



INTELLECTUAL PROPERTY: WHAT TO REVEAL, AND WHAT TO KEEP SECRET

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Intellectual Property: What to Reveal, and What to Keep Secret

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Introduction

American law provides several tools for inventors, creators and authors to protect their intellectual property. Trademarks and trade dress protect brands and brand names. Copyrights protect written works of literature, art, music, theater, and some creative designs. And patents and trade secrets can both be used to protect proprietary inventions. In some cases, an invention could be protected by both a patent and a trade secret.

But although patents and trade secrets can both be used to protect inventions, there are critical differences between the two forms of protection. This article discusses the key differences between the two, and how recent developments in federal law and Supreme Court jurisprudence will affect the scope of protection offered by both tools. For some companies, patents are the best way of protecting intellectual property. For others, trade secrets are the only available tool. But in most cases, whether to use patents or trade secrets to protect critical intellectual property will depend on many factors. Whether you manage litigation for a multi-billion dollar conglomerate, or a smaller family-owned business, understanding the differences between patents and trade secrets, as well as new developments in the law is critical to managing your company's or client's intellectual property.

Elements of patentability: patentable subject matter is governed by federal law.

There are two federal statutes that determine whether an invention is patentable – 35 USC Section 101 and 35 USC Section 103.

Section 101 reads in part as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Section 103 reads in part as follows:

A patent for a claimed invention may not be obtained . . . if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.

Taken together, these two provisions sum up the scope of what is patentable – the claimed invention must be novel, useful, and non-obvious, more commonly known as the “new, useful, and non-obvious” test.

Patentable subject matter can include any process, machine, manufacture, composition of matter or improvement. Congress intended the scope of patentable statutory subject matter to “include anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303 (1980) (man-made bacterium is patentable subject matter).

The first two elements of the “new, useful, and non-obvious” test are easy to establish, and rarely controversial. The third element, “non-obvious,” is more complicated. Determining what “would have been obvious to a person having ordinary skill in the art” is a question courts have struggled to define. In 1966, the Supreme Court offered this somewhat circular definition of what is obvious:

An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

The Graham court found a patent for a plow obvious when that patent did nothing more than incorporate known mechanical elements in a predictable way.

Although the Graham Court’s definition has been criticized as being unhelpful – “the difference between the new thing and what was known before is not considered sufficiently great” – it is still recognized as the test for obviousness.

Laws of nature, natural phenomena and abstract ideas are not patentable.

Although the scope of patentable subject matter is broad, it is not unlimited. Laws of nature, natural phenomena, and abstract ideas have never been patentable, as explained by the Supreme Court:

A new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter. Likewise, Einstein could not patent his celebrated law that $E=mc^2$; nor could Newton have patented the law of gravity. Such discoveries are manifestations of . . . nature, free to all men and reserved exclusively to none. *Diamond v. Chakrabarty*, 447 U.S. 303 (1980).

Elements of a trade secret.

The scope of inventions that can be protected by trade secret law is also broad. The Uniform Trade Secrets Act defines a trade secret as follows:

Information, including a formula, pattern, compilation, program, device, method, technique, or process, that:

Derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use

Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.

The Uniform Trade Secret Act (UTSA) was created in 1985 by the National Conference of Commissioners on Uniform State Laws. It has since been codified into law by most states.

There is no subject matter limit for trade secrets. Technical information can include formulas, recipes, patterns, compilations, databases, programs, source code, devices, research, prototypes, algorithms, methods, techniques, processes, know how, etc.

Non-technical information can include market analyses, strategic information, business plans, financial information, pricing, customer information, etc.

Like patents, the scope of trade secrets is broad, but not unlimited. Information that is typically not considered a trade secret includes the following:

Customer lists, unless they include payment or sales history; generally known industry principles; information that is readily ascertainable by proper means; or information that comprises general skills and knowledge acquired in the course of employment.

For example in *Harley Auto. Group, Inc. v. AP Supply, Inc.* (D. Minn. Dec. 23, 2013), a federal district court in Minnesota found that a list of car dealerships, account numbers, addresses, telephone numbers, and sometimes the name of a contact person were not considered trade secrets.

The trade secret owner bears the burden of maintaining the trade secret.

As discussed above, trade secrets must not be generally known to the public or in the relevant industry. In addition, trade secrets must not be readily ascertainable by proper (legal) means, i.e, the trade secret technology cannot be easily reverse-engineered. And the trade secret must be the subject of efforts that are reasonable under the circumstances to maintain its secrecy. If the trade secret owner does not maintain the secrecy of the technology or invention, trade secret protection disappears.

Famous trade secrets include the Coca-Cola Formula; the “special sauce” used in the McDonald’s Big Mac; the Krispy Kreme donut recipe; the formula for WD-40; and KFC’s recipe for the Colonel’s 11 secret herbs and spices. The companies who hold each of these trade secrets go to extraordinary lengths to protect and maintain these trade secrets. For example, KFC’s blend of 11 herbs

and spices is widely considered one of the biggest trade secrets in the world. KFC says that the original recipe of 11 secret herbs and spices was handwritten in 1940 by Harland “Colonel” Sanders. Today, KFC keeps the handwritten original recipe locked in a digital safe that is allegedly surrounded by two feet of concrete and monitored 24 hours a day by a video and motion detection surveillance system.

Length of Protection for Patents and Trade Secrets.

Utility and plant patents are valid for 20 years from the date of the patent application (not the issue date). Design patents last 15 years from the date the patent is granted. Regardless of the date of grant or application, patent protection ends when the patent is invalidated or rendered unenforceable.

Unlike patents, there is no expiration date for trade secrets. A trade secret can potentially last forever, if the secret is maintained, as remains the case with Coca-Cola and Krispy Kreme. However, trade secret protection ends immediately when the secret becomes public, or if someone legally reverse-engineers or otherwise breaks down or discovers the secret.

Benefits and Advantages of Patents.

There are several advantages that patents have over trade secrets. First, a valid patent provides a guaranteed monopoly for the patent term. Patents can be sold or licensed, and can generate revenue throughout the life of the patent. Moreover, the scope of the invention is clear, because a patentee is obligated to explain in great detail what the invention is. And because patents are public, competitors are aware of your invention, which deters competition.

Patents also allow owners to protect their core innovations and technology against independent development or invention from third parties. Finally, patents help create space in crowded markets.

Disadvantages of Patents.

Although patents have some clear advantages, many experts believe the disadvantages of patents outweigh the benefits. First, patents are extremely expensive to obtain and maintain – applicants will have to pay attorneys’ fees to prepare the application, and respond to USPTO office actions. Extremely complicated or contested patents can cost more than \$20,000 from application to issuance. And because they are public, anyone can make the invention after the patent expires – the monopoly and protection end the day the patent expires. Moreover, the patent

owner must pay to enforce the patent by suing infringers. Litigation costs through trial can be over \$5 million for extremely complicated technology patents.

In addition to cost, the Supreme Court has issued several decisions within the last ten years that have restricted patent owners’ rights. These include *Bilski v. Kappos*, 561 U.S. 593 (2010), which made it more difficult to enforce patent claims involving business methods and abstract ideas; *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014), which made it more difficult to enforce patent claims involving computer implemented business methods; *Nautilus, Inc. v. Biosig Instruments*, 134 S. Ct. 2120 (2014), which made it easier for defendants to argue patent claims are indefinite under Section 112 of the patent code; and *Limelight Networks, Inc. v. Akamai Technologies, Inc.*, 134 S. Ct. 2111 (2014), which made it harder to prove infringement when more than one actor has infringed, but no actor has performed all the steps of a patent claim.

Finally, there are the many statutory defenses to a patent infringement claim. Patent lawsuits are often described as a Defendant’s paradise, due to the large number of statutory defenses to a patent infringement claim. These defenses include anticipation based on a single prior art source, 35 USC Section 102; obviousness based on multiple prior art sources, 35 USC Section 103; indefiniteness due to failure to provide a clear written description of the invention, 35 USC Section 112; and inequitable conduct for omitting material information, or committing fraud on the USPTO, 37 CFR Section 1.56. A defendant who can prove any one of these defenses can get the asserted patent claim thrown out.

Benefits and Advantages of Trade Secrets.

Trade secrets have no expiration date, if the trade secret owner can keep them secret. There are no filing fees or costs, because trade secrets are not filed with any government agency. And trade secrets can be easier to enforce, if the scope of the trade secret is limited to a small manageable universe of individuals.

Disadvantages of Trade Secrets.

Unlike patents, trade secrets offer no protection if the secret is independently developed by others. Thus, someone toiling in a lab who happens to create the same formula WD-40 uses for its secret lubricant product can use that formula without fear of a lawsuit from WD-40. Independent creation by a third party eliminates the trade secret.

And the owner of the trade secret must protect the secret

at all times. Failure to do so eliminates protection.

Finally, as shown with the saga of KFC's now not-so-secret recipe, third parties can reveal the trade secret, without the trade secret owner's knowledge or consent.

In 2016, a Chicago Tribune reporter named Jay Jones was assigned to visit the Harland Sanders Cafe and Museum, the first fried chicken restaurant opened by Harland "Colonel" Sanders, in Corbin, Kentucky. Jones planned to write a piece about the museum for a feature entitled "Fork in the Road," a regular column in the Chicago Tribune's Travel section.

While in Corbin, he met long-time Corbin resident Joe Ledington, who as a boy worked in the original Harland Sanders restaurant. Ledington was Harland "Colonel" Sanders' nephew, and had worked for many years in the restaurant under his uncle's tutelage.

While giving Jones a tour of the restaurant, Ledington retrieved the last will and testament of Claudia Sanders, Harland Sanders's second wife and Joe Ledington's aunt. Inside the last and will testament was a crisply hand-written list of 11 herbs and spices, written in blue ink on a smooth piece of white paper. Ledington handed the list to Jones, who snapped a picture of the list with his cell phone camera. Jones then e-mailed the photo to his editors at the Chicago Tribune.

"That is the original 11 herbs and spices that were supposed to be so secretive," Ledington told reporter Jones about the piece of paper he had given Jones. At some point during the interview, Ledington began to realize the consequences of sharing the list with a newspaper reporter. Ledington later walked back his statement, saying the handwriting was not his uncle's and he did not know who wrote the list. "It could be; I don't know for sure," said Ledington, who acknowledged he had never shown the list to a reporter.

In August 2016, the Chicago Tribune made fried chicken in the newspaper's test kitchen, using the recipe from Ledington's hand-written list. After tinkering with the recipe for several hours, the Tribune's taste testers determined their chicken was "virtually indistinguishable from the batch bought at KFC." Based on this test, the Chicago Tribune concluded that it had indeed found and reproduced the Colonel's Secret Recipe, which KFC continues to keep in a locked vault.

KFC denies that Ledington's handwritten list is "The Colonel's Secret Recipe."

Whether Ledington's list really is the secret recipe is

immaterial. Because the list was publicly obtained, anyone can now attempt to make the recipe shown, and determine for themselves whether the recipe is the secret recipe. This example highlights the principle danger of trade secrets – no matter what steps a company takes to secure its trade secrets – locked vaults, motion detectors, guard dogs – a third party can reveal the secret, and it will vanish instantly.

How to Protect Trade Secrets.

Although there is no fool-proof way to protect trade secrets, there are some best practices. For example, trade secret owners should insist on non-disclosure agreements for potential investors and buyers. Trade secret owners should also insist on non-compete and non-disclosure agreements for current employees and company principals. In most states, non-compete agreements are considered restrictive covenants, with limitations on enforcement. Trade secret owners should also limit access to trade secrets solely to those in the company who need to know the secrets.

Finally, trade secret owners should use password protection and encryption for those secrets that are kept in company databases.

When to Use Trade Secrets.

Trade secrets are most applicable in industries where the invention is not likely to be independently developed by others. Trade secrets are also ideal for inventions that are not easily reverse engineered to precision, for example chemical formulations (WD-40), or food or beverage recipes (Krispy Kreme donuts, KFC, Coca-Cola).

Trade secrets are not ideal for mechanical or electrical inventions, which can be easily disassembled, for example cell phones.

Remedies for Trade Secret Violations.

The Uniform Trade Secrets Act (UTSA) provides the following remedies:

Injunctive relief; damages for misappropriation, which can include both the actual loss caused by misappropriation and the unjust enrichment caused by misappropriation; attorney's fees, if willful and malicious misappropriation is found.

When to Use Patents.

Patents are ideal for innovations that are improvements on existing technology, but are easily reverse-engineered, such as electrical or mechanical inventions.

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Patents protect against reverse engineering, and against subsequent independent invention by third parties.

In addition, patents are used as currency and defense

in highly competitive industries, such as high technology and cell phones. The following list shows the companies that were awarded the most patents in 2018.

| | |
|--|------|
| International Business Machines Corp | 9100 |
| Samsung Electronics Co Ltd | 5850 |
| Canon Inc | 3056 |
| Intel Corp | 2735 |
| LG Electronics Inc | 2474 |
| Taiwan Semiconductor Manufacturing Co (TSMC) Ltd | 2465 |
| Microsoft Technology Licensing LLC | 2353 |
| Qualcomm Inc | 2300 |
| Apple Inc | 2160 |
| Ford Global Technologies LLC | 2123 |

The companies that were awarded the most patents are primarily in tech, notably cell phone companies.

Remedies for Patent Infringement.

A court can award damages adequate to compensate for the infringement, but in no event less than a reasonable royalty. Damages can also include lost profits. And the court may increase the damages up to three times the amount found or assessed (35 USC Sec. 284).

In addition, a court can award reasonable attorney fees to the prevailing party in exceptional cases. The “prevailing party” can be plaintiff or defendant (35 USC Sec. 285).

Finally, a court can award injunctive relief, 35 USC Sec. 283.

Effect of the federal Defend Trade Secrets Act.

An owner of a trade secret that is misappropriated may now bring a civil action under federal law if the trade secret is related to a product or service used in, or intended for use in, interstate or foreign commerce. 18 U.S.C. Sec. 1836 (b)(1). The DTSA was enacted into law by President Obama on May 11, 2016. Prior to the enactment of the DTSA, a trade secret owner’s only remedies were under state law.

The DTSA contains several significant federal remedies for trade secret theft. A court can issue an order providing for the seizure of property necessary to prevent the propagation or dissemination of the trade secret that is the subject of the action. 18 U.S.C. Sec. 1836 (b)(2)(A).

And the DTSA can extend to conduct that occurs outside the United States, if the offender is a natural person who is a citizen or permanent resident alien of the United States, or an organization organized under the laws of the United States or a State or political subdivision thereof; or an act in furtherance of the offense was committed in the United States. 18 U.S.C. Sec. 1837.

Like its state counterpart the UTSA, the federal DTSA allows for injunctive relief, 18 USC Sec.1836(b)(3) (A); damages, 18 USC Sec.1836(b)(3)(B); exemplary damages in an amount not more than two times the amount of the damages awarded for willful and malicious misappropriation, 18 USC Sec.1836(b)(3)(C); and reasonable attorney’s fees if the trade secret was willfully and maliciously misappropriated, 18 USC Sec.1836(b) (3)(D).

Conclusion

The DTSA gives trade secret holders a new and powerful weapon against theft of trade secrets. Contrast this new weapon with recent Supreme Court decisions, which have almost all limited or weakened patent holder’s rights. And the DTSA expressly provides that it does not preempt state law, which means that state remedies under the Uniform Trade Secrets Act (UTSA) will continue to have the full force and effect of law. Trade secret owners can now use DTSA and MUTSA to protect trade secrets, which will have a profound impact on whether companies should use patents or trade secrets to protect valuable intellectual property.

Intellectual Property:

What to Reveal, and What to Keep Secret

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**Should you get a patent on
that new invention, or keep it
a trade secret?**

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Elements of Patentability: Section 101

- **Patentable subject matter is governed by federal law:**
 - "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." (35 U.S.C. § 101)

Elements of Patentability: Section 103

- "A patent for a claimed invention may not be obtained . . . if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains." (35 U.S.C. § 103)

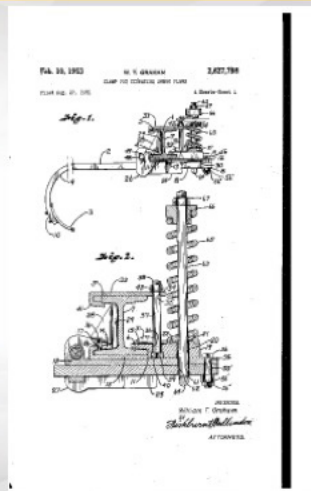
What is Patentable?

- Novel, useful, non-obvious, more commonly known as "new, useful, and non-obvious"
- Congress intended patentable statutory subject matter to "include anything under the sun that is made by man."
- *Diamond v. Chakrabarty*, 447 U.S. 303 (1980)

What is Non-Obvious?

- "An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent." *Graham v. John Deere Co.*, 383 U.S. 1 (1966)

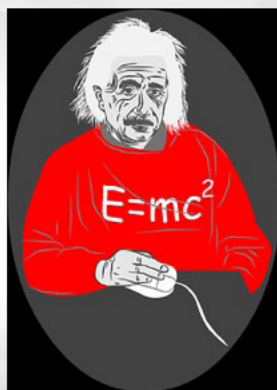
This Was Obvious



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Laws of nature, natural phenomena or abstract ideas are not patentable.



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What is A Trade Secret?

- Information that:
 - Derives independent economic value from not being generally known or ascertainable to the public.
 - Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.
- (Uniform Trade Secrets Act with 1985 Amendments).

Scope of Trade Secrets

- There is no subject matter limit.
- Virtually all technical information could qualify.
- Some categories of non-technical information can also be trade secrets:
 - Market analyses, strategic information, business plans, financial information, pricing, customer information, etc.

What is *not* a Trade Secret?

- Customer lists - unless they include payment or sales history.
- Generally known industry principles.
- Information that is readily ascertainable by proper means, or information that comprises general skills and knowledge acquired in the course of employment.

How are Trade Secrets Maintained?

- Must not be generally known
- Must not be readily ascertainable by proper (legal) means
 - *i.e.*, it cannot be easily reverse-engineered
- Must be the subject of efforts that are reasonable under the circumstances to maintain its secrecy

Famous Trade Secrets



- The Coca-Cola Formula, known by the code name "Merchandise 7X." The formula dates back to 1886.

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Famous Trade Secrets



- McDonald's "Special Sauce" used in the Big Mac. Some have speculated that the "Special Sauce" is simply Thousand Island dressing. McDonald's denies this.

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Famous Trade Secrets



- Krispy Kreme opened in North Carolina in 1937. The donut recipe is locked in a vault in Winston-Salem.

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Famous Trade Secrets



- WD-40 was made in 1953 by chemists who were attempting to create a product to protect the Atlas missile from rust and corrosion.

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Famous Trade Secrets



Founded 1930, Louisville Kentucky, United States

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Trade Secret: KFC Original Recipe

- The original recipe of 11 secret herbs and spices was handwritten in 1940 by Harland "Colonel" Sanders.
- Today, KFC keeps the handwritten original recipe locked in a digital safe that is allegedly surrounded by two feet of concrete and monitored 24 hours a day by a video and motion detection surveillance system.

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Length of Protection for Patents

- Utility and plant patents are valid for 20 years from the date of the patent application (not the issue date).
- Design patents last 15 years from the date the patent is granted.
- Patent protection ends when the patent is invalidated or rendered unenforceable.

Length of Protection for Trade Secrets

- There is no expiration date for trade secrets. A trade secret can potentially last forever, if the secret is maintained.



Benefits and Advantages of Patents

- Guaranteed monopoly for the patent term.
- Patents can be sold or licensed, and generate revenue.
- The scope of the invention is clear.
- Patents are public which can deter competition.
- Protect core innovations.
- Defense against independent invention.

Disadvantages of Patents: Cost

- Expensive to obtain and maintain. Extremely complicated or contested patents can cost more than \$20,000.
- Because they are public, anyone can make the invention after the patent expires.
- Litigation costs through trial can be over \$5 million.

Disadvantages of Patents: Supreme Court Limits Some Patents

- Bilski v. Kappos, 561 U.S. 593 (2010)
- Alice Corp. v. CLS Bank Int'l, 134 S. Ct. 2347 (2014)
- Nautilus, Inc. v. Biosig Instr., 134 S. Ct. 2120 (2014)
- Limelight Networks, Inc. v. Akamai Techs., Inc., 134 S. Ct. 2111 (2014)

Disadvantages of Patents: Many Statutory Defenses

- Patent lawsuits are often described as a “Defendant's paradise.”
- Anticipation – 35 USC Section 102
- Obviousness – 35 USC Section 103
- Indefiniteness – 35 USC Section 112
- Inequitable conduct for omitting material information, or committing fraud on the USPTO – 37 CFR Section 1.56

Benefits and Advantages of Trade Secrets

- No expiration date, if kept secret.
- No filing fees or costs – trade secrets are not filed with any government agency.
- Can be easier to enforce, if the scope of the trade secret is limited to a small universe of individuals.

Disadvantages of Trade Secrets

- Unlike patents, trade secrets offer no protection if the secret is independently developed by others.
- The owner of the trade secret must protect the secret -- failure to do so eliminates protection.
- Third parties can reveal the trade secret without the trade secret owner's knowledge or consent.

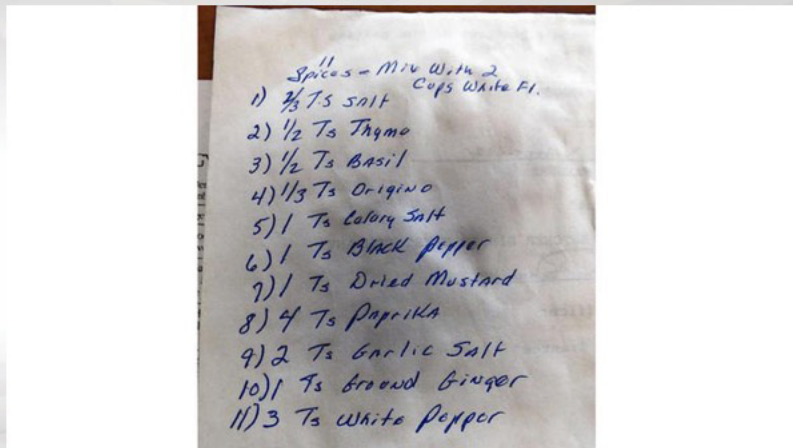
Difficulty of Protecting Trade Secrets



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This Was In the Will



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Was the Secret Revealed?

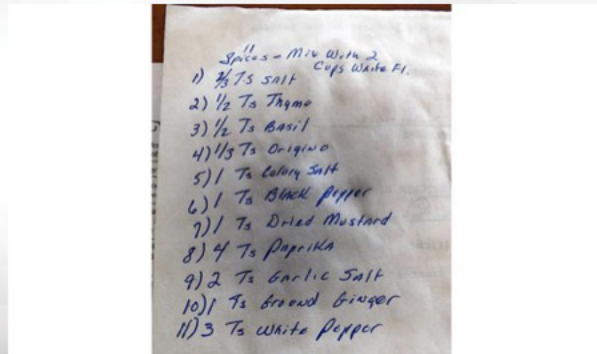
- "That is the original 11 herbs and spices that were supposed to be so secretive," Ledington told reporter Jones.
- KFC denies that Ledington's handwritten list is "The Colonel's Secret Recipe."

Was the Secret Revealed?

- In August 2016, the Chicago Tribune made fried chicken in the newspaper's test kitchen, using the recipe from Ledington's hand-written list.
- After trying several different mixes, the Tribune's taste testers determined their chicken was "virtually indistinguishable from the batch bought at KFC."

Was the Secret Revealed?

- KFC continues to deny Ledington's list is the Colonel's secret recipe.



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How to Protect Trade Secrets?

- Non-disclosure agreements for potential investors and buyers. Non-compete and non-disclosure agreements for current employees and principals.
- Limiting access to trade secrets solely to those who need to know.
- Password protection and encryption.

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How to Protect Trade Secrets?



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When to Use Trade Secrets?

- Industries where the invention is not likely to be independently developed by others.
- Trade secrets are not ideal for mechanical or electrical inventions, which can be easily disassembled.



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Remedies for Trade Secret Violations

- **1985 Uniform Trade Secrets Act Remedies.**
- Injunctive Relief.
- Damages, which can include both actual loss and unjust enrichment.
- Attorney's fees, if willful and malicious misappropriation is found.

When to Use Patents?

- Patents are used for innovations that are improvements on existing technology, but are easily reverse-engineered, such as electrical or mechanical inventions.
- Patents protect against reverse engineering, and against subsequent independent invention.

When to Use Patents



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Remedies for Patent Infringement

- Damages can include a reasonable royalty, or lost profits. The court may increase the damages up to three times the amount found or assessed (35 USC Sec. 284).
- Reasonable attorney fees to the prevailing party in exceptional cases (35 USC Sec. 285).
- Injunctive Relief (35 USC Sec. 283).

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Federal Defend Trade Secrets Act

- An owner of a trade secret that is misappropriated may bring a civil action under this subsection if the trade secret is related to a product or service used in, or intended for use in, interstate or foreign commerce (18 U.S.C. Sec. 1836 (b)(1)).
- Enacted into law by President Obama on May 11, 2016.

Key Provisions Under the DTSA

- Court can order seizure of property; injunctive relief; and damages.
- DTSA can apply to conduct that occurs outside the U.S.
- Exemplary damages twice the amount of actual damages for willful and malicious conduct.
- Attorney's fees for willful and malicious conduct.

DTSA Provides a New and Powerful Weapon Against Trade Secret Theft

- Recent Supreme Court decisions have almost all limited or weakened patent holder's rights.
- The DTSA expressly provides that it does not preempt state law. 18 USC Section 1838.
- Trade secret owners can now use DTSA and UTSA to protect trade secrets in states that have enacted UTSA.



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Terry Newby has extensive experience assisting clients with their intellectual property, e-commerce, and complex commercial litigation needs. He has successfully represented clients in state and federal courts throughout the country in a broad range of infringement matters involving patent, trademark, copyright, and trade dress as well as licensing disputes. In addition, Terry has taken intellectual property matters to trial, including federal jury trials in patent infringement, trademark infringement, and false advertising cases under the Lanham Act. His clients include software companies, consumer products companies, e-commerce and emerging technology companies, and medical device companies.

With a relentless focus on practical solutions to difficult problems, Terry regularly helps his clients navigate complex intellectual property matters. He devotes a large part of his practice to proactively drafting IP licenses, including confidentiality and non-disclosure agreements and software license agreements, so his clients can avoid litigation. When litigation is the only remaining option, Terry has the litigation and trial experience necessary to protect his client's intellectual property. Counseling clients and providing practical, common sense solutions are the core of Terry's practice.

Terry has significant appellate experience and has briefed and argued appeals involving complex commercial disputes, patents, and trademarks in various jurisdictions, including the Federal Circuit Court of Appeals and appellate courts in Minnesota, Iowa, and Illinois. He is also licensed to appear before the United States Supreme Court.

Areas of Practice

- Appeals
- Business Litigation
- Competitive Practices/Unfair Competition
- Intellectual Property Litigation

Representative Jury Trial Cases

- GTT v. Emtrac, et. al, U.S. District Court, District of Minnesota. Trial counsel for defendants in a patent infringement case. Case was tried before a jury in 2013.
- National Products, Inc. v. Gamber Johnson, U.S. District Court, Western District of Washington. Trial counsel for defendants in a false advertising case under the Lanham Act. Case was tried before a jury in 2010.
- Carpad, Inc. v. Brookstone, Inc., U.S. District Court, District of Nevada. Trial counsel for defendants in a trademark infringement case under the Lanham Act. Case was tried before a jury in 2003.

Recognition

- Professor of the Year Award, William Mitchell College of Law, 2009-2010
- Pro Bono Attorney of the Year, Minnesota Legal Services Coalition, 1999 (Award for "extraordinary service" in providing fair access to justice.)
- Adult Achiever Recognition, YMCA of St. Paul Black Achievers Program (Responsible for preparation of materials and coordinating annual Mock Trial program for inner city youth of St. Paul from 1997-2000.)

Education

- William Mitchell College of Law - J.D., 1995
- University of Wisconsin, Madison - B.A., 1989

