

SURVEY OF INDIANA TRADE SECRET LAW: UTSA SURVIVES AN ELEVENTH-YEAR SCARE

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INTRODUCTION

Through its first decade, the Indiana version of the Uniform Trade Secrets Act (“UTSA”)¹ received little attention from Indiana courts. During the survey period,² two opinions by the state’s appellate courts took the Indiana UTSA, and the business and legal communities, on a roller coaster ride from relative obscurity to national attention in defining what is a trade secret subject to protection.³

In *Amoco Production Co. v. Laird*,⁴ the Indiana Supreme Court and Court of Appeals wrote to a cornerstone issue in determining trade secret status regardless of the type of information involved.⁵ The impact of these decisions seems clear. Trade secret owners can take heart that the value of their time, effort, and money spent developing such “information” will more likely survive attack. Those who would misappropriate can no longer hide behind a simple hindsight test of what “could have” been. The public can rest knowing that further erosion of commercial ethics has been slowed and the development of new products and technology encouraged by protecting their value consistent

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1. The Indiana UTSA, substantially derived from the Uniform Trade Secrets Act, was added by Acts 1982, P.L. 148, § 1, “to effectuate its general purpose to make uniform the law with respect to the subject matter of this chapter among states” and to expressly displace “all conflicting law of this state pertaining to the misappropriation of trade secrets, except contract law and criminal law.” IND. CODE §§ 24-2-3-1(b) and (c). Refer to the beginning of this Chapter for a list of other jurisdictions wherein the UTSA has been adopted. For actual text of the Uniform Act, and for variation notes and annotation materials for adopting jurisdictions, see *Uniform Laws Annotated*, Master Edition, Vol. 14.

2. Approximately Jan. 1, 1993 to Oct. 31, 1993.

3. *Amoco Prod. Co. v. Laird*, 622 N.E.2d 912 (Ind. 1993), *rev’g*, 604 N.E.2d 1249 (Ind. Ct. App. 1992).

4. *Id.*

5. The section of the Indiana UTSA reviewed is IND. CODE § 24-2-3-2, defining “trade secret” as:

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, and not being readily ascertainable by proper means by, 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.

As added by Acts 1982, P.L. 148, § 1. Amended by P.L.8-1993, § 343.

with policies long underpinning trade secrets law. And finally, those who favor common sense statutory construction, where words mean what they say and nothing more, can savor this momentary victory and wonder, "What was the commotion all about?"

However viewed, the drama was certainly present as Indiana's highest courts squared off on this central issue in trade secrets law under the UTSA.

I. THE FIRST TEN YEARS

Only six Indiana cases focused on trade secret law under the Indiana UTSA from its enactment in 1982 into 1992.⁶ Historically, all six cases derive from the Indiana Court of Appeals, with four districts contributing. All dealt exclusively with customer lists and related data as the alleged "trade secret" information.⁷ Notable among this group is *Steenhoven v. College Life Insurance Co. of America*,⁸ which received negative attention as far away as California.⁹ Also notable is *Xpert Automation System Corp. v. Vibromatic Co.*,¹⁰ where the Court of Appeals attempted to draw conclusions from the earlier cases and in so doing, set the stage for last year's ride.

II. THE *AMOCO PRODUCTION CO. v. LAIRD*¹¹ DECISIONS

A. Background Facts

The operative facts in *Amoco Production Co. v. Laird* appear without

6. *Xpert Automation Sys. Corp. v. Vibromatic Co., Inc.*, 569 N.E.2d 351 (Ind. Ct. App. 1991); *The Prudential Ins. Co. of Am. v. Baker*, 499 N.E.2d 1152 (Ind. Ct. App. 1986); *Michels v. Dyna-Kote Indus., Inc.*, 497 N.E.2d 586 (Ind. Ct. App. 1986); *Kozuch v. CRA-MAR Video Ctr., Inc.*, 478 N.E.2d 110 (Ind. Ct. App. 1985); *The College Life Ins. Co. of Am. v. Austin*, 466 N.E.2d 738 (Ind. Ct. App. 1984); *Steenhoven v. College Life Ins. Co. of Am.*, 458 N.E.2d 661 (Ind. Ct. App. 1984), *reh'g denied*, 460 N.E.2d 973 (1984). The Indiana UTSA has also received only minor attention from the legislature. A 1984 amendment, P.L. 50-1984, §§ 3 and 4, rearranged a provision dealing with a court's ability to order payment of a "reasonable royalty," and redesignated subsections accordingly. A 1993 amendment, P.L. 8-1993, § 343, added "limited liability company" to the definition of "Person" under the act.

7. During this time, the Indiana Supreme Court dealt with the UTSA only once holding that it "merely articulates the common law." The Court entered a permanent injunction in the case even though there was no statutory authority to do so, since the misappropriation preceded the effective date of the act. *Wolfe v. Tuthill Corp.*, 532 N.E.2d 1, 2 (Ind. 1988). Two federal district court cases also applied the Indiana UTSA during this period, both in a customer list and restrictive covenant context. *Fleming Sales Co., Inc. v. Bailey*, 611 F. Supp. 507 (N.D. Ill. 1985); *Prudential Ins. Co. of Am. v. Crouch*, 606 F. Supp. 464 (S.D. Ind. 1985).

8. 458 N.E.2d 661.

9. See James H. Pooly, *The Uniform Trade Secrets Act: California Civil Code § 3426*, 1 SANTA CLARA COMPUTER & HIGH-TECH. L.J. 193, 198 n.19 (1985); MELVIN F. JAGER, *TRADE SECRETS LAW* § 3.04 at 3-50 (1991).

10. 569 N.E.2d 351.

11. 622 N.E.2d 912.

substantial dispute.¹² Relying heavily on recitations by the Indiana Supreme Court and Court of Appeals, those facts most critical to the issues follow. The plaintiff, Amoco Production Company (“Amoco”), was in the oil business and had a reputation for developing new sources of oil in the continental United States. The defendants, William D. Laird, Laird Exploration Company and others (“Laird”), were also in the oil business, as a Texas-based wildcatter and oil exploration financier. Only through the actions of John Clendenning, an Amoco geologist and former Laird neighbor, did their paths cross and this conflict arise.

In early 1991, Amoco formed a team of experts to study a large area of the Northeast Central United States in the hope of locating large reserves of oil within southern Michigan, northeastern Indiana, and northwestern Ohio. This area was chosen, at least in part, because of geological fault lines favorable for such sizable oil quantities. The Amoco team first reviewed published geologic survey literature, examined substantial proprietary documentation kept by Amoco on this area, and interviewed Amoco personnel to take advantage of previous experience. The Indiana Supreme Court wrote that “[t]wenty-four possible production locations were identified through this process.”¹³ Further statistical evaluation narrowed the search to four sites, and additional assessment allowed the team to “refine its focus to a 13,000-square-mile area in southern Michigan and northern portions of Ohio and Indiana known as the Trenton Black River formation.”¹⁴

Based on this preliminary work, a microwave radar study was commissioned with Airborne Petroleum, Inc. (“Airborne”) using navigational grids designed by Amoco’s team. The hope was to locate trending geological fault patterns relying on radar to detect micro-emissions associated with large concentrations of underground hydrocarbons. The Airborne study took a year to complete at a cost to Amoco of \$150,000.00. The accumulated raw data was forwarded by Amoco to QC Data, Inc. (“QC”), which digitized the information and converted it into maps corresponding to this area. It was undisputed that Amoco used internal security measures and contractual arrangements with Airborne and QC to preserve the confidentiality of these survey results.¹⁵

The Amoco team evaluated these maps and commissioned another microwave radar study in Fulton, Marshall and Kosciusko counties in northern

12. This is difficult to say for certain, as true to its trade secret nature, the record and briefs below were under seal and therefore unavailable for this Article. An acknowledgement is given, under the circumstances, to both Indiana appellate courts for possibly being more detailed in their statements of facts than would ordinarily be the case. These aid greatly in understanding the bases underlying their decisions.

13. *Amoco Prod. Co.*, 622 N.E.2d at 914.

14. *Id.*

15. It was for this reason that both Indiana courts found no issue as to part two of the “trade secret” definition in IND. CODE § 24-2-3-2.

Indiana. Analysis of these results identified two primary oil sites with an estimated yield of twenty-two to twenty-three million barrels of oil. This was sizeable, but nonetheless fell short of the goal of fifty million barrels. Following on-site inspection by an Amoco senior land negotiator, the team met to assess the two suspected reserve locations. The final recommendation was to delay actual site development pending future study, at least in part because of the estimated shortfall in production potential.

Clendenning was dissatisfied with the Amoco team recommendation. On November 9, 1991, he sent "a facsimile transmission of a page from a road atlas to Laird upon which he had drawn circles accurately defining location of the potential reserve sites."¹⁶ Moving quickly on this information, Laird traveled to Fulton County, Indiana, inspected the sites, hired a dowser¹⁷ to better determine the perimeter of the oil pool reserves, and proceeded in short order to obtain land leases for oil and gas exploration in a significant portion of these sites.

Meanwhile, also in November, 1991, Amoco management overruled the team's recommendation and directed that site development proceed at once. Learning this, Clendenning contacted Laird but could not stop its leasing efforts. One might imagine Amoco's surprise when its land negotiator discovered that extensive lease purchases for these reserve sites had only recently been sold. Clendenning later confessed to his unauthorized disclosure, and Amoco brought suit against Laird on January 24, 1992.¹⁸

After a three-day hearing, the trial court entered a preliminary injunction prohibiting Laird from using or disclosing the information in the Clendenning map, further pursuing or developing leases in these areas, and using or disclosing any other information gained from Clendenning. Findings of fact and conclusions of law were then entered, and an interlocutory appeal followed.

B. Court of Appeals Finds Xpert Controlling

On appeal, Laird argued the trial court committed reversible error in finding that the information concerning the geographic location of the oil field sites [placed on the map by Clendenning] was a trade secret protected under the Uniform Trade Secrets Act, I.C. § 24-2-3-1 *et seq.* Laird Exploration argues this information was discoverable by reason-

16. *Amoco Prod. Co.*, 622 N.E.2d at 914.

17. As the Court of Appeals reported, "[a] dowser is an individual who purports to have the ability to find underground substances with the use of divining rods." 604 N.E.2d at 1251, n.2.

18. Clendenning was not a named party to this case, at least on appeal. It is not known what other action Amoco brought or may yet bring against Clendenning on these facts, or what other arrangement was made. It is also outside this Article's scope to consider what other claims Amoco could have brought or may yet bring against Laird, alone or jointly with Clendenning, for wrongs other than trade secret misappropriation.

able means and therefore could not be a trade secret as a matter of law, citing *Xpert Automation Systems Corp. v. Vibromatic Co., Inc.*, 569 N.E.2d 351 (Ind. App. 1991).¹⁹

The Court of Appeals began by observing its standard for review in such cases is for abuse of discretion.²⁰ The court quoted the definition of trade secret at Indiana Code section 24-2-3-2, and found no dispute as to Amoco's efforts to maintain secrecy of the information.²¹ The court then focused on the trial court's conclusion that the "proprietary information referred to is not readily ascertainable to those interested in the market place in that the methods of accumulating this information were not simple or easy to accomplish, and are expensive to develop."²² The Court of Appeals cited the trial court's findings in support of this conclusion, and held that the issue was whether a finding of "difficult and costly to develop by independent means" justified the grant of preliminary relief against Laird on the basis that the Amoco information on the Clendenning map is a trade secret under the Indiana UTSA.

Finding this "same issue" presented in the recent case of *Xpert Automation System v. Vibromatic*,²³ the Court of Appeals initially wrote "that *Xpert* is controlling on this issue".²⁴ The court later found a

total lack of findings in this case to support the trial court's conclusion that the geographic information disclosed by Clendenning was not readily ascertainable by Laird Exploration. As in *Xpert*, there is no finding here that it was not *economically feasible* for Laird Exploration to identify the location of the Indiana oil fields by means other than Clendenning's map. The court's finding that it would be more difficult and costly for Laird Exploration to obtain the relevant information by alternative means will not suffice; that notion was explicitly rejected in *Xpert*.²⁵

This case was further likened to *Xpert*, the court held that "an absence of evidence indicating that the information at issue 'could not have been created by any means other than [plaintiff's] business operations.'"²⁶

19. *Laird*, 604 N.E.2d at 1252.

20. *Id.* at 1252 (citing *Harvest Ins. Agency, Inc. v. Inter-Ocean Ins. Co.*, 492 N.E.2d 686, 688 (Ind. 1986)).

21. *Id.* at 1252.

22. *Id.* at 1253; Trial Record at 173L.

23. *Xpert*, *supra* note 6.

24. *Id.* at 1252.

25. *Id.* at 1253 (emphasis added). It is noteworthy here that there is no debate in the Indiana Supreme Court or Court of Appeals decisions over whether Laird could have in fact duplicated the precise information in the Clendenning map under any circumstances. This seems unlikely, and a well-made argument on this point could have aided greatly at trial and on appeal.

26. *Id.* (citing *Kozuch v. CRA-MAR Video Center, Inc.*, 478 N.E.2d 110, 113 (Ind. Ct. App. 1985)).

In closing, the Court of Appeals noted that the knowledge of fault lines as guiding initial surveys and the use of microwave radar studies as a survey tool are generally known in the industry. The court also brought up, only to reject, the contention that Laird's wrongdoing or any independent duty owed to Amoco would suffice for more than a finding of misappropriation of information under Indiana Code section 24-2-3-3(a). In reversing the preliminary injunction, the court did so only "insofar as it prohibits Laird Exploration from pursuing or developing leases in the oil fields as indicated on Clendenning's map or otherwise using or disclosing the information conveyed by the map."²⁷

C. Supreme Court Rejects "Economic Infeasibility" Standard

In granting transfer, the Indiana Supreme Court cited *Amoco Production Co. v. Laird* as a "case of first impression to address the meaning of the phrase 'not being readily ascertainable' as used in the Indiana Uniform Trade Secrets Act"²⁸ The Court thereby accepted its first true consideration of this eleven year-old Indiana Act.²⁹ The result is a well-reasoned expression by the Court on this cornerstone issue separating those who develop new products and technologies trusting in trade secret protection, and those who would benefit from the developments of others, given the opportunity, without the same investment or risk.³⁰

27. *Id.* at 1254. The Court of Appeals let stand the trial court's injunction against use or disclosure of other information gained in the case. It also noted that, as in *Xpert*, its decision was limited by the trial court's findings based on the record of this interlocutory appeal, and acknowledged that a different record may be developed in a full trial on the merits.

28. *Amoco Prod. Co.*, 622 N.E.2d at 913.

29. This decision was applauded by some, including the Amicus Curiae representing the Indianapolis Bar Association, Patent, Trademark and Copyright Section, who participated both in writing and on oral argument before the Indiana Supreme Court on this case. The author would give a special acknowledgement to the Brief of this Amicus party and its authors who provided valuable assistance in the preparation of this Article.

30. The framing of these two sides is expressed well in the Court's statement of contentions on appeal:

Laird contends that Amoco failed to show that (1) it was not economically feasible for Laird to identify the location of the oil fields other than by Clendenning's map, or (2) the oil reserves information could have been created by means other than Amoco's business operations. Thus, Laird reasons, Amoco failed to establish that the information was not "readily ascertainable by other proper means," a requisite statutory element for trade secret protection.

Amoco urges that the oil reserve information highlighted on Clendenning's map is a trade secret. Amoco argues that IND. CODE § 24-2-3-2, the definitional component of the Indiana Uniform Trade Secrets Act, unambiguously sets forth in part that a trade secret refers to information not known to and "not being readily ascertainable" through proper means by others who can obtain economic value from its disclosure or use. Thus, Amoco asserts, because Laird could have duplicated the reserve site information only by considerable expenditure of time, effort, and expense, the information contained on the

The Indiana Supreme Court recognized this as an issue of greater importance than its definitional status would suggest. Quoting from *The Uniform Trade Secrets Act: The States' Response*,³¹ the Court agreed that "[t]he definitional section of the UTSA does a great deal more than provide definitions. It is substantive in nature and actually sets forth the elements of what constitutes a violation of the statute through its definitions of improper means, misappropriation, person, and trade secret."³² The Court also recognized the sound discretion of the trial court to grant or deny a preliminary injunction, and the proper abuse standard for its review.³³ The issue, thus framed, focused on the trial court's finding of sufficient evidence to support its conclusion that the information gathered by Amoco and transferred to the Clendenning map that was given to Laird was in fact protectable as a "trade secret" under Indiana Code section 24-2-3-2.

In tackling this issue, the Supreme Court first decided that the statutory language in question is ambiguous, thereby justifying its judicial construction.³⁴ It did so without reference to any common usage or dictionary definitions of "readily ascertainable" and without reference to the Commissioner's Comments to the UTSA which are instructive on the meaning and coverage of this term:

Information is readily ascertainable if it is available in trade journals, reference books or published materials. Often, the nature of a product lends itself to being readily copied as soon as it is available on the market. On the other hand, if reverse engineering [i.e. recreating the information] is lengthy and expensive, a person who discovers the trade secret through reverse engineering can have a trade secret in the information obtained from reverse engineering.³⁵

Rather, the Court reasoned that the phrase "not being readily ascertainable" was ambiguous in view of its "apparent susceptibility to more than one interpretation."³⁶ This was based, at least in part, on the fact that Amoco and Laird disagreed as to its coverage of the information on the Clendenning map. The

map was not readily ascertainable and therefore qualifies as a trade secret.

Amoco Prod. Co., 622 N.E.2d at 918.

31. Linda B. Samuels & Bryan K. Johnson, *The Uniform Trade Secrets Act: The States' Response*, 24 Creighton L. Rev. 49, 54 n.1 (1990).

32. *Id.*

33. *Id.* at 919 (citing *Harvest Ins. Agency v. Inter-Ocean, Ins. Co.*, 492 N.E.2d 686, 685 (Ind. 1986)).

34. *Id.* at 919-20 (citing *Superior Constr. Co. v. Carr*, 564 N.E.2d 281, 284 (Ind. 1990); *Community Hosp. of Anderson and Madison County v. McKnight*, 493 N.E.2d 775, 777 (Ind. 1986); *Hinshaw v. Board of Comm'rs of Jay County*, 611 N.E.2d 637, 638 (Ind. 1993); *P.B. v. T.D.*, 561 N.E.2d 749, 750 (Ind. 1990)).

35. *Unif. Trade Secrets Act* § 1, 14 U.L.A. 437 comment at 439 (1979).

36. *Amoco Prod. Co.*, 622 N.E.2d 912, 920.

Court further cited to text book and other references to “trade secrets” as being “heavily fact-specific,” “elusive,” and “extraordinarily difficult” to define.³⁷

Yet to be seen is whether this finding of statutory ambiguity is justified and whether it is received by other courts and commentators. The question remains unanswered since disagreement of the parties to this appeal can be viewed not as ambiguity in the statute, but rather as a dispute over its application to the facts of this case. If the Court’s reasoning is followed in other jurisdictions with similar versions of the UTSA, precedential value of *Amoco Production Co. v. Laird* should be sufficient to avoid parallel or conflicting constructions of this same language by other courts.

The Indiana Supreme Court proceeded to discount prior Indiana cases addressing trade secret law under the Indiana UTSA as “factually divergent” and offering “limited guidance in determining the trade secret status of information under present circumstances.”³⁸ It noted the Court of Appeals’ reliance on the judicially-created standard of “economic infeasibility” first appearing in *Xpert Automation System Corp. v. Vibromatic Co., Inc.*³⁹ The Court then reviewed the foundation in *Xpert*, which relied on the prior cases of *Kozuch v. CRA-Mar Video Ctr., Inc.*,⁴⁰ and *Fleming Sales Co., Inc. v. Bailey*,⁴¹ for this theory, and concluded that *Xpert* “distorts the content in both. *Kozuch* and *Fleming* fail to provide a sound precedential basis for an economic infeasibility standard that *Laird*, relying heavily on *Xpert*, would have us acknowledge.”⁴² Perhaps in

37. *Id.* at 921 (citing 1 MELVIN F. JAGER, TRADE SECRETS LAW § 5.01 (1992 Revision), quoting *Lear Siegler, Inc. v. Ark-Ell Springs, Inc.*, 569 F.2d 286, 288 (3rd Cir. 1978); 2 RUDOLPH CALLMAN, THE LAW OF UNFAIR COMPETITION, TRADEMARKS, AND MONOPOLIES § 14.06, 14-35 (4th ed. 1992); James Chapman, *California Uniform Trade Secrets Act: A Comparative Analysis of the Act and the Common Law*, 2 COMPUTER & HIGH-TECHNOLOGY L.J. 389, 392 (1986); RESTATEMENT OF TORTS § 757, Comment b (1939); Alois Valerian Gross, Annotation, *Trade Secrets*, 59 A.L.R.4th 641, § 2[a] (1988); J. Henderson, *The Specifically Defined Trade Secret: An Approach to Protection*, 27 SANTA CLARA L. REV. 537, 551 (1987)).

38. *Id.* at 923.

39. *Xpert*, 569 N.E.2d 351. Amoco’s assessment of the Court of Appeals decision in *Laird v. Amoco* is informative on this point.

[T]he Court of Appeals distorted the clear meaning of “not being readily ascertainable” by endorsing a dual standard which requires the plaintiff to show that (1) it would be economically infeasible for the defendants to acquire the same information through other means and (2) there is evidence indicating that the information at issue could not have been created by any means other than plaintiff’s business operations.

Amoco Prod. Co., 622 N.E.2d 912, 924.

40. 478 N.E.2d 110 (Ind. Ct. App. 1985).

41. 611 F. Supp. 507 (N.D. Ill. 1985).

42. *Id.* at 926. See generally Brief of Amicus Curiae Indianapolis Bar Assoc. Patent, Trademark and Copyright section at 7-10, *Amoco Prod. Co. v. Laird*, 622 N.E.2d 912 (Ind. 1993) (No. 25505-9310-CV-1144) (suggesting how the Court of Appeals was led astray in its reasoning from *Xpert*).

The court based its holding in *Amoco Prod. Co. v. Laird* on its earlier “reasonable means” standard created in *Xpert Automation Systems Corp. v. Vibromatic Co., Inc.*, (1991) Ind. App., 569

order to avoid further erosion of the public policies favoring trade secret protection underlying the Indiana UTSA, the Supreme Court did not rest with a simple rejection of an “economic infeasibility” standard based on case law precedent alone. Instead, it denounced the standard as deriving “no support from the plain language of either the Indiana Uniform Trade Secrets Act or the UTSA.”⁴³ It also held that

[a] defendant’s economic capacity to obtain information by other proper means is thus a notion extraneous to either statute Thus, the overlay of an economically infeasible standard upon the UTSA’s readily ascertainable standard is clearly inconsistent with the definitional elements of “trade secret” contained in the model statute endorsed in toto by our legislature. Economic infeasibility thus would alter Indiana’s Uniform Trade Secrets Act by having it mean what it does not say.⁴⁴

Still not satisfied, the Indiana Supreme Court further assailed an “economic infeasibility” standard as “inconsistent with apparent legislative intent”

N.E.2d 351: “Thus, it is clear that information which is discoverable by reasonable means cannot be a trade secret.” *Id.* at 569 N.E.2d at 355. This unfortunate and incorrect characterization of the proper standard (“readily ascertainable”) resulted from the *Xpert Automation Systems* court’s: (1) reliance on a discredited opinion of another Court of Appeals decision, *Steenhoven v. College Life Insurance Co.*, (1984), Ind.App., 460 N.E.2d 973; and, (2) oversimplification of the holding of a *pre-UTSA* decision of the Supreme Court in *Woodward Insurance, Inc. v. White* (1982), Ind., 437 N.E.2d 59, 68, as discussed *infra*.

The opinion in *Steenhoven v. College Life Ins. Co.* has been identified as causing the legislature of the sixth largest economic power in the world, California, to revise its version of the UTSA. Pooly, *The History of the California Trade Secrets Act*, 1 SANTA CLARA COMPUTER & HIGH-TECH. L.J. 193 (1985) (underlining added) (footnote included). Likewise, in Jager’s treatise TRADE SECRETS LAW (Clark Boardman), he states: “The Indiana Trade Secrets Act was construed in *Steenhoven v. College of Life Insurance Co.* . . . It is difficult to discern from the Act any legislative basis for this court-drawn distinction between lists of a wide group of customers and a small fixed group of customers.” JAGER, TRADE SECRETS LAW § 3.04 at 3-50. Thus, *Steenhoven* and its progeny have been criticized as being a departure from the accepted interpretation of the UTSA.

The *Xpert Automation Systems* court also oversimplified the holding in *Woodward Insurance*, stating: “In *Woodward Insurance, Inc. v. White* (1982), Ind., 437 N.E.2d 59, 68, the Supreme Court held that a policyholder list could not be considered a trade secret where the information on the list was available from other sources.” *Xpert Automation Systems*, 569 N.E.2d at 354. This is *not* the holding in *Woodward Insurance*. Instead, the Supreme Court merely applied the proper standard of review in affirming the trial court’s findings of fact. . . . Moreover, *Woodward Insurance* involved an alleged misappropriation occurring *prior to* the September 1, 1982 enactment of Indiana’s UTSA. I.C. 24-2-3-8. Since the UTSA expressly “displaces all conflicting law of this state pertaining to the misappropriation of trade secrets. . .”, I.C. 24-3-3-1(c), *Woodward Insurance* cannot be relied upon in interpreting the statute. The *Xpert Automation Systems* court’s reliance on *Woodward Insurance* is misplaced, and therefore the *Laird* court’s reliance on *Xpert Automation Systems* is similarly misplaced.

43. *Amoco Prod. Co.*, 622 N.E.2d 912, 926.

44. *Id.* at 927.

underpinning the Indiana Act and the UTSA as originally promulgated and adopted with varying modifications by thirty-nine jurisdictions in this country.⁴⁵ The Court cited case law from these other UTSA jurisdictions for their absence of any reliance on “economic infeasibility” and for their assistance in what information is properly seen as “readily ascertainable” under statute.⁴⁶

In concluding this analysis, the holding of the Court is not only historically significant, but also foreshadows the standard to be applied in Indiana courts in the future. This standard reads as follows.

Although the standard utilized by other jurisdictions to determine “not being readily ascertainable” varies, we find no case holding that “not being readily ascertainable” adheres when measures required to duplicate or acquire information are so prohibitively burdensome as to be “economically infeasible”. An economic infeasibility standard in trade secrets law not only would be unique to Indiana but also would be singularly extreme in its demand that the effort required to duplicate or acquire alleged trade secret information be not merely considerable or significant but so burdensome as to be a virtual economic impossibility.

We thus find that, consistent with the interpretation of the UTSA in other jurisdictions, where the duplication or acquisition of alleged trade secret information requires a substantial investment of time, expense, or effort, such information may be found “not being readily ascertainable” so as to qualify for protection under the Indiana Uniform Trade Secrets Act. Therefore, the trial court’s finding that methods of acquiring the information pertaining to the location of the Indiana oil reserve sites “were not simple or easy to accomplish, and are expensive to develop,” Record at 173L, is sufficient to support its conclusion that such information was not readily ascertainable and thus entitled to trade secret protection.⁴⁷

The Indiana Supreme Court could have ended its consideration of the appeal at this point. It did not. The reasoning which followed, albeit dicta, underscores the Court’s view of the correctness of the trial court’s findings based on the facts of this case. It also provides some guidance for future triers of fact.⁴⁸ In particular, the Court dispelled the thought, as argued by Laird, that a “could have” test based on hindsight would excuse trade secret misappropriation under the circumstances. It also followed the law of other jurisdictions in reasoning

45. See also MELVIN F. JAGER, TRADE SECRETS LAW § 3.04, at 3-30, -31 (1993).

46. *Id.* at 928.

47. *Amoco Prod. Co.*, 622 N.E.2d 912, 928.

48. *Id.*

that a trade secret may include elements, which taken separately are “readily ascertainable,” but taken together qualify for trade secret protection.

Notwithstanding Amoco’s use of some information and technology residing in the public domain, Amoco’s exploratory effort was nevertheless a unique undertaking. Amoco engaged in a considerable outlay of resources of time, effort, and funding

While some tools leading to Amoco’s site discoveries were easily accessible . . . , we find that, taken together, the integration of pertinent site information and result and projections as to potential oil reserves constitutes a unique compilation of information not previously known in the marketplace. We thus agree with the trial court’s conclusion that the information generated by Amoco, later appearing on Clendenning’s map, was not readily ascertainable.⁴⁹

The Supreme Court’s dicta in this case also reflects on the burdens of going forward with evidence in trade secret cases. Initially, a plaintiff seeking relief for misappropriation of trade secrets “must identify the trade secrets and carry the burden of showing they exist.”⁵⁰ Amoco met that burden by “providing evidence sufficient to demonstrate that duplication of its trade secret information would require a substantial investment of time, expense, and effort [This justified the trial court’s findings of fact and ultimate conclusion]. Thus, the geographical information displayed on Clendenning’s map is entitled to trade secret protection.”⁵¹ It is open to speculation what evidence Laird could have presented to meet its burden of going forward. For example, if Laird cited a published study identifying the same information on the Clendenning map, albeit possibly with other potential oil reserve sites as well, would this have changed the outcome at trial or on appeal? While the Court of Appeals stated, “[w]hether or not information is misappropriated is not part of the statutory definition of trade secret,”⁵² it is difficult to accept that even under lesser facts, the method by which Laird obtained Amoco’s trade secret information would not affect the outcome. Even if Laird had submitted this evidence, however, other actions may have been available under Indiana law to compensate Amoco for its loss.⁵³

49. *Id.* at 938. The author would hope the full impact of *Amoco v. Laird* in directing future courts in applying the Indiana UTSA is not undercut by the Supreme Court’s stress on the “unique” nature of Amoco’s work. Many trade secrets, if not all, comprise combinations at least in part of known or available information in some manner or respect. This does not lessen their value or uniqueness as “trade secrets” under the UTSA definition.

50. *Id.* at 938-37 (citing *Diodes, Inc. v. Franzen*, 67 Cal. Rptr. 19 (Cal. Ct. App. 1968); *Boeing Co. v. Sierracin Corp.*, 738 P.2d at 665, 674 (Wash. 1987)).

51. *Id.* at 939.

52. *Laird v. Amoco*, 604 N.E.2d 1249, 1254 (Ind. Ct. App. 1992).

53. The Illinois version of the UTSA is relevant on this point. By dropping the UTSA term “independent” as a modifier of “economic value” and defining a trade secret as information

In closing, the Indiana Supreme Court harkened back to policies underlying trade secrets law as promoting “[t]he maintenance of standards of commercial ethics and the encouragement of invention”⁵⁴ In this case, the Court found that “[t]he initial identification of significant oil reserve locations, though not strictly a new invention, product, or technology, represents the unique discovery of previously unknown deposits of a valuable natural resource. As such, we find that protection of such a discovery is consistent with the policies underpinning trade secrets law.”⁵⁵ Accordingly, transfer was granted and the judgment of the trial court affirmed. Some indication of the unanimity of the Indiana Supreme Court on these issues is seen in the fact that all Justices concurred without opinion.

III. CONCLUSION

This Article is not intended as an exhaustive analysis of the matters discussed, or a comprehensive study of all issues or considerations underlying the definition of “trade secrets” under the Indiana UTSA. Rather, the intent is to report on an exciting survey period for Indiana trade secrets law. Only time will tell how favorable the *Amoco Production Co. v. Laird* decision is received, and its effectiveness in guiding Indiana trial courts in the future. In any event, a clear expression by Indiana’s highest court on this most important Act was long awaited. Indiana needs a strong, predictable and enforceable trade secret law in order to attract new high technology companies, while keeping the ones it has. Stable trade secret law will also work to encourage investment in Indiana-based research and development efforts, to protect the interests of companies and individuals alike who have or develop such new ideas, and to maintain and foster commercial morality in this state.

“sufficiently secret to derive economic value, actual or potential, from not being generally known to others” Illinois focuses on the secrecy of the information sought to be protected. ILL. ANN. STAT. ch. 765, para. 1065/2 (Smith-Hurd 1993).

54. Citing *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481 (1974) and *Metallurgical Indus. Inc v. Fourtek, Inc.*, 790 F.2d 1195, 1201 (5th Cir. 1986).

55. *Amoco Prod. Co.*, 622 N.E.2d at 940.