

# Kluwer Patent Blog

## Claiming the ownership of your alleged invention in Spain might cause you sorrow and pain

Miquel Montaña (Clifford Chance) · Monday, February 14th, 2022

On 27 January 2022, the Spanish Supreme Court handed down a very interesting judgment dealing with a dispute surrounding the ownership of a patent application that claims a system to produce domestic hot and cold water. Judgments dealing with patent ownership are very scarce in Spain. Hence the interest of this case, the background to which may be summarized as follows:

The complainant (ICMA Sistemas S.L., “ICMA”) is a company that manufactures and markets geothermal heat pumps. Between 2007 and 2012, ICMA entered into three research & development (“R&D”) agreements with the University of Vigo, financed by ICMA and partially subsidized by the region of Galicia. The director of the second project was Mr. X. In the context of these R&D projects, the researchers at the University of Vigo and Mr. X had access to a prototype heat pump developed by ICMA.

In January 2012, the wife of Mr. X, who is a medical doctor, founded Ecoforest Geotermia S.L. (“Ecoforest”), a company that manufactures and markets heating pump systems.

On 5 October 2012, Ecoforest filed patent application ES 2454740 (“ES ‘740”), which protects a system to produce domestic water. The inventors named were Mr. X and Mr. Y, the director general of the Ecoforest group. Also, after the three R&D agreements had been completed, Ecoforest started to compete with ICMA on the heat pump market.

Against this background, ICMA filed a complaint against Ecoforest before the Commercial Courts of Pontevedra (Galicia) where, to sum-up, it claimed the ownership of patent application ES ‘740 and it maintained that Ecoforest had carried out various acts of unfair competition, including acts contrary to the principle of good faith. On 6 February 2017, Commercial Court number 3 of Pontevedra dismissed the complaint, finding, in a nutshell, that the domestic water system claimed in ES’ 740 had differences with respect to the prototype developed by the complainant. That conclusion was reached after assessing the expert opinions filed by both parties.

ICMA filed an appeal to the Pontevedra Appeal Court which, on 7 September 2018, dismissed the appeal on similar grounds (i.e., lack of identity between the prototype developed by ICMA and the system claimed in ES ‘740).

ICMA then filed an appeal to Supreme Court, which decided to hear the appeal. However, after considering the arguments of the parties, the Supreme Court dismissed the appeal. In relation to the

claim to the ownership of the invention, in response to the argument that the invention had its origin in ICMA's prototype, the Supreme Court considered that the relevant question was whether or not all the characteristics of the invention were the result of the research carried out in the framework of the R&D agreements mentioned above. The thinking of the Supreme Court is best encapsulated in the following paragraph:

*“The approach is inappropriate because, as not all the technical characteristics of the patented invention in claim 1 were in the prototype produced by the research work, it focuses on highlighting that the novelty lies where they do coincide and, where they do not, there is no novelty or inventive step. It is not a question of judging the novelty and inventive step of the patented invention, but rather of whether the ownership should be ICMA's due to the results of the research, and as we have already indicated, this implies that the invention as such, with all its technical characteristics and not just some of its characterising elements, was the result of that research work. As this has not been demonstrated, we believe that the claim was rightly dismissed.”*

So, in conclusion, this appeal was dismissed because the Supreme Court considered that, for the complaint to succeed, the complainant should have proved that each and every characteristic of the invention had been conceived by ICMA and/or in the framework of the R&D projects mentioned above.

The unfair competition arguments met with the same fate. What follows reflects how the Supreme Court addressed one of the most forceful unfair competition pleas:

*“The involvement of Mr. X, as a university professor, in the research project will inevitably have contributed to enhancing his knowledge of the subject of the research. Although taking advantage of the results of the research group, something that has not occurred in this case, would be an unfair act, the same cannot be said of the scenario where, once the project had concluded and ICMA had executed the prototype resulting from the research work, Mr Vicente developed a different system with another company, using knowledge acquired in the research work.*

*The dividing line between taking advantage of the results of the research and using the knowledge that is necessarily acquired by whoever intervenes in the research work to then develop another geothermic heat pump which, when launched onto the market, competes with the pump resulting from the research group, may not be very clear. But in this case, if we look at the conduct reported in the claim and the outcome illustrated at first instance by the expert opinions, the defendants' conduct did not constitute unfair competition as claimed, as there was no misappropriation of someone else's efforts, but rather lawfully taking advantage of the education acquired as a result of participation in the research group.”*

Whether or not making use of knowledge partially acquired through R&D projects financed by a third party to develop a technological system which seems to be an improvement of the prototype provided by that third party and which is aimed at competing with that third party is fair, may of course depend on where the threshold of fairness is drawn. One of the interesting points for thought raised by this judgment is whether the threshold of fairness applied is high, medium or low. Different readers will probably reach different conclusions.

All in all, the clear teaching of this judgment is that, unless the invention claimed in a patent application filed by a third party is identical to the invention that you allege to have conceived, claiming ownership of the invention in Spain will cause you sorrow and pain.

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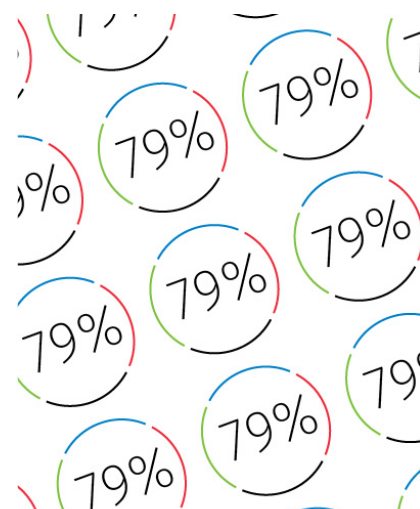
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