

專題企劃

論「營業秘密」(含法學英文)

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營業秘密、保密措施、機密、保密協定、經濟價值。

摘要

揆諸有關營業秘密的法律保護，普遍區分民事、刑事責任的規範，舉凡個人或公司因營業秘密受有損害者，得對違反保密協定的一方提起民事訴訟，主張侵權損害的賠償責任。另訴訟期間當事人亦得向法院聲請暫時處分，如美國各州民事訴訟法明定有相關之禁制令聲請，以提供企業為阻止營業秘密遭到外洩、或未經其許可使用而導致企業持續性損害的一種臨時救濟手段。惟就刑事責任的判斷，我國檢察官、法院之

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間對於相關法條的適用解釋存有分歧；前者採行為犯，後者以結果犯論處。比較美國法上侵害營業秘密的刑事責任部分在以處罰行為犯，至有否發生實質侵害結果非為所問，此與我國法院之判斷標準有別。而民事責任之認定，台、美法院的判斷差異較小，惟美國法對於營業秘密的定義較為寬鬆，次從契約法角度切入，先行確認系爭保密合同的公平、有效性，方才進一步檢驗系爭資訊是否具機密性，以釐清被告行為有否生侵權損害賠償之事實，此與我國法院偏重營業秘密的機密性質略顯不同。事項觀點，殊值我國法院借鑒參考。

壹、前言

2015年歐洲議會法律事務委員會上，歐盟各國針對營業秘密保護法的草案進行討論，最後以超過2/3的同意票決議通過，該份草案中特別增修了限制言論自由等若干權利條款。歐盟營業秘密保護法的立法目的在防止營業秘密被盜取和誤用，希盼能為歐盟企業提供更好的保護，故而立法支援歐盟企業長期投注研發創新的心力。而該草案將一統歐盟營業秘密的定義，除要求成員國採取措施以防止盜用營業秘密之犯罪外，兼具保障權利人的訴訟與獲得賠償的權利，而保護範圍也涵蓋了專門技術、獨家配方、產品製程等在內的商業機密¹。美國2016年4月有參議員仿效提起盜用營業秘密罪的法案，惟美國聯邦法本來就有類似之條文規範，如《經濟間諜法》（The Economic Espionage Act；簡稱EEA）供參，我國則以妨害電腦使用罪偵辦，對於有否必要再將竊用營業秘密罪單獨立法，各界意見分歧，而據贊助該法案的120多家企業表示，美國聯邦法院在審理此類案件時常疑似有法律引據的困難。而該法案已有一個版本提交於美國眾議院，正俟司法委員會敲定議程日期後進一步商議²。

營業秘密，或謂商業秘密（trade secrets），乃法律上承認具有經濟利益且應受保護的知識（know how）。按台灣《營業秘密法》第2條之定義，營業秘密，係指方法、技術、製程、配方、程式、設計或其他可用於生產、銷售或經營之資訊，而符合左列要件者：「一、非一般涉及該類資訊之人所知者。二、因其秘密性而具有實際或潛在之經濟價值者。三、所有人已採取合理之保密措施者。」又我國《營業秘密法》的立法理由是為保障營業秘密，維護產業倫理與競爭秩序，調和社會公共利益而制定。換言之，要判斷員工有否洩漏公司之營業秘密，尚須檢驗系爭資訊確實具備秘密性（如

1 See <http://www.mofcom.gov.cn/article/i/jyj/m/201506/20150601017643.shtml>, visited on Sept. 23, 2016.

2 See <http://finance.qq.com/a/20160405/007873.htm>, visited on Sept. 24, 2016.

特定職務人員方能取得)、經濟價值(如業者專屬的製程或特殊配方)、保密措施(如業者保護系爭資訊的作為)等三個要件。蓋智慧財產權中的營業秘密,一旦失去保護的重要性,即無所謂機密可言,企業的經濟價值便可能喪失或被稀釋。因此,有鑑於公司企業內部各個功能部門或組織單位的業務類型不同,員工取得之營業秘密有所差異,企業管理人有義務去讓員工瞭解其經手資訊為營業秘密,並從軟硬體方面建置相關措施,以形成保護營業秘密之意識。舉例,被告離職前一、二日,於上訴人之電腦閱覽上訴人供應商價格管理區、樣品目錄單、客戶索取樣品、模具合約書、客戶報價單等檔案資料乙節,因該等資料係位於共用區,並未設定授權帳號、密碼,亦未區分職級,未有相當分類分級之管制措施,相關部門之行政人員均可任意進入自由閱覽,難認上訴人已採取合理之保密措施。

簡言之,各國法律對於營業秘密的保護,分有民事、刑事責任的規範,即一般企業或個人因營業秘密而受有損害者,得對違反保密協定的一方提起民、刑事訴訟,主張侵權損害賠償或刑事責任。另訴訟期間當事人得向法院聲請暫時處分,揆諸美國各州民事訴訟法明定有相關之禁制令聲請,以提供企業於訴訟期間阻止營業秘密遭到外洩、或營業秘密未經其許可使用而導致企業持續遭受損害的一種臨時救濟手段。參照我國《營業秘密法》第11條亦有如是之規定:「營業秘密受侵害時,被害人得請求排除之,有侵害之虞者,得請求防止之。被害人為前項請求時,對於侵害行為作成之物或專供侵害所用之物,得請求銷燬或為其他必要之處置。」

就違反營業秘密之民事責任,優先適用我國《營業秘密法》第12條規定:「因故意或過失不法侵害他人之營業秘密者,負損害賠償責任。數人共同不法侵害者,連帶負賠償責任。前項之損害賠償請求權,自請求權人知有行為及賠償義務人時起,二年間不行使而消滅;自行為時起,逾十年者亦同。」另我國《民法》第184條亦有明文相關規定:「因故意或過失,不法侵害他人之權利者,負損害賠償責任。故意以背於善良風俗之方法,加損害於他人者亦同。違反保護他人之法律,致生損害於他人者,負賠償責任。但能證明其行為無過失者,不在此限。」

比較美國法上對於「營業秘密」之法律問題,刑事部分處罰行為犯,對於有否發生實質侵害結果非為所問,此與我國法院之判斷標準有別。至民事責任之認定,台、美法院的判斷差異較小,惟美國法對於營業秘密的定義較為寬鬆,次從契約法角度切入,先行確認系爭保密合同的公平、有效性,方才進一步檢驗系爭資訊是否具機密性,以釐清被告行為有否生侵權損害賠償之事實,此與我國法院偏重營業秘密的機密性質略顯不同。以下分述探討之。



貳、我國侵害營業秘密的刑事裁判疑義

參照我國《營業秘密法》第10條規定，下面五種之任一情形構成侵害營業秘密罪：「一、以不正當方法取得營業秘密者。二、知悉或因重大過失而不知其為前款之營業秘密，而取得、使用或洩漏者。三、取得營業秘密後，知悉或因重大過失而不知其為第一款之營業秘密，而使用或洩漏者。四、因法律行為取得營業秘密，而以不正當方法使用或洩漏者。五、依法令有守營業秘密之義務，而使用或無故洩漏者。前項所稱之不正當方法，係指竊盜、詐欺、脅迫、賄賂、擅自重製、違反保密義務、引誘他人違反其保密義務或其他類似方法。」由上違反營業秘密的類型，大致可將侵害的態樣劃分二類：一以不正當方法取得、使用或洩漏營業秘密者；二是合法取得營業秘密後之不正當使用或洩漏之行為者。前者包括竊盜、詐欺、脅迫、賄賂、擅自重製、違反保密義務、引誘他人違反其保密義務等方法屬之。又依照行為人取得營業秘密的不正方法，我國刑法另有處罰之規定，如妨害電腦使用罪等。後者所指合法取得係指經買賣、授權、委任、僱傭等法律關係；而針對法令上有保守營業秘密之義務者，係指包括營業秘密法第九條所規範的公務員、司法人員、當事人、代理人、辯護人、鑑定人、證人、其他相關之人、仲裁人、會計師、醫師、建築師、及其他相關之人因執行業務而知悉或持有他人之營業秘密者。惟前述明定於《營業秘密法》第十三條之一之罪，須告訴乃論。

對於意圖為自己或第三人不法之利益，或損害營業秘密所有人之利益者，而有觸犯同法第13-1條規定者，處五年以下有期徒刑或拘役，得併科新臺幣一百萬元以上一千萬元以下罰金。其中，對於持有營業秘密，經營營業秘密所有人告知應刪除、銷毀後，不為刪除、銷毀或隱匿該營業秘密者，亦有本條處罰之適用，殊值留意。同法同條第一項第三款供參。至意圖在外國、大陸地區、香港或澳門使用，而犯前條第一項各款之罪者，處一年以上十年以下有期徒刑，得併科新臺幣三百萬元以上五千萬元以下之罰金（同法第13-2條供參）。最後同法第15條補充，外國人所屬之國家與中華民國如無相互保護營業秘密之條約或協定，或依其本國法令對中華民國國民之營業秘密不予保護者，其營業秘密得不予保護。此所指「外國人所屬之國家」循同法第13-2條之意思似乎排除中國大陸，日後會否生疑義，有待觀察。

一、「營業秘密」的認定

我國實務上偵查侵害營業秘密罪，檢察官主要以刑法第359條妨害電腦使用罪起訴：無故取得、刪除或變更他人電腦或其相關設備之電磁紀錄，致生損害於公眾或他

人者，處五年以下有期徒刑、拘役或科或併科二十萬元以下罰金。惟要能以本條判決定罪的機率卻不高，其中關鍵在於「營業秘密」的認定、以及刑法第359條經最高法院解釋處罰對象為結果犯而非行為犯，此與檢察官的判斷似存分歧。援引兩則判決，以為對照說明。

- (一) 本件檢察官上訴意旨略稱³：1. 「四月公證案號表.xls」、「如何辦理夫妻財產制契約登記.doc」、「服務項目格式一空白.doc」、「辦理委託公證所須攜帶的證件.doc」等四項電磁紀錄檔案，無論是否可於其他公開網站上尋得，或是否與告訴人詹孟龍業務上之當事人機密無關，上開電磁紀錄既存在於詹孟龍之事務所內部電腦系統內，並僅供事務所內部使用，自屬詹孟龍之電磁紀錄，且不管被告陳璟方係基於何種動機及目的而取得上開電磁紀錄，或上開電磁紀錄對於被告具有何種用途，均不影響於被告無故取得他人電磁紀錄之行為。而被告於任職詹孟龍事務所之初所簽訂之保密協定，亦將「聘用方之業務處理內容、資料檔案」列入保密之範圍，上述四項電磁紀錄檔案，自在保密協定之內，顯見詹孟龍對於其事務所內部之所有檔案資料，均有嚴格之保密管理機制，被告無故取得上開電磁紀錄，顯然足生損害於詹孟龍對於其事務所內檔案、文件、電磁紀錄管理之正確性及機密性。原判決竟稱：上述四項電磁紀錄既非詹孟龍營業上秘密，且縱然攜出也不違反保密協定，即不足以認定對於詹孟龍已致生損害云云。顯有理由不備及調查未盡之違法。
2. 被告係於民國九十五年六月十五日上午之上班時間書立切結書（依卷內資料，被告業於九十四年六月十五日上午九時離職），事務所其他員工都在場，而被告於當日即將離職，倘詹孟龍有何不合理之要求，被告並無懼於主僱關係而曲意依從之必要，被告豈有因「不簽切結書就不能離開」，即心生畏怖違反其本意而書立切結書之理。證人即該事務所員工劉勝雄亦結證：被告書立切結書當時，伊並未聽到何爭吵喧嘩的聲音，伊事後才得知被告因類似洩密之行為而簽切結書。倘被告係受脅迫不能離去，惟當時既有其他員工在場，非不得以大聲呼救、製造聲響之方式，引起其他員工之注意，以求脫困，焉有隱忍不發，書立切結書後始離去之理。原判決以上開切結書是否出於被告真意，非無疑問云云，有調查未盡之違法。
- (二) 我國最高法院判決駁回檢察官上訴，重申原審法院已逐一敘明對於如何不能證明被告涉犯該罪，又其中理由⁴：1. 刑法第三百五十九條所規定「致生損害於公眾或他人」，必須行為人無故取得、刪除或變更他人電腦或其相關設備之電磁紀錄，

³ 最高法院100年臺上字第52號刑事判決。

⁴ 同前註。



已對公眾或他人產生具體損害為必要，如僅有發生損害之虞，或不生損害，即與該罪之犯罪構成要件不相符。詹孟龍指稱被告寄送之「四月公證案號表」、「如何辦理夫妻財產制契約登記」、「服務項目格式空白」、「辦理委託公證所須攜帶的證件」等四項電磁紀錄檔案，其內容為相關問題之「問與答」，或為辦理公證程式之說明，且於詹孟龍事務所網頁或台灣臺北地方法院網站上均可查得，顯屬公開之資訊，於客觀上難認屬於詹孟龍營業上之秘密。再依雙方簽訂之保密協定內容，被告雖對於「服務期間所知悉一切公證上業務內容，有絕對保密義務」，但僅限定被告「不得將客戶資料與公證書攜出事務所」。而前述四項電磁紀錄並不屬於協定範圍內之「客戶資料與公證書」，縱被告有將前述電磁紀錄以電子郵件方式寄出，亦與違反「協定」不合。前揭四項電磁紀錄既非詹孟龍營業上秘密，被告縱有該行為，亦與違反「協定」不合，不能證明已致生損害於詹孟龍。2. 詹孟龍雖主張被告於事發後，已簽立切結書、調解書，承認有寄送該資料。但被告辯稱簽署該切結書，非出於自由意思，且其作成之時間，是在詹孟龍指控被告行為（指詹孟龍指摘被告寄發前揭四項電子郵件）之後。則被告簽署該切結書，是否出於真意，非無疑問。另調解書之內容，則是針對勞資雙方關於薪資爭議所為讓步之協議。縱認切結書、調解書均被告所簽署，亦不足為不利於被告之認定。

二、刑法第359條之解釋

上揭案件中，我國最高法院直指檢察官對於刑法第三百五十九條意涵的誤解⁵：刑法第三百五十九條所規定「無故取得、刪除或變更他人電腦或其相關設備之電磁紀錄，致生損害於公眾或他人」罪，屬於結果犯，必須該行為已致生損害於公眾或他人之結果，始構成本罪。否則，縱有無故取得、刪除或變更他人電腦或其相關設備之電磁紀錄行為，倘未致生損害於公眾或他人之結果者，因該罪無處罰未遂犯明文，自不成立該罪。換言之，刑法第三百五十九條之罪，以「致生損害」於公眾或他人為構成要件，屬於結果犯，此與僅以「足以生損害」於公眾或他人為構成要件者，例如刑法第二百十條之偽造私文書罪，以有足生損害於公眾或他人之危險，即行成立者，迥然不同。檢察官上訴意旨以：被告無故取得上開電磁紀錄，「足（以）生損害」於詹孟龍，即應成立刑法第三百五十九條之罪云云。顯然對於刑法第三百五十九條之規定，有嚴重之誤解。

⁵ 同前註。

(一) 無故取得電磁紀錄行為

反觀檢察官以刑法第359條起訴而判決定罪的判決要旨，則強調「無故取得」業務資訊，已屬洩漏公司營業重要機密之行為。參照最高法院判決駁回被告上訴的理由⁶：

1. 本件原判決依憑證人即同案被告楊志偉於偵審供證本件犯罪事實，王怡凱供稱每月取特支費新台幣三千元，由楊依芳交予楊志偉；楊依芳於警詢時供承楊志偉將存有竊取泰特公司機密資訊之隨身碟內容複製至其隨身碟內，其當場交付楊志偉三千元，隨身碟則轉交王怡凱，資料內容為泰特公司進（銷）貨、封裝資料等供詞，就王怡凱指稱楊志偉係泰特公司之電腦管理員，進入該公司電腦取得本案電磁紀錄，係屬其職權範圍，無成立犯罪之辯解，如何不足採，亦於理由內為論述、指駁，所為論斷乃原審本諸職權之行使，對調查所得之證據而為價值上之判斷，據以認定上訴人等之犯罪事實，並未違背客觀上之經驗法則與論理法則，不能指為違法。
2. 刑法第三百五十九條之罪係以無故取得、刪除或變更他人電腦或其相關設備之電磁紀錄，致生損害於公眾或他人為其要件。原判決已敘明王怡凱、楊依芳均為盈豐電子股份有限公司員工，楊志偉為泰特公司員工，二公司之業務相同、販售對象之客源重疊，楊志偉未經授權或得泰特公司之同意，擅使王怡凱、楊依芳取得泰特公司內部關於產品原料進價、封裝、銷貨之客戶名稱、品名、價格、數量等業務資訊，已屬洩漏泰特公司營業重要機密之行為，基於公司市場之開發及競爭攸關營利目的，該行為已致使泰特公司受有壓縮營運可得利益之損害等情，於理由內說明其依憑之證據及判斷之理由，就上訴人等無故取得泰特公司營業秘密資訊之所為，致生損害於泰特公司之犯罪要件已為論斷，並非無據。

(二) 實行共同正犯之認定

另外關於犯罪之謀議，除共謀共同正犯，因其並未參與犯罪構成要件之實行行為，僅係以其參與犯罪之謀議為其犯罪構成要件之要素，故須以積極之證據證明其參與犯罪之謀議及為如何犯罪範圍之謀議外，其餘參與分擔犯罪構成要件行為之人，不論係以自己犯罪或幫助他人犯罪之意思而為，既均成立實行共同正犯，對其事前有無參與犯罪之謀議行為，於判決內無須明白認定，詳細記載，自無庸為證據之證明。又共同正犯間，在合同意思範圍內，各自分擔犯罪行為之一部，相互利用他人之行為，以達其犯罪之目的者，原不必每一階段均參與，祇須分擔犯罪行為之一部，即應對於全部所發生之結果共同負責。是共同正犯之行為，應整體觀察，就合同犯意內所造成之結果同負罪責，而非僅就自己實行之行為負責。

⁶ 最高法院101年臺上字第4173號刑事判決。



原判決就認定民國九十六年七、八月間，王怡凱指示楊依芳，透過不知情之邱靜美而與楊志偉取得聯繫，三人基於竊取泰特公司電腦電磁紀錄之犯意聯絡，由楊志偉利用職務之便，將泰特公司電腦伺服器內關於產品原料進價、封裝、銷貨之客戶名稱、品名、價格、數量等紀錄，以存入楊依芳住處電腦或寄發電子郵件等方式提供予楊依芳，王怡凱並以每月三千元代價，由楊依芳交由楊志偉收受，楊依芳則將該電磁紀錄轉交王怡凱供讀取，渠等間有以不正當方法取得他人電腦之電磁紀錄之犯意聯絡及行為分擔等情，已敘明本於調查所得，資以判斷上訴人等與楊志偉有上揭犯行之犯意聯絡事實之理由，俱有卷存資料可資覆按，而王怡凱既已參與無故取得他人電腦電磁紀錄犯罪行為之實行，為實行共同正犯，而非共謀共同正犯，對於參與實行犯罪行為前如何與其他共同正犯謀議，及在何時、何處為如何謀議內容等非待證事項，自毋庸為認定及為證據之證明。再王怡凱關於犯罪行為之實行，縱由楊依芳負責收取電磁紀錄及交付報酬予楊志偉，亦僅分工不同，屬其等間之行為分擔，無礙須就全部犯罪事實共同負責之認定，論以前揭犯罪之共同正犯，並無不合。

參、美國觸犯營業秘密之相關規定

關於觸犯營業秘密罪的責任追究，美國聯邦法院主要的法源依據是來自1996年的《經濟間諜法》，嗣其整併於美國法典第18章第1831條至1839條。查美國《經濟間諜法》條文規定，早期對於觸犯營業秘密罪的條文有二，分別就外國與內國的商業間諜作區分，並明文於美國法典第18章第1831條及第1832條規定。前者第1831條，指竊取美國個人或企業單位商業秘密的外國經濟間諜者，又稱為經濟間諜罪或商業間諜罪。後者第1832條則是指為利益而竊取美國個人或企業單位營業秘密的行為，通常被稱為商業秘密罪（以下使用營業秘密罪以符合我國慣用語）。爾後相關條文修正，放寬了營業秘密的定義，以下介紹經濟間諜法之適用規定：

一、聯邦法經濟間諜罪

首先，美國法典第18章第1839條清楚定義了何謂營業秘密⁷：營業秘密係指已採取合理保護措施之資訊；又前述資訊具獨立經濟價值，不論實際或潛在價值，且其不能被以普遍認識，或非容易被公開取得者。同法第1832條所指的外國經濟間諜罪，明定了兩種類型的犯罪主體，一種為個人經濟間諜行為、另一種為組織經濟間諜行為。兩

7 18 U.S.C. § 1839.

者的犯罪構成要件雷同，倘有從事下面任一行為者屬之⁸：（一）未經營業秘密所有權人許可，意圖侵佔、竊取、帶走或藏匿營業秘密，或者以詐騙、虛構事實或欺騙等不正手段獲取營業秘密之行為；（二）未經許可而以複製、複寫、草繪、繪製、拍照、下載、上傳、變更、毀壞、影印、傳輸、傳遞、發送、郵寄、傳播、或轉讓營業秘密之行為；（三）明知營業秘密是未經許可而以竊取、侵佔、獲得或挪用、接收、購買或取得商業秘密之行為；（四）前述1至3項所列之犯罪未遂行為；（五）一人或多人共謀實施上述1至3項之犯罪行為，而共同謀劃等情足以影響行為之既遂。惟前揭兩者的刑罰差異頗巨。成立個人施行的經濟間諜罪，最高得處罰金50萬美元，或15年以下有期徒刑，或罰金與監禁併罰。而成立組織經濟間諜罪者，最高得處1000萬美元以下罰金。此外，同法第1838條則申明，此條文不排除各州對於相同事實基礎案件適用其他相關法律之規定⁹。次就圖利的對象又區分兩類：

(一) 外國政府等機構

美國法典第18章第1831條合先序明針對涉嫌經濟間諜罪的外國組織或個人，其犯罪行為之利益方為外國政府、外國機構或外國代理人者，從而本條文之適用，必須犯罪行為人主觀上故意圖利外國政府、外國機構或外國代理人¹⁰。又考量外國經濟間諜的行為可能動搖國內的經濟體制，美國2013年1月起適用《外國經濟間諜量刑法》修正後之罰金刑，分別將對於個人施行經濟間諜行為者，罰金由原最高50萬美元調整至500萬美元；對於從事組織經濟間諜行為者，罰金最低得處1000萬美元、或三倍的損害價值，二擇一較高者¹¹。

(二) 內國企業或他人

對於侵害營業秘密的行為，如果純粹為個人或內國企業圖利而盜取營業秘密之行為，明定於美國法典第18章第1832條之規定。本條與第1831條的構成要件相同，除了劃分個人、組織行為的犯罪主體外，唯一的差別在於營業秘密的受益方不涉及外國政府、外國機構、或外國代理人。另外，違反營業秘密罪的處罰比觸犯經濟間諜罪的處罰輕了許多。就個人成立侵害營業秘密罪者，最高得處10年以下有期徒刑，或易科罰金、或罰金與監禁併罰；而成立侵害營業秘密的組織犯罪行為者，最高得處500萬美元以下罰金¹²。

8 18 U.S.C. § 1832.

9 18 U.S.C. § 1838.

10 18 U.S.C. § 1831.

11 Id. Foreign and Economic Espionage Penalty Enhancement Act of 2012.

12 18 U.S.C. § 1832.



(三) 罰金的估算

有關罰金如何估算的疑問，美國量刑指南中特別以公平的市場價值（fair market value）作為被害人主張所受損害的判斷標準，或有曰之被告違反營業秘密的不法利得¹³。又美國聯邦上訴巡迴法院已經於判決中闡述，違反營業秘密罪的損害分析是為確定系爭商業秘密於公平市場的價值¹⁴。所謂公平的市場價值，意指在公開市場上，於正常、公平的買賣交易下，系爭營業秘密的支付方與賣出方能謀合成功的市場價格。換言之，美國《經濟間諜法》自頒佈施行以來，累計約有七十多起違反營業秘密罪的刑事案件¹⁵。就渠等案件的既遂情形，受害人往往主張實際遭受的損失，對照被告獲得不正當的經濟利益，此時的公平市場價值便發揮了一個提供法院參酌的功能。反之，在未遂的情形下，由於受害人尚未發生實際損害，或恐有遭受損害之虞，而被告也還沒能真正獲取酬勞或任何利益，法院僅對之科處刑罰的目的便在以預防被告實現營業秘密罪的行為，因此量刑會據以審酌被告對犯罪行為的主觀意圖，而不問客觀行為有否對被害人發生實質侵害¹⁶。職是，美國處罰違反營業秘密罪的行為，不限結果犯，行為犯亦為處罰對象。此與我國最高法院的見解不同。

二、U.S. v. Aleynikov案判決

美國聯邦第二巡迴上訴審法院於Aleynikov案判決要旨揭示¹⁷：《經濟間諜法》僅適用於涉及跨州或外國的商品資訊保護，推翻了下級法院認定被告離職前拷貝Goldman Sachs公司的資料侵害營業秘密。該案判決逆轉的理由指出系爭資料只供內部行政業務使用，且因其非能用於對外的商業交易而不具經濟價值。繼該案後，2012年美國國會迅速通過竊取商業機密釋明法案¹⁸，目的即在修正《經濟間諜法》中有關營業秘密所定義的文字內容，又其修正後的營業秘密為¹⁹：用於商品或其相關之服務上、或意圖使用於跨州或外國商務上的營業資訊，且為他人提供經濟上利益者屬之。該項修正條文，擴大了營業秘密的保護範圍，包括用於企業內部或提供協力廠商的服務資訊。換言之，美國現行聯邦法所指的營業秘密，不論用於企業內部或得為外部商業利用，亦不問國內或國外商務目的，只要與營業之產品或服務相關的資訊，且非能公開取得者皆屬本條保護之營業秘密。

13 U.S.S.G. § 2B1.1 cmt.

14 United States v. Williams, 50 F.3d 863 (10th Cir. 1995).

15 See <http://www.cybercrime.gov/iplaws.html>, visited on Dec. 6, 2013.

16 U.S.S.G. § 1A.1.

17 U.S. v. Aleynikov, 676 F.3d 71, 102 U.S.P.Q.2d 1458 (2d Cir. 2012).

18 Theft of Trade Secrets Clarification Act of 2012, S. 3642, 112th Cong. (2012).

19 U.S. v. Aleynikov, 676 F.3d 71, 102 U.S.P.Q.2d 1458 (2d Cir. 2012).

三、州法對於營業秘密的保護

美國各州對於營業秘密之相關規定旨在強調資訊的「機密性」，因此保護營業秘密主要有兩種方式：透過契約法和侵權法去制裁非法使用他人的智慧財產。誠然，在美國，營業秘密的相關法律乃立於非法使用他人智慧財產的基礎上演進發展而成，早期被併入第一版彙編的侵權行為法（the Restatement (First) of Torts）²⁰。其核心概念申明「商業道德與合理行為」（commercial morality and reasonable conduct）作為一個營業秘密通過不正當手段獲取的判斷標準。此所指的商業道德標準被大多數法院採用，爾後營業秘密被融併於不公平競爭法彙編第三版（the Restatement (Third) of Unfair Competition）。迨至1979年，美國統一營業秘密法（Uniform Trade Secrets Act; UTSA）草擬完成，並於1985年修訂²¹。美國多數州立法制定營業秘密法即是以USTA為藍本，如紐約州、北卡州等。當然，各州使用的法律語言及法條解釋可能彼此間略具差異²²。不論如何，美國多數州的營業秘密法參循了《美國統一營業秘密法》第7(b)節，並明文其不會影響或取代契約法上或刑事上的救濟，無論是否基於不法取用營業秘密或任何非關營業秘密竊用的民事救濟²³。

肆、營業秘密的民事責任

我國實務上審理營業秘密的民事案件，就法院如何判斷認事的標準而言，大致與美國法院所採相當，包括系爭資訊是否屬營業秘密、系爭資訊的取得方式、系爭資訊是否有保密措施、保密協定的簽署等方法。惟在保密協定的內容判斷上，稍有差異。以下分述說明：

一、我國法院裁判要旨

參照我國最高法院的民事判決要旨所揭，重點可以歸納：

(一) 營業秘密具經濟價值。按依營業秘密法第二條規定，得作為該法保護對象之營業秘密，固以具有秘密性（非一般涉及該類資訊之人所知）、經濟價值（因其秘密性而具有實際或潛在之經濟價值）、保密措施（所有人已採取合理之保密措施），且可用於生產、銷售或經營之資訊，始足稱之。惟同法第一條既規定：「為保障營業秘

20 Restatement (Third) of Unfair Competition § 39 (1995).

21 See <http://www.uniformlaws.org/LegislativeFactSheet.aspx?title=Trade%20Secrets%20Act>, Uniform Law Commission, Legislative Fact Sheet, visited on March. 6, 2013.

22 Norbrook Laboratories Ltd. v. G.C. Hanford Mfg. Co., 297 F.Supp.2d 463, 483 (N.D.N.Y. 2003).

23 UTSA § 7(b).



密，維護產業倫理與競爭秩序，調和社會公共利益，特制定本法」，是於判斷爭執之資訊是否符合上開營業秘密要件時，自應以第一條規定之立法目的為重要依據。若僅表明名稱、位址、連絡方式之客戶名單，可於市場上或專業領域內依一定方式查詢取得，且無涉其他類如客戶之喜好、特殊需求、相關背景、內部連絡及決策名單等經整理、分析之資訊，即難認有何秘密性及經濟價值；又市場中之商品交易價格並非一成不變，銷售價格之決定，復與成本、利潤等經營策略有關，於無其他類如以競爭對手之報價為基礎而同時為較低金額之報價，俾取得訂約機會之違反產業倫理或競爭秩序等特殊因素介入時，亦難以該行為人曾接觸之商品交易價格資訊逕認具有經濟價值，以調和社會公共利益。換言之，經由公開資訊取得客戶資訊，再寄發大量電子郵件行銷，始取得與國外客戶進行交易之機會，難認客戶名單有何秘密性，且不同時間或不同客戶會有不同報價，亦難認商品銷售價格有經濟價值²⁴。

(二) 非屬個人經驗習得之資訊。原審認定上訴人提供之金屬球塞加工圖紙及其上記載之材質、管材規格、替代管材、客戶代號、成品規格、模具編號、模具尺寸及擴束模等數據資訊，或為委託代工客戶所應提供，或為內部管理辨識編號，或為涉及管材加工二次成形業者依其經驗所輕易得知，均不具秘密性，而非營業秘密法第二條所稱之營業秘密²⁵。員工因工作經驗而獲致之成長並非出於雇主刻意培訓，而係員工個人於工作過程中所點滴累積之成果，乃員工個人之資產，除涉及智慧財產權、營業秘密等相關問題外，不應認為雇主就此有何應受保護之利益。林麥克、張淑青任職於上訴人，多年從事窗簾零配件之國際貿易實務，從中累積相當之知識、經驗。上訴人既未與渠等簽訂競業禁止約定，卻以渠等離職後與其從事價格競爭，逕而主張被上訴人構成侵權行為，實不可採。難認上訴人主張之損害與被上訴人之行為間有何相當因果關係存在²⁶。

(三) 保密契約的內容明確合理。企業於經營活動為保護自身之營業秘密，對於可能接觸營業秘密之人，經由保密契約，課以接觸者保密義務，並無不可，且其約定應保守之秘密，基於契約自由原則，固非必須與營業秘密法所定義之「營業秘密」完全一致，惟仍須具備明確性及合理性。上訴人與張淑青、林麥克間所約定之辭離職聲明：「保證無影印、抄寫公司文件、函電、設計圖樣、帳冊、客戶往來等資料，並保證不得洩漏在公司任職期間所知之秘密」等內容，非僅限於營業秘密法所定之

24 最高法院99年臺上字第2425號民事判決。

25 最高法院104年臺上字第1838號民事裁定。

26 最高法院104年臺上字第1654號民事判決。

營業秘密，惟至少仍須具備非一般周知之特性，且上訴人已採行防止第三人獲悉之保密措施者，始屬相當，應不得擴張解為上訴人之任何資訊，均在保密範圍。上訴人主張張淑青、林麥克離職後擅自使用其於任職期間所知悉之供應商報價資料等，違反辭職申請書之約定云云。然上訴人所提出之客戶名單內容僅有客戶名稱及國別，並未包含個別客戶之風格及消費偏好等資訊。且窗簾業界國際買家名稱、國別及聯絡方式等一般性資料，係交易市場上公開之資訊，任何人均可透過網路查詢、國際展覽取得之廠商名冊獲得相關資料。至於產品之報價或銷售價格，如不涉及成本分析，即屬替代性產品進入市場進行價格競爭時得自市場中輕易獲取之資訊，非必因受僱於產品之製造或銷售者，始得獲知之秘密。張淑青於離職前雖有於上訴人電腦瀏覽客戶名單及交易價格等資料，然上訴人並未能舉證證明張淑青、林麥克有影印、抄寫前開資料之情事。則上訴人主張張淑青、林麥克有違反上述辭職聲明之情事，即難憑採²⁷。

二、美國法院裁判要旨

美國法將「保守營業秘密」的要求視為僱傭契約內的一項競業禁止條款，亦即我國產業界俗稱的保密協定，其乃一般公司企業為保護營業秘密要求部分員工簽署的一份同意書。所以實務上要以裁斷有否構成違反保密協定時，要從契約法切入。按契約法講究衡平之法理，約因是關鍵；反競業條款簽署後，契約有否強制效力，應先以觀察二項要件：一是該項條款是否作為較大僱傭契約之一部，如併入原僱傭契約；或其構成另一份獨立的新僱傭契約。復按契約整體內容有否符合公平性，如上揭公司對於應負保密責任的員工提供相當的專業培訓、福利、薪資條件，同時也平等要求公司應履行某些責任義務。一旦約因被以充分滿足，保密協定即生法律效力。以下援引美國 Charles Creech Inc v. Brown案說明²⁸：

(一) 案情提要

本件原告兼上訴人 Charles T. Creech, Inc. (Charles) 以下簡稱C公司；被告兼被上訴人 Standlee Hay Company, Inc. (Standlee) 以下簡稱S公司；Donald E. Brown (Brown) 以下簡稱B。事實經過：緣 B在C公司任職16年後被要求簽署保密協定。2006年7月B簽署保密協定後不久，C公司將B調離了原工作崗位，薪資維持不變。2008年11月中旬，B從C公司辭職，並到C公司的競爭對手S公司工作。2009年2月16日，C公司控告B和S公司，尋求補償和懲罰性損害賠償、以及聲請禁制令的救濟。S公司和B則向法院答辯

²⁷ 同前註。

²⁸ Charles Creech Inc v. Brown, Nos. 2012-Sc-000651-Dg, 2012-Sc-000693-Dg (2014).



請求駁回C公司之訴狀與聲請。美國肯塔基州審判法院在2009年5月5日准核暫時性禁制令。S公司和B不服上訴；請求釋明禁制令、暫停訴訟期間禁制令的執行、廢棄禁制令的裁定。

肯塔基州上訴審法院在審判法院為禁制令釋明的同一天，准核了S公司暫停執行禁制令的救濟聲請。而C公司依照民事訴法第65.09條規定提出駁回S公司的救濟聲請，一併遭到上訴審法院拒絕。上訴審法院判決認定下級審法院核發暫時禁止令濫用裁量權，理由指出C公司的保密協定存有若干疑義。繼而上訴審法院駁回C公司的聲請，S公司和B旋即聲請簡易判決，主張上訴審法院准核渠等之救濟，爰此得請求簡易判決。審判法院於2011年3月28日准核S公司和B的聲請，並為S公司和B有利的判決。2011年4月4日，C公司不服上訴。上訴審法院撤銷原審簡易判決的作成，復於理由書中建議六個檢驗項目，用以裁斷系爭保密協定中非屬競業的部分是否具執行力。法院強調當事人有理由請求進一步的證據開示。S公司和B不服上訴。

上列上訴人等，即C公司、S公司、B，因不服中級上訴審法院之決定，爰向肯塔基州最高法院提起上訴，請求對上訴審法院的意見書為裁量審查。肯塔基州最高法院受理審查。

(二) 裁判意見

美國肯塔基州最高法院（以下簡稱本院）判決理由如下²⁹：

本件上訴中，C公司爭執：審判法庭過早准核簡易判決，即審判法庭依賴上訴審法院引用民事規則CR65.07的意見是錯誤的；因它仍保留了系爭保密協定中的反競業爭點，而法院忽視解決這些問題。此外，上訴審法院於意見書中要求的六個要素的檢驗並不適用肯塔基州法律，且將造成重大的不良後果。B和S公司主張：系爭保密協定的限制條款不具強制力，蓋其未明定地域範圍是關鍵性瑕疵；又審判法庭自為決定系爭合同中的地域限制非為恰當；再者，B簽署系爭保密協定時沒有充分構成交換的約因。同業工會意見則陳述：反競業合同屬於勞資關係的契約，應與業務銷售分別以觀；繼續工作不足以構成反競業合同；勞動契約中限制性規定的好處不能超越衡平法上的瑕疵；況且雇傭關係一旦開始，員工將受到該限制性條款未衡平的不利處境對待。因為我們認為系爭保密協定不構成充分約因，這也是本案中唯一我們提出的意見。

首先，各種關於約因的定義可見於相關論著書籍或司法裁判中。參照Luigart v. Federal Parquetry Mfg. Co.案裁判中對於「約因」的解釋：「一個利益於當事人的允諾，

29 Id.

或該允諾的作成對於相對方是一種損失或者侵害。此所謂利益對受雇者而言，係指允諾人對其允諾給予回報，以換取法律上他不具有的權利。而損害的意思，是指受諾人，回報允諾，放棄他原有可以行使的權利。」Phillips v. Phillips案供參。

C公司爭執，B繼續工作就構成了系爭保密協定的足夠約因。為支持其論點，C公司援引兩份裁判，分別為Higdon Food Service, Inc. v. Walker案和Central Adjustment Bureau, Inc. v. Ingram Associates, Inc.案。固然兩件案情都很突出但不具決定性。

如在Higdon案中，Walker（以下簡稱W）自1974年起開始為Higdon Food Service工作（以下簡稱H公司），他在那裡工作四年沒有簽任何雇傭合同。1978年，Higdon公司給W一份雇傭合同，內容載明「特此雇用」W作為銷售代表，H公司同意如期支付W業績傭金。合同中還明文只有當H公司善意真誠不再需要他的服務時，抑或者H公司善意確定他的服務不令人滿意時，才可以解雇W。該份合同的最後包含了反競業條款。W證述他沒有被威脅如果他沒有簽署合同者將會致使他喪失工作。然而，W相信他不簽署的話他便會遭到解雇。

1981年，W辭去H公司工作並跑去H公司競爭對手之一的公司工作。H公司提起強制執行合同的聲請，審判法院核准聲請並為H公司有利的裁判。嗣後，W上訴，上訴審法院撤銷原審裁定，理由係上訴審法院認定H公司在合同上未提供任何交換W簽立系爭合同的約因。

本院廢棄上訴審法院的決定。經查合同中，確實闡明瞭W的職務和補償，改變原勞資關係的條件，同如一份新的雇傭關係。又H公司沒有不得不雇用W，或者重新雇用W的急迫性，而這便足以構成系爭合同的約因。

再者，本院認為只有當H善意真誠不再需要他的服務時，抑或者H公司善意確定他的服務不令人滿意者，才可以解雇W的條款，締結了H公司應負的權利與義務，以作為W違約時法律的救濟。前述的權利與義務條款，足以作為成立系爭契約的充分約因。

反觀本案，上揭的要素於本案中沒有出現。是C公司對於換取B簽立系爭保密協定，除了甩開Charles Creech的女兒外，沒有提供任何約因；而C公司要求B簽立保密協定，既非雇用或重新雇用，更非屬一份雇傭契約的部分內容，而與Higdon案中的反競業條款有別。此外，系爭保密協定不能被解釋為C公司要「雇用」或「重新雇用」B，正因為該份保密協定並沒有包含任何雇傭契約具備的內容，即它並沒有說明B會做什麼工作或公司應支付給B多少薪金工資。換句話說，系爭保密協定沒有改變C公司和B之間原存在的雇傭關係條件，又其非屬一份新的雇傭契約。換言之，C公司對於B接受系爭保密協定，並沒有提供雇用或重新雇用B的約因。



況且，C公司也沒有承諾B：只有當C善意真誠不再需要他的服務時，抑或者C公司善意確定B的服務不令人滿意時，才可以解雇B的條款。誠如庭審口頭辯論時，不論B曾簽署了系爭保密協定或在簽署之後，C公司都能立即解雇他，不論出於任何原因或沒有原因。其與Higdon案系爭契約不同便係在於，對於雙方同時創設權利與義務；反之，本案系爭保密協定只對B科予義務，即B必須保守營業秘密並且日後辭職的三年內不得為競爭對手工作，但此非在提供B任何權利。職是，系爭保密協定賦予了C公司權利去保護其公司資產，卻防止B去找尋其他工作，而沒有對C公司科予任何義務。如斯，系爭保密協定沒有要求C公司放棄法律權利的行使，或者前項將導致C公司受有損害，故而約因不存在。

在Central Adjustment Bureau, Inc. v. Ingram Associates, Inc.案中，Central Adjustment Bureau（以下簡稱CAB公司）向美國各地客戶提供收貨服務。CAB的業務取決於銷售人員與客戶之間的服務滿意度。1971年3月22日，CAB雇用Preston Ingram（以下簡稱I），I在當天同時簽署了反競業契約。1975年9月8日，CAB雇用Kathleen Garrison（以下簡稱G），G在1975年11月12日簽署反競業契約。CAB在1975年4月1日，雇用了David Powers（以下簡稱P），P在1975年5月15日簽署反競業契約。1979年，前述的三名雇員全辭去CAB公司的工作，並成立了與CAB相互競爭的集貨服務公司。

CAB提起強制執行反競業條款之訴。審判法院發現系爭條款不具執行效力，因為員工被告知說，如果他們不簽，他們會被解雇。法院並不認為CAB給予I、G、P三人繼續工作的威脅足以構成契約的充分約因。（I、G、P三人上訴）

上訴審法院廢棄審判法院的決定。上訴審法院理由指出，系爭的雇傭契約有足夠的約因。首先，前述三名員工都是在開始為CAB公司工作不久後簽署保密協定。再者，反競業條款簽署後，所有的三名雇員都繼續工作好幾年。況且，所有的三名雇員都在工作期間受到加薪和晉升。此外，在簽署系爭契約後，所有的三名雇員都在集貨業務方面獲得專門知識、培訓和專業技能，這些不是他們可能取得的。該等因素導致法院得出結論，如果在簽署反競業條款的當下沒有約因，當員工辭職時約因便構成。儘管C公司反向爭執，CAB公司允許員工簽署協定後繼續工作，其亦非決定充分約因的唯一要件。

更遑論，本案與CAB案的情況至少有五個關鍵方面的差異。首先，CAB員工是在到職後數週內或幾個月內簽署保密協定。而B在簽署系爭保密協定前已經在C公司工作16年之久。第二，CAB員工在簽署協定後不久即獲取專門知識、訓練、專業技能，那些不是他們可以隨處獲取的專業技能。然本案中，B在C公司工作前就具備有乾草領域

的專業，這是不爭的事實。雖說B在C公司服務的16年期間獲取了客戶資料，然並沒有證據顯示C公司曾於B工作期間提供他任何專門訓練或專業技術。何況，沒有證據顯示B在簽完系爭保密協定後，從C公司獲取任何專門訓練或專業技術。第三，C公司在B簽署系爭保密協定後的工作期間並沒有給予加薪。第四，C公司非但沒有給B加薪還將他調離原職務去取代降薪，是否降職尚存疑義。最後一點，C公司不像CAB公司一樣，沒有威脅B不簽署系爭保密協定者，將會使之喪失工作。

揆諸本案沒有一絲連接H公司和CAB公司的關聯性，即反競業條款簽署後，其是否作為較大勞動契約的一部分，或另為一份獨立的契約文書（此二項乃觀察之要件），蓋當事人之間的僱傭關係已經發生了變化。如Higdon案中，W不再僅僅是可以被任意資遣的員工。在CAB案中，員工接受專門培訓，以及升遷、加薪等福利。而B在簽署保密協定後，他與C公司僱傭關係並沒有變化。B仍可能被任意資遣、沒有晉升、或加薪，也沒有獲取專門技能的培訓。簡言之，B再簽立系爭保密協定後，沒有收到C公司的約因以為交換。從而，系爭保密協定不具強制性。

據上，本院自無庸再處理當事人所提的其他爭點。肯塔基州最高法院爰此廢棄上訴審法院的決定；維持原審法院為B和S公司有利的簡易判決。

伍、結論

根據美國《經濟間諜法》的規定，侵害商業秘密罪處罰行為犯，行為人只要實施了《經濟間諜法》所明定之行為即犯罪要件構成，不問有無發生實質侵害結果。有論者研究指出違反營業秘密的罰金判處，法院係以商業秘密的公平市場價值作為量刑依據，美國的量刑指南足資供參。採此標準量刑，既可以確認受害人遭受的經濟損害，又可以發見被告的違法所得。然在未遂的共謀營業秘密罪中，法院可能以被告主觀上認識其所竊取的商業秘密價值去進行量刑。次就營業秘密的民事和刑事保護之目的不同，民事保護在使營業秘密的權利人回復未受侵害前的狀態，並且救濟其因營業秘密外洩所遭受經濟利益的損失；而刑事保護則是透過刑罰去制裁嚇阻渠等嚴重擾亂市場經濟秩序的行為，兼為防止竊用商業秘密的行為再發生，從而縱使原告尚未受有實質上的經濟損失，或者被告也沒有獲得任何經濟利益，法律也必須對於被告已經實施的侵害營業秘密之未遂行為給予處罰，值得我國借鑒參考³⁰。是以，美國法就侵害營業秘

30 參見宋建寶，美國侵犯商業秘密罪的量刑依據問題及借鑒——以美國《經濟間諜法》為中心，法律適用，第2期，2015年2月，頁49。



密之行為不若我國法院係採結果犯論處，又U.S. v. Aleynikov案判決後放寬了營業秘密的定義，不再糾結系爭資訊是否客觀上具經濟價值，只要能為第三方提供利益且系爭資訊的所有權人善盡保護措施，即能滿足機密特性之要件而落入應受保護之營業秘密範疇，以確實發揮刑事保護之目的效益。

又為避免觸犯營業秘密罪，我國政府相關部門也提供了許多營業秘密的保護措施與建議讓業者及個人參考，諸如³¹：一、公司內部應使員工瞭解營業秘密保護的重要性及法律責任。二、公司應告知並教育各部門主管落實善良管理人之注意義務。三、公司主管應警覺任何研發資訊的提供者對於具經濟利益的資訊來源取得是否合法、或擁有合法授權使用的證明，以避免涉入商業間諜案，而被課予法律責任。四、公司內部應制訂營業秘密保護之員工守則。五、個人方面則應瞭解未經公司同意，不將公司營業秘密洩漏予未經合法授權取得的任何人。六、個人應注意不將前公司之營業秘密用於現任職公司，特別已與前公司簽有保密協定者。退一步言，立於企業競爭者之角度思考，公司企業藉由雇用契約明定競業禁止條款或保密協定，去防止員工在職期間或離職後可能對公司的營業秘密造成侵害，雖屬不得不然之作法，惟工作契約，不論內已載明競業禁止條款或勞資雙方另簽署之保密協定，整體內容仍須符合公平合理，方能法律上有效。

31 See <http://www.careernet.org.tw/modules.php?name=csr&cat=1>, visited on Sept, 22, 2016.

陸、法學英文

一、原文裁判摘要

CHARLES CREECH INC v. BROWN

Supreme Court of Kentucky

CHARLES T. CREECH, INC., Appellant v.

Donald E. BROWN and Standlee Hay Company, Inc., Appellees

Donald E. Brown and Standlee Hay Company, Inc., Appellants v.

Charles T. Creech, Inc., Appellee

Nos. 2012–SC–000651–DG, 2012–SC–000693–DG

Decided: June 19, 2014

OPINION OF THE COURT BY JUSTICE KELLER

Standlee Hay Company, Inc. (Standlee), Donald E. Brown (Brown), and Charles T. Creech, Inc. (Creech) filed separate appeals from an opinion by the Court of Appeals reversing the trial court's summary judgment in favor of Brown and Standlee. Because the issues raised on appeal arise from the same facts, we address both appeals herein. Having reviewed the record and the arguments of the parties as well as the arguments by amici curiae—Greater Louisville Building and Construction Trades Council; International Brotherhood of Electrical Workers, Local 369; Kentucky AFL–CIO; Kentucky Jobs with Justice; Teamsters Local 783; United Auto Workers; and United Steelworkers of America (collectively the Unions)—we reverse the Court of Appeals.



I. FACTS.

The parties have conducted little, if any, discovery in this matter; therefore, we take our facts, most of which are not in dispute, from the parties' pleadings and the attachments to those pleadings.

Creech is engaged in the business of providing hay and straw to farms throughout Kentucky. Brown worked for Creech for eighteen years as a driver, dispatcher, and salesperson. In the summer of 2006, the daughter of Charles Creech, Creech's President, circulated a "Conflicts of Interests" agreement (the Agreement) for signature by Creech's employees. On July 20, 2006, Charles Creech asked Brown to sign the Agreement, which Brown did. We note that Brown states that, when Charles Creech presented him with the Agreement, he said that Brown needed to sign it in order to "get [Creech's] daughter off our backs." Creech stated that Brown signed the Agreement in consideration for his continued employment. The Agreement provided in pertinent part as

All proprietary information will be held in strict confidence. As an employee of Creech, Inc. you will have access to sensitive company, customer and supplier information. Such information has been obtained through the over 25 years that the company has been in business and is, therefore, the property of Creech, Inc. If at any time, either during employment or after leaving the company, you share such information with competitors of [sic] other third parties, Creech, Inc. reserves the right to pursue all legal avenues to recoup damages as well as legal fees accrued in such legal action from the employee or former employee.

The industries that Creech, Inc. operates within are highly competitive. We require that all employees agree and understand that after leaving the company they are not permitted to work for any other company that directly or indirectly competes with the company for 3 years after leaving Creech, Inc. without the companies [sic] consent.

Failure to comply with this policy during employment may result in immediate termination. In the event an employee or former employee violates this policy, the company will prosecute to the fullest extent of the law, including the recoup of legal expenses incurred during such prosecution, if it deems that its interests were not protected or appropriately respected by any of its employees.

I, Donnie Brown, understand and agree to abide by the above agreement, and if I know of any non-compliance with the agreement, I will report it to management in a timely fashion.

Brown signed the Agreement but no one from or on behalf of Creech signed the Agreement. No one from Creech told Brown that his continued employment was contingent on his signing the Agreement, and he did not receive any monetary consideration for signing the Agreement.

Shortly after Brown signed the Agreement, Creech transferred him from his job as salesperson to the job of dispatcher. This job change did not involve any change in salary but did result in Brown having decreased responsibilities and little to no direct customer contact.

In mid-November 2008, Brown resigned from Creech to take a job with Standlee, a producer and seller of hay and straw. According to Brown, before taking the job with Standlee, he met with Charles Creech and explained that the Standlee job would include selling Standlee's products to farm managers and others in Kentucky and surrounding states. Charles Creech agreed that he had a conversation with Brown about the Standlee job. However, Charles Creech stated that Brown said that he would only be selling Standlee products to "big box stores," a market in which Creech does not participate.

On November 13, 2008, counsel for Creech sent correspondence to Brown reminding him of the Agreement that he "signed when [he] became an employee of Charles T. Creech, Inc." Counsel indicated that, based on representations Brown made to Charles Creech, Creech was willing to waive the Agreement "only insofar as it prevents you from



being employed by Standlee.” Creech was not willing to waive any other provisions of the Agreement. Specifically, Creech demanded that Brown not use “any proprietary information gained during [his] employment with Creech to benefit the business pursuits of Standlee.” This prohibition included any disclosure of Creech's “client information, supplier information, business models, finances, business plans, or any other company records or company information” obtained by Brown during his employment with Creech.

On November 17, 2008, counsel for Standlee sent correspondence to counsel for Creech indicating that Standlee wanted to “make sure there are no misunderstandings about what [Standlee] expect[ed] from Mr. Brown.” By way of explanation, counsel for Standlee stated that Standlee intended “to set up a new LLC in Kentucky to deal with that end of their operations and that Mr. Brown [would] be an employee of this new LLC.” Brown would “act as a salesman contacting any and all of the horse farms in Kentucky and the surrounding states, in an effort to sell Standlee Hay products to those potential customers.” While Brown “may well contact people who [had] previously been customers of” Creech, he would not “focus on any customer due to the fact that they may have been customers of” Creech. It was Standlee's intent “to give Mr. Brown the list of horse farms in Kentucky, and the surrounding states, and to then send him out to contact these farms.” As to proprietary information, counsel assured Creech that Standlee had its own practices and policies and had no interest in any such information Brown might have. Finally, counsel asked for “your thoughts on these matters after you have reviewed this letter.” When no response to that letter was forthcoming, Standlee hired Brown, and Brown began selling Standlee hay and straw in Kentucky.

According to Charles Creech and a Creech employee, in January 2009 they heard from several of Creech's customers that Brown had contacted them on behalf of or sold them hay from Standlee. Charles Creech also stated that Standlee had “stolen” two of Creech's warehouse employees and that Brown had contacted one of Creech's suppliers. Brown offered Affidavits disputing some of the contentions made by Charles Creech in his Affidavit. In particular, the supplier stated that he contacted Brown and one of the former Creech employees stated that he contacted Standlee after he had been fired by Creech. The

other former employee stated that he demanded a raise and when Creech refused to give him one, he quit, and he then contacted Brown.

On February 16, 2009, Creech filed suit against Brown and Standlee, seeking compensatory and punitive damages and injunctive relief. In its complaint, Creech alleged that: the Agreement constituted a contract between Brown and Creech; Brown had breached that contract; Standlee had intentionally interfered with the contract between Creech and Brown; Standlee induced or aided and abetted Brown in breaching his contract with Creech; and Standlee intentionally interfered with Creech's existing and prospective business contracts. Creech sought compensatory and punitive damages and injunctive relief. Creech later amended its complaint to add allegations of common law fraud and breach of confidentiality.

Simultaneously with its initial complaint, Creech filed a motion for a temporary injunction, seeking to enjoin Brown and Standlee from directly or indirectly competing with Creech; from interfering with or contacting any of Creech's existing or potential customers; and from using any of Creech's trade secrets and confidential or proprietary information.

Standlee and Brown filed motions to dismiss Creech's complaint and responses to Creech's motion for injunctive relief. In its response/motion, Standlee argued that Creech waived any objection to Brown's employment in the November 13, 2008 letter. Furthermore, Standlee argued that, to the extent the November 13, 2008 letter did not waive any objection to Brown's employment, Creech's failure to respond to the November 17, 2008 letter waived any and all objections to Brown's employment.

In his response/motion, Brown argued that: he had not obtained any proprietary information while working for Creech; customer names and contact information were public information; he had received no consideration for signing the Agreement; Creech violated the Agreement when it transferred him from his job as a salesman to a job as a dispatcher; and the Agreement was void because it contained no geographical limitation. In its reply, Creech argued that the failure to set out a geographical limitation was not



fatal because Brown knew the extent of Creech's business and the court could supply a reasonable geographical limitation. Furthermore, Creech argued that any waiver in the November 13 letter was not a knowing waiver because Brown told Charles Creech that he would only be selling to “big box stores.” Finally, Creech argued that it had no duty to respond to the November 17, 2008 letter; therefore, its failure to do so could not equitably estop Creech from enforcing the Agreement.

The court conducted several hearings on the parties' motions and ultimately issued a temporary injunction on May 5, 2009. In doing so, the court found that: Brown's continued employment by Creech constituted consideration for the Agreement; Brown had obtained confidential and proprietary information while employed by Creech; Brown provided confidential and proprietary information to Standlee and both of them used that information in direct competition with Creech; Creech did not directly or indirectly waive the terms of the Agreement; Creech would suffer immediate and irreparable harm absent injunctive relief; the court had the equitable power to provide a geographical limitation; a reasonable geographical limitation was the Commonwealth of Kentucky; and, with that modification, the Agreement was enforceable. Based on those findings, the court enjoined Brown from directly or indirectly competing with Creech and from using or disclosing information regarding Creech's customers.

Creech then filed a motion “to Confirm Compliance with Court's Temporary Injunction.” In that motion, Creech argued that Brown continued to work for Standlee, which Creech believed violated the injunction. Both Brown and Creech filed responses to that motion admitting that Brown was employed by Standlee but stating that Brown was not working in a sales position. They both also filed in chronological order: notices of appeal, appealing the court's issuance of the injunction to the Court of Appeals; answers to Creech's amended complaint; counterclaims against Creech; and Kentucky Rule of Civil Procedure (CR) 65.07 motions for interlocutory relief in the Court of Appeals. Creech then filed answers to the counterclaims and a motion for summary judgment as to Brown's counterclaims. Standlee then filed a motion for clarification of the injunction.

The trial court held a hearing on June 24, 2009 and, on July 7, 2009, entered an order clarifying the injunction by stating that Brown: could continue to work for Standlee but he could not sell hay to any party in Kentucky; could not purchase hay from any party in Kentucky; could not purchase hay from any party outside of Kentucky for delivery to a party in Kentucky; and could not disclose any information he had obtained during his employment with Creech.

The Court of Appeals entered an Order Granting CR 65.07 Relief the same day the trial court entered its order of clarification. In its Order, the Court of Appeal's held that the trial court abused its discretion when it issued the temporary injunction. In doing so, the Court noted the following problems with the Agreement: it contained no geographical limitation, making it appear to be an unenforceable covenant in restraint of trade; Brown had been employed by Creech for 16 years before Creech presented him with the Agreement; Creech had not presented any evidence that it had expended any time, effort, energy, or money to train Brown; and Creech presented insufficient evidence to support its claim that Brown had obtained proprietary information. Creech then filed a CR 65.09 motion from the Court of Appeals's order, which this Court denied.

Following this Court's denial of Creech's CR 65.09 motion, both Standlee and Brown filed motions for summary judgment. In their motions, they essentially argued that, based on the Court of Appeals's order granting CR 65.07 relief, summary judgment was appropriate. Creech responded, arguing that the Court of Appeals's order was not binding and that case law supported its position. The trial court held a hearing on the summary judgment motions in February 2011 and entered an order granting both motions on March 28, 2011. On April 4, 2011, Creech filed a notice of appeal from that order.

The Court of Appeals reversed the trial court's summary judgment. In doing so, the Court proposed a six factor test that should be applied by the trial court in determining whether the non-compete portion of the Agreement is enforceable. The Court held that the parties were entitled to conduct additional discovery and that the trial court had to review Creech's claims in light of that six factor test. The Court also held that, as a matter of law, Brown's



continued employment with Creech constituted sufficient consideration to support the Agreement. Finally, the Court held that the parties were entitled to additional discovery regarding Creech's alleged waiver of the Agreement. Creech, Brown, and Standlee sought discretionary review of the Court's opinion, which we granted.

II. STANDARD OF REVIEW.

The standard of review on appeal of a summary judgment is whether the circuit judge correctly found that there were no issues as to any material fact and that the moving party was entitled to a judgment as a matter of law.” *Pearson ex rel. Trent v. Nat'l Feeding Sys., Inc.*, 90 S.W.3d 46, 49 (Ky.2002). Summary judgment is only proper when “it would be impossible for the respondent to produce any evidence at the trial warranting a judgment in his favor.” *Steelvest, Inc. v. Scansteel Serv. Ctr., Inc.*, 807 S.W.2d 476, 480 (Ky.1991). In ruling on a motion for summary judgment, the Court is required to construe the record “in a light most favorable to the party opposing the motion and all doubts are to be resolved in his favor.” *Id.* at 480. A party opposing a summary judgment motion cannot rely on the hope that the trier of fact will disbelieve the movant's denial of a disputed fact, but must present affirmative evidence in order to defeat a properly supported motion for summary judgment. *Id.* at 481.

III. ANALYSIS.

In its appeal, Creech argues that: the trial court prematurely granted summary judgment; the trial court's reliance on the Court of Appeals's CR 65.07 opinion was erroneous; it adequately preserved issues related to the nondisclosure portion of the Agreement and the Court of Appeals erred by not addressing those issues; and the six factor test in the Court of Appeals's opinion is not supported by Kentucky law and will create significant and unintended consequences. In their appeal, Brown and Standlee argue that: the Agreement is an unenforceable restraint on trade; the Agreement is fatally flawed because it contains no geographical limitation; the trial court impermissibly reformed the Agreement by providing a geographical limitation; and Brown did not receive adequate consideration

in exchange for signing the Agreement. The Unions argue that non-compete agreements in an employment setting should be treated differently from those involving the sale of a business; continued employment is not adequate consideration to support a non-compete agreement; the benefits of restrictive covenants in employment situations do not outweigh the equitable deficits; and employees are equitably disadvantaged by such covenants presented once employment has begun. Because we hold that this Agreement was not supported by adequate consideration, that is the only issue we address.

Various definitions of consideration are found in the text books and judicial opinions. In *Luigart v. Federal Parquetry Mfg. Co.*, 194 Ky. 213, 238 S.W. 758, 760, the term “consideration” is thus defined: “A benefit to the party promising, or a loss or detriment to the party to whom the promise is made. ‘Benefit,’ as thus employed, means that the promisor has, in return for his promise, acquired some legal right to which he would not otherwise have been entitled. And ‘detriment’ means that the promisee has, in return for the promise, forborne some legal right which he otherwise would have been entitled to exercise.”

Phillips v. Phillips, 294 Ky. 323, 171 S.W.2d 458 (Ky.1943).

Creech argues that Brown's continued employment was sufficient consideration to support the Agreement. In support of its argument, Creech relies primarily on two cases—*Higdon Food Service, Inc. v. Walker*, 541 S.W.2d 750 (Ky.1982) and *Central Adjustment Bureau, Inc. v. Ingram Associates, Inc.*, 522 S.W.2d 581 (Ky.App.1981). Both cases are distinguishable and neither is dispositive.

In *Higdon*, Walker began working for Higdon Food Service (*Higdon*) in 1974 and worked there for four years without an employment contract. 541 S.W.2d at 751. In 1978, *Higdon* presented Walker with an employment contract stating that “*Higdon* ‘hereby employs’ Walker ‘as a sales representative’ and agrees to pay him according to a schedule of commissions.” *Id.* at 752. The contract also provided that Walker could only be discharged if *Higdon* determined in good faith that it no longer needed his services, or if *Higdon*



determined in good faith that his services were not satisfactory. *Id.* Finally, the contract contained a non-compete clause. *Id.* Walker testified that he was not threatened with loss of his job if he did not sign the contract. However, Walker believed he would have been fired if he had not done so. *Id.* at 751.

In 1981, Walker quit his job with Higdon and went to work for one of Higdon's competitors. Higdon sued to enforce the non-compete provision of the contract, and the trial court found in Higdon's favor. *Id.* at 751. The Court of Appeals reversed, finding that Higdon had not provided any consideration to Walker in exchange for his signature on the contract. *Id.*

This Court reversed. In doing so, the Court noted that the contract, which spelled out Walker's position and compensation, altered the terms of the employment relationship and “was the same as a new employment.” *Id.* at 751. Because Higdon was not compelled to keep Walker as an employee or to “rehire” Walker, the fact that it did so was sufficient consideration to support the contract. *Id.* at 752.

Furthermore, the Court held the provision that Walker could only be discharged if Higdon found in good faith that his work was unsatisfactory or that he was no longer needed, created “rights and obligations for breach of which there was a remedy at law.” *Id.* The creation of these rights and obligations was sufficient consideration to support the contract. *Id.* at 752.

None of the preceding factors are present here. Creech offered nothing to Brown in exchange for his signature on the Agreement except to get Charles Creech's daughter “off their backs.” Creech did not, by way of the Agreement, hire or rehire Brown because the Agreement, unlike the non-compete provision in Higdon, was not part of an employment contract. Furthermore, the Agreement cannot be construed as Creech “hiring” or “rehiring” Brown because the Agreement does not contain any of the indicia of an employment contract, i.e. it does not state what job Brown would be doing or what salary or wages Brown would be paid. In other words, the Agreement did not alter the terms of the employment relationship between Creech and Brown and was not “the same as new

employment.” Thus, Creech did not provide consideration to Brown by hiring or rehiring him based on his acceptance of the Agreement.

Furthermore, Creech did not promise Brown that he could only be discharged following a good faith finding by Creech that his work was unsatisfactory or that his services were no longer needed. As noted during oral arguments, immediately before Brown signed the Agreement, Creech was entitled to fire him for any reason or no reason and immediately after Brown signed the Agreement, Creech was entitled to fire him for any reason or no reason. Unlike the employment contract in *Higdon*, which created rights and imposed obligations on both parties, the Agreement herein imposed obligations on Brown—to maintain confidentiality and to refrain from working for a competitor for three years after resigning—but did not provide Brown with any rights. Furthermore, the Agreement gave Creech the right to protect certain assets and to keep Brown from seeking alternative employment but imposed no obligations on Creech. Because the Agreement did not require Creech to forbear the exercise of some legal right or otherwise result in some detriment to Creech, there was no consideration.

In *Central Adjustment Bureau, Inc. v. Ingram Associates, Inc.*, Central Adjustment Bureau (Central) provided collection services to customers throughout the United States. 622 S.W.2d. at 683. Central's business depended on “satisfactory personal contact between its sales and collection employees and its clients.” *Id.* Central hired H. Preston Ingram on March 1, 1971, and he signed a covenant not to compete on March 22, 1971. Central hired Kathleen Garrison on September 8, 1975, and she signed a covenant not to compete on November 12, 1975. Central hired David Powers on April 1, 1975, and he signed a covenant not to compete on May 15, 1975. In 1979, all three employees resigned from Central and started a competing collection service company. *Id.*

Central filed suit seeking to enforce the covenants. The trial court found that the covenants were not enforceable because the employees had been advised that, if they did not sign, they would be fired. The court was not convinced Central's continued employment of the three following that threat was sufficient consideration to support the covenants. *Id.*



The Court of Appeals reversed. In reversing, the Court of Appeals noted several factors that indicated there had been sufficient consideration. First, the Court noted that all three employees signed the covenants shortly after they started working for Central. Second, the Court noted that all three employees continued to be employed for a number of years. Third, the Court noted that all three employees received raises and promotions while employed at Central. Fourth, the Court noted that, after signing the covenants, all three employees “acquired specialized knowledge, training, and expertise in the collection business which they might not have otherwise acquired.” *Id.* at 686. These factors led the Court to conclude that, if there was no consideration when the covenants were signed, there was when the employees resigned. *Id.* Thus, Creech's argument to the contrary notwithstanding, the fact that Central permitted the employees to continue working after they signed the covenants was not the only factor the Court considered in determining the sufficiency of consideration.

Furthermore, this case differs considerably from Central Adjustment Bureau in at least five crucial ways. First, in Central Adjustment Bureau, the employees signed the covenants within several weeks to several months after being employed. Here, Brown had worked for Creech for sixteen years before he signed the Agreement. Second, after the employees in Central Adjustment Bureau signed the covenants, which they did early in their employment, they acquired specialized knowledge, training, and expertise they would not have otherwise acquired. Here, it is undisputed that Brown had significant experience in the hay business before he began working for Creech. While there is evidence that Brown obtained information regarding Creech's customers during the sixteen years he worked for Creech before signing the Agreement, there is no evidence that Creech provided any specialized training or expertise to Brown during that time period. Furthermore, unlike in Central Adjustment Bureau, there is no evidence that Brown gained any specialized knowledge, training, expertise, or customer information after he signed the Agreement. Third, Creech did not give Brown any raise during the months he worked after signing the Agreement. Fourth, Creech did not promote Brown but took away responsibility and, while not decreasing his salary, arguably demoted him. Finally, Creech, unlike Central, did not threaten Brown with loss of his job if he did not sign the Agreement.

There is a common thread running through both Higdon and Central Adjustment Bureau—after the non-compete provision was signed, whether as part of a larger employment contract or as a stand-alone document, the employment relationship between the parties changed. In Higdon, Walker became more than simply an at-will employee. In Central Adjustment Bureau, the employees received specialized training as well as promotions and increased wages. After Brown signed the Agreement his employment relationship with Creech did not change. He remained an at-will employee with no promotion, no increase in wages, and no specialized training. In short, Brown received no consideration from Creech in exchange for signing the Agreement or after he signed the Agreement. Therefore, the Agreement is not enforceable.

Based on the preceding, we need not address the other issues raised by the parties.

IV. CONCLUSION.

For the foregoing reasons, we reverse the Court of Appeals and reinstate the trial court's summary judgment in favor of Brown and Standlee.

二、實用法律詞彙

1. amici curiae (單數形amicus curiae)：拉丁文，法庭之友；指為案件的系爭爭點陳述實務意見並善意提醒法院注意某些法律問題的社會公正人士，以協助法院釐清案件事實。
2. 起因於：arise from
3. 委員會、工會組織：council
4. 同業工會：brotherhood
5. 爭執：dispute
6. 請求：pleading
7. 派送員：dispatcher
8. 相關的：pertinent
9. 所有權的、專屬的：proprietary
10. 補償：recoup



11. 服從遵守：comply with
12. 契約條款：covenant
13. 約束：restraint
14. 招致、惹起：incur
15. 視為：deem
16. 適當的、相稱的：appropriate
17. 遵守：abide by
18. 順從：compliance
19. 代表：on behalf
20. 金錢方面的：monetary
21. 辭職：resign
22. 訴訟律師：counsel
23. 通信：correspondence
24. 放棄：waive
25. 規定、條款：provision
26. 揭露、開示：disclosure
27. 執行業務：practice
28. 即將到來的：forthcoming
29. 宣誓書：affidavit
30. 補償、賠償性的：compensatory
31. 宣稱：allege
32. 構成：constitute
33. 違背、破壞：breach
34. 妨礙、介入幹預：interfere with
35. 勸誘：induce
36. 教唆：abet
37. 同步、同一時間：simultaneous
38. 命令、禁止：enjoin
39. 機密性的：confidential
40. 無效：void
41. 關鍵性、致命性的：fatal

42. 禁止(翻供) : estop
43. 不可修補的 : irreparable
44. 按時間順序 : chronological
45. 中間程式 : interlocutory
46. 裁量 : discretion
47. 強制執行 : enforce
48. 立書約定 : covenant
49. 拘束 : restraint