

HIGH-STAKES SLEUTHING

What You Should Know About Protecting Your Trade Secrets

Our global economy has entered the Information Age. Now, technological innovation and information is the “currency of the new millennium.” But with the stroke of a computer key, technology that took years and millions of dollars to develop can be stolen and sent to commercial and political competitors around the globe.

Recognizing the national economic benefits of the technology trade secrets of U.S.-based companies, and the ease with which these secrets can be stolen, the U.S. Congress enacted the Economic Espionage Act of 1996.

Though some argue the government has not used the Act often enough, the U.S. government’s recent prosecutions of two Chinese automotive engineers have highlighted the subject’s renewed importance. The charges take on extra weight as the engineers were accused of stealing GM and Ford’s trade secrets to send to Chinese competitors at a time when the U.S. government has a vested interest in domestic auto companies, and business commentators are likening theft of U.S. trade secrets to a “kind of warfare.”

In each case, the defendants were preparing to leave GM and Ford for jobs with companies in China. The government alleges the engineers attempted to convert confidential trade secrets to the economic benefit of their new employers, knowing that it could economically injure GM and Ford.

These cases underscore the complexity of laws surrounding intellectual property theft—particularly as companies cooperate, trade, and compete on an ever-expanding international field. At stake, too, are hot-button social and political issues like pre-trial detention and immigration.

These issues were recently exacerbated by news that the Chinese government may compel foreign auto makers that want to produce electric vehicles in China to share cutting-edge electric-vehicle technology in joint ventures with Chinese companies where the foreign auto maker has only a minority stake. Couple this with the currency valuation issues roiling between the U.S. and China, and Sino-American economic relations stand at a volatile crossroad.

If your company does business internationally, it’s time to take a closer look at how trade secret litigation affects you.

WHAT’S A TRADE SECRET?

The law defining trade secrets is broad. Unlike other forms of U.S. intellectual property protection—patent, copyright, and trademark—trade secret jurisprudence is a creature of state law. Most states have some variation of the Uniform Trade Secrets Act. Included in the definition of trade secrets are various forms of financial, scientific, technical, economic, or engineering information—whether tangible or intangible. Plans, patterns, program devices, formulas, designs, prototypes, codes, processes, methods, and techniques can be classified as trade secrets. “Negative know-how”—time and money spent learning what does not work—can be a trade secret.

It doesn’t matter whether or how this information is compiled, recorded, or stored if it meets these conditions:

1. The information derives actual or potential economic value from not being known nor readily ascertainable by the public.
2. The owner uses reasonable efforts to maintain the information’s secrecy.

WHAT’S NOT A TRADE SECRET

Though not exhaustive, and subject to the facts of a particular dispute, the following are generally not recognized by courts as trade secrets:

- General information or knowledge an employee obtains over his career
- General information or knowledge in a certain industry
- Independent development of an idea
- “Reverse engineering” a publicly available product to discover a design or method
- Publicly available information or information that the owner does not exercise reasonable efforts to keep secret

WHAT DOES THE LAW SAY?

While trade secret laws are addressed by individual state law, the Economic Espionage Act is a federal statute that criminalizes misappropriation of a trade secret if the government proves the following four elements beyond a reasonable doubt:



1. The defendant obtains, conveys, or receives a trade secret (or attempts or conspires to do so)
2. The trade secret relates to a product that is produced for or placed in interstate or foreign commerce
3. The defendant intends for the trade secret to economically benefit anyone other than the owner
4. The defendant intended or knew that his conduct would injure the owner

Individuals found guilty can be fined and imprisoned for up to 10 years; companies may receive fines up to \$5 million.

HOW SHOULD YOU PROTECT YOUR VALUABLE COMPANY TRADE SECRETS?

If your company relies on research and development of protected information; purchases, licenses, enters joint ventures that do; or uses vendors to help create protected information, there are several proactive steps you can take to lessen the risk of becoming the victim of trade secret theft or espionage.

- Develop non-compete agreements compliant with state laws to prevent an employee from working with a competitor for a period of time.
- Implement non-disclosure agreements to prevent employees, vendors, and partners from disclosing protected information.
- Require non-solicitation agreements to prevent employees, vendors, and partners from hiring your employees.
- Utilize assignment-of-inventions agreements that state any inventions or trade secrets developed by an employee, vendor, or partner while working for or with your company remain the property of the company.
- Restrict access to R&D networks, work spaces, and environments for your valuable trade secrets to help maintain their security; develop systems that guard access to development or computer source code repositories; monitor details of changes to product, source code, formulas, and equations; and keep clearly defined versions of a developing product, source code, formula, equation, or algorithm in a secure place.
- Understand the pros and cons of patent versus trade secret protection for your proprietary information, including applicable court decisions and any proposed legislation.
- Create policies clearly addressing the use of and rights to company-issued computers and networks.
- Conduct extensive exit interviews of departing employees, especially those in sensitive positions vis-à-vis trade secret development.

INTERNATIONAL PROTECTION OF TRADE SECRETS AND INTELLECTUAL PROPERTY

Protecting your trade secret and other intellectual property in the U.S. does not mean that it's protected in other countries. Indeed, most nations—including China—have their own trade secret and IP laws and filing requirements before those assets can be protected. Many nations (including the U.S. and China) are members of various treaties or world organizations that provide forums to resolve IP and trade secret issues. In the U.S., there's been an increase in U.S. companies filing complaints with the U.S. International Trade Commission seeking to exclude importation of foreign products that infringe IP rights in violation of Section 337 of the Tariff Act of 1930.

One thing is certain: in today's global market, invention, innovation, and information are your most valuable assets. Our firm can guide you through the intricacies of international law and make sure your intellectual property is safe. Call us if you'd like assistance.

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Matthew P. Allen is a business, securities, and intellectual property litigator and trial lawyer who has tried and arbitrated a wide variety of intellectual property disputes in a wide array of forums. Mr. Allen's significant intellectual property litigation experience includes representing companies in international corporate espionage investigations and prosecutions, and in national and international IP litigation and arbitration. Mr. Allen and the Miller Canfield Intellectual Property Team can help your company protect your brand, ideas, and technology by auditing, designing, and implementing global intellectual property solutions that not only protect your valuable intellectual property, but also maximize its value and performance.