

4162

2009-2010 Regular Sessions

I N S E N A T E

April 15, 2009

Introduced by Sen. AUBERTINE -- read twice and ordered printed, and when printed to be committed to the Committee on Judiciary

AN ACT to amend the general business law and the civil practice law and rules, in relation to the uniform trade secrets act

THE PEOPLE OF THE STATE OF NEW YORK, REPRESENTED IN SENATE AND ASSEMBLY, DO ENACT AS FOLLOWS:

1 Section 1. The general business law is amended by adding a new article
2 17-B to read as follows:

3 ARTICLE 17-B

4 UNIFORM TRADE SECRETS ACT

5 SECTION 279-M. SHORT TITLE.

6 279-N. DEFINITIONS.

7 279-O. INJUNCTIVE RELIEF.

8 279-P. DAMAGES.

9 279-Q. ATTORNEY'S FEES.

10 279-R. PRESERVATION OF SECRECY.

11 279-S. STATUTE OF LIMITATIONS.

12 279-T. EFFECT ON OTHER LAW.

13 279-U. UNIFORMITY OF APPLICATION AND CONSTRUCTION.

14 279-V. SEVERABILITY.

15 S 279-M. SHORT TITLE. THIS ARTICLE SHALL BE KNOWN AS THE "UNIFORM
16 TRADE SECRETS ACT".

17 S 279-N. DEFINITIONS. AS USED IN THIS ARTICLE, UNLESS THE CONTEXT
18 REQUIRES OTHERWISE:

19 (A) "IMPROPER MEANS" INCLUDES THEFT, BRIBERY, MISREPRESENTATION,
20 BREACH OR INDUCEMENT OF A BREACH OF A DUTY TO MAINTAIN SECRECY, OR ESPI-
21 ONAGE THROUGH ELECTRONIC OR OTHER MEANS;

22 (B) "MISAPPROPRIATION" MEANS: (1) ACQUISITION OF A TRADE SECRET OF
23 ANOTHER BY A PERSON WHO KNOWS OR HAS REASON TO KNOW THAT THE TRADE
24 SECRET WAS ACQUIRED BY IMPROPER MEANS; OR (2) DUPLICATING, SKETCHING,
25 DRAWING, PHOTOGRAPHING, DOWNLOADING, UPLOADING, CONCEALING, ALTERING,

EXPLANATION--Matter in ITALICS (underscored) is new; matter in brackets
[] is old law to be omitted.

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1 DESTROYING, REPLICATING, TRANSMITTING, DELIVERING, SENDING, MAILING,
2 COMMUNICATING, OR CONVEYING A TRADE SECRET WITHOUT AUTHORIZATION; OR (3)
3 RECEIVING, BUYING, OR POSSESSING A TRADE SECRET, KNOWING THE SAME TO
4 HAVE BEEN STOLEN OR APPROPRIATED, OBTAINED, OR CONVERTED WITHOUT AUTHOR-
5 IZATION; OR (4) DISCLOSURE OR USE OF A TRADE SECRET OF ANOTHER WITHOUT
6 EXPRESS OR IMPLIED CONSENT BY A PERSON WHO:

7 (I) USED IMPROPER MEANS TO ACQUIRE KNOWLEDGE OF THE TRADE SECRET; OR
8 (II) AT THE TIME OF DISCLOSURE OR USE, KNEW OR HAD REASON TO KNOW THAT
9 HIS OR HER KNOWLEDGE OF THE TRADE SECRET WAS:

10 (A) DERIVED FROM OR THROUGH A PERSON WHO HAD UTILIZED IMPROPER MEANS
11 TO ACQUIRE IT;

12 (B) ACQUIRED UNDER CIRCUMSTANCES GIVING RISE TO A DUTY TO MAINTAIN ITS
13 SECRECY OR LIMIT ITS USE; OR

14 (C) DERIVED FROM OR THROUGH A PERSON WHO OWED A DUTY TO THE PERSON
15 SEEKING RELIEF TO MAINTAIN ITS SECRECY OR LIMIT ITS USE; OR

16 (III) BEFORE A MATERIAL CHANGE OF HIS OR HER POSITION, KNEW OR HAD
17 REASON TO KNOW THAT IT WAS A TRADE SECRET AND THAT KNOWLEDGE OF IT HAD
18 BEEN ACQUIRED BY ACCIDENT OR MISTAKE;

19 (C) "PERSON" MEANS A NATURAL PERSON, CORPORATION, LIMITED LIABILITY
20 COMPANY, BUSINESS TRUST, ESTATE, TRUST, PARTNERSHIP, ASSOCIATION, JOINT
21 VENTURE, GOVERNMENT, GOVERNMENTAL SUBDIVISION OR AGENCY, OR ANY OTHER
22 LEGAL OR COMMERCIAL ENTITY; AND

23 (D) "TRADE SECRET" MEANS ANY FORM AND TYPE OF FINANCIAL, BUSINESS,
24 SCIENTIFIC, TECHNICAL, ECONOMIC, OR ENGINEERING INFORMATION, INCLUDING A
25 PATTERN, PLAN, COMPILATION, PROGRAM DEVICE, FORMULA, DESIGN, PROTOTYPE,
26 METHOD, TECHNIQUE, PROCESS, PROCEDURE, PROGRAM, OR CODE, WHETHER TANGI-
27 BLE OR INTANGIBLE, AND WHETHER OR HOW STORED, COMPILED, OR MEMORIALIZED
28 PHYSICALLY, ELECTRONICALLY, GRAPHICALLY, PHOTOGRAPHICALLY OR IN WRITING,
29 THAT:

30 (1) DERIVES INDEPENDENT ECONOMIC VALUE, ACTUAL OR POTENTIAL, FROM NOT
31 BEING GENERALLY KNOWN TO, AND NOT BEING READILY ASCERTAINABLE BY PROPER
32 MEANS BY, OTHER PERSONS WHO CAN OBTAIN ECONOMIC VALUE FROM ITS DISCLO-
33 SURE OR USE; AND

34 (2) IS THE SUBJECT OF EFFORTS THAT ARE REASONABLE UNDER THE CIRCUM-
35 STANCES TO MAINTAIN ITS SECRECY.

36 S 279-O. INJUNCTIVE RELIEF. (A) ACTUAL OR THREATENED MISAPPROPRIATION
37 MAY BE TEMPORARILY, PRELIMINARILY, OR PERMANENTLY ENJOINED. UPON APPLI-
38 CATION TO THE COURT, AN INJUNCTION SHALL BE VACATED WHEN THE TRADE
39 SECRET HAS CEASED TO EXIST, BUT THE INJUNCTION MAY BE CONTINUED FOR AN
40 ADDITIONAL REASONABLE PERIOD OF TIME IN ORDER TO ELIMINATE COMMERCIAL
41 ADVANTAGE THAT OTHERWISE WOULD BE DERIVED FROM THE MISAPPROPRIATION.

42 (B) IN EXCEPTIONAL CIRCUMSTANCES, AN INJUNCTION MAY CONDITION FUTURE
43 USE UPON PAYMENT OF A REASONABLE ROYALTY FOR NO LONGER THAN THE PERIOD
44 OF TIME FOR WHICH USE COULD HAVE BEEN PROHIBITED. EXCEPTIONAL CIRCUM-
45 STANCES INCLUDE, BUT ARE NOT LIMITED TO, A MATERIAL AND PREJUDICIAL
46 CHANGE OF POSITION PRIOR TO ACQUIRING KNOWLEDGE OR REASON TO KNOW OF
47 MISAPPROPRIATION THAT RENDERS A PROHIBITIVE INJUNCTION INEQUITABLE.

48 (C) IN APPROPRIATE CIRCUMSTANCES, THE COURT MAY ORDER AFFIRMATIVE ACTS
49 TO PROTECT A TRADE SECRET.

50 S 279-P. DAMAGES. (A) EXCEPT TO THE EXTENT THAT A MATERIAL AND PREJU-
51 DICIAL CHANGE OF POSITION PRIOR TO ACQUIRING KNOWLEDGE OR REASON TO KNOW
52 OF MISAPPROPRIATION RENDERS A MONETARY RECOVERY INEQUITABLE, A COMPLAIN-
53 ANT IS ENTITLED TO RECOVER DAMAGES FOR MISAPPROPRIATION. DAMAGES CAN
54 INCLUDE BOTH THE ACTUAL LOSS CAUSED BY MISAPPROPRIATION AND THE UNJUST
55 ENRICHMENT CAUSED BY MISAPPROPRIATION THAT IS NOT TAKEN INTO ACCOUNT IN
56 COMPUTING ACTUAL LOSS. IN LIEU OF DAMAGES MEASURED BY ANY OTHER METHODS,

1 THE DAMAGES CAUSED BY MISAPPROPRIATION MAY BE MEASURED BY IMPOSITION OF
2 LIABILITY FOR A REASONABLE ROYALTY FOR A MISAPPROPRIATOR'S UNAUTHORIZED
3 DISCLOSURE OR USE OF A TRADE SECRET.

4 (B) IF WILLFUL OR MALICIOUS MISAPPROPRIATION EXISTS, THE COURT MAY
5 AWARD EXEMPLARY DAMAGES IN AN AMOUNT NOT EXCEEDING TWICE ANY AWARD MADE
6 UNDER SUBDIVISION (A) OF THIS SECTION.

7 S 279-Q. ATTORNEY'S FEES. IF (A) A CLAIM OF MISAPPROPRIATION IS MADE
8 OR CONTINUED IN BAD FAITH, (B) A MOTION TO TERMINATE AN INJUNCTION IS
9 MADE OR RESISTED OR CONTINUED IN BAD FAITH, OR (C) A WILLFUL OR MALI-
10 CIOUS MISAPPROPRIATION EXISTS, THE COURT MAY AWARD REASONABLE ATTORNEY'S
11 FEES TO THE PREVAILING PARTY. FOR PURPOSES OF THIS SECTION, A CLAIM OF
12 MISAPPROPRIATION IS MADE OR CONTINUED IN BAD FAITH OR A MOTION TO TERMI-
13 NATE AN INJUNCTION IS MADE OR RESISTED OR CONTINUED IN BAD FAITH IF IT
14 IS UNDERTAKEN OR CONTINUED SOLELY TO HARASS OR MALICIOUSLY INJURE ANOTH-
15 ER OR TO DELAY OR PROLONG THE RESOLUTION OF THE LITIGATION; OR IT IS
16 UNDERTAKEN OR CONTINUED WITHOUT ANY REASONABLE BASIS IN FACT OR LAW AND
17 COULD NOT BE SUPPORTED BY A GOOD FAITH ARGUMENT FOR AN EXTENSION,
18 MODIFICATION OR REVERSAL OF EXISTING LAW.

19 S 279-R. PRESERVATION OF SECRECY. IN AN ACTION UNDER THIS ARTICLE, A
20 COURT SHALL PRESERVE THE SECRECY OF AN ALLEGED TRADE SECRET BY REASON-
21 ABLE MEANS, INCLUDING BUT NOT LIMITED TO, GRANTING PROTECTIVE ORDERS IN
22 CONNECTION WITH DISCOVERY DEVICES PURSUANT TO THE PROVISIONS OF SECTION
23 THIRTY-ONE HUNDRED THREE OF THE CIVIL PRACTICE LAW AND RULES, HOLDING
24 IN-CAMERA HEARINGS, SEALING THE RECORDS OF THE ACTION, AND ORDERING ANY
25 PERSON INVOLVED IN THE LITIGATION NOT TO DISCLOSE AN ALLEGED TRADE
26 SECRET WITHOUT PRIOR COURT APPROVAL.

27 S 279-S. STATUTE OF LIMITATIONS. NOTWITHSTANDING ANY INCONSISTENT
28 PROVISION OF LAW, AN ACTION FOR MISAPPROPRIATION MUST BE BROUGHT WITHIN
29 THREE YEARS AFTER THE MISAPPROPRIATION IS DISCOVERED OR BY THE EXERCISE
30 OF REASONABLE DILIGENCE SHOULD HAVE BEEN DISCOVERED. FOR THE PURPOSES OF
31 THIS SECTION, A CONTINUING MISAPPROPRIATION CONSTITUTES A SINGLE CLAIM.

32 S 279-T. EFFECT ON OTHER LAW. (A) EXCEPT AS PROVIDED IN SUBDIVISION
33 (B) OF THIS SECTION, THIS ARTICLE DISPLACES CONFLICTING TORT, RESTITU-
34 TIONARY, AND OTHER LAW OF THIS STATE PROVIDING CIVIL REMEDIES FOR MISAP-
35 PROPRIATION OF A TRADE SECRET.

36 (B) THIS ARTICLE DOES NOT AFFECT:

37 (1) CONTRACTUAL REMEDIES, WHETHER OR NOT BASED UPON MISAPPROPRIATION
38 OF A TRADE SECRET;

39 (2) OTHER CIVIL REMEDIES THAT ARE NOT BASED UPON MISAPPROPRIATION OF A
40 TRADE SECRET; OR

41 (3) CRIMINAL REMEDIES, WHETHER OR NOT BASED UPON MISAPPROPRIATION OF A
42 TRADE SECRET.

43 S 279-U. UNIFORMITY OF APPLICATION AND CONSTRUCTION. THIS ARTICLE
44 SHALL BE APPLIED AND CONSTRUED TO EFFECTUATE ITS GENERAL PURPOSE TO MAKE
45 UNIFORM THE LAW WITH RESPECT TO THE SUBJECT OF THIS ARTICLE AMONG STATES
46 ENACTING IT.

47 S 279-V. SEVERABILITY. IF ANY PROVISION OF THIS ARTICLE OR ITS APPLI-
48 CATION TO ANY PERSON OR CIRCUMSTANCES IS HELD INVALID, THE INVALIDITY
49 DOES NOT AFFECT OTHER PROVISIONS OR APPLICATIONS OF THIS ARTICLE WHICH
50 CAN BE GIVEN EFFECT WITHOUT THE INVALID PROVISION OR APPLICATION, AND TO
51 THIS END THE PROVISIONS OF THIS ARTICLE ARE SEVERABLE.

52 S 2. Section 8303-a of the civil practice law and rules is amended by
53 adding a new subdivision (d) to read as follows:

54 (D) THE PROVISIONS OF THIS SECTION SHALL NOT APPLY TO ACTIONS GOVERNED
55 BY ARTICLE SEVENTEEN-B OF THE GENERAL BUSINESS LAW.

1 S 3. This act shall take effect on the one hundred eightieth day after
2 it shall have become a law, except that the provisions of article 17-B
3 of the general business law, as added by section one of this act, shall
4 not apply to a misappropriation occurring prior to such effective date.
5 With respect to a continuing misappropriation that began prior to such
6 effective date, this act shall not apply to the continuing misappropri-
7 ation that occurs after such effective date.