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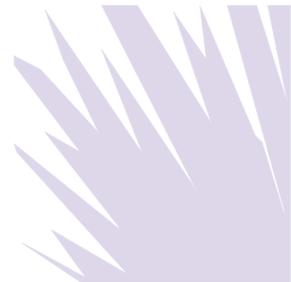
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The Sedona Conference Commentary on the Proper Identification of Asserted Trade Secrets in Misappropriation Cases

The Sedona Conference

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THE SEDONA CONFERENCE COMMENTARY ON THE
PROPER IDENTIFICATION OF ASSERTED TRADE SECRETS IN
MISAPPROPRIATION CASES

*A Project of The Sedona Conference Working Group on Trade
Secrets (WG12)*

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PREFACE

Welcome to the final October 2020 version of *The Sedona Conference Commentary on the Proper Identification of Asserted Trade Secrets in Misappropriation Cases*, a project of The Sedona Conference Working Group on Trade Secret Law (WG12). This is one of a series of Working Group commentaries published by The Sedona Conference, a 501(c)(3) research and educational institute dedicated to the advanced study of law and policy in the areas of anti-trust law, complex litigation, intellectual property rights, and data security and privacy law. The mission of The Sedona Conference is to move the law forward in a reasoned and just way.

The mission of WG12, formed in February 2018, is “to develop consensus and nonpartisan principles for managing trade secret litigation and well-vetted guidelines for consideration in protecting trade secrets, recognizing that every organization has and uses trade secrets, that trade secret disputes frequently intersect with other important public policies such as employee mobility and international trade, and that trade secret disputes are litigated in both state and federal courts.” The Working Group consists of members representing all stakeholders in trade secret law and litigation.

The WG12 *Commentary* drafting team was launched in May 2018. Earlier drafts of this publication were a focus of dialogue at the WG12 Annual Meeting in Charlotte, North Carolina, in November 2019, the WG12 Inaugural Meeting in Los Angeles, California, in November 2018, and the Inaugural Sedona Conference on Developing Best Practices for Trade Secret Issues in Scottsdale, Arizona, in December 2017. The *Commentary* was published for public comment in April 2020. The editors have carefully considered the comments received through the Working Group Series review and comment process and, where appropriate, incorporated them into this final version.

This *Commentary* represents the collective efforts of many individual contributors. On behalf of The Sedona Conference, I thank in particular James Pooley, the Chair of WG12, and Victoria

Cundiff, the Vice-Chair of WG12, who serve as the Editors-in-Chief of this publication, and David Almeling and Charles Tait Graves, both WG12 Steering Members, who serve as the Senior Editors of this publication. I also thank everyone else involved for their time and attention during this extensive drafting and editing process, including our Contributing Editors Demarron Berkley, Thomas A. Brown, Steven M. Kayman, Mark Klapow, Sid Leach, Patrick J. O'Toole, Jr., Dean A. Pelletier, and Michael Risch.

The Working Group had the benefit of candid comments by the Judicial Advisors designated to this Commentary drafting team effort—Hon. Denise Cote and Hon. Gail Standish. The statements in this *Commentary* are solely those of the nonjudicial members of the Working Group; they do not represent any judicial endorsement of any recommended practices.

The drafting process for this *Commentary* has also been supported by the Working Group 12 Steering Committee and Judicial Advisors.

We encourage your active engagement in the dialogue. Membership in The Sedona Conference Working Group Series is open to all. The Series includes WG12 and several other Working Groups in the areas of electronic document management and discovery, cross-border discovery and data protection laws, international data transfers, data security and privacy liability, patent remedies and damages, and patent litigation best practices. The Sedona Conference hopes and anticipates that the output of its Working Groups will evolve into authoritative statements of law, both as it is and as it should be.

Craig W. Weinlein
Executive Director
The Sedona Conference
October 2020

FOREWORD

A fundamental question in every case involving a claim of trade secret misappropriation is: what are the alleged trade secrets that are the subject of the claim? This question sets apart trade secret law from other major categories of intellectual property, such as patents and copyrights, in which the alleged intellectual property is defined and registered with a regulatory body before litigation begins.

The burden is on the party asserting trade secret misappropriation to answer this question by “identifying” the alleged trade secrets. While this requirement for “identification” is ubiquitous, the rules for doing so are not clear or consistent. At the federal level, neither the criminal statute (Economic Espionage Act) nor the civil statute (Defend Trade Secrets Act) explicitly addresses identification. At the state level, California and Massachusetts define certain, but not all, aspects of identification by statute, while other states set out certain rules in case law, and a few states appear yet to have addressed the issue.

The Sedona Conference’s Working Group 12 (WG12) resolved that its first commentary on trade secret law would address the identification question. This commentary represents WG12’s views about certain aspects of identification, including when an identification must be provided, what an identification must contain, and how an identification can be amended. The proposals below and across our WG12 commentary drafting team efforts are not intended to displace current law, which is diverse with respect to numerous substantive and procedural issues in trade secret law and litigation, and thus often does not lend itself to the development of more authoritative Best Practice recommendations. Rather, they are intended to summarize WG12’s consensus Principles and Guidelines regarding the identification of alleged trade secrets in trade secret litigation, which if adopted in whole or in part would advance The Sedona

Conference's mission, "moving the law forward in a reasoned and just way."

The editors would like to express their appreciation to the members of the drafting team and the judicial advisors for their valuable input and thoughtful commentary.

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**THE PROPER IDENTIFICATION OF ASSERTED TRADE SECRETS IN
MISAPPROPRIATION CASES PRINCIPLES AT A GLANCE**

- Principle No. 1:** The identification of an asserted trade secret during a lawsuit is not an adjudication of the merits and is not a substitute for discovery.
- Principle No. 2:** The party claiming misappropriation of a trade secret should identify in writing the asserted trade secret at an early stage of the case.
- Principle No. 3:** The party claiming the existence of a trade secret must identify the asserted trade secret at a level of particularity that is reasonable under the circumstances.
- Principle No. 4:** The identification of an asserted trade secret may be amended as the case proceeds.

THE PROPER IDENTIFICATION OF ASSERTED TRADE SECRETS IN MISAPPROPRIATION CASES GUIDELINES AT A GLANCE

Guideline 1: Where the trade secret plaintiff requests preliminary relief, the scope of an identification will depend on the relief sought.

Guideline 2: Where the plaintiff does not request preliminary relief, the plaintiff should identify an asserted trade secret with reasonable particularity by the outset of merits discovery.

Guideline 3: The description of an asserted trade secret in a publicly filed pleading, or other publicly filed document, may be general if necessary to avoid destroying the status of information asserted to be a trade secret.

Guideline 4: The identification of an asserted trade secret under a protective order or equivalent agreement between the parties should be made with sufficient particularity to allow the defendant to meaningfully compare an asserted trade secret to information that is generally known or readily ascertainable and to permit the parties and the court to understand what information is claimed to be a trade secret.

Guideline 5: While an asserted trade secret should be identified at a level of particularity that is reasonable under the circumstances, a defendant should not use this standard as a tool to delay litigation by demanding particularity beyond that reasonably necessary for the defendant to develop its defenses and for the court to evaluate the claims and defenses.

Guideline 6: The plaintiff should not identify an

asserted trade secret exclusively by reference to a document or other item, or exclusively by cross-reference to another asserted trade secret, unless such document, other item, or cross-reference sets forth the asserted trade secret.

Guideline 7: The plaintiff should verify its identification of an asserted trade secret under oath or affirmation.

Guideline 8: If the plaintiff claims that the defendant has taken files or other materials, the court may allow motion practice and/or discovery relating to the return or inspection of such files or materials prior to requiring identification of an asserted trade secret contained within such files or materials.

I. INTRODUCTION

A. *Why the Identification of Asserted Trade Secrets Poses Special Challenges in Trade Secret Cases*

Unlike other major categories of intellectual property (patents and copyrights), trade secrets are not registered with, or examined by, any regulatory body before a litigation commences. Unless and until a court or a jury decides whether that information constitutes a trade secret, the status of an asserted trade secret is generally a matter for private contractual protection and self-help security measures.

Specific trade secrets are thus often expressly identified as such in writing for the first time during a litigation in which they are asserted. While the procedure and logistics vary widely across the country, once litigation is underway, it is common for attorneys, whether in-house or outside counsel, to work with expert witnesses and/or company employees to develop documents identifying and otherwise describing an asserted trade secret that are then served on the opposing party.

Identification of asserted trade secrets poses special challenges in litigation because the expression of what a plaintiff¹ believes to constitute its intellectual property (in the form of trade secrets) is typically only a subset of the plaintiff's technology or business information. All businesses employ a mix of secret and nonsecret information, with different types of protection (patent, copyright, trademark, and trade secret) in play. Especially in technology cases, a body of engineering work (in a product or in research) may contain trade secrets, public information, patented subject matter, and copyrighted expression all at the same time.

1. This *Commentary* uses the term "plaintiff" throughout to refer to the trade secret claimant.

Thus, when a plaintiff alleges that a defendant has misappropriated a trade secret, it is not always evident at the outset of a lawsuit what information the plaintiff claims as a trade secret in the case. Further, it may be that some individual elements of what the plaintiff contends to be a trade secret are known to or readily ascertainable by the relevant public, while the plaintiff's particular combination of public information that the plaintiff claims has value may not be readily ascertainable. Thus, it can be challenging to distinguish information that qualifies as a proprietary secret from information that does not.

Early identification of trade secrets in a lawsuit is important for several reasons. It avoids situations where an asserted trade secret becomes a moving target, leading to significant inefficiencies for the parties and the court. It defines the contours of discovery, leading to a more streamlined process of evidence exchange. And it allows the court to focus its attention on the relevant issues early on, allowing more effective judicial oversight of the litigation as a whole.

At the same time, parties asserting a trade secret cause of action are not, and should not be, required to specifically describe an asserted trade secret in a public filing. To do so would destroy the trade secret itself. As a result, lawsuits begin without a detailed identification of the asserted trade secrets, unless the plaintiff is able to file its complaint under seal or identifies the asserted trade secrets in a separate document available to opposing counsel pursuant to a protective order or confidentiality agreement. Courts have observed, however, that pleading requirements such as those set forth in *Bell Atlantic Corp. v. Twombly*² and *Ashcroft v. Iqbal*³ require something more than a statement that the defendant has allegedly misappropriated

2. 550 U.S. 544 (2007).

3. 556 U.S. 662 (2009).

“trade secrets” without some explanation of the nature of the alleged trade secrets (technical information relating to particular topics, compilations of customer data, or the like), how they have been subject to reasonable measures to protect them, and their actual or potential economic value.⁴ Otherwise, virtually every trade secret complaint would survive a motion to dismiss.

Once a protective order is in place, however, disagreements frequently arise regarding when and how a plaintiff must deliver a written identification of an asserted trade secret to opposing counsel and what happens if that identification is insufficient. Courts began ruling on these issues regularly in the 1970s, and the number of such rulings has particularly increased since the 2000s. One reason for this is that the volume of trade secret litigation has steadily increased in state and federal courts in recent years. Nevertheless, neither the federal Defend Trade Secrets Act nor the states’ and territories’ respective versions of the Uniform Trade Secrets Act and related procedural statutes (with three exceptions, California, Puerto Rico, and Massachusetts⁵) provide a procedure for identification of an asserted trade secret during litigation.

To assist parties and courts in solving identification problems, this Commentary provides a set of principles, guidelines

4. See, e.g., *Elsevier Inc. v. Doctor Evidence, LLC*, No. 17-CV-5540 (KBF), 2018 WL 557906 (S.D.N.Y. Jan. 23, 2018).

5. See CAL. CIV. PROC. CODE § 2019.210 (enacted in 1985), P.R. LAWS title 10, § 4139(a) (2011), and MASS. GEN. LAWS ANN. ch. 93 § 42D(b) (2018). We do not propose, nor do we advise against, the adoption, in any jurisdiction or case, of the statutory approach employed in California and Massachusetts, in which discovery regarding the trade secret claims is effectively stayed pending determination that the plaintiff has provided an adequate—*i.e.*, “reasonable”—identification. We instead present the specific proposals defined below in this document. In this section, we merely explain why having the claimed trade secrets identified with reasonable particularity at some point and in some way is advantageous for all involved in the litigation.

for identifying different types of asserted trade secrets, and a reference library of case law from around the country. The proposals below are not intended to displace existing statutory law, case law, or local rules and practices. Rather, these proposals are intended to supplement such authority and practices and to provide guidance for all courts and litigants with a consensus baseline.

Early identification is but one step in the parties' litigation of the elements of a trade secret cause of action. A plaintiff, for example, might argue that the defendant took an asserted trade secret and modified it, so that the defendant's end product differs but still reflects use of the asserted trade secret. Or, the defendant might argue that the end product is the result of independent development by persons whose efforts predated the hiring of an employee from the plaintiff, and thus is not the result of access to the information the plaintiff asserts as a trade secret. Early identification of an asserted trade secret assists the parties and the court in adjudicating the substantive claims and defenses, but it does not alter the substantive law that applies to determine whether there is liability for misappropriation of those trade secrets.

B. Benefits of Identifying Asserted Trade Secrets with Reasonable Particularity

We recommend that courts adopt a local rule or proposed order governing the identification of trade secrets. This would benefit: judges who must adjudicate different kinds of trade secret claims (and issues relating to the appropriate scope of discovery and the proper reach of any remedies); attorneys who represent trade secret owners or those accused of trade secret misappropriation (whether a business or individual employees); third parties subject to discovery in trade secret lawsuits; and academics whose interests may include consistency in the application of state and federal intellectual property laws.

A local rule or proposed order should provide clarity sufficient to reduce disputes in trade secret litigation. A clear approach to identification should also help parties understand the scope of their preservation obligations. To that end, we use the phrase most commonly adopted by courts around the country—“reasonable particularity”—while recognizing implementation of that standard can differ when, for example, the types of information in dispute differ.

Requiring the identification of asserted trade secrets makes litigation more efficient by, among other things, providing notice of what trade secrets the defendant is alleged to have misappropriated, reducing disputes about when and how to identify trade secrets, helping define the scope of discovery, and streamlining substantive motion practice, pretrial proceedings, and trial. At the same time, rules for identification should not be disproportionately burdensome and strict when compared with the efficiency and other benefits they provide. Moreover, accommodation should be provided for cases in which there is clear evidence of improper acquisition coupled with an urgent need for temporary relief, where the plaintiff may not be fully aware of the scope of the information that has been taken. In many such cases, the emphasis at the outset will understandably be on obtaining an order directing the quarantine, appropriate inspection, and, as further adjudicated, removal or remediation of more specifically identified information from the devices or computer systems of the accused party. Indeed, in cases where a party merely seeks an order to preserve or return specific documents that have (for example) been downloaded, identification of asserted trade secrets would not be required in that narrow context.

Trial judges, whether in state or federal court, sometimes adjudicate cases where the information in dispute is highly technical or scientific. A local rule or proposed order for the identification of trade secrets should improve the understanding of

judges who are not specialists in the relevant technical or scientific field, allowing them to guide the parties during discovery and assess the allegations and defenses being asserted.

The proposals advanced in this *Commentary* come after a number of state and federal courts have adopted approaches to trade secret identification. Especially where states have adopted a process via statute or published case law, WG12 does not intend to “reinvent the wheel,” and we have taken those approaches into account. At the same time, WG12 recognizes that a clear local rule or proposed order may assist courts that have not yet considered this problem, and may inform a process of reconsideration or evaluation, in individual cases or overall, for those that have.

C. Stages of Identifying Asserted Trade Secrets

Courts have examined the identification of an asserted trade secret in different ways, and at different times, during litigation. By way of example, a plaintiff may seek a temporary restraining order to preserve evidence or to require the segregation or return of downloaded files. Such cases may present different issues, at least at an early stage, from those in which a plaintiff seeks a preliminary injunction restricting ongoing or future activity by the defendant, where the degree of detail required in federal courts may be subject to the requirements of Rule 65(d). Or, a court may address identification on a motion for summary judgment, in order to assess whether there remains a triable issue of fact. Disputes over written discovery, depositions, or even third-party subpoenas might also involve identification in some manner. Finally, courts overseeing jury trials may decide the means by which jury members will be exposed to an asserted trade secret.

Decisions made about identification early in a lawsuit may affect other aspects of the litigation over time—such as the scope

of discovery, responses to written discovery, deposition testimony, document production, expert reports, summary judgment, and how the jury is instructed during trial.

D. Common Areas of Dispute over Trade Secret Identifications

Disputes over identification can be costly, time consuming, and burdensome for the court and parties. In the worst instances, parties trade accusations of delay and impropriety. In jurisdictions or federal district courts that have not yet settled on a process, litigants sometimes dispute whether early identification is required at all, and, if so, to what degree, which side has the burden in a challenge, and what are the consequences for noncompliance.

Most disagreements center not on the wisdom of early identification, but rather on the degree of particularity that should be required. For example, disputes may center on: (1) whether information should be broken down and described in a numbered list; (2) whether claimed secrets can be identified in whole or in part by reference to documents; (3) whether and how “combination” or “compilation” trade secrets should be described; and—most commonly—(4) the degree of detail required for identification.

Parties sometimes dispute the standard for subsequent amendments to an identification of an asserted trade secret. On the one hand, defendants contend they should not have to prepare a defense to a moving target, while on the other hand, plaintiffs are reluctant to too narrowly define the trade secrets at issue before they discover the extent of the alleged misappropriation.

Parties also may argue over whether discovery should proceed while the sufficiency of a trade secret identification remains disputed, including discovery not only on the trade secret claim but also on other claims that are based on the same general

set of allegations and directed to the same body of information as the trade secret claim.

While many litigants approach these issues reasonably, the intensity of disagreements can increase at the extremes. For example, a plaintiff may seek to avoid providing meaningful information that a defendant could use to adequately defend itself, or a defendant may file repetitive motions challenging identification of an asserted trade secret and seek delay, even where the plaintiff has already provided an identification reasonable minds would find sufficiently particular.

E. The Structure and Purpose of this Commentary

The adoption of the proposals below is intended to reduce disputes and make trade secret litigation fairer and more efficient. To that end, this *Commentary* contains four guiding principles; additional commentary regarding these principles—including sample identifications of particular types of asserted trade secrets; and a model local rule and provision for a case management order (also known as a scheduling order). While by no means comprehensive, it also includes a library of relevant case law from state and federal courts for reference.

In addition to the principles, commentary, model local rule, and case law library, WG12 presents in Appendix A a Proposed Local Rule or Case Management Order that courts can use in trade secret cases around the country, taking into account the four principles enumerated below. Throughout this *Commentary*, WG12 cites various case decisions and other authorities that illustrate elements of these principles. WG12 cautions, however, that these are only examples, and WG12 does not express an opinion on the correctness or incorrectness of any particular authority or its reasoning. Many opinions and orders in trade secret cases are deliberately crafted to be opaque so that trade secrets are not exposed to non-parties. The cited cases provide

color and can be instructive but should not be taken as fully representative of judicial decision-making in this field.

II. IDENTIFICATION IS NOT AN ADJUDICATION AND IS NOT A SUBSTITUTE FOR DISCOVERY

Principle No. 1: The identification of an asserted trade secret during a lawsuit is not an adjudication of the merits and is not a substitute for discovery.

Any court ruling on the sufficiency of identification of an asserted trade secret during a lawsuit is not a determination of whether the information is a trade secret or has been misappropriated. Identifying an asserted trade secret is a procedural notice issue—a drafting step to provide clarity so that merits issues can separately and later be determined in a facilitated manner.⁶

Courts have repeatedly held that the acceptance by a court or party of a trade secret identification as adequate is not a ruling or an admission as to whether the information at issue is in fact a trade secret.⁷ The identification is instead intended to put the court and parties on notice of the plaintiff’s misappropriation claim and to facilitate evaluation and resolution of issues such as a request for preliminary relief, case management (including the scope of discovery), appropriate protection of all parties’ claimed proprietary information, and relevance.

Just as a sufficient identification says nothing about whether the identified subject matter actually constitutes a trade secret, it also does not address the question whether misappropriation has occurred. The plaintiff must have a sufficient basis to assert

6. See *Brescia v. Angelin*, 172 Cal. App. 4th 133, 144 (Cal. Ct. App. 2009) (emphasizing that the step of identifying an asserted trade secret during a lawsuit is not a mini-trial on the merits, and instead is a preliminary step before reaching the merits).

7. See, e.g., *Advanced Modular Sputtering, Inc. v. Superior Court*, 132 Cal. App. 4th 826, 835–36 (2005) (identification does not call for a “miniature trial on the merits”).

that a trade secret was misappropriated. But in most instances, the identification need only describe the information reasonably believed to have been misappropriated. It does not and need not specify how that misappropriation took place and whether the kind of misappropriation alleged (improper acquisition, use, or disclosure) varies as to each specific trade secret.

Nor is the identification of a trade secret the end of the parties' ability to inquire through discovery into how the trade secret works or is used, how it has been protected or not, and whether the alleged trade secret constitutes a trade secret. Identification is an important step in trade secret litigation, but it is not an end point or a substitute for discovery.

III. TIMING OF THE IDENTIFICATION

Principle No. 2: The party claiming misappropriation of a trade secret should identify in writing the asserted trade secret at an early stage of the case.

A party claiming the misappropriation of a trade secret should describe the asserted trade secret in written form. The plaintiff should not be allowed to refuse to provide any written identification or be allowed to identify only documents and state that its asserted trade secret may be found in those documents.⁸

Guideline 1: Where the trade secret plaintiff requests preliminary relief, the scope of an identification will depend on the relief sought.

If there is a request for preliminary relief, then the asserted trade secret should be identified as part of that process. The extent and scope of an identification may vary, however, depending on the nature of the relief sought, the urgency of the claimed need for relief, and the timing of the request. On this latter point, where a party seeks a temporary restraining order at the outset of a lawsuit or seeks a preliminary injunction, whether the same principles for identification of an asserted trade secret detailed below should apply depends on the nature of the relief sought.

As an exception, one circumstance where a plaintiff seeking early injunctive relief would not be required to serve an identification that complies with the rule or order proposed in Appendix A below is when there is evidence that a defendant downloaded or otherwise took documents or information, and the plaintiff seeks an order to (1) preserve evidence relating to that

8. *But see* Guideline 6, *infra*.

cause of action; and/or (2) return the documents or information alleged to have been taken.⁹

In other situations in which a plaintiff seeks early injunctive relief, the plaintiff would be required to serve on the defendant an identification of its asserted trade secret that complies with the rule or order proposed below.¹⁰ In cases where the plaintiff seeks early injunctive relief regarding some, but not all, of its asserted trade secret as to some, but not all, named defendants, and where such asserted trade secrets are reasonably separable by subject matter or otherwise, the plaintiff need only identify the asserted trade secret at issue in the motion and need only serve such identification on the defendants against or from whom such relief is being sought.¹¹

Guideline 2: Where the plaintiff does not request preliminary relief, the plaintiff should identify an asserted trade secret with reasonable particularity by the outset of merits discovery.

If there is no request for preliminary relief, the asserted trade secret should be identified with reasonable particularity by the outset of merits discovery. Courts may implement this principle with attention to the needs of the particular case and applicable statutes, and case law rules.

9. See Appendix A, Paragraph 3-1, *infra*.

10. See Appendix A, Paragraph 3-2, *infra*.

11. *Id.*

IV. REQUIRED LEVEL OF PARTICULARITY: CASE LAW EXAMPLES

Principle No. 3: The party claiming the existence of a trade secret must identify the asserted trade secret at a level of particularity that is reasonable under the circumstances.

Any type of information is eligible to be a trade secret. In other words, the subject matter of an asserted trade secret varies widely, from operational information like customer lists to financial information like prerelease prices to technical information like formulas and inventions. A rule or order requiring trade secret identification should therefore be flexible enough for litigants and courts to use in cases involving small businesses or large corporations and in relatively simple or complex cases, regardless of the type of information at issue. Given the wide variety of information and technology that can be at issue in trade secret cases, there is no single format by which a plaintiff can properly identify its asserted trade secret. However, a proper identification must reach a level of particularity that is reasonable under the circumstances, including taking into account the alleged urgency of the need for relief and the nature of the relief sought. For example, a request for relief directing the segregation and inspection of particular information alleged to have been wrongfully acquired, retained, or transferred in bulk may require a different level of particularity than a claim that a defendant has used a particular chemical formula to advance its research, development, or manufacturing processes.

Guideline 3: The description of an asserted trade secret in a publicly filed pleading, or other publicly filed document, may be general if necessary to avoid destroying the status of information asserted to be a trade secret.

Because most complaints are public documents, a plaintiff is not expected to provide in a complaint details that publicly disclose an asserted trade secret. Ordinarily, it is sufficient for a plaintiff to provide descriptions of the categories of the asserted trade secrets in a complaint. We address here the situation after the plaintiff has filed the complaint and the parties or the court have arrived at procedures to protect the trade secret from public disclosure. Issues surrounding the use of protective orders to shield parties' confidential information during litigation are addressed in the forthcoming Working Group 12 *Commentary on Protecting Trade Secrets in Litigation About Them*.

Guideline 4: The identification of an asserted trade secret under a protective order or equivalent agreement between the parties should be made with sufficient particularity to allow the defendant to meaningfully compare an asserted trade secret to information that is generally known or readily ascertainable and to permit the parties and the court to understand what information is claimed to be a trade secret.

Because there is no "one-size-fits-all" format for the identification of trade secrets, WG12 provides here instead: (1) examples of identifications that courts have deemed sufficient, (2) examples of identifications that courts have deemed insufficient, (3) a suggested format for an identification, and (4) additional guidelines that should be helpful.

Guideline 5: While an asserted trade secret should be identified at a level of particularity that is reasonable under the circumstances, a defendant should not use this standard as a tool to delay litigation by demanding particularity beyond that reasonably necessary for the defendant to develop its defenses and for the court to evaluate the claims and defenses.

The Principles and Guidelines in this Commentary are designed to assist in the efficient administration of trade secret cases, not to prolong or expand the scope of litigation. For example, in a particular case, the trade secret may be that a specific ingredient—say, aluminum—is used for a specific purpose in a certain way as part of a formula claimed to be at issue. There may be several different types of aluminum, each sourced from a different vendor. If the plaintiff does not claim that the efficacy of the secret formula is affected by the source of the aluminum, however, or the defendant is not accused of having misappropriated information regarding the source of the aluminum, it would not be efficient to require the plaintiff to identify the particular source of aluminum it uses.

Absent a statute, rule, or existing order that requires trade secrets to be identified with particularity before the plaintiff may engage in discovery, the progress of the case, including such discovery, should be delayed only if the defendant successfully moves for a protective order or other ruling to that effect. This Commentary does not express an opinion on whether or under what circumstances such an application should be granted. Where the court declines to enter such an order, it should consider alternative measures to ensure that a reasonable identification is provided at an appropriate stage of the litigation.

A. Examples of Identifications Courts Have Deemed Sufficient

Courts have found that the identification of a trade secret is sufficiently particular where it enables the court to manage the scope of discovery and the defendant to prepare a defense.¹² Importantly, consistent with Principle No. 1 above, courts have

12. See, e.g., *M.A. Mobile Ltd. v. Indian Inst. of Tech. Kharagpur*, No. C08-02658 RMW (HRL), 2011 WL 92734 (N.D. Cal. Jan. 10, 2011).

distinguished the sufficiency of the identification from whether the identified information is in fact a trade secret.¹³ The format of the identification and the scope and amount of information necessary to identify a trade secret may vary depending on the nature of the secret that is being claimed. In some cases, the identification can be straightforward and likely uncontroversial. For example, if the claim is that a physical prototype embodies the trade secret, the plaintiff should so state and provide a copy of the prototype, provide access to the prototype, or provide photographs that sufficiently display the prototype. If the claim is that a particular algorithm is the trade secret, the algorithm itself should be disclosed. If the claim is that a customer list is the trade secret, the list should be provided, with a statement that the compilation of all the information in the list (or a specified subset of that information) is the trade secret or, instead, a statement that specified information about each customer, such as its name, is a separate trade secret. And if immediate relief is sought for the preservation or return of specified files alleged to have been improperly downloaded or taken, there may be no need at that stage of the proceeding to address the specific trade secret information contained in those files.

There is a limited body of reported cases providing guidance on the adequacy of early trade secret identifications.¹⁴ Some examples of efforts the courts have found to be adequate include:

13. See, e.g., *Prolifiq Software Inc. v. Veeva Sys. Inc.*, No. C 13-03644 SI, 2014 WL 2527148, at *3 & n.4 (N.D. Cal. June 4, 2014) (decided on motion to dismiss Third Amended Complaint; holding that California's procedural rule concerning identification of trade secrets "does not create a procedural device to litigate the ultimate merits of the case—that is, to determine as a matter of law on the basis of evidence presented whether the trade secret actually exists") (citing *Brescia v. Angelin*, 172 Cal. App. 4th 133, 149 (2009)).

14. Detailed discussions about the adequacy of trade secret identifications are frequently filed only under seal, so the publicly available case law on this topic is limited. California has produced a disproportionate amount of these

- a listing of specific computer files with reference to specific pages of documents;¹⁵
- a flow chart identifying the structural aspects of a computer program;¹⁶
- compilations of data specifically identifying related text files allegedly at issue (as opposed to an earlier identification of “Plaintiff’s Data-Source Database,” which was held to be too broad and not sufficiently particular);¹⁷
- a “schematic depicting a [billing] database’s structure”;¹⁸
- a formula setting forth 15 specific ingredients and their percentages and a manufacturing process for combining and processing them;¹⁹
- specification of pricing of products sold to specifically identified customers, profit margins and production costs on those products, and promotional discounts, pricing concessions, advertising allowances, volume rebates and marketing concessions, rebate incentives, trade

published cases due to the fact that it enacted its version of the United Trade Secrets Act (UTSA) in 1985 with the then novel “reasonable particularity” requirement for pre-discovery identification of trade secrets, resulting in a wave of disputes over interpretation and application of the statute.

15. *CBS Interactive, Inc. v. Etilize, Inc.*, No. BC410579, 2009 WL 8514005 (Cal. Super. Ct. Nov. 20, 2009).

16. *Id.*

17. *Id.*

18. *TelSwitch, Inc. v. Billing Sols. Inc.*, No. C 12-00172 EMC LB, 2012 WL 3877645, at *2 (N.D. Cal. Sept. 6, 2012) (unreported).

19. *Brescia v. Angelin*, 172 Cal. App. 4th 133, 141 (2009).

discounts, and payment terms offered to particular customers;²⁰

- identification of eight elements that, in combination with one another, were alleged to form the trade secrets at issue;²¹
- identification of a specific combination of flow charts, even though some of the individual charts contained public information;²²
- identification of claimed trade secrets that the defendant had identified as warranting protection as trade secrets while employed by the plaintiff;²³
- identification of seven discrete aspects of an adjustable, weighted golf club design, including details of design elements and degrees employed in the product.²⁴

A description in a trade secret identification that uses terms like “comprising” or “including” may be appropriate where it provides guidance on how the parties and the court are to determine whether particular information falls within the scope of what is claimed as a trade secret.²⁵ However, a description

20. *Whyte v. Schlage Lock Co.*, 101 Cal. App. 4th 1443, 1455 (2002).

21. *Advanced Modular Sputtering, Inc. v. Superior Court*, 132 Cal. App. 4th 826, 836 (2005).

22. *Air Facts, Inc. v. deAmezaga*, 909 F. 3d 84, 97 (4th Cir. 2018).

23. *In the Matter of Certain Crawler Cranes and Components Thereof*, No. 337-TA-887, USITC Pub. 556530 (May 6, 2015).

24. *Triple Tee Golf, Inc. v. Nike, Inc.*, 485 F.3d 253, 258–59 (5th Cir. 2007).

25. As discussed in detail in Sect. IV.C. (A Proposed Format for Identification), *infra*, Working Group 12 does not intend to adopt or require the use of patent-drafting concepts or terms in the identification of asserted trade secrets in misappropriation cases.

saying that the trade secret “includes but is not limited to” particular information may sometimes be misused as a way of preparing to “spring” an entirely new claimed secret on a defendant at a later stage of the litigation without providing fair notice to either the court or the parties. Therefore, courts that are asked to assess the adequacy of an identification should be attentive to whether plaintiff’s use of such terms is an attempt at gamesmanship rather than a thoughtful, although nonexhaustive, identification.

Sometimes an asserted trade secret such as a formula, a computer program, or a process may have many elements. If the plaintiff does not intend to place all of those elements at issue, the plaintiff likely will not have to identify all elements of the formula or program. The time of the court and the litigants should not be spent on achieving granular identification of information plaintiff does not contend is at issue.

B. Examples of Identifications Courts Have Deemed Insufficient

Courts and parties should focus on whether a proposed identification can be reasonably understood by the court and parties to identify the information at issue. Generally, a “data dump” without further particularity will not satisfy that objective.

In some cases, including those set forth below, courts have determined after the motion-to-dismiss stage that a proposed trade secret identification was insufficient:

- submission of 20 pages of formulas and machine operating settings²⁶

26. *Loparex, LLC v. MPI Release Techs., LLC*, No. 09 Civ. 1411, 2011 WL 1135906, at *5 (S.D. Ind. Mar. 25, 2011).

- a claim to the dimensions and tolerances of particular components, without stating what were the specific dimensions and tolerances²⁷
- referring to an entire computer program containing thousands of lines of code as a trade secret where the plaintiff does not contend that the entirety of the program has been misappropriated²⁸
- providing only hundreds of file names, or a 43-page description of “the methods and processes underlying and the inter-relationships among various features” of plaintiff’s software²⁹

27. *Imax Corp. v. Cinema Techs., Inc.*, 152 F.3d 1161 (9th Cir. 1998). Note that if the plaintiff had not claimed these dimensions and tolerances as trade secrets, however, their identification would not have been necessary.

28. *Canter v. W. Publ’g Co., Inc.*, 1999 U.S. Dist. LEXIS 3815 (N.D. Cal. Jan. 6, 1999) (granting summary judgment to defendant where plaintiff made a blanket reference to an entire computer program as a trade secret, leaving defendant and the court to speculate as to what plaintiff claimed to be its trade secrets). *See also* *Staffbridge, Inc. v. Gary D. Nelson Assocs., Inc.*, No. 0124912BLS, 2004 WL 1429935, at *2 (Mass. Super. June 11, 2004) (unpublished opinion), (requiring plaintiff to separate its alleged trade secrets from the “vast body” of its own source code, but not to go further and separate it from information in the public domain, as the latter was a merits issue, not an identification issue).

29. *IDX Sys. Corp. v. Epic Sys. Corp.*, 285 F.3d 581, 583 (7th Cir. 2002) (holding the proposed identification was “both too vague and too inclusive, effectively asserting that all information in or about its software is a trade secret.”); *Integral Dev. Corp. v. Tolat*, No. C 12-06575 JSW, 2014 WL 721844, at *3 (N.D. Cal. Feb. 24, 2014) (granting summary judgment to defendant on trade secret claim, finding a “description of the category, or even of the sub-categories of information within a category, does not comply with the requirement to identify the actual matter that is claimed to be a trade secret Listing hundreds of file names without identifying the trade secret information contained within the files, is insufficient.” (internal citations omitted)).

- merely referring to voluminous documents without identifying the particular information within them that is the claimed trade secret³⁰
- a combination of “[p]erhaps five” and “[p]erhaps four, probably not fewer” than any four of thirteen elements in a claimed combination³¹

30. See, e.g., *Safety Today, Inc. v. Roy*, 2014 WL 12749231, at *2–3. (S.D. Ohio Feb. 11, 2014) (rejecting effort to produce documents in lieu of identifying claimed trade secret, finding that “[o]nly the employer will know what portion of that myriad of information known to its employees can legitimately be claimed as a trade secret, and no amount of record production . . . can provide the appropriate answer to that question,” quoting *Xerox Corp. v. IBM*, 64 F.R.D. 367, 371 (S.D.N.Y. 1974)); *U.S. Gypsum Co. v. LaFarge N. Am., Inc.*, 508 F. Supp. 2d 601, 636 (N.D. Ill. 2007) (holding that plaintiff could not “simply point to an 11,000-page document covering many diverse topics and assert that the entire document constitutes a trade secret that defendants must refute, page-by-page.”); *Utah Med. Prods., Inc. v. Clinical Innovations Assocs., Inc.*, 79 F. Supp. 2d 1290 (D. Utah 1999), *aff’d* 251 F. 3d 171 (Fed. Cir. 2000) (dismissing trade secret claim on motion for summary judgment where plaintiff alleged only that much information in 17,000 pages of documents was a trade secret).

31. *Maxtech Consumer Prods., Ltd. v. Robert Bosch Tool Corp.*, 255 F. Supp. 3d 833, 854 (N.D. Ill. 2017); see also, e.g., *Tesla Wall Systems, LLC v. Related Companies, L.P.*, No. 17-cv-5966, 2018 WL 2225002, at *5 n.4 (S.D.N.Y. May 14, 2018) (granting summary judgment to defendant based on claim that defendant had misappropriated an unspecified “unique compilation of data”); *Vesta Corp. v. Amdocs Mgmt. Ltd.*, 147 F. Supp. 3d 1147, 1155–56 (D. Ore. 2015), *Switch Commc’ns Grp. v. Ballard*, No. 2:11-CV-00285-KJD, 2012 WL 2342929 (D. Nev. June 19, 2012), and *Hill v. Best Med. Int’l Inc.*, No. 2:2007-cv- 01709, 2010 WL 2546023, at *3–4 (W.D. Pa. June 24, 2010) (notably, awarding attorney’s fees to defendant in a subsequent decision for the failure to identify trade secrets with particularity), all citing *Struthers Sci. & Int’l Corp. v. Gen. Foods Corp.*, 51 F.R.D. 149, 153 (D. Del. 1970), for the proposition that where the trade secret is a combination, “[plaintiff] should . . . specifically describe what particular combination of components it has in mind, how these components are combined, and how they operate in unique combination”; *Sit-Up Ltd. v. IAC Interactive Corp.*, No. 05-cv-9292, 2008 WL

Determining whether a proposed trade secret identification is sufficient is often contextual; indeed, in other cases, courts have found that identifications that appear similar in some respects to those described above were actually sufficient. One distinguishing factor in some instances may have been that the defendant seemed to have some prior business knowledge of what trade secrets were at issue.³²

C. A Proposed Format for Identification

Patent claims are drafted in accordance with specific requirements set forth in statutes and case law.³³ For a host of legal and practical reasons, courts should not import those requirements into trade secret litigation and require trade secret plaintiffs to compose their identifications as if they were patent claims. For example, the broader scope of trade secrets (applying to “information” and not just “inventions”), together with the special requirements of the patent statute, make it inappropriate to equate the two.

With that said, one way to identify trade secrets that is consistent with the principles and guidelines in this *Commentary* is provided below and includes three parts:

463884, at *10 (S.D.N.Y. Feb. 20, 2008) (rejecting generalized description of compilation, phrasing the standard as requiring the plaintiff to “describe the secret with sufficient specificity that its protectability can be assessed and to show that its compilation is unique”; granting summary judgment for defendants on trade secret claim).

32. See, e.g., *Alta Devices, Inc. v. LG Elecs., Inc.*, 343 F. Supp. 3d 868, 881 (N.D. Cal. 2018) (finding that schedules to the parties’ pre-dispute contracts had defined trade secrets and that plaintiff’s trade secret identification in its complaint enabled the defendant to ascertain at least the boundaries in which the trade secret lies).

33. See, e.g., 35 U.S.C. § 112.

1. A short introductory description for the general subject matter, i.e., general subject matter or description, such as:
 - a. A formula for a
 - b. A program, or code, to do b
 - c. A process for making c
 - d. A design of d
 - e. A combination or compilation of a type of information
 - f. A use of e for doing f
 - g. A fact
 - h. A piece of information
 - i. A teaching from research and development of g
 - j. An image, diagram, drawing or other rendering of h

With the a, b, c, d, type of information, e, f, fact, piece of information, g or h specifically identified as noted in part (3) below,

2. A transitional term, such as “comprising,” “consisting of,” “for,” “of,” and
3. Specific, identifying information, such as: the trade secret elements, components, ingredients, steps, algorithms, and other specific details the plaintiff contends constitute the trade secret at issue.

To provide applications of this proposed format of identification of trade secrets that would presumptively meet the trade secret plaintiffs’ burden at an early stage of a trade secrets case, WG12 provides the following examples:

If the plaintiff contends its trade secret is an entire formula, then it should identify the entire formula, including, where the plaintiff contends such information is at issue, the ingredients and the respective amounts, proportions, and ranges of ingredients. If the plaintiff contends individual ingredients or amounts, proportions, or ranges of individual ingredients are additional trade secrets, then it should separately identify those ingredients, amounts, proportions, and ranges as additional trade secrets.

If the plaintiff contends the sources or other specific aspects of particular ingredients are additional trade secrets, then it should separately identify each such source or aspect as an additional trade secret.

If the plaintiff contends its trade secret is an entire computer program, then the plaintiff should identify the entire program. If the plaintiff contends a trade secret is only a portion of a program, such as certain lines of code, module, or an underlying algorithm, then the plaintiff should identify that portion, i.e., those lines of code, the module, or the algorithm, as a trade secret.

If the plaintiff contends its entire manufacturing process is a trade secret, then it should describe the entire process, including relevant details such as sequencing rates and methods of adding ingredients, temperatures, pressures, cure or preparation times, and the like. If the plaintiff contends its trade secret consists of only one or several aspects of a process, then it should identify those specific aspects that it claims to be a trade secret.

If the plaintiff contends its trade secret is an entire design, then it should identify the entire design, including all aspects of the design, such as dimensions, features, and materials. If the plaintiff contends individual aspects, such as individual dimensions, features, and materials, are additional trade secrets, then

it should separately identify each such aspect as an additional trade secret.

If the plaintiff contends its trade secret is a combination or compilation of information, including information that is generally known, such as a combination of elements or a compilation of data (whether any, some, or all of the individual elements or data are generally or publicly known or not), then it should identify the entire combination or compilation. If the plaintiff contends its trade secret consists of only one or several elements of the claimed combination or only a subset of data in the compilation, then it should identify that element(s) or subset(s) as a trade secret(s).

If the plaintiff contends its trade secret is a use of an item, including a generally or publicly known item, for a certain purpose or function, then it should identify the use of the item and the purpose or function.

A plaintiff can choose to identify a trade secret in a format other than the three-part format described above. However, a differently formatted identification likewise must meet the reasonable particularity standard, i.e., a level of particularity that is reasonable under the circumstances, taking into account the nature of the information at issue, the nature of the parties and the industry (e.g., the extent to which there is knowledge in the industry or by the defendant that is not claimed to be a trade secret), the relief sought, and the urgency of the relief requested. One example of a differently formatted identification might concern details in a customer list that a plaintiff contends is its trade secret. In that instance, given the relative simplicity of expressing such information, the plaintiff might simply provide the database at issue, or list for each customer or group of customers the specific associated details alleged to be at issue.

The same guidelines apply if a plaintiff seeks to identify negative information, such as knowledge of something that did not

work well or at all. In making such an identification, it may be appropriate, depending on context, to identify the trade secret as, for example, “the fact that adding ingredient x to the formula does not create a stronger material, as evidenced in detail in the lab results set forth in Exhibit 1 pertaining to material strength.” Or, in the case of extensive research and development leading to a preferred outcome, the information developed through experimentation may be described by reference to the records of it.

D. Guidelines for a Trade Secret Identification

Guideline 6: The plaintiff should not identify an asserted trade secret exclusively by reference to a document or other item, or exclusively by cross-reference to another asserted trade secret, unless such document, other item, or cross-reference sets forth the asserted trade secret.

A trade secret should not be identified exclusively by reference to a document or other item, unless such document (e.g., specification, drawing, schematic diagram or formula/formulation sheet, computer program (source code), or customer list) or other item (e.g., prototype or model) constitutes the alleged trade secret. A trade secret should not be identified exclusively by reference to another asserted trade secret, unless such reference provides an identification that meets the reasonable particularity standard. If the plaintiff references a document or other item as setting forth more than one trade secret, then where possible the plaintiff should specify which portion of the document or other item identifies each such trade secret. The plaintiff may choose to add document or other-item references to its written identification, but such references do not excuse the plaintiff’s obligation to provide a proper identification that meets the reasonable particularity standard.

Guideline 7: The plaintiff should verify its identification of an asserted trade secret under oath or affirmation.

The identification, regardless of format, should be verified,³⁴ i.e., the plaintiff should have the identification signed by at least one witness (other than counsel) knowledgeable about what the plaintiff contends are the trade secrets. The witness should certify that, to the best of that person's knowledge, information, and belief, formed after a reasonable inquiry, the identification is accurate and complete as to the asserted trade secrets. The same should be true of any permitted amendments to the identification. Verification by a party's employee or officer, rather than by counsel, will aid in accuracy by encouraging a party's qualified employee or officer, such as a qualified engineer or other employee, to play an active role in identification efforts. It also will facilitate discovery by identifying at least one person knowledgeable about each asserted trade secret.

Guideline 8: If the plaintiff claims that the defendant has taken files or other materials, the court may allow motion practice and/or discovery relating to the return or inspection of such files or materials prior to requiring identification of asserted trade secret contained within such files or materials.

There may be instances in which the plaintiff knows, at the time of filing its trade secret misappropriation claim, that files or other materials have been taken, but does not know the contents and/or the extent of what was taken. For example, the party taking the files or materials may have removed the only

34. *See, e.g.,* Decision Insights, Inc. v. Sentia Grp., Inc., 311 F. App'x 586, 589–90 (4th Cir. 2009) (directing plaintiff to produce a “clear and express verified statement containing only those items which Plaintiff considers to be actual trade secrets and which Plaintiff has reasonable grounds to believe were misappropriated by Defendant.”).

existing version. In such instances, it may be appropriate to allow motion practice and/or discovery relating to the return or inspection of such files or materials prior to requiring particularized identification of an asserted trade secret.

V. AMENDMENT OF THE IDENTIFICATION

Principle No. 4: The identification of an asserted trade secret may be amended as the case proceeds.

The identification of an asserted trade secret may be amended in appropriate circumstances.

If a party wishes to amend its prior identification, it should first confer with the opposing party. If the parties are unable to reach an agreement, the party proposing the amendment may then file a motion for leave to amend, with the motion subject to the court's discretion based on all the circumstances, including all the factors set forth below.

Important and often dispositive factors in deciding such a motion are whether the party seeking leave to amend was diligent and whether the opposing party would be unduly prejudiced by amendment. These factors are not specific to trade secret law but reflect traditional concerns where amendment of pleadings or disclosures is sought.

There are other factors that may be considered. Although these factors exist in other areas of law as well, they may have special relevance in trade secret cases because of information asymmetry—for example, a plaintiff may learn details about the claimed misappropriation, including a defendant's internal technology or processes or dissemination of the information at issue, only during discovery. Thus, these factors include whether the proposed amendments are based on facts that were newly learned (such as learning through discovery that a defendant has misappropriated a trade secret the plaintiff previously did not believe was at issue), in which case an amendment is more likely to be allowed, depending on overall case management considerations. They also include the stage of the litigation, with amendments being more likely to be allowed if they occur at an earlier stage; whether the amendment will delay the

trial date, with amendments being more likely to be allowed if they do not necessitate a delay; and whether this is the first attempt or a later attempt to amend, with the first attempt more likely to be allowed.

Another factor that may be considered is the nature of the amendment: whether it simply clarifies or explains a prior identification or whether it materially alters or expands a prior identification. In the latter two cases, it will generally be appropriate for the party seeking leave to amend the identification to explain the circumstances and rationale for the proposed change. If the proposed amendment materially narrows (i.e., reduces) the number of asserted trade secrets, the party seeking to amend the identification should explain why the amendment was not sought earlier. In some cases, discovery may have revealed that contrary to initial reasonable belief, fewer trade secrets are at issue than initially suspected, or certain information initially at issue may have ceased being a trade secret at a relevant point in time. In many such cases, a narrowing amendment could likely be assented to as appropriate without material court intervention. In other cases, however, if a prior identification of trade secrets is found to have been overly expansive by design in order to unduly expand the scope of discovery, protract litigation, or drive up expenses, it may be that sanctions directed against the plaintiff for the initial overclaiming are appropriate. Such cases will likely be rare, and, in general, narrowing amendments should be viewed favorably as streamlining the case.

APPENDIX A: Proposed Model Local Rule For Trade Secret Misappropriation Cases

The goal of Appendix A is to propose a rule appropriate for the full range of trade secret misappropriation cases—whether a relatively simple customer list case or a highly complex technology case. WG12’s proposed rule is thus presented here in two formats—a model local rule, and a provision for use in a case management order—so that courts and parties can select the format more appropriate for them.

The identification of asserted trade secrets must be in writing and it must be kept confidential using appropriate procedures as determined by the court.

Courts may adjudicate cases concerning the rule or provision, and address violations of the rule or provision, in the same way that they would address other issues concerning discovery sequencing and conduct.

This format is for use in cases in which a plaintiff alleges a trade secret misappropriation claim. Whether a rule or provision requiring identification should be extended to a breach of contract claim or other claim arising out of the defendant’s access to the plaintiff’s confidential information may depend on the degree of overlap with the trade secret misappropriation claim. Whether a rule or provision requiring identification of asserted trade secrets should also apply to tort claims that the plaintiff alleges may depend on factors such as whether the particular jurisdiction treats its version of the Uniform Trade Secrets Act as preempting such tort claims, along with case-specific factors.

1. Scope of Rules

1.1 Title. These are the Local Rules of Practice for Trade Secret Cases before the [insert name of federal district court or state court].

1.2 Application. These rules apply to all civil actions filed in or transferred to this Court in which a trade secret misappropriation cause of action is asserted, whether the cause of action arises out of state or federal law or both. They are intended to supplement, and not to replace, the rules that otherwise apply in this Court, in order to provide for better management of issues likely to arise in trade secret litigation.

1.3 Modification. Based on the circumstances of the particular case, the Court may modify any aspect of these Local Rules in the interests of justice and efficient case management. Before seeking any modification, the parties shall confer and attempt to reach agreement. The burden for obtaining any such modification rests on the party proposing the modification.

1.4 Effective date. These rules apply to any case filed in or transferred to this Court after [insert date], and may be applied in previously pending cases as the Court deems appropriate.

2. Identification of Asserted Trade Secrets

2-1. Obligation to identify trade secrets. Subject to applicable law regarding the timing and content of trade secret identification and following the entry of a protective order, a party claiming the existence of a trade secret must, by the outset of merits discovery (or, subject to

Rule 3-1, with a motion for preliminary relief) identify in writing and serve on the parties, with a level of particularity that is reasonable under the circumstances, each asserted trade secret. The required particularity of this identification differs from what may be adequate in a publicly filed pleading under applicable pleading rules such as Federal Rule of Civil Procedure 8 or analogous state procedural rules, which may allow more generalized identification to avoid disclosing the substance of the asserted secrets and destroying the trade secret status of the information. The identification is not intended to and should not require the Court to make a threshold finding as to whether it is a trade secret or was misappropriated. These issues are ultimate issues to be decided by the Court or jury.

2-2. Initial identification. The identification required by Paragraph 2-1 must be sufficiently particularized to allow the other party to meaningfully compare the asserted trade secret to information that is generally known or readily ascertainable and to permit the parties and the Court to understand what information is claimed to be the trade secret. The identification does not need to specify the differences between the alleged trade secret and publicly available information. The identification should separate, to the extent practical, different asserted trade secrets into numbered paragraphs. Documents may be appended as a supplement to the identification but may not be used as a substitute for the identification unless the document itself is claimed to be the trade secret. In cases where an entire document or portions thereof constitutes the trade secret, the written identification must identify the content in such documents or portions of

such documents in language sufficient to meet the standards in this Paragraph 2-2.

2-3. Amendments. A party that has provided an initial identification under Paragraph 2-1 may amend that identification if the parties so agree or if the Court permits such amendment. The parties must confer regarding the timing and terms of the proposed amendment. If the parties are unable to reach an agreement, the party proposing the amendment may apply to the Court for an order allowing the proposed amendment. In determining whether to grant leave to amend the identification, the Court shall consider whether the party seeking amendment was diligent and whether the party opposing amendment would be unduly prejudiced by the amendment. Other factors that may be considered include, but are not limited to: whether the proposed amendment is based on facts that were newly learned in discovery; the stage of the litigation; whether the amendment will expand discovery and/or delay the trial date; and whether the amendment adds, removes, or materially modifies asserted trade secrets, or merely clarifies an existing identification.

2-4. Verification. The identification of each asserted trade secret shall be verified under oath or affirmation by one or more employees or officers of the party asserting trade secret misappropriation.

2-5. Purpose of the identification. The purpose of the identification under Paragraph 2-1 is to facilitate the resolution of trade secret cases and to inform the Court and parties of the information at issue. The process of identifying trade secrets should not become a protracted and

repetitive exercise in evaluating proffered identifications that satisfy this purpose.

3. Applications for Preliminary Relief

3-1. Orders to preserve evidence and/or return documents or information. Where a party has evidence that an opposing party improperly downloaded or otherwise took documents, things, or information from the party, and the party files a lawsuit that includes a trade secret misappropriation cause of action, and then, by motion, seeks an early court order requiring only that the defendant (1) preserve evidence; and/or (2) return the specific documents, things or information that were allegedly taken, the moving party is not required to prepare or serve an identification of its asserted trade secret that complies with Paragraph 2.

3-2. Identification of asserted trade secrets in requests for other early injunctive relief. In all other situations in which a party asserting trade secret misappropriation seeks such relief, the moving party must comply with Paragraph 2 as to the trade secrets for which it seeks early injunctive relief to the extent it has not already done so.

3-3. This Paragraph 3 is subject to Federal Rule 65(d) or state law equivalents and other applicable statutory requirements.

APPENDIX B: Examples of Case Law Regarding Identification of Asserted Trade Secrets During Litigation

This list, although not comprehensive, identifies most of the best-known cases regarding trade secret identification and many other examples from jurisdictions around the country through late 2018. It separates cases by the applicable stage of the litigation and also by jurisdiction. As with other cited authority, WG12 does not necessarily embrace any of these decisions as representing consensus views or controlling law on the issues they address.

Early Discovery and/or Discovery Stay Case

State & Territorial Statutes:

CAL. CIV. PROC. CODE § 2019.210 (enacted in 1985).

PUERTO RICO LAWS title 10, § 4139(a) (2011).

MASS. GEN. LAWS ANN. ch. 93 § 42D(b) (2018).

State Cases:

California: *Perlan Therapeutics, Inc. v. Superior Court*, 178 Cal. App. 4th 1333, 1339 (2009); *Brescia v. Angelin*, 172 Cal. App. 4th 133, 144 (2009); *Advanced Modular Sputtering, Inc. v. Superior Court*, 132 Cal. App. 4th 826, 834–35 (2005).

Delaware: *Engelhard Corp. v. Savin Corp.*, 505 A.2d 30 (Del. 1986).

Florida: *AAR Mfg., Inc. v. Matrix Composites, Inc.*, 98 So. 3d 186, 187 (Fla. Dist. Ct. App. 2012).

New Hampshire: *Vention Med. Advanced Components, Inc. v. Pappas*, 2015 N.H. Super. LEXIS 7 (July 15, 2015).

North Carolina: *DSM Dyneema, LLC v. Thagard*, 2014 WL 5317770 (N.C. Super. Ct. Oct. 17, 2014).

Federal Cases:

Arizona: *BioD, LLC v. Amnio Tech., LLC*, 2014 WL 3864658 (D. Ariz. Aug. 6, 2014).

California: *VIA Techs., Inc. v. Asus Computer Int'l*, 2016 U.S. Dist. LEXIS 141581 (N.D. Cal. Oct. 12, 2016) & 2016 U.S. Dist. LEXIS 63676 (N.D. Cal. May 13, 2016), & 2016 WL 1056139 (N.D. Cal. Mar. 17, 2016); *Lilith Games (Shanghai) Co. v. uCool, Inc.*, 2015 WL 4149066 (N.D. Cal. July 9, 2015); *Loop AI Labs Inc. v. Gatti*, 195 F. Supp. 3d 1107 (N.D. Cal. July 6, 2016) & 2015 WL 9269758 (N.D. Cal. Dec. 21, 2015); *Prolifiq Software Inc. v. Veeva Sys., Inc.*, 2014 WL 2527148 (N.D. Cal. June 4, 2014); *Phoenix Techs., Ltd. v. DeviceVM, Inc.*, 2010 WL 8590525 (N.D. Cal. March 17, 2010).

Connecticut: *Powerweb Energy, Inc. v. Hubbell Lighting, Inc.*, 2012 WL 3113162, at *1–2 (D. Conn. July 31, 2012).

Colorado: *L-3 Commc'ns Corp. v. Jaxon Eng'g & Maint., Inc.*, 2011 WL 10858409, at *3–4 (D. Col. Oct. 12, 2011).

Georgia: *DeRubeis v. Witten Techs., Inc.*, 244 F.R.D. 676, 682 (N.D. Ga. 2007).

Illinois: *AutoMed Techs., Inc. v. Eller*, 160 F. Supp. 2d 915, 925–26 (N.D. Ill. 2001).

Michigan: *Giasson Aerospace Sci., Inc. v. RCO Eng'g, Inc.*, 2009 WL 1384179, at *2 (E.D. Mich. May 14, 2009).

Minnesota: *Porous Media Corp. v. Midland Brake Inc.*, 187 F.R.D. 598, 600 (D. Minn. 1999).

Nevada: *Switch Commc'ns Grp. v. Ballard*, 2012 WL 2342929, at *4–5 (D. Nev. June 19, 2012).

New Jersey: *Osteotech, Inc. v. Biologic, LLC*, 2008 WL 686318 (D.N.J. Mar. 7, 2008); *Reckitt Benckiser Inc. v. Tris Pharma, Inc.*, 2011 WL 773034 (D.N.J. Feb. 28, 2011).

North Carolina: *Ikon Office Sols., Inc. v. Konica Minolta Bus. Sols. USA, Inc.*, 2009 WL 4429156, at *4 (W.D.N.C. Nov. 25, 2009).

Ohio: *A&P Tech., Inc. v. Lariviere*, 2017 WL 6606961 (S.D. Ohio Dec. 27, 2017).

Oregon: *Vesta Corp. v. Amdocs Mgmt. Ltd.*, 147 F. Supp. 3d 1147, 1156 (D. Or. 2015); *Nike, Inc. v. Enter Play Sports, Inc.*, 305 F.R.D. 642, 646 (D. Or. 2015); *St. Jude Medical S.C., Inc. v. Janssen-Coulotte*, 305 F.R.D. 630, 632 (D. Or. 2015).

Texas: *Huawei Techs. Co. v. Huang*, 2018 U.S. Dist. LEXIS 136929 (E.D. Tex. Aug. 14, 2018); *Zenimax Media, Inc. v. Oculus Vr, Inc.*, 2015 WL 11120582 (N.D. Tex. Feb. 13, 2015); *StoneEagle Servs. v. Valentine*, 2013 WL 9554563 (N.D. Tex. June 5, 2013); *United Serv. Auto Ass'n v. Mitek Systems, Inc.*, 289 F.R.D. 244, 248 (W.D. Tex. Feb. 15, 2013); *Polydyne Software, Inc. v. Celestica Int'l, Inc.*, 2014 WL 12479201 (W.D. Tex. Dec. 31, 2014).

Utah: *Storagecraft Tech. Corp. v. Symantec Corp.*, 2009 WL 361282, at *2 (D. Utah Feb. 11, 2009).

Interrogatory Dispute

State courts:

Massachusetts: *Alnylam Pharms. v. Discerna Pharms. Inc.*, 2016 Mass. Super. LEXIS 140 (Apr. 6, 2016).

Tennessee: *Cryosurgery, Inc. v. Rains*, 2016 Tenn. Bus. LEXIS 11 (Chancery Ct. Tenn. May 25, 2016).

Federal courts:

California: *Attia v. Google LLC*, 2018 U.S. Dist. LEXIS 84196 (N.D. Cal. May 10, 2018); *Excelligence Learning Corp. v. Oriental Trading Co., Inc.*, 2004 WL 2452834, at *3–4 (N.D. Cal. June 14, 2004); *Phoenix Techs., Ltd. v. DeviceVM, Inc.*, No. 09-cv-4697, 2010 WL 8590525 (N.D. Cal. Mar. 17, 2010).

Florida: *Knights Armament Co. v. Optical Sys. Tech., Inc.*, 254 F.R.D. 463, 467 (M.D. Fla. 2008).

Georgia: *DeRubeis v. Witten Techs., Inc.*, 244 F.R.D. 676, 680 (N.D. Ga. 2007).

Illinois: *Compuware Corp. v. Health Care Serv. Corp.*, 2002 WL 485710, at *7 (N.D. Ill. Apr. 1, 2002).

Kentucky: *Caudill Seed & Warehouse Co. v. Jarrow Formulas, Inc.*, 2017 WL 4799815 (W.D. Ky. Oct. 24, 2017); *Babcock Power, Inc. v. Kapsalis*, 2015 WL 9244487 (W.D. Ky. Dec. 17, 2015).

Michigan: *Dow Corning Corp. v. Jie Xiao*, 2011 WL 6739403 (E.D. Mich. Dec. 22, 2011); *Dura Global Tech., Inc. v. Magna Donnelly Corp.*, 2007 WL 4303294, at *4 (E.D. Mich. Dec. 6, 2007).

Minnesota: *Luminara Worldwide, LLC v. Liown Elecs. Co.*, 2015 WL 9861106 (D. Minn. Oct. 5, 2015).

Nevada: *Switch Communs. Grp. v. Ballard*, 2012 WL 2342929 (D. Nev. June 19, 2012).

New Jersey: *Givaudan Fragrances Corp. v. Krivda*, 639 F. App'x 840 (3d Cir. 2016); *Givaudan Fragrances Corp. v. Krivda*, 2013 WL

5781183 (D.N.J. Oct. 25, 2013); *Vital State Canada, Ltd. v. Dream-Pak, LLC*, 303 F. Supp. 2d 516 (D.N.J. 2003).

New York: *Uni-Sys., LLC v. U.S. Tennis Ass'n*, 2017 WL 4081904 (E.D.N.Y. Sept. 13, 2017); *Norbrook Labs. Ltd. v. G.C. Hanford Mfg. Co.*, 297 F. Supp. 2d 463 (N.D.N.Y. 2003).

North Carolina: *Ikon Office Sols., Inc. v. Konica Minolta Bus. Sols. U.S.A., Inc.*, 2009 WL 4429156 (W.D.N.C. Nov. 25, 2009).

Ohio: *Safety Today, Inc. v. Roy*, 2014 WL 12749231 (S.D. Ohio Feb. 11, 2014).

Oregon: *Vesta Corp. v. Amdocs Mgmt., Ltd.*, 2016 U.S. Dist. LEXIS 45741 (D. Or. Apr. 1, 2016).

Pennsylvania: *Syngy, Inc. v. ZS Assocs.*, 2013 WL 3716518, at *15 (E.D. Pa. July 15, 2013); *Hill v. Best Med. Int'l, Inc.*, 2010 WL 2546023, at *1–3 & n.4 (W.D. Pa. June 24, 2010).

Texas: *Triple Tee Golf, Inc. v. Nike, Inc.*, 485 F.3d 253, 258–59 (5th Cir. 2007) (description of interrogatory response in case summary); *Vianet Grp. PLC v. Tap Acquisition, Inc.*, 2016 WL 9559913 (N.D. Tex. Mar. 8, 2016).

Utah: *StorageCraft Tech. Corp. v. Symantec Corp.*, 2009 WL 112434 (D. Utah Jan. 16, 2009).

Washington: *StonCor Grp., Inc. v. Campton*, 2006 WL 314336 (W.D. Wash. Feb. 7, 2006).

Court of Federal Claims: *Demodulation, Inc. v. United States*, 122 Fed. Cl. 652 (2015).

Motion for Summary Judgment, Pretrial, or Post-Trial Stage

Freeman Inv. Mgmt. Co., LLC v. Frank Russell Co., 2016 WL 5719819 (S.D. Cal. Sept. 30, 2016).

Fortinet, Inc. v. Sophos, Inc., 2015 WL 5971585 (N.D. Cal. Oct. 14, 2015).

PTT, LLC v. Gimme Games, 2014 WL 5798148 (D.N.J. Nov. 6, 2014).

Waymo LLC v. Uber Techs., Inc., 2017 U.S. Dist. LEXIS 182197 (N.D. Cal. Nov. 2, 2017) (MSJ stage).

Loparex, LLC v. MPI Release Techs., LLC, 2012 WL 6094141 (S.D. Ind. Dec. 7, 2012) (post-trial stage).

Sit-Up Ltd. v. IAC/InterActiveCorp., 2008 WL 463884 (S.D.N.Y. Feb. 20, 2008) (MSJ stage).

Amendment

Swarmify, Inc. v. Cloudflare, Inc., 2018 WL 2445515 (N.D. Cal. May 31, 2018).

Neothermia Corp. v. Rubicor Med., Inc., 345 F. Supp. 2d 1042 (N.D. Cal. 2004).

LifeCell Corp. v. Tela Bio, Inc., No. SOM-C-12013-15 (N.J. Ch. Apr. 30, 2015).

Fast Food Gourmet, Inc. v. Little Lady Foods, Inc., 2007 WL 3052944 (N.D. Ill. Oct. 18, 2007).

Dura Global Techs., Inc. v. Magna Donnelly Corp., 2011 WL 4527576 (E.D. Mich. Sept. 29, 2011).

Montgomery v. eTreppid Techs., LLC, 2008 WL 2277118 (D. Nev. May 29, 2008).

Morgardshammar, Inc. v. Dynamic Mill Servs. Corp., 2009 WL 10685154 (W.D.N.C. Nov. 19, 2009).