



# Three Things Every In-House Counsel Should Know About...

Tuesday, May 2, 2023

PIERCE ATWOOD 



# Employment Law

with Katherine Porter

PIERCE ATWOOD 

## Misclassification of Workers

- Independent contractors v. employees
- Non-exempt versus exempt employees
- *Consequences*: wage claims, benefit claims, fines/penalties
- *When this comes up*:
  - › Transactions – buyer’s counsel and underwriters focus on classification and potential wage claims
  - › Governmental agency inquiries
  - › Employee claims

## Addressing Performance:

- *Dos*
  - › Document performance
  - › Share feedback with employees
- *Don'ts*
  - › Managers should be careful not to overdo documentation
  - › Talk to your managers about written communications – if there is no business purpose, best left unsaid
- Consider different performance management options:
  - › Performance Improvement Plans/Development Plans
  - › Trainings
  - › Performance coaches

## Restrictive Covenants

- Non-competes:
  - › They are coming under fire and the drafting/enforcement bar is getting higher
- Other restrictive covenants can achieve a similar result:
  - › Confidential information (with carve outs)
  - › Non-solicitation
  - › Intellectual property
  - › Notice periods
- Need to periodically revisit restrictions to make sure they are protective
- Tailor restrictions to each employee



# Presenter

Katherine L. Porter  
kporter@pierceanwood.com

Merrill's Wharf  
254 Commercial Street  
Portland, ME 04101

PH / 207.791.1212



# Litigation and Disputes

with Katherine Kayatta

PIERCE ATWOOD 

## Litigation

1. Litigation hold notices – when do you need one?
2. Incoming subpoena – now what?
3. Review your consumer communications & contracts.



## Duty to Preserve

- When the duty to preserve arises, counsel must take steps to protect relevant data in a *legally defensible* manner.
- Litigation Hold Notice.
  - › Designed to suspend any routine procedures of destruction of relevant data and maintain relevant data.
  - › Data = paper files, e-mails, voicemails, texts, other electronically stored data.
  - › Requires preservation of relevant data and documents within an entity's/employee's control.
  - › Consider issues relating to modification of existing data.

## Triggering Events

- When a party “reasonably anticipates litigation.”
- Complaint.
- Subpoena.
- Demand letter.
- Civil investigation.
- Government inquiry.
- Administrative agency proceeding.
- Arbitration demand.
- Notice from opposing counsel requesting preservation

## What to preserve?

- Relevant information.
- Information likely to be sought by your adversary.
- Information helpful to your adversary's case.
- Information in your client's possession, custody and control – can include third parties!

## Litigation Hold Notice

- What should it cover?
- Clear message – do not destroy!
- Time period at issue.
- Explain what must be preserved.
- Give examples of where such information may be found, and in what medium.
- Explain maintenance in original form v. modification.
- Inform recipients of legal obligation.
- Inform recipients of possible penalties.
- Provide contact information for recipients.
- Acknowledgement/return copy.

# Custodian Questionnaire

Name: \_\_\_\_\_  
Title: \_\_\_\_\_  
Phone: \_\_\_\_\_  
Email: \_\_\_\_\_

**Purpose: investigation to ascertain use and practices concerning company computer hard drives, personal email accounts and other devices.**

Please check "yes" or "no" in response to the following questions:

- (1) Have you ever saved any work related document to your work computer hard drive (as opposed to a shared server)?  
Yes \_\_\_\_\_ No \_\_\_\_\_
- (2) Have you ever performed company-related work on a personal computer, laptop, or tablet?  
Yes \_\_\_\_\_ No \_\_\_\_\_
- (3) Have you ever saved any company-related work document to a personal computer hard drive, personal flash drive, or personal tablet hard drive?  
Yes \_\_\_\_\_ No \_\_\_\_\_
- (4) Have you ever used a personal email account (Gmail, Yahoo, Hotmail, etc.) for work purposes or to conduct company business?  
Yes \_\_\_\_\_ No \_\_\_\_\_
- (5) Have you ever used text or instant messaging on any personal device, such as a computer, tablet or mobile phone?  
Yes \_\_\_\_\_ No \_\_\_\_\_
- (6) Have you ever used text or instant messaging on any personal device, such as a computer, tablet, or mobile phone, to conduct company business?  
Yes \_\_\_\_\_ No \_\_\_\_\_

## Compliance

- One notice is not enough for ongoing litigation.
- Routinely reissue notice as a reminder.
- Non-routine update and reissue when:
  - › New information learned in discovery.
  - › New custodians discovered.
  - › Departure of existing custodians.

## Incoming subpoena – now what?

- Do I have a legal obligation to respond?
- Should I object or move to quash?
- Implement litigation hold.
- Confidentiality concerns.

## Review of consumer communications and contracts

- Different forms for different states?
- Conflict of laws.
- Arbitration clauses.
- Class action waivers.





# Presenter

Katherine S. Kayatta

[kkayatta@pierceatwood.com](mailto:kkayatta@pierceatwood.com)

Merrill's Wharf  
254 Commercial Street  
Portland, ME 04101

PH / 207.791.1105



# Intellectual Property Rights

with Michael Hernandez

PIERCE ATWOOD 

## Introduction

- **IP: intangible assets embodied in tangible assets**
- **Four Forms of IP:**
  1. Patents
  2. Trade Secrets
  3. Trademarks
  4. Copyrights
- **IP is often the most-valuable asset of a company. See <https://oceantomo.com/intangible-asset-market-value-study/>.**

## Key Trademark Insights

- **Selection strategy**
  - › Tension within spectrum of distinctiveness
  - › Scope of protection
- **Clear before you invest**
  - › Risk of controversy
  - › Risk of infringement
  - › Chances of registration
- **Establish and protect your rights**
  - › Unregistered marks are protectable in the United States
  - › If appropriate, seek registration for additional benefits
  - › Diligently enforce and license your rights

## Other IP Takeaways

- **Lock-down IP ownership issues**
  - › Proper assignments of work
  - › Deliverables and underlying IP
- **Copyrights**
  - › Registration not necessary, unless filing claim for infringement
  - › Educate business on reusing images from Internet without a license
- **Patents**
  - › No protection unless and until patent issues
- **Trade secrets**
  - › Dependent on protection of confidential information



# Presenter

Michael C. Hernandez  
mhernandez@pierceatwood.com

Merrill's Wharf  
254 Commercial Street  
Portland, ME 04101

PH / 207.791.1168



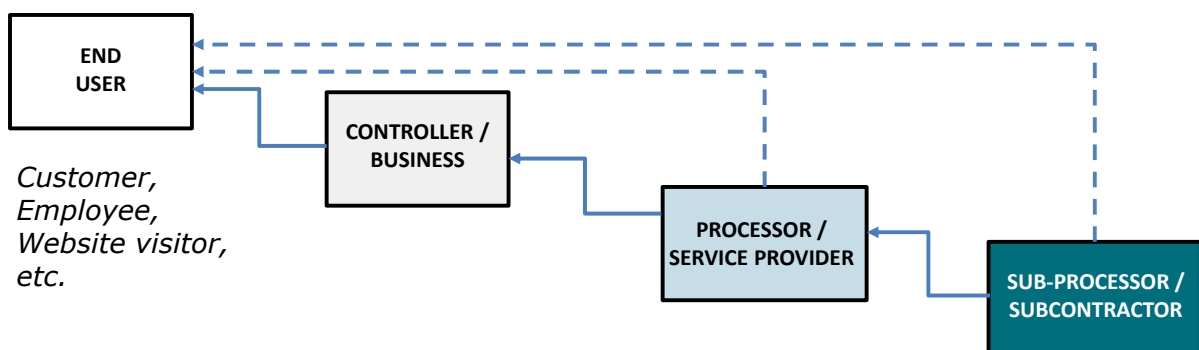
# Privacy and Data Security

with Vivek Rao

PIERCE ATWOOD 

## “Controller”-“Processor” Dynamic

- Identify your company’s role(s) in relation to the personal data it handles.



- › If *controller*, your downstream data processors and your contract terms with them will be critical to your complying with your legal obligations and managing your risk.
- › If *processor*, your risk profile and compliance obligations will depend on the context in which your upstream controller customers uses those services/solutions.



## Data Protection by Design

- Privacy and data protection as a proactive and default mode of operation, not merely reactive to data breaches and regulatory changes.
  - › Product development
    - Privacy awareness on development teams.
    - Diagram of anticipated data flows early in design/development cycle.
    - Outline of privacy notice (or anticipated “upstream” requirements) early on in design/development cycle.
  - › Procurement of third-party services/solutions
    - Data security controls, certifications and audits.
    - Contractual indemnities and liability caps.
    - Transparency regarding nature/extent of processing.
    - Cooperating in managing data subject rights.
    - Management of “upstream” and “downstream” considerations.

## Compliance Roadmap

- Maintain and update a data compliance roadmap that takes into account changing data flows and evolving legal requirements.

HISTORICAL APPROACH TO U.S. DATA PROTECTION REGULATION	NEW WAVE OF U.S. DATA PROTECTION REGULATION
<ul style="list-style-type: none"><li>• State data breach notification laws</li><li>• Federal data protection laws in specific industries<ul style="list-style-type: none"><li>• HIPAA</li><li>• GLBA</li><li>• FERPA</li><li>• FCRA</li></ul></li><li>• Laws regulating certain contexts<ul style="list-style-type: none"><li>• COPPA</li><li>• TCPA</li><li>• CAN-SPAM</li></ul></li><li>• Regulation of “unfair or deceptive” practices</li></ul>	<ul style="list-style-type: none"><li>• Restrictions on processing of sensitive data</li><li>• Restrictions on processing associated with sale, behavioral advertising, profiling, automated decision-making</li><li>• Expanded consumer rights</li><li>• More specific transparency/notice requirements</li><li>• Contracting requirements</li><li>• Other requirements relating to –<ul style="list-style-type: none"><li>• purpose limitation</li><li>• proportionality and minimization</li><li>• data security</li><li>• privacy impact assessment</li></ul></li></ul>



# Presenter

Vivek J. Rao

[vrao@pierceatwood.com](mailto:vrao@pierceatwood.com)

Merrill's Wharf  
254 Commercial Street  
Portland, ME 04101

PH / 207.791.1171