

**IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK  
WHITE PLAINS DIVISION**

CARBONCHARGE TECHNOLOGIES  
LLC,

Plaintiff,

vs.

MARYLOU TALAFOUS-FAVETTA,  
individually and in her capacity as  
Executrix of The Estate of Dino A. Favetta,

Defendants.

No. 24cv361

**COMPLAINT FOR  
CORRECTION OF PATENT  
INVENTORSHIP AND TO  
QUIET TITLE**

**COMPLAINT**

Plaintiff CarbonCharge Technologies LLC (“CarbonCharge” or “Plaintiff”), by its undersigned attorneys, for its Complaint against Ms. Marylou Talafous-Favetta, individually and in her capacity as Executrix of the Estate of Mr. Dino A. Favetta (“Defendant”), upon actual knowledge and upon information and belief, alleges as follows:

**NATURE OF THE ACTION**

1. This is a civil action for declaratory judgment under 28 U.S.C. § 2201 as to patent inventorship under 35 U.S.C. § 256 of U.S. Patent No. 9,478,324 (the “324 Patent”) and U.S. Patent No. 10,121,563 (the “563 Patent”) (collectively, the “Biochar Patents”).

2. Plaintiff brings this action to correct the inventorship of the Biochar Patents to remove Mr. Dino A. Favetta from the list of inventors. Plaintiff also seeks a declaration of patent ownership and to quiet title of the Biochar Patents.

**THE PARTIES**

3. Plaintiff CarbonCharge is a Delaware Limited Liability Company with a principal place of business at 40 Fulton Street 17th Floor, New York, New York 10038.

4. Mr. Dirk-Jan Rosse is a member and owner of Plaintiff CarbonCharge and is a resident of Millbrook, New York.

5. Mr. James C. Slattery is a member and owner of Plaintiff CarbonCharge and is a resident of Staten Island, New York.

6. Mr. Dino A. Favetta died on or about January 10, 2023. Before his death, Mr. Favetta was domiciled at 87 Madison Street, Apartment 307, Park Ridge, New Jersey 07656.

7. Upon information and belief, Defendant Marylou Talafous-Favetta is the surviving spouse of Mr. Favetta and any interest that Mr. Favetta had in the Biochar Patents passed to her under Mr. Favetta's Last Will and Testament, dated October 5, 2015 (the "Will"). Exhibit 1. Upon information and belief, Defendant Talafous-Favetta is domiciled at 87 Madison Street, Apartment 307, Park Ridge, New Jersey 07656.

8. Ms. Talafous-Favetta was appointed as Executrix of Mr. Favetta's Estate by the Will. Mr. Favetta's Will was admitted to probate on March 7, 2023, at the Bergen County Surrogate's Court, New Jersey, by the Honorable Michael R. Dressler, Surrogate, Bergen County.

#### **JURISDICTION AND VENUE**

9. This Court has subject-matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a).

10. This Court has supplemental jurisdiction over the claim for declaratory relief involving patent ownership and to quiet title under 28 U.S.C. § 1367(a).

11. This Court has personal jurisdiction over Defendant because she is named in the Will as the beneficiary of Mr. Favetta's residual estate, which, on information and belief, includes the Biochar Patents. In relation to the Biochar Patents, Mr. Favetta routinely and repeatedly directed his activities involving the preparation and filing of those patents and the underlying

technology to and in the Southern District of New York. In the relevant time frame leading to the filing of the patent applications that would mature into the Biochar Patents, Mr. Favetta repeatedly met with and visited Mr. Rosse at or near Mr. Rosse's home in Millbrook, New York, for the purpose of securing his listing as an inventor on the Biochar Patents. Mr. Slattery also attended several of those meetings. During each of those visits, Mr. Favetta discussed with Mr. Rosse the latter's research, development, and technology that would eventually become the subject matter of the Biochar Patents. During those visits, Mr. Favetta would also take from Mr. Rosse samples of feedstock, bio-oil, converted-biomass pellets, and biochar pellets that Mr. Rosse had made using the end-to-end system/process described and claimed in the Biochar Patents. Mr. Rosse believed all this information would be kept confidential and would be used only for experimentation at the Stevens Institute of Technology ("Stevens"). Mr. Favetta also discussed his desire to found and to operate a business in the Southern District of New York that would build a biomass-processing plant in this District. Mr. Rosse wrote large portions of the Biochar Patent applications at his home in Millbrook, New York, and Mr. Favetta consulted with Mr. Rosse about the applications by email and phone numerous times while Mr. Rosse was in this District.

12. Venue is proper in this District under 28 U.S.C. § 1391, as a substantial part of the events or omissions giving rise to the claims occurred in this judicial district.

### **FACTUAL BACKGROUND**

13. The world is facing many crises. Chief among them is the ever-growing carbon load caused by the production and burning of fossil fuels. Carbon load has resulted in, according to most scientists, seismic changes in the Earth's climate and threatens our species with extinction. Without change, the planet careens towards catastrophe.

14. Humankind's reliance on hydrocarbon-based fertilizers that use greenhouse-gas-producing materials as feedstock is one source of this problem. These fertilizers and materials further compound environmental issues by adding more non-sequestered carbon to the ecosystem, directly altering the global nitrogen cycle and adding nitrogen and phosphate to the ecosystem. Further, these chemical fertilizers contribute to the decline in biodiversity and to widespread air-quality problems, and they destroy important carbon-sequestration systems in the oceans and other waterways. According to one report from the Yale School of the Environment, industrial ammonia production for use in fertilizers, on its own, produced about 1 to 2 percent of global carbon emissions. Nicola Jones, "From Fertilizer to Fuel: Can Green Ammonia Be A Climate Fix?" *Yale Environment 360*, Jan. 20, 2022, available at <https://e360.yale.edu/features/from-fertilizer-to-fuel-can-green-ammonia-be-a-climate-fix> (last visited Dec. 21, 2023). This is but a fraction of the dangers associated with the use of these fertilizers.

15. Unfortunately, the demand for ammonia-based fertilizer is only growing. As populations expand, industrialized farming has grown more and more dependent on such additives to the soil. Yet, even this lifeline against starvation is in jeopardy.

16. One proposed solution to the carbon-emissions and global-warming problems is biochar.

17. Biochar is defined by the International Biochar Initiative as a "solid material obtained from the thermo-chemical conversion of biomass in an oxygen-limited environment." (See <https://biochar-international.org/about-biochar/faqs/>.) Biochar has a role as a soil improver; pesticide remover or remediator; and food supplement to reduce methane emissions by cattle, and in reducing or even eliminating the need for chemical fertilizers. Produced properly, it is also a carbon sink. Thus, by 2018, the International Panel on Climate Change officially listed biochar as

a negative-emissions technology. *See* IPCC, *Global Warming of 1.5 °C: An IPCC Special Report on the impacts of global warming of 1.5 °C above pre-industrial levels and related global greenhouse gas emission pathways, in the context of strengthening the global response to the threat of climate change, sustainable development, and efforts to eradicate poverty*, Masson-Delmotte, V., Zhai, P., Pörtner, H. -O., Roberts, D., Skea, J., Shukla, P. R., Pirani, A., Moufouma-Okia, W., Péan, C., Pidcock, R., Connors, S., Matthews, J. B. R., Chen, Y., Zhou, X., Gomis, M. I., Lonnoy, E., Maycock, T., Tignor, M., & Waterfeld, T. (Eds.) (2018).

### **OVERVIEW OF THE BIOCHAR PATENTS**

18. On October 25, 2016, the '324 Patent, entitled "Systems and Methods for Producing Biochar-Based Products," was duly and legally issued by the United States Patent and Trademark Office ("USPTO"). A copy of the '324 Patent is attached as Exhibit 2.

19. The '324 Patent issued from U.S. Patent Application No. 13/648,828 ("the '828 Application"), filed on October 10, 2012.

20. On November 6, 2018, the '563 Patent, entitled "Systems and Methods for Producing Biochar-Based Products," was duly and legally issued by the USPTO. A copy of the '563 Patent is attached as Exhibit 3.

21. The '563 Patent is a continuation of the '324 patent and issued from U.S. Patent Application No. 15/334,165 ("the '165 Application"), filed on October 25, 2016.

22. The Biochar Patents claim priority to U.S. Provisional Patent Application No. 61/545,229 (the "'229 Provisional Application"), filed on October 10, 2011.

23. The face of the Biochar Patents lists three co-inventors: Dino Favetta of Cedar Knolls, New Jersey, Dirk-Jan Rosse of Millbrook, New York, and James C. Slattery of Staten Island, New York.

24. Plaintiff CarbonCharge is a current owner of the Biochar Patents by way of an assignment from Mr. Rosse and Mr. Slattery recorded at the USPTO on April 5, 2023. Copies of the assignments from Messrs. Rosse and Slattery recorded at the USPTO are attached as Exhibit 4.

25. On information and belief, Mr. Favetta never lawfully assigned his rights to the Biochar Patents. As such, on information and belief, Mr. Favetta retained purported co-ownership of the Biochar Patents upon his death on or about January 10, 2023.

26. On information and belief, Mr. Favetta was legally married to Ms. Marylou Talafous-Favetta. Mr. Favetta's Will names Ms. Talafous-Favetta as the sole beneficiary of Mr. Favetta's estate, which, upon information and belief, includes Mr. Favetta's interests in the Biochar Patents. On information and belief, Mr. Favetta's purported rights to the Biochar Patents legally passed to Ms. Talafous-Favetta. Thus, on information and belief, whatever rights Mr. Favetta had to the Biochar Patents now belong to Ms. Talafous-Favetta.

27. On information and belief, the entire right, title, and interest in the Biochar Patents is currently owned by Plaintiff CarbonCharge and, purportedly, by Ms. Talafous-Favetta (as Mr. Favetta's successor and heir).

28. As alleged herein, however, Mr. Favetta should not have been listed as an inventor on the Biochar Patents, and thus Mr. Favetta, and his successors and heirs (including Ms. Talafous-Favetta) should have no ownership rights in the Biochar Patents.

#### **THE TECHNOLOGY OF THE BIOCHAR PATENTS**

29. The Biochar Patents disclose an end-to-end system/process for producing advantageous biochar end products from a raw-biomass feedstock. (*See, e.g.*, Exhibit 2 (the '324 Patent) at "Abstract.")

30. The biochar end products produced by the patented end-to-end system/process may be used for a variety of applications. (*See, e.g.*, Exhibit 2 (the'324 Patent) at "Abstract.") One application is the fabrication of ultra-capacitor electrodes and electric-battery components. (*See, e.g., id.*)

31. As described, the method steps may be employed in selecting, treating, and handling biomass materials and their additive inputs to tailor their end performance. (*See, e.g.*, Exhibit 2 (the'324 Patent) at "Abstract.") Each operative step in the process may be employed to enhance the overall effectiveness of biochar generation and use. (*See, e.g., id.*) More specifically, the novel biochar-fabrication process allows the material inputs to respond to the fabrication process, thereby making a product that can be "tuned" and tailored to its use. (*See, e.g., id.* at 1:65-2:1.)

32. The patented method creates a novel material that is "net-shaped." (*See, e.g.*, Exhibit 2 (the'324 Patent) at 1:19-27, 4:60-5:2, 12:3-7.) The biochar produced by these methods has a multitude of "pores and chambers," such as a numerous "meso-, micro-, and nano-" pores. (*See, e.g.*, Exhibit 2 (the'324 Patent) at 7:14-26, 15:43-47, 17:5-10.) The size, number, length, diameter, and cross-channeling of the pores and chambers are affected by the concentration of free-radical ions of alkali metals found in the biomass and the processing conditions. (*See, e.g.*, Exhibit 2 (the'324 Patent) at 7:26-29.) In turn, the size, number, length, diameter, and cross-channeling of the pores and chambers affect the performance of the biochar in desired end products/applications, such as, *e.g.*, absorbing and holding electrical ions and electrons. (*See, e.g.*, Exhibit 2 (the'324 Patent) at 7:29-32, 17:5-10.)

33. As described in the Biochar Patents, "[t]he 'Time, Temperature, Pressure, and Environment' (the Prepared Biomass-generated volatiles created by the heating of the Prepared

Biomass, or other introduced gas, liquid, vacuum of the charring furnace environment) is an important aspect in controlling the chemical transformations within the resulting biochar to control the end physical, chemical and electrical properties of the resultant net-shaped and prepared biochar for use as a component in ultra-capacitor electrodes.” (See, e.g., Exhibit 2 (the ’324 Patent) at 17:11-19.) The newly formed biochar created in accordance with the processes described in the Biochar Patents is a substantially pure carbon material containing a high degree of meso-, micro-, and nano-porosity. (See, e.g., *id.* at 15:43-46, 17:5-10.)

34. The Biochar Patents further discuss net-shaping the “Raw Biochar” into ultra-capacitor electrodes. (Exhibit 2 (the ’324 Patent) at 17:32-37.) According to the Biochar Patents, “[t]he Net-Shaping takes advantage of the controlled presence of the Biomass inputs of residual ions, compounds and elements in the controlled fabrication of the biochar electrode pores, channels, tubes, spaces, surfaces, cross-channeling and conductivity of those ions and added ions in the controllable end performance characteristics of the net-shaped biochar as an ultra-capacitor electrode.” (Exhibit 2 (the ’324 Patent) at 17:54-61.)

35. Further, “suitability of Net-Shaped Ultra-Capacitors made from Biochar can be tuned and tailored to the end-use applications to meet the performance requirements of energy density, power density, frequency response, electrical charge and discharge rates, number of charge cycles and other economic and engineering parameters mainly based on the key factors of raw biomass selection, handling, compounding, converting, pre-shaping, charring, net-shaping and treating, (not necessarily in that order.)” (Exhibit 2 (the ’324 Patent) at 18:4-12.)

36. Combined, the Biochar Patents have 20 claims, two of which are independent claims, and the remainder are dependent claims. All claims describe methods for generating biochar material.



37. In the case of the '324 Patent, Claim 1 is directed to:

- A method for generating net-shaped biochar material for use in charge storage, comprising:
- a. selecting plant material for use in generating biochar;
  - b. mechanical conversion of the selected plant material to form mechanically converted plant material exhibiting a fibrous consistency;
  - c. shaping the mechanically converted plant material to a pre-shaped condition defining wafers; and
  - d. charring the wafers in a furnace to generate net-shaped biochar wafers;
- wherein the plant material obviates the need for additive compounds as part of the charring step in generating net-shaped biochar wafers;
- wherein the plant material generates free-radical ions of alkali metals in the charring step sufficient to create pores and chambers within the biochar wafers for charge storage; and
- wherein the charring step is performed without additive compounds.

(Exhibit 2 (the '324 Patent) at Claim 1.)

38. Thus, Claim 1 of the '324 Patent claims a unique method of processing plant-based biomaterials using mechanical conversion and conditioning into wafers and charring the wafers into net-shaped biochar wafers — without the need for additive compounds — for use in charge storage.

39. Dependent Claim 10 of the '324 Patent recites using the “net-shaped biochar wafers as an ultra-high capacitor or a battery component.”

40. According to the Examiner’s statement of reasons for allowance for the '324 Patent, “the prior art of record does not teach or suggest a method for generating net-shaped

biochar material as claimed.” (Exhibit 5, the ’324 Patent Prosecution History, June 28, 2016 Notice of Allowance at 2.)

41. In the case of the ’563 Patent, Claim 1 is directed to:

- A method for generating biochar material, comprising:
- a. selecting plant material for use in generating biochar based on predetermined criteria;
  - b. mechanical conversion of the selected plant material;
  - c. pre-shaping the mechanically converted plant material to a desired net-shape;
  - d. charring the mechanically converted plant material in the desired net-shape in a furnace to generate biochar material; and
  - e. fabricating at least one end-product from the net-shaped biochar material.

(Exhibit 3 (the ’563 Patent) at Claim 1.)

42. Thus, Claim 1 of the ’563 Patent claims a unique method of processing plant-based biomaterials such that, after processing, the resulting material retains a “net-shape” after the process of being “charred” into biochar.

43. Claim 9 of the ’563 Patent depends on Claim 1 with the added limitation of “using the end-product as an ultra-high capacitor or a battery component.”

44. According to the Examiner’s statement of reasons for allowance for the ’563 Patent, “the prior art of record does not teach or suggest a method for generating biochar material as claimed.” (Exhibit 6, the ’563 Patent Prosecution History, July 9, 2018 Notice of Allowance at 2.)

**THE CONCEPTION, REDUCTION TO PRACTICE,  
AND PROSECUTION OF THE BIOCHAR PATENTS**

45. Mr. Rosse is a trained engineer with extensive experience in agronomy, construction, and metal fabrication. He has a Bachelor of Science degree in Agricultural Engineering from Cornell University.

46. Mr. Rosse, while a trained engineer, is also a tinkerer. For example, as a child, Mr. Rosse was familiar with wood stoves, but he felt there must be a better way to generate heat in an environmentally responsible way. Long interested in this question, Mr. Rosse, through self-study and work with a growing environmentally conscious community, began, at his own expense, experimenting with biomass sources to generate biomass pellets as fuel. Mr. Rosse first focused on grasses due to their short growing cycle.

47. During the course of these experiments, Mr. Rosse became knowledgeable of the potential of Goldenrod (genus *Solidago*) as a source of biomass for a larger effort to convert such material into a fuel source suitable for use in a wood stove.

48. In the process of his experimentation to find a suitable source of biomaterial, Mr. Rosse discovered that conversion of certain kinds of biomass into fuel pellets created material that did not hold its shape during the “biochar” formation process. Moreover, certain materials, upon use, had an unacceptable level of residual material, known as ash.

49. Through careful trial and error, Mr. Rosse identified different plants, growing conditions, and soils in the quest to understand what would make an optimal biomass feedstock. He traveled, talked to different farmers, and went to U.S. Department of Agriculture offices to study maps and to check soil conditions. Mr. Rosse further learned that various biomaterials, even those from the same genus, have different constituent elements. Plants that grow slow and have

low lignin content have different complex structures than plants that grow quickly and may have higher lignin content.

50. With this knowledge, and again through trial and error, Mr. Rosse tinkered, adjusted, and altered the processes, including the steps before, during, and after pellet formation to unlock and to manipulate the biomass feedstock to produce a desirable end product. Mr. Rosse's efforts led to the initial step in the successful conception of the Biochar Patents process. True to his skill, education, and heritage as an engineer, he understood and recorded processes and data.

51. Mr. Slattery is an electrical engineer by education and training, with extensive experience arising from his work as Managing Engineer Primary System for Consolidated Edison of New York, Inc. ("Consolidated Edison"). He has a Bachelor of Engineering Sciences degree from the College of Staten Island, City University of New York. Mr. Slattery is also a Licensed Professional Engineer in the states of New York and Connecticut.

52. Mr. Slattery has been working with power systems for decades. Through his work with Consolidated Edison and his educational background, he understood the long-felt need for small capacitors that have a large size-to-energy-storage ratio, are stable, and can easily be charged and discharged with a large number of cycles reliably available over time.

53. Mr. Slattery was also very familiar with the use of capacitors for power correction. Most power systems are alternating-current ("AC") systems. Because the current and voltage alternate in AC systems, the flow of electrons is not always constant in one direction. Some uses of electrical power, particularly with motors, inductive-heating equipment, generators, transformers, and arc-welding equipment produce an electrical lag, and thus induction or capacitance, when powered with alternating current. This can cause problems at the user level, but also across the electrical-power grid.

54. The ability of a capacitor to store and to release energy in the form of current in a linear fashion has multiple applications. In theory, the smaller and more powerful a capacitor is, the better it is. But creating such capacitors faces many issues, and efforts to create small powerful capacitors — known as ultracapacitors or supercapacitors — using carbon substrates have largely been unsuccessful.

55. Through Mr. Favetta, Mr. Slattery was made aware of Mr. Rosse's work and the material produced by Mr. Rosse.

56. Because of his education, experience, and training, Mr. Slattery recognized that higher energy density (and, hence, greater ability to store charge for a given size) could be achieved with the unique properties of the net-shaped product produced by Mr. Rosse's methods. Mr. Slattery recognized that Mr. Rosse's net-shaped biochar process, through the pre-shaping and the conditions in the combustion process, would create additional surface area that could be used for charge storage. Further, he conceived that, if the surface area (either through channels or pores) were accessible to the chemical processes that permit the surface of the carbon substrate to hold an electrical charge, then the biochar could be the basis for forming a unique ultracapacitor or electrical-storage system. Mr. Slattery also recognized that the selection of starting materials and the process parameters could be adjusted for this specific application. For these reasons, Mr. Slattery proposed fabricating a capacitor using the materials generated by Mr. Rosse.

57. Mr. Favetta was a self-employed chemical and electrical engineer, and an adjunct professor at Stevens. He received his B.E. and M.E. from that institution.

58. Mr. Rosse first met Mr. Favetta as part of an entirely different enterprise than biochar and its applications. In the early 2000s, Mr. Favetta was associated with work conducted at Stevens under a grant from the U.S. Department of Defense ("DoD") directed to the processing

of biomaterials into “pyrolysis oil” for use as an alternative fuel source. Mr. Favetta was not the lead investigator for the grant, but was responsible for aspects of the control mechanisms for a reactor designed to convert plants into oil. This grant work was consistent with Mr. Favetta’s prior experience with a company he had formed called Controlamatics Corporation, which offered consulting services for control systems similar to the work conducted under the grant. In all, Mr. Favetta’s expertise was in automation control.

59. Around this same time, Mr. Rosse applied for and was granted a license to process biomaterials, including Goldenrod, into alternative fuel sources. This license was of public record. Mr. Favetta, while working at Stevens under the DoD grant, stumbled upon Mr. Rosse in 2010 through a review of public licenses granted for processing biomaterials. As of 2010, and prior to meeting Mr. Favetta, Mr. Rosse had already conceived of and reduced to practice an end-to-end system and certain processes for producing biochar from a raw-biomass feedstock.

60. After this, Mr. Favetta was, at best, a “pair of hands” that transferred the biochar produced solely by Mr. Rosse to others for experimental testing. For example, on or about 2010, Mr. Rosse provided pyrolysis oil and samples of the biochar to Mr. Favetta free of charge and on a confidential basis; Mr. Favetta then brought them to Stevens researchers for experimental testing and analysis. In fact, in January of 2018, almost eight years after meeting each other, Mr. Favetta was still asking Mr. Rosse for biochar samples because Mr. Favetta was, and always had been, incapable of producing the biochar himself.

61. On information and belief, Mr. Favetta had little to no experience with pyrolysis, biomaterial preparation, or the development of electrical-storage devices. Mr. Favetta convinced Mr. Rosse to work with him starting in or around 2010 by presenting himself as someone with important connections who could help commercialize Mr. Rosse’s process. In fact, by writing

around June 2010 that “[y]ou know all this stuff, not me!” Mr. Favetta admitted that the specifics of the process, as well as those relating to the technical details of the biochar product, came from Mr. Rosse. Indeed, Mr. Favetta used the term “Dirk’s biochar” and similar phrases many times when writing about the product.

62. Tellingly, around April 2011, Mr. Favetta acknowledged in writing to Mr. Rosse that he had contributed nothing to the technology and, when recounting Mr. Rosse’s contribution, recognized that “the true IP” and “proprietary” techniques that resulted in the Biochar Patents were “your secret totally.”

63. After convincing Mr. Rosse to work with him, Mr. Favetta asked for “some details about your biochar” on or about June 2010, and pressured Mr. Rosse to spend time detailing the “Technical Data” of what he called “[y]our char.” Starting around this same time in Spring and Summer 2010, and continuing into 2011, Mr. Favetta made at least a half-dozen trips to meet with Mr. Rosse at or near his home in Millbrook, New York, to retrieve feedstock, bio-oil, converted-biomass pellets, and biochar pellets produced by Mr. Rosse using his end-to-end system and processes, and to seek information from Mr. Rosse about how Mr. Rosse’s system and processes worked. Mr. Rosse believed all this information would be kept confidential and would be used only for experimentation at Stevens.

64. Between June 2010 and October 10, 2011, Mr. Favetta controlled the preparation and filing of the ’229 Provisional Application. While Messrs. Rosse and Slattery provided the relevant materials and insight to draft the ’229 Provisional Application and the subsequent Biochar utility applications, Mr. Favetta interposed himself between the two co-inventors and the prosecuting patent attorney with respect to decision-making. While Messrs. Rosse and Slattery provided the essential information underlying, and contributed to the drafting

of, the patent application, they were generally kept out of the loop of the preparation, filing, and prosecution of the Biochar Patents, while Mr. Favetta controlled the flow of information and insisted on being in charge.

65. Mr. Favetta apparently knew the prosecuting patent attorney socially and set up the engagement for prosecuting the Biochar Patents.

66. Mr. Favetta provided the prosecuting attorney with an initial draft of the provisional patent application on or about October 4, 2011.

67. Mr. Favetta dictated the order in which the inventors were listed on the patent application, placing himself as the first-named inventor without consulting with either Mr. Rosse or Mr. Slattery.

68. The subsequent filings of the Biochar utility applications followed the same pattern. Mr. Favetta would solicit information from Messrs. Rosse and Slattery and then control the distribution to the prosecuting patent attorney. Indeed, as only recently learned by Messrs. Rosse and Slattery, the filing of the '165 Application was delayed in part because the prosecuting patent attorney had been given instructions by Mr. Favetta to consider adding allegedly new subject matter that Mr. Favetta had been discussing with a third party, which ultimately was not added.

69. Since March 2022, despite the fact that he was their attorney of record on the '324 and '563 Patents, the prosecuting patent attorney has refused to provide Messrs. Rosse and Slattery any case files, which forced Messrs. Rosse and Slattery to expend extraordinary efforts in an attempt to wrest their patent records from the prosecuting law firm and, working with new legal counsel, to reconstruct as much of the patent-prosecution history as possible from email



correspondence that started more than twelve years ago. Those efforts are ongoing as of the date of this Complaint.

70. Through these efforts, Messrs. Rosse and Slattery have obtained incomplete drafting records that reveal how Mr. Favetta simply copied or incorporated ideas and concepts communicated to him by Messrs. Rosse and Slattery and passed them along to the prosecuting patent attorney.

71. The Notice of Allowance for the '165 Application was mailed on July 19, 2018. After discussions between only Mr. Favetta and the prosecuting patent attorney — but not with Messrs. Rosse and Slattery — no additional continuing-patent applications were filed, thus effectively truncating any future lineage of the Biochar Patents.

72. Evidence uncovered over approximately the past eighteen months shows that the decision of whom to name as co-inventors on the Biochar Patents was dictated to Messrs. Rosse and Slattery by Mr. Favetta and the attorney prosecuting the patents. At the time, neither Mr. Rosse nor Mr. Slattery were aware of the legal implications attached to the inventorship determination, nor were they informed of such implications by either Mr. Favetta or the prosecuting patent attorney.

73. Messrs. Rosse and Slattery, however, are the only true inventors of the entire subject matter claimed in the Biochar Patents. Mr. Favetta did not contribute to the formation in the minds of Messrs. Rosse and Slattery of a definite and permanent idea of the complete and operative invention, as it was thereafter to be applied in practice and claimed in the Biochar Patents. Mr. Favetta provided no contribution to the inventions as claimed in the Biochar Patents. Accordingly, Mr. Favetta should be removed as an inventor of the Biochar Patents.

**COUNT I**  
**(Correction of Inventorship of the '324 Patent)**

74. CarbonCharge alleges and incorporates the allegations set forth in Paragraph 1 through Paragraph 73 herein.

75. Mr. Favetta was not involved in conceiving, developing, or reducing to practice the inventions claimed in the '324 Patent.

76. Mr. Favetta is not an inventor of the subject matter claimed in the '324 Patent.

77. Messrs. Rosse and Slattery are the only true inventors of the '324 Patent.

78. Under 28 U.S.C. § 2201 and 35 U.S.C. § 256, CarbonCharge seeks correction of the '324 Patent to reflect the proper inventorship by removing Mr. Favetta as an inventor.

79. This Court should issue an order pursuant to 35 U.S.C. § 256 directing the Commissioner for Patents to remove Mr. Favetta as an inventor from the '324 Patent.

**COUNT II**  
**(Correction of Inventorship of the '563 Patent)**

80. CarbonCharge alleges and incorporates the allegations set forth in Paragraph 1 through Paragraph 79 herein.

81. Mr. Favetta was not involved in conceiving, developing, or reducing to practice the inventions claimed in the '563 Patent.

82. Mr. Favetta is not an inventor of the subject matter claimed in the '563 Patent.

83. Messrs. Rosse and Slattery are the only true inventors of the '563 Patent.

84. Under 28 U.S.C. § 2201 and 35 U.S.C. § 256, CarbonCharge seeks correction of the '563 Patent to reflect the proper inventorship by removing Mr. Favetta as an inventor.

85. This Court should issue an order pursuant to 35 U.S.C. § 256 directing the Commissioner for Patents to remove Mr. Favetta as an inventor from the '563 Patent.

**COUNT III**  
**(Declaration of Patent Ownership and to Quiet Title)**

86. CarbonCharge alleges and incorporates the allegations set forth in Paragraph 1 through Paragraph 85 herein.

87. A controversy presently exists between CarbonCharge and Defendant Talafous-Favetta, as Mr. Favetta's successor, heir, and Executrix of Mr. Favetta's estate, as to who is the proper owner of the Biochar Patents.

88. Because Mr. Favetta is currently listed a co-inventor of the Biochar Patents, Mr. Favetta's heir(s) (including Ms. Talafous-Favetta) wrongfully retain purported ownership rights to the Biochar Patents.

89. Because Mr. Favetta's heir(s) (including Ms. Talafous-Favetta) retain purported ownership rights to the Biochar Patents, CarbonCharge wrongfully does not own the entire right, title, and interest in the Biochar Patents.

90. CarbonCharge is entitled to a declaration that Mr. Favetta is not a co-inventor, and thus neither Ms. Talafous-Favetta nor any other heir of Mr. Favetta is a co-owner of the Biochar Patents, and that CarbonCharge owns the entire right, title, and interest in the Biochar Patents through the assignment to CarbonCharge by Messrs. Rosse and Slattery.

**JURY TRIAL DEMANDED**

In accordance with Federal Rule of Civil Procedure 38 and the Local Rules of the Southern and Eastern Districts of New York, Plaintiff requests a jury trial of all issues properly triable by jury.

**PRAYER FOR RELIEF**

**WHEREFORE**, Plaintiff prays for judgment against Defendant(s) as follows:

1. That the inventorship of the '324 Patent and of the '563 Patent be corrected to reflect only the two true inventors, Messrs. Rosse and Slattery;
2. That CarbonCharge shall be declared the true and lawful owner of the entire right, title, and interest in and to the Biochar Patents; and
3. Any further relief that the court may deem just and equitable.

Dated: January 17, 2024  
New York, New York

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