

Sunday, November 4, 2018

5:30 — 7:30 **Welcome Reception**

Monday, November 5, 2018

7:30 — 8:30 **Breakfast & Registration**

8:30 — 8:45 **Welcome and Introductions**
(*Cundiff, Pooley, Weinlein*)

8:45 — 10:15 **[Panel 1] Identification of Trade Secrets**
(*Almeling*, Brown, Graves, Klapow, Pelletier, Standish (J)*)

One of the most important issues in any case alleging trade secret misappropriation is the identification of the asserted trade secrets. This panel will present the work of the WG12 Commentary on the Proper Identification of Asserted Trade Secrets in Misappropriation Lawsuits drafting team, which is drafting consensus rules for when and how this identification must take place, what this identification must contain, and what revisions to the identification are permitted as the case proceeds.

Materials

1.1 WG12 Commentary on the Proper Identification of Asserted Trade Secrets in Misappropriation Lawsuits (Oct. 2018 ver.)

10:15 — 10:30 **Morning Break**

10:30 — 12:00 **[Panel 2] The Range of Equitable Remedies in Trade Secret Litigation**
(*Beeler (J), Elkon, Feldman, Hunter, Morton, Rowe**)

Under the UTSA and the DTSA, judges may grant various forms of equitable remedies to protect trade secrets. This panel will explore the various kinds of equitable relief that may be appropriate to particular disputes at various stages of trade secret litigation. Consideration will be given to what may be or what may influence the appropriate duration for such relief. The panel will also address possible differences in the nature of injunctive relief for threatened versus actual misappropriation. Finally, the role of presumptions in the granting of equitable relief, such as those relating to irreparable harm and contractual terms will also be discussed.

Materials

2.1 WG12 Commentary on Equitable Remedies in Trade Secret Litigation Project Charter (Oct. 2018 ver.)

2.2 V. Cundiff, et al., Getting The Remedy Just Right: Making Sure That "Equitable" Relief Really Is (December 2017).

Monday, November 5, 2018 (Cont.)**12:00 — 1:15 Lunch****1:15 — 2:30 [Panel 3] Governance and Management of Information Security and Trade Secrets**
(Adler, Blakeley, Halligan, Passman*)

An essential legal requirement of enforceable trade secrets is that they are the subject of “reasonable measures” by the holder to control their use and distribution. In a very dynamic, competitive business and innovation environment, companies are balancing a range of information security and other practices to protect trade secrets and be able to evaluate the reasonableness of various protective measures against the costs and barriers of such practices—economic and otherwise—on the use and monetizing of trade secrets. The panel will first discuss the best practices related to the life-cycle of a company’s trade secrets, from identification and prioritization of information for protection to a range of ways to manage trade secrets to minimize the risk of loss or misappropriation. For most companies, these “steps” generally need a business rationale. In an environment where many different kinds of information in an enterprise are subject to different levels of governance and in some cases regulatory requirements, the panel will also explore how companies can most effectively make the business case for investing in the appropriate “reasonable measures” to manage and protect trade secrets. How can measures to safeguard trade secrets be integrated with other compliance efforts in a variety of business settings? Are there ways to manage trade secrets internally to foster appropriate internal sharing of trade secrets to develop new business ideas?

Materials3.1 CREATE.org, *Protecting Trade Secrets From Cyber And Other Threats* (2018).3.2 CREATE.org and PwC, *eBook: Safeguarding Trade Secrets And Mitigating Threats* (2015).**2:30 — 4:00 [Panel 4] Protecting Trade Secrets in Litigation About Them**
(Duncan, Fink, Kahnke*, Nix, Ostroff, Wilson (J))

Litigation of trade secret disputes requires significant exchange of presumptively secret information during discovery, as well as presentation of such information to courts. The WG12 Commentary on Protecting Trade Secrets in Litigation About Them drafting team will propose balanced guidelines for courts and counsel to ensure that rights sought to be protected by trade secret law are not unnecessarily compromised by the litigation process. The panel discussion will focus on the following four topics:

i. Access by in-house counsel, experts, and internal consultants/employees to opposing party’s trade secrets during discovery: This topic to include discussion of common issues that arise in drafting protective orders and disclosing confidential information to these key players in trade-secret litigation.

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- ii. Access by patent prosecution attorneys (i.e., prosecution bars): This topic to include discussion of common issues that arise in drafting protective orders that limit disclosure of confidential information to an opposing party's patent prosecution attorneys.
- iii. Right of public access to court proceedings and protecting trade secrets during trial: This topic to include a discussion of how litigants engage with the court and its staff on these issues – procedures, approaches, and philosophies.
- iv. Addressing the problem of over-designation of confidential information and protocols for challenges to designations: This topic to include common and best practices in drafting protective orders and litigation surrounding these issues.

Materials

4.1 R. Kahnke, Ordering Protections in Protective Orders: Critical Issues Regarding Protecting Trade Secrets in Litigation About Them (October 2018)

4:00 — 4:15 Afternoon Break

4:15 — 5:30 [Panel 5] Monetary Relief in Trade Secret Litigation

(Bohrer, Gerardi, Lynde, Putnam, Weibust)*

Large damage awards in trade secret litigation capture our attention, but compared to other areas of intellectual property one finds less specific guidance for courts and industry about calculating damages. To an extent this reflects the law's genesis in tort, expressed more in principles than in rules; but finding common approaches and identifying differences would be helpful. Towards these ends, can we identify areas of consensus regarding the framework for recovering monetary damages, the knowledge of which could be instructive in future cases?

In addition, there are differences across jurisdictions regarding whether and how to calculate award of unjust enrichment damages. Among other things, there appear to be material differences between New York common law, on the one hand, and the UTSA and DTSA, on the other hand, regarding recovery of avoided development costs. Is there way to accommodate differences such as these? A well-settled principle applicable to trade secret damages is that while damages do not need to be proven with certainty, they also may not be speculative. Much more fluid is the application of this principle in connection with issues such as apportionment, future use of trade secrets, or as between recovery for actual losses versus unjust enrichment or reasonable royalty. Is there a way forward for the courts in this area?

Finally, due to the nature of the property rights at issue, there is inherent tension in applying the *Georgia Pacific* factors to determining reasonable royalty damages. What is the case for untethering the calculation of reasonable royalty in trade secret cases from rules developed in patent cases?

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Materials

- 5.1 J. Putnam, Trade Secret Valuation: Should *Georgia-Pacific* Be On Your Mind? (November 2018)
- 5.2 V. Cundiff, New York Rejects Defendant's Avoided Development Costs As A Measure of Damages for Trade Secret Misappropriation (October 2018)
- 5.3 D. Bohrer, Must Damages Be Apportioned on a Trade Secret-by-Trade Secret Basis? (June 2018)

Tuesday, November 6, 2018

7:30 — 8:30 Breakfast & Registration

8:30 — 10:00 [Panel 6] Judicial Roundtable

(Beeler (J), Kleinberg (J), Standish (J), Wilson (J), Withers)*

What is a judge's immediate reaction when he or she gets a new trade secrets case? Is there something about trade secrets litigation that makes it different from other intellectual property, employment, or commercial actions? Are there unique case management considerations for the judges, and if so, what special procedures have judges implemented to address those concerns? Are there special advocacy issues for counsel appearing in front of these judges, and what do they need from the court to make sure their case moves forward? Expedited discovery, privacy, experts, protective orders, FTSA and UTSA? These are some of the questions this Judicial Roundtable will address, as well as questions arising out of the previous day's dialogue, questions that attendees may submit in writing, and questions the Roundtable may be able to take from the floor, if we have time. This is your chance to ask the judges, and the judges' chance to ask you!

Materials

[N/A]

10:00 — 10:15 Morning Break

10:15 — 11:30 [Panel 7] Trade Secret Issues Across International Borders

(Grzimek, Kay, Pade, Schultz, Waggoner)*

Many businesses operate internationally and are susceptible to involvement in cross border trade secret investigation and litigation. In an age of global markets and digital communications, trade secret information increasingly moves across borders where it may be subject to different legal standards and procedures. The WG12 Commentary on Trade Secret Issues Across International Borders drafting team will examine (1) extraterritorial reach by US courts in trade secret matters, including issues of jurisdiction and recourse; (2) cross border access to evidence; and (3) impact of criminal charges against foreign actors, whether in the US or abroad.

Materials

7.1 M. Schultz and D. Lippoldt, *Litigating Trade Secrets: An International Comparative Assessment Of Civil And Criminal Trade Secret Enforcement* (Oct. 2018)

7.2 J. Pade and T. Counts, *Trade Secrets Litigation Concerning Foreign Acts* (Jan. 2018)

7.3 J. Pade, *Critical Issues For Foreign Defendants In International Trade Secrets Litigation – Part I* (May 2016)

7.4 J. Pade, *Critical Issues For Foreign Defendants In International Trade Secrets Litigation – Part II* (June 2016)

Tuesday, November 6, 2018 (Cont.)**11:30 — 1:00 [Panel 8] The Employee Life Cycle Relating to Trade Secrets***(Beck, Dole, Marsh, McCarthy, Milligan*)*

Every company must rely on its employees to safeguard its trade secrets. But, because people are fallible, those employees also pose the greatest risk to those trade secrets. And, those risks are present at every stage of the employee life cycle relationship, from the recruiting process through post-employment. All too often, companies and employees alike are insufficiently aware of the risks or how to mitigate them. It is therefore imperative that a company that wishes to protect its trade secrets properly educate and train itself and its employees, and manage its employees over the life cycle of the employee relationship.

The WG12 Commentary on Employee Life Cycle Related to Trade Secrets drafting team is developing guidelines for new employers to properly manage their own trade secrets and avoid unintentionally receiving or benefiting from the trade secrets of another company. The panel will focus is discussion on three particular hot topics that will aid the group as it prepares its guidelines. First, we will address pre-hiring considerations of a competitor's employees and creating roles that adequately addresses trade secret concerns where possible. Second, we will address monitoring and surveillance of employees as part of a trade secret protection plan and the attendant privacy issues. Last, we will discuss appropriately handling an employee's retention of their former employer's data. Each topic will be viewed from both the employer's perspective and the employee's perspective.

Materials

- 8.1 WG12 Commentary on The Employee Life Cycle Relating Trade Secrets – Subgroup Outlines (Nov. 2018 ver.)
- 8.2 S. Stawski, Digital Pollination: User Impact on the Document Life Cycle (Oct. 2018)
- 8.3 Sample BYOM End User Consent Form

1:00 — 1:05 Closing Statements*(Weinlein)***1:05 — 2:00 Grab and Go Lunch (provided)**