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21 *Midwest Industrial Supply, Inc.*

22 **UNITED STATES DISTRICT COURT**  
23 **IN AND FOR THE DISTRICT OF ARIZONA**

24 SOILWORKS, LLC, an Arizona  
25 corporation,

26 Plaintiff / Counterdefendant /  
27 Counterclaimant,

28 v.

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

Defendant / Counterclaimant /  
Counterdefendant.

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

**DECLARATION OF ROBERT  
VITALE IN SUPPORT OF MIDWEST  
INDUSTRIAL SUPPLY, INC.'S  
MOTION FOR PARTIAL SUMMARY  
JUDGMENT**

1 I, Robert Vitale having personal knowledge of the facts stated herein, and being of legal  
2 age and sound mind and memory, do hereby declare as follows:

3  
4 1. I am the Chief Executive Officer of Midwest Industrial Supply, Inc.  
5 (“Midwest”). The declarations set forth herein are true to the best of my knowledge and  
6 belief, and are based upon my personal knowledge and information known to me as the  
7 representative of Midwest.

8  
9 2. This declaration is being given in support of Midwest’s *Motion for Partial*  
10 *Summary Judgment* in this action.

11 3. Midwest manufactures, distributes, markets, and sells dust control, erosion  
12 control, soil stabilization, and anti-icing/de-icing products and related services for use to its  
13 customers in various industrials located throughout the United States and the world.

14  
15 4. During the course of its more than thirty (30) years in business, Midwest has  
16 developed a substantial reputation and goodwill as a manufacturer and leading provider of  
17 chemical soil stabilization and dust control products.

18  
19 5. Midwest was granted U.S. Patent Nos. 7,074,266 (“‘266 Patent”) and  
20 7,081,270 (“‘270 Patent”) from the U.S. Patent and Trademark Office (“USPTO”) for its  
21 innovative soil stabilization and dust control technology. Copies of Midwest’s ‘266 Patent  
22 and ‘270 Patent are attached hereto as **Attachment 1** and **Attachment 2**, respectively.

23  
24 6. Midwest owns and uses the following federally registered trademarks: Soil-  
25 Sement®, EnviroKleen®, EK35®, Road Oyl®, Road Pro NT®, Haul Road Dust Control®,  
26 Dustfyghter®, Diamond Dr®, Arena Rx®, Base-Bldr®, ROAD-BLDR®, and Synthetic  
27 Organic Dust Control® in connection with its soil stabilization and dust control products.  
28

1           7.     On August 10, 1982, Midwest received a registration on the Principal Register  
2 (Reg. No. 1,204,198) for the trademark Soil-Sement® for “chemical adhesive used in  
3 cementing surface dust particles together and then cementing the bound surface layer to the  
4 road bed subbase[.]” A copy of Midwest’s 1,204,198 Soil-Sement® trademark registration  
5 is attached as hereto as **Attachment 3**.

7           8.           On February 9, 1999, Midwest received a registration on the Principal  
8 Register (Reg. No. 2,222,732) for the trademark Soil-Sement® for “chemical adhesive used  
9 in cementing surface dust and surface particles together and then cementing the bound  
10 surface layer to a subbase, including roadbase earth-work, bareground environments, clear  
11 cut or excavated areas, and subbase which is subject to wind, water, and vehicle erosion[.]”  
12 A copy of Midwest’s 2,222,732 Soil-Sement® trademark registration is attached hereto as  
13 **Attachment 4**.

14           9.           Midwest’s Soil-Sement® trademark has been in continuous use for more  
15 than five consecutive years by Midwest subsequent to the date of its registrations.

16           10.           On October 23, 2007, Midwest received a registration on the Principal  
17 Register (Reg. No. 3,318,243) for the trademark Synthetic Organic Dust Control® for “dust  
18 suppressant in the nature of aliphatic and cyclic organic dust suppressing compositions for  
19 use in controlling dust on roadways, shoulders, trails, helipads, stockpiles, heavy traffic  
20 roads, baseball diamonds, and horse-tracks[.]” A copy of Midwest’s Synthetic Organic Dust  
21 Control® trademark registration is attached hereto as **Attachment 5**.

1           11.           Midwest began using its Synthetic Organic Dust Control® mark in  
2 commerce since at least as early as July 1998 and had used the mark exclusively until  
3 Soilworks began using it no earlier than 2003.

4  
5           12.           Midwest has extensively marketed its soil stabilization and dust control  
6 products using the term “synthetic organic dust control” in its product literature, online, on  
7 the Internet, and at trade shows.

8  
9           13.           Midwest has invested considerable resources in developing goodwill in  
10 its Synthetic Organic Dust Control® trademark and in promoting its products throughout the  
11 United States. As a result, an appreciable number of consumers have come to associate the  
12 Synthetic Organic Dust Control® mark with Midwest.

13  
14           14.           Midwest markets its soil stabilization and dust control products,  
15 including EK35®, EnviroKleen®, Soil-Sement®, Diamond Dr®, and Arena Rx®, in product  
16 literature, on the Internet, and at tradeshow.

17           15.           Soilworks is a competitor of Midwest in the areas of dust control and soil  
18 stabilization products. More specifically, Midwest’s EK35®, EnviroKleen®, Diamond Dr®  
19 and Arena Rx® products compete with Soilworks’ Durasoil® product, while Midwest’s  
20 Soil-Sement® product competes with Soilworks’ Soiltac® product.

21  
22           16.           Midwest has never consented to Soilworks’ use of any of its trademarks,  
23 including its Soil-Sement® or Synthetic Organic Dust Control® trademarks.

24  
25           17.           “Oil-sheen free” is generally understood in the dust control and soil  
26 stabilization industry as meaning that the product has passed the Static Sheen Test of the  
27 United States Environmental Protection Agency. Passing this test indicates that, in the event  
28

1 that the product reaches a water body, the product will not cause a sheen on the receiving  
2 water and necessitate a clean-up or other response.

3  
4 18. It is Midwest's belief that, based upon certain materials listed by  
5 Soilworks on its Material Safety Data Sheet and Midwest's testing of those materials in  
6 relation to its own products, that Durasoil® is not "oil-sheen free."

7  
8 19. Petroleum distillates are not considered "oil-sheen free" because they  
9 cause an oil sheen if they reach a water body.

10  
11 20. The characteristics of "synthetic" and "oil-sheen free" are often  
12 considered important by customers and users when selecting a dust control or soil  
13 stabilization product. For example, the specifications for public projects often include  
14 express and/or implicit requirements that dust control and soil stabilization products must be  
15 synthetic and/or oil-sheen free. These specifications have been included in requests for bids  
16 for public projects for which both Midwest and Soilworks' distributors have submitted bids  
17 (or portions thereof) and have competed with one another to supply the requested synthetic  
18 and/or oil-sheen free product.

19  
20 21. For example, the dust palliative specifications in the request for bids for  
21 an Alaska Department of Transportation ("ADOT") airport construction project issued in  
22 May 2006 included an express requirement that "the product shall be a high viscosity  
23 *synthetic* iso-alkane." The specifications also included an express requirement that "material  
24 shall *not* be a petroleum distillate." A copy of the dust palliative specifications for this  
25 project is attached hereto as **Attachment 6**.

1           22.           As another example, the dust palliative specifications in the request for  
2 bids for bids for another ADOT airport construction project issued in June 2006 also  
3 included express requirements that “the product shall be a high viscosity *synthetic* iso-  
4 alkane” and the “material shall *not* be a petroleum distillate.” A copy of the dust palliative  
5 specifications for this project is attached hereto as **Attachment 7**.  
6

7           23.           As yet another example, the dust palliative specifications in the request  
8 for bids for two ADOT highway-accessible projects issued in May 2007 included an express  
9 requirement that the product must have “no environmental constraints,” including “no  
10 specialized response or clean-up requirements triggered or needed if an inadvertent spill  
11 occurs, whether to the ground or to a water body.” A copy of the dust palliative  
12 specifications for this project is attached hereto as **Attachment 8**.  
13  
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15           24.           In 2006, Midwest became aware that Soilworks’ Durasoil® product potentially  
16 infringed claims in Midwest’s then-pending patent applications for Patent ‘266 and ‘270.  
17 Midwest’s belief of this infringement by Soilworks was based on a review of the publicly  
18 available information regarding Soilworks’ Durasoil® product, including (but not limited) to  
19 the product’s Material Safety Data Sheet, by Midwest and Midwest’s intellectual property  
20 attorney (John Skeriotis of Brouse McDowell LPA).  
21


22           25.           In July 2006, Midwest became aware that Polar Supply Company, a distributor  
23 of Soilworks’ products located in Anchorage, Alaska, was attempting to submit a bid in  
24 response Notice of Intent to Award a Contract issued on July 10, 2006 by the Alaskan  
25 Department of Transportation (“ADOT”) that expressly included a dust palliative  
26 specification for Midwest’s EK35® product.  
27  
28

1           26.           Based on Midwest's good faith belief that the sale or offer for sale of  
2 Soilworks' Durasoil® product constituted infringement of Midwest's then-issued Patent  
3 '266, I sent letters on July 27, 2006 to Polar Supply Company's President (Donald  
4 Dunavant) and Sales Manager (Dave Schooner) (the "Polar Supply Letters").  
5

6           27.           As stated in the Polar Supply Letters, my purpose in sending the Polar  
7 Supply Letters was to: (a) notify Polar Supply Company of the issuance of Patent '266,  
8 which I enclosed with the Polar Supply Letters; (b) advise Polar Supply Company that the  
9 issuance of Patent '266 allowed Midwest to legally pursue those who make, sell, offer for  
10 sale, and/or import knock-off or imitators of EK35® and EnviroKleen®; and (c) inform  
11 Polar Supply Letters that Midwest had apprised Soilworks of the issuance of Patent '266 and  
12 had not yet received a substantive response. The Polar Supply Letters are attached hereto as  
13 **Attachment 9** and **Attachment 10**, respectively.  
14  
15

16  
17           I declare under penalty of perjury that the foregoing is true and correct.  
18

19           Executed this 8<sup>th</sup> day of May, 2008.  
20

21   
22 \_\_\_\_\_  
23 Robert Vitale,  
24 Chief Executive Officer of Midwest Industrial  
25 Supply, Inc.  
26  
27  
28

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **DECLARATION OF ROBERT VITALE IN SUPPORT OF MIDWEST INDUSTRIAL SUPPLY, INC.'S MOTION FOR PARTIAL SUMMARY JUDGMENT** has been electronically filed on this 9th day of May, 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 Bautista  
Jill A. Bautista

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