



## → Rebecca Edelson

### Partner

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Rebecca (“Bec”) Edelson is a partner in the firm’s Intellectual Property and Litigation Practice Groups and leads its Trade Secrets Team.

### Areas of Practice

Bec is a seasoned business litigator and represents businesses in intellectual property, unfair competition, injunction and other litigation matters. She handles all phases of state and federal litigation, including pre-trial development, discovery and motion practice, trials, writs and appeals. She also counsels businesses on how to proactively protect their proprietary rights and to minimize the risk of litigation.

Bec has unmistakable expertise in the trade secrets arena. She “wrote the book” on trade secrets – she is co-editor and co-author of the treatise, *Trade Secret Litigation and Protection in California*, published by the State Bar of California, as well as its 2017 supplement on the Defend Trade Secrets Act (DTSA). She also contributed to an English language handbook on trade secret litigation in the United States created for the Ministry of Commerce of the People’s Republic of China. Bec also chaired the State Bar of California’s Executive Committee for its Intellectual Property Section as well as its Trade Secret Subsection.

Bec represents clients in a variety of industries, including the healthcare, publication, entertainment, media, aerospace, energy, retail, fashion, financial, medical technology, biotech, computer, panel-maker, database, toy, jewelry, heavy/industrial equipment, lighting technology, insurance, food and travel and leisure industries, among others.

### Approach to Meeting Client Goals

Bec strives to meet her clients’ goals as efficiently and quickly as possible and understands a “win” is frequently achievable without the need for prolonged litigation (although she also is prepared to try a case should it be necessary). Her clients value her ability to see the big picture, hone in on the strategic options, and then focus on the best path to achieve the desired outcome. Bec prides herself in providing creative solutions that meet her clients’ business and budgetary goals.

Examples of Bec achieving favorable resolutions for clients include:

- Bec obtained consent judgment for aerospace company in trade secret misappropriation, copyright infringement and trademark infringement case shortly after deposing the defendant. Bec understands that if a deposition is handled strategically and with finesse, it can bring a client’s litigation adversary to its knees (figuratively speaking) and set the stage for a resolution without the need for the client to incur the expense

of going the full distance to trial.

- Bec also is adept at counseling clients so that they can resolve potential disputes without litigation. For example, after she offered a client a strategic action plan in response to its discovery that an employee misappropriated a former employer's purported confidential materials in connection with developing a new product for the client, no litigation was filed even after the former employer learned of the incident. Bec recognizes effective crisis management can be critical to a client's business and, therefore, assists clients to contain potential crises so that they do not turn into actual crises.
- Bec also is skilled at assisting clients to conduct themselves to avoid disputes before they occur. For example, she advised a client on "best practices" to address a concern that a misappropriation claim may be asserted by a former joint development partner (e.g., implement "clean room" and "reverse engineering" protocols). Taking proactive measures by a client can often avert what would otherwise be an expensive dispute.

## Honors

Recipient, Century City Chamber of Commerce's Women of Achievement Award - Law, 2004

## Experience

### Representative Matters

#### Litigation

- Defended claims by investor that healthcare diagnostic technology clients defaulted on promissory note and was entitled to a writ of attachment. Shortly after we asserted cross-claims (trade secret misappropriation, breach of fiduciary duty, breach of a royalty agreement) against the investor and some of the clients' former officers, the matter settled.
- Defended food distributor against claims for trade name infringement and receipt of unlawful secret rebates. Obtained early dismissal of claims at the pleading stage.
- Represented entertainment business in arbitration proceedings between its employee and their former employer which claimed the employee misappropriated its trade secret information for client's business. The matter settled favorably for our client and its employee.
- Obtained consent judgment for aerospace company in trade secret misappropriation, copyright infringement and trademark infringement case shortly after deposing the defendant.
- Defeated motion for preliminary injunction in dispute between foreign manufacturer of food products (client) and its former U.S. distributor. Later obtained summary judgment in client's favor on distributor's claims and client's counter-claims, and against distributor's owner on the ground that the distributor was the owner's alter ego.
- Obtained judgment for over \$160 million against an international reinsurance company and its principles following trial.
- Favorably settled copyright infringement dispute after persuading the Court to deny plaintiff's request to forego Hague Convention service on client, a foreign content producer of entertainment programming.
- Obtained favorable settlement and dismissals for well-known international clothing retailer in lawsuits alleging patent, trademark and copyright infringement.

- Obtained permanent injunction and favorable monetary settlement for beauty products distributor in trademark infringement litigation and related Trademark Trial and Appeal Board proceedings.
- Favorably settled during trial trade secret dispute brought by medical device manufacturer client against former distributor.
- Obtained favorable jury verdict for manufacturer and designer of fashion accessories in trade dress and copyright dispute. Defeated the infringer's equitable defenses on bench trial.
- Obtained temporary restraining order, permanent injunction and monetary award against infringers of client's copyrights and trademarks of client.
- Obtained insurance coverage for food manufacturer client from loss arising from contaminated packets of ketchup by persuading arbitrator loss fell within "explosion" exception to coverage exclusions because ketchup packets had burst due to contamination.

## Counseling

- Advised client on whether to pursue trade secret or patent protection for its technology invention.
- Offered client potential measures to do "damage control" and improve its measures to protect its trade secrets after a third party that was given access to the client's trade secret information about energy technology disclosed it in violation of the NDA it executed.
- Counseled client about its interests in a criminal prosecution of an individual who engaged in misappropriation of the client's trade secret designs.
- Guided client through the breakdown of a complex joint development relationship and advised client whether to assert potential claims against the joint developer.
- Analyzed for a client whether a government contractor can assert against others trade secrets rights in unlimited rights data that government contractor provided to the government.
- Advocated on behalf of clients to persuade government agencies not to release trade secret information to members of the public who requested access.
- Advised various clients of potential measures they could implement to reduce the risk of misappropriation of trade secret information.
- Offered strategy recommendations to client to reduce likelihood that the other member of its failed joint venture would assert misappropriation claims against it.
- Advised client how to decrease the risk of misappropriation claims by a competitor in connection with the client's acquisition of a business that sold the competitor's products.
- Proposed modifications to a client's standard NDA to better protect the client's trade secrets and to limit unwarranted misappropriation claims against the client.
- Overhauled client's employee materials (form employee agreement, employee handbook) to improve the client's ability to enforce its trade secret rights.
- Guided client in its response to a competitor's claim that the client misappropriated the competitor's confidential information to obtain a customer's business.
- Advised on "best practices" to address concern that a misappropriation claim may be asserted (e.g., implement "clean room" and "reverse engineering" protocols).
- Counseled client on appropriate remediation and other potential responses to the discovery of a potential misappropriation incident (e.g., an employee brought over a former employer's purported confidential

materials).

- Advised client on potential claims under a patent sales agreement which provided for on-going royalty payments.
- Advised client how to respond to unwarranted royalty demands under IP license agreements.

## Appeals

- Convinced Court of Appeal to issue writ ordering the trial court to show why its order permitting service of process on client without Hague Convention compliance should not be vacated. Thereafter, the underlying dispute, which concerned perpetual license of certain television programs, settled.
- Obtained from Court of Appeal reversal of summary judgment order declaring generic trademark of client, a distributor of products in the fashion/beauty industry. Settled case favorably for client thereafter.
- Convinced Court of Appeal to affirm judgment awarding real estate investor client over half million dollars in interest based on adversary's wrongful refusal to return multi-million dollar escrow deposit after adversary terminated transaction.
- After receiving client's opening brief on petition of review of denial of asylum, government agreed to reopen asylum proceedings.
- Submitted amicus curiae briefs on behalf of public interest organizations in proceedings in California Supreme Court and U.S. Supreme Court arising from California Proposition 8 (defining marriage as between a man and a woman).

## Articles

- The Status of a Cannabusiness' Ability to Seek Relief in the Courts – the 'Illegality' Issue  
*Cannabis Business Executive*, 06.10.2020
- To Disclose Or Not to Disclose: Responding to Trade Secrets Misappropriation By an Employee  
*IP Watchdog*, 06.01.2020
- Who's Watching? Hidden Dangers to Trade Secrets From Video Conferencing  
*The Recorder*, 05.21.2020
- Does COVID-19 threaten your trade secrets? (Yes, it does) (Part 2)  
*Daily Journal*, 04.29.2020
- Does COVID-19 threaten your trade secrets? (Yes, it does) (Part 1)  
*Daily Journal*, 04.28.2020
- Intellectual Property in the Cannabis Industry – Protecting Innovations and Products, Parts I and II  
*Cannabis Business Executive*, 12.2019
- Ruling Makes it Easier to Block a Competitor's FOIA Access to Confidential Information  
*Daily Journal*, 07.05.2019
- Do Not Give NDAs the Short Shrift  
*The Licensing Journal*, 05.2019
- Access to a competitor's confidential information?  
*Daily Journal*, 04.17.2019

- NDA Tips, Traps and Pitfalls: Best Practices Avoid Common Errors  
*The Recorder*, 04.11.2018
- Federal DTSA Versus California UTSA  
Potential Pros and Cons  
*California Business Law Practitioner*, Vol.32, No. 2, Spring 2017
- People Will Talk: Protecting Trade Secrets in the World of Social Media, *Corporate Counsel*, November 18, 2010

## Trade Secrets Law Blog Posts

- Members Of The Fashion and Retail Industry: Trade Secret Claims Are In Vogue These Days, July 13, 2020
- Admonition To Members Of The Healthcare Industry: Don't Give Trade Secret Protection The Short Shrift! July 8, 2020

## Government Contracts, Investigations & International Trade Blog Posts

- OH SNAP! Supreme Court Rejects Substantial Competitive Harm Test For Key FOIA Exemption, June 26, 2019
- OH SNAP! Supreme Court to Take on Meaning of Key FOIA Exemption, April 2, 2019

## Intellectual Property Law Blog Posts

- A Cautionary Trade Secrets Tale: Failure To Preserve Potentially Relevant Evidence, May 6, 2020
- 6 Steps to Protect Your Trade Secrets During Covid-19 Layoffs, April 30, 2020
- COVID-19 and Trade Secrets: Is Your Business Prepared to Protect its Trade Secrets While Your Employees Work From Home? March 24, 2020
- 3 Steps in Furtherance of Avoiding Devastating Spoliation Sanctions in Trade Secret Misappropriation Litigation, December 5, 2019
- "Don't Spill Your Trade Secrets: Protecting Your Competitive Advantage in the Food and Beverage Industry (Parts 1 and 2)," July 17 & 22, 2019
- A Cautionary Tale: Don't Wait Until There Is A Problem To Protect Your Trade Secrets, May 2, 2019
- Do NOT Give NDAs the Short Shrift, April 5, 2019
- UPDATE: The Federal Defend Trade Secrets Act vs. The California Uniform Trade Secrets Act, March 26, 2018
- The Federal Defend Trade Secrets Act vs. The California Uniform Trade Secrets Act, July 21, 2016

## Books

The Defend Trade Secrets Act Supplement to Trade Secret Litigation and Protection in California  
2017

Trade Secret Litigation and Protection in California  
2014

## Media Mentions

Remote workers and trade secrets: More care needed than ever  
*The Legal Examiner*, 08.10.2020

Sheppard Mullin's Gross Revenue Growth Continues  
*The Recorder*, 03.01.2017

Sheppard Mullin Nabs IP Pro Duo From Steptoe & Johnson  
*Law360*, 06.02.2016

## Speaking Engagements

Minimizing Risks Of Trade Secret Misappropriation Claims: An Intent Not To Misappropriate Is Not Always Enough, Practicing Law Institute's "Advanced Trade Secrets 2020: New Risks, New Challenges & Emerging Solutions" conference, October 28, 2020

Trade Secrets in Cannabis, California Lawyers Association, October 21, 2020

Can You Keep A (Trade) Secret, Episode 9 of Stroke of Genius Season 3, podcast of the Intellectual Property Owners Education Foundation, September 25, 2020

The Evolution of Entertainment: Timeless Content, New Media, 9th Annual Jewish Executive Leadership Conference, February 23, 2020

Hot Topics in Trade Secret Litigation: the DTSA, Remedies, Anti-SLAPP, and Constitutional Issues, 43rd Annual IP Institute, California Lawyers Association, November 8, 2018

Hot Topics in Trade Secret Law, State Bar of California, July 14, 2015

Trade Secrets of Trade Secrets, 38th Annual IP Institute of the State Bar of California, November 7, 2013

Litigating the Trade Secret Case, Bridgeport Continuing Education, May 17, 2013

Obtaining Injunctive Relief in Trade Secret Cases, 37th Annual IP Institute of the State Bar of California, November 8, 2012

Why Every Lawyer Should Know More About Trade Secret Law, 36th Annual IP Institute of the State Bar of California, November 12, 2011

## Events

Cannabis Webinar Wednesday - Intellectual Property in the Cannabis Space  
Webinar, 09.23.2020

ACC Southern California In House Counsel Conference  
Choosing Between Patent And Trade Secret Protection: When, Why And How?  
Universal Hilton, 01.23.2020

ACC-SFBA Patent Law Committee Meeting  
Choosing Between Patent and Trade Secret Protection: When, Why and How  
Palo Alto, 12.11.2019

ACC-SFBA Patent Law Committee Meeting Sponsored  
Choosing Between Patent and Trade Secret Protection: When, Why and How  
Sheppard Mullin San Francisco, 12.10.2019

## Memberships

Member, Sedona Conference Trade Secrets Working Group, 2020

Member, Board of Directors, Century City Chamber of Commerce, 2015-2016

Shriver Project's Advisory Board, 2014

Member, Federation of Defense and Corporate Counsel, 2005-2009 (served as Vice Chair of Intellectual Property Section and Member of Diversity Committee)

Chair, Executive Committee, Intellectual Property Section of the State Bar of California, 2004-2005

Member, Steering Committee of the Century City Chamber of Commerce Women's Business Council, 2003

## Podcasts & Webinars

Cannabis Webinar Wednesday - Intellectual Property in the Cannabis Space  
09.23.2020

## Practices

Intellectual Property

Copyrights

False Advertising, Lanham Act and Unfair Competition

IP Licensing, Technology and Commercial Transactions

Trade Secrets

Trademarks and Trade Dress

Litigation

International Reach

Korea

China

## Industries

Aerospace, Defense & Government Services

Automotive

Aviation

Cannabis

Entertainment and Digital Media

Fashion, Apparel and Beauty

Food and Beverage

Healthcare

Life Sciences and FDA

Retail

Transportation

## Education

J.D., University of California - Los Angeles, 1990

B.A., University of Pennsylvania, 1983

## Admissions

California

U.S. Supreme Court

U.S. District Court, Central District of California

U.S. District Court, Eastern District of California

U.S. District Court, Northern District of California

U.S. District Court, Southern District of California

U.S. Court for the Ninth Circuit

U.S. District Court, Western District of Wisconsin