

**PRESENTED AT**

29<sup>th</sup> Annual Labor and Employment Law Conference  
May 5-6, 2022  
Austin, TX

**Trade Secret and Non-Compete Update****Carlos R. Soltero****Ken Hughes**

## Author Contact Information:

Carlos R. Soltero  
Soltero Sapire Murrell PLLC  
7320 N. MoPac Expy, Ste 309,  
Austin TX 78731  
(737) 202-4873  
carlos@ssmlawyers.com

Ken Hughes  
Ken Hughes PLLC  
700 Louisiana, Suite 2300  
Houston, TX 77002  
(713) 588-0890  
khughes@khughesplc.com

## TABLE OF CONTENTS

|     |  |    |
|-----|--|----|
| I.  | INTRODUCTION .....   | 1  |
| II. | TEXAS COVENANT NOT TO COMPETE UPDATE.....  | 1  |
| 1.  | The Primary Sources Of Law That Govern Covenants<br>Not To Compete in Texas.....   | 1  |
| A.  | The Texas Covenant Not to Compete Act.....   | 1  |
| B.  | The Effect of the Preemption Clause In The Act .....   | 2  |
| C.  | Cases Holding That The Act Does Not Preempt<br>the Common Law or Other Statutes .....                                      | 2  |
| 1.  | Cases Involving Temporary Injunctive Relief.....   | 2  |
| 2.  | Cases Involving Declaratory Judgments.....   | 3  |
| D.  | Can Another State’s Law Regarding Non-competes Apply<br>to a Texas Employee? .....   | 4  |
| 2.  | The Basic Requirements For A Non-Compete Under Texas Law .....   | 5  |
| 3.  | When Is A Covenant Not To Compete Ancillary To An<br>Otherwise Enforceable Agreement?.....                                 | 6  |
| A.  | The Requirement That The Non-Compete Be Ancillary<br>To An Enforceable Agreement .....                                     | 6  |
| B.  | Types Of Consideration That Courts Have Found To<br>Be Sufficient For A Non-Compete Agreement.....                         | 8  |
| 4.  | The Reasonability Requirement .....  | 9  |
| A.  | Geographic Scope .....   | 9  |
| B.  | Duration of Non-Compete.....   | 10 |
| C.  | Scope Of Activity Restrained .....   | 11 |
| 5.  | Evidence Required To Establish A Violation Of A Covenant Not<br>To Compete Sufficient For Temporary Injunctive Relief..... | 11 |
| 6.  | Attorneys’ Fees In Non-Compete Cases .....   | 12 |
| A.  | Employers Cannot Recover Attorneys’ Fees In Cases<br>Involving Covenants Not To Compete.....                               | 12 |

|      |   |    |
|------|---|----|
| B.   | An Employee May Recover Attorney Fees Under The Act;<br>However, The Burden Is High Under the Statute ..... | 13 |
| 7.   | Injunction Orders and Bonds .....   | 14 |
| A.   | Tex. R. Civ. P. 683: Form and Scope of Injunction Order .....   | 14 |
| B.   | Rule 684: The Bond Requirement .....  | 14 |
| III. | TUTSA UPDATE .....  | 15 |
| A.   | Matters Found To Constitute Trade Secrets .....   | 15 |
| 1.   | Customer Lists .....  | 15 |
| 2.   | Marketing Strategies .....  | 16 |
| 3.   | Products In Development .....   | 16 |
| 4.   | Current Fee schedules .....   | 16 |
| B.   | Matters Found Not to Be Trade Secrets .....   | 16 |
| 1.   | Bid Calculators .....   | 16 |
| 2.   | Sales Quote Sheets .....  | 17 |
| 3.   | General Industry Know How .....   | 17 |
| 4.   | Information In The Public Domain Is Not A Trade Secret .....  | 17 |
| 5.   | Information in Trade Journals, Reference Books<br>and Published Materials .....                             | 17 |
| 6.   | Information Freely Available On The Internet .....  | 17 |
| 7.   | Generic Information About Potential Customers .....   | 18 |
| 8.   | Patented Products .....   | 18 |
| 9.   | Information Voluntarily Disclosed In A Transaction .....  | 18 |
| IV.  | THE IMPORTANCE AND EFFECT OF INJUNCTIVE RELIEF<br>IN EMPLOYMENT CASES.....                                  | 19 |
| A.   | General Requirements For Injunctive Relief.....   | 19 |
| B.   | Defenses To Injunctive Relief.....  | 19 |

|     |   |    |
|-----|---|----|
| 1.  | Failure to Show Imminent Risk Of Injury.....  | 19 |
| 2.  | Failure To Show Irreparable Injury (i.e., Inadequate<br>Remedy At Law) .....                | 20 |
| 3.  | Laches .....  | 20 |
| 4.  | Non-Competes—Some Countervailing<br>Ex-Employee Concerns .....                              | 21 |
| C.  | Scope of Injunction .....   | 22 |
| D.  | Choice of Law Issues.....   | 22 |
| E.  | Effect Of A Temporary Injunction.....   | 24 |
| F.  | Protecting Confidential Information by Protective Orders<br>and Sealing of Courtrooms ..... | 25 |
| V.  | LITIGATING A NON-COMPETE CASE AFTER THE TEMPORARY<br>INJUNCTION HEARING .....               | 25 |
| A.  | Are Damages Available For Breaching the Non-compete? .....                                  | 25 |
| 1.  | Not If The Court Reforms The Non-Compete .....  | 25 |
| 2.  | Damages for Breach of Non-Compete.....  | 26 |
| B.  | Recovery of Damages Under Theories Other Than The<br>Non-compete Agreement.....             | 27 |
| C.  | Are Damage Remedies Available When An Injunction<br>Has Been Granted? .....                 | 27 |
| 1.  | Cases That Say Damages Are Not Available .....  | 27 |
| 2.  | Cases That Say Damages Are Available.....   | 27 |
| D.  | TUTSA Preemption.....   | 28 |
| VI. | CLAIMS COMMONLY ASSERTED AGAINST EMPLOYEES.....   | 30 |
| A.  | Fiduciary Duty Claims.....  | 30 |
| 1.  | Employees Owe Fiduciary Duties To Employers.....  | 30 |
| 2.  | Employee’s Fiduciary Duty May Extend Beyond Termination .....                               | 31 |

|       |   |    |
|-------|---|----|
| 3.    | The Burden Of Proof Shifts So That Employees<br>Must Prove They Did Not Breach Their Duty.....            | 31 |
| 4.    | An Employee Who Breaches His Fiduciary Duty May<br>Be Required To Forfeit Salary And Other Benefits ..... | 31 |
| B.    | Computer Fraud and Abuse Act .....  | 32 |
| 1.    | Employers and Employees Have A Private Right of Action.....   | 32 |
| 2.    | Employees Can Be Liable for Exceeding Authorized<br>Access To A Company Computer.....                     | 33 |
| 3.    | Two Year Statute of Limitations .....   | 33 |
| 4.    | The Interstate Commerce Requirement.....  | 33 |
| 5.    | The “Damage” or “Loss” Requirement.....   | 33 |
| C.    | The Electronic Communications Privacy/Stored<br>Communications Act .....                                  | 34 |
| D.    | Fraud Claims Against Employees.....   | 35 |
| VII.  | ATTACKING THE TEMPORARY INJUNCTION ITSELF BY APPEAL<br>OR A MOTION TO DISSOLVE .....                      | 35 |
| A.    | Interlocutory Accelerated Appeal.....   | 35 |
| B.    | Motions To Dissolve Temporary Injunctions.....  | 35 |
| C.    | Enforcement Motions/Contempt .....  | 35 |
| VIII. | MISCELLANEOUS ISSUES.....   | 36 |
| A.    | Effect of Removal To Federal Court .....  | 36 |
| B.    | Pitfalls with Using Rule 202 Proceedings in Employment Cases .....  | 37 |

# TEXAS NON-COMPETE AND TRADE SECRETS UPDATE

## I. INTRODUCTION

Non-compete and trade secret litigation continues to be a highly active and ever-changing area of practice. This paper will address the essential cases and statutes, as well as more recent noteworthy decisions.

## II. TEXAS COVENANT NOT TO COMPETE UPDATE

### 1. The Primary Sources Of Law That Govern Covenants Not To Compete in Texas

#### A. *The Texas Covenant Not to Compete Act*

The Texas Covenant Not To Compete Act should be the starting point for analyzing any case involving a non-compete. The Act generally establishes the criteria for the enforceability of all non-compete agreements in Texas. Tex. Bus. & Com. Code § 15.50-52.

It is important to remember that when it was initially passed in 1989 the “the Act was intended to reverse the Court’s apparent antipathy to covenants not to compete.” *Marsh USA Inc. v. Cook*, 354 S.W.3d 764, 772 (Tex. 2011). Prior to passage of the Act, the Texas Supreme Court and lower courts had issued opinions making it hard to enforce covenants not to compete in Texas. In 1989, the Texas Legislature passed The Covenants Not To Compete Act which intended to supplant Texas decisional law that was unfavorable for non-compete agreements.

The Supreme Court has repeatedly emphasized the Texas Legislature’s intent to make covenants not to compete more likely to be enforced when construing the Act. Prior to its statement in *Marsh*, the Court discussed the legislative history of the Act in *Sheshunoff*, noting that:

Cumulatively, this legislative history indicates that (1) in 1989 and 1993 the Legislature wanted to expand the enforceability of covenants not to compete beyond that which the courts had allowed, (2) in 1989 the Legislature specifically wanted to ensure that covenants could be signed after the employment relationship began so long as the agreement containing the covenant was supported by new consideration, and (3) in 1993 the Legislature specifically wanted to make clear that covenants not to compete in the at-will employment context were enforceable.

*Alex Sheshunoff Mgmt. Servs., L.P. v. Johnson*, 209 S.W.3d 644, 654 (Tex. 2006).

Other states and jurisdictions have made legislative changes to non-compete obligations. Perhaps the Texas Legislature will again wade into the areas of non-compete law in upcoming sessions.

## **B. The Effect of the Preemption Clause In The Act**

Section 15.52 of the Texas Business and Commerce Code expressly provides that the Act preempts the common law insofar as the enforceability of non-competes and the related procedures and remedies are concerned. The Act states:

The criteria for enforceability of a covenant not to compete provide by Section 15.50 of this code and the procedures and remedies in an action to enforce a covenant not to compete provided by Section 15.51 of this code are exclusive and preempt any other criteria for enforceability of a covenant not to compete or procedures and remedies in an action to enforce a covenant not to compete under common law or otherwise. Tex. Bus. & Com. Code Ann. § 15.52.

The Texas Supreme Court noted five years after the Act was passed that “Section 15.52 makes clear that the Legislature intended the Covenants Not to Compete Act to largely supplant the Texas common law relating to enforcement of covenants not to compete.” *Light v. Centel Cellular Co. of Texas*, 883 S.W.2d 642, 644 (Tex. 1994).<sup>1</sup>

The Legislature’s insertion of a preemption clause was a response to cases decided after the Act was first enacted in which Courts held that covenants not to compete were unenforceable. *Alex Sheshunoff Mgmt. Servs., L.P. v. Johnson*, 209 S.W.3d 644, 653 (Tex. 2006) (“section 15.52 was added to provide that the Act preempts common law”). The Legislative history of the 1993 amendments adding the preemption clause to the Act suggested that there was a belief that courts were ignoring the intent and substance of the 1989 Act.

There are cases where intermediate appellate courts have limited the effect of the Act’s preemption clause holding that it does not apply. One area where courts have found that the common law is not preempted involves injunction cases and the requirements for temporary injunctive relief. Another involves declaratory judgments.

## **C. Cases Holding That The Act Does Not Preempt the Common Law or Other Statutes**

### **1. Cases Involving Temporary Injunctive Relief**

Several Texas intermediate appellate courts have held that the Act does not preempt the common law requirements for obtaining temporary injunctive relief including irreparable injury. *EMS USA, Inc. v. Shary*, 309 S.W.3d 653, 658 (Tex. App.—Houston [14th Dist.] 2010, no pet.); *EMSL Analytical, Inc. v. Younker*, 154 S.W.3d 693, 695 (Tex. App.—Houston [14th Dist.] 2004, no pet.); *Cardinal Health Staffing Network, Inc. v. Bowen*, 106 S.W.3d 230, 239–40 (Tex. App.—Houston [1st Dist.] 2003, no pet.). This is

---

<sup>1</sup> Although the Court’s holding in *Light* was first modified by *Alex Sheshunoff Mgmt. Servs., L.P. v. Johnson*, 209 S.W.3d 644 (Tex. 2006), then abrogated by *Marsh USA Inc. v. Cook*, 354 S.W.3d 764 (Tex. 2011), the notion that the Legislature intended that the Act supplant Texas common law regarding covenants not to compete remains true.

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

## Title search: Trade Secret and Non-Compete Update

Also available as part of the eCourse

[2022 Labor and Employment Law eConference](#)

First appeared as part of the conference materials for the 29<sup>th</sup> Annual Labor and Employment Law Conference session "Trade Secret and Non-Compete Update"