

# IP Energy Capabilities 2024

CMS is a heavyweight in both energy and intellectual property specialisms. There are few firms (if any) that can match our “Tier One” ranked capability in both areas across many key jurisdictions, most notably, England and Scotland. The breadth and depth of our expertise enables us to support energy, power and renewables clients looking to protect and monetise their innovation, technology and brands. From patent disputes in wind turbines through to fast-track green patent filings; from generative AI challenges through to station franchising and advertising greenwashing, our team stands ready to assist.

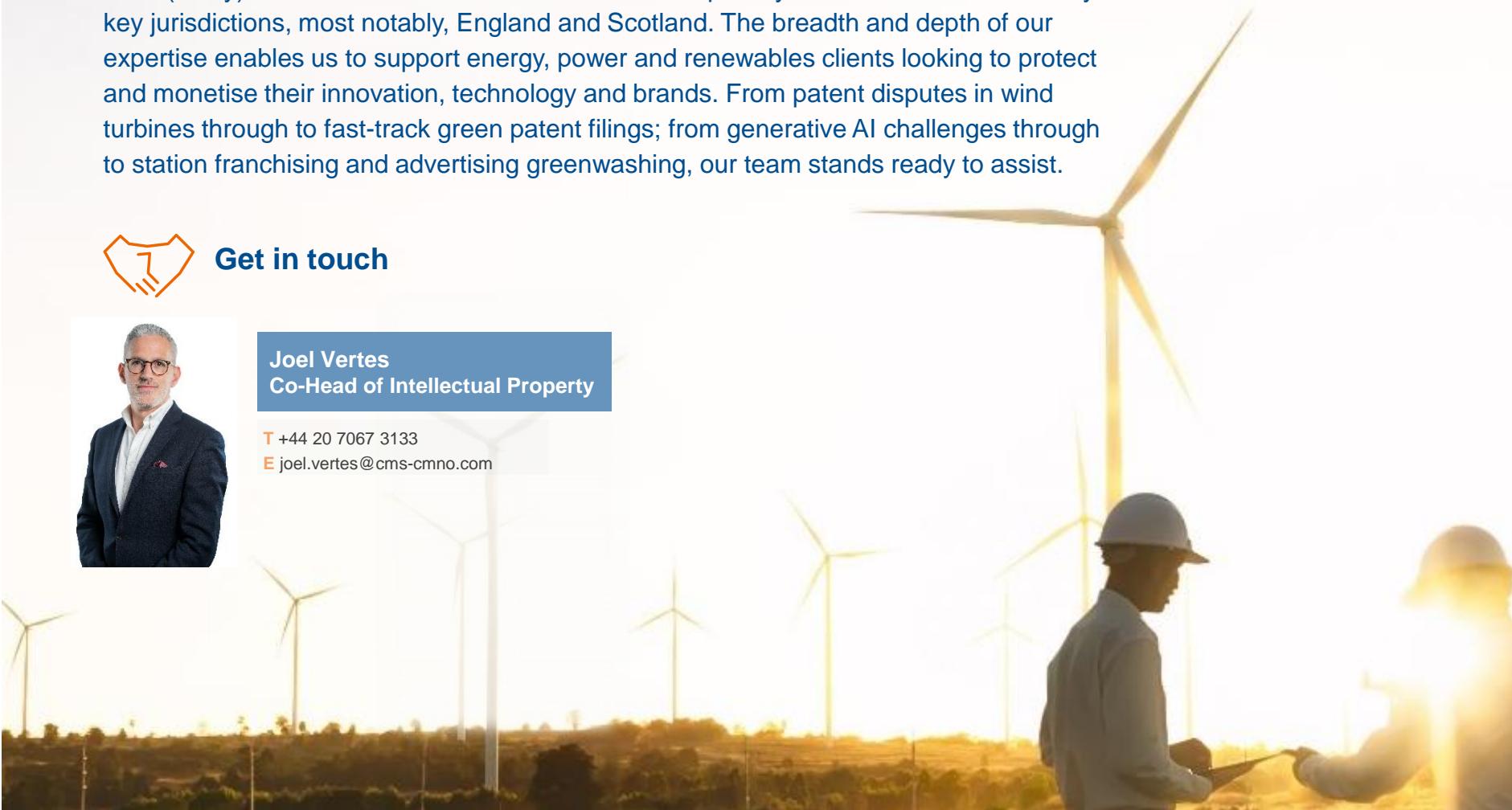


## Get in touch



**Joel Vertes**  
Co-Head of Intellectual Property

T +44 20 7067 3133  
E [joel.vertes@cms-cmno.com](mailto:joel.vertes@cms-cmno.com)



**CMS**  
law·tax·future

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CMS provides a comprehensive IP service capable of handling any dispute, transaction or prosecution strategy. The team is celebrated for hi-tech and digital expertise. CMS is also one of very few firms with in-house patent attorneys.

*Intellectual Property: London –  
Chambers and Partners UK 2024*

With a global presence spanning 78 offices in over 40 countries, CMS has consolidated its reputation in the IP arena. It boasts one of the biggest IP teams in the United Kingdom, and is stacked with an elite group of practitioners who are adept at filing, protecting and enforcing intellectual property for their esteemed clientele. .

*World Trademark Review 1000, 2024*

CMS presents a comprehensive patent offering, taking in contentious and non-contentious legal matters alongside a robust and well-stocked prosecution team with cutting-edge technical capabilities.

*IAM Patent 1000 2023*

# Intellectual property issues for the energy sector

There are many IP issues that are impacting the fast-paced energy sector. Here are just nine examples of the IP issues we are working on with our clients. CMS would be delighted to provide in-depth training and advice to your teams on any of these issues – please do use this as a menu to cherry-pick from.



## Offshore enforceability of patents

In 2022, the English Courts ruled that offshore windfarms are not caught by the UK Patents Act. The judgment is also likely to be applicable in Scotland.

This significant judgment may de-risk operator businesses and bring new commercial opportunities.

Conversely, IP owners may need to look for more novel claims to bring against infringers. There is also scope for lobbying for change for IP owners, given the law was written before the wind industry emerged.

Our patents team stands ready to advise on this nuanced area.



## Advertising and green-washing

Industry is under pressure from government and consumers to adopt more sustainable practices. However, businesses must provide an honest account of the effect their activities have on the environment without conveying a false impression or providing misleading information.

Reputational risk from “green washing” means compliance with consumer protection laws and advertising codes must be ingrained across the whole organisation. Regulators have expressed particular focus recently on energy utility companies. Our advertising team is already working with many clients in this area.



## AI risks and opportunities for exploration and innovation

The rapid recent emergence of generative AI creates significant opportunities as well as risks for clients in the energy sector.

We can also advise on patents being granted for inventions relating to AI, and on the significant regulatory, policy and ethical issues surrounding AI.

Our team already has exclusive rights to an AI tool which can help identify both patent validity and third party infringements. This tool enables you to support licensing or litigation activity, driving new revenue from otherwise purely defensive or dormant patents.

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## Green patents

Every energy business is innovating, particularly those transitioning from traditional fossil fuel based systems to renewable and sustainable operations.

The UK Intellectual Property Office is highly supportive of companies seeking patent protection in the UK for green technologies.

Our huge in-house patent attorney team can advise on a number of available initiatives, including expedited patent application and examination processes, as well as supporting you on patent prosecution procedure.



## Transactional IP developments

We have seen a trend towards open innovation and collaboration and a move away from traditional IP licence agreements.

Some companies remain focused on monetising sustainable innovations in new licensing contexts, others wish to bring the industry with them through education and collaboration.

Our IP team advises on billion-dollar ventures in the energy sector, and can advise you on commercialisation and R&D strategy, as well as negotiations in M&A deals.



## Unified Patent Court

The new European Unified Patent Court and Unitary patents provide a complex legal environment of patent scope and enforcement in Europe.

For the first time, a single pan-European patent exists – a pan-European injunction can now be obtained against an infringer from a single court action. However, it also means validity of key patents can also be attacked just once, to devastating effect.

With IP lawyers in all key jurisdictions, CMS is ideally placed to advise on your European patent strategy.

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## Confidentiality and trade secrets

From energy generation to downstream retail, every energy company relies on sensitive information, protecting both innovations and confidential data. Trade secrets, know-how and confidential information are often-overlooked IP assets.

Effective policy and procedure are the foundations of, and can be an absolute pre-requisite for, enforcement of these rights. CMS can also help manage your risk, identify knowledge gaps and bottlenecks, reduce operational risks and infringement leaks, improve efficiency and ultimately drive value.



## Standard Essential Patents (SEPs) and FRAND Licensing

Standards facilitate the interoperability of technology from one company to another and from device to device. Companies holding Standard Essential Patents (SEPs) are increasingly looking to industries outside of the classical telecoms sector for licensing revenue (in the case of SEPs, this being FRAND licensing, i.e. licensing that is on a Fair, Reasonable and Non-Discriminatory basis).

These SEP holders have the energy sector in their sights. The UK, a hotbed for SEP/FRAND activity, is going to be a key battleground. CMS is experienced in both bringing and defending SEP/FRAND claims, with expertise forged in the High Court through to the Supreme Court.



## Development of IP policies

Effective IP policies are essential for sophisticated energy clients. For instance, do you have an invention capture process which identifies new innovations and enables patent filings? Are you taking steps to mitigate the risk of premature disclosure of an invention? Do you manage “open-source software” usage to prevent tainting of proprietary source code? Or around generative AI usage to avoid inadvertent disclosure of commercial secrets and confidential customer data?

# Some highlights of our experience

## Equinor

Equinor on its US\$1.1bn joint venture arrangement with BP relating to windfarm technology and knowhow.

## National Grid

National Grid on the IP and technology licensing and transfer arrangements in connection with the West Coast HVDC Link and providing IP advice for the Eastern Green Link 2 (a 2GW high voltage DC link connecting the electricity transmission system in Scotland owned by SSE and the electricity transmission network owned by National Grid in England).

## Centrica

Centrica on a range of IP matters including management of its IP portfolio, trade mark disputes, trade secrets matters and IP aspects of M&A transactions.

## EDF

EDF on the IP aspects of various transactions.

## Halliburton

Halliburton on the IP aspects of its acquisition of an innovative technology oilfield service company, Red Spider Technology Limited.

## BP/Castrol

BP/Castrol on the acquisition of a wind turbine technology business Romax Insight.

## Hydra Well Intervention AS

A leading supplier of oil well tooling, in binding declaration of non-infringement proceedings at the Intellectual Property Office against Titan Torque and HRG Well Solutions, rival oil well tooling suppliers.

## Shareholders in an oil & gas company

Successfully defending a £15million claim brought in the Court of Session, Scotland, in respect of alleged breach of IP warranties given in a Share Purchase Agreement.

## Major global construction company

Advising an internationally renowned construction company on protecting innovations developed during a nuclear facility project.

## BP

BP on a wide range of IP matters, from brand protection and trade mark disputes through to IP aspects of tech M&A transactions.

## PKN Orlen

PKN Orlen – Poland's largest oil refiners/petrol retailer, on various complex deals including in relation to chemical manufacturing plants and IP collaborations.

## Scottish oil & gas operator service co.

Defending a c. £55 million claim involving the alleged misappropriation of IP by a licensee in a case involving complex areas of Texan, UK and Scots contractual and patent law

## Awards



Named UK Trademark Prosecution Law Firm of the Year at the *Managing IP* Awards 2022



Named firm of the Year for IP Transactions & Advisory at the Managing IP Awards, United Kingdom: Scotland 2023



Tier 1 Intellectual Property: Trade marks, copyright and design – *TMT, United Kingdom - Solicitors, London Legal 500*: 2022 & 2023



Tier 1 PATMA: Patent Attorneys – TMT, UK: London Legal 500: 2022 & 2023



Tier 1 PATMA: Patent Attorneys – TMT, UK: London Legal 500: 2022 & 2023



Tier 1 Intellectual Property – Legal 500 and Chambers and Partners – Scotland



Gold Tier Firm: Solicitors – World Trademark Review 1000, England & Scotland 2023



Listed in 8 jurisdictions with 22 recommended individuals – *IAM Patent 1000* 2022 & 2023

# Key contacts in the CMS IP team

Our global IP team handle the full lifecycle of IP assets, in both contentious and non-contentious work. Whether you own IP or license it, we can help you maximise the value of the assets in your portfolio.



## Joel Vertes

Co-Head of Intellectual Property, Partner

**T** +44 20 7067 3133

**E** [joel.vertes@cms-cmno.com](mailto:joel.vertes@cms-cmno.com)

[Web bio](#)



## Toby Sears

Partner

**T** +44 20 7367 2018

**E** [Toby.Sears@cms-cmno.com](mailto:Toby.Sears@cms-cmno.com)

**W** [Web bio](#)



## Neeraj Thomas

Partner

**T** +44 141 304 6086

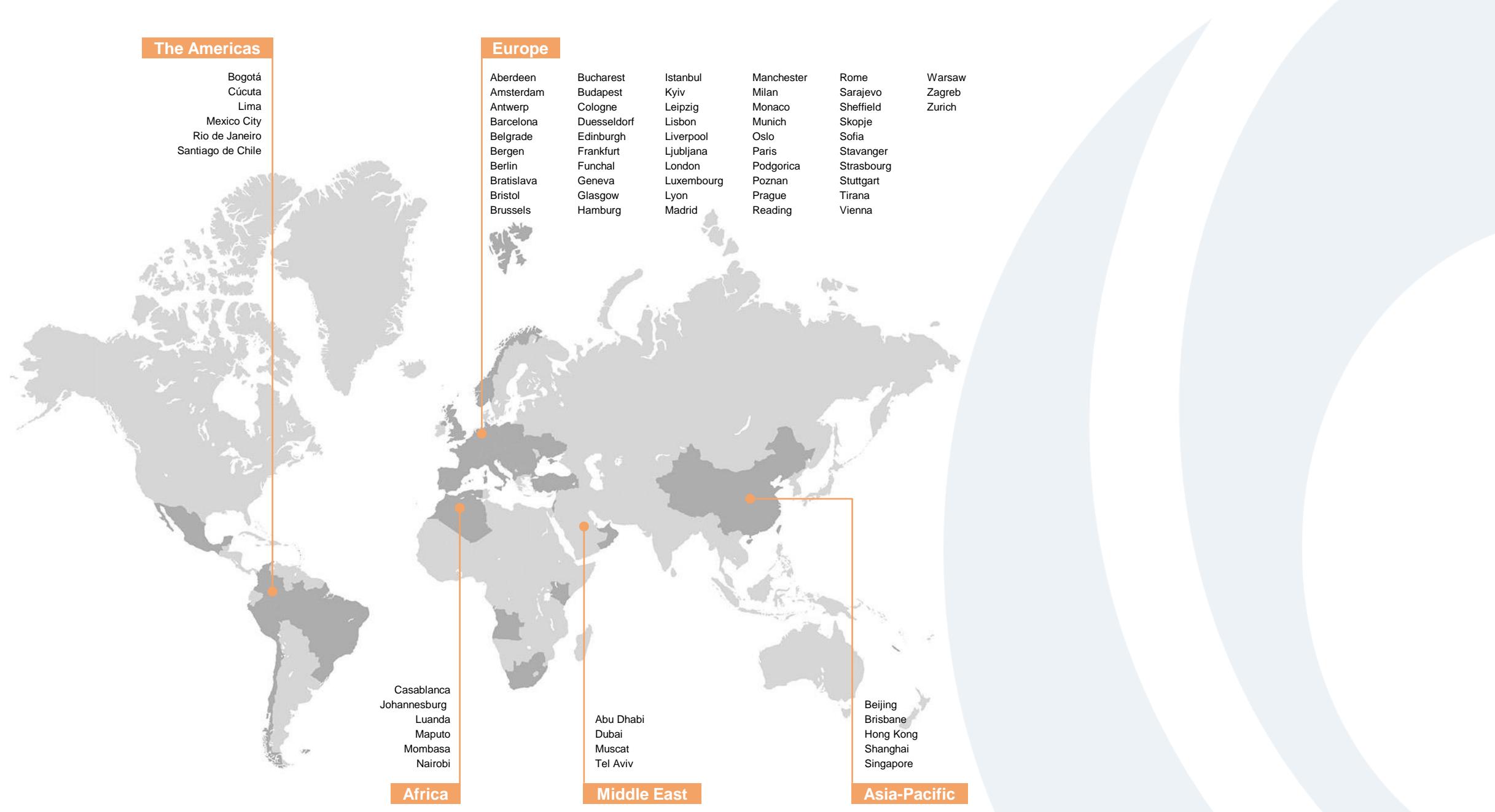
**E** [neeraj.thomas@cms-cmno.com](mailto:neeraj.thomas@cms-cmno.com)

**W** [Web bio](#)



“It is always a flawless experience working with CMS.”

World Trademark Review 2024





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