

1 E. SCOTT DOSEK #012114  
 JOHN P. PASSARELLI #16018 (NE)  
 2 KUTAK ROCK LLP  
 Suite 300  
 3 8601 North Scottsdale Road  
 Scottsdale, AZ 85253-2742  
 4 (480) 429-5000  
 Facsimile: (480) 429-5001  
 5

6 *Attorneys for Plaintiff / Counterdefendant /  
 Counterclaimant Soilworks, LLC*

7 **UNITED STATES DISTRICT COURT**  
 8 **IN AND FOR THE DISTRICT OF ARIZONA**

9 SOILWORKS, LLC, an Arizona  
 10 corporation,

11 Plaintiff / Counterdefendant /  
 Counterclaimant,

12 v.

13 MIDWEST INDUSTRIAL SUPPLY, INC.,  
 an Ohio corporation authorized to do  
 14 business in Arizona,

15 Defendant / Counterclaimant /  
 Counterdefendant.  
 16

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

**SOILWORKS' MOTION FOR LEAVE  
 TO ADD EXHIBIT AND WITNESS  
 TO FINAL PRETRIAL ORDER**

(Before the Honorable David G. Campbell)

17 Soilworks respectfully requests leave of Court to permit the addition of the Report of  
 18 Analysis (as described below and attached hereto as **Exhibit 1**) to its list of exhibits and add  
 19 Neal E. Spingarn, Ph.D., the author of the report as a witness to testify at trial. In support of  
 20 this Motion, Soilworks submits the following:

21 On January 9, 2009, for the first time in this litigation, Midwest Industrial Supply,  
 22 Inc., ("Midwest"), identified its infringement claims against Soilworks, LLC. Midwest now  
 23 asserts that Soilworks has infringed (a) claims 1, 7, 8, and 9 of U.S. Patent No. 7,074,266  
 24 and (B) Claims 1 and 3 of U.S. Patent No. 7,081,270. 9. (*See* Midwest's Pretrial  
 25 Memorandum Per the Court's October 16, 2008 Order at 20). Prior to January 9, 2009,  
 26 Midwest had repeatedly refused to identify to Soilworks which claims of the Midwest  
 27 Patents it has allegedly infringed. Midwest also failed and refused to disclose just exactly  
 28 what it was about Durasoil that constituted an infringement. Midwest intentionally obscured

1 these fundamental components of its patent infringement claim for more than two years,  
2 despite repeated requests from Soilworks since its demand for a claims chart in July of 2006  
3 (*See* timeline attached as **Exhibit 2**).

4 This Court addressed the uncertainty derived from Midwest's conduct. "... this is a  
5 very uncertain patent trial. We're going into this trial not even knowing what claims are at  
6 issue ...." (See Pretrial Hearing Transcript, October 9, 2008, attached hereto as **Exhibit 3** at  
7 p. 62:7-9). As result, this Court rightfully ordered that Midwest will bear the risk of any  
8 ambiguity arising from its patent claims during trial. (See Order Setting Trial, dated October  
9 16, 2008 at 3).

10 While Soilworks respects this Court's declaration that neither party may supplement  
11 the record at this late date, within a week of learning how it is that Midwest believes  
12 Durasoil infringes Midwest's patents, Soilworks caused a chemical analysis of its Durasoil  
13 product to be performed by an independent laboratory to address the specific claims finally  
14 asserted by Midwest. That analysis was completed four days later and showed that the  
15 Durasoil product revealed no evidence of esters or synthetic isoalkanes, and therefore, cannot  
16 infringe the Midwest patents.

17 Soilworks respectfully requests that this Court permit this evidence be added to  
18 Soilworks' list of exhibits to prevent the manifest injustice that would result if this Court  
19 were to allow, over Soilworks' objection, Midwest's introduction of any evidence that would  
20 support its infringement claim as set forth on January 9, 2009.

21 Admittedly, Soilworks could have taken the extraordinary step of disproving  
22 infringement of each and every claim of the Midwest Patents, but, based upon Midwest's  
23 own 30(b)(6) testimony, the deposition testimony of its in-house chemist and the utter  
24 absence of evidence supporting its infringement claim (i.e., no expert testimony, no claims  
25 chart, no chemical analysis, etc.), the so-called "patent infringement evidence" to be  
26 insufficient for this issue to be presented to a jury.

27 Notwithstanding this belief, Soilworks seeks to admit the Report of Analysis to  
28 counteract Midwest's intolerant refusal to identify the patent claims at issue. Even before

1 this litigation began, Midwest refused to respond to Soilworks' express requests for a claims  
2 chart. As far back as July 18, 2006, counsel for Soilworks expressly requested that Midwest  
3 provide a claims chart supporting its allegations. Again, on July 27, 2006, counsel for  
4 Soilworks asked Midwest to provide a claims chart. From June 8, 2006 until January 9,  
5 2009, Midwest consistently refused to identify the claims allegedly infringed by Soilworks:

- 6 • "By our review, the claims of the two enclosed patents are not complicated . . . and I  
7 ask that you let me know the grounds for [Soilworks' **non**-infringement] position so  
8 we can put this matter aside." (See August 8, 2006 Letter from Skereotis).
- 9 • Soilworks' Durasoil product is "included within the elements of at least once  
10 independent claim" based upon "publicly available information." [See Midwest's  
11 Response to Soilworks' Second Set of Interrogatories, dated December 31, 2007.]
- 12 • "The evidence will demonstrate that Soilworks infringes one or more of the claims."  
13 [See the parties' Joint Final Pretrial, dated September 19, 2008
- 14 • "Plaintiff is infringing one or more claims of the Midwest Patents" based upon  
15 "publicly available information." [See Midwest's Settlement Conference  
16 Memorandum, dated December 30, 2008].

17 Midwest's 30(b)(6) deposition was equally unenlightening with regard to Midwest's  
18 patent infringement claims. In fact, any time Soilworks counsel directed questions towards  
19 whether Midwest performed any chemical analysis of Durasoil, counsel of Midwest  
20 instructed Midwest representatives (including 30(b)(6)) not to answer. (*See* Hawkins  
21 Deposition Transcript attached hereto as **Exhibit 4** at 122:5-128:4; Vitale 30(b)(6)  
22 Deposition Transcript attached hereto as **Exhibit 5** at 36:5-38:3, 39:21-40:24; Detloff  
23 Deposition Transcript attached as **Exhibit 6** at 28:9-31:7).

24 Midwest's discovery tactics are bizarre at best. For example, Midwest employs a  
25 chemist. Yet, she was never asked to perform any tests on the Durasoil product. (*Id.* at  
26 29:21-25-30:1-8). Midwest never secured an expert to set forth the metes and bounds of its  
27 patents or to opine on the alleged infringement of Durasoil. And now, at this incredibly late  
28 hour, Midwest attempts to introduce evidence to prove its patent infringement claim, which

1 was not disclosed to Soilworks and this Court until January 9, 2009.

2 Soilworks moved as quickly as it possibly could to secure testing of its product in  
3 light of Midwest finally disclosing the substance of its patent claim. Now, Soilworks  
4 respectfully requests that this Court permit the addition of the Report of Analysis to its list of  
5 exhibits and add Neal E. Spingarn, Ph.D., the author of the report as a witness to testify at  
6 trial.

7  
8 Dated this 25<sup>th</sup> day of February, 2009.

9 KUTAK ROCK LLP

10 By \_\_\_\_\_/s E. Scott Dosek

11 E. Scott Dosek, Esq.  
12 John P. Passarelli, Esq.  
13 8601 North Scottsdale Road #300  
14 Scottsdale, AZ 85253-2742  
15 *Attorneys for Plaintiff Soilworks, LLC*

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**CERTIFICATE OF SERVICE**

I hereby certify that on February 25, 2009, the foregoing **SOILWORKS' MOTION FOR LEAVE TO ADD EXHIBIT AND WITNESS TO FINAL PRETRIAL ORDER** was filed electronically. Notice of this filing will be sent to all parties by operations of the Court's electronic filing system. Parties may access this filing through the Court's system.

\_\_\_\_\_  
*/s Amy S. Fletcher*

Amy S. Fletcher