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Discovery Sharing in Texas: Litigant Confidentiality v. Litigation Costs

Dustin B. Benham*

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I. INTRODUCTION

Texas courts have long allowed discovery sharing between similar cases.¹ Discovery sharing has a multitude of systemic benefits—not the least of which is reducing pretrial litigation costs.² Despite these

*Associate Professor of Law, Texas Tech University School of Law. Thanks to Lonny Hoffman, Rory Ryan, Meryl Benham, and Lisa Hobbs for their thoughts and comments on earlier versions of this work. Thanks also to Jamie Baker for her research assistance. Special thanks to my research assistants, Jake Rutherford and Catharine Hansard, for their excellent citation work.

¹See *Garcia v. Peeples*, 734 S.W.2d 343, 348 (Tex. 1987).

²See, e.g., Dustin B. Benham, *Proportionality, Pretrial Confidentiality, and Discovery Sharing*, 71 WASH. & LEE L. REV. 2181, 2229 (2014) (describing the efficiencies of discovery sharing); see also MANUAL FOR COMPLEX LITIGATION (FOURTH) § 11.432 (2004) (endorsing sharing).

advantages, some contend that the Supreme Court of Texas should forbid the practice in cases involving trade secrets.³ But the court should not limit discovery sharing—doing so would run contrary to Texas’s efforts to reduce undue litigation expenses.⁴

Discovery sharing is prevalent in product-liability cases involving nationally distributed products.⁵ Indeed, recent media coverage of the GM defective-ignition crisis (and GM’s surprising simultaneous attack on sharing at the supreme court) has highlighted the war over discovery sharing in Texas.⁶ Sharing’s widespread use in products cases is not surprising: identical products (if defective) tend to injure people similarly across the products’ distribution area. Attorneys representing those injured people tend to be interested in similar information across cases—the product design, design and manufacturing processes, safer alternative designs, and information surrounding the manufacturing company’s knowledge of the defect.⁷

Discovery sharing allows these attorneys, representing people with similar claims against common or related defendants, to avoid reinventing the wheel.⁸ Put simply, attorneys and parties in a sharing system reuse the

³ See, e.g., Brief of Amicus Curiae Alliance of Automobile Manufacturers in Support of Relator’s Petition for Writ of Mandamus at 2, *In re Gen. Motors, LLC*, No. 13-0794 (Tex. Aug. 8, 2014, *pet. dismissed*), 2014 WL 3898459 [hereinafter *Automobile Manufacturers’ Amicus Brief*] (former Supreme Court of Texas Chief Justice Wallace B. Jefferson, as counsel, contending that Texas’s qualified trade secret privilege limits sharing in trade secret cases); cf. also *Zappe v. Medtronic USA, Inc.*, No. C-08-369, 2009 WL 792343, at *1 (S.D. Tex. Mar. 23, 2009) (approving a non-sharing order in a case involving trade secrets based on a reading of post-*Garcia* (Texas’s seminal sharing decision) case law as overruling *Garcia*).

⁴ See, e.g., TEX. R. CIV. P. 169 cmt. 1 (explaining 2013’s legislature-directed rule changes to reduce pretrial cost burdens in certain civil cases); 3 ROY W. McDONALD & ELAINE A. GRAFTON CARLSON, TEXAS CIVIL PRACTICE § 13:2 (2d ed. 2014) (highlighting 1999 discovery reform efforts meant to streamline pretrial practice).

⁵ See Gary L. Wilson, Note, *Seattle Times: What Effect on Discovery Sharing?*, 1985 WIS. L. REV. 1055, 1055 (1985).

⁶ See Sue Ambrose, *Could Texas’ High Court Curb Trade-Secret Sharing in Safety Lawsuits?*, DALL. MORNING NEWS (Apr. 18, 2015), <http://www.dallasnews.com/news/metro/2015-04-18-experts-expect-attempt-to-curb-trade-secret-sharing-in-suits.ece>.

⁷ Cf., e.g., FRANCIS H. HARE, JR. ET AL., CONFIDENTIALITY ORDERS 69–70 (1988) (discovery often “must be repeated anew” as a result of repeating information needs).

⁸ E.g., Arthur R. Miller, *Confidentiality, Protective Orders, and Public Access to the Courts*, 105 HARV. L. REV. 427, 497 (1991) (“Barring sharing smacks too much of requiring each litigant to reinvent the wheel.”).

discovery information obtained in previous cases to avoid wasteful rediscovery.

Someone not familiar with the issue might wonder, “What could possibly be wrong with sharing information between similar cases? Isn’t that commonsense?” But despite its somewhat obvious appeal as a cost-saving measure, discovery sharing often runs head on into another important interest in pretrial discovery: the protection of proprietary information.⁹

Litigants routinely ask courts to enter orders to limit the dissemination of competitively sensitive discovery information (like product designs).¹⁰ They putatively do so, at least in part, to keep the information from competitors.

Sharing proceeds on the theory that the practice does not hamper the competitive value of discovery information shared only among non-competitor litigants.¹¹ If the audience for discovery information is limited to similar litigants, the reasoning goes, the value of the proprietary or trade secret information remains intact.¹²

But those who oppose sharing contend otherwise—sharing trade secrets, even among non-competitors, increases the risk of inadvertent or intentional disclosure to competitors by sharing attorneys and litigants.¹³ Moreover, according to some of these voices, sharing violates Texas’s qualified trade secret privilege by allowing collateral litigants to receive information without demonstrating that the information is necessary in their *particular* cases.¹⁴

⁹See *Garcia v. Peeples*, 734 S.W.2d 343, 345–47 (Tex. 1987) (balancing trade secret holder’s interest against the “public policies favoring the exchange of information”); see also, e.g., Richard P. Campbell, *The Protective Order in Products Liability Litigation: Safeguard or Misnomer?*, 31 B.C. L. REV. 771, 824–25 (1990) (opposing discovery sharing for, among other reasons, its potential to undermine the value of proprietary information).

¹⁰See, e.g., Dustin B. Benham, *Dirty Secrets: The First Amendment in Protective-Order Litigation*, 35 CARDOZO L. REV. 1781, 1784 (2014) (describing the frequent use of protective orders in civil litigation to protect proprietary discovery information).

¹¹See, e.g., *Garcia*, 734 S.W.2d at 348 (holding that trial court should have balanced competing needs for information by sharing litigants against producing party’s interest in preventing dissemination to competitors).

¹²See *id.*

¹³See, e.g., Campbell, *supra* note 9, at 824–25 (contending that discovery sharing increases risk of disclosure of competitively sensitive information).

¹⁴*Cf.*, e.g., *Wal-Mart Stores E., L.P. v. Endicott*, 81 So. 3d 486, 490 (Fla. Dist. Ct. App. 2011).

This Article is the first piece of scholarship to evaluate these arguments in light of historic and recent efforts to make Texas and federal pretrial procedure more efficient. After evaluating both pro- and anti-sharing positions, the Article concludes that sharing furthers pretrial efficiency without unduly compromising trade secret and other confidential information.

The Article proceeds in four parts. First, it examines the development of discovery sharing as a routine practice. Second, the Article considers some common arguments against discovery sharing. Third, it briefly examines the relationship between sharing and efforts to reduce pretrial costs, both in the Texas and federal court systems. Finally, the Article contends that sharing is a practice that both reduces costs and is compatible with litigants' proprietary-information interests, even in cases involving trade secrets.

II. THE DEVELOPMENT OF DISCOVERY SHARING

The story of discovery sharing and the story of protecting trade secrets in discovery have been intertwined from the beginning.¹⁵ This entanglement comes from a practical reality in product-liability cases: parties simultaneously allege that the design of the product is both dangerous and a trade secret.¹⁶ Indeed, plaintiffs seeking to prove that a dangerous product caused injury send over volleys of discovery requests for the product's design as proof of its danger.¹⁷ The party resisting these requests (typically the defendant) often contends that the product's design is a privileged trade secret.¹⁸

¹⁵ See, e.g., *Garcia*, 734 S.W.2d at 344–45, 348 (entering non-sharing protective order was abuse of discretion in a trade secret case); cf. also, e.g., Laurie Kratky Doré, *Secrecy by Consent: The Use and Limits of Confidentiality in the Pursuit of Settlement*, 74 NOTRE DAME L. REV. 283, 364–65 (1999) (recognizing that “injury to a cognizable privacy or property interest” can weigh against discovery sharing).

¹⁶ In another typical version, a corporate defendant alleges that its practices constitute trade secrets while a plaintiff alleges that those same practices were injurious. See, e.g., *Endicott*, 81 So. 3d at 488.

¹⁷ See, e.g., *Raymond Handling Concepts Corp. v. Superior Court*, 45 Cal. Rptr. 2d 885, 885–86 (Cal. Ct. App. 1995) (assessing protective order in case involving designs of an allegedly injurious forklift); *Garcia*, 734 S.W.2d at 344–45.

¹⁸ See, e.g., *Garcia*, 734 S.W.2d at 344–46.

Courts and litigants facing this fight often compromise.¹⁹ Instead of denying discovery of product designs (undoubtedly vital proof in many products cases), courts typically allow discovery of the information subject to a “protective order.”²⁰ These protective orders vary in their particulars, but in general they limit the audience for the discovery information at stake to something less than the general public.²¹ For instance, a protective order might restrict discovery access to just the parties and attorneys in the particular case (a “non-sharing” protective order).²² In contrast, a more lenient order might allow access for individuals in similar cases (a “sharing” protective order).²³

Note that in both versions, the protective orders’ audience limitation implicitly excludes product-producing competitors (who are corporations that will almost certainly not be injured physically by a competing product and therefore are unlikely to be “similar” litigants).²⁴ And many protective orders exclude competitors with language that expressly declares that discovery information shall not be shared with competitors, even if they are in similar litigation.²⁵

¹⁹ See, e.g., *United Nuclear Corp. v. Cranford Ins. Co.*, 905 F.2d 1424, 1427 (10th Cir. 1990) (recognizing that stipulated protective orders are common).

²⁰ *Id.* But see, e.g., *In re Bass*, 113 S.W.3d 735, 745–46 (Tex. 2003) (denying discovery of trade secret information where party failed to establish that the information was necessary proof in case); *In re Cont’l Gen. Tire, Inc.*, 979 S.W.2d 609, 615 (Tex. 1998) (same).

²¹ See FED. R. CIV. P. 26(c)(1)(G) (allowing courts to limit the audience for discovery materials); TEX. R. CIV. P. 192.6 (same).

²² See, e.g., *Long v. TRW Vehicle Safety Sys., Inc.*, No. CV-09-2209-PHX-DGC, 2010 WL 1740831, at *1–2 (D. Ariz. Apr. 29, 2010) (denying request for sharing provision in otherwise agreed protective order); see also, e.g., David Timmins, Note, *Protective Orders in Products Liability Litigation: Striking the Proper Balance*, 48 WASH. & LEE L. REV. 1503, 1509 (1991) (“[A] protective order may create absolute restrictions on disclosure, meaning that a protective order allows no dissemination beyond the parties themselves.”).

²³ See, e.g., *Raymond Handling Concepts Corp. v. Superior Court*, 45 Cal. Rptr. 2d 885, 886 (Cal. Ct. App. 1995) (upholding a trial court’s protective order providing that “plaintiffs counsel may disclose said discovery so designated as confidential to counsel in other pending similar litigation”).

²⁴ Cf. *Pincheira v. Allstate Ins. Co.*, 190 P.3d 322, 337 (N.M. 2008) (noting that “sharing among other litigants and witnesses” is often appropriate where those sharing the information “are not competitors of the [producing] defendant”).

²⁵ See, e.g., *Garcia v. Peeples*, 734 S.W.2d 343, 348 (Tex. 1987) (“Out of an abundance of caution, the trial court, after determining which documents are true trade secrets, can require those wishing to share the discovered material to certify that they will not release it to competitors or others who would exploit it for their own economic gain.”).

By excluding competitors, these orders protect the value of product-design information.²⁶ Indeed, trade secrets are valuable precisely because they are secret from a particular group—competitors who would make use of the information to gain an undue advantage in the marketplace.²⁷

So, for instance, imagine that a company spends millions to design a product and keeps its efforts secret. If a competing company gained access to the information, it would have the benefit of the first company's research and development without spending substantial resources.²⁸ This windfall would simultaneously devalue the design for the first company because it would now potentially compete, on equal or similar design footing, with the company that obtained the design. Presumably, competition between the two would cause the price of the product to fall, reducing the first company's profits.

This hypothetical highlights the theory behind audience-limiting protective orders—not all audiences are created equal. An injured individual who seeks a product design for use in a lawsuit does not have the capability (or likely the interest) to use the information to build the product and compete in the marketplace against a product manufacturer.²⁹ And so long as that individual is ordered not to disclose the information to such competitors, a court order to turn over the information in discovery does not injure the product-producing company.³⁰

²⁶ See, e.g., *Jampole v. Touchy*, 673 S.W.2d 569, 574 (Tex. 1984) (holding that trial court abused its discretion by denying discovery of product information where protective order keeping information from competitors would have sufficiently protected manufacturer's interest).

²⁷ See, e.g., *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 1011 n.15 (1984) ("We emphasize that the value of a trade secret lies in the competitive advantage it gives its owner over competitors."); cf. also RESTATEMENT (FIRST) OF TORTS § 757 cmt. b (AM. LAW INST. 1939) ("A trade secret may consist of any formula, pattern, device or compilation of information which is used in one's business, and which gives him an opportunity to obtain an advantage over competitors who do not know or use it.").

²⁸ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 39 (AM. LAW INST. 1995) ("[T]he protection of trade secrets has been justified as a means to encourage investment in research by providing an opportunity to capture the returns from successful innovations.").

²⁹ See, e.g., *Garcia*, 734 S.W.2d at 348 (noting that trade-secret-holder defendant's interest was in protecting proprietary product designs from competitors; plaintiff's interest was in effectively preparing for trial).

³⁰ See, e.g., *Jampole*, 673 S.W.2d at 574 ("*Jampole* is not GMC's business competitor, and GMC acknowledged that, if the documents were relevant, any proprietary interest could be safeguarded by a protective order.").

The story gets more complicated, though, because many allegedly defective products injure many people who pursue lawsuits contemporaneously. Imagine that our product is a defective drug sold by a national company to treat a common condition.³¹ The history of pharmaceutical claims shows that when a nationally distributed drug purportedly causes injury, hundreds (if not thousands) of people file suit.³² In each of these suits, one core issue almost certainly will be whether the design of the drug is dangerous.³³ Should the plaintiff in each suit be forced to litigate his or her entitlement to this design information? Should the courts be forced to resolve hundreds of identical discovery disputes?³⁴

These questions are particularly acute in light of what some have characterized as a discovery-cost crisis. According to these voices, the costs of discovery in U.S. litigation outweigh its benefits in many cases.³⁵ Litigants and courts, the reasoning goes, are forced to expend resources to facilitate the discovery of information with scant connection to the merits of the case.³⁶ And with the technological revolution of the past two decades,

³¹The Yaz birth control lawsuit provides a real-world analogue—women across the country filed suit alleging that the drug injured them by creating blood clots, strokes, and heart attacks. *See, e.g.*, 120 AM. JUR. *Trials* § 429 (2011) (“More than 50 women claim in lawsuits filed in Indianapolis that they suffered strokes, heart attacks or other serious health problems while taking the birth control pills Yasmin or Yaz, manufactured by Bayer Healthcare Corporation. Across the nation, dozens of lawsuits have been filed in the past few months by women claiming similar health problems after taking the pills.”).

³²*See id.*

³³*See, e.g., id.* (woman brought products liability suit for defective design of a birth control patch).

³⁴*See id.* Many national-scale products suits, including the Yaz lawsuits mentioned above, end up in multidistrict litigation. *Id.* This trend has the effect of consolidating discovery for all cases subject to the MDL and presumably, reducing the need for informal discovery sharing. *See id.*

³⁵FED. R. CIV. P. 26(b)(1) (Advisory Committee’s note to 2015 proposed amendment) (“The 1983 Committee Note stated that [provisions limiting the breadth of discovery] were added ‘to deal with the problem of over-discovery.’ The objective is to guard against redundant or disproportionate discovery by giving the court authority to reduce the amount of discovery that may be directed to matters that are otherwise proper subjects of inquiry.”); *cf.* Richard Marcus, *Procedural Postcard from America*, 1 RUSS. L.J. 9, 17 (2013) (“As a political matter, the notion that American litigation is too costly and time-consuming has gained much force. As an empirical matter, proving or evaluating such claims is difficult and involves contentious value judgments.”).

³⁶FED. R. CIV. P. 26(b)(1) (Advisory Committee’s note to 2015 proposed amendment).

the amount of all information subject to discovery (connected strongly to the merits or not) has soared to terabytes in many cases.³⁷

Over the years, in the federal and Texas systems, rule makers have attempted to reign in discovery costs.³⁸ Some commentators have questioned the efficacy of their efforts.³⁹ Whatever the merits of that debate, recent amendments to the Federal Rules of Civil Procedure expressly target the lack of “proportionality” between the costs of discovery and its benefits.⁴⁰ Those amendments are discussed in some depth in Part IV.B.

Outside of the recent discovery amendments, several procedural innovations have sought to reduce litigation costs in repeating case contexts, like product liability. For instance, multi-district litigation has become prevalent over the past thirty years, allowing a single court to resolve common issues in similar cases.⁴¹ But for similar cases not subject to MDL, questions persist about the sanity of allowing multiple courts to resolve virtually identical discovery issues.

Courts and litigants have grappled with informal solutions. Some courts enter sharing protective orders to allow litigants to cooperate and share information.⁴² Litigants have attempted to capitalize on sharing orders by

³⁷ Cf., e.g., Dana A. Remus, *The Uncertain Promise of Predictive Coding*, 99 IOWA L. REV. 1691, 1696 (2014) (“The unmanageable scope and extent of e-discovery offered new opportunities for abuse and quickly became a principal cause of increasing costs and delays in the court system.”).

³⁸ See, e.g., MCDONALD & CARLSON, *supra* note 4, § 13:2 (observing that 1999 amendments to the Texas Rules of Civil Procedure “were made to streamline discovery procedures and to reduce costs and delays associated with discovery practice”); Benham, *supra* note 2, at 2218–19 (chronicling federal efforts).

³⁹ See Jordan M. Singer, *Proportionality’s Cultural Foundation*, 52 SANTA CLARA L. REV. 145, 148 (2012) (observing that attempts to reign in broad discovery have had “virtually no impact”).

⁴⁰ See Supreme Court of the United States, Order Amending the Federal Civil Rules of Procedure (Apr. 29, 2015), [http://www.supremecourt.gov/orders/courtorders/frcv15\(update\)_1823.pdf](http://www.supremecourt.gov/orders/courtorders/frcv15(update)_1823.pdf).

⁴¹ See Martin H. Redish & Julie M. Karaba, *One Size Doesn’t Fit All: Multidistrict Litigation, Due Process, and the Dangers of Procedural Collectivism*, 95 B.U. L. REV. 109, 116 (2015) (“Since its inception in the late 1960s, MDL has become more and more common, to the point where today its use could almost be called routine.”).

⁴² See, e.g., *Idar v. Cooper Tire & Rubber Co.*, No. C-10-217, 2011 WL 688871, *3–4 (S.D. Tex. Feb. 17, 2011) (allowing discovery sharing); *Miller v. Gen. Motors Corp.*, 192 F.R.D. 230, 231, 233 (E.D. Tenn. 2000) (rejecting non-sharing provision in favor of discovery sharing).

creating information exchanges of varying levels of formality.⁴³ These exchanges typically stockpile discovery information in repeating cases and allow members to access it for a fee, subject to the terms of applicable protective orders.⁴⁴ Corporate defendants have resisted the sharing phenomenon, contending that shared discovery increases the risk of inadvertent or intentional disclosure of secret information to a competitor or the public at large.⁴⁵

In the mid-1980s, the Supreme Court of Texas stepped into the middle of this fight by enshrining sharing protective orders in Texas practice with its landmark decision, *Garcia v. Peebles*.⁴⁶ *Garcia* was a paradigmatic case—an individual plaintiff alleged that the fuel system in a common General Motors vehicle was defective and caused a deadly fuel-fed fire.⁴⁷ The plaintiff and his attorneys sought to share design information with litigants in similar lawsuits; GM contended that doing so would compromise its trade secrets.⁴⁸

But the story of trade secrets and discovery sharing in Texas did not begin and end with *Garcia*. Before the case, Texas courts had at least a partial framework for protecting trade secrets in discovery.⁴⁹ And long after *Garcia* was decided, Texas courts continue to grapple with questions about

⁴³ See, e.g., *Ward v. Ford Motor Co.*, 93 F.R.D. 579, 579 (D. Colo. 1982) (“Facing a single large manufacturer capable of coordinating its defenses nationwide, and a complex design engineering problem, about fifty attorneys representing the plaintiffs in many of these cases have organized an information exchange or clearing house for sharing information obtained by any of them through discovery.”).

⁴⁴ See Howard M. Erichson, *Informal Aggregation: Procedural and Ethical Implications of Coordination Among Counsel in Related Lawsuits*, 50 DUKE L.J. 381, 396 (2000) (“The Attorney’s Information Exchange Group (AIEG), a nonprofit cooperative comprised of ATLA members representing plaintiffs in products liability cases, provides members with extensive discovery information. AIEG describes its primary objective: ‘to provide plaintiffs’ counsel with the same collaborative benefits that defense attorneys have long enjoyed.’ AIEG information has been credited with aiding plaintiff victories against manufacturers of all-terrain vehicles and other products. One products liability lawyer called AIEG ‘the first and least expensive step in evaluating [product] design.’”).

⁴⁵ Cf. Campbell, *supra* note 9, at 824–25 (“[T]he likelihood of [protective order] violation[s], inadvertent or otherwise, will increase in direct proportion to the number of disclosures.”).

⁴⁶ 734 S.W.2d 343, 349 (Tex. 1987).

⁴⁷ *Id.* at 344.

⁴⁸ *Id.* at 344–45.

⁴⁹ See *infra*, Part II.A.

sharing trade secrets and the more fundamental question of whether they are discoverable in the first place.⁵⁰

A. Confidential Discovery

For more than fifty years, Texas has protected trade secrets in discovery,⁵¹ and the supreme court has routinely reiterated the importance of doing so.⁵² The trade secret privilege (which existed at common law) was enshrined in Texas Rule of Evidence 507 in 1983.⁵³ This qualified privilege gives litigants grounds to refuse to produce trade secret information except in cases where not producing the information would work a fraud or injustice.⁵⁴ Moreover, and as discussed in more depth in Part III, Rule 507

⁵⁰ See, e.g., *In re Bass*, 113 S.W.3d 735 (Tex. 2003); *In re Cont'l Gen. Tire, Inc.*, 979 S.W.2d 609 (Tex. 1998).

⁵¹ See former TEX. R. CIV. P. 186(b) (West 1957, repealed 1984), replaced with the current protective-order rule, TEX. R. CIV. P. 192.6.

⁵² See, e.g., *In re Bass*, 113 S.W.3d at 739 (adopting a multi-factor test to protect trade secrets); *In re Cont'l*, 979 S.W.2d at 612 (Texas's trade secret privilege "recognizes that trade secrets are an important property interest, worthy of protection."); *Garcia*, 734 S.W.2d at 346 (noting that Texas courts have long observed the "importance" of protecting trade secrets); *Lehnhard v. Moore*, 401 S.W.2d 232, 235 (Tex. 1966) (recognizing a qualified trade secret privilege).

⁵³ See TEX. R. EVID. 507.

⁵⁴ See *id.* Texas Rule of Evidence 507 mandates that trade secrets are privileged but fails to define what a "trade secret" is. *Id.* Courts in Texas have filled the gap. In 2003, the Supreme Court of Texas clarified the trade secret definition. *In re Bass*, 113 S.W.3d at 739. In *Bass*, the court recognized the Restatement of Torts' six-factor test for determining whether information is a trade secret:

- (1) the extent to which the information is known outside of his business; (2) the extent to which it is known by employees and others involved in his business; (3) the extent of the measures taken by him to guard the secrecy of the information; (4) the value of the information to him and to his competitors; (5) the amount of effort or money expended by him in developing the information; (6) the ease or difficulty with which the information could be properly acquired or duplicated by others.

Id. The court went on to recognize that the Restatement (Second) of Torts did not include the trade secret definition. *Id.* Rather, the test was relocated to the Restatement (Third) of Unfair Competition. *Id.* That Restatement included the six-factor test in the reporter's notes to section 39. *Id.* Those notes observe that the test is relevant in determining whether information is a trade secret, but the factors are not exclusive or dispositive. *Id.* The supreme court agreed, holding that a party seeking trade secret status for information need not demonstrate that all six of the restatement factors weigh in its favor. *Id.* at 740. Rather, courts may consider some or all of the factors in assessing whether information merits trade secret status. *Id.*

requires courts to provide “adequate” protection for trade secret information when litigants are forced to produce it.⁵⁵

In this way, the Texas trade secret privilege dovetails with Texas Rule of Civil Procedure 192.6, the rule that gives courts rule-based authority to enter audience-limiting protective orders.⁵⁶ This protective-order rule, like its federal counterpart, Rule 26(c), allows courts to mitigate the ill effects of what would be public disclosure of secret information in pretrial discovery.⁵⁷

The Texas rule is silent on the burden to obtain such an order, but the supreme court has suggested that the federal “good cause” framework under Rule 26(c) is analogous.⁵⁸ Federal law (and presumably consistent Texas law) requires parties seeking an audience-limiting order to make two showings. First, litigants must typically demonstrate that the information is in fact “confidential.”⁵⁹ “Confidential information” is a broader category than “trade secrets” and sometimes includes secret, non-privileged commercial or personal information.⁶⁰ Thus, the rule recognizes that much of the information exchanged in discovery will not meet the more onerous trade secret standard yet still be secret, sensitive, or private.⁶¹ The paradigm

⁵⁵TEX. R. EVID. 507(c).

⁵⁶See TEX. R. CIV. P. 192.6.

⁵⁷Compare TEX. R. CIV. P. 192.6(5), with FED. R. CIV. P. 26(c)(1)(G).

⁵⁸See, e.g., *Garcia v. Peeples*, 734 S.W.2d 343, 345 n.1 (Tex. 1987) (noting that amendments to Texas’s protective order rule brought it closer to the language of Rule 26(c) and discussing federal protective order burdens); see also *Benham*, *supra* note 2, at 2191–93 (describing the federal protective-order framework).

⁵⁹See, e.g., *United States v. Int’l Bus. Machs. Corp.*, 67 F.R.D. 40, 47–48 (S.D.N.Y. 1975) (finding that no protection was warranted where no evidence supported a representation that information was confidential); cf. also 8A CHARLES ALAN WRIGHT ET AL., *FEDERAL PRACTICE AND PROCEDURE* § 2043 (3d ed. 2010) (noting that Rule 26(c) generally provides protection for confidential information, in addition to other categories of information).

⁶⁰*In re Ford Motor Co.*, 211 S.W.3d 295, 299–300 (Tex. 2006) (“Although a trial court often considers protective orders in the context of trade secrets, e.g., *Garcia v. Peeples*, 734 S.W.2d 343, 346 (Tex.1987), the express terms of the parties’ agreed protective order make clear that trade secrets are not the only materials worthy of protection.”).

⁶¹See *Phillips ex rel. Estates of Byrd v. Gen. Motors Corp.*, 307 F.3d 1206, 1211 (9th Cir. 2002). Some courts have suggested that Rule 26(c) provides protection in some circumstances even when the information at issue is not “confidential research information.” *Id.* (“The law, however, gives district courts broad latitude to grant protective orders to prevent disclosure of materials for many types of information, including, *but not limited to*, trade secrets or other confidential research, development, or commercial information.”); cf. also WRIGHT ET AL., *supra* note 59, § 2043 (dispelling argument that Rule 26(c) provides for protective orders only when

category of non-trade secret confidential information would be personal medical records: no one would dispute a litigant's legitimate interest in keeping medical information private, yet it could virtually never qualify as a trade secret.⁶² Still, the rule allows courts to limit the audience for medical records just as it does for trade secrets or other proprietary commercial information.⁶³

Second, to obtain an audience-limiting protective order, litigants must demonstrate that public dissemination of the confidential information would be seriously harmful.⁶⁴ In cases involving trade secrets and commercial information, the harm put forward is typically economic. As discussed above, the theory goes that forcing litigants to disclose proprietary information, unprotected from competitors, devalues the information.⁶⁵

The supreme court has been unequivocal on the quantum of proof required to establish both prongs. Parties seeking protective orders must provide "a particular and specific demonstration of fact as distinguished from stereotyped conclusory statements."⁶⁶ Moreover, "sweeping

"true" trade secrets are involved). But without some minimal showing of confidentiality, an audience-limiting protective order does not make sense as a protective measure. Indeed, if information were generally known, limiting the audience for the information would hardly do the person seeking the order much good.

⁶²See, e.g., *Pearson v. Miller*, 211 F.3d 57, 60–61 (3d Cir. 2000) (medical and psychiatric records).

⁶³*Id.* at 61.

⁶⁴See, e.g., *Gelb v. Am. Tel. & Tel. Co.*, 813 F. Supp. 1022, 1034 (S.D.N.Y. 1993) ("With respect to [a] claim of confidential business information, [the good cause] standard demands that the company prove that disclosure will result in a 'clearly defined and very serious injury to its business.'"); cf. also 6 JAMES WM. MOORE, MOORE'S FEDERAL PRACTICE § 26.104 (Daniel R. Coquillette et al. eds., 3d ed. 2015); WRIGHT ET AL., *supra* note 59, at § 2043.

⁶⁵But in some cases, putatively confidential information (even trade secret information) has little value to protect. For instance, stale commercial information regarding a decades-old product or practice might well be confidential, but its dissemination would not harm the company that had kept it secret. See, e.g., *Garcia v. Peebles*, 734 S.W.2d 343, 348 n.3 (Tex. 1987) (admonishing courts to be wary of protecting "stale" information); see also *United States v. Int'l Bus. Machs. Corp.*, 67 F.R.D. 40, 49 (S.D.N.Y. 1975) (denying confidentiality request where "[n]one of this data is current; it reveals directly little, if anything at all, about Honeywell's current operations" and determining that "[b]y a fair reading of [the party seeking the protective order's] own representation, the value of this data to [that party's] competitors is speculative").

⁶⁶*Garcia*, 734 S.W.2d at 345 (citations and quotations omitted); see also, e.g., *In re Alford Chevrolet-Geo*, 997 S.W.2d 173, 181 (Tex. 1999) ("A party resisting discovery, however, cannot simply make conclusory allegations that the requested discovery is unduly burdensome or unnecessarily harassing. The party must produce some evidence supporting its request for a protective order.").

predictions” or harm without “specific examples” are insufficient to support a protective order.⁶⁷ This burden largely mirrors federal protective-order requirements.⁶⁸

B. Discovery Sharing

A discovery-sharing dispute gave the Supreme Court of Texas an opportunity to examine the contours of the protective-order burden.⁶⁹ In *Garcia v. Peeples*, the court reviewed a trial judge’s broad protective order, putatively issued to protect General Motor’s trade secrets.⁷⁰ The order forbade dissemination of vehicle design documents to anyone outside of the specific case.⁷¹ The critical question before the court: was the trial court’s order too broad where it stopped the plaintiff’s attorney from sharing the documents with other (non-competitor) attorneys involved in similar litigation?⁷²

Predictably, the sharing/trade secret issue arose in a product-liability case. Manuel Garcia, the plaintiff, was the sole survivor of a post-collision fuel-fed fire in a GM vehicle.⁷³ He sued and requested fuel-system design documents from GM.⁷⁴ GM produced the fuel-system documents in the case but asked the trial court to protect them from wider dissemination because the documents apparently contained trade secrets.⁷⁵ The trial judge

⁶⁷ *Garcia*, 734 S.W.2d at 345.

⁶⁸ See, e.g., *Parsons v. Gen. Motors Corp.*, 85 F.R.D. 724, 726 (N.D. Ga. 1980) (denying protective order where allegations of confidentiality were not “particularized” and allegations of “competitive harm [were] vague and conclusory when specific examples are necessary”); see also MOORE, *supra* note 64, at § 26.102; WRIGHT ET AL., *supra* note 59, at § 2035 (“The courts have insisted on a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements, in order to establish good cause.”); cf. Richard L. Marcus, *A Modest Proposal: Recognizing (At Last) That the Federal Rules Do Not Declare That Discovery is Presumptively Public*, 81 CHI.-KENT L. REV. 331, 348 (2006) (observing that the protective order burden is “somewhat exacting” but not an insurmountable hurdle that would create public access right).

⁶⁹ See *Garcia*, 734 S.W.2d at 344–45.

⁷⁰ *Id.*

⁷¹ *Id.* at 346.

⁷² *Id.* The court also decided two collateral issues in *Garcia*, holding that certain notes and indexes were attorney work product and also allowing GM to enforce protective orders from other jurisdictions. See *id.* at 348–49.

⁷³ *Id.* at 344.

⁷⁴ *Id.*

⁷⁵ See *id.* at 344–45.

(David Peeples) issued an onerous protective order that, among other restrictions, allowed only the plaintiff, his attorneys, and his experts to access the documents.⁷⁶

Garcia sought mandamus relief, contending that GM's evidence did not support the order's breadth.⁷⁷ In particular, Garcia contended that he should be allowed to share the fuel-system-design information with litigants involved in similar litigation against GM.⁷⁸ Doing so, the reasoning went, would not harm GM because litigants in product-liability cases were almost certainly not competitors.⁷⁹ Moreover, Garcia contended that public policy favored discovery sharing as a mechanism to encourage full candor in discovery and a method to increase court efficiency.⁸⁰

The supreme court agreed.⁸¹ Justice Kilgarlin, writing for the majority, observed that GM did have a legitimate interest in keeping its trade secrets from competitors.⁸² But the court went on to hold that sharing discovery information between non-competitor litigants would not harm GM in a manner that outweighed the public policies favoring sharing.⁸³

The court accepted at least two of the oft-stated policy rationales that support sharing: discovery integrity and litigation efficiency. With respect to the first, the court bemoaned "the lack of candor during discovery in complicated litigation."⁸⁴ Parties in cases with similar discovery requests and shared discovery, the court reasoned, "are forced to be consistent in their responses by the knowledge that their opponents can compare those responses."⁸⁵

⁷⁶ *See id.* at 346 n.2.

⁷⁷ *Id.* at 345–46.

⁷⁸ *Id.* at 346.

⁷⁹ *See id.* at 348.

⁸⁰ *Id.* at 346–47.

⁸¹ *Id.* at 348.

⁸² *Id.*

⁸³ *Id.*

⁸⁴ *Id.* at 347. Discovery sharing's propensity to increase candor in disclosure is a laudable feature even without sharing's efficiency benefits. *See, e.g., id.* Likewise, sharing creates the ability for plaintiff's counsel to collaborate in discovery for similar cases—a practice that would be forbidden in many instances in a non-sharing regime. A byproduct of this collaboration may very well be increased efficiency as a result of better-tailored discovery requests. *Cf., e.g., Patterson v. Ford Motor Co.*, 85 F.R.D. 152, 153–54 (W.D. Tex. 1980); *cf. also Benham, supra* note 2, at 2199, 2206.

⁸⁵ *Garcia*, 734 S.W.2d at 347.

The court also recognized the obvious efficiencies of discovery sharing. A non-sharing system “forces similarly situated parties to go through the same discovery process time and time again, even though the issues involved are virtually identical.”⁸⁶ A sharing order, on the other hand, would allow parties in similar cases to benefit from previous discovery while denying the defendant in those cases the undue benefit of requiring re-discovery by each party bringing a suit against it.

The *Garcia* court found that the protective order was too broad.⁸⁷ Importantly, GM’s legitimate interest in the protective order was to prevent dissemination to *competitors*, not non-competitor litigants like Garcia.⁸⁸

Garcia left Texas courts with several important takeaways for issuing protective orders in trade secret cases. First, parties that produce trade secret information in discovery are typically entitled to an order protecting the information from competitors.⁸⁹ Second, a party seeking such protection must produce specific, concrete evidence that it will indeed be harmed in the absence of the order.⁹⁰ Third, the court implicitly held that protective orders must be no broader than the evidence supports.⁹¹ If evidence only supports a party’s contention that it will be harmed by disclosure to Person A, a protective order preventing dissemination to both Person A and Person B is overbroad (assuming that under the more lenient order Person B would be forbidden from providing Person A with the information). Fourth, courts should consider the systemic impact of orders restricting the dissemination of discovery information.⁹² These systemic considerations—discovery

⁸⁶ *Id.*

⁸⁷ See *id.* at 348; *cf. also In re Quality Safety Sys. Co.*, No. 05-10-00801-CV, 2010 WL 4192897, at *1 (Tex. App.—Dallas Oct. 26, 2010, no pet.) (mem. op.) (citing *Garcia* to deny petition for writ of mandamus seeking to limit discovery sharing with third parties); *Am. Honda Motor Co. v. Dibrell*, 736 S.W.2d 257, 259 (Tex. App.—Austin 1987, no writ) (holding that trial court did not abuse its discretion by entering sharing order in case involving trade secrets). *But see In re Universal Coin & Bullion, Ltd.*, 218 S.W.3d 828, 833 (Tex. App.—Beaumont 2007, pet. denied) (warning, in dicta, that potential protective order was not adequate where it did not limit sharing to suits concerning the same subject matter).

⁸⁸ See *Garcia*, 734 S.W.2d at 348.

⁸⁹ *Id.*

⁹⁰ *Id.*; *cf. also In re Alford Chevrolet-Geo*, 997 S.W.2d 173, 189 (Tex. 1999) (stating that in *Garcia*, the court “held that a motion for protection from discovery must be based on ‘a particular, articulated and demonstrable injury’”).

⁹¹ *Garcia*, 734 S.W.2d at 348.

⁹² *Id.* at 346–47.

integrity and litigation efficiency—obviously extend beyond the proprietary interests of the parties to the litigation.⁹³

A few years after *Garcia*, then-Justice (now-Senator) Cornyn, writing for the majority, reaffirmed the court's commitment to discovery sharing. In *Eli Lilly & Co. v. Marshall*, the court considered the propriety of an order compelling production of information that a pharmaceutical company previously submitted to the FDA.⁹⁴ The information related to the health care provider's reports about problems with the drug Prozac, and no party contended that the information comprised trade secrets.⁹⁵ Instead, the pharmaceutical company resisted production on the basis that the FDA regulations made the information secret.⁹⁶

While the court did find that the trial court abused its discretion by ordering production of at least some of the information, it went on to express its commitment to shared discovery.⁹⁷ Justice Cornyn observed that “under the doctrine of shared discovery, the fruits of discovery are available not only to the parties in a particular case but may be disseminated in turn to other litigants and potential litigants.”⁹⁸ Indeed, the court noted that with respect to the discoverable portion of the FDA information, the requesting parties were entitled to “to share that discovery with their expert witnesses and litigants in other cases.”⁹⁹

C. *Implicit Sharing Ban?*

While the supreme court has revisited the discoverability of trade secrets several times, it has not directly addressed trade-secret discovery-sharing

⁹³ With all protective-order determinations, the evidence supporting the order matters. One might read *Garcia* to mean that protective orders must always include sharing provisions, but this interpretation ignores the case-by-case nature of the inquiry. One feature of *Garcia* is undoubtedly mandatory—trial courts should not enter protective orders absent evidence of significant and serious harm that would occur absent the order. *Id.* at 248. Because well-crafted sharing provisions almost always exclude competitors from access to discovery materials and prevent discovery-dissemination-based harms, it follows that sharing orders are mandatory in most cases.

⁹⁴ 850 S.W.2d 155, 156–57 (Tex. 1993).

⁹⁵ *Id.* at 156–57, 160.

⁹⁶ *Id.* at 157.

⁹⁷ *Id.* at 160.

⁹⁸ *Id.*

⁹⁹ *Id.*

since *Garcia*.¹⁰⁰ Nonetheless, according to opponents of sharing, the court implicitly overruled *Garcia* in a later trade secret case, *In re Continental*.¹⁰¹ This argument is flawed for several reasons, as discussed in Part III. Still, it is worth examining *In re Continental*—the case sheds light on the relationship between the discoverability of trade secrets and the best methods to protect them during litigation.

In re Continental said much about when trial courts may order production of trade secrets.¹⁰² But it said little to nothing about whether parties may share the information after exchanging it. In *In re Continental*, a trial court ordered a defendant tire company to produce its “skim stock” formula—essentially a portion of the tire’s ingredients.¹⁰³ The plaintiffs conceded that the formula was a trade secret.¹⁰⁴ Thus, the issue in the case was whether the qualified trade secret privilege (Texas Rule of Evidence 507) allowed the tire company to withhold the information in discovery.¹⁰⁵

Texas Rule of Evidence 507 provides a privilege to withhold trade secret information when doing so does not “tend to conceal fraud or otherwise work injustice,”¹⁰⁶ subject to an “appropriate protective order.”¹⁰⁷ In *In re Continental*, the court grappled with exactly when courts are allowed to order production of trade secret information in discovery to prevent “injustice.”¹⁰⁸

There are at least three ways to approach the trade secret discoverability problem in the routine (non-fraud) case. First, courts could allow discovery of the information so long as it is relevant to the case.¹⁰⁹ The *In re Continental* court rejected this approach, reasoning that if a bare relevance threshold could defeat the trade secret privilege, Rule 507 would be

¹⁰⁰ See, e.g., *In re Bass*, 113 S.W.3d 735, 737 (Tex. 2003); *In re Cont’l Gen. Tire, Inc.*, 979 S.W.2d 609, 610 (Tex. 1998).

¹⁰¹ See, e.g., *Zappe v. Medtronic USA, Inc.*, No. C-08-369, 2009 WL 792343, at *1 (S.D. Tex. Mar. 23, 2009) (reading *In re Continental* to approve a non-sharing order); *In re Cont’l*, 979 S.W.2d at 615.

¹⁰² See *In re Cont’l*, 979 S.W.2d at 612–14.

¹⁰³ *Id.* at 610.

¹⁰⁴ *Id.* at 615.

¹⁰⁵ *Id.* at 610.

¹⁰⁶ TEX. R. EVID. 507.

¹⁰⁷ *In re Cont’l*, 979 S.W.2d at 613.

¹⁰⁸ *Id.* at 610–13.

¹⁰⁹ *Id.* at 613–14.

rendered meaningless.¹¹⁰ Indeed, information that is not relevant is generally not discoverable in any event, making relevance an illusory floor in trade secret cases.¹¹¹ A second approach (advocated by the defendants in *In re Continental*) reads Rule 507 as something approaching an absolute privilege.¹¹² According to this line of reasoning, a protective order “can never adequately protect a sensitive trade secret” because of the risk of intentional or inadvertent disclosure.¹¹³ The court rejected this approach because it would effectively nullify the qualification language in Rule 507 that expressly allows production of trade secrets in certain circumstances.¹¹⁴ But the court noted that trial judges should balance “potential inadequacies” of protective orders when deciding to compel production of trade secrets (or not).¹¹⁵

The court settled on a third approach, somewhere in the middle, requiring parties requesting trade secrets to demonstrate “necessity.”¹¹⁶ When a party establishes that information sought in discovery comprises trade secrets, “[t]he burden . . . shifts to the requesting party to establish that the information is necessary for a fair adjudication of its claims.”¹¹⁷ The court went on to hold that the plaintiffs in *In re Continental* had not established that the tire formula was necessary for a fair adjudication of its claims and barred discovery of the information.¹¹⁸

Along the way to this holding, the court dropped a footnote that has engendered a wave of anti-sharing litigation, multiple mandamus proceedings across the state, and several granted petitions for review by the supreme court.¹¹⁹ When noting that trial courts that order trade secret

¹¹⁰ *Id.*

¹¹¹ See TEX. R. CIV. P. 192.3 (“In general, a party may obtain discovery regarding any matter that is not privileged and is relevant to the subject matter of the pending action”).

¹¹² *In re Cont'l*, 979 S.W.2d at 614.

¹¹³ *Id.*

¹¹⁴ See *id.*

¹¹⁵ *Id.*

¹¹⁶ See *id.* at 613.

¹¹⁷ *Id.*

¹¹⁸ See *id.* at 615.

¹¹⁹ See, e.g., *id.* at 613 n.3; *Idar v. Cooper Tire & Rubber Co.*, No. C-10-217, 2011 WL 688871, at *1–2 (S.D. Tex. Feb. 17, 2011) (denying request for non-sharing order and holding that *In re Continental* did not overrule *Garcia*); *Zappe v. Medtronic USA, Inc.*, No. C-08-369, 2009 WL 792343, at *1 (S.D. Tex. Mar. 23, 2009) (citing *In re Continental* before entering a non-sharing protective order); see also *In re Quality Safety Sys. Co.*, No. 05-10-00801-CV, 2010 WL 4192897, at *1 (Tex. App.—Dallas Oct. 26, 2010, no pet.) (mem. op.); Order Granting Oral

production must do so subject to an appropriate protective order, the court (in its rift-creating footnote) wrote, “In this case, for example, the trial court limited access to the information to the parties in this lawsuit, their lawyers, consultants, investigators, experts and other necessary persons employed by counsel to assist in the preparation and trial of this case.”¹²⁰ In other words, a non-sharing order was apparently appropriate in the *In re Continental* proceeding.

This murky footnote, undoubtedly dicta, led to arguments that the supreme court had implicitly overruled *Garcia*'s holding that sharing provisions were often required in protective orders.¹²¹ And the arguments went further—after *In re Continental*, many litigants argued that the supreme court had actually forbidden discovery sharing altogether.

III. THE ATTACK ON DISCOVERY SHARING

Litigants (usually large corporate interests) have asked the supreme court to forbid discovery sharing in Texas trade secret cases multiple times in the past decade.¹²² And since 2004, the court has agreed to hear the issue at least three times, though it has never issued an opinion revisiting the *Garcia* question.¹²³ If granted, the requests to overrule *Garcia* and prohibit sharing would undercut the practice in sharing jurisdictions across the country.

To make these extraordinary requests to change the law seem plausible, the proponents usually conflate the standard governing the *discoverability* of trade secrets with the standard for *protecting them after disclosure*.¹²⁴ Sharing protective orders in trade secret cases, the reasoning goes, would nullify Texas Rule of Evidence 507 (a rule aimed at discoverability, not protective-order standards.)¹²⁵

The typical three-part attack on *Garcia* and sharing in trade secret cases:

Argument, *In re Gen. Motors, LLC*, (No. 13-0794), <http://www.search.txcourts.gov/SearchMedia.aspx?MediaVersionID=1e0473a2-4940-4485-a8c8-b820c88b60e1&coa=cossup&DT=SUBMISSIONSET&MediaID=4428246b-840b-4ae7-a8ee-54d0f09c334e> (Tex. Aug. 22, 2014).

¹²⁰ *In re Cont'l*, 979 S.W.2d at 613 n.3.

¹²¹ *See Idar*, 2011 WL 688871, at *2.

¹²² *See Ambrose*, *supra* note 6.

¹²³ *Id.*

¹²⁴ *See, e.g.*, Automobile Manufacturers' Amicus Brief, *supra* note 3.

¹²⁵ *See, e.g., id.* (“Sharing orders eliminate [Rule 507’s] requirement that necessity be demonstrated on a case-by-case basis.”).

- To obtain trade secret information in discovery, Rule 507 requires requesting parties to establish that the information is necessary to prove a claim or defense.
- Similarly situated third-party litigants who would receive the information under a sharing protective order must individually demonstrate that the information is necessary in their particular cases.
- If courts enter sharing protective orders that allow parties to disseminate trade secret information to similar third-party litigants, those courts ignore Rule 507's necessity requirement.

Only the first of these three propositions is demonstrably true.¹²⁶ *In re Continental* itself belies the other two.¹²⁷ Indeed, *In re Continental* separates the trade secret discoverability inquiry (one that allows discovery of trade secrets (absent fraud) only if they are necessary proof in the case) from the standard governing the adequacy of audience-limiting protective orders.¹²⁸

The case actually held that *after* trial courts determine that trade secret information “is necessary for a fair adjudication” of the requesting party’s claims, trial courts should “ordinarily” compel production of the information subject to “an *appropriate* protective order.”¹²⁹ The term “protective order,” as used in *In re Continental*, plainly refers to an order that was available under former Texas Rule of Civil Procedure 166b(5)—titled “Protective Orders”—and succeeded by identically titled Rule 192.6.¹³⁰ The court correctly recognized, consistent with decades of similar decisions in Texas and around the country, that a protective order is the appropriate mechanism to limit the audience for otherwise discoverable information.¹³¹

¹²⁶ See *In re Cont’l Gen. Tire, Inc.*, 979 S.W.2d 609, 613 (Tex. 1998).

¹²⁷ See *id.* at 611–13.

¹²⁸ See *id.* at 613.

¹²⁹ See *id.* (emphasis added).

¹³⁰ TEX. R. CIV. P. 192.6; TEX. R. CIV. P. 166b(5) (West 1983, repealed 1998).

¹³¹ See *In re Cont’l*, 979 S.W.2d at 613; see also, e.g., *Glenmede Tr. Co. v. Thompson*, 56 F.3d 476, 483 (3d Cir. 1995) (recognizing protective orders as method to limit discovery access); *Garcia v. Peeples*, 734 S.W.2d 343, 345 (Tex. 1987) (evaluating propriety of protective order to limit access to trade secrets in discovery); cf. *In re Terra Int’l, Inc.*, 134 F.3d 302, 306 (5th Cir. 1998) (allowing parties to limit the audience when discovery is conducted).

In re Continental thus acknowledged two important pieces of pretrial-discovery and protective-order bedrock: (1) the audience-limiting protective-order inquiry is distinct from the discoverability inquiry,¹³² and (2) some protective orders are “appropriate” to protect trade secret discovery information while others are not.¹³³

By using the modifier “appropriate” before “protective order,” the court did indeed recognize that some protective orders might fail because they do not satisfactorily protect trade secrets.¹³⁴ Likewise, some protective orders might not be “appropriate” because they are too severe, restricting disclosure to an audience more narrow than evidence of harm would support.¹³⁵

Thus, the question in trade secret-sharing cases is whether narrowly drawn sharing protective orders adequately protect otherwise discoverable trade secret information and are therefore “appropriate.” The question is not (as those attacking discovery sharing would contend) whether other similarly situated litigants must establish “necessity” under Rule 507 after the discovering party has already done so.¹³⁶

¹³²See *In re Cont'l*, 979 S.W.2d at 613; *Chapa v. Garcia*, 848 S.W.2d 667, 678 n.8 (Tex. 1992) (Doggett, J., concurring) (“While discoverability by the parties is often confused with disclosability to the public, discoverability and disclosability issues must be resolved separately.”). No doubt the two inquiries inform one another—courts should consider the efficacy of protective measures when deciding to order production of trade secrets or other sensitive information. See *In re Cont'l*, 979 S.W.2d at 614.

¹³³See *In re Cont'l*, 979 S.W.2d at 613–14.

¹³⁴See *id.*

¹³⁵*Cf.*, e.g., *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 274 F.R.D. 576, 584 (E.D. Va. 2010) (refusing to enter protective-order provision that would have denied in-house counsel access to trade secrets and other confidential information in lawsuit between competitors).

¹³⁶Even if courts were required to consider “necessity” before allowing sharing orders in trade secret cases, most already do so (at least implicitly) when crafting the sharing provision in the order. See *Raymond Handling Concepts Corp. v. Superior Court*, 45 Cal. Rptr. 2d 885, 888 (Cal. Ct. App. 1995) (rejecting argument that necessity requirement of California trade secret privilege foreclosed sharing protective orders and noting that “[s]ince plaintiff’s attorney may share this discovery only with counsel in other similar cases, it must be assumed that the information is also discoverable in these other similar cases”). The sharing provision in a sharing protective order defines the class of similar litigants who are entitled to receive the discovery information. Sharing provisions are often quite specific. So, for instance, a sharing provision might provide that the sharing class includes all persons with pending claims against the defendant in the sharing case for injuries stemming from the particular product at issue in the sharing case. Assuming the discovery at issue is necessary to resolve the sharing case, it would presumably be relevant and necessary in the receiving cases as well. See *id.* Product design information, for

Two uncontroversial legal principles support framing the inquiry in this way. First, absent a valid protective order, litigants may freely distribute information that they obtain in discovery.¹³⁷ Thus, discovery sharing, and even public dissemination, is the default without a valid order to the contrary.

Second, a contested protective order is valid only where the party seeking it establishes good cause (or an analogous legal standard) for the order by producing concrete evidence of a serious and clearly defined injury.¹³⁸

Federal courts and state courts routinely reject requests for non-sharing orders because inadequate (or no) evidence of competitive harm supports the requests.¹³⁹ By doing so, courts also further their own interest (and the public's interest) in litigation efficiency.¹⁴⁰

Proponents of a no-discovery-sharing regime reject this evidence-based approach and the efficiency benefits that flow from it.¹⁴¹ They would

instance, would likely be necessary in any case where the parties allege the product is defective. Assuming the sharing provision in the protective order limits sharing to cases where parties allege the product is defective, the court has effectively found the information necessary in those later cases.

¹³⁷ See, e.g., *Seattle Times Co. v. Rhinehart*, 467 U.S. 20, 37 (1984); *Exum v. U.S. Olympic Comm.*, 209 F.R.D. 201, 205 (D. Colo. 2002) (“Parties to litigation have a First Amendment right to disseminate information they obtained in discovery absent a valid protective order.”); see also *infra* Part III.B.

¹³⁸ See, e.g., *Masinga v. Whittington*, 792 S.W.2d 940, 940 (Tex. 1990) (holding that party “must show particular, specific and demonstrable injury by facts sufficient to justify a protective order”).

¹³⁹ See, e.g., *Kamp Implement Co. v. J.I. Case Co.*, 630 F. Supp. 218, 221 (D. Mont. 1986) (ruling that “burden will be upon defendants to make a specific showing of harm or competitive disadvantage which will result from disclosure” to similar litigants); cf. *Benham*, *supra* note 2, at 2191–93.

¹⁴⁰ See, e.g., *Garcia v. Peebles*, 734 S.W.2d 343, 347 (Tex. 1987) (“[S]hared discovery makes the system itself more efficient.”); Richard L. Marcus, *The Discovery Confidentiality Controversy*, 1991 U. ILL. L. REV. 457, 464–66, 466 n.61, 495–96 (1991) (endorsing at least some form of discovery sharing, noting pro-sharing state legislation); *Miller*, *supra* note 8, at 498–99 (embracing sharing where it furthers efficiency); see also *HARE, JR. ET AL.*, *supra* note 7, at 69–70 (observing that non-sharing protective orders mean that discovery “must be repeated anew in every case”).

¹⁴¹ Cf., e.g., *Wal-Mart Stores E., L.P. v. Endicott*, 81 So. 3d 486, 490 (Fla. Dist. Ct. App. 2011).

instead inject a de facto presumption of harm into every trade secret case to justify forbidding sharing protective orders categorically.¹⁴²

But a no-evidence-required take on protective orders would nullify decades of Texas law and would put the Supreme Court of Texas in conflict with federal and state courts across the country.¹⁴³ A discovery-sharing ban in trade secret cases would also make litigation more expensive and run contrary to Texas procedural reform aimed at increasing litigation efficiency.

A. Evidence-Based Protective-Order Standards

As detailed in Section II.A, Texas and federal courts require parties requesting protective orders to produce evidence of “a particular, articulated and demonstrable injury, as opposed to conclusory allegations.”¹⁴⁴ Along the same lines, courts have long recognized that in the context of trade secrets or confidential commercial information, parties must establish that an economic or competitive harm would occur without entry of a protective order.¹⁴⁵

Despite this baseline proof requirement, courts have undeniably broad discretion in tailoring protective orders, “frequently finding protection justified and frequently denying protection.”¹⁴⁶ This discretion is rooted in

¹⁴²*Id.* Florida courts, for instance, have found sharing protective orders to be inconsistent with that state’s trade secret privilege. *Id.* In *Wal-Mart v. Endicott*, an intermediate appellate court held that a sharing protective order conflicted with Florida’s qualified trade secret privilege. *Id.* Moreover, the court found that the sharing order’s failure to adequately identify litigants with similar pending claims would harm Wal-Mart’s interests, whether competitors were in the sharing class or not. *See id.*

¹⁴³*See, e.g.,* *Raymond Handling Concepts Corp. v. Superior Court*, 45 Cal. Rptr. 2d 885, 888 (Cal. Ct. App. 1995) (holding trial court did not abuse its discretion by allowing sharing order in case involving trade secrets). *But see Endicott*, 81 So. 3d at 490.

¹⁴⁴*Masinga v. Whittington*, 792 S.W.2d 940, 940 (Tex. 1990); *Garcia*, 734 S.W.2d at 345.

¹⁴⁵*See, e.g.,* *Glenmede Tr. Co. v. Thompson*, 56 F.3d 476, 484 (3d Cir. 1995) (finding that parties seeking protective order failed to establish harm from disclosure and refusing to upset trial court’s denial of protective order); *see also, e.g.,* *Parsons v. Gen. Motors Corp.*, 85 F.R.D. 724, 726 (N.D. Ga. 1980) (denying protection where GM failed to prove that discovery information was “confidential and that disclosure [would have] create[d] a competitive disadvantage for the party”).

¹⁴⁶WRIGHT ET AL., *supra* note 59, at § 2036; *see also* Benham, *supra* note 2, at 2192.

trial courts' unique position in managing the pretrial discovery process and the fact-intensive nature of the protective-order inquiry.¹⁴⁷

But discretion does have limits.¹⁴⁸ As guidance, several federal circuits have articulated factors to shepherd trial courts exercising protective-order discretion. For instance, in a widely cited analysis from *Glenmede Trust Co. v. Thompson*, the Third Circuit held—consistent with the Texas high court's public policy-based approach in *Garcia*—that courts should consider, among other factors, “whether the sharing of information among litigants will promote fairness and efficiency.”¹⁴⁹

Thus, along with Texas courts, federal courts have constructed a protective-order system of bounded discretion, demarcated by proof of good cause and influenced by public policy considerations. And like Texas courts, federal courts value discovery sharing, though courts in the federal system differ with one another on how best to accomplish it. Some federal courts enter sharing protective orders.¹⁵⁰ Others disfavor upfront sharing protective orders and instead prefer later, case-by-case modification to allow sharing.¹⁵¹

B. The Freedom to Disseminate Discovery Information

If a court does not find adequate cause for a protective order, parties are free to disseminate the materials to other litigants or the public at large.¹⁵² Thus, the decision to “allow” discovery sharing is actually a decision not to enter a protective order to forbid it. Over the past four decades, the idea that

¹⁴⁷ See, e.g., *Seattle Times Co. v. Rhinehart*, 467 U.S. 20, 36 (1984) (“To be sure, Rule 26(c) confers broad discretion on the trial court to decide when a protective order is appropriate and what degree of protection is required.”).

¹⁴⁸ See, e.g., *Benham*, *supra* note 2, at 2192 (citing, e.g., *In re Roman Catholic Archbishop of Portland in Or.*, 661 F.3d 417, 424 (9th Cir. 2011) (applying multi-factor analysis to assess “good cause” for protective order)).

¹⁴⁹ 56 F.3d at 483; cf. *Garcia*, 734 S.W.2d at 348 (holding that sharing promotes “public policies” of efficient, transparent court operations).

¹⁵⁰ See, e.g., *In re Abbott Labs. Sec. Litig.*, No. 92 C 3869, 1993 WL 616693, at *4 (N.D. Ill. Nov. 15, 1993) (allowing sharing with attorneys in pending cases).

¹⁵¹ See *Bertetto v. Eon Labs, Inc.*, Civ. No. 06-1136 JCH/ACT, 2008 WL 2522571, at *2 (D.N.M. May 29, 2008) (rejecting a sharing provision in preference to a system of case-by-case protective-order modification). Some might argue that sharing decisions should be made on a case-by-case basis through after-the-fact protective order modifications. Modifying protective orders on a case-by-case basis, however, is often less efficient than Texas's current sharing-protective-order framework. See *Benham*, *supra* note 10, at 1781.

¹⁵² See, e.g., *Exum v. U.S. Olympic Comm.*, 209 F.R.D. 201, 205 (D. Colo. 2002).

discovery can be made public unless a court orders otherwise has become entrenched.¹⁵³ This freedom, it turns out, has a constitutional root.

In *Seattle Times Co. v. Rhinehart*, the United States Supreme Court considered whether a litigant had a First Amendment right to publish pretrial discovery information.¹⁵⁴ The dispute began when a Washington state trial court entered a protective order in a quirky defamation case.¹⁵⁵ The order forbade a defendant newspaper from publishing religious information it obtained in discovery from the defamation plaintiffs (a religious sect and its leader).¹⁵⁶

Writing for the Court and striking a pragmatic tone, Justice Lewis Powell observed that civil discovery can be particularly invasive.¹⁵⁷ Nonetheless, the Court held that the First Amendment protects the dissemination of pretrial discovery.¹⁵⁸ Ultimately, however, the Court also held that discovery was a special context, and thus protective orders were not the type of prior restraints that would require the usual exacting First Amendment scrutiny.¹⁵⁹

Instead, the Supreme Court held that protective orders satisfy the First Amendment only where they are “*entered on a showing of good cause as required by Rule 26(c)*, [are] limited to the context of pretrial civil discovery, and [do] not restrict the dissemination of the information if

¹⁵³ See, e.g., Seymour Moskowitz, *Discovering Discovery: Non-Party Access to Pretrial Information in the Federal Courts 1938–2006*, 78 U. COLO. L. REV. 817, 825 n.35 (2007) (cataloguing cases in which courts noted the right to disseminate pretrial discovery absent a valid protective order).

¹⁵⁴ *Seattle Times Co. v. Rhinehart*, 467 U.S. 20, 22 (1984); see also Benham, *supra* note 10, at 1781.

¹⁵⁵ See *Seattle Times Co.*, 467 U.S. at 26–27.

¹⁵⁶ See *id.* at 27.

¹⁵⁷ See *id.* at 34–35.

¹⁵⁸ See *id.* at 31 (“It is, of course, clear that information obtained through civil discovery authorized by modern rules of civil procedure would rarely, if ever, fall within the classes of unprotected speech identified by decisions of this Court.”).

¹⁵⁹ See *id.* at 33–34. *Seattle Times* is often cited for the blanket proposition that there is no First Amendment right of “access” to pretrial discovery materials. See, e.g., *Bond v. Utreras*, 585 F.3d 1061, 1077 (7th Cir. 2009). *Seattle Times* does so hold, but this aspect of the case does not speak to whether parties may disseminate discovery. Parties may not have a protected right to access discovery information, but they do have a First Amendment right to disseminate discovery information. *Seattle Times Co.*, 467 U.S. at 37. This speech interest may be restricted only by a protective order that satisfies *Seattle Times*’ requirements. *Id.*

gained from other sources”¹⁶⁰ Thus, courts that enter protective orders without good cause (or presumably a standard requiring a similar evidentiary showing) violate the First Amendment in addition to ignoring the requirements of the applicable rules of civil procedure.

The evidence-based good cause analysis approved in *Seattle Times* works to constrict the breadth of protective orders. The decision to grant or deny a protective order is not binary: A court considering a protective-order request does not simply decide to enter an order or not. Instead, courts must evaluate whether the scope and breadth of the particular order is justified.¹⁶¹

At one end of the spectrum, an audience-limiting protective order might limit the audience for discovery materials to an *in camera* review.¹⁶² At the other end, a court might deny a protective-order request altogether, allowing widespread public dissemination of discovery materials.¹⁶³

The distinction between the two scenarios, and scenarios along the spectrum in between, often lies in differences between the proof of harm put forward by the party seeking the order. Protective orders crafted on a proof-of-harm basis answer the concern that litigants engaged in intrusive discovery might suffer serious harm without a sufficient audience limitation (e.g. an order forbidding access to competitors or the media). But the proof-of-harm requirement also protects speakers who have a right to share what they learn in discovery when doing so is not harmful.

Presuming harm (expressly or implicitly) in trade secret cases through an outright ban on discovery sharing would turn this evidence-based

¹⁶⁰ See *Seattle Times Co.*, 467 U.S. at 37 (emphasis added). Courts are divided on whether the proper First Amendment test for protective orders is simple good cause or intermediate scrutiny. Cf. *In re Requests for Investigation of Attorney E.*, 78 P.3d 300, 310 (Colo. 2003) (en banc) (applying intermediate scrutiny to a protective order under an attorney discipline rule analogous to Rule 26(c)). For a full discussion of the split and its implications, see Benham, *supra* note 10, at 1784–85. For purposes of this case, and without conceding that the good cause standard sufficiently protects plaintiffs’ speech rights, it is incontestable that good cause is the *minimum* standard a protective order must meet to satisfy the First Amendment. See *Seattle Times Co.*, 467 U.S. at 37.

¹⁶¹ See *Seattle Times Co.*, 467 U.S. at 36 (Protective-order rule “confers broad discretion on the trial court to decide when a protective order is appropriate *and what degree of protection is required.*” (emphasis added)).

¹⁶² See, e.g., *Kamp Implement Co. v. J.I. Case Co.*, 630 F. Supp. 218, 221 (D. Mont. 1986).

¹⁶³ See, e.g., *Stone Connection, Inc. v. Simpson*, No. 4:07-CV-431, 2008 WL 1927033, at *1 (E.D. Tex. Apr. 28, 2008) (denying protective order in trade secret case where “conclusory statements” did not “suffice” to establish good cause for the order).

approach on its head, obviating the First Amendment burden typically placed on parties seeking speech-restricting protective orders.¹⁶⁴

C. Competitor Cases

One argument against sharing protective orders is that attorneys in the sharing class (representing similar litigants, not competitors of the producing party) might inadvertently or intentionally leak protected documents.¹⁶⁵ Those documents, the reasoning goes, could then fall into the hands of competitors.

But how do courts address the risk of harmful disclosure in the higher risk context of cases *between* competitors? It turns out that they require specific and substantial evidence of harm before denying access to proprietary discovery information, even in cases involving *direct* competitors.¹⁶⁶

For example, in *Volvo Penta of the Ams., Inc. v. Brunswick Corp.*, a federal district court refused to enter an onerous “outside-counsel-only” protective-order provision in a competitor case.¹⁶⁷ This provision would have prevented virtually everyone but the parties’ outside counsel from viewing discovery information.¹⁶⁸ The court declined to include the provision because there was no evidence that an in-house lawyer was involved in competitive decision making for her employer.¹⁶⁹

In *Volvo*, like most complex cases, both parties had agreed that some form of protective order was appropriate.¹⁷⁰ The disagreement before the court was which of two competing orders was adequate—a narrower version allowed in-house counsel access while a broader version forbade it.¹⁷¹ The court’s decision was particularly high stakes because *Volvo* and *Brunswick* were apparently “hostile” competitors.¹⁷²

¹⁶⁴ See, e.g., *Kamp Implement*, 630 F. Supp. at 220 (approving sharing protective order and recognizing that the “burden” to obtain a non-sharing order remains “squarely upon defendants, as is required by Rule 26(c) and the first amendment”) (internal quotations omitted).

¹⁶⁵ See *Volvo Penta of the Ams., Inc. v. Brunswick Corp.*, 187 F.R.D. 240, 243, 245 (E.D. Va. 1999).

¹⁶⁶ See *id.* at 242.

¹⁶⁷ *Id.* at 245.

¹⁶⁸ See *id.* at 241.

¹⁶⁹ *Id.* at 242–45.

¹⁷⁰ *Id.* at 241.

¹⁷¹ See *id.*

¹⁷² See *id.*

The district court, citing the seminal circuit case on outside-counsel protective orders, denied the outside-counsel-only provision.¹⁷³ The court went on to observe that Brunswick's in-house counsel testified in an affidavit that she had no role in "competitive decision making."¹⁷⁴ Volvo produced no specific contrary evidence to establish that disclosing the documents to the in-house lawyer would harm its competitive position other than to contend she *might* inadvertently disclose the information to someone in her company with the power to make a competitive decision.¹⁷⁵

The court recognized the risk of inadvertent disclosure by an otherwise protective-order-abiding in-house attorney but noted that in-house lawyers "like any other retained attorney, must serve as 'officers of the court' and must abide by the 'same Code of Professional Responsibility and ethics.'"¹⁷⁶ As a result, the court "could not merely assume that in-house attorneys would allow confidential information to fall into the hands of their employer."¹⁷⁷ After concluding that no evidence indicated that Brunswick's in-house lawyer played a role in the company's competitive decision making, the court held that it should enter the less restrictive protective order and allow her access.¹⁷⁸

Volvo is one among dozens of representative cases applying the "competitive-decision-making" analysis to limit the scope of protective orders in direct competitor cases.¹⁷⁹ In many of these cases, including decisions emanating from Texas federal courts, trial judges allow one competitor's in-house counsel access to another competitor's proprietary information.¹⁸⁰ And in many instances, courts do so because the party seeking to exclude in-house lawyers from viewing the information does not put forward specific evidence of serious harm that would flow from such a

¹⁷³ *See id.* at 243.

¹⁷⁴ *Id.* at 244.

¹⁷⁵ *See id.* at 243.

¹⁷⁶ *Id.* (quoting *U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1468 (Fed. Cir. 1984)).

¹⁷⁷ *Id.*

¹⁷⁸ *See id.* at 243–45.

¹⁷⁹ *See also, e.g.,* *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 274 F.R.D. 576, 583–84 (E.D. Va. 2010).

¹⁸⁰ *See, e.g.,* *Life Techs. Corp. v. Biosearch Techs., Inc.*, No. 2:09-CV-283-TJW-CE, 2011 WL 1157860, at *3 (E.D. Tex. Mar. 29, 2011) (allowing access to competitor's in-house attorneys where no specific evidence supported risk of disclosure).

disclosure—even where the lawyer works *directly for* the competing company.¹⁸¹

Like in-house attorneys who are allowed access to their competitors' trade secrets, the non-competitor attorneys in the typical discovery-sharing case who would receive trade secret information under the sharing provision should be required to agree not to disclose the information inappropriately.¹⁸² And although there is some negligible risk of inadvertent disclosure under any protective order, sharing or non-sharing, attorneys receiving shared discovery “must serve as ‘officers of the court’ and must abide by the ‘same Code of Professional Responsibility’ and ethics” as the attorneys who first receive the information in the original case.¹⁸³

A similar argument against sharing posits that protective orders have been violated in the past and therefore could be violated in the future.¹⁸⁴ But this argument ignores the reality that all protective orders, sharing and non-sharing, can be violated. Thus, if one accepts a version of the world where the violability of protective orders means they are always inadequate, no protective order would ever suffice to protect trade secret information. Some have suggested as much—arguing to the court that all protective orders may be insufficient to protect trade secrets.¹⁸⁵ Accepting this argument could mean Texas Rule of Evidence 507 would function much like an absolute privilege—trade secrets would be beyond litigants' reach, even if justice depended on their disclosure.

By its own language, Rule 507 is not an absolute privilege, however.¹⁸⁶ The court recognized this, holding that “protective orders” may be “appropriate” to protect trade secrets and rejecting a contention that Texas Rule of Evidence 507 should function like an absolute privilege.¹⁸⁷ To accept the position that speculative, unspecified protective-order violations

¹⁸¹ See, e.g., *id.*

¹⁸² See, e.g., *Garcia v. Peeples*, 734 S.W.2d 343, 348 (Tex. 1987) (noting that trial courts can require parties to agree not to disclose shared discovery information inappropriately).

¹⁸³ See *Volvo Penta of the Ams., Inc.*, 187 F.R.D. at 243 (quoting *U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1468 (Fed. Cir. 1984)).

¹⁸⁴ Cf., e.g., Brief of Amicus Curiae Product Liability Advisory Council, Inc., In Support of Relator at 7, 9–12, *In re Cont'l Tire of the Ams., LLC* (No. 12-0124), 2012 WL 6042916 (Tex. May 7, 2012).

¹⁸⁵ *Id.* at 7 (“... the reality is that protective orders in trade secret cases frequently do not work . . .”).

¹⁸⁶ See TEX. R. EVID. 507.

¹⁸⁷ See *In re Cont'l Gen. Tire, Inc.*, 979 S.W.2d 609, 612–13 (Tex. 1998).

make protective orders unsuitable is to accept that the second half of Rule 507, which provides for the disclosure of trade secrets pursuant to protective orders, is meaningless.¹⁸⁸ This absolute reading of Rule 507 is inconsistent with Texas and federal law.¹⁸⁹

D. Modification and Jurisdiction Issues

Perhaps one explanation for Texas's affinity for sharing protective orders is a possible limitation on Texas courts' jurisdiction to modify protective orders after a final judgment.¹⁹⁰

Federal courts, by contrast, have long recognized that parties or non-parties (including similar litigants, media, and members of the public) may intervene and request to modify a protective order.¹⁹¹ This is even true long after cases settle or otherwise reach final judgment.¹⁹²

Many federal courts, in fact, prefer later protective-order modifications to upfront, *Garcia*-style sharing provisions.¹⁹³ To understand the difference between an upfront sharing provision and a later modification, imagine that in Case 1, Party X sues Corporation Y alleging that Y's widget injured X. The court in Case 1 enters a non-sharing protective order, allowing X and Y to use discovery information only for the purpose of resolving Case 1. Case 1 settles and is disposed of through a final order or judgment.

Some years later, Party A sues Corporation Y in Case 2, alleging that Y's widget injured A. Party A would like to use discovery from Case 1 (same defendant, same widget) to avoid having to repeat the efforts of Party X.

¹⁸⁸ See TEX. R. EVID. 507.

¹⁸⁹ See *In re Cont'l*, 979 S.W.2d at 614 (rejecting tire manufacturer's argument that the Rule 507 trade secret protection should operate as an "absolute" privilege).

¹⁹⁰ See *Times Herald Printing Co. v. Jones*, 730 S.W.2d 648, 649 (Tex. 1987) (per curiam) (holding that trial court did not have power to "unseal" litigation documents after plenary power expired).

¹⁹¹ See, e.g., *United Nuclear Corp. v. Cranford Ins. Co.*, 905 F.2d 1424, 1427 (10th Cir. 1990); cf. *Benham*, *supra* note 2, at 2210.

¹⁹² See *Pub. Citizen v. Liggett Grp., Inc.*, 858 F.2d 775, 782 (1st Cir. 1988) ("We note that the courts and commentators seem unanimous in finding such an inherent power to modify discovery-related protective orders, even after judgment, when circumstances justify."); see also MOORE, *supra* note 64, at ¶ 26.106[1] ("As long as a protective order remains in effect, the court that entered the order retains the power to modify it, even if the underlying suit has been dismissed.")

¹⁹³ See *Benham*, *supra* note 2, at 2228–29.

Because the protective order in Case 1, however, is non-sharing, Party X cannot share the information with Party A. Party A may, however, petition the court in Case 1 to modify its protective order to allow Party A to use the Case 1 information in Case 2. Under federal law, the court in Case 1 has ongoing jurisdiction to do so, and courts routinely engage in such modifications.¹⁹⁴

Texas case law, on the other hand, gives a less-than-clear answer on post-plenary protective-order jurisdiction. In April 1987, a few months before the Texas Supreme Court decided *Garcia v. Peeples*, it decided a lesser-known case that arguably undermined trial-court power to modify existing protective orders.¹⁹⁵ In *Times Herald Printing Co. v. Jones*, a non-party newspaper moved to unseal court files and discovery materials in a civil lawsuit more than five months after an agreed final judgment in the case.¹⁹⁶

Chief Justice Hecht, then presiding trial judge of the 95th District Court in Dallas, denied the motion.¹⁹⁷ The Dallas Court of Appeals affirmed, agreeing that the trial court had jurisdiction to consider the motion and affirming on the merits.¹⁹⁸

On writ of error, the Texas Supreme Court reversed in a summary opinion, holding that the trial court's plenary power over the sealing order had expired pursuant to Texas Rule of Civil Procedure 329b.¹⁹⁹ At a minimum, *Times Herald* raises questions about a trial court's power to modify protective orders after cases settle or otherwise reach a final judgment. And one could speculate that *Garcia v. Peeples*, decided months later in July 1987, could very well have been the court's pragmatic recognition that *Times Herald* made sharing through later, post-plenary protective-order modifications untenable.

¹⁹⁴ See, e.g., *United Nuclear*, 905 F.2d at 1427 (relying on continuing jurisdiction to modify protective orders); see also Benham, *supra* note 2, at 2228–29.

¹⁹⁵ *Times Herald*, 730 S.W.2d at 648.

¹⁹⁶ 717 S.W.2d 933, 935 (Tex. App.—Dallas 1986), *vacated and dismissed*, 730 S.W.2d 648 (Tex. 1987).

¹⁹⁷ *Id.* at 933.

¹⁹⁸ *Id.* at 935.

¹⁹⁹ *Times Herald*, 730 S.W.2d at 649. Specifically, the court took issue with both the trial court hearing a motion from a non-party (the newspaper) that did not intervene before the trial court's plenary power expired and with the court of appeals implying that the district court "only lost its plenary power to *alter* or *change* the judgment and that it still had plenary power to *uphold* the judgment." *Id.*

Since *Times Herald*, the court has not definitively overruled the case to provide for definitive continuing protective-order modification jurisdiction. This uncertainty is in tension with the court's approach to post-plenary injunction modifications outside the protective-order context.

Protective orders are similar, in many senses, to prohibitory injunctions—both forbid certain conduct. An injunction could prohibit a wide range of conduct, e.g., the sale or disposal of property or the enforcement of a particular law. At their root, protective orders forbid a specific type of conduct—speech.²⁰⁰

Texas courts have long recognized the power to modify injunctions in light of changed circumstances, even when their plenary power has expired.²⁰¹ Any reading of *Times Herald* as an absolute prohibition against post-plenary protective-order modifications (even with evidence of changed circumstances) seems to conflict with the rule that allows courts to modify final injunctions after the ordinary time for doing so has passed.

This conflict may be reason enough to reject *Times Herald* as a limit on protective-order modification. The better approach to modification would allow trial courts to liberally revisit protective orders, even after ordinary jurisdiction has expired. The Texas Supreme Court, however, has not yet explicitly overruled the case in the protective-order context. But Texas Rule of Civil Procedure 76a did create post-judgment jurisdiction for at least a subset of protective and sealing orders.²⁰² This sliver of jurisdiction has turned out to be quite narrow.²⁰³

In 1990, the court adopted Texas Rule of Civil Procedure 76a.²⁰⁴ Rule 76a(7) does create jurisdiction in some protective-order cases.²⁰⁵ This continuing jurisdiction provision may very well have been, at least in part, a reaction to *Times Herald's* apparent anti-modification holding. Indeed, one of 76a's primary proponents expressly recognized that before the adoption of Rule 76a, intervening to modify a protective order after plenary power

²⁰⁰ See generally Donald J. Rendall, Jr., *Protective Orders Prohibiting Dissemination of Discovery Information: The First Amendment and Good Cause*, 1980 DUKE L.J. 766 (1980).

²⁰¹ See, e.g., *City of San Antonio v. Singleton*, 858 S.W.2d 411, 412 (Tex. 1993) (“A trial court generally retains jurisdiction to review, open, vacate or modify a permanent injunction upon a showing of changed conditions.”).

²⁰² See TEX. R. CIV. P. 76a.

²⁰³ See *Gen. Tire, Inc. v. Kepple*, 970 S.W.2d 520, 524–25 (Tex. 1998).

²⁰⁴ See TEX. R. CIV. P. 76a.

²⁰⁵ See *id.* 76a(7).

expired “was improper because the court entering the order had lost jurisdiction when the judgment became final.”²⁰⁶

At a cursory glance, 76a(7) might automatically provide jurisdiction to modify protective orders to allow sharing in all cases. But the rule actually provides continuing jurisdiction to modify protective orders only in cases involving “court records” as opposed to ordinary unfiled discovery.²⁰⁷ “Court records” under 76a include *filed* documents “of any nature” and a subset of *unfiled* discovery materials that “have a probable adverse effect upon the general public health or safety, or the administration of public office, or the operation of government”²⁰⁸

At another quick glance, then, Rule 76a might apply in a case where the allegations in the petition indicate that unfiled discovery information could reveal that the health and safety of thousands of widget-injury victims (to borrow from the hypothetical above) is in jeopardy. This unfiled discovery could, therefore, be considered “court records” subject to Rule 76a. If so, the rule would provide continuing trial-court modification jurisdiction. But one of the supreme court’s seminal Rule 76a decisions has largely narrowed this route to post-plenary protective-order jurisdiction.²⁰⁹

In *General Tire, Inc. v. Kepple*, the court held that trial courts have no self-executing obligation to determine whether unfiled discovery materials are “court records” under Rule 76a.²¹⁰ Indeed, where “no party or intervenor contends that the discovery is a ‘court record,’ a trial court need not conduct a hearing or render any findings on that issue.”²¹¹ And Rule 76a’s notice and sealing provisions do not apply to non-court-record discovery.²¹²

If Rule 76a’s sealing provisions do not apply, it is unlikely that its continuing jurisdiction provision would apply either. The text of Rule

²⁰⁶ Lloyd Doggett & Michael J. Mucchetti, *Public Access to Public Courts: Discouraging Secrecy in the Public Interest*, 69 TEX. L. REV. 643, 681 n.186 (1991) (citing *Times Herald Printing Co. v. Jones*, 730 S.W.2d 648, 649 (Tex. 1987)).

²⁰⁷ See TEX. R. CIV. P. 76a(7), (9).

²⁰⁸ *Id.* 76a(2)(c).

²⁰⁹ See *Gen. Tire, Inc. v. Kepple*, 970 S.W.2d 520, 522–25 (Tex. 1998).

²¹⁰ See *id.* at 525. This article does not express an opinion on the correctness or wisdom of the *Kepple* holding.

²¹¹ *Id.*

²¹² See *id.*

76a(7) says as much.²¹³ Indeed, the rule indicates that a court retains jurisdiction over a “*sealing order*” (a term typically used to refer to orders sealing court records as opposed to protecting ordinary unfiled discovery).²¹⁴ Another sentence of the same provision establishes the right of a third party to intervene “at any time before or after judgment *to seal or unseal court records.*”²¹⁵ Nowhere does the rule expressly indicate that trial courts have continuing jurisdiction to modify protective orders restricting access to non-court-record unfiled discovery.²¹⁶

Likewise, the text of Rule 76a(9) (Application) expressly indicates that Rule 76a does not apply to run-of-the-mill, non-court-record protective orders.²¹⁷ The provision states that “documents in court files not defined as court records by this rule” are subject to “existing law” and not Rule 76a, presumably including its provision for continuing jurisdiction.²¹⁸

Unfiled discovery is a “court record” under Rule 76a only when a party establishes that it concerns public health or the operation of government.²¹⁹ But in run-of-the-mill protective-order cases (where no party establishes such facts), the text of Rule 76a(7) and 76a(9), along with the court’s decision in *Kepple*, likely eliminates Rule 76a as a source of post-plenary protective-order jurisdiction.²²⁰

²¹³ See TEX. R. CIV. P. 76a(7). Parties who might seek to obtain continuing jurisdiction over a protective order by filing discovery materials would also be out of luck in Texas. Texas Rule of Civil Procedure 191.4 specifically forbids parties from filing myriad forms of discovery. TEX. R. CIV. P. 191.4 (prohibiting parties from filing documents and tangible things produced in discovery, among other discovery materials).

²¹⁴ TEX. R. CIV. P. 76a(7) (emphasis added).

²¹⁵ *Id.* (emphasis added).

²¹⁶ Courts would undoubtedly have post-plenary jurisdiction to consider whether unfiled discovery comprises “court records” pursuant to Rule 76a(2)(c) and 76a(7). See TEX. R. CIV. P. 76a(7); cf. *Kepple*, 970 S.W.2d at 522–25 (reviewing “court records” determination post-judgment). If unfiled discovery were, indeed, “court records,” courts would also have jurisdiction to modify a protective order (treated as a “sealing” order when court records are involved) restricting dissemination of the material. See TEX. R. CIV. P. 76a(7) (“A court that issues a sealing order retains continuing jurisdiction to enforce, alter, or vacate that order.”).

²¹⁷ See TEX. R. CIV. P. 76a(9).

²¹⁸ See *id.* The phrasing is curious in the unfiled-discovery context. Unfiled discovery does not reside in “court files” and discovery comprises more types of information than just “documents.”

²¹⁹ See *id.* 76a(2)(c).

²²⁰ Even in cases where courts indisputably have jurisdiction (e.g. before final judgment), Texas law arguably gives trial courts broad discretion to strike interventions aimed at modifying protective orders. Indeed, Texas Rule of Civil Procedure 60 allows trial courts to strike an

This potential lack of jurisdiction would seriously hamper discovery sharing in a jurisdiction that simultaneously forbids upfront sharing provisions (in even a subset of protective orders). In many instances, discovery materials that could aid courts and litigants in resolving pending disputes exist in closed cases.²²¹ If those materials were produced subject to non-sharing protective orders, and if courts have no power to modify those orders, sharing would be impossible. Individual cases may last two years, one year, or even less than a year. The discovery exchanged in those cases, however, may be pertinent to other similar cases for the better part of a decade (or beyond).²²² In a system without upfront discovery sharing provisions in trade secret cases (the system anti-sharing advocates currently demand), the Texas Supreme Court might react in at least one of three significant ways:

1. A categorical upfront sharing ban would force the court to interpret Rule 76a to provide for continuing jurisdiction over all protective orders, including those that do not restrict dissemination of “court records,” contrary to Rule 76a’s plain language and the court’s decision in *Kepple*;
2. An upfront sharing ban would require the court to overrule *Times Herald* expressly and allow liberal post-plenary modification (the court should do this in any event—courts should have post-plenary power to modify protective orders); OR

intervention when it is not “almost essential to effectively protect the intervenor’s interest.” *Guar. Fed. Sav. Bank v. Horseshoe Operating Co.*, 793 S.W.2d 652, 657 (Tex. 1990). This stands in contrast to federal law, where intervening to modify a protective order is liberally allowed under Federal Rule of Civil Procedure 24. *See, e.g., San Jose Mercury News, Inc. v. U.S. Dist. Court—N. Dist. (San Jose)*, 187 F.3d 1096, 1100 (9th Cir. 1999) (“Nonparties seeking access to a judicial record in a civil case may do so by seeking permissive intervention” under Federal Rule of Civil Procedure 24.). A more malleable intervention standard, like the federal approach, is preferable in the protective-order context.

²²¹*See Garcia v. Peeples*, 734 S.W.2d 343, 347 (Tex. 1987).

²²²The prevalence of “return-or-destroy” provisions in many protective orders would also make sharing through later modification untenable. If parties were required to return or destroy otherwise sharable discovery almost immediately after cases close, post-plenary case-by-case sharing would largely fail. Indeed, parties that no longer possess documents would be unable to share them, protective order modification or not.

3. A sharing prohibition would require the court to amend Rule 329b to provide courts continuing jurisdiction to modify protective orders that do not implicate 76a.

Perhaps the easy answer is simply to continue to allow upfront discovery sharing protective orders—orders that are signed when trial courts undisputedly have jurisdiction to do so.²²³

IV. DISCOVERY SHARING AND COURT EFFICIENCY

As *Garcia v. Peebles* recognized, one of the “public policies” favoring shared discovery is increased court efficiency.²²⁴ Courts and commentators around the country have long lauded discovery sharing as a mechanism to avoid wasteful rediscovery of the same information in similar lawsuits.²²⁵ The value of these features is echoed by historical and current discovery-reform efforts.

A. Discovery Sharing’s Relationship with Litigation Efficiency

While there are subtle disagreements as to the proper mechanism to effectuate sharing, virtually no authority categorically opposes the practice.²²⁶ This unanimity flows largely from sharing’s recognized efficiency benefits.²²⁷ The civil rules echo this pro-efficiency sentiment.²²⁸

Contrary to frequent anti-sharing arguments, e.g., that courts should focus myopically on particular party interests when considering sharing

²²³ See *Garcia*, 734 S.W.2d at 347.

²²⁴ *Id.* at 346–47.

²²⁵ See, e.g., *Raymond Handling Concepts Corp. v. Superior Court*, 45 Cal. Rptr. 2d 885, 887–88 (Cal. Ct. App. 1995) (affirming trial court’s entry of sharing protective order and citing *Garcia* for the proposition that sharing increases systemic efficiency); *Timmins*, *supra* note 22, at 1543 (preferring protective orders with sharing provisions).

²²⁶ Compare Richard L. Marcus, *Myth and Reality in Protective Order Litigation*, 69 CORNELL L. REV. 1, 21–22 (1983) (arguing that collateral litigants should establish entitlement to discovery information before sharing, presumably in an intervention and modification proceeding), with *Timmins*, *supra* note 22, at 1543 (preferring protective orders with sharing provisions); see also *Benham*, *supra* note 2, at 2192, 2199–2200. But see *Campbell*, *supra* note 9, at 784 (opposing discovery sharing).

²²⁷ See, e.g., *Garcia*, 734 S.W.2d at 347.

²²⁸ See TEX. R. CIV. P. 1; FED. R. CIV. P. 1.

requests, the rules suggest that courts should actually construe procedural rules to foster systemic efficiency while furthering the quality of justice.²²⁹

For example, Federal Rule of Civil Procedure 1, largely similar to its Texas counterpart, commands courts and parties to construe and administer the civil rules to “secure the just, speedy, and inexpensive determination of every action and proceeding”.²³⁰ Courts’ responsibility to secure efficiency in every case implies that they should account for the systemic impact of rulings in particular cases. Similarly, Texas Rule of Civil Procedure 1 commands courts to give the rules a “liberal construction” to attain justice “at the least expense both to the litigants and the state as may be practicable”²³¹

Well-crafted discovery-sharing provisions complement Rule 1, making litigation less costly for the state’s courts and litigants on both sides of the docket.²³² The efficiencies generated by sharing are relatively straightforward: Parties in litigation obtain previously produced discovery materials and thereby avoid wasteful rediscovery in contemporaneous or subsequent similar cases.

The savings to litigants comes in the form of having to draft fewer discovery requests, fewer responses to those requests, and fewer motions to compel responses because much discovery information is already available from another case.²³³ The savings to the court system flows from not having to police discovery disputes, a particularly irksome task for trial judges that is both time consuming and tedious.²³⁴ Fewer discovery requests mean fewer disputes over those requests.²³⁵

In response to the obvious, commonsense appeal of sharing as a cost-saving measure, anti-sharing advocates contend that sharing actually makes litigation *less* efficient through several clever but flawed arguments.²³⁶ For instance, some contend that defendants will stop

²²⁹ See TEX. R. CIV. P. 1; FED. R. CIV. P. 1.

²³⁰ FED. R. CIV. P. 1. (emphasis added).

²³¹ TEX. R. CIV. P. 1.

²³² See Benham, *supra* note 2, at 2216.

²³³ See *id.*

²³⁴ Cf., e.g., Brad N. Friedman, *Mass Products Liability Litigation: A Proposal for Dissemination of Discovered Material Covered By a Protective Order*, 60 N.Y.U. L. Rev. 1137, 1154 (1985).

²³⁵ Cf. *id.*

²³⁶ To refute the idea that shared discovery reduces discovery costs, some litigants have cited an increase in discovery costs since *Garcia* was decided in 1987. See, e.g., Relator’s Brief on the

cooperating in discovery to some extent if subjected to sharing orders.²³⁷ According to this pick-up-my-marbles-and-go-home version of the world, trade secret holders are more likely to fight discovery of trade secrets aggressively unless courts forbid trade secret sharing.²³⁸

It is less than clear that trade secret holders are generally less cooperative in a sharing system. No one has put forward any empirical data to suggest that discovery disputes are more frequent in courts that allow sharing. And defendants still have substantial incentives to cooperate in discovery, whether sharing is allowed or not. Resisting discovery is costly, and in many cases those costs could exceed the negligible value (if any) of avoiding the risk of inadvertent or intentional sharing protective order violations.

The particular incentives are, of course, dependent on the nature of the sharing provision and the nature of the information at issue. Trial courts would be in the best position to determine whether a particular protective-order provision creates a significant incentive to resist discovery.²³⁹ So instead of a categorical no-sharing approach, those courts should be afforded the discretion to include sharing provisions or not, as appropriate to further case and systemic efficiencies based on the circumstances.

Some have also suggested that a decision forbidding trade secret sharing would have a minimal impact because trade secrets do not comprise a large percentage of discovery information.²⁴⁰ It is true that trade secret information comprises something substantially less than the whole of discovery information.²⁴¹ Evidence of the relative percentage of trade secret

Merits at 42, *In re Gen. Motors LLC*, 2014 WL 1510890 (Tex. Apr. 16, 2014) (No. 13-0794). This argument ignores what most would acknowledge is a substantial, if not primary, driver of increased discovery costs—the explosion of electronic information subject to discovery. *See, e.g.*, WRIGHT ET AL., *supra* note 59, at § 2008.2 (“Electronically stored information can present particularly severe problems” of disproportionate discovery; “One of the consequences of the introduction of the computer has been to increase the amount of information available for a variety of purposes. One of these purposes is responding to discovery . . .”).

²³⁷ *See, e.g.*, Campbell, *supra* note 9, at 824 (“Defendants faced with the prospect that documents produced in one case will generate similar claims throughout the country will more aggressively resist disclosure.”).

²³⁸ *See, e.g., id.*

²³⁹ *See Garcia v. Peeples*, 734 S.W.2d 343, 345 (Tex. 1987).

²⁴⁰ *See, e.g.*, Automobile Manufacturers’ Amicus Brief, *supra* note 3, at 40.

²⁴¹ *See id.*

information in discovery is scant or non-existent. Thus, the true impact of a trade-secret-sharing ban is likely to remain a guess.

And even if the relative percentage of discovery impacted by a no-trade-secret-sharing rule is in fact small, alleged trade secrets are often among the most important information in the case—the designs of an allegedly defective product, for example, or information about potentially safer alternative product designs. Sharing this vital information among similar cases (where its importance likely means it is requested in every case) would obviate the need to wastefully rediscover it.

A no-trade-secret-sharing rule could actually incentivize parties to seek trade secret status for a broader swath of information. And an increase in resource intensive trade secret hearings could significantly increase the cost of discovery. If a trade secret designation came with a guaranteed non-sharing protective order for any information so designated, defendants inclined to resist sharing could very well burden courts with trade secret hearings. On the other side of the docket, plaintiffs interested in sharing would likely contest trade secret status more frequently than they currently do. Trade secret hearings, particularly in complex cases involving terabytes of information, can be lengthy and onerous. Adopting a no-trade-secret-sharing rule would likely result in more of them.

Another argument proceeds that a no-sharing rule would impose minimal costs because parties can already share discovery *responses* (as opposed to actual discovery *information*) that identify, but do not include, trade secret data.²⁴² According to this argument, similarly situated litigants could simply request the same data described in the responses and seek to satisfy Rule 507 to the extent trade secrets are at issue.²⁴³

This suggestion exposes the devil in the details of the proposal—to obtain the information, a party would have to re-request it and potentially consume additional, unnecessary court time to establish the party is “entitled to access.”²⁴⁴ Under a sharing protective order, on the other hand, parties and courts could skip that discovery fight altogether and simply obtain the materials subject to appropriate disclosure restrictions.

The efficiency gains under a sharing regime would benefit defendants along with plaintiffs. Thus, it is somewhat puzzling that (typically

²⁴² See Relator’s Brief on the Merits, *supra* note 236, at 43.

²⁴³ See *id.* at 44.

²⁴⁴ See *id.*

corporate) defendants continue to vigorously resist the practice.²⁴⁵ These companies contend, with putative earnestness, that they are concerned about protecting trade secrets and that sharing orders do not do enough to protect those secrets.²⁴⁶

But these same parties also stand to benefit from a non-sharing regime in other, less savory ways. In a non-sharing system, each plaintiff would be forced to seek the same discovery in virtually identical cases, imposing costs that might otherwise be avoided by sharing and raising the price of entry for legitimate claims.²⁴⁷

Indeed, even if a sharing ban were applied just to trade secret information, the cost of bringing some lawsuits might still increase. Assuming trade secret information is sufficiently necessary to be discoverable in one case under Rule 507, other similar cases would presumably need the information as well.²⁴⁸ Making necessary information available only after parties run and rerun the expensive gauntlet of the discovery process and privilege fights in virtually identical cases is, in effect, a form of claim suppression.²⁴⁹

Based on the costs that a categorical non-sharing rule would impose on courts and litigants, the supreme court, and other courts facing similar questions, should affirm *Garcia's* commitment to efficiency.²⁵⁰ In an era with increasing discovery and litigation costs, forbidding sharing in even a subset of cases runs contrary to Rule 1's laudable goal of making justice more affordable.

B. State and National Efficiency Trends

Texas has a history of rulemaking that complements Rule 1's command to reduce litigation costs where possible.²⁵¹ In 1994, rule-recommending entities created by the supreme court reached a consensus that litigation had

²⁴⁵ See Benham, *supra* note 2, at 2206 (“In many cases, the putative reason for requesting a nonsharing order—to protect competitive information—may be pretextual.”).

²⁴⁶ See, e.g., Automobile Manufacturers' Amicus Brief, *supra* note 3, at 24–29.

²⁴⁷ See Benham, *supra* note 2, at 2204, 2206.

²⁴⁸ See *id.*

²⁴⁹ See *id.*

²⁵⁰ See *Garcia v. Peebles*, 734 S.W.2d 343, 346–47 (Tex. 1987).

²⁵¹ See 47 ALEX WILSON ALBRIGHT & CHARLES HERRING, JR., TEXAS PRACTICE SERIES: HANDBOOK ON TEXAS DISCOVERY PRACTICE § 2:3 (2014).

become too expensive and burdensome.²⁵² Justice Hecht (now Chief Justice) expressed his hope for “real restrictions” on discovery.²⁵³

The rulemaking process ultimately produced what are now widely known as the 1999 discovery amendments.²⁵⁴ The amendments were intended to “curb abuses and reduce cost and delay.”²⁵⁵ They created a tiered system of presumptive limits on the number of interrogatories, time limits on depositions, and also a limit on the timeframe to complete discovery.²⁵⁶ Courts retained the power to adjust the presumptive limits for any case, and parties retained substantial latitude to plead cases out of the most restrictive limits.²⁵⁷

More recent amendments to the Texas civil rules also focus on reducing discovery costs and went further in limiting court and party discretion to opt out of discovery restrictions in some cases.²⁵⁸ In 2013, the court adopted Texas Rule of Civil Procedure 169 and amended Rule 190.2, creating an expedited discovery and trial process for smaller cases.²⁵⁹ The changes were responsive to the Texas Legislature’s request for “rules to promote the prompt, efficient, and cost-effective resolution of civil actions when the amount in controversy does not exceed \$100,000.”²⁶⁰

Like Texas’s efforts, current federal rulemaking aims to make federal discovery efficient.²⁶¹ For more than thirty years, federal discovery practice has been the target of reform efforts.²⁶² These changes reflect a belief (by at least some) that discovery in the American pretrial litigation system can be uniquely intrusive and costly, in both time and money.²⁶³ The costs,

²⁵² *Id.*

²⁵³ *Id.*

²⁵⁴ MCDONALD & CARLSON, *supra* note 4, at § 13:2.

²⁵⁵ Nathan L. Hecht & Robert H. Pemberton, *A Guide to the 1999 Discovery Rules Revisions* (Nov. 11, 1998), <http://www.adr.com/law1/rules.htm>.

²⁵⁶ *See* TEX. R. CIV. P. 190, 191, 192, 193, 196, 197, 198, 199; *see also* ALBRIGHT & HERRING, *supra* note 251, at § 2:3.

²⁵⁷ *See* TEX. R. CIV. P. 190, 191, 192, 193, 196, 197, 198, 199; *see also* ALBRIGHT & HERRING, *supra* note 251, at § 2:3.

²⁵⁸ *See* TEX. R. CIV. P. 169, 190.2.

²⁵⁹ *See id.*

²⁶⁰ TEX. R. CIV. P. 169 cmt. 1.

²⁶¹ *See* WRIGHT ET AL., *supra* note 59, at § 2008.1 (describing recent discovery rulemaking efforts); *see also* Benham, *supra* note 2, at 2219–25 (describing recent discovery reform efforts).

²⁶² *See, e.g.,* WRIGHT ET AL., *supra* note 59, at § 2008.1 (describing efforts to constrain the scope and cost of discovery).

²⁶³ *See* Marcus, *supra* note 35, at 17.

according to these voices, flow from both overbroad discovery requests and unfounded boilerplate objections that consume party resources and court time.²⁶⁴

Over the past few decades, rule amendments have repeatedly targeted federal discovery.²⁶⁵ In 1983, amendments formally introduced the concept that discovery should be “proportional.”²⁶⁶ Later amendments narrowed the scope of discovery from information relevant to the “subject matter of the action” to information relevant to parties’ claims or defenses.²⁶⁷

Most recently, a group of judges, academics, and lawyers convened at Duke Law School in 2010 at the request of the federal Advisory Committee for Civil Rules for a major three-day conference.²⁶⁸ Some at the conference contended that past amendments had not gone far enough in curbing excessive discovery.²⁶⁹

Responding to the Duke Conference concerns, the civil rules advisory committee proposed a package of rule amendments in fall 2013.²⁷⁰ Among other changes, the proposal would promote the proportionality limitation into federal Rule 26(b)(1)’s discovery scope provision.²⁷¹ Based on this express limitation, lawyers framing discovery requests and courts considering discovery disputes should restrict discovery to that which is

²⁶⁴ See *id.* at 21.

²⁶⁵ See, e.g., WRIGHT ET AL., *supra* note 59, at § 2008.1 (describing efforts to constrain the scope and cost of discovery). This Article does not express an opinion on the propriety, wisdom, or potential efficacy of the proportionality amendments.

²⁶⁶ See Amendments to the Federal Rules of Civil Procedure, 97 F.R.D. 165, 172 (1983); see, e.g., WRIGHT ET AL., *supra* note 59, at § 2008.1.

²⁶⁷ See *In re Cooper Tire & Rubber Co.*, 568 F.3d 1180, 1184 (10th Cir. 2009) (observing 2000 amendment to narrow the scope of discovery).

²⁶⁸ See Marcus, *supra* note 35, at 17. The conference largely ignored protective-order issues and instead focused on pleading and discovery standards.

²⁶⁹ See *id.*

²⁷⁰ See *id.* The Judicial Conference of the United States forwarded a revised version of the proportionality amendment to the Supreme Court for review in April 2015, and the Supreme Court subsequently sent the package of amendments to Congress. See Supreme Court Order, *supra* note 40; Zoe Tillman, *Federal Judiciary Approves Civil Discovery Rules Changes*, LEGAL TIMES (Sept. 16, 2014), <http://www.law.com/sites/articles/2014/09/16/federal-judiciary-approves-civil-discovery-rules-changes/>.

²⁷¹ See Comm. on Rules of Prac. and Proc. of the Jud. Conf. of the U.S., Preliminary Draft of Proposed Amendments to the Federal Rules of Bankruptcy and Civil Procedure 284–96 (2013), available at <http://www.uscourts.gov/uscourts/rules/preliminary-draft-proposed-amendments.pdf>.

proportional to the case.²⁷² In 2015, the United States Supreme Court approved the amendment and forwarded it to Congress.²⁷³ The proportionality amendment became law in December 2015.²⁷⁴

The rule now sets the scope of discovery to include relevant, non-privileged information in light of “the importance of the issues at stake in the action, the amount in controversy, the parties’ relative access to relevant information, the parties’ resources, the importance of the discovery in resolving the issues, and whether the burden of the discovery outweighs its likely benefit.”²⁷⁵

The debate over proportionality’s place in discovery has been heated. A public comment period during spring 2014 produced over 2,300 comments.²⁷⁶ To some, the amendments did not go far enough in limiting discovery.²⁷⁷ To others, the new limitations will result in a cataclysmic failure of American pretrial litigation.²⁷⁸ As with most matters involving public comment by interested lawyers, the truth probably lies in the middle.²⁷⁹ But it is possible that the changes will lead to at least some reduction of the amount of discovery information exchanged in federal courts.

Consistent with contemporary federal efforts, Texas has long attempted to control discovery costs, from the supreme court’s decision in *Garcia*, to the 1999 discovery amendments, to the recent expedited trial rules.²⁸⁰ Limitations on discovery sharing stand in stark contrast to these efforts. A non-sharing rule in trade secret cases would be a step backward, forcing parties to engage in wasteful, avoidable rediscovery in similar cases and increasing the burden on the system.

²⁷² See Marcus, *supra* note 35, at 20.

²⁷³ See Supreme Court Order, *supra* note 40.

²⁷⁴ See *id.*

²⁷⁵ FED. R. CIV. P. 26(b)(1).

²⁷⁶ See Tera E. Brostoff & Jeffrey D. Koelmay, *E-Discovery Rules Gets Late-Night Rewrite*, *Advisory Committee Approves Rules Package*, 82 U.S.L.W. 1549, 1550 (April 14, 2014).

²⁷⁷ *Cf.*, e.g., Marcus, *supra* note 35, at 23–24 (“From the perspective of the rest of the world, this package of changes is likely to seem very modest, perhaps minimal.”).

²⁷⁸ See Benham, *supra* note 2, at 2225.

²⁷⁹ See *id.*

²⁸⁰ See MCDONALD & CARLSON, *supra* note 4, at § 13:2; see also ALBRIGHT & HERRING, *supra* note 251, at § 2:3.

V. CONCLUSION

One of the most curious features of the discovery-sharing fight is that it flips at least some of the players against their traditional positions. Corporate interests and defense lawyers, who typically line up to support pretrial efficiency reforms, lobby against a practice that creates those very efficiencies.²⁸¹ In response to this observation, those interests might say that efficiency is not the only important concern in pretrial litigation—protecting proprietary information from undue dissemination to competitors is also important. Sharing, according to these voices, increases the risk of that happening.²⁸²

But in almost thirty years of sharing in Texas, opponents of the practice have been unable to identify significant problems with attorneys in the sharing class leaking information to competitors or the public at large. The lack of evidence of actual past harm from discovery sharing is deafening in its silence. And it points firmly to another possible motivation: greater savings that might flow from increasing the cost of entry on those who benefit most from discovery sharing.²⁸³ This group includes individuals who claim to have been injured by common products or business practices. While protecting trade secrets in discovery is important, so too is reducing the cost of litigation.

Sharing has few costs and many benefits. Based on the absence of significant evidence that sharing (over a three-decade time period) has deprived anyone of the value of a trade secret, the practice should continue in Texas and beyond.

²⁸¹ See, e.g., Automobile Manufacturers' Amicus Brief, *supra* note 3.

²⁸² See, e.g., Campbell, *supra* note 9, at 824–25 (sharing increases risk of harm to producing parties).

²⁸³ See, e.g., Benham, *supra* note 2, at 2206.

Take a Second-Look at Liquidated Damages in Texas (Regardless of What the Texas Supreme Court Says)

Trey Qualls*

I. INTRODUCTION

The purpose of a liquidated damages clause in a contract is to allow the parties to agree in advance to the amount of compensation due one party in the event of the other party's breach.¹ Texas courts have long recognized the general enforceability of liquidated damage clauses.² These clauses have become routine in various types of contracts, including real estate sales contracts, construction contracts, and noncompetition agreements to name a few.³ However, as always, the right of contracting parties to make their own bargains is not completely unlimited.⁴ The fundamental goal of the law when it comes to contract damages is to redress breach by compensating the injured party, not to preemptively deter breach by compelling performance.⁵ Therefore, courts will not enforce a liquidated damages provision deemed to function as a "penalty" intended only to secure the performance of the contract.⁶

The determination of whether a provision in a contract is an enforceable liquidated damages clause or an unenforceable penalty is a question of law

*Candidate for Juris Doctor, 2016, Baylor University School of Law. I would like to thank my faculty advisor, Professor Luke Meier, for his assistance and feedback in composing this Note. I would also like to thank Professors Rory Ryan and Mike Morrison for bringing this topic to my attention in their Contracts and Remedies classes, respectively. Last but not least, I would like to thank my wife, Natalie, for all of her love and support.

¹ *Garden Ridge, L.P. v. Advance Int'l, Inc.*, 403 S.W.3d 432, 438 (Tex. App.—Houston [14th Dist.] 2013, pet. denied).

² *See, e.g., Durst v. Swift*, 11 Tex. 273, 282 (1854).

³ 2 William V. Dorsaneo III, *Texas Litigation Guide* § 21.10[4][b] (2015).

⁴ *Phillips v. Phillips*, 820 S.W.2d 785, 788 (Tex. 1991).

⁵ 3 E. ALLAN FARNSWORTH, *FARNSWORTH ON CONTRACTS* § 12.18, at 301 (3d ed. 2004).

⁶ *See Roberts v. Dehn*, 416 S.W.2d 851, 853 (Tex. Civ. App.—Dallas 1967, no writ).

for the courts to decide.⁷ However, courts have often struggled with articulating and applying consistent standards in making this determination.⁸ The distinction between a valid liquidated damages clause and an illegal penalty has been called one of the most subtle questions of the law,⁹ leading one New York Court of Appeals judge to comment that “[t]he ablest judges have declared that they felt themselves embarrassed in ascertaining the principle on which the decisions . . . were founded.”¹⁰

In many jurisdictions, older opinions often make reference to the “intention of the parties” as being the controlling factor.¹¹ However, commentators have noted these statements can be somewhat misleading.¹² For even in those early decisions, courts regularly acknowledged that “mere use of the term ‘penalty,’ or the term ‘liquidated damages,’ does not determine this intention, if, on the whole, the instrument discloses a different intent.”¹³ Thus, the decisions appear to have turned on some criteria other than simply what the parties intended as evidenced by the language in their contracts.¹⁴

⁷Baker v. Int’l Record Syndicate, Inc., 812 S.W.2d 53, 55 (Tex. App.—Dallas 1991, no writ); Mayfield v. Hicks, 575 S.W.2d 571, 576 (Tex. Civ. App.—Dallas 1978, writ ref’d n.r.e.); Schepps v. Am. Dist. Tel. Co. of Tex., 286 S.W.2d 684, 690 (Tex. Civ. App.—Dallas 1955, no writ).

⁸Roy Ryden Anderson, *Liquidated Damages Under the Uniform Commercial Code*, 41 SW. L.J. 1083, 1085 (1988).

⁹Zucht v. Stewart Title Guar. Co., 207 S.W.2d 414, 418 (Tex. Civ. App.—San Antonio 1947, writ dismissed).

¹⁰Cothel v. Talmage, 9 N.Y. 551, 553 (1854); see also Giesecke v. Cullerton, 117 N.E. 777, 778 (Ill. 1917) (“This court has said more than once that no branch of the law is involved in more obscurity by contradictory decisions than whether a sum specified in an agreement to secure performance will be treated as liquidated damages or a penalty”); Ferguson v. Ferguson, 110 S.W.2d 1016, 1018 (Tex. Civ. App.—Eastland 1937, no writ) (“Whether . . . a sum named in a contract to be paid by a party in default on its breach is to be considered liquidated damages or merely a penalty is one of the most difficult and perplexing inquiries encountered in the construction of written agreements.”) (internal quotation marks omitted).

¹¹See, e.g., City of Indianola v. Gulf, W. Tex. & Pac. Ry., 56 Tex. 594, 606 (1882); Durst v. Swift, 11 Tex. 273, 281 (1854); Fessman v. Seeley, 30 S.W. 268, 269 (Tex. Civ. App.—San Antonio 1895, no writ).

¹²24 SAMUEL WILLISTON & RICHARD A. LORD, A TREATISE ON THE LAW OF CONTRACTS § 65:11, at 274–75 (4th ed. 2002).

¹³Yetter v. Hudson, 57 Tex. 604, 613 (1882) (internal quotation marks omitted).

¹⁴See Comment, *Liquidated Damages and Penalties Under the Uniform Commercial Code and the Common Law: An Economic Analysis of Contract Damages*, 72 NW. U. L. REV. 1055, 1062 n.47 (1978) (quoting 11 JOSEPH M. PERILLO, CORBIN ON CONTRACTS § 58.5, at 426 (rev. ed. 2005) (“the intention of the parties is to control, as long as they have the right intention”));

Underlying this purported “intention of the parties” analysis were often two criteria which have become the modern two-part test for analyzing liquidated damages clauses in almost every jurisdiction across the country.¹⁵ The first prong of the test requires that the harm which could be expected to flow from a breach of the contract must be difficult or impossible to estimate.¹⁶ The second requirement is that the amount stipulated as liquidated damages must be a reasonable estimate of just compensation.¹⁷

At first glance, these two criteria already appear at odds with one another: one based on uncertainty, the other reasonableness. Regarding the first prong, jurisdictions (including Texas) generally agree that the uncertainty of the damages must exist at the time the contract was negotiated and entered into.¹⁸ The second element—often referred to as the more important analysis—is where jurisdictions have differed widely.¹⁹ The reasonableness analysis raises questions such as “reasonable as compared to what?” and “determined as of when?”²⁰ How a court answers these questions generally places the jurisdiction into one of two camps: those taking a *prospective* approach to the reasonableness analysis, and those taking a *retrospective* approach.²¹

Confusingly, Texas courts have at times used language that would seem to place it in both camps.²² This Note will attempt to briefly describe the differences between the two approaches,²³ trace the history of Texas jurisprudence regarding the reasonableness analysis,²⁴ and shine a light on

Anderson, *supra* note 8, at 1086 (“Professor Corbin was quick to point out that this reasoning was wholly circular. In the context of liquidated damage provisions, ‘intent of the parties’ provided nothing more than a means for squaring doctrine with result.”) (citations omitted).

¹⁵ See WILLISTON & LORD, *supra* note 12, § 65:16, at 291–94; Anderson, *supra* note 8, at 1086.

¹⁶ Polimera v. Chemtex Envtl. Lab., Inc., No. 09-10-00361-CV, 2011 Tex. App. LEXIS 3886, at *11 (Tex. App.—Beaumont May 19, 2011, no pet.).

¹⁷ *Id.*

¹⁸ Arthur’s Garage, Inc. v. Racial-Chubb Sec. Sys., Inc., 997 S.W.2d 803, 810 (Tex. App.—Dallas 1999, no pet.); 11 JOSEPH M. PERILLO, CORBIN ON CONTRACTS § 58.11, at 459 (rev. ed. 2005); WILLISTON & LORD, *supra* note 12, § 65:15, at 290.

¹⁹ See Comment, *supra* note 14, at 1065.

²⁰ WILLISTON & LORD, *supra* note 12, § 65:17, at 299.

²¹ See *id.* at 302.

²² See *infra* Part III.

²³ See *infra* Part II.

²⁴ See *infra* Part III.

what appears to be the current Texas approach as applied in the recent Texas Supreme Court decision of *FPL Energy LLC v. TXU Portfolio Management Company*.²⁵ As that case demonstrates, while Texas courts may use seemingly contradictory language to describe what it is they are doing with regard to the reasonableness analysis, in application their analysis is most consistent with a retroactive or “second-look” approach. Finally, this Note will offer a few basic drafting recommendations for increasing the likelihood that a liquidated damages provision will be enforced in Texas.

II. THE TWO APPROACHES FOR ASSESSING THE REASONABLENESS OF LIQUIDATED DAMAGES

As mentioned above, it is generally well-settled that the uncertainty of damages must be present at the time of contract formation.²⁶ Because few cases have hinged on the uncertainty element,²⁷ the reasonableness of the stipulated damages clause is often decisive. This section provides a basic discussion of the two approaches to the timing of the reasonableness analysis. The purpose is merely to explain the different approaches and their application, not to advocate for one approach over the other. The latter decision is left to the courts.

A. The “Single-Look” Approach

Traditionally, the reasonableness of a liquidated damages clause was judged at the time the contract was made, not the time at which a subsequent breach occurred.²⁸ This approach to reasonableness is sometimes called a “prospective” or “single-look” approach.²⁹ Courts using

²⁵ See *infra* Part IV.

²⁶ *Oetting v. Flake Unif. & Linen Serv., Inc.*, 553 S.W.2d 793, 796 (Tex. Civ. App.—Fort Worth 1977, no writ); see *Stewart v. Basey*, 245 S.W.2d 484, 486 (Tex. 1952); see also Comment, *supra* note 14, at 1064. While it is worth noting that the uncertainty analysis is also susceptible to the same prospective/retrospective debate as the reasonableness analysis, there appears to be more agreement across jurisdictions that the damages must be difficult to estimate at the time of contract formation. Comment, *supra* note 14, at 1064. With that said, some commentators have suggested that courts are strongly affected by the facts as of the time of trial and that even for courts proclaiming a prospective approach “what counts is the convenience and efficiency by which actual damages can be measured *at trial*.” *Id.* at 1065 (emphasis added).

²⁷ PERILLO, *supra* note 18, § 58.7, at 440.

²⁸ FARNSWORTH, *supra* note 5, § 12.18, at 305–06.

²⁹ WILLISTON & LORD, *supra* note 12, § 65:17, at 299–300.

this approach compare the amount of damages stipulated in the contract to the amount of damages that could have reasonably been foreseen or anticipated based solely on what the parties knew at the time of contract formation.³⁰ As one court applying this approach explained, “[t]he standard of measure here is not furnished by the plaintiff’s actual loss or injury . . . but by loss or injury which might reasonably have been anticipated at the time the contract was made It is the look forward, and not backward, that we are called upon to take”³¹ Under this approach, whether actual damages are greater or less than the amount stipulated in the contract is immaterial.³² As long as the liquidated sum was a reasonable prediction of the potential damages—as judged at the time the contract was made—courts following this approach will generally enforce the liquidated damages provision.³³

Courts applying the single-look approach phrase it in a variety of ways. One court has stated that the stipulated amount must bear “a reasonable relation to probable damages and . . . not [be] disproportionate to any damages reasonably to be anticipated.”³⁴ Another has said that the amount in the liquidated damages clause must be a “reasonable estimate of the damages that would actually result if the contract were breached.”³⁵ Regardless of the language used, the court will try to put itself in the same position the parties themselves were in when they were making the contract.³⁶

A 1998 Massachusetts appellate court, in reviewing the enforceability of a liquidated damages provision, surveyed the law of every state to determine which test each state applied to the reasonableness analysis.³⁷ While noting that language and context made precise categorization

³⁰ See *id.* at 300.

³¹ *Banta v. Stamford Motor Co.*, 92 A. 665, 667 (Conn. 1914).

³² *In re Schaumburg Hotel Owner Ltd. P’ship*, 97 B.R. 943, 953 (Bankr. N.D. Ill. 1989).

³³ *Guiliano v. Cleo, Inc.*, 995 S.W.2d 88, 99 (Tenn. 1999); see also *In re Schaumburg*, 97 B.R. at 953 (“parties are not required to make the best estimation of damages, just one that is reasonable”).

³⁴ *Wandler v. Lewis*, 567 N.W.2d 377, 382–83 (S.D. 1997).

³⁵ *Lawyers Title Ins. Corp. v. Dearborn Title Corp.*, 939 F. Supp. 611, 616 (N.D. Ill. 1996), *aff’d in part, vacated in part on other grounds*, 118 F.3d 1157 (7th Cir. 1997).

³⁶ PERILLO, *supra* note 18, § 58.6, at 431; see also *Honey Dew Assocs., Inc. v. M & K Food Corp.*, 241 F.3d 23, 28 n.3 (1st Cir. 2001) (“a judge, in determining the enforceability of a liquidated damages clause, should examine only the circumstances at contract formation”) (internal quotation marks omitted).

³⁷ *Kelly v. Marx*, 694 N.E.2d 869 (Mass. App. Ct. 1998).

difficult, the court found that the single-look approach was most commonly applied, though only by a slight margin.³⁸ At that time, twenty-two states applied a single-look approach³⁹; twenty applied a second-look approach⁴⁰; three were controlled by a statute implicating neither approach⁴¹; and in the remaining states, the court was not able to discern the approach used.⁴² Interestingly, the year after the appellate court in *Kelly v. Marx* espoused a second-look approach for the state of Massachusetts,⁴³ the Supreme Judicial Court of Massachusetts reversed course and adopted the single-look approach.⁴⁴ Federal courts also appear to apply the single-look test in cases involving federal government contracts.⁴⁵

Courts following the single-look approach cite several advantages to this approach. The most commonly mentioned is the deference it gives to the bargain actually struck by the parties, or what some might call freedom of contract.⁴⁶ As Justice Holmes once said in reviewing the enforceability of a liquidated damages clause, “the proper course is to enforce contract[s] according to their plain meaning, and not to undertake to be wiser than the parties”⁴⁷ In testing the validity of a liquidated damages clause only at the time of contracting, the single-look approach arguably “most accurately matches the expectations of the parties, who negotiated a liquidated damage amount that was fair to each side based on their unique concerns and circumstances surrounding the agreement, and their individual estimate of

³⁸ See *id.* at 873–74.

³⁹ *Id.* at 873.

⁴⁰ *Id.* at 874; see *infra* Part II.B for a discussion of the “second-look” approach.

⁴¹ *Kelly*, 694 N.E.2d at 874.

⁴² *Id.*

⁴³ *Id.* at 870.

⁴⁴ *Kelly v. Marx*, 705 N.E.2d 1114, 1116 (Mass. 1999) (“The question before us is whether [the] enforceability of a liquidated damages clause is to be tested by analyzing the circumstances at contract formation, the prospective or ‘single look’ approach, or when the breach occurs, the retrospective or ‘second look’ approach. . . . We agree . . . that a judge, in determining the enforceability of a liquidated damages clause, should examine only the circumstances at contract formation.”).

⁴⁵ See *K-Con Bldg. Sys., Inc. v. United States*, 97 Fed. Cl. 41, 50 (2011).

⁴⁶ See *Kelly*, 694 N.E.2d at 870; *Guiliano v. Cleo, Inc.*, 995 S.W.2d 88, 100 (Tenn. 1999) (“Generally, the parties to a contract are free to agree upon liquidated damages and upon other terms that may not seem desirable or pleasant to outside observers. In that respect, courts should not interfere in the contract, but should carry out the intentions of the parties and the terms bargained for in the contract, unless those terms violate public policy.”) (citations omitted).

⁴⁷ *Guerin v. Stacey*, 56 N.E. 892, 892 (Mass. 1900).

damages in event of a breach."⁴⁸ Related to the idea of freedom of contract, the single-look approach also provides a level of certainty to the parties regarding their potential liability on the contract.⁴⁹ Another advantage is that it saves courts, juries, parties, and witnesses the time and expense of having to litigate actual damages after a breach has occurred.⁵⁰ Furthermore, courts have noted that in a great number of cases the parties themselves are more intimately acquainted with the peculiar circumstances of the contract or the subject matter of the transaction and are therefore better able to compute the probable damages than are courts or juries.⁵¹ In this sense, the courts recognize the estimate of damages made by the parties themselves "as being the best and most certain mode of ascertaining the actual damage, or what sum will amount to a just compensation."⁵²

The obvious downfall of the single-look approach is the potential windfall it can create if, in the event of breach, actual damages turn out to be much less than a stipulated amount deemed reasonable at the time of contracting.⁵³ While such disparity may call into question the initial reasonableness of the pre-estimate in the first place, assuming the amount stipulated *was* reasonable at the time of contracting, a court employing a strict single-look approach would enforce the liquidated damages provision.⁵⁴

The most taxing scenario for the single-look approach is the rare but extreme case where there are no actual damages at all.⁵⁵ Some courts stick firmly to the single-look approach and enforce a liquidated damages provision even in light of a subsequent lack of actual damages, the only question being whether the stipulated sum was reasonable when the contract was made.⁵⁶ This view weighs the practical advantages of

⁴⁸ Kelly, 705 N.E.2d at 1117.

⁴⁹ Guiliano, 995 S.W.2d at 100.

⁵⁰ PERILLO, *supra* note 18, § 58.7, at 438.

⁵¹ Jaquith v. Hudson, 5 Mich. 123, 137 (1858).

⁵² *Id.* at 137-38. For a good article advocating the use of the "single-look" approach, see Dennis R. LaFiura & David S. Sager, *Liquidated Damages Provisions and the Case for Routine Enforcement*, 20 FRANCHISE L.J. 175 (2001).

⁵³ Kelly, 705 N.E.2d at 1117.

⁵⁴ See *In re Schaumburg Hotel Owner Ltd. P'ship*, 97 B.R. 943, 953 (Bankr. N.D. Ill. 1989).

⁵⁵ FARNSWORTH, *supra* note 5, § 12.18, at 307.

⁵⁶ See *Sw. Eng'g Co. v. United States*, 341 F.2d 998, 1003 (8th Cir. 1965) ("It is not unfair to hold the contractor performing the work to such agreement if by reason of later developments damages prove to be less or nonexistent.").

upholding a forecast that was reasonable at the time of contracting over the disadvantages of allowing a party who has sustained no actual losses to recover damages.⁵⁷ Other single-look jurisdictions, however, have recognized the distastefulness of such strict adherence and have drawn a somewhat arbitrary line between cases in which there are no actual damages and those in which actual damages simply turn out to be less than anticipated.⁵⁸

B. The “Second-Look” Approach

The other prevailing method for assessing the reasonableness of a liquidated damages provision compares the stipulated sum in the contract not only to the amount of damages that could reasonably be anticipated at the time of contract formation, but also to the amount of actual damages caused by a subsequent breach of the contract.⁵⁹ This addition of a retrospective analysis from the moment in time of contract breach is often characterized as the “second-look” approach.⁶⁰ The second-look approach is in many ways simply the opposite of the single-look approach. Whereas evidence of actual damages is irrelevant in a true single-look jurisdiction,⁶¹ courts applying a second-look approach will strike down a liquidated damages provision as an unenforceable penalty if the stipulated sum greatly exceeds the amount of actual damages that later result from a breach.⁶² In that case, the plaintiff’s recovery is limited to the actual damages sustained and proven.⁶³ As one court concisely described the process of applying the second-look analysis:

[O]ne must first judge whether the provision was a reasonable *estimate* of difficult-to-ascertain damage at the time the parties agreed to it. If it was a reasonable *estimate*, one must then conduct a retrospective appraisal of [the] liquidated damages provision. . . . If the actual damages turn out to be easily ascertainable, a court must consider whether the stipulated sum is unreasonably and grossly

⁵⁷ FARNSWORTH, *supra* note 5, § 12.18, at 307.

⁵⁸ *Id.* at 307–08.

⁵⁹ *Guiliano v. Cleo, Inc.*, 995 S.W.2d 88, 99 (Tenn. 1999).

⁶⁰ FARNSWORTH, *supra* note 5, § 12.18, at 306.

⁶¹ *See, e.g.*, *Frick Co. v. Rubel Corp.*, 62 F.2d 765, 768 (2d Cir. 1933).

⁶² *Guiliano*, 995 S.W.2d at 99.

⁶³ *Id.*

disproportionate to the real damages from a breach If so, the liquidated damages provision will be deemed unenforceable as a penalty, and the court will award the aggrieved party no more than his actual damages.⁶⁴

Thus, even in a case where the stipulated sum was freely negotiated by the parties and was a reasonable pre-estimate of damages when viewed from the moment of contract formation, under a second-look approach, the provision will not be enforced if actual damages turn out to be substantially lower than the stipulated amount.⁶⁵

Courts adopting the second-look approach often cite to the Uniform Commercial Code and the Restatement (Second) of Contracts for support,⁶⁶ both of which are discussed below regarding their application to Texas law.⁶⁷ While sometimes referred to as the more “modern” test,⁶⁸ as of the 1998 Massachusetts case of *Kelly v. Marx* mentioned above, the second-look approach was slightly less common than the single-look approach.⁶⁹

The advantages and disadvantages of the second-look approach are largely just the flip-side to those of the single-look approach. The main advantage of the second-look approach is that it prevents the windfalls in favor of the non-breaching party that the single-look approach allows, particularly in cases where there are no actual damages at all.⁷⁰ This arguably makes the approach more consistent with the basic principles of contract law—that the aggrieved party should be fully compensated for their losses but that penalty clauses should not be enforced.⁷¹ The biggest criticism of the second-look approach is that it interferes with the parties’ freedom of contract and undermines the certainty they have in their bargains, thus defeating the purpose of stipulating to damages in the first place.⁷²

⁶⁴ *Shallow Brook Assocs. v. Dube*, 599 A.2d 132, 137 (N.H. 1991) (second emphasis added) (citations omitted) (internal quotation marks omitted).

⁶⁵ *Id.*

⁶⁶ WILLISTON & LORD, *supra* note 12, § 65:17, at 302–04.

⁶⁷ *See infra*, Part III.B.

⁶⁸ PERILLO, *supra* note 18, § 58.6, at 431.

⁶⁹ *Kelly v. Marx*, 694 N.E.2d 869, 873–74 (Mass. App. Ct. 1998).

⁷⁰ *See Kelly v. Marx*, 705 N.E.2d 1114, 1117 (Mass. 1999).

⁷¹ *See Anderson*, *supra* note 8, at 1088.

⁷² *See Guiliano v. Cleo, Inc.*, 995 S.W.2d 88, 100 (Tenn. 1999).

III. HISTORY OF TEXAS JURISPRUDENCE REGARDING THE REASONABLENESS ELEMENT

Putting a finger on Texas's approach to the reasonableness analysis seems like it should be as easy as simply placing it in either the single-look or the double-look camp.⁷³ However, a look at the case law reveals that the Texas approach has been less than clear. Different courts have, at times, said different things regarding the appropriate time for assessing the reasonableness of a liquidated damages provision.⁷⁴

Two early Texas cases illustrate the confusion that has plagued the Texas courts on this issue. *Eakin v. Scott*⁷⁵ and *Collier v. Betterton*⁷⁶ were decided relatively close in time—only seven years apart—and written by the same Texas Supreme Court Justice but have been cited as supporting opposite interpretations of the reasonableness analysis. *Eakin* is an 1888 decision written by Justice Gaines.⁷⁷ The case involved a contract for the sale and delivery of cattle from Scott to Eakin for \$50,000.⁷⁸ The contract called for the first payment of \$8,000 to be made by Eakin within sixty days.⁷⁹ The contract also included a liquidated damages clause by which Eakin agreed “that the above amount [\$8,000] shall act as a forfeiture in the event I shall abandon said trade.”⁸⁰ Eakin subsequently breached the contract but refused to pay the \$8,000, so Scott sued to recover the stipulated amount.⁸¹ The court in *Eakin* acknowledged that its decision depended “upon the question whether the stipulation for the forfeiture of the \$8,000 note is to be treated as an agreement for liquidated damages, or as a mere penalty to recover such damages as the plaintiffs should actually

⁷³ Indeed, in 1998, the Massachusetts appellate court seemed to have no trouble labeling Texas a “double-look” jurisdiction. *Kelly*, 694 N.E.2d at 874.

⁷⁴ See *Presnal v. TLL Energy Corp.*, 788 S.W.2d 123, 123 (Tex. App.—Houston [1st Dist.] 1990, writ denied) (“We find that the decisions of the various courts of civil appeals in this state upon this question . . . are hopelessly irreconcilable, and after as full an investigation as we have been able to make of the holdings by our Supreme Court[,] the correct rule to be announced in this case is in considerable doubt . . .”) (quoting *Bourland v. Huffhines*, 244 S.W. 847, 849 (Tex. Civ. App.—Amarillo 1992, writ dismissed w.o.j.)).

⁷⁵ 7 S.W. 777 (Tex. 1888).

⁷⁶ 29 S.W. 467 (Tex. 1895).

⁷⁷ *Eakin*, 7 S.W. at 777–78.

⁷⁸ *Id.* at 778.

⁷⁹ *Id.*

⁸⁰ *Id.*

⁸¹ *Id.*

sustain.”⁸² Although it was agreed by both sides that no actual damages accrued to Scott as a result of Eakin’s breach, the court upheld the liquidated damages clause “without reference to the actual damages sustained.”⁸³

Seven years later, Justice Gaines—now Chief Justice of Texas Supreme Court—wrote the decision in another liquidated damages case, however, this time he sang a different tune.⁸⁴ The *Collier* case involved a contract to build a house.⁸⁵ The contract provided that if Betterton, the contractor, did not complete construction by October 1, he agreed to pay Collier, the owner, \$10 per day for every day thereafter that completion was delayed.⁸⁶ Betterton missed the deadline, and Collier was not able to move into the house until November 12.⁸⁷ Collier sought liquidated damages for the forty-two days he was delayed in taking possession.⁸⁸ Although the liquidated damages award of \$10 per day was ultimately upheld, in its rationale the court stated that “[i]f the supposed stipulation greatly exceed the actual loss, if there be no approximation between them, and this be made to appear by the evidence, then, it seems to us, and then only, should the actual damages be the measure of the recovery.”⁸⁹ Because Betterton had provided no evidence of the amount of actual damages suffered by Collier, the liquidated damages provision was sustained,⁹⁰ and thus the result in *Collier* does not appear all that different from the result in *Eakin*. However, the *Collier* court’s reference to the comparison of actual damages to a stipulated amount represents a marked difference from Justice Gaines’s prior holding in *Eakin* that a liquidated damages provision agreed to by the parties should be enforced “without reference to the actual damages sustained.”⁹¹

⁸² *Id.*

⁸³ *Id.* at 778–79.

⁸⁴ *Collier v. Betterton*, 29 S.W. 467, 467–68 (Tex. 1895).

⁸⁵ *Id.*

⁸⁶ *Id.* So called “delay” clauses for liquidated damages are common in construction contracts. *See, e.g., Commercial Union Ins. Co. v. La Villa Indep. Sch. Dist.*, 779 S.W.2d 102, 106 (Tex. App.—Corpus Christi 1989, no writ); *Loggins Constr. Co. v. Stephen F. Austin State Univ. Bd. of Regents*, 543 S.W.2d 682, 683 (Tex. Civ. App.—Tyler 1976, writ ref’d n.r.e.).

⁸⁷ *Collier*, 29 S.W. at 468.

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Eakin v. Scott*, 7 S.W. 777, 779 (Tex. 1888).

The *Eakin* case appears to have fixed the time for testing the reasonableness of a liquidated damages provision at the time the contract was entered into, disregarding the actual loss sustained.⁹² The *Collier* case, on the other hand, held that a liquidated damages provision is only valid so long as there is an approximation between the amount stipulated and the damages actually suffered.⁹³ In the years following these decisions, Texas courts appeared to endorse one approach or the other based on a desire to either to sustain or strike down the liquidated damages provision in question.⁹⁴ This was the state of the law in 1952 when the Texas Supreme Court decided *Stewart v. Basey*,⁹⁵ which became—and remains—the style case on liquidated damages in Texas.

A. *Stewart v. Basey and the Common Law Test for Liquidated Damages in Texas.*

Stewart v. Basey is often cited as establishing the common law test for liquidated damages in Texas.⁹⁶ The case involved the breach of a lease contract containing a liquidated damages clause.⁹⁷ The lease was for a five-year term, and the rent was \$325 per month.⁹⁸ A liquidated damages clause

⁹²Carl G. Mueller, Jr., Comment, *A Functional Approach in Determining the Validity of a Liquidated-Damages Clause*, 30 TEX. L. REV. 752, 756 (1952).

⁹³*Id.*

⁹⁴*Id.*; see, e.g., *Pippin Bros. v. Thompson*, 292 S.W. 618, 620 (Tex. Civ. App.—Waco 1927, writ dismissed w.o.j.) (“Does the amount of damages it can reasonably be inferred the parties had in contemplation at the time of the execution of the contract . . . bear some reasonable proportion to the amount stipulated?”) (emphasis added); *Norman v. Vickery*, 128 S.W. 452, 453 (Tex. Civ. App.—Dallas 1910, writ refused) (“The question is: What did the parties intend at the time the contract was made?”) (emphasis added); *Whitcomb v. City of Hous.*, 130 S.W. 215, 218 (Tex. Civ. App.—San Antonio 1910, writ refused) (invalidating a liquidated damages clause because the city sustained no actual damages); *Cowart v. Walter Connally & Co.*, 108 S.W. 973, 975 (Tex. Civ. App.—Texarkana 1908, no writ) (holding that the rule announced in *Collier* is “a later expression of the views of the Supreme Court, and we think a better interpretation of the law”).

⁹⁵245 S.W.2d 484 (Tex. 1952).

⁹⁶See, e.g., *Presnal v. TLL Energy Corp.*, 788 S.W.2d 123, 125 (Tex. App.—Houston [1st Dist.] 1990, writ denied); *Cnty. Dev. Serv., Inc. v. Replacement Parts Mfg., Inc.*, 679 S.W.2d 721, 726 (Tex. App.—Houston [1st Dist.] 1984, no writ); *Bethel v. Butler Drilling Co.*, 635 S.W.2d 834, 838 (Tex. App.—Houston [14th Dist.] 1982, writ refused n.r.e.); *U.S. Leasing Corp. v. Smith*, 555 S.W.2d 766, 770 (Tex. Civ. App.—Tyler 1977, writ refused n.r.e.); 2 William V. Dorsaneo III, *Texas Litigation Guide* § 21.10[4][b] (2015).

⁹⁷*Stewart*, 245 S.W.2d at 485.

⁹⁸*Id.*

provided that if the lessee failed to make rental payments when due *or breached any other term of the lease*, the lease would terminate and the lessee would owe liquidated damages of \$150 per month for the remaining months of the unexpired term.⁹⁹ Eleven months into the lease, the lessee vacated the premises and returned his keys to the lessor.¹⁰⁰ The lessor was able to re-let the premises to other tenants—thus negating any actual damages—but still sought liquidated damages from the breaching tenant in the amount of \$150 per month for the remaining months of the original five-year term.¹⁰¹

The Texas Supreme Court rightly identified the controlling question in the case as “whether the language . . . stipulating the damages recoverable for the breach of a lease contract is a provision for liquidated damages or for a penalty.”¹⁰² The court noted that “[v]olumes have been written on the question,”¹⁰³ and it acknowledged the inconsistent judicial decisions on the issue.¹⁰⁴ In its attempt to reconcile these conflicting lines of authority, the court handed down what became generally recognized as the common law test for liquidated damages in Texas: “All agree that to be enforceable as liquidated damages the damages must be uncertain and the stipulation must be reasonable.”¹⁰⁵ In formulating this test, the court relied on language from the Restatement (First) of Contracts,¹⁰⁶ which provided that:

- (1) An agreement, made in advance of breach, fixing the damages therefor, is not enforceable as a contract and does not affect the damages recoverable for the breach, unless
 - (a) the amount so fixed is a reasonable forecast of just compensation for the harm that is caused by the breach, and
 - (b) the harm that is caused by the breach is one that is incapable or very difficult of accurate estimation.¹⁰⁷

Ultimately, the court held that the liquidated damages provision in the lease was not a reasonable forecast of damages because it “provided the

⁹⁹ *Id.*

¹⁰⁰ *Id.*

¹⁰¹ *Id.*

¹⁰² *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Id.* at 485–86.

¹⁰⁵ *Id.* at 486.

¹⁰⁶ *Id.*

¹⁰⁷ RESTATEMENT (FIRST) OF CONTRACTS § 339 (AM. LAW INST. 1932).

same reparation for the breach of each and every covenant” without regard for the varying degrees of importance of the different covenants within the lease.¹⁰⁸ Though often credited with establishing the common law test for liquidated damages in Texas, *Stewart* says nothing about when the reasonableness of a liquidated damages provision is judged or to what extent actual damages are relevant to that determination.

The court did note that “the true test of uncertainty” is “that the damages were very uncertain in the contemplation of the parties when the contract was executed.”¹⁰⁹ One commentator writing soon after the *Stewart* decision believed this language answered the question for the reasonableness prong as well,¹¹⁰ and a court of appeals decision just a few years later seemed to support this belief.¹¹¹ Texas’s adoption of the Uniform Commercial Code’s (UCC) treatment of liquidated damages a decade later, however, would seem to cast doubt on this interpretation, at least as far as transactions under the Code are concerned.

B. The Uniform Commercial Code and the “Anticipated or Actual Harm” Test

The enactment of Article 2 of the UCC in Texas in 1967 represented a significant departure from the common law test of *Stewart* for contracts involving the sale of goods. Section 2-718(1) of the Uniform Commercial Code, adopted in Texas as Section 2.718(a) of the Texas Business and Commerce Code,¹¹² provides that:

Damages for breach by either party may be liquidated in the agreement but only at an amount which is reasonable in light of the anticipated or actual harm caused by the breach,

¹⁰⁸ *Stewart*, 245 S.W.2d at 486–87.

¹⁰⁹ *Id.* at 486.

¹¹⁰ See Mueller, *supra* note 92, at 756 n.21 (“Although the court stated the time in terms of judging uncertainty, it is clear on a reading of the entire opinion that the same time would apply to the determination of reasonableness.”).

¹¹¹ See *Schepps v. Am. Dist. Tel. Co. of Tex.*, 286 S.W.2d 684, 690 (Tex. Civ. App.—Dallas 1955, no writ) (“Generally, the question of whether a sum named in a contract . . . is to be considered as liquidated damages, or merely as a penalty, is . . . to be determined as of the time when the contract was executed. The viewpoint of the parties at the time when the contract was made, and not the situation which is shown to have existed when it was breached, is to be considered in determining the issue as to reasonableness of the stipulation or certainty as to actual damages.”) (citations omitted) (internal quotation marks omitted).

¹¹² TEX. BUS. & COM. CODE ANN. § 2.718(a) (West 2009).

the difficulties of proof of loss, and the inconvenience or non-feasibility of otherwise obtaining an adequate remedy. A term fixing unreasonably large liquidated damages is void as a penalty.¹¹³

While seemingly incorporating both the uncertainty and reasonableness prongs of the common law test, the most significant change is the UCC's specific inclusion of "actual damages" in the determination of reasonableness. Thus, the "anticipated or actual harm" test would appear, at least at first glance, to be most consistent with a second-look approach. As some commentators have pointed out, however, the "anticipated or actual harm" language is actually subject to multiple interpretations.¹¹⁴

There is no debating that the UCC makes actual damages now relevant to the reasonableness determination in contracts for the sale of goods. The question is what role actual damages should play. Does the "anticipated or actual harm" language require that a liquidated damages provision be reasonable when compared with *either* anticipated *or* actual harm?¹¹⁵ Or should the "or" be read as an "and," and thus a stipulated amount must be reasonable when compared to both anticipated *and* actual damages?¹¹⁶

When the test is read literally—in the disjunctive in which it was written—a liquidated damages provision need only be reasonable when compared to one or the other of anticipated harm *or* actual harm.¹¹⁷ As applied by one court approving of this interpretation, anticipated harm and actual harm would be treated as two alternative means for validating a liquidated damages provision.¹¹⁸

¹¹³ U.C.C. § 2-718(1) (AM. LAW INST. & UNIF. LAW COMM'N 2011).

¹¹⁴ See, e.g., Comment, *supra* note 14, at 1070; Anderson, *supra* note 8, at 1099; Margaret L. Hussey, Comment, *Liquidated Damages: A New Rule for Texas Under the Uniform Commercial Code?*, 32 BAYLOR L. REV. 123, 128 (1980).

¹¹⁵ See Comment, *supra* note 14, at 1070–71.

¹¹⁶ *Id.*

¹¹⁷ See Anderson, *supra* note 8, at 1093–94.

¹¹⁸ *Equitable Lumber Corp. v. IPA Land Dev. Corp.*, 344 N.E.2d 391, 395 (N.Y. 1976) ("a liquidated damages provision will be valid if reasonable with respect to [e]ither (1) the harm which the parties anticipate will result from the breach at the time of contracting or (2) the actual damages suffered by the nondefaulting party at the time of [the] breach"); see also *Cal. & Hawaiian Sugar Co. v. Sun Ship, Inc.*, 794 F.2d 1433, 1436 (9th Cir. 1986), *amended by* 811 F.2d 1264 (9th Cir. 1987) ("The choice of the disjunctive appears to be deliberate."); Anderson, *supra* note 8, at 1098 ("Although section 2-718 does refer to actual harm, the reference is in the disjunctive and, therefore, can be read to exclude evidence of actual harm if the clause is found to

A second interpretation of the UCC's "anticipated or actual harm" language is more in line with a second-look approach to reasonableness, where a provision that appeared reasonable at the moment of contract formation—i.e. in relation to "anticipated harm"—could still be held to be an unenforceable penalty if it is not also reasonable when compared with the actual harm that resulted from a breach.¹¹⁹ It is somewhat misleading to characterize this interpretation as requiring that the stipulated amount be reasonable when compared to *both* anticipated and actual harm because there would be no practical reason for invalidating a liquidated damages clause that accurately approximates actual damages but not anticipated harm.¹²⁰ Therefore, in practice, this approach only cares whether the stipulated amount is reasonable when compared to actual damages, which reflects a true second-look approach to reasonableness.

Another question raised by the language of the UCC is what effect to give the last sentence of Section 2-718(1), which states: "A term fixing unreasonably large liquidated damages is void as a penalty."¹²¹ This sentence can be read as either placing an additional restriction on liquidated damages, or as merely explaining the consequence for failing to satisfy the "anticipated or actual harm" analysis in the first sentence.¹²² New York appears to be the lone state interpreting this sentence as a separate test to be applied independently of the criteria in the first sentence of Section 2-718(1).¹²³ This sentence is more accurately read as merely clarifying the penalty imposed once a liquidated amount is found to be unreasonable under the "anticipated or actual harm" test of the first sentence.¹²⁴ Indeed, reading the last sentence as an additional test by which a liquidated

be reasonable in terms of the anticipated loss."); Hussey, *supra* note 114, at 128 ("if at either time the stipulation is reasonable, the provision will be enforced as liquidated damages").

¹¹⁹ See Anderson, *supra* note 8, at 1099.

¹²⁰ *Id.* ("there would be no sense in striking down such a clause, because that would leave the court in a position requiring it to determine damages under usual legal tests, which would bring it to the same dollar amount as the liquidated clause").

¹²¹ U.C.C. § 2-718(1) (AM. LAW INST. & UNIF. LAW COMM'N 2011); TEX. BUS. & COM. CODE ANN. § 2.718(a) (West 2009).

¹²² Hussey, *supra* note 114, at 128.

¹²³ See, e.g., *N. Bloom & Son (Antiques) Ltd. v. Skelly*, 673 F. Supp. 1260, 1268 (S.D.N.Y. 1987) ("The second sentence of § 2-718(1) is held to constitute a separate test . . ."); *Equitable Lumber*, 344 N.E.2d at 395 ("Having satisfied the test set forth in the first part of subdivision (1) of section 2-718, a liquidated damages provision may nonetheless be invalidated under the last sentence of the section if it is so unreasonably large that it serves as a penalty . . .").

¹²⁴ See Hussey, *supra* note 114, at 128; see also Anderson, *supra* note 8, at 1105–06.

damages clause could be invalidated would only seem plausible under the second-look approach described above; for if a stipulated damages provision could satisfy the “*either/or*” test based on its reasonable relation to anticipated damages only to be struck down by the last sentence of Section 2-718(1) for being “unreasonably large,” it would seem to invalidate the “*either/or*” interpretation of the test altogether.¹²⁵ Interestingly, this sentence was completely removed from Section 2-718(1) when Article 2 of the UCC was revised in 2003.¹²⁶ However, because no state chose to adopt the 2003 amendments, they were withdrawn from the Code in 2011,¹²⁷ and thus the sentence remains in Section 2-718(1).

1. The “Equivocation” of the Restatement (Second) of Contracts

Section 356 of the Restatement (Second) of Contracts, published in 1981, was drafted to “harmonize with Uniform Commercial Code Section 2-718(1),”¹²⁸ and provides the following:

Damages for breach by either party may be liquidated in the agreement but only at an amount that is reasonable in the light of the anticipated or actual loss caused by the breach and the difficulties of proof of loss. A term fixing unreasonably large liquidated damages is unenforceable on grounds of public policy as a penalty.¹²⁹

Upon initial inspection, the language of the Restatement (Second) appears to track very closely to the UCC. The Restatement echoes the “anticipated or actual” harm test of the UCC—though it replaces “harm” with “loss”—and, indeed, the Restatement (Second) is often cited as persuasive authority in support of a second-look approach to reasonableness.¹³⁰

¹²⁵ See Anderson, *supra* note 8, at 1106. Paradoxically, this is exactly what the New York Court of Appeals did in *Equitable Lumber* when it held that a liquidated damages provision could satisfy the first sentence of § 2-718(1) and yet still be struck down for being “unreasonably large” per the second sentence. 344 N.E.2d at 395–97.

¹²⁶ U.C.C. § 2-718(1) (as amended in 2003). The reasons provided in the Official Comments were that it was unnecessary, misleading, and redundant. *Id.* cmt. 3.

¹²⁷ U.C.C. Forward to Official Text and Comments (2011).

¹²⁸ RESTATEMENT (SECOND) OF CONTRACTS § 356 reporter’s note (AM. LAW INST. 1981).

¹²⁹ *Id.* § 356(1).

¹³⁰ PERILLO, *supra* note 18, § 58.6, at 434–36; WILLISTON & LORD, *supra* note 12, § 65:16, at 291–92, § 65:17, at 302–03.

However, in the comments to Section 356, the Restatement provides the following: “Furthermore, the amount fixed is reasonable to the extent that it approximates the loss anticipated at the time of the making of the contract, even though it may not approximate the actual loss.”¹³¹ The comment then directs the reader to the following illustration:

A contracts to build a grandstand for B’s race track for \$1,000,000 by a specified date and to pay \$1,000 a day for every day’s delay in completing it. A delays completion for ten days. If \$1,000 is not unreasonable in light of the anticipated loss and the actual loss to B is difficult to prove, A’s promise is not a term providing for a penalty and its enforcement is not precluded on grounds of public policy.¹³²

This comment and illustration seem surprisingly to reflect a single-look approach to reasonableness.

The next illustration uses the same fact pattern as the previous illustration but changes it slightly to address the situation in which there are no actual damages:

The facts being otherwise as stated in [the previous illustration], B is delayed for a month in obtaining permission to operate his race track so that it is certain that A’s delay of ten days caused him no loss at all. Since the actual loss to B is not difficult to prove, A’s promise is a term providing for a penalty and is unenforceable on grounds of public policy.¹³³

The situation *not* addressed by the Restatement, however, is the one that falls just between these two illustrations—the one in which the liquidated damages provision is reasonable when compared to anticipated damages but where actual damages can be readily proven to be much lower than the amount stipulated.¹³⁴ Thus, as one commentator noted, the Restatement “equivocates” on the most difficult liquidated damages situation.¹³⁵

¹³¹ RESTATEMENT (SECOND) OF CONTRACTS § 356 cmt. b (AM. LAW INST. 1981).

¹³² *Id.* § 356 cmt. b, illus. 3.

¹³³ *Id.* § 356 cmt. b, illus. 4.

¹³⁴ Anderson, *supra* note 8, at 1093.

¹³⁵ *Id.*

C. Post-UCC Caselaw in Texas

The additional confusion created by the “anticipated or actual harm” language in the UCC—and repeated in the Restatement (Second) of Contracts—has not been lost on Texas courts.¹³⁶ The question of whether Texas follows the traditional single-look or the modern second-look approach to reasonableness has continued to stymie the intermediate appellate courts,¹³⁷ and cases citing both approaches can still be found since the enactment of the UCC in Texas.¹³⁸ Adding to the confusion, a new breed of cases sprang up in the wake of the UCC and the Restatement in which the courts use language that would seem to support both approaches within a single decision. The following two cases represent this post-UCC trend.

1. Muddying the Water

The facts of *Baker v. International Record Syndicate*¹³⁹ are good facts for a liquidated damages clause. Baker was a photographer hired by International Record Syndicate to photograph a little-known musical

¹³⁶ See *Garden Ridge, L.P. v. Advance Int'l, Inc.*, 403 S.W.3d 432, 438–40 (Tex. App.—Houston [14th Dist.] 2013, pet. denied); *Baker v. Int'l Record Syndicate, Inc.*, 812 S.W.2d 53 (Tex. App.—Dallas 1991, no writ).

¹³⁷ To be fair, the federal courts have not fared much better at nailing down the Texas approach. See, e.g., *Advance Tank & Constr. Co. v. City of DeSoto*, 737 F. Supp. 383, 385 (N.D. Tex. 1990) (citing *Stewart v. Basey* for the proposition that “a liquidated damages provision is to be considered in light of the circumstances as the parties perceived them at the formation of the contract, and not as they exist when the contract was performed (or breached) and the damages occurred”). But see *Thanksgiving Tower Partners v. Anros Thanksgiving Partners*, 64 F.3d 227, 232 (5th Cir. 1995) (stating that under Texas law “liquidated damages must not be disproportionate to actual damages as measured at the time of the breach” and that “if the liquidated damages are disproportionate to the actual damages, the clause will not be enforced and recovery will be limited to the actual damages proven”).

¹³⁸ See, e.g., *Nexstar Broad., Inc. v. Gray*, No. 09-07-364 CV, 2008 WL 2521967, at *3 (Tex. App.—Beaumont June 26, 2008, no pet.) (“Evidence that the harm caused is difficult to estimate, and that the amount of liquidated damages is a reasonable forecast, must be viewed as of the time the parties executed the contract.”); *Murphy v. Cintas Corp.*, 923 S.W.2d 663, 666-67 (Tex. App.—Tyler 1996, writ denied) (holding a liquidated damages provision to be enforceable even though actual damages were readily calculable at the time of trial); *Guido & Guido, Inc. v. Culberson Cty.*, 459 S.W.2d 674, 678 (Tex. Civ. App.—El Paso 1970, writ ref'd n.r.e.) (“The amount of actual damages is relevant to the issue of whether the stipulation for damages is reasonable, for it must be so in order to be enforced and must bear a reasonable relationship to the actual damages contemplated or, in fact, suffered as a result of the breach.”).

¹³⁹ *Baker*, 812 S.W.2d at 53.

group.¹⁴⁰ Baker mailed thirty-seven negatives to the record company, but when the negatives were returned to Baker they had holes punched in them.¹⁴¹ The contract between Baker and the record company provided for liquidated damages of up to \$1,500 per photograph if any photographs were lost or damaged by the record company.¹⁴² On appeal, the court noted that Baker had presented evidence at trial of the wide range he had been paid for similar photographs in the past,¹⁴³ demonstrating both the difficulty of estimating the true value of the photographs as well as the reasonableness of the \$1,500 per photograph estimate.¹⁴⁴ Therefore, based on the band's unknown potential for fame at the time, the inherent difficulty of valuing a piece of art in general, and the broad range of values and long-term earning power of photographs, the court found that \$1,500 per photograph was not an unreasonable estimate of damages.¹⁴⁵

The result in *Baker* seems to be the correct one. This was clearly a situation where the actual damages that could be expected to flow from a breach of the contract would be very difficult to determine at the time of contracting, and there was evidence presented at trial to support the \$1,500 per photograph estimate. But the confusing aspect of *Baker* is not in the result; it is in the reasoning—or rather the language—employed by the court in reaching the result.

After quoting the UCC rule, as codified in the Texas Business and Commerce Code,¹⁴⁶ the court restated the rule using the language of the two-part, common law test of *Stewart*.¹⁴⁷ The court noted this rule “might be termed the ‘anticipated harm’ test.”¹⁴⁸ Even more definitively, the court explicitly stated that “[e]vidence related to the difficulty of estimation and the reasonable forecast must be viewed *as of the time the contract was*

¹⁴⁰ *Id.* at 54–55.

¹⁴¹ *Id.*

¹⁴² *Id.*

¹⁴³ *Id.* at 55 (noting he had made as little as \$125 and as much as \$1,500 off of a single photograph).

¹⁴⁴ *Id.* at 55–56.

¹⁴⁵ *Id.* at 55.

¹⁴⁶ *Id.*; see *supra*, Part III.B.

¹⁴⁷ *Baker*, 812 S.W.2d at 55 (“Under Texas law, a liquidated damages provision will be enforced when the court finds (1) the harm caused by the breach is incapable or difficult of estimation, and (2) the amount of liquidated damages is a reasonable forecast of just compensation.”).

¹⁴⁸ *Id.*

executed."¹⁴⁹ Only a few lines later, however, the court provided that "[a]dditionally, liquidated damages must not be disproportionate to actual damages," and that "[i]f the liquidated damages are shown to be disproportionate to the actual damages, then the liquidated damages can be declared a penalty and recovery limited to actual damages proven."¹⁵⁰ This, the court noted, "might be called the 'actual harm' test."¹⁵¹

Ultimately, the court's intermingling of prospective (single-look) language with retrospective (second-look) language did not affect the result in that case because, on these facts, the actual damages were just as difficult to determine at the time of trial as they had been at the time of contracting.¹⁵² The question not answered by these facts is the same question on which the Restatement "equivocates": what if the estimate was reasonable at the time of contracting but actual damages have become susceptible to calculation by the time of trial and are much less than the stipulated amount?

2. Preparing a Path to the Texas Supreme Court

A recent case out of the Fourteenth Court of Appeals in Houston looked squarely at the relationship between the common law and statutory tests for liquidated damages and decided that they are, in fact, the same test and that both are consistent with a second-look approach to reasonableness.¹⁵³ The *Garden Ridge* case involved the retail housewares chain, Garden Ridge, and one of its vendors, Advance.¹⁵⁴ Garden Ridge placed an order with Advance for 4,450 inflatable snowmen of different sizes, which it planned to sell during the holiday season.¹⁵⁵ Shortly before putting the snowmen out for sale, Garden Ridge realized that some of the snowmen in the shipment did not conform to the purchase order it had submitted to Advance.¹⁵⁶ Garden Ridge decided to sell the snowmen anyway but then charged back to Advance the entire purchase price for all of the snowmen pursuant to a

¹⁴⁹ *Id.* (emphasis added).

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.* at 55–56.

¹⁵³ *Garden Ridge, L.P. v. Advance Int'l, Inc.*, 403 S.W.3d 432, 438–40 (Tex.App.—Houston [14th Dist.] 2013, pet. denied).

¹⁵⁴ *Id.* at 435.

¹⁵⁵ *Id.*

¹⁵⁶ *Id.*

liquidated damages clause in its vendor contract addressing “unauthorized substitution” of merchandise.¹⁵⁷ At trial, Garden Ridge did not establish any amount of actual damages from Advance’s noncompliance with the purchase order.¹⁵⁸

Reviewing whether the liquidated damages provision in the vendor contract was enforceable, the appellate court first noted that the UCC test and the common law test for liquidated damages “reflect the same essential factors and the same type of reasonableness test.”¹⁵⁹ The court equated the first clause of § 2.718(a) (requiring that the liquidated damages be “reasonable in light of the anticipated or actual harm caused by the breach”) with the common law requirement that liquidated damages be a “reasonable forecast of just compensation.”¹⁶⁰ It equated the second and third clauses of § 2.718(a) (regarding “the difficulties of proof of loss”) with the common law requirement “that the harm caused by the breach is incapable or difficult of estimation.”¹⁶¹

Having established that the tests are the same, the court turned to Garden Ridge’s argument for an “ex ante” reasonableness analysis.¹⁶² While acknowledging that language in *Baker* would seem to support Garden Ridge’s single-look theory, the court went on to hold that unreasonableness can be established by showing that actual damages are much less than the amount stipulated in the contract.¹⁶³ Thus, basing its decision on the explicit reference to “actual harm” in the UCC, the court applied a second-look approach and found that the liquidated damages clause was unenforceable because there were no actual damages.¹⁶⁴

A concurring opinion, however, argued that the statutory rule is actually different from and thus supersedes the common law rule in contracts for the sale of goods.¹⁶⁵ The concurring judge felt the majority’s interpretation of the UCC’s language—specifically the word “or”—strained the plain

¹⁵⁷ *Id.* at 435–36.

¹⁵⁸ *Id.* at 436.

¹⁵⁹ *Id.* at 439.

¹⁶⁰ *Id.* at 438.

¹⁶¹ *Id.*

¹⁶² *Id.* at 439 (“That is, if, *at the time the contract is formed*, actual damages are difficult to estimate and the amount specified in the contract is a reasonable forecast of just compensation, a liquidated damages term is enforceable.”) (emphasis added).

¹⁶³ *Id.* at 440.

¹⁶⁴ *Id.*

¹⁶⁵ *Id.* at 447 (Frost, J., concurring) (citation omitted).

meaning of the statute and undermined the freedom of contract.¹⁶⁶ Following the “either/or” interpretation of the UCC discussed above,¹⁶⁷ the judge argued that “a liquidated-damages provision may be reasonable based upon *either* anticipated harm *or* actual harm caused by the breach.”¹⁶⁸ Thus, the party asserting penalty should have to show “unreasonableness under *both* anticipated harm *and* actual harm caused by the breach.”¹⁶⁹ This judge noted “there are now three different and conflicting views on this question from the three intermediate appellate courts that have addressed this issue,”¹⁷⁰ but expressed hope that the Texas Supreme Court would clarify Texas’s position in one of the cases in which the court had recently granted review.¹⁷¹ That case was *FPL Energy LLC v. TXU Portfolio Management Co.*,¹⁷² discussed below.

IV. THE TEXAS SUPREME COURT “CLARIFIES” ITS POSITION ON REASONABLENESS

As noted in the concurrence to *Garden Ridge*, the *TXU* case provided the Texas Supreme Court with an opportunity to settle once and for all the question of whether Texas is a single-look or a second-look jurisdiction.¹⁷³

A. Facts

The facts of the case are somewhat complicated. The case involves a liquidated damages provision in a contract for the production of electricity and renewable energy credits.¹⁷⁴ The plaintiff, TXU, was a retail electricity provider distributing electricity directly to consumers.¹⁷⁵ Beginning in 1999, Texas energy providers, like TXU, were required to purchase a certain portion of the electricity they distribute from renewable sources.¹⁷⁶ At the same time, the legislature also created a renewable energy credit

¹⁶⁶ *Id.* at 448–49.

¹⁶⁷ *See supra*, Part III.B.

¹⁶⁸ *Garden Ridge*, 403 S.W.3d at 448 (Frost, J., concurring).

¹⁶⁹ *Id.*

¹⁷⁰ *Id.* at 450.

¹⁷¹ *Id.*

¹⁷² 426 S.W.3d 59 (Tex. 2014).

¹⁷³ *Garden Ridge*, 403 S.W.3d at 450 (Frost, J., concurring).

¹⁷⁴ *TXU*, 426 S.W.3d at 60–61.

¹⁷⁵ *Id.* at 61.

¹⁷⁶ *Id.*

(REC) trading program, whereby distributors like TXU could purchase RECs in lieu of purchasing actual capacity from renewable sources.¹⁷⁷ One REC represents one megawatt hour of energy produced from renewable sources.¹⁷⁸ The producers of renewable energy, therefore, can sell both the actual renewable energy produced, as well as the RECs created by that production.¹⁷⁹

FPL was a renewable energy production company operating several windfarms.¹⁸⁰ In 2000, TXU contracted with FPL to purchase renewable electric energy, as well as the RECs generated from the production of that energy, in order to meet TXU's statutory renewable energy requirements.¹⁸¹ In the event that FPL failed to meet its obligations under the contract, the contract provided for liquidated damages of \$50 per REC not produced.¹⁸² This \$50 per REC figure was tied to the penalty TXU would be assessed by the Texas Public Utilities Commission for failing to meet its REC requirement.¹⁸³ The contract also provided that if the Public Utilities Commission ever removed or amended the \$50 per REC penalty, the liquidated damages under the contract would be equal to the lesser of (1) the amended penalty or (2) twice the annual average market price per REC as determined by the Public Utilities Commission.¹⁸⁴ For several years, FPL failed to provide the agreed upon amount of renewable energy and RECs to TXU.¹⁸⁵

B. Procedure

TXU sued FPL for breach of contract and sought liquidated damages for FPL's failure to provide the agreed upon RECs and electricity.¹⁸⁶ The trial court refused to enforce the liquidated damages provision because TXU was able to cover by obtaining substitute electricity elsewhere and because it determined that the stipulated amount of \$50 per REC was not a realistic

¹⁷⁷ *Id.*

¹⁷⁸ *Id.*

¹⁷⁹ *Id.*

¹⁸⁰ *Id.*

¹⁸¹ *Id.*

¹⁸² *Id.* at 66.

¹⁸³ *Id.*

¹⁸⁴ *Id.*

¹⁸⁵ *Id.* at 62.

¹⁸⁶ *Id.*

forecast of damages.¹⁸⁷ The court of appeals, however, held that the liquidated damages provision *was* enforceable because the damages were difficult to estimate and the \$50 per REC was a reasonable estimate of just compensation; thus, it assessed damages at \$29 million based on a deficiency of 580,000 RECs and a deficiency rate of \$50 per REC.¹⁸⁸

C. Analysis

For reasons not related to this Note, the Texas Supreme Court held, as a preliminary matter, that the liquidated damages provision could be applied only, if at all, to REC deficiencies (not failure to deliver actual renewable electricity capacity), and only to those REC deficiencies not excused by lack of transmission capacity or curtailment orders from the Electricity Reliability Council of Texas.¹⁸⁹ Thus, the appellate court's damages assessment of \$29 million was immediately cut down to a possible \$11 million based on a 220,000 REC deficiency that was determined to be directly attributable to FPL.¹⁹⁰

The court then considered the enforceability of the liquidated damages provision with regard to those 220,000 RECs.¹⁹¹ After affirming that “[t]he basic principle underlying contract damages is compensation for losses sustained and no more,” the court restated the “two indispensable findings a court must make to enforce contractual damages provisions: (1) the harm caused by the breach is incapable or difficult of estimation, and (2) the amount of liquidated damages called for is a reasonable forecast of just compensation.”¹⁹² Next, the court paid lip service to the traditional, single-look approach by stating: “We evaluate both prongs of this test from the perspective of the parties at the time of contracting.”¹⁹³ And then, like so

¹⁸⁷ *Id.*

¹⁸⁸ *Id.* at 62, 71–72.

¹⁸⁹ *Id.* at 67–68.

¹⁹⁰ *See id.* at 71–72.

¹⁹¹ *Id.* at 72.

¹⁹² *Id.* at 69 (internal quotation marks omitted).

¹⁹³ *Id.* at 69–70 (citing *Polimera v. Chemtex Envtl. Lab, Inc.*, No. 09-10-00361-CV, 2011 Tex. App. LEXIS 3886, at *11–12 (Tex. App.—Beaumont May 19, 2011, no pet.); *Baker v. Int'l Record Syndicate, Inc.*, 812 S.W.2d 53, 55 (Tex. App.—Dallas 1991, no writ); *Mayfield v. Hicks*, 575 S.W.2d 571, 576 (Tex. Civ. App.—Dallas 1978, writ ref'd n.r.e.); *Muller v. Light*, 538 S.W.2d 487, 488 (Tex. Civ. App.—Austin 1976, writ ref'd n.r.e.); *Schepps v. Am. Dist. Tel. Co. of Tex.*, 286 S.W.2d 684, 690 (Tex. Civ. App.—Dallas 1955, no writ); *Zucht v. Stewart Title*

many courts before it, in the very next sentence the court stated that “a liquidated damages provision may be unreasonable because the actual damages incurred were much less than the amount contracted for.”¹⁹⁴

Regarding the first element of the test for liquidated damages, the court agreed with TXU that damages for failure to provide the agreed upon RECs were difficult to estimate at the time of contract formation.¹⁹⁵ The court reached this conclusion based on the uncertain market for RECs at the time of contracting.¹⁹⁶ The statutory scheme was passed in 1999; at the time of contracting in 2000, the market for RECs did not yet exist.¹⁹⁷

Moving on to the second element of the test, the court addressed what it termed the “unbridgeable discrepancy” between the liquidated damages provision as written and the “unfortunate reality in application.”¹⁹⁸ The liquidated damages provision as written provided for liquidated damages of \$50 per REC, or if the statutory penalty applicable to TXU were ever amended, then the lesser of (1) the amended amount or (2) twice the annual average market price per REC as determined by the Public Utilities Commission.¹⁹⁹ Because the statutory penalty had not been amended, and because the Public Utilities Commission had not issued a determination of the average annual market price per REC, applying the liquidated damages provision as written would have resulted in liquidated damages of \$50 per REC.²⁰⁰ The court, however, ignoring the language which required the determination of market value to come from the Public Utilities Commission, stated that “[t]he contracts . . . anticipate that the amount of damages may be tied to market value, rather than an arbitrary number.”²⁰¹ Although the Public Utilities Commission had expressly denied TXU’s request to issue a determination of the annual average market price per REC, the court noted that the actual market value of a REC during the period in question ranged from \$4 to \$14.²⁰² Thus, the court indicated that

Guar. Co., 207 S.W.2d 414, 418 (Tex. Civ. App.—San Antonio 1947, writ *dism’d*); RESTATEMENT (SECOND) OF CONTRACTS § 356 cmt. b (AM. LAW INST. 1981)).

¹⁹⁴ TXU, 426 S.W.3d at 70. (internal quotation marks omitted).

¹⁹⁵ *Id.*

¹⁹⁶ *Id.*

¹⁹⁷ *Id.*

¹⁹⁸ *Id.* at 72.

¹⁹⁹ *Id.*

²⁰⁰ *Id.*

²⁰¹ *Id.* at 71.

²⁰² *Id.* at 72.

the appropriate amount of damages should be between \$8 and \$28 per REC, “depending on what the PUC would have determined as the actual market value of a REC in each year.”²⁰³ This would have placed TXU’s damages somewhere between \$1,760,000 and \$6,160,000.²⁰⁴

Ultimately, because the court found that actual damages, whatever they might have been found to be by the Public Utilities Commission, would have been less than the stipulated amount of \$50 per REC, the court held that the liquidated damages clause was an unenforceable penalty.²⁰⁵ While the court noted that the law does not “create a broad power to retroactively invalidate liquidated damages provisions that appear reasonable as written,” it stated that the forecast of damages in this case “was flawed by its reliance on events that did not and perhaps [could not] occur.”²⁰⁶

D. Implications of TXU

1. What the Texas Supreme Court Held

Whatever its language in getting there, the Texas Supreme Court appears to have interpreted the common law test for liquidated damages to apply a second-look approach to reasonableness, one in which actual damages can retrospectively invalidate a provision even if that provision was reasonable when viewed from the moment of contract formation.²⁰⁷

2. What the Texas Supreme Court Did Not Hold

Contrary to what it may appear, the Texas Supreme Court did not address the question before the court in *Garden Ridge* regarding whether the language of the UCC should be interpreted to require only that liquidated damages be reasonable when compared to *either* anticipated *or* actual harm. The Texas Supreme Court, noticeably, did not mention the UCC in its holding in *TXU* because the UCC is only applicable to transactions in “goods,”²⁰⁸ and the transmission of electrical power has previously been determined by the court not to be a “good” for purposes of

²⁰³ *Id.*

²⁰⁴ *See id.*

²⁰⁵ *Id.*

²⁰⁶ *Id.* (referring to a Public Utilities Commission determination of the market value of RECs during the applicable period).

²⁰⁷ *See id.*

²⁰⁸ U.C.C. §§ 2-102 & 2-105 (AM. LAW INST. & UNIF. LAW COMM’N 2011).

the UCC.²⁰⁹ Until this specific question is addressed by the Texas Supreme Court, it is still an open question; however, based on the results of *Baker* and *Garden Ridge*, and by analogy the court's application of a second-look approach under the common law test in *TXU*, it seems safe to assume that the court would likely place emphasis on actual damages in cases under the UCC as well.

V. DRAFTING RECOMMENDATIONS

As the saying goes, hindsight is twenty-twenty. Or, in the context of liquidated damages, what was reasonable at one point in time may have become unreasonable in retrospect. Thus, it seems that even the most carefully drafted liquidated damages provision may be invalidated as a penalty if actual damages wind up being less than was reasonably anticipated at the time of contracting. There is no precise formula by which to determine when liquidated damages become disproportionate to the actual damages²¹⁰; therefore, the best one can do is try to make sure liquidated damages are reasonable at the time of contracting. With that said, what follows are some general recommendations for drafting liquidated damages clauses in Texas.

A. Call It "Liquidated Damages"

Courts have routinely held that merely designating a clause in a contract as "liquidated damages" will not prevent the courts from holding that it is in fact a penalty, and vice versa.²¹¹ However, there is no sense in inviting controversy.²¹² Therefore, when drafting a liquidated damages provision, avoid using the term "penalty," and instead specifically refer to the provision as "liquidated damages."

²⁰⁹ *Navarro Cty. Elec. Coop., Inc. v. Prince*, 640 S.W.2d 398, 400 (Tex. App.—Waco 1982, no writ).

²¹⁰ *S. Union Co. v. CSG Sys., Inc.*, NO. 03-04-00172-CV, 2005 Tex. App. LEXIS 564, at *17–18 (Tex. App.—Austin Jan. 27, 2005, no pet.).

²¹¹ *Chan v. Montebello Dev. Co.*, No. 14-06-00936-CV, 2008 WL 2986379, at *3 (Tex. App.—Houston [14th Dist.] July 31, 2008, pet. denied).

²¹² FARNSWORTH, *supra* note 5, § 12.18, at 319.

B. Include Explicit "Recitals"

It may be beneficial to include explicit recitals in the contract acknowledging that "actual damages are uncertain and would be difficult of ascertainment," and that both parties agree the stipulated sum "constitutes reasonable compensation in the event of a breach."²¹³ One example, in the context of a contract for the sale of real estate, might include the following:

The parties to this contract agree that the Seller's actual damages, in the event of a default by the Purchaser, would be difficult of definite ascertainment because of the uncertainties of the real estate market and the fluctuations of property values between the date of this contract and the date of breach, and because of differences of opinion with respect thereto, and the parties therefore agree that such amount is, as to each of them, reasonable as liquidated damages.²¹⁴

Parties may also want to clearly express that the stipulated sum is intended as "liquidated damages and not as a penalty," and that it is meant to be "compensatory" rather than "punitive."²¹⁵

Finally, it may be wise to recite a nonexhaustive list of the general categories of losses which are intended to be compensated by the liquidated damages clause.²¹⁶ If nothing else, this may serve as evidence of the types of damages that were "anticipated" by the parties at the moment of contract formation. It also has the added benefit of providing evidence of foreseeability for consequential damages in the event that liquidated damages are not enforced.²¹⁷

C. Avoid "Shotgun" Clauses

Courts have historically invalidated liquidated damages clauses that prescribe the same amount of liquidated damages for breaches of varying degrees of importance.²¹⁸ This type of clause is sometimes referred to as a

²¹³ 10 *Texas Transaction Guide* § 55.293[1][a] (Kendrick et al. eds., 1991).

²¹⁴ *Id.* at § 55.293[2].

²¹⁵ *Id.* at § 55.293[1][a].

²¹⁶ FARNSWORTH, *supra* note 5, § 12.18a, at 320.

²¹⁷ *Id.*

²¹⁸ *See, e.g., Stewart v. Basey*, 245 S.W.2d 484, 486-87 (Tex. 1952).

“shotgun” or “blunderbuss” clause.²¹⁹ Instead, liquidated damages clauses should be drafted narrowly so that the stipulated sum relates to a particular, specific type of breach.²²⁰ Alternatively, a clause in which damages are graduated based on some formula or criteria that take into account the potential for the varying degrees of seriousness of the breach may be more likely to be enforced.²²¹

D. Avoid “Multiples” of Actual Damages

Liquidated damages clauses providing for some multiple of actual damages have been held to be illegal as a matter of law in Texas.²²² The definitive case on this is the Texas Supreme Court case of *Phillips v. Phillips*, in which a partnership agreement between ex-spouses provided for liquidated damages of ten times actual damages in the event of a breach of the partnership agreement.²²³

E. Avoid “Damages-Plus” Clauses

Similar to the “multiples” clauses mentioned above, parties should never draft a liquidated damages clause that attempts to allow the aggrieved party to collect some level of liquidated damages *in addition to* actual damages.²²⁴ This sort of clause has been described as attempting to allow the aggrieved party to “have his cake and eat it too,”²²⁵ and such a clause could never logically be supported as being a reasonable forecast of damages.²²⁶

F. Consider a Choice of Law Provision

A drafter in a second-look jurisdiction wishing to take advantage of the certainty the single-look approach provides may wish to include a choice of law provision directing that the relationship between the parties be controlled by the law of a state following the single-look approach to

²¹⁹ FARNSWORTH, *supra* note 5, § 12.18a, at 319.

²²⁰ Anderson, *supra* note 8, at 1110.

²²¹ *Id.* at 1109–10; FARNSWORTH, *supra* note 5, § 12.18a, at 319.

²²² *Phillips v. Phillips*, 820 S.W.2d 785, 789 (Tex. 1991).

²²³ *Id.* at 786–87.

²²⁴ Anderson, *supra* note 8, at 1110.

²²⁵ *Id.*

²²⁶ FARNSWORTH, *supra* note 5, § 12.18a, at 319.

reasonableness. Note, however, that the forum state may still choose not to apply the law of the chosen state, notwithstanding the choice of law provision, if doing so would violate the public policy of the forum state.²²⁷

G. Consider a Bonus for Early Performance as an Alternative to Liquidated Damages.

An alternative to a liquidated damages clause may be to offer a bonus or premium for early performance.²²⁸ For example, where a \$1,000 per day penalty for delayed performance may be unenforceable, moving the completion date in the contract to 10 days later but then offering a \$1,000 per day bonus for each day the work is finished early may be allowable.²²⁹ Obviously, adjustments for deadlines and contract price must be taken into consideration. While this sort of clause may still be subject to the same penalty analysis as a liquidated damages provision, courts may be understandably hesitant about where to draw the line in this area.²³⁰

H. Other Considerations

Given the second-look approach applied by the Texas Supreme Court in *TXU*, it may go without saying that a forecast of damages has a better chance of being viewed as reasonable if there is, in fact, *some* level of actual damages proven.²³¹ Plaintiffs with no actual damages have lost the ability in Texas to hide behind a liquidated damages clause that appeared reasonable at the outset. Even actual damages that are smaller than expected stand a better chance of being reasonable compared to a stipulated amount than *no* damages at all. Thus, if a defendant can prove, or if a plaintiff concedes, that no actual damages occurred, even a reasonable pre-estimate will likely not be enforced. Note the difference between a lack of actual damages and a situation in which actual damages exist but remain incapable or very difficult to quantify after a breach, as was the case in *Baker*.²³² On a related note, there is some support for the idea that the more difficult it

²²⁷ *Gator Apple, LLC v. Apple Tex. Rests., Inc.*, 442 S.W.3d 521, 532 (Tex. App.—Dallas 2014, pet. filed).

²²⁸ FARNSWORTH, *supra* note 5, § 12.18, at 315.

²²⁹ *Id.*

²³⁰ *Id.*

²³¹ *FPL Energy, LLC v. TXU Portfolio Mgmt. Co.*, 426 S.W.3d 59, 70 (Tex. 2014).

²³² *Baker v. Int'l Record Syndicate, Inc.*, 812 S.W.2d 53, 55 (Tex. App.—Dallas 1991, no writ).

would be to estimate damages, the more lenient a court might be in assessing the reasonableness of the estimation.²³³

VI. CONCLUSIONS

In stating that reasonableness is assessed “from the perspective of the parties at the time of contracting” but then striking down the liquidated damages provision as an unenforceable penalty based on the “unbridgeable discrepancy between [the provision] as written and the unfortunate reality in application,” the Texas Supreme Court in *TXU* appears to have fallen into the familiar trap of talking out of both sides of its mouth when it comes to the reasonableness of liquidated damages.²³⁴ While its decision did little to alleviate the confusing language courts have used in dealing with this issue, one thing it appears the court did resolve is that Texas follows the second-look approach to the reasonableness analysis.²³⁵ This is likely to be better news for defendants than for plaintiffs because it gives defendants an “ace in the hole” of avoiding onerous liquidated damages provisions by proving that actual damages were less than the amount stipulated in the contract.

The adoption of the UCC in Texas for contracts involving the sale of goods further convoluted what was already a confusing issue.²³⁶ While the court’s decision in *TXU* did not specifically address contracts under the UCC, it seems likely that a similar retrospective approach, in which more emphasis is placed on actual damages than what the parties may have decided amongst themselves was reasonable at the moment of contracting, would be applied in that context as well.

Though there are certainly cases that would appear to point to the contrary, this may have been the Texas position as far back as *Collier v. Betterton* in 1895.²³⁷ Whatever the case, it seems to be the Texas position now.²³⁸ Thus, practitioners should always be cognizant of the fact that any liquidated damages clause, however reasonable it may seem at the outset, will be subject to a second-look in light of the actual damages sustained. Though this approach may detract from the confidence parties have that courts will enforce their mutual bargains, it helps assure that illegal

²³³ *Wassenaar v. Panos*, 331 N.W.2d 357, 363 (Wis. 1983).

²³⁴ *TXU*, 426 S.W.3d at 70–72.

²³⁵ *See id.* at 72.

²³⁶ *Anderson*, *supra* note 8, at 1091.

²³⁷ 29 S.W. 467, 468 (Tex. 1895).

²³⁸ *See generally TXU*, 426 S.W.3d at 72.

penalties cannot be dressed up as liquidated damages clauses. The most practitioners can do now in drafting a liquidated damages clause is try to make it appear as reasonable as possible at the time of contracting. But as to whether it will actually be enforced or not, as one blogger recently wrote in response to the *TXU* case, you may need to “get out your crystal ball.”²³⁹

²³⁹ Jason Johns, *Negotiating a Liquidated Damages Clause in Texas? Get Out Your Crystal Ball*, CLIMATE POLICY, RENEWABLE ENERGY, & SUSTAINABILITY BLOG (March 21, 2014), <http://www.lawofrenewableenergy.com/2014/03/articles/renewable/negotiating-a-liquidated-damages-clause-in-texas-get-out-your-crystal-ball/>.