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Trade Secrets

For most companies, their intangible assets—trade secrets and corporate know-how—are what gives them their edge over their business competitors. Yet the risk of having confidential information stolen or leaked is growing, as both workforces and information become more mobile. Information is increasingly digital in form and easily published or purloined: sent by e-mail; revealed on a blog; removed on a CD, DVD, or USB drive; or photographed with a digital camera or cellphone.

Since every business is vulnerable to having trade secrets and know-how stolen by departing employees, contractors, vendors, consultants, and licensees, how can companies protect their trade secrets and corporate know-how? How can they exploit their confidential know-how while still maintaining trade secret status?

Steptoe & Johnson LLP's Trade Secrets team regularly assist clients in protecting trade secrets and in defending against misappropriation claims, whether in a courtroom or an ADR/mediation arena. Due to this practice's multi-faceted nature, Steptoe relies on an interdisciplinary group of intellectual property, labor and employment, and litigation attorneys that stand ready to assist clients in these matters. Steptoe's team has vast experience in these matters and thus has the bench strength available whenever and wherever needed throughout the nation to handle the following issues appropriately and efficiently for its clients:

- Developing trade secret and confidential know-how protection programs;
- Creating employee handbooks, non-competition agreements, confidentiality agreements, non-solicitation agreements, e-mail and privacy policies, and incentive compensation agreements for corporate employees;
- Counseling employers on steps to take to avoid receiving trade secrets or confidential information when hiring key employees from competitors;
- Litigating claims for misappropriation of trade secrets and confidential information, unfair competition, breach of fiduciary duty, interference with prospective advantage or contractual relations, employee raiding, and related business torts;
- Litigating claims to enforce or invalidate confidentiality agreements and covenants not to compete;

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- Conducting trade secret and confidential information audits, either as stand-alone audits or as part of a broader IP audit;
- Preparing non-disclosure agreements, confidentiality agreements, and non-compete agreements for prospective merger and acquisition partners, joint venture partners, contractors, vendors, consultants, and professionals;
- Negotiating with government agencies to prevent them from releasing clients' trade secret information in response to a request made by a member of the public for access;
- Drafting outsourcing agreements and technology commercialization agreements with appropriate protections for trade secrets, confidential know-how, and other intellectual property;
- Identifying appropriate steps to maintain confidentiality and protect trade secrets and confidential know-how in a digital, networked, or Internet environment;
- Litigating related claims under the Computer Fraud and Abuse Act, Digital Millennium Copyright Act, or Electronic Communications Privacy Act; and
- Protecting confidential information during litigation.

Representative Matters

Trade Secrets and Unfair Competition Cases

- *Huawei Technologies Co., Ltd. v. Motorola, Inc. et al.* (N.D. Ill., 2011) – Represented **Nokia Siemens Networks B.V.** and **Nokia Siemens US** (collectively "NSN") in a trade secret action seeking to prevent the \$1.2 billion sale of Motorola's wireless networks business to NSN.
- *Newport Controls v. Balboa Instruments* (C.D. Cal., 2010) – Represented **Balboa Instruments** in an antitrust action involving the commercialization of spa controllers. The case settled on favorable terms.

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- *Thomas and Betts Power Solutions, LLC dba JT Packard v. S.R. Bray, LLC dba Power Plus! et al.* (W.D. Wis., 2010) – Defeated an attempt by Thomas and Betts Power Solutions, LLC dba JT Packard to obtain a preliminary injunction against its competitor, **S.R. Bray, LLC dba Power Plus!**, in a trade secret misappropriation case involving the power services industry.
- *StarTrak Sys. Inc. v. Satamatics, et al.* (D. N.J., 2007) – Defeated motion for preliminary injunction, against **Satamatics**, following evidentiary hearing in a trade secrets matter involving satellite and software technology.
- *SundRy v. Xwave* (E.D. Va., 2007) – Defended **Xwave** in trade secrets case relating to software. Case settled.
- *Kirchman Corporation v. Regions Financial Corporation* (M.D. Fla., 2006)– Defended **Regions** in a contract action concerning bank data processing software in which the plaintiff was seeking in excess of \$60 million. The action was concluded with a settlement favorable to Regions.
- *Phoenix Newspapers, Inc. v. Keegan*, 201 Ariz. 344, 35 P.3d 105 (Ct. App., 2001) – Represented a major newspaper, **Phoenix Newspapers, Inc.**, in an action against a developer of a high school graduation aptitude examination that was prohibiting access to or disclosure of the test on the grounds that it contained trade secrets.
- *McDonnell Douglas v. NASA*, 180 F.3d 303 (D.C. Cir., 1999) – Served as lead counsel for **McDonnell Douglas** in ground-breaking reverse-FOIA litigation, establishing that line item prices in government contracts can be protected from public disclosure under Exemption 4 and the Trade Secrets Act.
- *REM v. Risk Assessment Solutions, et al.* – Represented defendants in a case involving trade secrets, contracts, and ownership of intellectual property assets. Plaintiff dismissed actions.