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THE GENERAL ASSEMBLY OF PENNSYLVANIA

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SENATE BILL

No. 1319 Session of  
2002

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INTRODUCED BY DENT, CORMAN, WAUGH, COSTA, ORIE, PUNT, M. WHITE,  
BELL, LEMMOND, THOMPSON AND STACK, MARCH 12, 2002

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REFERRED TO JUDICIARY, MARCH 12, 2002

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AN ACT

1 Amending Title 12 (Commerce and Trade) of the Pennsylvania  
2 Consolidated Statutes, adding provisions relating to trade  
3 secrets.

4 The General Assembly of the Commonwealth of Pennsylvania  
5 hereby enacts as follows:

6 Section 1. Title 12 of the Pennsylvania Consolidated  
7 Statutes is amended by adding a chapter to read:

8 CHAPTER 53

9 TRADE SECRETS

10 Sec.

11 5301. Short title of chapter.

12 5302. Definitions.

13 5303. Injunctive relief.

14 5304. Damages.

15 5305. Attorney fees.

16 5306. Preservation of secrecy.

17 5307. Statute of limitations.

18 5308. Effect on other law.

1 § 5301. Short title of chapter.

2 This chapter shall be known and may be cited as the Uniform  
3 Trade Secrets Act.

4 § 5302. Definitions.

5 The following words and phrases when used in this chapter  
6 shall have the meanings given to them in this section unless the  
7 context clearly indicates otherwise:

8 "Improper means." Includes, but is not limited to, theft,  
9 bribery, misrepresentation, breach or inducement of a breach of  
10 a duty to maintain secrecy or espionage through electronic or  
11 other means.

12 "Misappropriation." Includes:

13 (1) acquisition of a trade secret of another by a person  
14 who knows or has reason to know that the trade secret was  
15 acquired by improper means; or

16 (2) disclosure or use of a trade secret of another  
17 without express or implied consent by a person who:

18 (i) used improper means to acquire knowledge of the  
19 trade secret;

20 (ii) at the time of disclosure or use, knew or had  
21 reason to know that his knowledge of the trade secret  
22 was:

23 (A) derived from or through a person who had  
24 utilized improper means to acquire it;

25 (B) acquired under circumstances giving rise to  
26 a duty to maintain its secrecy or limit its use; or

27 (C) derived from or through a person who owed a  
28 duty to the person seeking relief to maintain its  
29 secrecy or limit its use; or

30 (iii) before a material change of his position, knew

1 or had reason to know that it was a trade secret and that  
2 knowledge of it had been acquired by accident or mistake.

3 "Person." A natural person, corporation, business trust,  
4 estate, trust, partnership, association, joint venture,  
5 government, governmental subdivision or agency or any other  
6 legal or commercial entity.

7 "Trade secret." Information, including a formula, drawing,  
8 pattern, compilation, program, device, method, technique or  
9 process that:

10 (1) Derives independent economic value, actual or  
11 potential, from not being generally known to, and not being  
12 readily ascertainable by proper means by, other persons who  
13 can obtain economic value from its disclosure or use.

14 (2) Is the subject of efforts that are reasonable under  
15 the circumstances to maintain its secrecy.

16 "Willful and malicious." Such intentional acts or gross  
17 neglect of duty as to evince a reckless indifference of the  
18 rights of others on the part of the wrongdoer, and an entire  
19 want of care so as to raise the presumption that the person at  
20 fault is conscious of the consequences of his carelessness.

21 § 5303. Injunctive relief.

22 (a) Injunctions.--Actual or threatened misappropriation may  
23 be enjoined. Upon application to the court, an injunction shall  
24 be terminated when the trade secret has ceased to exist, but the  
25 injunction may be continued for an additional reasonable period  
26 of time in order to eliminate commercial advantage that  
27 otherwise would be derived from the misappropriation.

28 (b) Exceptional circumstances.--In exceptional  
29 circumstances, an injunction may condition future use upon  
30 payment of a reasonable royalty for no longer than the period of

1 time for which use could have been prohibited. Exceptional  
2 circumstances include, but are not limited to, a material and  
3 prejudicial change of position prior to acquiring knowledge or  
4 reason to know of misappropriation that renders a prohibitive  
5 injunction inequitable.

6 (c) Affirmative acts compelled by court order.--In  
7 appropriate circumstances, affirmative acts to protect a trade  
8 secret may be compelled by court order.

9 § 5304. Damages.

10 (a) Monetary damages.--Except to the extent that a material  
11 and prejudicial change of position prior to acquiring knowledge  
12 or reason to know of misappropriation renders a monetary  
13 recovery inequitable, a complainant is entitled to recover  
14 damages for misappropriation. Damages can include both the  
15 actual loss caused by misappropriation and the unjust enrichment  
16 caused by misappropriation that is not taken into account in  
17 computing actual loss. In lieu of damages measured by any other  
18 methods, the damages caused by misappropriation may be measured  
19 by imposition of liability for a reasonable royalty for a  
20 misappropriator's unauthorized disclosure or use of a trade  
21 secret.

22 (b) Exemplary damages.--If willful and malicious  
23 misappropriation exists, the court may award exemplary damages  
24 in an amount not exceeding twice any award made under subsection  
25 (a).

26 § 5305. Attorney fees.

27 A court may award reasonable attorney fees, expenses and  
28 costs to the prevailing party:

- 29 (1) if a claim of misappropriation is made in bad faith;  
30 (2) a motion to terminate an injunction is made or

1       resisted in bad faith; or

2           (3) willful and malicious misappropriation exists.

3   § 5306. Preservation of secrecy.

4       In any action under this chapter, a court shall preserve the  
5   secrecy of an alleged trade secret by reasonable means which may  
6   include, but are not limited to, granting protective orders in  
7   connection with discovery proceedings, holding in camera  
8   hearings, sealing the records of the action and ordering any  
9   person involved in the litigation not to disclose an alleged  
10   trade secret without prior court approval.

11   § 5307. Statute of limitations.

12       An action under this chapter for misappropriation must be  
13   brought within three years after the misappropriation was  
14   discovered or by the exercise of reasonable diligence should  
15   have been discovered.

16   § 5308. Effect on other law.

17       (a) General rule.--Except as provided in subsection (b),  
18   this chapter displaces conflicting tort, restitutionary and  
19   other law of this State providing civil remedies for  
20   misappropriation of a trade secret.

21       (b) Exceptions.--This chapter does not affect:

22           (1) contractual remedies, whether or not based upon  
23   misappropriation of a trade secret;

24           (2) other civil remedies that are not based upon  
25   misappropriation of a trade secret; or

26           (3) criminal remedies, whether or not based upon  
27   misappropriation of a trade secret.

28       Section 2. In applying and construing 12 Pa.C.S. Ch. 53,  
29   comments or reports of the type referred to in 1 Pa.C.S. § 1939  
30   shall control in the event of a conflict between such comments

1 or reports and the policy of uniformity provided under 1 Pa.C.S.  
2 § 1927.

3 Section 3. This act shall not apply to misappropriation  
4 occurring prior to the effective date of this act, including a  
5 continuing misappropriation that began prior to the effective  
6 date of this act and which continues to occur after the  
7 effective date of this act.

8 Section 4. This act shall take effect in 60 days.