IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ALABAMA
SOUTHERN DIVISION

KARL STORZ ENDOSCOPY-AMERICA INC.,	)	
Plaintiff,	)	
	)	Civil Action No. 2:12-cv-02716-KOB
v.	)	
STERIS INSTRUMENT MANAGEMENT SERVICES, INC.	)	
Defendant.	)	

ORDER

This matter comes before the court on Defendant STERIS Instrument Management Services, Inc.'s (IMS's) "Motion for Limited Extension of Fact Discovery Deadline to Depose the Inventors of the Patents in Suit" (doc. 138) and IMS's "Motion for Letter of Request Pursuant to the Hague Convention on the Taking of Evidence Abroad in Civil and Commercial Matters" (doc. 139). Plaintiff Karl Storz Endoscopy-America, Inc. (KSEA), filed responses in opposition to both motions (docs. 141, 144). The court **DENIES** both of Defendant's motions.

Defendant asks the court to indefinitely extend fact discovery in this case so that that it can take the depositions of two German citizens, Klaus Renner and Markus Kupferschmid (the "Named Inventors"), who are the surviving inventors of the patents involved in this case. (Doc. 138 at 1–2). Defendant asserts that it has not been able to take the Named Inventors' depositions due to the COVID-19 pandemic, which has caused the

U.S. Consulate General in Frankfurt, Germany—the only place at which depositions of German citizens for use in U.S. civil litigation may take place—to pause all scheduling of depositions. (*Id.* at 2). Defendant also filed a motion asking the court to issue a Letter of Request addressed to the judicial authority in Germany so that Defendant may collect documents and take the Named Inventors' depositions under the Hague Evidence Convention. (Doc. 139). Defendant asserts that the Named Inventors possess relevant information that IMS has no alternative means of obtaining. (Doc. 138 at 4–5).

In response, Plaintiff KSEA argues that Defendant has not shown good cause for extending the deadline for fact discovery because Defendant has not shown diligence nor the need for any particular information from the Named Inventors. (Doc. 141 at 2). Plaintiff argues that it will be unduly prejudiced if the court extends the deadline for fact discovery. (*Id*. at 6). Plaintiff points out that Defendant first raised the issue of deposing the Named Inventors by e-mail on April 1, 2021. (*Id.* at 3). On April 5, 2021, the parties had a meet-and-confer. (*Id.*). On April 13, 2021, Plaintiff proposed to Defendant that it would not call the Named Inventors at trial as a compromise to the discovery dispute, and Plaintiff believed that this compromise had resolved the dispute. (Doc. 141-1). On April 15, 2021, the parties submitted a confidential Joint Status Report to the court, which made no mention of the issue of deposing the Named Inventors and also stated that "the parties had resolved all but one discovery issue"—unrelated to the Named Inventors—and that the parties "plan[ned] to complete all fact witness depositions" within 30 days. (Doc. 143).

Under Federal Rule of Civil Procedure 16(b)(4), a scheduling order "may be modified only for good cause and with the judge's consent." "Good cause" exists when "the [court's] schedule cannot 'be met despite the diligence of the party seeking the extension.'" *Sosa v. Airport Sys., Inc.*, 133 F.3d 1417, 1418 (11th Cir. 1998). The court finds that Defendant IMS has not shown diligence here.

Defendant made no mention of deposing the Named Inventors until April 1, 2021, approximately six weeks before the first extended deadline for completion of fact discovery. The Consulate in Frankfurt requires eight weeks of advanced notice to schedule depositions. True, the Consulate has not been scheduling depositions during COVID. Even so, *if* Defendant wanted to depose the Named Inventors, it should have started the process of scheduling these depositions months ago, so that it would be "in line" when the Consulate again begins scheduling depositions. As Plaintiff pointed out, Defendant did not mention to the court the need to depose the Named Inventors in the April 15, 2021 Joint Status Report. Further, the court recently extended the deadline for fact discovery from May 14, 2021, to May 25, 2021, so that the parties could take the depositions of three fact witnesses; Defendant made no mention of the need to depose the Named Inventors or obtain documents then. (Doc.137).

In fact, as to obtaining documents from the Named Inventors, Defendant made its request for the first time in its motion for a letter of request from this court. (Doc. 139). Defendant did not mention the need to obtain documents from the Named Inventors in its motion for an extension of the fact discovery deadline. (Doc. 138). And, as Plaintiff points out in its opposition, Defendant did not show that it attempted to resolve the

discovery dispute regarding documents with Plaintiff before coming to the court and Defendant has shown no reason "for seeking additional document discovery at this late stage.' (Doc. 144 at 2–3).

Because Defendant has not shown diligence, the court **DENIES** Defendant's motion for an extension of the fact discovery deadline (doc. 138) and also **DENIES** Defendant's motion for a letter of request (doc. 139). Instead, the court adopts Plaintiff's proposed resolution to the discovery dispute regarding the depositions and precludes the Named Inventors from testifying at trial.

DONE and **ORDERED** this 20th day of May, 2021.

Karon O. Bowdre

KARON OWEN BOWDRE
UNITED STATES DISTRICT JUDGE