

Charles Tait Graves

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Litigation
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FOCUS AREAS

Litigation
Trade Secret Litigation
Trial

HIGHLIGHTS

- Unique Specialization in Trade Secret Law**
Tait has almost 25 years of experience handling countless trade secret matters in Silicon Valley and around the country, from litigating trade secret disputes to providing strategic guidance on the full range of complex trade secret problems.
- Trial Litigation Experience**
He has secured defense verdicts in jury and bench trials and eliminated a large number of cases through motion practice.
- Intellectual Leadership**
Tait is one of the nation's most widely-cited writers on trade secret law. His ideas have generated influential precedents and changed California law protecting mobile employees and the companies hiring talent. He has taught trade secret law for 15 years at UC Law, San Francisco.

EXPERIENCE

Charles Tait Graves litigates trade secret disputes and provides intellectual property counseling on complex trade secret matters. Few globally have similar depth, experience, and insight in this area.

Tait is renowned for his focus on trade secret law. For more than two decades, he has handled countless trade secret matters in Silicon Valley and around the country. He is often hired for the most difficult cases, including jury trials. He has secured defense verdicts in jury and bench trials and eliminated a large number of cases through motion practice. He also frequently writes and lectures in the field. A number of his ideas and approaches have been adopted in important court rulings that have set new precedent in California and influenced the practice of trade secret law nationwide.

Tait has served on the firm's Board of Directors since 2021, and has been co-leader of the firm's IP litigation group since 2019. He has served on the firm's Compensation Committee several times (2019-20, 2022-23) and was co-chair of the Nominating Committee from 2016-2018.

Litigation: Trade secret cases have increased in recent years. From inception through trial and appeal, Tait handles trade secret, nondisclosure agreement, invention assignment, work for hire, preparations to compete, and similar matters. Recent matters include a complete victory in arbitration in 2023 and the resolution of a long-running case between cybersecurity vendors in California state court from 2020 to 2023.

Through his litigation wins and influential publications, he has helped shape California's trade secret laws by advancing creative theories on issues such as claim identification, statutory preemption of alternative causes of action, the meaning of the statutory phrase "threatened misappropriation," expert

damages opinions, choice of law, bad-faith claims, and the application of Business & Professions Code Section 16600 in various contexts.

Strategic Guidance: Many potential problems never result in litigation because clients receive precise and careful counseling. Tait has counseled a vast number of companies—from start-ups to some of technology's biggest names—as well as individuals and investors. This includes pre-dispute counseling, internal investigations, workforce training, policy development, clean room planning, advising new start-ups and company founders, hiring and mobility, international questions, restrictive covenants, pre-acquisition diligence, and investment due diligence .

Rulings on important points of trade secret law include the following:

- **Independent Derivation:** In a rare ruling on the independent development defense, Tait won a motion for summary judgment in *Snapkeys, Ltd. v. Google LLC*, 539 F. Supp. 3d 1040 (N.D. Cal. 2021).
- **DTSA/RICO Interface:** In one of the first rulings on the RICO amendment and the Defend Trade Secrets Act of 2016, Tait won a motion to dismiss all federal claims with prejudice in *Attia v. Google LLC*, which the Ninth Circuit affirmed, 983 F.3d 420 (9th2020); 2019 WL 1259162 (N.D. Cal. March 19, 2019).
- **Trade Secret Standing:** Tait helped win summary judgment twice in a case centering on standing issues regarding the interplay of trade secret claims and patent application assignments in *Attia v. Google LLC* (California state court 2014-2020; plaintiffs' appeal denied Nov. 3, 2023).
- **Trade Secret Statute of Limitations:** Tait helped win a motion to dismiss with prejudice under the DTSA and New York state law statutes of limitation in *Zirvi v. Flatley*, 433 F. Supp. 3d 448 (S.D.N.Y. 2020), *affirmed* (2nd Dec. 11, 2020).
- **Voiding a Co-Worker Non-Solicit:** Tait helped secure the dismissal of a former employer's claim which sought to enforce an employee non-solicitation covenant as void under California law in *Agilent v. Twist Bioscience et al.* (California state court, May 2019).
- **Preemption:** Tait has been a leading voice in bringing order and clarity to trade secret law through UTSA preemption, including some of the nation's most widely cited rulings on the issue; these cases include *DAT Sols., LLC v. Convoy, Inc.*, 2023 U.S. Dist. LEXIS 70734 (D. Ore. 2023) (UTSA preemption under Delaware law); *Snapkeys, Ltd. v. Google LLC*, 442 F. Supp. 3d 1196 (N.D. Cal. 2020) (UTSA preemption of fraud claim); *GSI Tech., Inc. v. Integrated Silicon Solution, Inc.*, 2015 WL 5655092 (N.D. Cal. Sept. 25, 2015) (UTSA preemption on summary judgment); *SunPower Corp. v. SolarCity Corp.*, 2012 WL 6160472 (N.D. Cal. 2012); (comprehensive UTSA preemption ruling); *AirDefense, Inc. v. AirTight Networks, Inc.*, 2006 WL 2092053 (N.D. Cal. 2006); and *Digital Envoy, Inc. v. Google Inc.*, 370 F. Supp. 2d 1025 (N.D. Cal. 2005) (the test for UTSA preemption later adopted by the California Court of Appeal).
- **Claim Identification:** Tait won the first published ruling in Texas on early trade secret claim identification, in *United Serv. Auto Ass'n v. Mitek Systems, Inc.*, 289 F.R.D. 244, 248 (W.D. Tex. 2013), *aff'd*, 2013 WL 1867417 (W.D. Tex. 2013), as well as a rare ruling in Oregon on the subject, *DAT Sol., LLC v. Convoy, Inc.*, 2022 U.S. Dist. LEXIS 150655 (D. Ore. 2022).
- **Employee Mobility, Inevitable Disclosure, and Bad Faith:** Tait won an important trial and appeal that made so-called "inevitable disclosure" sanctionable against departing employees and established new standards for awarding sanctions against overbearing former employers in *FLIR Systems, Inc. v. Parrish*, 172 Cal. App. 4th 1270 (2009) (after prevailing at bench trial, clients were awarded one of the largest defense-side attorneys' fees amounts ever granted in a trade secret case; interpretation of "threatened misappropriation" under California's Uniform Trade Secret Act).
- **Threatened Misappropriation:** Tait limited the definition of "threatened misappropriation" in the *FLIR* case and in *Edifecs, Inc. v. TIBCO Software Inc.*, 756 F. Supp. 2d 1313 (W.D. Wash. 2010), 2011 WL 1045645 (W.D. Wash. 2011) (choice of law principles under trade secret law; interpretation of "threatened misappropriation" on a motion to dismiss).
- **Conflict of Law and Trade Secrets:** Tait has won two decisions which favorably flipped the controlling law to California trade secret law, in the *Edifecs* case and in *Ophthalmic Research Assoc., Inc. v. Sarcode Corp.*, 2013 U.S. Dist. LEXIS 72560 (D. Mass. May 22, 2013) (dismissing claims alleged under Massachusetts trade secret law to California law).
- **Intent and Access:** Tait advanced the interpretation of the UTSA's intent requirement in *Be In, Inc. v. Google Inc.*, 2013 WL 5568706 (N.D. Cal 2013) (granting motion to dismiss for Google, YouTube, and Google UK), and, representing a client in a multi-defendant case, contributed to an important decision on downstream immunity in the *Silvaco* cases (California State Court 2005-2010).
- **Advertising/Trade Secret Interplay:** Tait secured dismissal of a Lanham Act advertising claim improperly premised on trade secret allegations in *United Serv. Auto Ass'n v. Mitek Systems, Inc.*, 2013 WL 781900 (W.D. Tex. 2013).
- **Damages Apportionment:** Tait helped undermine a runaway damages award where an expert failed to apportion claimed trade secret damages in *O2 Micro Int'l, Inc. v. Monolithic Power*

Systems, Inc., 399 F. Supp. 2d 1064 (N.D. Cal. 2005) (denial of injunction and limitations on trade secret damages expert testimony based on improper claim analysis methodology).

- **IP Claims and Mergers:** In a multi-defendant case, Tait helped win dismissal with prejudice of a lawsuit raising IP allegations aimed at a merger agreement in *The Florey Institute of Neuroscience and Mental Health v. Kleiner Perkins Caufield & Byers et al.*, 31 F. Supp. 3d1034, (N.D. Cal. 2014).

Since 2009, Tait has taught a course on trade secret law at UC Law, San Francisco. He has also co-taught the IP seminar there. In addition, he has regularly participated in scholarly conferences on trade secret law around the country for many years, he is a frequent guest lecturer at law schools on the topic, and he has spoken at conferences organized by the United States Patent and Trademark Office and the United States Department of Energy. From 2017-2020, Tait served as a co-chair of the drafting group on identification of trade secret claims for the Sedona Conference's Working Group on trade secret law, an effort by judges, academics, and practitioners to promulgate recommendations on various aspects of the law. The resulting [publication](#) was issued in October 2020.

Tait is one of the nation's most widely-cited writers on trade secret law, with numerous research articles and essays on the history, theory, and practice of trade secret and employee mobility law. His articles focus on unexplored policy aspects and discontinuities found in these areas. These publications have been frequently cited by courts in California and around the country, as well as by scholars and practitioners.

Tait also speaks basic Japanese.

CREDENTIALS

Education

- J.D., University of California College of the Law, San Francisco, 1998
Cum Laude
- B.S., University of California, Berkeley, 1994
With Honors

Admissions

- State Bar of California
- U.S. District Court for the Central District of California
- U.S. District Court for the Eastern District of California
- U.S. District Court for the Northern District of California
- U.S. District Court for the Southern District of California
- U.S. District Court for the District of Colorado
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the First Circuit
- U.S. Court of Appeals for the Second Circuit
- U.S. Court of Appeals for the Ninth Circuit

PUBLICATIONS

Select Publications

[View Tait's Google Scholar profile here.](#)

- "Intentionality in Trade Secret Law," *Berkeley Technology Law Journal*, forthcoming 2024
- "Curiosities of Standing in Trade Secret Law," 20 *Northwestern Journal of Technology and Intellectual Property* 159, 2023
- "Questioning the Co-Worker Non-Solicitation Covenant," 55 *Loyola of Los Angeles Law Review* 959, 2022
- Co-author with Sonia K. Katyal, "From Trade Secrecy to Seclusion," 109 *Georgetown Law Journal* 1337, 2021 (Winner of the 2022 McCarthy Institute award for best IP law review article of the year)
- "Should California's Film Script Cases be Merged into Trade Secret Law?" 44 *Columbia Journal of Law & the Arts* 21, 2020
- "Preparing to Quit: Employee Competition versus Corporate Opportunity," 41 *Berkeley Journal of Employment and Labor Law* 333, 2020
- Co-author with R. Feldman, "Naked Price and Pharmaceutical Trade Secret Overreach," 22 *Yale Journal of Law and Technology* 61, 2020
- "Is the Copyright Act Inconsistent with the Law of Employee Invention Assignment Contracts?" 8 *NYU Journal of Intellectual Property & Entertainment Law* 1, 2019

- "Is There an Empirical Basis for Predictions of Inevitable Disclosure?" 18 *Wake Forest Journal of Business & Intellectual Property Law* 190, 2018
- Co-author with E. Tippet, "UTSA Preemption and the Public Domain: How Courts Have Overlooked Patent Preemption of State Law Claims Alleging Employee Wrongdoing," 65 *Rutgers Law Review* 59, 2013; reprinted in *Trade Secrets and Undisclosed Information*, edited by S. Sandeen and E. Rowe, 2014
- "Trade Secrecy and Common Law Confidentiality: The Problem of Multiple Regimes," *The Law and Theory of Trade Secrecy: A Handbook of Contemporary Research*, edited by R. Dreyfuss and K. Strandberg, 2011
- "Analyzing the Non-Competition Covenant as a Category of Intellectual Property Regulation," 3 *Hastings Science & Technology Law Journal* 69, 2011
- "Trade Secrets as Property: Theory and Consequences," 15 *Journal of Intellectual Property Law* 39, 2008
- "The Law of Negative Knowledge: A Critique," 15 *Texas Intellectual Property Law Journal* 387, 2007
- Co-author with B. Range, "Identification of Trade Secret Claims During Litigation: Solutions for a Ubiquitous Dispute," 5 *Northwestern Journal of Technology & Intellectual Property* 68, 2007
- "Non-Public Information and California Tort Law: A Proposal for Harmonizing California's Employee Mobility and Intellectual Property Regimes under the Uniform Trade Secrets Act," 2006 *UCLA Journal of Law & Technology* 1, 2006
- Co-author with J. DiBoise, "Do Strict Trade Secret and Non-Competition Rules Obstruct Innovation?" 1 *Ohio State Entrepreneurial Business Law Journal* 323, 2006 (symposium presentation)
- "Bad Faith and the Public Domain: Requiring a Pre-Lawsuit Investigation of Potential Trade Secret Claims," 8 *Virginia Journal of Law & Technology* 12, 2004
- Co-author with A. Macgillivray, "Combination Trade Secrets and the Logic of Intellectual Property," 20 *Santa Clara Computer & High Technology Law Journal* 261, 2004

From 2017-2020, Tait served as a co-chair of the drafting group on identification of trade secret claims for the Sedona Conference's Working Group on trade secret law, an effort by judges, academics, and practitioners to promulgate recommendations on various aspects of the law. The resulting publication is *The Sedona Conference, Commentary on the Proper Identification of Asserted Trade Secrets in Misappropriation Cases*, 22 *Sedona Conference Journal* 223 (2021).

Tait was the primary editor of the leading treatise in the field, *Trade Secrets* by James Pooley, from 2006-09. He is also a past editor of the treatise *Trade Secrets Practice in California* (2004-08), his work has been cited in the *Los Angeles Times*, and he has contributed to other treatises and written numerous shorter articles.