

How to Protect Your Company's IP

(and knowing the right questions to ask)

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About Entralta



- We are a virtual law firm.
 - All seasoned professionals (10+ years experience each) with varying technical backgrounds.
- We view clients as partners whose success is our chief aim.
 - “Remote in-house counsel”
 - We learn your business needs and goals to ensure that your IP portfolio protects your specific business and creates potential licensing opportunities in other areas where you don’t operate.
- We handle a wide range of intellectual property issues spanning many different technologies and industries.
 - IP identification
 - IP procurement
 - IP monetization
 - IP portfolio management
- Cost-effective, competitive, predictable flat fee pricing structure (as opposed to hourly billing).

Overview

Today we'll cover...

- What intellectual property (“IP”) is, generally
- The 4 main types of IP
- How IP rights are typically owned and monetized
- Questions to keep in mind as you engage in any business endeavor

What is “Intellectual Property”?

- The collection of rights that you have in the work product of your mind.
 - i.e., your inventions, your trade names and symbols, your literary, artistic or musical works, your competitively advantageous secrets, etc.
- While intangible, IP is freely transferable like any tangible asset.

Why Protect Your IP?

- Properly protected IP gives your company a competitive advantage.
- That competitive advantage also makes your company more attractive for potential investment, licensing and acquisition opportunities.
 - If your company's IP is not adequately protected, you will suffer because no one will pay you for technology that is not protected (instead, they will simply take it).
- Before you can protect your IP, you need to know exactly what you have and what can be monetized.
- And before you monetize your IP, you need to make sure you won't infringe someone else's rights.

Types of Intellectual Property

- Patents
- Trademarks
- Copyrights
- Trade Secrets

Types of Intellectual Property

PATENTS



Patents

- Set of exclusive rights in an invention granted for a limited period of time (i.e., a limited monopoly) in exchange for a disclosure of that invention.
- Right to exclude/prevent others from making, using, selling, or importing infringing goods/services.
 - This exclusivity can add significant value to a company, both for keeping competitors at bay and to attract potential investors/licensees/purchasers.
- Rights are country-specific.

Patents

- Inventions must comprise “patentable” subject matter.
 - **Patentable:** processes, machines, articles of manufacture, compositions of matter, or improvements thereof.
 - **Not Patentable:** natural phenomena, mental processes, and abstract ideas.
- Inventions must also be:
 - Useful;
 - Novel (i.e., new, unique); and
 - Non-obvious (to a P.H.O.S.I.T.A.).
- Patentability is determined by comparing invention against the relevant “prior art.”
 - Prior art = any third party disclosure (anywhere in the world) pre-dating the invention’s earliest effective filing date.

Patents

- **Public Disclosure**
 - Any disclosure (not covered by NDA), public use, public display, public sale or offer for sale, or public commercial exploitation of the invention, anywhere in the world.
 - One year grace period from date of your first public disclosure to file patent application(s) in the U.S., else all potential patent rights may be forfeited.
 - Prior third party disclosures count as “prior art.”
 - Grace period not available outside of North America, where earliest patent application filing date must pre-date any public disclosure anywhere in the world.
- **Keep inventions confidential until they are “patent pending” (i.e., until a patent application has been filed).**
 - Use non-disclosure/non-compete agreements.

Patents

- Types of U.S. Patents:
 - Utility Patents
 - Design Patents
 - Plant Patents
- Similar types of patents in other countries.

Utility Patents


- Protect structural/functional features of an invention (i.e., the way an invention works).
- Term: 20 years from earliest effective non-provisional filing date.

Utility Patents

What is claimed is:

1. A batting skills development device for use with a bat, the bat having a proximal handle portion and a distal barrel portion with a tapered section extending therebetween, the device comprising:
 - a weighted sleeve having a tapered inner surface configured for approximating the tapered section of the bat, with a first end of the sleeve having a first inner diameter larger than a second inner diameter of an opposing second end of the sleeve, the first inner diameter being less than or equal to a barrel diameter of the barrel portion; where, during use, the sleeve is slipped over the handle portion of the bat and wedged against the tapered section proximal the barrel portion, thereby maintaining a balanced distribution of weight along the bat.
2. The batting skills development device of claim 1 wherein the sleeve further defines a lengthwise opening extending between opposing first and second ends of the sleeve and configured for allowing the handle portion of the bat to pass therethrough.




 US 20110275458A1

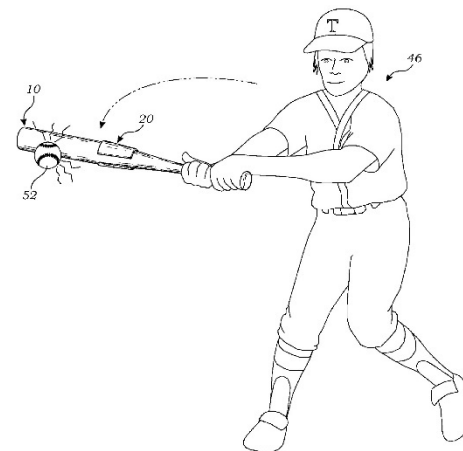
(19) **United States**
 (12) **Patent Application Publication** (10) **Pub. No.:** US 2011/0275458 A1
 Estrada, JR. et al. (43) **Pub. Date:** Nov. 10, 2011

(54) **BATTING SKILLS DEVELOPMENT DEVICE** **Publication Classification**
 (75) **Inventors:** Marco Estrada, JR., El Segundo, CA (US); Marco Estrada, SR., El Segundo, CA (US) (51) **Int. Cl.** A63B 69/00 (2006.01)
 (73) **Assignee:** ESTRADA BEISBOI, L.L.C., El Segundo, CA (US) (52) **U.S. Cl.** 473/437
 (21) **Appl. No.:** 13/144,056 (57) **ABSTRACT**
 (22) **PCT Filed:** Nov. 16, 2009
 (86) **PCT No.:** PCT/US09/64515
 § 371 (e)(1), (2), (4) **Date:** Jul. 11, 2011

Related U.S. Application Data

(60) Provisional application No. 61/146,933, filed on Jan. 23, 2009.

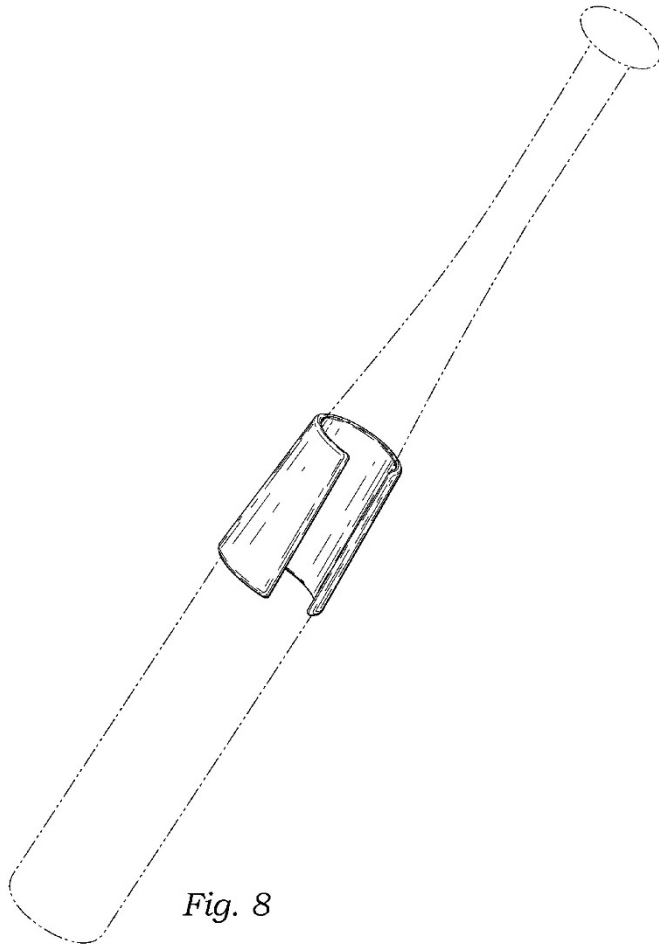
A batting skills development device for use with a bat, the bat generally having a proximal handle portion and a distal barrel portion with a tapered section extending therebetween. The device comprises, in an exemplary embodiment, a weighted sleeve having a tapered inner surface configured for approximating the tapered section of the bat, with a first end of the sleeve having a first inner diameter larger than a second inner diameter of an opposing second end of the sleeve; the first inner diameter being less than or equal to a barrel diameter of the barrel portion. Thus, during use, the sleeve is slipped over the handle portion of the bat and wedged against the tapered section proximal the barrel portion, thereby maintaining a balanced distribution of weight along the bat while allowing the barrel portion to remain substantially unobstructed.



Design Patents

- Protect non-functional, ornamental features of an invention (i.e., the way an invention looks).
- Term: 15 years from date of patent grant.
 - Term varies from country to country.

Design Patents



US00627841S

(12) **United States Design Patent** (10) **Patent No.:** **US D627,841 S**
 Estrada, Jr. et al. (45) **Date of Patent:** **Nov. 23, 2010**

(54) **BATTING SKILLS DEVELOPMENT DEVICE**
 (75) **Inventors:** Marco Estrada, Jr., El Segundo, CA (US); Marco Estrada, Sr., El Segundo, CA (US)
 (73) **Assignee:** Estrada Helshol LLC, El Segundo, CA (US)

(68) **Term:** 14 Years
 (21) **Appl. No.:** 29/357,064
 (22) **Filed:** Mar. 5, 2010

Related U.S. Application Data
 (65) Continuation of application No. PCT/US2009/064515, filed on Nov. 16, 2009.

(51) **LOC (9) CL:** 21-02
 (52) **U.S. CL:** D21/753
 (58) **Field of Classification Search:** D21/680, D21/722, 753; 429/564, 568, 457, 457
 See application file for complete search history.

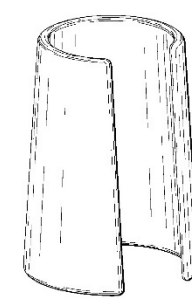
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 Primary Examiner: Mitchell J Siegel
 (74) **Attorney, Agent, or Firm:** Mind Law Firm; Justin G. Sanders; Jerome V. Sartain

(57) **CLAIM**
 The ornamental design for a batting skills development device, as shown and described.

DESCRIPTION
 FIG. 1 is a perspective view showing an exemplary embodiment of our new batting skills development device design;
 FIG. 2 is a front view thereof;
 FIG. 3 is a rear view thereof;
 FIG. 4 is a left side view thereof;
 FIG. 5 is a right side view thereof;
 FIG. 6 is a top view thereof;
 FIG. 7 is a bottom view thereof; and,
 FIG. 8 is a perspective view of an exemplary embodiment of the present design removably engaged on a baseball bat.
 The broken lines are for illustrative purposes only and form no part of the claimed design.

1 Claim, 3 Drawing Sheets



Types of Intellectual Property

TRADEMARKS



Trademarks

- Non-functional, distinctive (i.e., unique) source identifiers used in connection with sale and offer for sale of goods and/or services.
 - Brand names, company names, logos, tag-lines, jingles, product packaging, product shape, product color, store appearance/décor, etc.
- Intended to protect consumers by ensuring that they know the source behind the products and services they purchase and use.
- Exclusive right to prevent competitors from adopting “confusingly similar” marks in connection with similar or competing goods/services.
 - e.g., DELTA
- Rights are country-specific.

Trademarks

- Types of U.S. Trademark Rights:
 - Common Law Trademark Rights
 - State Trademark Rights
 - Federal Trademark Rights

Trademarks

- Common Law Trademark Rights
 - Often identified by “TM” or “SM” symbol.
 - Not required, but highly encouraged.
 - Arise automatically based on use.
 - No application process or cost involved.
 - Rights are geographically limited in scope.
 - Term: Lasts for as long as the trademark is actually used.
 - Abandonment typically presumed after 3 years of non-use.

Trademarks

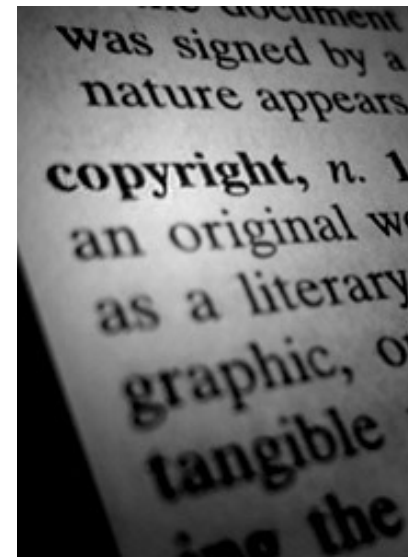
- State Trademark Rights
 - Also often identified by “TM” or “SM” symbol.
 - Not required, but highly encouraged.
 - Requires formal application and fees.
 - Expands scope of protection to cover entire state.
 - Only utilized where the mark is to be used in a single state.
 - Term: Lasts for as long as the trademark is actually used and renewals are timely paid.

Trademarks

- Federal Trademark Rights
 - Identified by “®” symbol.
 - Not required, but highly encouraged.
 - Requires formal application and fees.
 - Expands scope of protection to cover entire U.S. and U.S. territories.
 - Mark must be used in interstate commerce, but application may be filed based on intended use.
 - Term: Lasts for as long as the trademark is actually used and renewals are timely paid.

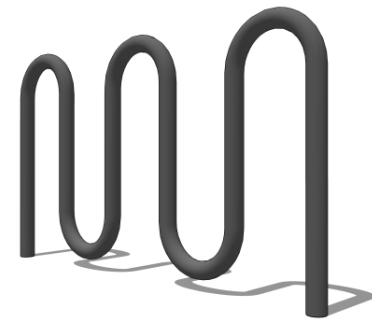
Types of Intellectual Property

COPYRIGHTS



Copyrights

- Legal right of ownership that arises automatically when an original work of creative authorship is fixed in any tangible medium of expression from which the work can be perceived, reproduced or otherwise communicated, either directly or with the aid of a device.
 - Work must be independently created and possess minimal degree of creativity.
 - Work cannot be functional (e.g., undulating Ribbon bicycle rack).
- Right to prevent others from reproducing, distributing or performing the work, except where “fair use,” “independent creation,” “first sale,” or “parody” defense applies.
- Identified by “©” symbol, along with year(s) of publication and author/owner name.
 - Not required, but highly encouraged.
- Term: Last surviving author’s life plus 70 years, generally.
 - Works made for hire: 120 years after creation or 95 years after publication, whichever expires first.

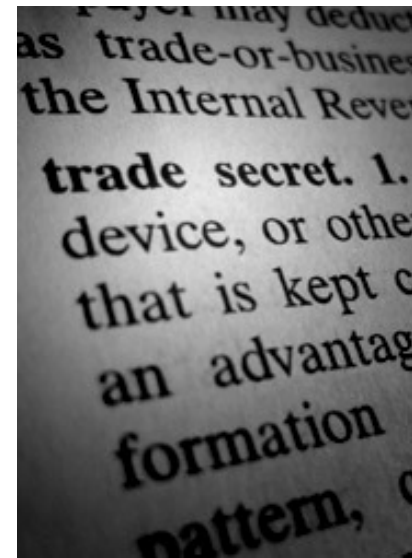


Copyrights

- No application process or costs to acquire rights.
 - BUT, work must be registered with the U.S. Copyright Office before enforcing those rights against third parties in the U.S.
 - Note: Software source code containing trade secret information can be redacted so as to preserve trade secret status.
 - Timely registering work with Copyright Office permits awarding of statutory damages and attorneys fees if work is ever infringed.
- Rights automatically extend to most countries around the world (Berne Convention).

Types of Intellectual Property

TRADE SECRETS



Trade Secrets

- Any information that derives independent economic value (actual or potential) from not being generally known to others, so long as reasonable measures (under the circumstances) are taken to maintain secrecy of information.
 - e.g., Coca Cola recipe
- Right to take action against persons who steal or otherwise misappropriate information.
 - Legally acquiring the information (i.e., reverse engineering, independent creation, etc.) is not actionable.

Trade Secrets

- No application process or costs to acquire rights.
 - Except for any costs associated with implementing an appropriate “trade secret protection program.”
- Term: Lasts for as long as the information remains secret.
- In general, trade secret rights and patent rights are mutually exclusive.
 - Sometimes trade secret rights and copyrights are mutually exclusive as well.

IP Ownership

- Absent a written agreement to the contrary...
 - **Patents**
 - Each inventor has equal, undivided ownership interest with no profit-sharing obligations to any co-inventors.
 - **Trademarks**
 - User of the trademark is considered the owner.
 - **Copyrights**
 - Each author has equal, undivided ownership interest, but must share profits with any co-authors.
 - **Trade Secrets**
 - Creator of the information is considered the owner.

IP Ownership

- **Employer/Employee Relationships**
 - Typically, employer owns anything employee creates within the scope of their employment.
 - But patent ownership still requires an express written agreement in most cases.
 - Copyright ownership also typically requires an express written agreement.
- **Independent Contractor Relationships**
 - Ownership typically depends on the terms of the written agreement between the parties.
 - “Work made for hire” arrangements with independent contractors only apply to a very limited subset of copyrightable works.
 - But they also turn the independent contractor into an “employee” under the California Labor Code (§3351.5(c)) for insurance and tax purposes.
 - Alternatively, use an express present assignment clause in the agreement.
 - Longer copyright term + no termination risk VS. no employment obligations
- Be sure to get these arrangements in writing (and reviewed by an attorney) at the outset of any relationship (employment, independent contractor, joint development, etc.) to ensure your potential ownership interests and related rights are properly memorialized before you begin development.

IP Monetization

- Typical avenues for monetizing IP include:
 - Direct Commercialization
 - i.e., profiting from your own production and sale of associated goods/services covered by the IP.
 - Licensing
 - i.e., collecting royalties from third parties who are licensed (either exclusively or non-exclusively) to produce and/or sell associated goods/services covered by the IP.
 - Sale
 - i.e., collecting money from a third party in exchange for the outright transfer of IP rights to that third party.
 - Enforcement
 - i.e., collecting damage awards or settlement amounts from accused infringers.

Questions to Ask

(before doing anything else)

- Who **owns** the IP that I create or commission?
 - Any obligations to assign?
 - Any co-owners?
 - Are the appropriate ownership/confidentiality agreements in place?
- Are any aspects of my **idea** protectable (and worth protecting)?
 - Through patent protection?
 - Through trade secret protection?
- Are any **tangible works** associated with my idea protectable (and worth protecting) through copyright?
- Are the **source identifiers** I plan to use protectable (and worth protecting) as trademarks?
- Do any aspects of my planned products/services **infringe** any third party IP rights?
- How can I **monetize** my IP?

Questions?

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