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6/16/2017 2:12:29 PM
Clerk of Court
Superior Court of CA,
County of Santa Clara
16CV291137
Reviewed By:R. Walker

SUPERIOR COURT OF CALIFORNIA
COUNTY OF SANTA CLARA

AGILENT TECHNOLOGIES, INC., a
Delaware corporation,

Plaintiff,

vs.

TWIST BIOSCIENCE CORP., a Delaware
corporation; EMILY LEPROUST, an
individual; and DOES 1 through 20, inclusive,

Defendants.

Case No.: 16CV291137

**ORDER AFTER HEARING ON
JUNE 16, 2017**

(1) Motion by Defendants Twist Bioscience Corp. and Emily Proust for Protective Order Regarding Agilent's Third Amended Trade Secret Identification; (2) Motion by Plaintiff Agilent Technologies, Inc. to Seal Documents filed in connection with Defendants' Motion for Protective Order Regarding Agilent's Third Amended Trade Secret Identification; (3) Motion by Plaintiff Agilent Technologies, Inc. to Seal Documents filed in connection with Plaintiff's Opposition to Defendants' Motion for Protective Order Regarding Agilent's Third Amended Trade Secret Identification; (4) Motion by Plaintiff Agilent Technologies, Inc. to Seal Documents filed in connection with Defendants' Reply Papers, lodged 6/2/17

This Order was lodged on June 16, 2017 by the Court and issued conditionally under seal to the parties. Pursuant to California Rules of Court, Rule 2.551(b)(3)(B), the Clerk will remove this document from its sealed envelope and place it in the public file unless a motion or application to seal the record is filed within 10 days from the date the Order was lodged under seal.

1 The above-entitled matter came on regularly for hearing on Friday, June 16, 2017 at
2 9:00 a.m. in Department 1 (Complex Civil Litigation), the Honorable Brian C. Walsh
3 presiding. The Court reviewed and considered the written submission of all parties and issued
4 a **confidential** tentative ruling on June 15, 2017. No party contested the tentative ruling; as
5 such, the Court orders the tentative ruling be adopted and incorporated herein as the Order of
6 the Court, as follows:

7
8 This is an action for trade secret misappropriation and related claims. Plaintiff Agilent
9 Technologies, Inc. alleges that its former employee, defendant Emily Leproust, stole its industry-
10 leading genomics technologies to start her own competitive company, defendant Twist
11 Bioscience Corporation. (First Amended Complaint (“FAC”), ¶ 1.)
12

13 Currently at issue is defendants’ second motion for a protective order regarding the
14 adequacy of Agilent’s trade secret disclosures. Agilent opposes the motion. Also at issue are
15 three motions by Agilent to seal materials filed in connection with defendants’ motion, which are
16 unopposed.
17

18 I. Allegations of the Complaint
19

20 Agilent alleges that Leproust misappropriated confidential information and trade secrets
21 related to DNA oligonucleotide (“oligo”) synthesis technologies in violation of her contractual
22 and other legal duties to Agilent. (FAC, ¶ 1.) In February 2012—more than a year before she
23 resigned from her employment with Agilent—she registered internet domain names for Twist,
24 and she proceeded to use Agilent’s resources to develop Twist’s technology and to pitch her
25 competing company to venture capitalists while still employed by Agilent. (*Ibid.*) After leaving
26 Agilent in April 2013, Leproust targeted and poached key employees. (*Ibid.*)
27
28

1 In July 2013, Twist obtained \$4.7 million in Series A funding and in August 2013, it filed
2 provisional patent applications regarding its use of an oligo writer to synthesize oligos using
3 inkjet technology, the same technology employed by Agilent. (FAC, ¶ 42.) The technology
4 presented in Twist's patent applications and business presentations was not and could not have
5 been independently developed during Twist's short existence to date. (*Id.* at ¶¶ 50-51.) Twist
6 has since raised millions more in funding. (*Id.* at ¶ 42.)
7

8 Based on these allegations, the FAC asserts claims for (1) breach of contract (against
9 Leproust), (2) breach of the duty of loyalty (against Leproust), and (3) trade secret
10 misappropriation (against both defendants).
11

12 II. Discovery Dispute

13

14 On September 9, 2016, Agilent served its initial trade secret identification pursuant to
15 Code of Civil Procedure section 2019.210. Defendants challenged the adequacy of the
16 designations, and the parties were unable to come to agreement after engaging in meet and
17 confer efforts including an informal discovery conference with the Court. Defendants moved for
18 a protective order, and on November 21, 2016, the Court (Hon. Kirwan) granted their motion,
19 finding that 24 of Agilent's 35 trade secret designations were inadequate.
20

21 Between December of 2016 and March of 2017, Agilent served a series of amended trade
22 secret identifications. The parties continued to meet and confer over asserted deficiencies in
23 these designations. On March 20, Agilent served the operative Third Amended Identification.
24 Defendants no longer dispute the sufficiency of 33 of the 50 secrets identified in that document,
25 but the parties have reached an impasse regarding the remaining asserted secrets.
26
27
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1 III. Motions to Seal

2
3 Agilent moves to seal the unredacted versions of several documents lodged in connection
4 with (1) defendants' moving papers, (2) Agilent's opposition papers, and (3) defendants' reply
5 papers.

6
7 A. Legal Standard

8
9 Generally, "[t]he court may order that a record be filed under seal only if it expressly
10 finds facts that establish: (1) There exists an overriding interest that overcomes the right of
11 public access to the record; (2) The overriding interest supports sealing the record; (3) A
12 substantial probability exists that the overriding interest will be prejudiced if the record is not
13 sealed; (4) The proposed sealing is narrowly tailored; and (5) No less restrictive means exist to
14 achieve the overriding interest." (Cal. Rules of Court, rule 2.550(d).)

15
16 However, in actions for trade secret misappropriation, the court "shall preserve the
17 secrecy of an alleged trade secret by reasonable means, which may include ... sealing the records
18 of the action" (Civ. Code, § 3426.5.) The usual sealing rules do not apply to records such as
19 these, which "are required to be kept confidential by law." (Cal. Rules of Court, rule
20 2.550(a)(2); see *In re Providian Credit Card Cases* (2002) 96 Cal.App.4th 292, 298-299 ["a
21 mandatory confidentiality requirement ... is imposed ... in actions initiated pursuant to the
22 Uniform Trade Secrets Act for misappropriation of trade secrets".]) While the Court retains the
23 authority to unseal claimed secrets that are not even arguably secret, it must generally preserve
24 the confidentiality of claimed secrets until such time as that information is finally adjudged not
25 to be a trade secret. (See *Cypress Semiconductor Corporation v. Maxim Integrated Products,*
26 *Inc.* (2015) 236 Cal.App.4th 243, 255.)

1 B. Analysis

2
3 Agilent moves to seal portions of the moving, opposition, and reply papers associated
4 with defendants' motion for a protective order on the basis that these documents discuss its
5 confidential trade secret designations. Appropriately redacted public versions of the documents
6 at issue have been filed, and Agilent is entitled to have this information filed under seal. Even if
7 the Court were required to apply the rule 2.550 factors in a trade secret action, those factors are
8 satisfied here.

9
10 These unopposed motions to seal are accordingly GRANTED.

11 IV. Motion for a Protective Order

12
13 In their motion for a protective order, defendants challenge 17 of the 50 asserted trade
14 secrets designated in plaintiff's Third Amended Identification.

15 A. Legal Standard

16
17 “A trade secret is ‘information, including a formula, pattern, compilation, program,
18 device, method, technique, or process, that: (1) Derives independent economic value, actual or
19 potential, from not being generally known to the public or to other persons who can obtain
20 economic value from its disclosure or use; and (2) Is the subject of efforts that are reasonable
21 under the circumstances to maintain its secrecy.’” (*Perlan Therapeutics, Inc. v. Superior Court*
22 (*NexBio, Inc.*) (2009) 178 Cal.App.4th 1333, 1342-1343, quoting Civ. Code, § 3426.1, subd.
23 (d)(1) and (2).) In an action alleging trade secret misappropriation, the plaintiff must identify the
24 trade secret with reasonable particularity before commencing discovery related thereto. (Code
25 Civ. Proc., § 2019.210.) The pre-discovery designation serves four purposes: (1) it promotes
26 well-investigated claims and dissuades the filing of meritless trade secret complaints, (2) it
27 prevents plaintiffs from using the discovery process as a means to obtain defendants' trade
28 secrets, (3) it assists the court in framing the appropriate scope of discovery and determining
whether discovery requests fall within that scope, and (4) it enables defendants to form complete

1 and well-reasoned defenses, ensuring that they need not wait until the eve of trial to effectively
2 defend the action. (*Perlan Therapeutics, Inc. v. Superior Court, supra*, 178 Cal.App.4th at p.
3 1343.)

4
5 A trade secret must be identified with sufficient particularity to distinguish it from
6 matters of general knowledge in the trade or special knowledge of those persons who are skilled
7 in the trade. (*Advanced Modular Sputtering, Inc. v. Superior Court (Mishin, et al.)* (2005) 132
8 Cal.App.4th 826, 835.) Reasonable particularity does not require the party alleging
9 misappropriation to define every minute detail of its claimed trade secret. (*Ibid.*) Rather, it
10 requires some showing that is “reasonable, i.e., fair, proper, just and rational under all of the
11 circumstances” to advance the underlying purposes of the designation, identified above. (*Id.* at
12 pp. 835-836.) Section 2019.210 requires only the *identification* of trade secrets. (*Brescia v.*
13 *Angelin* (2009) 172 Cal.App.4th 133, 149.) It does not compel the provision of argument or
14 evidence demonstrating that the identified trade secrets actually qualify as such, and it “does not
15 create a procedural device to litigate the ultimate merits of the case.” (*Ibid.*)

16 “[W]here ‘the alleged trade secrets consist of incremental variations on, or advances in
17 the state of the art in a highly specialized technical field, a more exacting level of particularity
18 may be required to distinguish the alleged trade secrets from matters already known to persons
19 skilled in that field.’ ” (*Perlan Therapeutics, Inc. v. Superior Court, supra*, 178 Cal.App.4th at p.
20 1343, quoting *Advanced Modular Sputtering, Inc. v. Superior Court, supra*, 132 Cal.App.4th at
21 p. 836; see also *I-Flow Corp. v. Apex Medical Technologies, Inc.* (S.D. Cal., May 23, 2008, No.
22 07CV1200-DMS(NLS)) 2008 WL 2233962, at *1 [court had ordered trade secret plaintiff “to
23 amend its statement such that technical and marketing trade secrets would be distinguished
24 clearly from general knowledge in the field of infusion technology”].) Where “ ‘credible experts
25 declare that they are capable of understanding the designation and of distinguishing the alleged
26 trade secrets from information already known to persons in the field, the designation should, as a
27 general rule, be considered adequate to permit discovery to commence.’ ” (*Perlan Therapeutics,*
28 *Inc. v. Superior Court, supra*, 178 Cal.App.4th at p. 1343.)

1 B. Analysis

2
3 Defendants challenge a group of twelve asserted secrets (nos. 7, 10, 12, 14, 16, 18, 20,
4 22, 24, 27, 30, and 36) relating to **REDACTED** as well as three additional
5 categories (nos. 31-33) that it claims are inadequately disclosed and indistinguishable from
6 information already known in the field, and two categories (nos. 17 and 19) that it contends rely
7 on impermissibly open-ended definitions. As the Court held in its prior order, it is clear that
8 Agilent's asserted secrets are of a technical nature for which a more exacting level of
9 particularity in the designation is required. (*Perlan Therapeutics, Inc. v. Superior Court, supra*,
10 178 Cal.App.4th at p. 1343.) Both defendants and Agilent submit declarations by qualified
11 experts supporting their positions.

12 1. *Asserted Secrets Related to* **REDACTED** (*Nos. 7, 10, 12, 14,*
13 *16, 18, 20, 22, 24, 27, 30, and 36)*

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15 **REDACTED**
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17 **REDACTED**
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1 REDACTED

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3 REDACTED

4
5 *Perlan Therapeutics, Inc. v. Superior Court, supra*, 178 Cal.App.4th 1333 provides
6 ample support for this approach. It held that the trial court did not abuse its discretion by issuing
7 a protective order where the plaintiff “did not segregate its alleged trade secrets (by, for example,
8 listing them numerically in the statement)” and “referenced hundreds of pages of extra
9 documents.” (At p. 1352.) It cited with approval a federal trial court’s approach in ordering that
10 “[a]ll trade secrets shall be described in narrative form, rather than by cross-reference to other
11 trade secrets or documents. If Plaintiff references a document as setting forth one or more trade
12 secrets, it shall specify precisely which portions of the document describes [*sic*] the trade
13 secret(s).” (*Id.* at fn. 14.) The Court finds that this approach is appropriate here, REDACTED

14
15 2. *Asserted Secret Nos. 31-33*

16
17 Defendants also contend that the methods described in asserted secret nos. 31-33 are not
18 adequately disclosed or distinguished from matters already known in the field.

19 REDACTED

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12 3. *Asserted Secret Nos. 17 and 19*

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17 [REDACTED]
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21 [REDACTED]
22 [REDACTED]

23
24 Tellingly, defendants' expert indicates that he was not "asked to opine on the overall
25 disclosures of Categories 17 and 19 and whether they are disclosed with reasonable
26 particularity," but was asked only "to evaluate the definitions provided by Agilent" for the
27 phrases challenged by defendants. (Mrksich Decl., ¶ 328.) Since the terms defendants criticize
28 are not definitional but are used in connection with Agilent's narrative description of how its
claimed secrets differ from matters known in the field, the expert's criticism of these terms in

1 isolation does not establish that there is an issue with the definitional portion of the designations.
2 The Court finds these designations to be straightforward and adequate.

3
4 *4. Appropriate Relief*

5 Between their moving and reply papers, defendants argue that the Court should preclude
6 Agilent from serving a further amended trade secret designation, or should “strike” the
7 inadequate designations from Agilent’s identification “with prejudice,” or should rewrite
8 Agilent’s designations as proposed in a redline prepared by defendants. Defendants cite no
9 authority supporting these requests.

10
11 By the same token, plaintiff’s authorities, discussed in footnote 5 to its opposition brief,
12 do not support an order permitting discovery to proceed on some trade secrets but not others.
13 *Advanced Modular Sputtering, Inc. v. Superior Court, supra*, 132 Cal.App.4th 826 clearly does
14 not permit the Court to bifurcate discovery on related trade secrets in this manner. (At p. 834
15 [holding that it is generally improper to allow even non-trade secret claims to proceed when
16 raised in the same action as trade secret claims governed by an inadequate designation].)

17 The appropriate course of action here is to continue the discovery stay as to all of
18 Agilent’s claims. If Agilent chooses to withdraw its inadequate trade secret designations, the
19 stay will be lifted; however, given that this is the Court’s second ruling on a challenge to
20 Agilent’s designations and a great deal of progress has been made since its first ruling, the Court
21 will permit a further amendment to those designations that remain inadequate.

22
23 *5. Conclusion and Order*

24 Defendants’ motion for a protective order is GRANTED in light of the deficiencies in the
25 designations of asserted secret nos. 7, 10, 12, 14, 16, 18, 20, 22, 24, 27, 30-32, and 36.
26 Discovery on all of Agilent’s claims remains stayed. Agilent shall serve any amended trade
27 secret disclosure addressing the deficiencies in the inadequate designations within 20 calendar
28 days of the filing of this order. Alternatively, Agilent may serve an amended disclosure omitting

1 these inadequate designations and the discovery stay will be lifted without the need for further
2 action by the Court.

3
4 SO ORDERED.

5
6 Dated:

JUNE 16, 2017



Honorable Brian C. Walsh
Judge of the Superior Court

EXHIBIT 2

Calendar Line 2

Case Name: *Agilent Technologies, Inc. v. Twist Bioscience Corp., et al.*

Case No.: 16-CV-291137

This is an action for trade secret misappropriation and related claims. Plaintiff Agilent Technologies, Inc. alleges that its former employee, defendant Emily Leproust, stole its industry-leading genomics technologies to start her own competitive company, defendant Twist Bioscience Corporation. (First Amended Complaint (“FAC”), ¶ 1.)

Currently at issue is defendants’ second motion for a protective order regarding the adequacy of Agilent’s trade secret disclosures. Agilent opposes the motion. Also at issue are three motions by Agilent to seal materials filed in connection with defendants’ motion, which are unopposed.

I. Allegations of the Complaint

Agilent alleges that Leproust misappropriated confidential information and trade secrets related to DNA oligonucleotide (“oligo”) synthesis technologies in violation of her contractual and other legal duties to Agilent. (FAC, ¶ 1.) In February 2012—more than a year before she resigned from her employment with Agilent—she registered internet domain names for Twist, and she proceeded to use Agilent’s resources to develop Twist’s technology and to pitch her competing company to venture capitalists while still employed by Agilent. (*Ibid.*) After leaving Agilent in April 2013, Leproust targeted and poached key employees. (*Ibid.*)

In July 2013, Twist obtained \$4.7 million in Series A funding and in August 2013, it filed provisional patent applications regarding its use of an oligo writer to synthesize oligos using inkjet technology, the same technology employed by Agilent. (FAC, ¶ 42.) The technology presented in Twist’s patent applications and business presentations was not and could not have been independently developed during Twist’s short existence to date. (*Id.* at ¶¶ 50-51.) Twist has since raised millions more in funding. (*Id.* at ¶ 42.)

Based on these allegations, the FAC asserts claims for (1) breach of contract (against Leproust), (2) breach of the duty of loyalty (against Leproust), and (3) trade secret misappropriation (against both defendants).

II. Discovery Dispute

On September 9, 2016, Agilent served its initial trade secret identification pursuant to Code of Civil Procedure section 2019.210. Defendants challenged the adequacy of the designations, and the parties were unable to come to agreement after engaging in meet and confer efforts including an informal discovery conference with the Court. Defendants moved for a protective order, and on November 21, 2016, the Court

(Hon. Kirwan) granted their motion, finding that 24 of Agilent's 35 trade secret designations were inadequate.

Between December of 2016 and March of 2017, Agilent served a series of amended trade secret identifications. The parties continued to meet and confer over asserted deficiencies in these designations. On March 20, Agilent served the operative Third Amended Identification. Defendants no longer dispute the sufficiency of 33 of the 50 secrets identified in that document, but the parties have reached an impasse regarding the remaining asserted secrets.

III. Motions to Seal

Agilent moves to seal the unredacted versions of several documents lodged in connection with (1) defendants' moving papers, (2) Agilent's opposition papers, and (3) defendants' reply papers.

A. Legal Standard

Generally, "[t]he court may order that a record be filed under seal only if it expressly finds facts that establish: (1) There exists an overriding interest that overcomes the right of public access to the record; (2) The overriding interest supports sealing the record; (3) A substantial probability exists that the overriding interest will be prejudiced if the record is not sealed; (4) The proposed sealing is narrowly tailored; and (5) No less restrictive means exist to achieve the overriding interest." (Cal. Rules of Court, rule 2.550(d).)

However, in actions for trade secret misappropriation, the court "shall preserve the secrecy of an alleged trade secret by reasonable means, which may include ... sealing the records of the action ..." (Civ. Code, § 3426.5.) The usual sealing rules do not apply to records such as these, which "are required to be kept confidential by law." (Cal. Rules of Court, rule 2.550(a)(2); see *In re Providian Credit Card Cases* (2002) 96 Cal.App.4th 292, 298-299 ["a mandatory confidentiality requirement ... is imposed ... in actions initiated pursuant to the Uniform Trade Secrets Act for misappropriation of trade secrets"].) While the Court retains the authority to unseal claimed secrets that are not even arguably secret, it must generally preserve the confidentiality of claimed secrets until such time as that information is finally adjudged not to be a trade secret. (See *Cypress Semiconductor Corporation v. Maxim Integrated Products, Inc.* (2015) 236 Cal.App.4th 243, 255.)

B. Analysis

Agilent moves to seal portions of the moving, opposition, and reply papers associated with defendants' motion for a protective order on the basis that these documents discuss its confidential trade secret designations. Appropriately redacted public versions of the documents at issue have been filed, and Agilent is entitled to have

this information filed under seal. Even if the Court were required to apply the rule 2.550 factors in a trade secret action, those factors are satisfied here.

These unopposed motions to seal are accordingly GRANTED.

IV. Motion for a Protective Order

In their motion for a protective order, defendants challenge 17 of the 50 asserted trade secrets designated in plaintiff's Third Amended Identification.

A. Legal Standard

"A trade secret is 'information, including a formula, pattern, compilation, program, device, method, technique, or process, that: (1) Derives independent economic value, actual or potential, from not being generally known to the public or to other persons who can obtain economic value from its disclosure or use; and (2) Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.'" (*Perlan Therapeutics, Inc. v. Superior Court (NexBio, Inc.)* (2009) 178 Cal.App.4th 1333, 1342-1343, quoting Civ. Code, § 3426.1, subd. (d)(1) and (2).) In an action alleging trade secret misappropriation, the plaintiff must identify the trade secret with reasonable particularity before commencing discovery related thereto. (Code Civ. Proc., § 2019.210.) The pre-discovery designation serves four purposes: (1) it promotes well-investigated claims and dissuades the filing of meritless trade secret complaints, (2) it prevents plaintiffs from using the discovery process as a means to obtain defendants' trade secrets, (3) it assists the court in framing the appropriate scope of discovery and determining whether discovery requests fall within that scope, and (4) it enables defendants to form complete and well-reasoned defenses, ensuring that they need not wait until the eve of trial to effectively defend the action. (*Perlan Therapeutics, Inc. v. Superior Court, supra*, 178 Cal.App.4th at p. 1343.)

A trade secret must be identified with sufficient particularity to distinguish it from matters of general knowledge in the trade or special knowledge of those persons who are skilled in the trade. (*Advanced Modular Sputtering, Inc. v. Superior Court (Mishin, et al.)* (2005) 132 Cal.App.4th 826, 835.) Reasonable particularity does not require the party alleging misappropriation to define every minute detail of its claimed trade secret. (*Ibid.*) Rather, it requires some showing that is "reasonable, i.e., fair, proper, just and rational under all of the circumstances" to advance the underlying purposes of the designation, identified above. (*Id.* at pp. 835-836.) Section 2019.210 requires only the *identification* of trade secrets. (*Brescia v. Angelin* (2009) 172 Cal.App.4th 133, 149.) It does not compel the provision of argument or evidence demonstrating that the identified trade secrets actually qualify as such, and it "does not create a procedural device to litigate the ultimate merits of the case." (*Ibid.*)

"[W]here 'the alleged trade secrets consist of incremental variations on, or advances in the state of the art in a highly specialized technical field, a more exacting level of particularity may be required to distinguish the alleged trade secrets from matters already known to persons skilled in that field.'" (*Perlan Therapeutics, Inc. v. Superior*

Court, supra, 178 Cal.App.4th at p. 1343, quoting *Advanced Modular Sputtering, Inc. v. Superior Court, supra*, 132 Cal.App.4th at p. 836; see also *I-Flow Corp. v. Apex Medical Technologies, Inc.* (S.D. Cal., May 23, 2008, No. 07CV1200-DMS(NLS)) 2008 WL 2233962, at *1 [court had ordered trade secret plaintiff “to amend its statement such that technical and marketing trade secrets would be distinguished clearly from general knowledge in the field of infusion technology”].) Where “ ‘credible experts declare that they are capable of understanding the designation and of distinguishing the alleged trade secrets from information already known to persons in the field, the designation should, as a general rule, be considered adequate to permit discovery to commence.’ ” (*Perlan Therapeutics, Inc. v. Superior Court, supra*, 178 Cal.App.4th at p. 1343.)

B. Analysis

Defendants challenge a group of twelve asserted secrets (nos. 7, 10, 12, 14, 16, 18, 20, 22, 24, 27, 30, and 36) relating to [REDACTED] as well as three additional categories (nos. 31-33) that it claims are inadequately disclosed and indistinguishable from information already known in the field, and two categories (nos. 17 and 19) that it contends rely on impermissibly open-ended definitions. As the Court held in its prior order, it is clear that Agilent’s asserted secrets are of a technical nature for which a more exacting level of particularity in the designation is required. (*Perlan Therapeutics, Inc. v. Superior Court, supra*, 178 Cal.App.4th at p. 1343.) Both defendants and Agilent submit declarations by qualified experts supporting their positions.

1. *Asserted Secrets Related to* [REDACTED] (*Nos. 7, 10, 12, 14, 16, 18, 20, 22, 24, 27, 30, and 36*)

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

REDACTED

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

REDACTED

Perlan Therapeutics, Inc. v. Superior Court, supra, 178 Cal.App.4th 1333 provides ample support for this approach. It held that the trial court did not abuse its discretion by issuing a protective order where the plaintiff “did not segregate its alleged trade secrets (by, for example, listing them numerically in the statement)” and “referenced hundreds of pages of extra documents.” (At p. 1352.) It cited with approval a federal trial court’s approach in ordering that “[a]ll trade secrets shall be described in narrative form, rather than by cross-reference to other trade secrets or documents. If Plaintiff references a document as setting forth one or more trade secrets, it shall specify precisely which portions of the document describes [*sic*] the trade secret(s).” (*Id.* at fn. 14.) The Court finds that this approach is appropriate here. REDACTED

2. *Asserted Secret Nos. 31-33*

Defendants also contend that the methods described in asserted secret nos. 31-33 are not adequately disclosed or distinguished from matters already known in the field.

REDACTED

REDACTED

REDACTED

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

REDACTED

REDACTED

REDACTED

3. *Asserted Secret Nos. 17 and 19*

REDACTED

REDACTED

Tellingly, defendants' expert indicates that he was not "asked to opine on the overall disclosures of Categories 17 and 19 and whether they are disclosed with reasonable particularity," but was asked only "to evaluate the definitions provided by Agilent" for the phrases challenged by defendants. (Mrksich Decl., ¶ 328.) Since the terms defendants criticize are not definitional but are used in connection with Agilent's

narrative description of how its claimed secrets differ from matters known in the field, the expert's criticism of these terms in isolation does not establish that there is an issue with the definitional portion of the designations. The Court finds these designations to be straightforward and adequate.

4. Appropriate Relief

Between their moving and reply papers, defendants argue that the Court should preclude Agilent from serving a further amended trade secret designation, or should "strike" the inadequate designations from Agilent's identification "with prejudice," or should rewrite Agilent's designations as proposed in a redline prepared by defendants. Defendants cite no authority supporting these requests.

By the same token, plaintiff's authorities, discussed in footnote 5 to its opposition brief, do not support an order permitting discovery to proceed on some trade secrets but not others. *Advanced Modular Sputtering, Inc. v. Superior Court*, supra, 132 Cal.App.4th 826 clearly does not permit the Court to bifurcate discovery on related trade secrets in this manner. (At p. 834 [holding that it is generally improper to allow even non-trade secret claims to proceed when raised in the same action as trade secret claims governed by an inadequate designation].)

The appropriate course of action here is to continue the discovery stay as to all of Agilent's claims. If Agilent chooses to withdraw its inadequate trade secret designations, the stay will be lifted; however, given that this is the Court's second ruling on a challenge to Agilent's designations and a great deal of progress has been made since its first ruling, the Court will permit a further amendment to those designations that remain inadequate.

5. Conclusion and Order

Defendants' motion for a protective order is GRANTED in light of the deficiencies in the designations of asserted secret nos. 7, 10, 12, 14, 16, 18, 20, 22, 24, 27, 30-32, and 36. Discovery on all of Agilent's claims remains stayed. Agilent shall serve any amended trade secret disclosure addressing the deficiencies in the inadequate designations within 20 calendar days of the filing of this order. Alternatively, Agilent may serve an amended disclosure omitting these inadequate designations and the discovery stay will be lifted without the need for further action by the Court.

The Court will prepare the order.