

# Inventors Society

April 2002

*Inventors Society of South Florida, PO Box 4306, Boynton Beach, FL 33424*

## Bullet-proofing for Patent Litigation

Joseph N Hosteny, Esq.

Success almost guarantees that someone someday will infringe your patent. Don't make mistakes while prosecuting your patent that will come back to bite you.

Your invention's success today almost guarantees that someone someday will infringe your patent. If you end up in court, early mistakes made while prosecuting your patent may come back to haunt you. Whether you were trying to save money or time, or were simply unaware, early mistakes will powerfully affect what happens to your patent in litigation.

As a patent litigation attorney, I have seen many inventors embroiled in lengthy, expensive lawsuits that could have been avoided or greatly simplified if certain mistakes hadn't been made during prosecution.

The biggest mistake inventors make is being pack rats. The minute your patent is allowed, purge your file of extraneous documents. Save all communications with the Patent Office but throw away drafts of claims, revisions to specifications and drawings, musings on scraps of paper, and patents with notes and comments inscrutable even to you. If you don't get rid of them, they may cause two kinds of fights during litigation that will wear you down and waste your resources.

First, you may end up fighting over what is--and isn't--covered by the attorney-client privilege, and you will find it difficult to protect your privileged communications from being admitted into evidence, especially if you can't prove to the judge when and to whom they were written. If your attorney manages to protect these documents, your fight to keep them out of evidence may give the court the impression that you have much to conceal.

The second fight over documents may be more damaging. It starts the moment you are ordered to turn documents over--and you will be. You have now given your opponent more material for questions, and a virtual crowbar with which to pry open your thinking. Because you were a pack rat, your opponent now is able to prove you questioned the wording of your claims, or decided not to give the Patent Office a particular reference--no harm in itself, but for a reason that now appears suspicious. You may also give him the ability to prove you claimed your invention inaccurately, or narrowed its scope because you feared the prior art he is now hitting you over the head with in court.

In one of our cases, our client's patent prosecution files were a junkyard mess. He'd kept everything--every marked-up copy of patents he had ever considered as possible prior art (including those he rightly decided not to mention to the Patent Office), as well as all his scribbles, all drafts of the specification, and every version



### **Special Interest Articles:**

- Bullet-proofing for Patent Litigation.
- First Ten Commandments of Inventing.
- Invention Promotion Firms.

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**Mission Statement**

To provide a forum that fosters creativity, freethinking and education that will help further our members' innovations.

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of every claim he ever wrote. He also kept every draft of every amendment and response, giving his opponent the chance to argue that all his later deletions were made with the intent of preventing the examiner from knowing all relevant facts. Our client obviously never heard of computers, which would have enabled him to keep only up-to-date documents with his best and current thinking, instead of a lot of outmoded rubbish.

A good patent file retains only the truly important: invention disclosure, results of your search, perhaps a privileged letter discussing the facts and providing legal advice about the invention's scope, and all documents to and from the Patent Office. Your patent's official file history doesn't contain extraneous materials and ruminations, so why should your personal file keep junk that can later be readily misused?

Fortunately we won our case. But the time spent writing briefs and preparing withheld lists of documents wasted everyone's time-ours, our client's, and the court's.

Another mistake inventors make during prosecution is not disclosing all prior art to the examiner. The rule of thumb: if in doubt, disclose; and if you're not sure it's prior art, disclose it anyway. That way, you cannot lose. If your examiner doesn't consider the art, we rightly tell court and jury at trial that the art is not important because your examiner-by law a "quasi judicial officer"-didn't address it. If the examiner considers the art, your claims are even stronger because you defined your invention with the prior art in mind. A patent with a lengthy list of references on its first page is what I call a "Superman" patent. It impresses court, jury, and even the defendants-although they probably won't admit it.

Consistency with your patent prosecution is critical, because jurors want to accept patent examiners' decisions. So, if you presented your examiner with the same or equivalent of the art now being used by the accused infringer, you will win any contest concerning your patent's validity.

Part of the statutory record of your patent are the amendments and arguments you made in response to your examiner's office actions. Here, the less said the better. When discussing prior art, focus on prior art, not the invention; comment on the shortcomings of the prior art, e.g., what it does not show. Minimize comments on what your invention is, and avoid interpreting the claims themselves. The law says amendments made to better define an invention do not create the same restrictions as amendments made to avoid prior art. So, when making amendments, always tell your examiner you are doing so to better define the invention. This reduces a future infringer's ability to argue that you modified your claims to avoid some prior art.

Another problem crops up with affidavits, which are used in patent prosecution for many reasons, including demonstrating an invention's commercial success. When using affidavits, accuracy and hindsight are again critical.

We recently had a case where our client-a major corporation-wanted to overcome an obviousness rejection by proving its invention had achieved significant commercial success. Fifty years ago the Supreme Court held that an invention's sales are a good indicator of its merits. But our client advertises heavily, so sales may not be due solely to its invention's merits. In its original form, the affidavit would have been worse than useless, since it would have led the examiner to the right conclusion for the wrong reason. So we had our client investigate other possible reasons for the sales increases, and prove in the affidavit that they were not the reasons for the invention's success.

Commercial success affidavits cannot be rebutted by an examiner since the Patent Office maintains no sales data. If not properly done, your commercial success affidavit can be turned into an argument by your opponent during litigation that you willfully misled your examiner to an incorrect conclusion, since you knew advertising (or an unpatented feature of the invention, or its low price, or even a good distributor's network) contributed to your invention's sales.

In another case, one of our expert witnesses provided a commercial success affidavit in a patent we were litigating, and which our opponents had put into reexamination—a frequent last measure of the accused infringer. Our expert was not quite on the button with the invention's profits, and our opponent argued that our client had tried to mislead the Patent Office both in the original prosecution and during the reexamination. So, although we were ultimately successful, this small inaccuracy in our expert witness's affidavit, an unintentional arithmetic error, helped bolster the other side's argument, caused delay, incurred added expense—and added another argument we had to defeat. So, when providing a commercial success affidavit, analyze the affidavit from the standpoint of a potential infringer.

Is your patent worth a European search through the World Intellectual Property Organization? It may be, even though such searches often cost several thousand dollars. Any well-funded defendant will search there, and may challenge the validity of your patent, confronting you with "crucial" patents and publications your examiner never saw. This creates doubt in the jury's mind, since it can no longer rely on your examiner's expertise.

Finally, what should you do if you are accused of infringing someone else's patent? First, respect the other party's patent rights. If feasible, you might drop the product or activity accused of infringement. If you believe you did not infringe and want to continue the activity, get an opinion from a competent attorney, and give him or her all necessary facts.

This legal opinion should be in writing. In a recent Chicago case, a corporate defendant tried to persuade the jury that its attorney had asserted it had not infringed the plaintiff's patent. However, since the advice was undocumented, neither court nor jury believed what looked like a litigation afterthought. So the plaintiff's one hundred million dollar damage award may turn into three hundred million dollars because the jury concluded the infringement was willful.

This written opinion must also reflect that the attorney has received an honest disclosure of facts from the client accused of infringement. An incomplete disclosure is worse than no opinion, because it makes you look like a crook, much like a defendant in a tax case who says he relied on his accountant to make an accurate tax return, but forgot to tell the accountant about his bank account and condominium in Grand Cayman.

Remember, be extremely accurate during patent prosecution with factual statements, and know what you say may later be misinterpreted and/or used against you. While a strong prosecution may not save you from infringement, it will make a significant difference in how smoothly, economically and successfully your litigation goes.

(Reprinted from *Inventor's Digest*, September/October 1997) ❖



#### Disclaimer

The Inventors Society of South Florida, Inc. is a not-for-profit corporation engaged primarily in the organization of monthly meetings, inventors fairs, and seminars for the purpose of facilitating networking and educating its members and guests. The Inventors Society of South Florida, Inc. disclaims any responsibility for any investment, legal, accounting, or other professional advice which may be rendered by individual officers, directors, sponsors, Members, speakers, or guests, at/or as a result of contacts made at any social activity. Information provided in this publication is from sources believed to be reliable. Anyone choosing to follow or use such information provided in this publication must verify with appropriate professionals before relying on any statement, article, or comment herein. The Inventors Society of South Florida, Inc. takes no responsibility for the accuracy or reliability of information presented in this publication. The intent is creative and thoughtful thinking, but not to provide definite answers or solutions.

#### Membership

Your membership entitles you to all that is offered by the Society: events, meetings, contests, prizes, awards, nominations, and networking. Members also benefit from a monthly newsletter that includes tips, publications, useful websites and national expositions. Membership means added benefits to you and, of course, funds to the Society to hold meetings, send newsletters, hold special events, and maintain an Internet presence. Discounted Student Memberships are available.

**ISSF Meetings**

**ISSF Palm Beach branch** meets at 1:30 pm on the **first** Saturday of each month at:

Muvico Palace 20 Theater  
Premier Club  
3200 Airport Road  
Boca Raton, FL 33431

Directions:

I-95 to Glades Road (Exit 39) east. Turn left at the first light onto Airport Road. The Muvico complex is on the right (east side). Enter the building north of the Premier Club entrance. Take the escalator upstairs.

Contact:  
Abby Waters 561-988-2020  
abbysideas@aol.com

**ISSF Miami branch** meets at 1:00 pm on the **third** Saturday of each month at:

N. Miami Beach Pub. Library  
1601 NE 164th ST  
North Miami Beach, FL

Directions from south:

I-95 North to North Miami Beach exit 17 (167th St). Follow 167th St east which curves to the right and becomes NE 163rd Street. Pass 163rd St Mall, turn left on NE 16 Ave. Go one block to NE 164th Street. The library is straight ahead as you proceed through the traffic light. Note that NE 167th Street turns into NE 163rd Street.

Directions from north:

I-95 South to Miami Garden Drive (NE 183rd St.) exit. Go straight through traffic light (you are now at the top of NE 6th Ave). Follow 6th Ave to NE 167th St and turn left (east). Follow NE 167th St. which curves to the right and becomes NE 163rd Street. Pass 163rd St Mall, then turn left on NE 16 Ave. Go one block to NE 164th Street. The library is straight ahead as you proceed through the traffic light. Note that NE 167th Street turns into NE 163rd Street.

Contact:  
Bob Levy 305-893-5989  
305-205-2884 cell  
boblevy@bellsouth.net

**President's Corner**

Our March speaker, Karen Steele, really showed us the importance of having a marketing plan. Just having a great idea is not enough. You must have a comprehensive plan as to how you will market your idea and who your target audience is. Don't be in a rush without doing the proper research. Make sure you are aware of who your competitors are and what they are doing.

We are about to publish the Silkens' book. The society will contribute some money and the Silkens are also making a donation. We need about \$500.00 more. If one of our patent attorney firms can help, we would really appreciate it.

We have two out-of-town guest speakers coming in. One will sit on our panel of experts as to sourcing out of the country. The other guest speaker has a long program on prototyping in September.

Thanks to Leon and Mort for my presents. You all spoil me. Leon made me a necklace by hand and Mort gave me a fan. Thanks guys. Keep creating and work smart.

Creatively yours!

*Abby*

**QVC National Product Search...the opportunity of a lifetime**

From April 26th to the 28th, QVC will be conducting a search for the next great products at the Mall of America in Minnesota! If you think you have a winner, register at <http://www.QVCproductsearch.com> or by phone at 1-866-302-4633 and meet us at the mall!

Speaking at the National Product Search will be Don Kelly, well-known inventors' champion and founding director of the USPTO's Office of Independent Inventor Programs. Don will discuss the management of intellectual property aspects of new products and describe the ten most common mistakes made by inventors seeking patent protection. ❖

**2002 Schedule of Events – Palm Beach**

04/06	Guest speaker: <b>Janet Carabelli</b> , discussing corporate identity packaging ... the difference between PR and marketing
05/04	Guest speaker: <b>Li Yi</b> , Patent Agent, discussing TBA
06/01	Guest speaker: <b>H. John Risvi</b> , patent attorney at Gold & Risvi, the idea attorneys. Topic: licensing
07/06	Guest speaker: <b>Edith Tolchin</b> , discussing manufacturing out of the country.
08/03	TBD
09/07	Guest speaker: <b>Duane L. Gettelfinger</b> , sales manager for Beach Mold and Tool Inc., speaking on prototyping

## ID's First Ten Commandments of Inventing

1. Stay away from invention marketing firms that advertise on radio and late night TV. They're out to fatten their wallets and empty yours!
2. Keep good records about your idea some day they may be the back up you need to prove YOUR idea is YOURS!
3. Go to a Patent Depository Library and do your own patent search. If you find your invention is already patented, there's no need to go to a patent attorney.
4. Build a model. No need to get fancy at first--cardboard, white glue, balsa wood, off-the-shelf parts. No matter how simple the idea, prove it works.
5. Have your invention evaluated by a non-biased professional (even if your Mom's in the business, go to someone else!).
6. Read all you can about new product development. Go to your local book store or library...others have gone before you. Don't re-invent the wheel.
7. Network with other inventors. Join a local inventors' organization.
8. If your patent search looked promising (see #3), make an appointment with a patent attorney. Show your attorney the results of your search and follow the advice he or she gives you.
9. Do what you do well and hire pros to do the rest.
10. Don't fall in love with your invention but if you're really sure you've got a winner (see #5), hang in there! Even "overnight" successes take a while!

(Reprinted from *Inventor's Digest* November/December 1995) ❖

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### Advertiser's Corner

***David W. Barman, P.A.***

Patent Preparation Service, Corporate and Independent Inventors  
1101 NE 176 Terrace, N. Miami Beach, FL 33162 tel. 305-332-4089  
[DWBarman@aol.com](mailto:DWBarman@aol.com)

***Arthur Shilling***

Independent Distributor, EcoQuest  
818 Chukker Road, Delray Beach, FL 33483 tel. 561-734-5678  
[eqj4me@aol.com](mailto:eqj4me@aol.com)

***Yi Li, PA***

Full Service Patent Law Firm For Our Inventors  
11820 SW 107 Avenue, Miami, FL 33176 tel. 786-242-9349  
[yilicuspa@aol.com](mailto:yilicuspa@aol.com)

***Bob Levy***

Product Designer  
tel. 305-893-5989 or 305-205-2884  
[boblevy@bellsouth.net](mailto:boblevy@bellsouth.net)

***Cathy VerSchneider***

Technical Writing & Website Design  
638 Snug Harbor Drive 15, Boynton Beach, FL 33435 tel. 561-737-2182  
[cever@ix.netcom.com](mailto:cever@ix.netcom.com)

### Newsletter Submissions

If you have something you'd like to see in the newsletter, please discuss with or send it to Abby Waters. If it is something that has to be copied, please send the original or a high quality copy. If you need the original document returned, please note this in the submission package.

Please remember that the newsletter is black print only. Submissions that have color (especially over text, i.e. words in a colored box) may not be usable. Try to keep submissions as simple and basic as possible.

### "Ask the Experts" Panel

This panel was formed to assist our members in going to the next step in the inventing process. At the end of every meeting we will have a panel of experts address inventors and their questions pertaining to patenting, prototyping, and commercializing. The panel may include:

- **Alvin Blum:** registered patent agent
- **Freddy Lee:** prototyping expert
- **Bob Levy:** product designer
- **John Fulton:** patent attorney
- **H & P Silken:** commercialization



**The American Inventors Protection Act of 1999**

On November 29, 1999, Congress passed AIPA, which for the first time imposed a duty on Invention Marketing Companies to disclose information to prospective clients before they sign contracts. Specifically, a company must disclose:

1. The number of customers who contracted with the promoter over the last 5 years.
2. Total number of inventions evaluated by the promoter in the past 5 years.
3. The number of these inventions which received positive and negative evaluations.
4. The total number of these customers who have received a net financial profit as a direct result of the promotion services by the promoter.
5. The total number of customers who have received license agreements for their inventions as a direct result of the promotion services by the promoter.
6. The names and addresses of all previous invention promotion firms with which the invention promoter or its officers have been affiliated for the last ten years.

Any customer who has contracted with a promoter and has been injured by an omission to state any of these facts, or any other material fact, or by any material false or misleading statement by the promotee's actions to have been willfully taking other complaints into account, the damages may be trebled. These provisions took effect on January 29, 2000.

**Inventor's Resource Guide**

The Fourth Edition of the Inventor's Resource Guide is published by the membership of the United Inventors Association of the USA (UIA-USA). This 32-page guide tells "would-be Edisons" how to go from the great idea to a marketable product while avoiding the invention marketing scams artists along the way. Topics include: How to keep good records, write a business plan, obtain an invention evaluation and how to patent, prototype and market a new product. It is available for \$9.95 postpaid.

If interested in finding out about inventor support groups in areas not serviced by a local organization, contact Joanna Hayes-Rines at 1-617-367-4540 or UIA-USA, PO Box 23447, Rochester, NY 14692 1-716-359-9310 FAX 1-716-359-1132 <http://www.UIAUSA.org> or Inventor's Awareness Center <http://www.uiausa.com> ❖

**Idea Magazine for Inventors & Innovators**

Our highly recommended Idea Magazine for Inventors & Innovators; Inventors' Digest, 30-31 Union Wharf, 3rd Floor, Boston, MA 02109, 1-800-838-8808, ask for IASL inventor's club discount @\$18. Inventors' Digest is developing a nationwide database of inventions available for sale/licensing. It includes all inventions that have been publicized in "Invention Mart" since 1985, plus other inventions. The information will be made available to companies interested in licensing inventions. Included in the listing will be the name and description of the invention as well as the inventor's name, address and phone number. Cost to list your invention on the database: \$10 (one-time charge). For application forms, send SASE to: ID Database, 30-31 Union Wharf, 3rd Floor, Boston, MA 02109, 1-617-367-4540 FAX 1-617-723-6988, [InventorsD@aol.com](mailto:InventorsD@aol.com) ❖

**Our second fundraiser for the scholarship is done! Thanks to the following members for their dedication...Freddy Lee, Joanna Zaremba, Lucy Pettersen, Arthur Shilling, Howard & Paula Silken, Bob Fortier, and Lucy & Richard Fechtner. ❖**

**Upcoming Events That May Help You**

- Visit <http://www.inventorsdigest.com/current/shows.html>
- May 3, 2002 is the Pulse of Innovation Trade Show on Long Island. Email [lcarter@lift.org](mailto:lcarter@lift.org) for information.

**2002 Schedule of Events – Miami**

03/16	TBD
05/18	TBD
06/15	TBD

## Ways to Learn Inventing

**Camp Invention** is organized by the USPTO and the National Inventor's Hall of Fame. It is a one-week day camp throughout the USA for children entering the second through sixth grades. Here kids are invited to "let their imaginations run wild through encouraged teamwork, creative problem solving and inventive thinking."

The **Jerome and Dorothy Lemelson Center for the Study of Invention and Innovation** is at the Smithsonian Institution National Museum of American History. The center has the museum's vast resources available, and uses research, discussion and dissemination of ideas. Its programs get students involved in the study and exploration of invention and innovation.

The **WIPO Worldwide Academy** offers training on intellectual property. The Distance Learning Program uses the Internet and electronic media for teaching, training and capacity-building. There is a professional program for managers and technical staff, as well as a summer school for students and young professionals. There is a Policy Training Program for policy advisors and decision-makers. The WIPO library has a specialized legal library for staff and outside researchers.

The **Academy of Applied Science** is a non-profit organization promoting creativity, invention and scientific achievement. They have partnered with the Smithsonian Institution to develop a National Young Inventors' Center. Its activities include the Young Inventors Program, National Junior Science and Humanities Symposia (under contract with the US Army Research Office) and the Research and Engineering Apprenticeship Program at colleges and universities around the USA.

**Invention University** has an open free campus on the Internet. Invention University also offers one-day seminars for a fee. Lisa Lloyd teaches the inventing process including due diligence, patents, marketing, financing and licensing. ❖

## Patent Fees as Taxes

Since 1990, more than a half billion dollars of fees collected by the USPTO have been diverted by the US Treasury General Fund. If you filed a patent application and/or had a patent issue during the last 11 years, Congress took some of your money and spent it on something other than prosecuting your patent application. One brave inventor has filed a class action suit.

On August 7, 2001, Miguel Figueroa, an inventor from Puerto Rico, filed a class action suit on behalf of all persons who have paid fees to the USPTO's Fiscal Year 1991. The suit was filed against the United States. Mr. Figueroa's attorney, Heath Hoglund, says the suit was filed because Congress "should not be using the patent system as a system for taxation." The suit has merit because the diversion of patent fees "exceeds the limited grant or power and other Constitutional limitations" imposed by Article 1, Section 8 of the US Constitution.

Join Miguel Figueroa in this class action suit. It will cost you nothing but, if successful, will reduce patent fees. Sign on by sending Heath Hoglund ([email@hoglund.com](mailto:email@hoglund.com)) your name, address, and patent numbers. Read the complaint at [www.hoglund.com](http://www.hoglund.com). ❖

### USPTO Maintenance Fees

Laura Lannon of the Office of the Budget said that 78% of the USPTO maintenance fees due at 3-1/2 years are paid. 55% of those due at 7-1/2 years are paid. Only 33% of those dues are paid at 11-1/2 years. The reason cited for this trend is technology advances that obsolete patents. ❖

### Will It Sell?

James E. White wrote a resource book for inventors to determine if your invention is profitable and marketable. The book has over 300 jam-packed pages of relevant information, and is deep reading.

You will get the feeling that Mr. White is looking over your shoulder mentoring you at each stage of development to keep you from throwing away your money.

His marketing philosophy is "Give the customer what they want, but only if it is in their best interests." When you have an inventive idea, no longer will you wonder whether it is a "good idea" or a "dead idea." Visit <http://www.WillItSell.com>. ❖

### Our New Website & Newsletter

We are putting the final touches on our website and hope to email our newsletter shortly. If you have an email address, be sure to send it to [flee766241@cs.com](mailto:flee766241@cs.com). For those without email, hard copy of the newsletter will be mailed through the USPS. ❖

ISSF PB Branch  
Presents on  
April 6th

**Janet Carabelli**

*Corporate Identity  
Packaging*

Board Meeting at 10:30am  
Regular Meeting at 1:30pm

ISSF Miami Branch



Regular Meeting at 1:00pm

**We're on the Web!**

See us at:

**www.InventorsSociety.  
com**

## Numbers and Internet Addresses

Inventors Association	<a href="http://www.communityconnection.org">http://www.communityconnection.org</a>
US PTO	<a href="http://www.USPTO.gov">http://www.USPTO.gov</a> (go to Independent Inventor)
US Copyright Office	<a href="http://lcweb.loc.gov/copyright">http://lcweb.loc.gov/copyright</a>
Copyright Myths Explained	<a href="http://www.clari.net/brad/copymyths.html">http://www.clari.net/brad/copymyths.html</a>
Inventors Hard Facts	<a href="http://www.WillItSell.com">http://www.WillItSell.com</a> (read this first!)
Inventors' Resources	<a href="http://www.PatentCafe.com">http://www.PatentCafe.com</a>
Inventors' Magazine	<a href="http://www.InventorsDigest.com">http://www.InventorsDigest.com</a>
Business Plans	<a href="http://www.SBAonline.aba.gov/starting/businessplan.html">http://www.SBAonline.aba.gov/starting/businessplan.html</a>
Inventors Book Store	<a href="http://www.InventorHelp.com">http://www.InventorHelp.com</a>
Helping Grow & Prosper	<a href="http://www.SBAon.com">http://www.SBAon.com</a> (St. Louis resources)
Federal Trade Center	<a href="http://www.FTC.com">http://www.FTC.com</a> (dial 1-877-FTC-HELP)
Federal Information Center	1-800-688-9889
USPTO Gen'l. Services	1-703-308-4357 or 1-800-PTO-9199

## ISSF Educational Presentation

It's an hour lecture followed by 15-20 minute question-and-answer session. The presenters show students what a US patent looks like, teach them what to do if they get an idea, and explain how to determine if the idea is already patented. The young audience is taken through the entire process of obtaining a patent. Literature is handed out, including information on how to avoid being scammed. ❖

### *About Our Organization...*

The Inventors Society of South Florida, Inc. was formed in 1982. Since 1983 the society has hosted exhibits, seminars, workshops, field trips, fund raisers and children's programs.

The monthly meetings include guest speakers, networking and member spotlights (members and their innovations are highlighted). There are field trips and educational symposiums to help inventors learn how to protect and commercialize their ideas.

ISSF has two branches: Palm Beach and Miami. See page 4 side bar for details. ❖

## INVENTORS SOCIETY OF SOUTH FLORIDA

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