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11
 12 **UNITED STATES DISTRICT COURT**
 13 **IN AND FOR THE DISTRICT OF ARIZONA**

14 SOILWORKS, LLC, an Arizona
 15 corporation,

16 Plaintiff / Counterdefendant /
 Counterclaimant,

17 v.

18 MIDWEST INDUSTRIAL SUPPLY, INC.,
 19 an Ohio corporation authorized to do
 business in Arizona,

20 Defendant / Counterclaimant /
 21 Counterdefendant.

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

**MIDWEST’S INDUSTRIAL SUPPLY,
 INC’S OPPOSITION TO
 SOILWORKS, LLC’S MOTION *IN
 LIMINE* TO EXCLUDE EVIDENCE
 OF ITS SALES OF DURASOIL**

(Before the Honorable David G. Campbell)

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1 Plaintiff Soilworks moves *in limine* to exclude evidence of sales of its Durasoil
2 product. Soilworks' motion should be denied for two principle reasons, which are
3 interrelated: (1) Soilworks' motion *in limine* improperly seeks the Court to weigh the
4 evidence and make a summary judgment determination that Midwest cannot meet its burden
5 on the substantive issue of patent infringement and (2) evidence of Soilworks' sales of its
6 Durasoil product is relevant to the issue of damages in the event that the jury determines that
7 Midwest's Durasoil product infringes Midwest's patents-in-suit.
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10 Soilworks' motion *in limine* is really a second attempt at a motion for summary judgment on
11 Soilworks' "no patent infringement" argument. Soilworks' motion argues that Midwest
12 cannot meet its burden on the issue of Soilworks' liability for patent infringement and, as
13 such, sales of Soilworks' Durasoil product are irrelevant and should be excluded at trial.
14 Soilworks' attempt to obtain a summary judgment ruling from the Court, *in limine*, on the
15 substantive issue of patent infringement is improper and its motion should be denied by the
16 Court on that basis alone.
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18 "Motions in limine address evidentiary questions and are inappropriate devices for
19 resolving substantive issues." *Natural Resources Defense Council v. Rodgers*, 2005 WL
20 1388671 *1 (E.D. Cal. 2005) *citing* 75 *Am.Jur.2d Trial* § 99 (2004) (explaining that motions
21 in limine are improper vehicles to raise motions for summary judgment or motions to dismiss
22 because "[m]otions in limine are not to be used as a sweeping means of testing issues of
23 law," *Provident Life & Accident Ins. Co. v. Adie*, 176 F.R.D. 246, 250 (D.Mich. 1997). As
24 articulated by the D.C. Circuit court in *C & E Services, Inc. v. Ashland Inc.*, 539 F.Supp.2d
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1 316 (D.D.C. 2008), motions *in limine* cannot be used to argue that evidence on damages
2 should be precluded on the basis that the underlying claim allegedly lacks evidentiary
3 support:
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5 It is worth noting that a motion *in limine* should not be used to resolve
6 factual disputes or weigh evidence. *Sigma Tool & Mach. v. Nagayama*
7 *Elect. Ind. Co., Ltd.*, No 00-cv-2936, 2002 WL 34354482, at * 2
8 (D.D.C. 2002). Nor should a motion *in limine* be used to argue, as
9 Ashland does here, that an item of damages may not be recovered
10 because no reasonable person could find that it was proximately caused
11 by the defendant's acts. That is the function of a motion for summary
12 judgment, with its accompanying and crucial procedural safeguards. *See*
13 *Provident Life & Accident Ins. Co. v. Adie*, 176 F.R.D. 246, 250
14 (D.Mich.1997) (motion *in limine* cannot be used as substitute for motion
15 for summary judgment); *Bradley v. Pittsburgh Bd. of Educ.*, 913 F.2d
16 1064, 1069- 70 (3d Cir.1990) (motions *in limine* are not subject to the
17 same procedural safeguards as motions for summary judgment).
18

19 In order for this Court to exclude evidence of sales of Durasoil *in limine*, the Court
20 would necessarily have to find that no reasonable juror could find that Soilworks' Durasoil
21 product infringes any claim of the Midwest's patents-in-suit, *i.e.*, the standard used at the
22 summary judgment stage. This Court established a dispositive motion deadline, and
23 Soilworks moved for summary judgment in its favor on the issue of liability for patent
24 infringement and relied solely upon an expert report that was stricken by the Court. (See
25 Order of August 7, 2008, at p. 23.) The Court denied Soilworks' motion and held that the
26 parties' patent-related claims would proceed to trial. Soilworks cannot now request the
27 Court to revisit this ruling through an improperly based motion *in limine*.
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Moreover, it goes without saying that, if Midwest does not prove patent infringement
at trial, as in all cases where movant bears the burden of showing liability, then the jury will

1 not have to determine any damages whatsoever.¹ If Midwest does prove patent
2 infringement, evidence of Soilworks' sales of its Durasoil product are relevant to the jury's
3 determination of the damages that should be awarded to Midwest.
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5 Furthermore, Soilworks is plainly wrong in the assertions concerning patent law,
6 infringement and whether Midwest can prove infringement. Expert testimony on patent
7 infringement is not always required to prove patent infringement.. *See, e.g., Al-Site Corp. v.*
8 *Opti-Ray, Inc.*, 841 F. Supp. 1318 (E.D.N.Y. 1993). Infringement is a question of fact, which
9 can be proven many ways. *See, e.g., W. F. & John Barnes Co. v. International Harvester*
10 *Co.*, 51 F. Supp. 254 (N.D. Ill. 1943), *order aff'd*, 145 F.2d 915 (C.C.A. 7th Cir. 1944).
11 Midwest can, and will, prove patent infringement by showing that each element of at least
12 one claim of Midwest's patents-in-suit are found in Soilworks' Durasoil product.
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15 Because Soilworks' motion *in limine* is actually an improper motion for summary
16 judgment and because Midwest can and will satisfy its burden of proving that Soilworks'
17 Durasoil product infringes Midwest's patents-in-suit, Midwest respectfully requests that the
18 Court deny Soilworks' motion *in limine*, ECF Docket No. 108.
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27 _____
28 ¹ Plaintiff has not moved for this case to be bifurcated and this case should not be bifurcated
between liability and damages.

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15 **CERTIFICATE OF SERVICE**

16 The undersigned hereby certifies that a copy of the foregoing **MIDWEST'S**
17 **INDUSTIAL SUPPLY, INC'S OPPOSITION TO SOILWORKS, LLC'S MOTION IN**
18 **LIMINE TO EXCLUDE EVIDENCE OF ITS SALES OF DURASOIL** has been
19 electronically filed on this 24th day of September, 2008. Notice of this filing will be sent to
20 all parties by operation of the Court's electronic filing system. Parties may access this filing
21 through the Court's system.

22 /s/ John M. Skeriotis
23 John Skeriotis