVERTISING
 40 TO THE FOUR DOCUMENTS IT
 41 PRODUCED DURING DISCOVERY**

42 **I. INTRODUCTION**

43 Defendant Midwest Industrial Supply, Inc. ("Midwest") moves this Court *in limine* to
 44 limit the evidence upon which Plaintiff Soilworks, LLC ("Plaintiff") may rely to prove
 45 Midwest's alleged violations of the Lanham Act and Arizona's Common Law of Unfair
 46 Competition to the four documents it produced during discovery and on which the

1 development of this case has focused.¹

2 **II. ARGUMENT**

3 In its First Requests for Production of Documents and Things, Midwest asked
4 Plaintiff for documents that supported its claims:

5
6 27. [Produce] [a]ll documents, things, and electronically stored information
7 concerning any and all factual bases for each and every claim set forth in
8 Plaintiff's Complaint and/or Counterclaims.

9 28. [Produce] [a]ll documentary, physical, and electronically stored evidence
10 that Plaintiff may or intends to rely upon in any pleading, at trial, and/or any
11 hearing in this action.

12 (Soilworks, LLC'S Responses to Midwest Industrial Supply, Inc.'s First Request for
13 Production of Documents and Things ("Plaintiff's Response"), Request 27 and 28, relevant
14 pages attached as Exhibit A). Plaintiff did not initially provide documents that were
15 responsive to either document request. Instead, it answered that it would provide responsive
16 documents after the Court entered a protective order. Plaintiff also answered that it would
17 provide a privilege log in response to the requests.

18 Plaintiff, however, failed to provide a privilege log. Furthermore, Plaintiff *only*
19 provided four documents which allegedly supported its Lanham Act claims and its Arizona
20 Common Law claim of unfair competition (the "False Advertising Claims"). Those four
21 documents were:

- 22 (i) Two letters, dated July 27, 2006, from Midwest to Polar Supply, in which
23 Midwest informs Polar Supply that Soilworks may be violating Midwest's
24 patent;
25 (ii) A press release from Midwest, announcing its new patent; and
26 (iii) A chart from Midwest's former website that compared Midwest's and
27 Plaintiff's products.

28 ¹ This motion is limited to the allegedly false statements on which Soilworks' false
advertising claim is based. Midwest has filed another motion in limine regarding the
remaining elements of the claim.

1 At no time did Plaintiff later supplement its responses to the document requests to add
2 new information. Thus, Plaintiff is limited pursuant to Fed. Civ. R. 37(c) to these four
3 documents on which to prove its False Advertising Claims.
4

5 Rule 26(e) of the Federal Rules of Civil Procedure requires that “[a] party who has ...
6 responded to ... [a] request for production ... must supplement or correct its disclosure or
7 response.” Rule 37(c) of the Federal Rules of Civil Procedure provides that a party which
8 fails to supplement its answers with new information – if its failure is not substantially
9 justified or harmless – is “not allowed to use that information.” *See Zhang v. American*
10 *Gem Seafoods, Inc.*, 339 F.3d 1020, 1028 (9th Cir. 2003); *see also International Flora*
11 *Technologies, Ltd. v. Clarins U.S.A., Inc.*, Case No. 06-1372, 2008 WL 4174894 (D.Ariz.
12 2008) (holding that a non-disclosed patent claim was excluded pursuant to Fed. Civ. 37(c)).
13
14

15 If Plaintiff has other documents supporting its False Advertising Claims, it should
16 have supplemented its responses to provide those documents. Plaintiff’s failure to do so
17 would result in sanction, pursuant to Rule 37(c), excluding the evidence. Thus, Plaintiff’s
18 proof in support of its False Advertising Claims should be limited to the four documents
19 discussed above and testimony it may elicit regarding those documents.
20

21 **III. CONCLUSION**

22 For the foregoing reasons, Midwest respectfully submits that the Court should enter
23 an order limiting the evidence upon which Plaintiff may rely to prove Midwest’s alleged
24 violations of the Lanham Act and Arizona’s Common Law of Unfair Competition to the four
25 documents it produced during discovery.
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Respectfully Submitted

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **MIDWEST INDUSTRIAL SUPPLY, INC.’S MOTION *IN LIMINE* TO LIMIT SOILWORKS, LLC’S EVIDENCE OF MIDWEST’S ALLEGED FALSE ADVERTISING TO THE FOUR DOCUMENTS IT PRODUCED DURING DISCOVERY** has been electronically filed on this 17th day of September, 2008. Notice of this filing will be sent to all parties by operation of the Court’s electronic filing system. Parties may access this filing through the Court’s system.

/s/ Jill A. Bautista
Jill A. Bautista

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