

Monday, June 21, 2021

11:50 — 12:00 Check-in**12:00 — 12:10 Welcome and Introductions***(Victoria Cundiff, Nicole Galli, James Pooley, Craig Weinlein)***12:10 — 1:10 [Panel 1] The Identification of Trade Secrets in Misappropriation Lawsuits***(David Almeling, Tait Graves*, Steven Kayman, Mark Klapow, Patrick O'Toole, Dean Pelletier, Christopher Yates (J))*

Every trade secret lawsuit begs the question of what intellectual property claims the plaintiff asserts—that is, what is each asserted trade secret? Courts around the country have grappled with when a plaintiff should identify its asserted secrets, what degree of detail is required to identify a trade secret claim at what stage of a case, and whether a plaintiff may amend its claims as the case proceeds. In recent years, something of a consensus has emerged – but questions remain.

Based on the April 2020 publication of the Working Group's Commentary on the Proper Identification of Asserted Trade Secrets in Misappropriation Cases, this panel will discuss such topics as a general guideline for early identification of asserted trade secrets, whether early requests for injunctive relief involve different considerations, and how to balance varying interests when a party seeks to amend its claim identification.

Materials

- 1.1 WG12 *Commentary on the Proper Identification of Asserted Trade Secrets in Misappropriation Cases* (Oct. 2020 ed.)

1:10 — 1:25 Break**1:25 — 2:50 [Panel 2] Tailoring Remedies to the Misappropriation: Equitable Relief, Damages, or Both***(Jennifer Battle, David Bohrer, John Bone, Amy Candido, Vicki Cundiff*, James Gale (J), Christopher Gerardi, Donald Parsons (J) (ret.), Erik Weibust)*

This panel explores the end game of trade secret litigation: what remedy or remedies are appropriate, and how is the decisionmaker to decide this issue? We will begin by discussing the Equitable Relief Commentary, focusing on the Commentary's objectives, Principles and Guidelines.

Most notably, while by definition there is no "one size fits all" solution to requests for equitable relief, the Commentary:

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- offers suggestions for assessing how an early remedy can be calibrated to the availability of evidence and whether targeted expedited discovery may assist the parties and the court in evaluating early requests for relief to prevent ongoing or “threatened” misappropriation of trade secrets
- emphasizes that equitable relief, or its denial, must always be tied to the direct and circumstantial evidence presented to the court and the reasonable inferences therefrom and not rely simply on oft-cited mantras or invocations of presumptions
- provides guidance for selecting, scoping, and drafting a variety of equitable remedies to suit the needs of a variety of disputes and to balance the concerns of the parties and the public.

Equitable relief is almost always discussed in the shadow of claims for monetary relief. The question of whether or how money can address the impact of misappropriation bears on the question of whether harm is “irreparable,” thus meriting some form of equitable relief. If actual injury has occurred or is ongoing, money may be the chief remedy the law can offer the aggrieved party. But how is the money award to be calculated? And who calculates it? We are told that the proper approach is both “flexible” and “fair,” but what does that mean? The second part of our discussion will work through a number of hypotheticals illustrating recurring trade secret problems and ways particular monetary remedies can help address them, with an eye to developing future Principles and Guidelines.

Materials

- 2.1 *WG12 Commentary on Equitable Remedies in Trade Secret Litigation* (May 2021 publ. comment ver.)
- 2.2 Hypothetical problems relating to monetary remedies in trade secret disputes

2:50 — 3:05 Break**3:05 — 4:30 [Panel 3] Trade Secret Issues Across International Borders**

(Brian Busey, Monte Cooper*, Seth Gerber, Dean Harts, Randall Kay, Jeff Pade, Mark Schultz, Nikki Vo, Nina Wang (J))

This panel will address the extraterritorial reach of United States federal and state trade secret law. Trade secret misappropriation is increasingly a cross-border problem, with conduct that is difficult to reach in the United States. In some instances, foreign parties are accused of misappropriating U.S. trade secrets but never enter the United States physically and have little or no presence in the United States. Other cases involve parties and incidents that span multiple countries, including the United States. It often is equally

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difficult to address overseas and extraterritorial misappropriation through foreign legal proceedings due to shortcomings in national laws and enforcement in many countries. Moreover, it may be the case that no one country's courts are able to offer a complete remedy.

This panel will also present consensus best practice recommendations to counsel, parties, and the courts on case management where cross-border discovery is necessary. In particular, the best practices address:

- mechanisms the courts and counsel can use to plan for and streamline issues that arise from extended timelines involved with cross-border discovery, for example, letters of request under the Hague Convention on Taking Evidence Abroad.
- many of the comity factors that the U.S. Supreme Court identified in its seminal decision in *Société Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa* to guide district courts when resolving disputes relating to cross-border discovery.

Materials

- 3.1 *WG12 Commentary on Trade Secret Issues Across International Borders: Extraterritorial Reach* (March 2021 publ. comment ver.)
- 3.2 *WG10/12 Joint Commentary on Cross-Border Discovery Issues in U.S. Patent and Trade Secret Cases* (May 2021 publ. comment ver.)

4:30 — 5:15 Current and Future Trends? / Social Hour

Tuesday, June 22, 2021

11:50 — 12:00 Check-in**12:00 — 12:05 Welcome and Introductions***(Victoria Cundiff, Nicole Galli, James Pooley, Craig Weinlein)***12:05 — 1:30 [Panel 4] Leveraging Internal Assets in the Governance and Management of Trade Secrets***(Russell Beck, Hildy Bowbeer (J), Rebecca Edelson, Cash Elston, Nicole Galli*, John Marsh, Jennifer Miller, Elizabeth McBride, Robert Milligan)*

Companies are increasingly looking to leverage the value of their trade secrets. The pursuit of an innovation culture in many instances leads to an increased interest in better capturing and documenting trade secrets. Trade secrets are now considered integral if not essential to corporate strategy, long-term competitive advantage, and financial viability across many industries. And there is growing interest emanating from the financial markets to leverage trade secrets as assets in a range of transactions, including mergers and acquisitions, licensing, securing loans, and risk transfer solutions. From the perspective of valuable corporate asset protection, investing in an organized framework or initiative for a Trade Secret Management Program is fundamentally about risk mitigation and protection, but it may also be about creating and extracting value from the trade secrets.

All organizations necessarily rely on their employees to actually implement a Trade Secret Protection Program and to exercise appropriate care and judgment in connection with their use or disclosure of trade secrets and other confidential information. Employers reasonably expect that their employees will maintain the confidentiality of the company's information (including information entrusted to the company by third parties) and that they will avoid either inadvertently or intentionally disclosing or using that information for any purpose outside the defined parameters of their employer's business. But both mistakes and malfeasance happen.

How should employers tailor their policies and procedures to guard against the risk of unlawful use or disclosure of their trade secrets, while avoiding inappropriately restricting their former employees' application of their general knowledge, skill, and experience in their next employment? How can a company best balance the need to rely upon this key internal asset—their employees—with the risks inherent in doing so? How can employees ensure their ability to work effectively and pursue new opportunities while meeting their obligations to their employers (past and present)? This panel will explore the closely interrelated topics of governing and managing trade secrets while protecting trade secrets throughout the employment life cycle.

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- 4.1 *WG12 Commentary on The Employment Life Cycle Relating Trade Secrets* (June 2021 publ. comment ver.)

1:30 — 1:45 Break

1:45 — 2:45 **[Panel 5] Inevitable Tension: Reconciling Public Court Access with Protecting Trade Secrets in Litigation**

(John Barry, Cathy Bissoon (J), Charles Duncan, Mark Halligan, Dina Hayes, Randy Kahnke*, Eric Ostroff)

Trade secrets are a property interest that can be destroyed by disclosure. This makes litigation of trade secrets unique; by bringing claims seeking to remedy misappropriation, a trade secret owner puts these secret information assets at issue in the public litigation process. Without the ability to protect the secrecy of trade secrets in litigation, the law of trade secrets would disappear, as it would be impossible to enforce trade secret rights in the face of misappropriation. Both the Uniform Trade Secrets Act and the Defend Trade Secrets Act explicitly acknowledge the need to protect trade secrets in litigation.

But this issue of protection runs into competing policy objectives: First, defendants need information about the claims to mount an effective defense, and second, the public generally has a constitutional right to access judicial proceedings.

This panel attempts to reconcile these important objectives with the need to protect trade secrets when litigating misappropriation claims.

This panel will:

- offer consensus recommendations to parties and courts for addressing these thorny issues in various contexts, including access to trade secret information by in-house counsel, experts, employees, and attorneys who prosecute patents
- provide consensus guidance to parties and courts about balancing the right to public access with the trade secret owner's right to maintain the secrecy of its trade secrets
- address logistical issues that often arise in trade secret cases, including with regards to the protective order and the issue of the designation (and overdesignation) of confidentiality in the production of documents.

Materials

- 5.1 *WG12 Commentary on Protecting Trade Secrets in Litigation About Them* (May 2021 publ. comment ver.)
- 5.2 *WG2 Commentary on Best Practices Addressing Protective Orders, Confidentiality & Public Access in Civil Cases* (Mar. 2007 ed.)

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2:45 — 3:00 Break

3:00 — 4:30 **[Panel 6] Judicial Roundtable**

(Laurel Beeler (J), Cathy Bissoon (J), Hildy Bowbeer (J), James Gale (J), Jim Pooley, Nina Wang (J), Christopher Yates (J))*

This panel brings together judges from key state and federal courts experienced in trade secret cases to bring their judicial perspectives to the trade secret issues raised throughout this Conference.

Materials

[N/A]

4:30 — 4:35 **Closing Statements**

(Weinlein)