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17 *Attorneys for Defendant/Counterclaimant*
 18 *Midwest Industrial Supply, Inc.*

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

21 SOILWORKS, LLC, an Arizona
 22 corporation,

23 Plaintiff / Counterdefendant /
 24 Counterclaimant,

v.

25 MIDWEST INDUSTRIAL SUPPLY,
 26 INC., an Ohio corporation authorized to do
 27 business in Arizona,

28 Defendant / Counterclaimant /
 Counterdefendant.

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

**MIDWEST INDUSTRIAL SUPPLY,
 INC.'S MOTION IN LIMINE TO
 BAR TESTIMONY AND EVIDENCE
 REGARDING THE VALIDITY OR
 CONSTRUCTION OF MIDWEST'S
 PATENTS**

I. INTRODUCTION

Defendant Midwest Industrial Supply, Inc. ("Midwest") moves this Court for an order, *in limine*, barring Plaintiff Soilworks, LLC ("Plaintiff") from introducing any evidence or testimony regarding the validity or construction of Midwest's patents' claims.

1 **II. ARGUMENT**

2 Rule 26(e) of the Federal Rules of Civil Procedure requires a party who has
3 responded to an interrogatory, request for production, or request for admission to
4 supplement or correct its disclosure or response. Rule 37(c)(1) of the Federal Rules of
5 Civil Procedure provides that a party's failure to disclose information required by rule
6 26(e), without substantial justification, bars use of that evidence at trial or in any motion
7 unless such failure is harmless. *See also, Zhang v. American Gem Seafoods, Inc.*, 339
8 F.3d 1020, 1027 (9th Cir. 2003); *Yeti by Molly, Ltd. v. Deckers Outdoor Corp.*, 259 F.3d
9 1101, 1106 (9th Cir. 2001); *E.E.O.C. v. GLC Restaurants, Inc.*, Case No. CV05-618,
10 2007 WL 30269 (D.Ariz. 2007) (excluding evidence based on Fed.R.Civ.P. 37(c)).

11 Midwest requested Plaintiff to identify the claims that are ambiguous or required
12 definition or construction and a detailed statement setting forth the meaning that Plaintiff
13 contends is the correct construction. (See Soilworks, LLC's Answers to Midwest
14 Industrial Supply, Inc.'s First Set of Interrogatories, Interrogatory 10, relevant pages
15 attached as Exhibit A). Midwest also requested any opinions, reports, studies,
16 documents, and patent searches requested, obtained, or drafted by Plaintiff related to
17 Midwest's Patents. (See *Id.*, Interrogatory 15). Plaintiff replied, in both instances, that
18 the interrogatories were premature and that it would provide documents in answer to the
19 interrogatories. Plaintiff has not provided any relevant documents in reply to these
20 interrogatories or supplemented its initial reply. Therefore, Plaintiff should be barred
21 from producing any evidence related to these interrogatories at trial.
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1 On August 7, 2008, this Court granted Midwest's claim for a declaratory judgment
2 that its two patents were valid. As a result, Plaintiff should be barred from presenting any
3 evidence which challenges the validity of Midwest's patents, including any defenses to
4 Midwest's claim of patent infringement based on invalidity (i.e., obviousness).
5

6 Finally, Plaintiff should be barred from presenting any evidence challenging or
7 varying the construction of Midwest's patents. If Plaintiff wishes to challenge the
8 construction or interpretation of Midwest's patents, the proper procedure for such a
9 challenge is a *Markman* hearing. While Plaintiff may still request a *Markman* hearing in
10 accordance with this Court's Case Management Order (ECF Docket No. 28), the hearing,
11 at this juncture, would be useless as a *Markman* hearing necessarily requires expert
12 testimony. Plaintiff did not disclose any expert witnesses by December 14, 2007, the
13 date required in the Court's Case Management Order. Further, as stated above, Plaintiff
14 has not supplemented its response to Midwest's request for Plaintiff's contentions to its
15 claim construction or its contended interpretation of Midwest's patents. Thus, Plaintiff
16 would be barred from presenting any evidence at the *Markman* hearing. Finally, Plaintiff
17 has failed to request a *Markman* hearing since this case was filed. Therefore, the Court
18 should bar Plaintiff from presenting any evidence of claim construction at trial and
19 Midwest's patents should be interpreted in accordance with their ordinary meaning.
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23 **III. CONCLUSION**

24 For the foregoing reasons, the Court should enter an order precluding Plaintiff
25 from presenting any evidence or testimony regarding the construction or validity of
26 Midwest's patents.
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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 BAR TESTIMONY AND EVIDENCE REGARDING THE VALIDITY OR CONSTRUCTION OF MIDWEST’S PATENTS** 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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