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QUESTIONS WITH PATENT ATTORNEY CAROLYN

Favorito

LONGTIME *Inventors Digest* contributor, author and inventor resource provider Edith G. Tolchin was referred to Carolyn Favorito, Esq., by Lisa Lane, who Tolchin interviewed for *Inventors Digest* (Rinsaroo, April 2022). Tolchin needed a patent attorney to complete the Service Providers section of her book, “Secrets of Successful Women Inventors” (Square One Publishers, 2024), and conducted this separate interview for *ID*.

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Please tell us about yourself: education, background, hobbies, etc.

Edie! It’s so wonderful that we kept in touch. These days, I enjoy living in sunny San Clemente, California, after living in several states near the eastern seaboard from Massachusetts to Tennessee.

After receiving a Bachelor of Science in Chemistry with a concentration in Biochemistry from the University of Delaware, I received a Juris Doctor from American University in Washington, D.C. I worked at several large law firms before opening Favorito Law.

Like many chemists, I enjoy cooking (read: eating) and gardening to grow food for said

cooking. I also love traveling and trying new foods as a part of experiencing new cultures. During a recent trip to Southern Africa, I tried kudu, impala, crocodile and kapenta, which tastes like a mouthful of crispy guppies and is on my short list of foods to never eat again.

I went on safari to Botswana’s Okavango Delta, bungee-jumped over the Zambezi River in Victoria Falls, and ate my way through foodie heaven, Cape Town, South Africa.

To keep fit, I enjoy yoga, weight training, and—since my marathon running days are over—brisk beach walks.

What is involved in your practice?

After more than a decade at large law firms, I began Favorito Law in 2011. My primary focus has been patent prosecution and client counseling for startups in the pharmaceutical and life sciences space, and other areas such as medical devices and consumer products. Many startups can benefit from the intellectual property advice that large law firms provide but typically cannot afford the hefty price tag.

In addition to providing sound advice at a more competitive rate, my business model includes acting as part-time, in-house patent counsel for

startups that may not yet have the resources or portfolio size to hire a full-time patent attorney.

With over 25 years of relevant professional experience, I can cost-effectively guide a company's patent strategy to align with their business objectives, which is where I shine.

Why did you choose intellectual property law? When did you determine this would be your area of practice?

After graduating with a chemistry degree and realizing I would be unfulfilled as a bench chemist, I worked as a chemical sales representative. Chemical sales teetered on the cusp between business and science, which I enjoyed.

After a few years, the job required less science and more business, so I began pursuing a more challenging occupation: patent law. In addition to combining business and science, patent law by its very nature provides an endless stream of cutting-edge inventions with a science focus while unavoidably focusing on business and law. Never a dull moment.

Who was your first client?

Coincidentally, Favorito Law's first client was related to one of my first clients at my former firm. My first major project at the former firm related to a venture capital firm's due diligence for funding a target company, Trius Therapeutics.

During the due diligence process, I found an error in the prosecution history and the venture capital firm insisted that I take over the prosecution and fix the problem, which I did. The venture capital firm's representative was later installed as Trius's CEO, and we continued to work together.

Eventually, in addition to patenting its antibiotic (Sivextro®), I shepherded Trius through its initial public offering due diligence. When I started my firm, Trius was eager to follow me and capitalize on my institutional patent knowledge.

At Favorito Law, I continued to guide Trius through major milestones—including a massive international collaboration with Bayer Pharma AG, various SEC filings, and ultimately a high-stakes acquisition.



Have you ever visited the U.S. Patent and Trademark Office in Virginia?

Many times! I continued working in Washington, D.C., for several years after graduating from law school there. Early in my career, I successfully interviewed examiners, often with their supervisors present, to hash out particularly thorny issues in person.

I have also had the opportunity to argue a few patent appeals in front of the Board of Patent Appeals and Interferences (now called the Patent Trial and Appeal Board).

I have participated in focus groups at the USPTO with its personnel and other patent practitioners to make the patent process run more smoothly. Although I moved across the country, I am still in contact with patent examiners with whom I developed relationships early in my career who now have risen to influential positions in the USPTO. I contact them occasionally to suggest improvements to the patenting procedure.

Carolyn Favorito's primary focus is patent prosecution and client counseling for startups in pharmaceutical and life sciences, as well as in medical devices and consumer products. She is involved with USPTO activities that help the patent process run more efficiently.

IP Law is predominantly a male practice. Have you ever encountered any prejudices or subtle discrimination because you are a female IP lawyer?

Early in my career, I chose to pursue patent prosecution instead of patent litigation to establish more control over my schedule, which otherwise could be derailed by unplannable litigation.

Patent prosecution, a mentally intense occupation, affords little billable downtime that might be available to litigators. Thus, it's more difficult to achieve the level of billable hours needed to make partner. Further, raising children while practicing at a large firm makes for an exhausting life that's likewise incongruent with billing sizeable hours.

As making partner is generally a numbers game, only those with the highest billable hours will advance. My daughters were young when I was initially up for partner, and I did not make it.

Would it behoove firms to be more inclusive and make meaningful accommodations for

mothers who have children at inconvenient times for the law firm? Yes. Whether I'd describe the result as overt discrimination is another question. Nonetheless, I have often said that the best thing that happened in my career was not making partner (and starting Favorito Law).

For those starting out, I'd suggest having a Plan B in case you do not make partner or do not want to become a partner. Building relationships with and becoming indispensable to your clients can help you springboard to your next adventure.

In "Secrets of Successful Women Inventors," you contributed your own chapter. What was it about?

I found it fulfilling to provide vital how-to advice to female inventors who may not have resources or mentors to help them protect their intellectual property.

Household inventions, often invented by women, account for about 30 percent of research and development, and unfortunately also account for an unrecognized portion of the gross domestic product. Further, many household inventions can be patented, manufactured and sold relatively quickly in comparison to drugs, which have a long runway from patenting to sales.

Working with consumer products for the Rinseroo® brand has enabled me to work with patents, trademarks, and copyrights on an ongoing and often urgent basis. In the book, I discussed all areas of intellectual property on which these women relied. I hoped to convey that forming a viable business from a good idea is well within reach.

Why should a student in law school choose IP law? Can you recommend any undergraduate classes to help them prepare?

Regarding patent law, most law students who have sufficient technical credits or a scientific degree are usually already eyeing patent law as one of the few career options that combine the two specialties, so it's a pretty soft sell for these law students to convince them to choose patent law. The requirements for the technical background may be found here: uspto.gov/sites/default/files/documents/OED_GRB.pdf

Favorito (right) was instrumental in helping college friend Lisa Lane (left) secure a patent for her product, Rinseroo. Lane said Favorito "did a patent search, found that it was something that I could possibly patent, and worked on it as if it was her own. She encouraged me and motivated me to make it happen."



PHOTO BY QUIN BALDWIN-FAVORITO

However, as a law degree is not necessary to take the patent bar, I recommend sitting for the patent bar exam before graduating from law school, which is what I did. Including admission to the patent bar on your resume could be considered a valuable asset for an attorney position and, if nothing else, shows a commitment to the field.

As a career, I found patent law to be not only interesting but, from a practical standpoint, recession-proof.

Patent law is a niche market spanning science and law. While inventors keep inventing, they need sound patent advice providing job security to patent attorneys. Further, trademarks and copyrights provide value to almost all businesses, and a career choice in these areas of intellectual property law will likewise remain relevant.

What has been your most challenging case?

Well, various situations may present different types of challenges. For example, sometimes a complicated technology makes the case challenging; sometimes threading the patentability needle is the challenge; sometimes the time pressure is challenging; sometimes patent examiners throw in an unexpected challenge, and sometimes budget issues come into play. And I've experienced them all.

On the patentability and time pressure front, the backstory involves Trius, my first client mentioned earlier.

Trius was developing its patented antibiotic. Generally, new antibiotics are needed because microbes become resistant to old antibiotics. When Trius was developing its exit strategy, its scientists discovered that combining a minute, otherwise ineffective amount of Trius's new patented antibiotic with the competitor's old antibiotic would prevent microbes from becoming resistant to the competitor's old antibiotic.

The competitor's antibiotic was coming off patent, so generic companies' sales would soon start diminishing the competitor's market share of roughly \$1 billion in annual worldwide sales. From a business perspective, the competitor did not want to compete with Trius's new combination using mostly the competitor's soon-to-be-off-patent antibiotic.

Potentially this patented combination could achieve sales of \$1 billion—i.e., the amount of the competitor's antibiotic sales alone. So, in addition to the challenge of building patentability arguments into the patent application to rebut any potential examiner rejections regarding combinations, we needed to patent this valuable combination pronto.

We requested an expedited examination, interviewed the examiner and supervisor, and convinced them straight away that this combination was no ordinary, unpatentable combination. The extensive preparation in drafting the patent application paid off as we succeeded in receiving a warp speed allowance in under six months.

Within no time, the competitor offered to acquire Trius for about \$800 million, the largest biotech acquisition that year. I certainly felt the pressure cooker on that one.

“Patent law by its very nature provides an endless stream of cutting-edge inventions with a science focus while unavoidably focusing on business and law. Never a dull moment.”

As a side note, even though I was a mere conduit of their collective genius in getting a patent, the scientists were so ecstatic that in a selfless gesture, they put my name along with theirs on their commemorative patent plaque and presented me with one.

What would you advise a new inventor about seeking IP protection?

Intellectual property may be a company's only significant asset, and it's therefore worth the initial investment.

The company's viability relies on the ability to prevent competitors from infringing patents, trademarks, and/or copyrights. If a competitor can swoop in and take market share for an unpatented invention, competitors will price the product inexpensively to get sales, thereby squeezing the innovator's profit margins and destroying the company. ☺

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