

# **WEST VIRGINIA LEGISLATURE**

## **2020 REGULAR SESSION**

**Introduced**

### **House Bill 4005**

BY DELEGATES LINVILLE, HANSHAW (MR. SPEAKER),  
BARNHART, MANDT, PORTERFIELD, WAXMAN, HOWELL,  
GRAVES, ESPINOSA AND HOUSEHOLDER

[Introduced January 08, 2020; Referred to the  
Committee on the Judiciary]

1 A BILL to repeal §47-22-9 and §47-22-10 of the Code of West Virginia, 1931, as amended; and  
 2 to amend and reenact §47-22-1, §47-22-2, §47-22-3, §47-22-4, §47-22-6, §47-22-7, and  
 3 §47-22-8 of said code, all relating to the protection of intellectual property and trade  
 4 secrets; changing the "Uniform Trade Secrets Act" to the "West Virginia Intellectual  
 5 Property and Trade Secrets Act"; providing for definitions; setting forth criminal penalties  
 6 for certain acts associated with the misappropriation of intellectual property and trade  
 7 secrets; providing for injunctive and civil relief; allowing for punitive damages and  
 8 attorney's fees in certain circumstances; and clarifying applicability of amendments.

*Be it enacted by the Legislature of West Virginia:*

**ARTICLE 22. ~~UNIFORM TRADE SECRETS ACT.~~ WEST VIRGINIA INTELLECTUAL  
PROPERTY AND TRADE SECRETS ACT.**

**§47-22-1. Definitions Short title.**

1 As used in this article, unless the context requires otherwise:

2 (a) ~~"Improper means" includes theft, bribery, misrepresentation, breach or inducement of~~  
 3 ~~a breach of a duty to maintain secrecy or espionage through electronic or other means.~~

4 (b) ~~"Misappropriation" means:~~

5 (1) ~~Acquisition of a trade secret of another by a person who knows or has reason to know~~  
 6 ~~that the trade secret was acquired by improper means; or~~

7 (2) ~~Disclosure or use of another person's trade secret without the other's express or~~  
 8 ~~implied consent by a person who:~~

9 (A) ~~Used improper means to acquire knowledge of the trade secret; or~~

10 (B) ~~At the time of disclosure or use, knew or had reason to know that his or her knowledge~~  
 11 ~~of the trade secret was:~~

12 (i) ~~Derived from or through a person who had utilized improper means to acquire it; or~~

13 (ii) ~~Acquired under circumstances giving rise to a duty to maintain its secrecy or limit its~~

14 use; or

15 ~~(iii) Derived from or through a person who owed a duty to the person seeking relief to~~  
16 ~~maintain its secrecy or limit its use; or~~

17 ~~(C) Before a material change of his or her position, knew or had reason to know that the~~  
18 ~~information was a trade secret and that knowledge of it had been acquired by accident or mistake.~~

19 ~~(c) "Person" means a natural person, corporation, business trust, estate, trust, partnership,~~  
20 ~~association, joint venture, government, governmental subdivision or agency or any other legal or~~  
21 ~~commercial entity.~~

22 ~~(d) "Trade secret" means information, including, but not limited to, a formula, pattern,~~  
23 ~~compilation, program, device, method, technique or process, that:~~

24 ~~(1) Derives independent economic value, actual or potential, from not being generally~~  
25 ~~known to, and not being readily ascertainable by proper means by, other persons who can obtain~~  
26 ~~economic value from its disclosure or use; and~~

27 ~~(2) Is the subject of efforts that are reasonable under the circumstances to maintain its~~  
28 ~~secrecy~~

29 This article may be cited as the "West Virginia Intellectual Property and Trade Secrets  
30 Act."

**§47-22-2. Injunctive relief Definitions.**

1 ~~(a) Actual or threatened misappropriation may be enjoined. Upon application to the court,~~  
2 ~~an injunction shall be terminated when the trade secret has ceased to exist, but the injunction~~  
3 ~~may be continued for an additional reasonable period of time in order to eliminate commercial~~  
4 ~~advantage that otherwise would be derived from the misappropriation.~~

5 ~~(b) In exceptional circumstances, an injunction may condition future use upon payment of~~  
6 ~~a reasonable royalty for no longer than the period of time for which the use could have been~~  
7 ~~prohibited. Exceptional circumstances include, but are not limited to, a material and prejudicial~~  
8 ~~change of position prior to acquiring knowledge or reason to know of a misappropriation that~~

9 ~~renders a prohibitive injunction inequitable.~~

10 ~~(c) In appropriate circumstances, affirmative acts to protect a trade secret may be~~  
11 ~~compelled by court order~~

12 As used in this article, unless the context requires otherwise:

13 (a) "Intellectual property" means a commercially valuable product of the human intellect  
14 that:

15 (1) Is a trade secret in the sense that it is not, as a body or in the precise configuration  
16 and assembly of its components, generally known among, or readily accessible to persons within  
17 circles that normally deal with the kind of information in question;

18 (2) Has commercial value because it is a trade secret; and

19 (3) Has been subject to reasonable steps under the circumstances, by the person lawfully  
20 in control of the information, to keep it secret.

21 (b) "Improper means" includes theft, bribery, misrepresentation, breach, or inducement of  
22 a breach of a duty to maintain secrecy or espionage through electronic or other means.

23 (c) "Misappropriation" means:

24 (1) Acquisition of intellectual property or trade secret of another by a person who knows,  
25 or has reason to know, that the trade secret was acquired by improper means; or

26 (2) Disclosure or use of another person's intellectual property or trade secret without the  
27 other's express or implied consent by a person who:

28 (A) Used improper means to acquire knowledge of the intellectual property or trade secret;  
29 or

30 (B) At the time of disclosure or use, knew or had reason to know, that his or her knowledge  
31 of the intellectual property or trade secret was:

32 (i) Derived from or through a person who had utilized improper means to acquire it; or

33 (ii) Acquired under circumstances giving rise to a duty to maintain its secrecy or limit its  
34 use; or

35 (iii) Derived from or through a person who owed a duty to the person seeking relief to  
36 maintain its secrecy or limit its use; or

37 (C) Before a material change of his or her position knew, or had reason to know, that the  
38 information was intellectual property or a trade secret and that knowledge of it had been acquired  
39 by accident or mistake.

40 (d) "Person" means a natural person, corporation, business trust, estate, trust, partnership,  
41 association, joint venture, government, governmental subdivision or agency, or any other legal or  
42 commercial entity.

43 (e) "Trade secret" means information including, but not limited to, a formula, pattern,  
44 compilation, program, device, method, technique or process, that:

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

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

**§47-22-3. Damages Unlawful acts.**

1 ~~(a) Except to the extent that a material and prejudicial change of position prior to acquiring~~  
2 ~~knowledge or reason to know of misappropriation renders a monetary recovery inequitable, a~~  
3 ~~complainant is entitled to recover damages for misappropriation. Damages may include both the~~  
4 ~~actual loss caused by the misappropriation and the unjust enrichment caused by the~~  
5 ~~misappropriation. In lieu of damages measured by any other methods, the damages caused by~~  
6 ~~misappropriation may be measured by imposition of liability for a reasonable royalty for a~~  
7 ~~misappropriator's unauthorized disclosure or use of a trade secret.~~

8 ~~(b) If willful and malicious misappropriation occurs, the court may award exemplary~~  
9 ~~damages in an amount not exceeding twice any award made under subsection (a).~~

10 Pursuant to the terms of this article, the following acts are unlawful:

11 (a) Acquisition of intellectual property or trade secret of another by a person who knows,  
12 or has reason to know, that the intellectual property or trade secret was acquired by improper  
13 means;

14 (b) Disclosure or use of another person's intellectual property or trade secret without the  
15 other's express or implied consent by a person who:

16 (1) Used improper means to acquire knowledge of the intellectual property or trade secret;

17 or

18 (2) At the time of disclosure or use knew, or had reason to know, that his or her knowledge  
19 of the intellectual property or trade secret was:

20 (A) Derived from or through a person who had utilized improper means to acquire it; or

21 (B) Acquired under circumstances giving rise to a duty to maintain its secrecy or limit its  
22 use; or

23 (C) Derived from or through a person who owed a duty to the person seeking relief to  
24 maintain its secrecy or limit its use;

25 (c) Breach of a nondisclosure agreement or other employment agreement by an  
26 employee, officer, or agent for the purposes of misappropriation of intellectual property or trade  
27 secrets;

28 (d) Willful disregard for a person's intellectual property or trade secrets;

29 (e) Any knowing and willful attempt, either directly or indirectly, to access or cause to be  
30 accessed a computer or computer network with the intent to obtain the intellectual property or  
31 trade secrets of another; or

32 (f) Any knowing and willful attempt, either directly or indirectly, to disclose intellectual  
33 property or trade secrets to any corporation, trust, association, partnership, or other entity  
34 organized outside the laws of the United States.

35 In addition to the civil relief provided in §47-22-4 of this code, any person violating any  
36 provision of this section is guilty of a misdemeanor and, upon conviction thereof, shall be fined

37 not more than \$1,000, or confined in jail for not more than one year, or both, for each violation of  
38 this act: *Provided*, That any person violating the provisions of subsection (f) of this section is guilty  
39 of a felony and, upon conviction thereof, shall be *confined* in a state correctional facility not less  
40 than one year, or fined not less than \$1,000, or both *confined* and fined.

**§47-22-4. ~~Attorney's fees~~ Injunctive and civil relief; damages; attorney's fees.**

1 ~~If (a) a claim of misappropriation is made in bad faith, or (b) a motion to terminate an~~  
2 ~~injunction is made or resisted in bad faith, or (c) willful and malicious misappropriation occurs, the~~  
3 ~~court may award reasonable attorney's fees to the prevailing party.~~

4 In addition to the penalties set forth in §47-22-3 of this code, any person whose property  
5 or person is injured by reason of actual or threatened misappropriation of the person's intellectual  
6 property or trade secrets, may sue therefor in circuit court and may be entitled to recover as  
7 follows for each violation:

8 (a) *Injunctive relief.* —

9 (1) Actual or threatened misappropriation shall be enjoined to the extent necessary to  
10 effectuate the immediate cessation of use of a person's intellectual property or trade secret;

11 (2) Affirmative acts may be compelled by court order to provide for the immediate  
12 protection of a person's intellectual property or trade secret from further disclosure, including, but  
13 not limited to, requirement that the person or persons accused of misappropriation remain in the  
14 jurisdiction of the court for the remainder of the judicial process;

15 (3) Upon application to the court, an injunction shall be terminated when the intellectual  
16 property or trade secret has ceased to exist, but the injunction may be continued for an additional  
17 reasonable period of time in order to eliminate commercial advantage that otherwise would be  
18 derived from the misappropriation; and

19 (4) In appropriate circumstances, a court may require posting of a bond to secure against  
20 future potential damages associated with the misappropriation of the intellectual property or trade  
21 secret.

22 (b) Civil relief. —

23 (1) Except to the extent that a material and prejudicial change of position, prior to acquiring  
24 knowledge or reason to know of misappropriation, renders a monetary recovery inequitable, a  
25 complainant is also entitled to recover compensatory damages for the misappropriation of the  
26 person’s intellectual property or trade secrets, as well as for any breach of a nondisclosure  
27 agreement or other employment agreement by an employee, officer, or agent of the complainant  
28 for the purposes of misappropriation of intellectual property or trade secrets.

29 (2) Damages may include the actual loss caused by the misappropriation, as well as the  
30 unjust enrichment caused by the misappropriation, and any intangible or future losses caused by  
31 the misappropriation.

32 (3) In lieu of damages measured by any other methods, the damages caused by  
33 misappropriation may be measured by imposition of liability for a reasonable royalty for a mis-  
34 appropriator’s unauthorized disclosure, or use of the intellectual property or trade secret.

35 (4) If willful and malicious misappropriation occurs, a person may recover punitive  
36 damages in accordance with §55-7-29 of this code.

37 (c) Attorney’s Fees. —

38 The court may award reasonable attorney’s fees to a prevailing party if:

39 (A) A claim of misappropriation is made in bad faith;

40 (B) A motion to terminate an injunction is made or resisted in bad faith; or

41 (C) Willful and malicious misappropriation occurs.

**§47-22-6. Statute of limitations.**

1 An action for misappropriation must be brought within ~~three~~ five years after the  
2 misappropriation is discovered or, by the exercise of reasonable diligence, should have been  
3 discovered. For the purposes of this section, a continuing misappropriation constitutes a single  
4 claim.

**§47-22-7. Effect on other law.**



1 (a) Except as provided in subsection (b), of this section, this article displaces conflicting  
2 tort, restitutive, and other law of this state providing civil remedies for misappropriation of  
3 intellectual property or a trade secret.

4 (b) This article does not affect:

5 (1) Contractual remedies, whether or not based upon misappropriation of intellectual  
6 property or a trade secret;

7 (2) Other civil remedies that are not based upon misappropriation of intellectual property  
8 or a trade secret; or

9 (3) Criminal remedies, whether or not based upon misappropriation of intellectual property  
10 or a trade secret.

11 (c) Nothing in this section applies to any information about the marketing and distribution  
12 of any substance regulated under Schedule II of the Controlled Substances Act, Title 21, Code of  
13 federal Regulations, §1308.12(b) and §1308.12(c), including opioids and opiates.

**§47-22-8. Uniformity of application and construction Applicability.**

1 ~~This article shall be applied and construed to effectuate its general purpose to make~~  
2 ~~uniform the law with respect to the subject of this act among states enacting it~~

3 The amendments to this article enacted during the regular session of the Legislature,  
4 2020, shall take effect on July 1, 2020, and do not apply to any misappropriations occurring prior  
5 to the effective date or to misappropriations which began prior to the effective date and continue  
6 past the effective date.

**§47-22-9. Short title.**

1 [Repealed.]

**§47-22-10. Time of taking effect.**

1 [Repealed.]

NOTE: The purpose of this bill is to create the West Virginia Intellectual Property and Trade

Secrets Act. The bill provides criminal, injunctive and civil protections against the misappropriation of intellectual property and trade secrets.

Strike-throughs indicate language that would be stricken from a heading or the present law and underscoring indicates new language that would be added.