

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

PAUL MORELLI DESIGN, INC. : CIVIL ACTION
 :
v. :
 :
MERIT DIAMOND CORP., et al. : NO. 99-3219

MEMORANDUM ORDER

This is a copyright infringement action. Presently before the court is plaintiff's Motion to Compel Production of Original Documents for Inspection and Expert Testing.

Plaintiff alleges that defendant Merit has infringed upon plaintiff's copyrighted designs for its "Wavey Vine Necklace," "Wavey Vine Earring" and "Wavey Vine Bracelet." To refute this claim, defendant has produced copies of two pages of "design drawings" for its allegedly infringing products, marked D0003 and D0004. Defendant represents that these drawings were created prior to plaintiff's registration of its copyrights. Plaintiff seeks production of the original drawings for testing to determine their age and authenticity. The result of such testing could be critical, if not dispositive. Plaintiff acknowledges the proposed testing may result in the partial or total destruction of the original drawings.

Defendant is willing to produce the original drawings but seeks to condition the expert examination on plaintiff's

provision of access to the testing and to all information relating to it, even if this would otherwise implicate the attorney-client privilege and work product doctrine.

Defendant has made no showing that its legitimate interests cannot be protected without vitiating the attorney-client privilege. Its position, however, is otherwise quite reasonable.

Although generally undiscoverable, material compiled by an opposing party's nontestifying expert is discoverable in exceptional circumstances where it is impracticable for the party seeking discovery to obtain facts or opinions on the same subject by other means. See Fed. R. Civ. P. 26(b)(4)(B). Access to the results of destructive testing which corroborates defendant's claim would be the only practicable means convincingly to refute a suggestion of fabrication. Should plaintiff's expert destroy the original documents in the course of reaching an opinion that they post-date plaintiff's registration, defendant would be severely prejudiced in its ability to challenge that opinion if its own expert has been denied an opportunity not only to replicate the tests but to observe them.

ACCORDINGLY, this day of September, 2000, upon consideration of plaintiff's Motion to Compel Production of Original Documents for Inspection and Expert Testing (Doc. #18) and defendant's response thereto, **IT IS HEREBY ORDERED** that

plaintiff's Motion is **GRANTED** in that defendant shall produce by September 25, 2000 the original "design drawings" marked D0003 and D0004 but plaintiff shall not subject these documents to any testing which may result in their partial or complete destruction without first filing an affidavit by plaintiff's expert that it is not professionally possible to reach a reliable opinion regarding authenticity and age without such potentially destructive testing and then only upon advance notice of at least five business days to defendant Merit which shall be entitled to have a representative and expert present to observe such testing; and, should any such testing in fact result in the partial or complete destruction of the documents, plaintiff shall produce to defendant promptly after the conclusion of such testing all pertinent information regarding the methodology and results of the testing.

BY THE COURT:

JAY C. WALDMAN, J.