PRC Labor and Employment Law Newsflash

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Protection of Trade Secret in Talent Flow

In the recent years, the increasing cases of trade secret infringement due to talent flow cover a large proportion of trade secret cases heard by the people's courts, which prominently focus on (1) serving staff violating duty of loyalty and infringing company's trade secret by means of part-time job; and (2) ex-serving staff of key positions provide service to competitors or participating in their own business that competes with the ex-employer. This newsflash is aimed to discuss the issue of trade secret protection in talent flow.

1. The Consideration and Term of Confidentiality Duty

Confidentiality duty, which is derived from the duty of loyalty, is the main obligation to employees in employment relation. Employers, strictly, are not supposed to compensate employees for their assuming the duty; however, provided confidentiality fee has been stipulated between the employer and employee, compensation shall be paid under the agreement. Employers shall not use lack of such legal obligation as defense.

Besides, we often see the term of period of confidentiality duty, such as employers are subject to confidentiality duty for two years following termination of employment in legal practice. Such agreement, however, in our opinion is not very appropriate. On one hand, confidentiality duty is a main obligation to employee in employment relation, which still lasts even though employment relationship has been terminated. Confidentiality duty period, to some extent, makes a limitation to the right of employer. On the other hand, since trade secret is deemed as employer's property before it enters into the public realm, employee, as counterparty, has no right to infringe or disclose. Hence, the agreement on period of confidentiality duty shall be revised.

2. Proof of Trade Secret Infringement

The trial principle of trade secret infringement cases, in many parties' opinions, is "similarity (or identical) + contact – legal source". The counterparty is supposed to bear the burden of proof as to the fact of "legal source" as long as the facts that the counterparty's information is similar or identical and the counterparty has access to the trade secrets at his convenience have been proved. If the counterparty cannot prove the "legal source", the counterparty shall be liable to infringement.

The aforesaid analysis, however, is not in compliance with *the Interpretation of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Civil Cases Involving Unfair Competition*. Pursuant to Article 14 of it, where a party alleges that another infringes its trade secret, the party shall bear the burden of proof as to the fact that the trade secret it has possessed is in conformity to the statutory requirements, that the other party's information is identical or substantially identical to its trade secret, and that the other party has adopted unfair means. The evidence showing that the trade secret conforms to the statutory conditions shall include the carrier, specific content, and business value of the trade secret, and the specific confidentiality measures taken for the trade secret.

Therefore, the party shall bear the burden of proof as to the facts as below prior to requiring the counterparty to prove "legal source", or it seems to require the counterparty to prove his own innocence that is against the principle of civil law.
(1) Proving that they are the legitimate holders of trade secrets; and
(2) The other party has adopted unfair means.

3. Identification and Protection of Customer List

Customer list is one of the most common and important trade secrets to all corporations. Unfortunately, not all the customer lists are deemed to as protected trade secrets. In compliance with Article 13 of *the Interpretation of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Civil Cases Involving Unfair Competition*, the customer list that is a trade secret shall generally refer to special customer data that is different from

relevant public information, such as the names, addresses, contact information, habits, intentions, and contents of transaction of the clients, etc. It includes a customer list with the names of many customers /clients, and specific customers/clients with whom a long-term stable trade relationship has been established.

Hence, only the compile of the contact information of customers cannot constitute the customer list protected by the Interpretation. In summary, the undisclosed habits and contents of transaction, except the names and contact information of corporations which can be obtained publicly, are the substantial contents of a protected customer list.

Case Study

Plaintiff A is an equipment company which runs for production and sales for agriculture machinery. Defendant B and C were both employee of A and concluded a confidential agreement with A. In December 2012, B and C, during the employment at the company, set a Company D whose business competes with company A. Besides, B and C, making use of their position convenience at company A, illegally disclosed trade secrets of A to company D, which led adverse impacts on A's operation. Thus A sued B and C for ceasing infringing act and compensating for loss.

The trial found that what the plaintiff alleged cannot constitute trade secrets defined in *the Anti-unfair Competition Law*, because most of the information has been disclosed on A's website, some of it even on public websites. Moreover, the plaintiff can only prove that B and C have taken part in the same bid, which cannot prove that the defendants illegally obtain customer lists.

The trial held that the plaintiff failed to prove it holds the information of trade secret. The plaintiff also failed to prove that the defendant had infringing act. Therefore, the claims of plaintiff have been denied.

Our team believes that employers shall establish and improve the regulations on trade secret protection and effective media censorship system to avoid unconsciously discloses trade secrets. Concerning customer lists, under the circumstances of failing to set security classification of the contents, enhancing

the customer relationship management is the fundamental way.

Moreover, although there are still some doubts about effects of non-compete agreement in practice, the successful rate of the non-compete disputes is still much higher than general trade secret infringement disputes in judicial cases. Therefore, imposing non-compete obligation on key personnel is still an adoptable strategy.

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人才流动中的商业秘密保护

近年来，伴随人才流动所产生的商业秘密侵权案件越来越多,几乎已经占到人民法院受理的商业秘密案件的“大半江山”，突出表现为：（1）在职人员违反忠诚义务，通过“兼职”的方式侵害现用人单位的商业秘密；及（2）关键岗位的离职人员为竞争对手提供服务或自营与原用人单位竞争的业务。鉴此，本团队特准备本期中国劳动法通讯，与读者诸君探讨在人才流动中所产生的商业秘密保护问题。

一、保密义务的对价与期限问题

保密义务来自于雇员对雇主的忠诚义务，乃是劳动关系中劳动者的主要义务。严格意义上，用人单位无需就劳动者履行保密义务额外支付补偿；但，如果用人单位与劳动者已经约定了保密费的，则仍要履行此项约定，而不得以法律上无此义务进行抗辩。

此外，在实践操作中，笔者亦经常遇到对保密义务约定期限的情形，例如“员工的保密义务将持续至劳动合同解除后二年”。就此，笔者认为，此类约定有欠妥当。如前所述，一方面，保密义务乃劳动关系中劳动者的主要义务，即使劳动关系解除，此项义务仍然存在，故，约定保密期限的行为等于限制了用人单位的相关权利；另一方面，商业秘密在进入公知领域之前系所有人之财产，只要其尚为用人单位之财产，作为相对人的劳动者即无权利进行侵害（泄密）。故，总而言之，就保密义务约定具体期限的行为需进行改进。

二、关于商业秘密侵权之举证

相当数量之当事人认为，商业秘密侵权案件的审理原则为“相似（或相同）+接触-合法来源”，故只要其能够证明，相对方持有与其相似或相同的商业秘密，并且其能够证明相对方有接触其商业秘密的便利，则当然应当由相对方来证明“来源合法”；否则，相对方应当承担侵权责任。

但，上述理解并不符合《最高人民法院关于审理不正当竞争民事案件应用法律若干问题的解释》的相关规定。根据该解释第十四条的相关规定，当事人指称他人侵犯其商业秘密的，应当对其拥有的商业秘密符合法定条件、对方当事人的信息与其商业秘密相同或者实质相同以及对方当事人采取不正当手段的事实负举证责任。其中，商业秘密符合法定条件的证据，包括商业秘密的载体、具体内容、商业价值和对该项商业秘密所采取的具体保密措施等。

故，在要求对方证明合法来源之前，当事人至少应当证明如下事项，否则有要求相对人“自证无罪”的嫌疑：

（1）锁定密点，证明其为相关商业秘密的权利人；及
（2）对方采取了不正当手段。

三、关于客户名单的认定及保护问题

对于所有的企业而言，客户名单可谓是最普遍也是最重要的一种商业秘密。遗憾的是，并不是所有的客户名单都是可以予以保护的商业秘密。《最高人民法院关于审理不正当竞争民事案件应用法律若干问题的解释》第十三条规定，商业秘密中的客户名单，一般是指客户的名称、地址、联系方式以及交易的习惯、意向、内容等构成的区别于相关公知信息的特殊客户信息，包括汇集众多客户的客户名册，以及保持长期稳定交易关系的特定客户。

故，仅仅是客户联系方式的汇编，尚不能构成上述司法解释所保护的“客户名单”，也就是说，在可公开查询的企业名称、联系方式以外所获得的较为隐秘的交易习惯及内容等才是受保护的客户名单的实质性内容。

案例分析

原告 A 设备有限公司系从事农牧机械设备生产销售的专业公司。被告 B、C 等均曾为原告的员工，且均与原告签订了保密协议或保密条款。2012 年 12 月，上述被告在原告处任职期间出资成立了与原告从事竞争业务的公司即被告 D 公司。被告 B、C 利用在原告处工作的职务便利，非法将上述原告的商业秘密披露给被告 D 公司，对原告的经营造成非常重大的影响，故原告起诉至相关人民法院要求被告停止侵权行为并赔偿损失。

经审理查明，原告主张的商业秘密中，大部分在原告公司网站上已经公开披露，有的还在公共网页等渠道公开，均不构成反不正当竞争法规定的商

业秘密。此外，就客户名单，原告仅能证明 B、C 等人曾与原告同时参加相同的竞标会，并不能证明被告违法获取客户名单。

最终，法院经审理认为，原告不能证明其持有相关商业秘密，进一步，其也不能证明被告有侵权行为，故不支持原告的诉讼请求。

本所律师认为，用人单位应当建立及健全商业秘密保护的规章制度，并且建立切实有效的媒体审查制度，以免不自觉的泄漏自身的商业秘密。而就客户名单，在无法对其内容设定密级等保密措施的情况下，加强对客户方的“关系管理”方才是根本。

此外，尽管竞业限制协议在实践操作中的实际效果存疑，但从现有司法实践角度考虑，有关竞业限制纠纷的胜诉几率要远高于普通的商业秘密侵权纠纷，故，对关键核心人员设定竞业限制义务仍不失为一种可取的保密策略。

本资讯速递系大成劳动法团队撰拟，责任编辑：孔琪、罗欣、单训平、徐智强、杨傲霜、张根旺和周军。期待我们的资讯速递能对您有所裨益。若您有任何问题，请通过电邮 laborlaw@dachenglaw.com *联系我们团队。*

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