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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 Plaintiff / Counterdefendant /
 25 Counterclaimant,

26 v.

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

Defendant / Counterclaimant /
 Counterdefendant.

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

**MIDWEST INDUSTRIAL SUPPLY,
 INC.’S MOTION *IN LIMINE* TO
 BAR EVIDENCE REGARDING ANY
 LEGAL ADVICE SOILWORKS, LLC
 MAY HAVE RECEIVED
 CONCERNING MIDWEST’S
 PATENTS**

I. INTRODUCTION

Defendant Midwest Industrial Supply, Inc. (“Midwest”) moves this Court *in limine* to preclude Plaintiff Soilworks, LLC (“Plaintiff”) from presenting any evidence regarding any legal advice it may have received concerning Midwest’s Patents.

1 **II. ARGUMENT**

2 In its First Set of Interrogatories, Midwest asked Plaintiff whether it received any
3 advice from counsel “pertaining to the infringement, validity and/or enforceability ... of the
4 Midwest Patents.” (Soilworks, LLC’s Answers to Midwests Industrial Supply, Inc.’s First
5 Set of Interrogatories (“Plaintiff’s Answer”), Interrogatory 11, relevant pages attached as
6 Exhibit A). Additionally, in its First Requests for Production of Documents and Things,
7 Midwest asked Plaintiff for documents pertaining to any legal advice it may have received
8 concerning Midwest’s patents. (Soilworks, LLC’S Responses to Midwest Industrial Supply,
9 Inc.’s First Request for Production of Documents and Things (“Plaintiff’s Response”),
10 Request 20, relevant pages attached as Exhibit B).

13 Plaintiff did not initially respond to either the interrogatory or the document request,
14 and further, it later failed to supplement its answer to the interrogatory and its response to the
15 document request to add new information. Plaintiff, thus, is precluded pursuant to Fed. Civ.
16 R. 37(c) from introducing any evidence at trial of any "Advice of Counsel" defense or any
17 other evidence suggesting any reliance by Soilworks on input of Counsel regarding
18 Midwest's Patents in any way.

21 Rule 26(e) of the Federal Rules of Civil Procedure requires that “[a] party who has ...
22 responded to an interrogatory [or a] request for production ... must supplement or correct its
23 disclosure or response.” Rule 37(c) of the Federal Rules of Civil Procedure provides that a
24 party which fails to supplement its answers with new information – if its failure is not
25 substantially justified or harmless – is “not allowed to use that information.” *See Zhang v.*
26 *American Gem Seafoods, Inc.*, 339 F.3d 1020, 1028 (9th Cir. 2003) (holding that non-
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28

1 disclosed manual was excluded pursuant to Fed.Civ.R. 37(c)); *see also Yeti by Molly, Ltd. v.*
2 *Deckers Outdoor Corp.*, 259 F.3d 1101, 1106 (9th Cir. 2007); *International Flora*
3 *Technologies, Ltd. v. Clarins U.S.A., Inc.*, Case No. 06-1372-PHX-ROS, 2008 WL 4174894
4 (D.Ariz. 2008) (holding that a non-disclosed patent claim was excluded pursuant to Fed. Civ.
5 37(c)(1)).
6

7 In response to Midwest's Interrogatory 11, Plaintiff answered that the request was not
8 applicable. (Plaintiff's Answer, 11, Ex. A). Again, Plaintiff failed to supplement its answer
9 to provide any further response. Thus, and for this reason as well, Plaintiff is precluded,
10 pursuant to Fed.Civ.R. 37(c), from introducing any evidence at trial that it received any legal
11 advice concerning Midwest's Patents.
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13 In response to Midwest's Request for Production 20, Plaintiff objected that the
14 documents were protected by privilege and asserted that, if there were responsive documents,
15 it would provide a privilege log. (Plaintiff's Response, 20, Ex. B). Despite Midwest's
16 multiple inquiries, however, Plaintiff also failed to provide a privilege log. Thus, according to
17 Fed. Civ. R. 37(c), Plaintiff, again, is precluded from introducing any documents at trial
18 regarding any legal advice it received concerning Midwest's Patents.
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21 **III. CONCLUSION**

22 For the foregoing reasons, Midwest respectfully submits that the Court should enter
23 an order precluding Plaintiff from presenting any evidence regarding any legal advice it may
24 have received concerning 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 EVIDENCE REGARDING ANY LEGAL ADVICE SOILWORKS, LLC MAY HAVE RECEIVED CONCERNING 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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