



**Seeking Remedies for Misappropriation of Trade Secrets:**

**In seeking remedies, are there any issues particularly relevant to trade secrets, compared to other IP?**

## Issues particularly relevant to trade secrets, „compared to other IP“

„Other IP“?

- EU: Trade secrets are no IP right

Recital 16 Directive (EU) 2016/943 on the protection of undisclosed know-how and business information (trade secrets) against their Unlawful Acquisition, Use and Disclosure („**Directive**“):  
“no exclusive right to know-how or information protected as trade secrets”.

- Consequence: „Enforcement Directive“ (Directive 2004/48/EC on the enforcement of intellectual property rights) does not apply.
- Consequence: Effects on access to evidence.

## “Seeking Remedies” for misappropriation – where to begin

**Check:** Have you got a trade secret in the first place?

- Legitimate ownership of the information (no register, no presumption of ownership)
- Secrecy of the information
- Value derived from the secrecy
- Reasonable measures applied to preserve the secrecy of the information

## Issue: Preserve confidentiality in the course of legal proceedings (I)

Confidentiality is at risk throughout the proceedings:

- Plaintiff's prayer for relief
  - Respondent's defenses
  - Statements of fact in written submissions
  - Presentation and discussion of expert evidence
  - Judgement granting the plaintiff relief
- 
- Principle of publicity of civil proceedings

## Preserve confidentiality in the course of legal proceedings (II)

Measures against the loss of confidentiality (Art. 9 Directive):

- Restrict access to documents
- Restrict access to hearings
- Prohibit use or disclosure of information
  
- But access to documents and hearings to at least one natural person from each party plus lawyers

Alternatives: arbitration or ADR

## Other issues relevant to seeking remedies for trade secrets misappropriation:

Lawful acquisition, use and disclosure (Art. 3 Directive), if secret is obtained by:

- Independent discovery or creation
- Reverse engineering, unless contractually prohibited
- Practices consistent with honest commercial practices

Exceptions (Art. 5 Directive), i.e. applications for remedies shall be dismissed where acquisition, use or disclosure was carried out for:

- Exercising the right to freedom of expression
- Revealing misconduct, wrongdoing or illegal activity („whistleblowing“), and respondent acted for the purpose of protecting the general public interest (what is that?)
- The purpose of protecting other legitimate interests recognized by EU or national laws

# Panelist



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Dr. Stefan Dittmer advises companies on all aspects of intellectual property and trade secrets law, including licensing, with a focus on technology, media and digitization. He represents clients in disputes relating to unfair competition, trade secrets and intellectual property rights, and in general commercial disputes before courts of law and arbitral tribunals.

He is a member of the Commission on Intellectual Property of the International Chamber of Commerce, chairman of the Berlin chapter of the German Association for the Protection of Intellectual Property (GRUR e.V.), and a co-editor and co-author of *Büscher/Dittmer/Schiwy*, a comprehensive commentary of IP laws, licensing and media law, 4th edition due for publication in 2020.

# ICC Report

## Protecting trade secrets – recent EU and US reforms

The report is available for free download here:

<https://iccwbo.org/publication/trade-secrets-report/>





# The EEA/DTSA/ RICO Widens the Scope of Civil Liability for Trade Secret Theft and Foreign Economic Espionage



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Mark is an accomplished trial lawyer who focuses his practice on intellectual property litigation and complex commercial litigation, including antitrust and licensing issues.



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**WIPO – Geneva**

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# Cross-border issues on Trade Secrets

# Challenges

- Lack of harmonization worldwide
- Civil vs Criminal law variations
- Conflicting rules for jurisdiction
- Variation of rules by “role” of person with access to trade secrets: employees, vendors, government officers, etc.
- Other local laws involved (cybercrime, labor, etc.)
- Availability of different *interim* and final measures for enforcement

## Key Issues

- ✓ Existence of cooperation agreements between countries for enforcement of judicial decisions.
- ✓ Cooperation of agencies for criminal law.
- ✓ Provisions on applicable law and jurisdiction in agreements with confidentiality obligations.

# Importance of Harmonization

- ✓ US – Trade Secrets as Federal Law

Formerly there was not harmonization within the US for state law differences.

- ✓ European Directive on Trade Secrets

AIPPI has made a survey on the status of the implementation per country.

- ✓ Other countries/regions?



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*Harmonization and cooperation  
are of the essence in order to  
ensure availability of remedies at  
international level for trade  
secrets enforcement.*

Thank you!

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# Seeking Remedies for Misappropriation of Trade Secrets

Punish the leaker

Take measures

Prohibit illegal use

Destroy all products

Prevent customer churn

# Stop Infringement Act



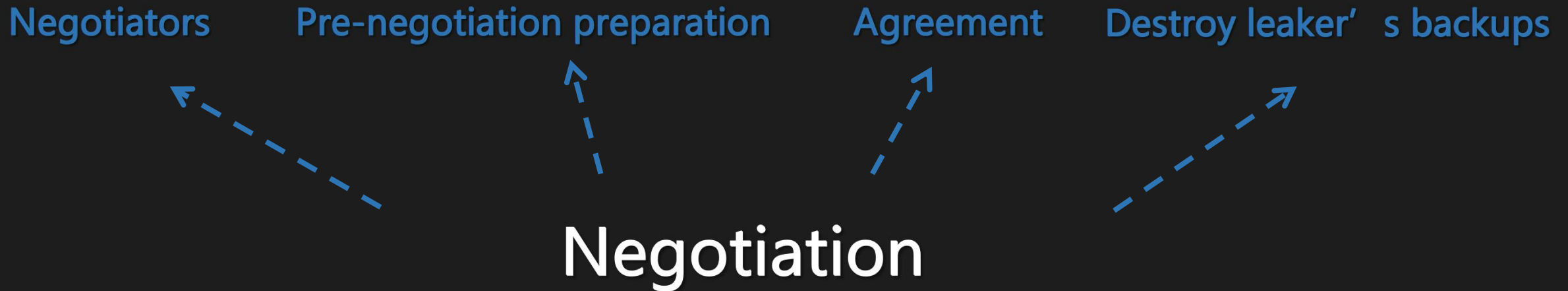
Define a trade secret with the law.

Assess the cash value of a trade secret.

Provide ownership.

# Scenario 1

A secret is divulged,  
but it has not yet been disclosed publicly or put into practical use.



# Scenario 2

A secret is publicly disclosed or used illegally.

Criminal litigation

Evidence preservation

Civil litigation

## Judicial Means

Notarization

Administrative penalty

Judicial identification

Passive → Active

Key word is Evidence

# Thank you!

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