

Brouse McDowell  
388 South Main Street, Suite 500  
Akron, Ohio 44311-4407  
(330) 535-5711

1 BROUSE MCDOWELL  
2 JOHN M. SKERIOTIS, 0069263 (OH)  
3 JILL A. GRINHAM, 0075560 (OH)  
4 388 S. Main Street, Suite 500  
5 Akron, Ohio 44311-4407  
6 Telephone: 330-535-5711  
7 Facsimile: 330-253-8061  
8 Email: [jskeriotis@brouse.com](mailto:jskeriotis@brouse.com)  
9 Email: [jgrinham@brouse.com](mailto:jgrinham@brouse.com)

7 BRYAN CAVE LLP, 00145700  
8 LAWRENCE G. SCARBOROUGH, 006965  
9 GEORGE C. CHEN, 019704  
10 2 N Central Ave, Suite 2200  
11 Phoenix, AZ 85004-4406  
12 Telephone: 602-364-7000  
13 Facsimile: 602-364-7070  
14 Email: [Lgscarborough@bryancave.com](mailto:Lgscarborough@bryancave.com)  
15 Email: [george.chen@bryancave.com](mailto:george.chen@bryancave.com)

*Attorneys for Defendant  
Midwest Industrial Supply, Inc.*

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF ARIZONA**

18 SOILWORKS, LLC, an Arizona corporation,

19 Plaintiff / Counterdefendant

20 v.

21 MIDWEST INDUSTRIAL SUPPLY, INC.,  
22 an Ohio corporation authorized to do business  
23 in Arizona,

24 Defendant / Counterclaimant.

No. 2:06-CV-02141-DGC

**MIDWEST INDUSTRIAL SUPPLY,  
INC.’S MEMORANDUM IN  
SUPPORT OF ITS MOTION TO  
STRIKE THE COUNTERCLAIM  
OF SOILWORKS, LLC**

25 Defendant/Counterclaimant Midwest Industrial Supply, Inc. (“Midwest”) submits  
26 this Memorandum of Points and Authorities in support of its Motion to Strike the  
27 Counterclaim of Soilworks, LLC (“Soilworks”).  
28

**INTRODUCTION**

1  
2 The counterclaim asserted by Soilworks in its Reply to Midwest’s Counterclaims  
3 must be stricken by the Court for two principal reasons. First, the Federal Rules of Civil  
4 Procedure do not permit a plaintiff to assert a counterclaim in its reply to a defendant’s  
5 counterclaim. Second, Soilworks’ allegations in the counterclaim related to Midwest’s  
6 U.S. Patent No. 7,081,270 (“Midwest’s ‘270 Patent”) are entirely duplicative and  
7 redundant of the claims already asserted by Soilworks in Count II of its Complaint.  
8

**THE PARTIES’ PLEADINGS**

9  
10 Soilworks filed its Complaint on September 7, 2006. (Complaint for Damages and  
11 Equitable Relief and Demand for Jury Trial, ECF Docket No. 1.) In the Complaint,  
12 Soilworks asserted five counts against Midwest: (1) false representation under section  
13 43(a) of the Lanham Act; (2) declaratory judgment under 28 U.S.C. § 2201 seeking a  
14 declaration that Soilworks does not infringe on Midwest’s U.S. Patent No. 7,081,270  
15 (“Midwest’s ‘270 Patent”) and/or Midwest’s ‘270 Patent is invalid; (3) misappropriation  
16 of goodwill; (4) tortious interference with business relationship and expectancy; and (5)  
17 violation of Arizona common law and unfair competition.  
18

19  
20 Midwest filed its Answer and Counterclaims on March 26, 2007. (Midwest  
21 Industrial Supply, Inc.’s Answer and Counterclaims, ECF Docket No. 16.) In its  
22 Counterclaims, Midwest asserted five counts against Soilworks: (1) trademark  
23 infringement, false designation and unfair competition under section 43(a) of the Lanham  
24 Act; (2) false advertising under section 43(a) of the Lanham Act; (3) declaratory judgment  
25 under 28 U.S.C. § 2201 for a declaration of the validity of Midwest’s ‘270 Patent and  
26  
27  
28

1 infringement of the patent by Soilworks; (4) violation of Arizona common law and unfair  
2 competition; and (5) unjust enrichment.

3 Soilworks filed its Reply to Midwest’s Counterclaims on April 16, 2007 (Reply to  
4 Midwest Industrial Supply, Inc.’s Counterclaims, ECF Docket No. 22). In the Reply,  
5 Soilworks asserts a “counterclaim” against Midwest for declaratory judgment under 28  
6 U.S.C. § 2201, which requests a declaration from the Court that Midwest’s ‘270 Patent  
7 and U.S. Patent No. 7,046,266 (“Midwest’s ‘266 Patent”) are invalid and are not infringed  
8 by Soilworks.  
9

### 10 LAW AND ANALYSIS

11 Federal Rule of Civil Procedure 7 governs the pleadings that are permitted to be  
12 filed in a civil action:  
13

14 There shall be a complaint and an answer; a reply to a counterclaim  
15 denominated as such; an answer to a cross-claim, if the answer contains a  
16 cross-claim; a third-party complaint, . . . and a third-party answer, if a third-  
party complaint is served. **No other pleadings shall be allowed.**

17 Fed. R. Civ. P. 7(a) (emphasis added).

18 The purported “counterclaim” asserted by Soilworks in its reply to Midwest’s  
19 counterclaims is improper for two reasons. First, a “counterclaim to a counterclaim” is  
20 not authorized under Rule 7. Second, Soilworks’ allegations in the counterclaim related  
21 to Midwest’s ‘270 Patent are duplicative and redundant of the claims asserted, and the  
22 relief sought, by Soilworks in Count II of the Complaint. Accordingly, Soilworks’  
23 counterclaim must be stricken by the Court pursuant to Rule 12(f). See Rule 12(f)  
24 (allowing the court to strike from “any pleading any insufficient defense or any  
25 redundant, immaterial, impertinent, or scandalous matter”); *Fantasy, Inc. v. Fogerty*, 984  
26  
27  
28

1 F.2d 1524 (9th Cir. 1993), *rev'd on other grounds*, 510 U.S. 517 (1994) (Rule 12(f) may  
2 be used to order the striking of allegations in counterclaims).

3 In addition to being disallowed by Rule 7, Soilworks' counterclaim will engender  
4 both confusion and further pleadings by the parties outside of the scope of Rule 7(a). For  
5 example, the allegations asserted by Soilworks related to the '266 Patent (e.g., invalidity  
6 and non-infringement) will necessarily require Midwest to include a counterclaim against  
7 Soilworks in Midwest's "reply to Soilworks' reply" that requests a declaration from the  
8 Court that Midwest's '266 Patent *is* valid and *is* infringed by Soilworks. This result is  
9 clearly disfavored under the Federal Rules of Civil Procedure.  
10

11  
12 Soilworks' proper course of action for seeking to assert an additional claim in this  
13 action regarding Midwest's Patent '266 is to move the Court for leave to amend its  
14 Complaint pursuant to Rule 15(a). *See* Rule 15(a) (providing that a party may amend the  
15 pleadings after the time for amending as a matter of course "only by leave of the court or  
16 by written consent of the adverse party; and leave shall be freely granted when justice so  
17 requires"). Midwest will not oppose such a motion if properly filed by Soilworks. The  
18 Court, however, must strike the improper counterclaim asserted by Soilworks in its Reply  
19 to Midwest's Counterclaims.  
20  
21  
22  
23  
24  
25  
26  
27  
28

**CONCLUSION**

1  
2 For the foregoing reasons, Midwest respectfully requests that the Court strike the  
3 counterclaim contained in Soilworks' Reply to Midwest Industrial Supply, Inc.'s  
4 Counterclaims (Reply to Midwest Industrial Supply, Inc.'s Counterclaims, ECF Docket  
5 No. 22).

6  
7  
8  
9 DATED this 3<sup>rd</sup> day of May, 2007.

10  
11  
12 By /s/ John M. Skeriotis  
13 BROUSE MCDOWELL  
14 JOHN M. SKERIOTIS, 0069263 (OH)  
15 JILL A. GRINHAM, 0075560 (OH)  
16 388 S. Main Street, Suite 500  
17 Akron, Ohio 44311-4407  
18 Telephone: 330-535-5711  
19 Facsimile: 330-253-8061  
20 Email: [jskeriotis@brouse.com](mailto:jskeriotis@brouse.com)  
21 Email: [jgrinham@brouse.com](mailto:jgrinham@brouse.com)

22 BRYAN CAVE LLP, 00145700  
23 LAWRENCE G. SCARBOROUGH, 006965  
24 GEORGE C. CHEN, 019704  
25 2 N Central Ave, Suite 2200  
26 Phoenix, AZ 85004-4406  
27 Telephone: 602-364-7000  
28 Facsimile: 602-364-7070  
Email: [Lgscarborough@bryancave.com](mailto:Lgscarborough@bryancave.com)  
Email: [george.chen@bryancave.com](mailto:george.chen@bryancave.com)

*Attorneys for Defendant  
Midwest Industrial Supply, Inc.*

678601.2

Bryan Cave LLP  
Two North Central Avenue, Suite 2200  
Phoenix, Arizona 85004-4406  
(602) 364-7000

**CERTIFICATE OF SERVICE**

1  
2 I hereby certify that on May 3, 2007, the foregoing MIDWEST INDUSTRIAL  
3 SUPPLY, INC.'S MEMORANDUM IN SUPPORT OF ITS MOTION TO STRIKE THE  
4 COUNTERCLAIMS OF SOILWORKS, LLC was filed electronically. Notice of this  
5 filing will be sent to all parties by operation of the Court's electronic filing system.  
6  
7 Parties may access this filing through the Court's system.

8  
9  
10 /s/ John M. Skeriotis  
11 John M. Skeriotis

12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28  
Bryan Cave LLP  
Two North Central Avenue, Suite 2200  
Phoenix, Arizona 85004-4406  
(602) 364-7000