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Sunday, December 12, 2021

5:30 — 7:30 **Welcome Reception**

Monday, December 13, 2021

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

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

8:45 — 10:15 **[Panel 1] What Can and Cannot Be a Protectable Trade Secret?**  
*(Buziak, Hrdy, Morton\*, Slights (J), Winton)*

The fundamental trade secrets issues—What is a trade secret? How to establish misappropriation—permeate all of our Sedona Working Group 12 on Trade Secrets commentary drafting efforts:

- What are the Contours of General Skill, Knowledge, and Experience vs. Protectable Trade Secrets?
- Can Information that Doesn't Qualify as a Trade Secret Be Protected as Confidential Information Under Contract?

**Materials**

1.1 WG12 *What Can and Cannot Be a Protectable Trade Secret?* (Dec. 2021 proj. charter)

1.2 WG12 *The Proper Identification of Trade Secrets in Misappropriation Cases* (Oct. 2020 ed.)

10:15 — 10:30 **Morning Break**

10:30 — 12:00 **[Panel 2] Sharing Trade Secrets With Other Organizations**  
*(Barry, Forester, Hayes\*, Heaven, Pelletier\*, Saeedi)*

Much has been written about sharing trade secrets with employees; not as much on sharing trade secrets with other businesses, whether in exploring potential relationships,

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conducting joint venture or other collaborative relationships, and disentangling from B2B relationships. This topic includes issues such as

- due diligence;
- ways to assess and negotiate safeguards to be followed by the “receiving” party;
- the use of technological and contractual tools to document and control information sharing; and
- terms to consider when drafting NDA’s including provisions relating to the termination/wind down of relationships.

### Materials

2.1 *WG12 Sharing Trade Secrets with Other Organizations* (Dec. 2021 proj. charter)

**12:00 — 2:00 Lunch**

**2:00 — 3:30 [Panel 3] Forensic Issues in Trade Secret Disputes**

*(Falk, Gerber\*, Obaro, Roffman, Vaughn\*, Yates (J))*

Forensic discovery in trade secret disputes involves unique issues including:

- managing proportionate discovery;
- balancing the rights of litigants and rights in personal information or, in the case of competing organizations, their own trade secrets; and
- issues relating to the role of attorneys in designing and implementing forensic protocols and attorney client privilege.

This project draws on forensic experts, inside and outside counsel and includes representation by lawyers who frequently represent employees as well as attorneys who often represent organizations.

### Materials

3.1 *WG12 Forensic Issues in Trade Secret Disputes* (Dec. 2021 proj. charter)

3.2 *WG12 Protecting Trade Secrets Throughout The Employment Life Cycle* (June 2021 public comment ver.)

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Monday, December 13, 2021 (Cont.)

3:30 — 3:45 Afternoon Break

3:45 — 5:15 [Panel 4] Monetary Remedies in Trade Secret Disputes

(Almeling\*, Beeler (J), Bone, Gerardi, Weibust\*)

Unlike patent and other statutory IP, trade secret damages are grounded in tort principles, and tend toward the flexible and generous. This effect is sometimes amplified by the emotional themes of litigation. What rules should apply to make damage awards reasonably predictable and fair to all concerned? Can learning from other areas of IP be useful in developing sound procedures and methods of calculation?

**Materials**

4.1 WG12 *Commentary on Monetary Remedies in Trade Secret Litigation* (Nov. 2021 ver.)

## Tuesday, December 14, 2021

## 7:30 — 8:30 Breakfast &amp; Registration

8:30 — 10:00 [Panel 5] Getting In and Staying Out of Trouble: Ethical Issues in Trade Secret Cases  
(Almeling, Cameron-Banks, Fink\*, Kenedy\*, Miller (J), O'Toole)

This 1.5-hour panel will discuss professional responsibility issues unique to trade secret litigation, including:

- The representation of multiple clients, including the duty of equal degree of loyalty to each (*see, e.g., Nelson Bros. Profl Real Estate, LLC v. Freeborn & Peters, LLP*, 773 F.3d 853 (7th Cir. 2014), and discussing circumstances in which counsel may need to withdraw (*see, e.g., Model Rules 1.7, 1.16(a)(1), and 1.7.*).
- Potentially misappropriated trade secrets, when someone possesses trade secret belonging to someone else, but the trade secret owner does not yet know or has not raised the issue—should the information be destroyed, deleted, returned to the owner, forensically preserved first, etc.?
- The required good faith belief in the assertion of the right to trade secret protection for their clients on both factual and legal grounds (*see, e.g. ABA Model Rule of Prof. Responsibility 3.1*), the ongoing good faith obligation imposed on counsel throughout the dispute (*see, e.g. Fed. R. Civ. P. 11; LiiON, LLC v. Vertiv Grp. Corp. et al.*, 2021 WL 4963610, Slip Copy (2021), and what to do when a client's facts and/or evidence creates a question about authenticity or truthfulness of evidence and testimony but without definitive or relatively certain evidence of its "untruthfulness" (*see e.g. Model Rules 3.1 and 1.4*).
- Defending a trade secret claim on reasonable terms and avoiding potential liability for "willful and malicious" misappropriation (*see Uniform Trade Secrets Act*, Section 3(b); *Defend Trade Secrets Act*, 18 U.S.C. §1836(b)(3)(C)).
- Addressing simultaneous criminal investigations or proceedings and civil litigation.

**Materials**

- 5.1 WG12 *Ethical Issues in Trade Secret Cases* (Dec. 2021 proj. charter)
- 5.2 WG12 *Equitable Remedies in Trade Secret Litigation* (May 2021 public comment ver.)
- 5.3 *Nelson Bros. v. Freeborn & Peters* (7th Cir. 2014)
- 5.4 *LiiOn v. Vertiv Grp.* (N.D. Ill. 2021)

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**10:00 — 10:15 Morning Break****10:15 — 11:30 [Panel 6] Governance and Management of Trade Secrets**  
*(Bowbeer (J), Galli, Miller, Pooley)*

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

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

**Materials**

6.1 WG12 Commentary on Governance and Management of Trade Secrets (Nov. 2021 ver.)

**11:30 — 1:00 [Panel 7] Judicial Roundtable**  
*(Beeler (J), Bowbeer (J), Miller (J), Pooley\*, Slight (J), Yates (J))***1:00 — 1:05 Closing Statements**  
*(Weinlein)***1:05 — 2:00 Grab and Go Lunch (provided)**