

Philip R. Zender

Partner

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About Philip

Philip R. Zender is the US practice group leader of the Technology Transactions Group within the firm's Intellectual Property & Technology Practice, where he advises clients on the legal and commercial aspects of technology-driven business models, including emerging issues in artificial intelligence (AI) and machine learning (ML), software-as-a-service (SaaS) and cloud computing, data licensing and other advanced technology transactions.

Philip has more than 30 years of experience counseling clients on intellectual property matters and business, and commercial transactions with a particular emphasis on transactions and legal issues involving intellectual property and technology. He also provides general business and corporate counseling. Philip has extensive experience with a wide variety of technologies and industries, including computer and semiconductor technology, AI and ML, as well as medical devices and pharmaceuticals, biotechnology, internet and e-commerce and media and entertainment.

Philip's transactional experience includes the licensing and commercialization of patents, copyrights, trademarks and trade secrets; intellectual property aspects of M&A transactions and associated ancillary agreements; e-commerce and internet transactions; hosting, cloud computing and SaaS agreements; mobile applications; software licensing and development agreements; open source licenses; outsourcing agreements; distribution agreements; research and technology development arrangements; technology transfers; video game agreements; and licensing of entertainment properties. He has a particular focus on structuring technology transactions in fast-moving areas such as AI, cloud computing and SaaS.

His intellectual property and business counseling experience includes assisting clients with the creation and implementation of strategies for protecting and leveraging their intellectual property assets, including patents, trademarks, copyrights and trade secrets and providing strategic and general advice on business and legal issues that confront companies on a daily basis, including internet domain name disputes, infringement and unfair competition disputes, as well as advertising issues, gray market goods and right of publicity issues. His counseling work increasingly includes advising on AI-related risk, compliance and data protection, in addition to traditional IP and business issues.

Experience

IT/Technology/E-Commerce Transactions

- Assisting an online service provider with the structuring, drafting and negotiation of a white label software-as-a-service (SaaS) offering for its online financial transactions solution, including outsourced help desk, data center management and operations offered by the service provider to the customer. The agreement included custom software development, system operation and hosting services, internal customer-facing help desk services, external end user call center services, and service level agreements covering service availability, system performance, transaction processing, data transfer, problem management, call center reporting and external sales service reporting.
- Assisted cloud-based service provider with the preparation of standard subscription agreements for its enterprise tag management service that enables subscribers to manage tags placed on their websites and to integrate website pages with analytics, testing or marketing partners.
- Advised new media client on all aspects of its interactive online, social media, mobile device e-commerce "gifting" business, including: drafting Service Participation Agreement and negotiating same with business partners; advising on state law issues regarding online, social media promotions and sweepstakes; negotiating Joint Marketing Agreements with business partners; drafting website and Facebook terms of use and privacy policies; drafting end user license agreement for mobile application; and advising on state and federal gift card and escheat laws; advising on applicability of Controlling the Assault of Non-Solicited Pornography and Marketing Act of 2003 (CAN-SPAM) in connection with its product delivery; and advising on the Digital Millennium Copyright Act, including compliance with safe harbor provisions.
- Representing an iPhone application developer in licensing and development transactions.
- Providing advice, negotiation and drafting assistance to a major semiconductor manufacturing materials supplier with the company's development and licensing programs, including patent and know-how license agreements and joint development agreements with the industry's major computer and semiconductor suppliers.
- Assisting a large, well-known high-end computer storage equipment vendor in major OEM and other licensing arrangements with key players and customers in the computer storage industry.
- Providing assistance with the drafting of internet website terms and conditions of use and privacy policies.

Outsourcing

- Assisted a power company with the negotiation and drafting of a major data center outsourcing agreement pursuant to which the outsource service provider provided all data center operations to power company, including operation of servers, software, security and internet traffic at the service provider's data centers, and including help desk and trouble-shooting services.
- Assisting client with the negotiation and drafting of an outsourcing agreement covering the outsourcing of the client's help desk services for its internal computer system. The agreement covered the integration of and transition to the service provider's help desk team for the provision of 24x7x365 help desk coverage from the service provider's facilities, and included service level agreements and metrics for a number of different performance obligations under the agreement.
- Providing advice and assistance to client in the drafting and negotiation of a data center outsourcing agreement pursuant to which our client outsourced its entire data center and computer operations to a third-party service provider, including detailed statements of work and service-level agreements.
- Assisting client with the outsourcing of payroll services to a third-party service provider. The agreement covered the outsourcing of all payment processing and payroll remittance to the service provider.

Trademarks and Branding

- Routinely advise clients regarding domestic and international trademark protection and branding strategies, including assistance with trademark selection and clearance, trademark registration, portfolio planning and management, policing and enforcement.

Life Sciences/Pharmaceuticals

- Assisting a US-based pharmaceutical company with a software license and hosting agreement for a benchmarking and budgeting application for the prediction and management of investigator costs and budgets for clinical trials.
- Assisting a pharmaceutical company with the drafting and negotiation of a patent and know-how license agreement for a patented drug delivery system for the sustained release of drug formulations.
- Assisting a pharmaceutical company with the planning, structuring and negotiating of a variety of in-licenses for a variety of small molecule compounds for use in drug products.
- Assisted medical device company on the out-licensing of its patented polymer material for use in implantable medical devices, with a license back for the manufacture, marketing and sale of medical device designs made from the polymer.
- Assisted multinational pharmaceutical company and its affiliates in the transfer of its US sales force to a major US pharmaceutical company, and the transfer of marketing and sales responsibility for three prescription drugs to the US company through an exclusive distribution and supply agreement, an associated quality agreement and a transition services agreement.
- Negotiation of an in-license agreement from a major US university for a patented pharmaceutical compound.
- Assisted medical device company with the drafting of a distribution and supply agreement for medical devices.
- Provided advice to major medical device company with respect to a Material Transfer Agreement and rights granted under the agreement.
- Advised client on the negotiation of a patent license with a major US university covering patented sensing technology for infectious disease detection and forensics, biomarker identification and validation, pharmacogenetics and proteomics.

Other

- Providing advice regarding the use and display of thumbnail photographs and images as generated results from internet search engine software and copyright issues associated with such use.
- Provided advice on the Digital Millennium Copyright Act and assist clients with safe harbor compliance, including the appointment and registration of copyright agents and the implementation of notice and takedown procedures.
- Assisting an event production company client with the negotiation and drafting of license agreements with major movie studios for the use of movie properties in productions.
- Prepared a television production agreement and other entertainment related agreements for producer of events and television shows.
- Provided advice and assistance with the drafting and negotiation of a merchandising license for the use of company's trademarks on paint products.
- Assisted a toy company with the drafting and negotiation of an option agreement with production company to create a television series based on toy line.

Credentials

Education

- University of California, Hastings, J.D., staff, *Hastings Communications and Entertainment Law Journal*, note editor, *Hastings International and Comparative Law Review*, 1988
- Pomona College, B.A., 1981

Admissions

- California, 1988

Recognitions

- Recommended in *World Trademark Review's* WTR 1000 2025
- Recognized as "Highly Recommended" in USA Trademarks Rankings by *World Intellectual Property Review (WIPR)* 2024-2025
- Named as a Leader by *World Intellectual Property Review (WIPR)* 2022-2025
- Ranked as a notable practitioner in the *World Trademark Review's* WTR1000 in 2017 and 2018
- Ranked as a leading Intellectual Property professional in *World Intellectual Property Review's* 2018 Leaders directory

Expertise

Services

- Intellectual Property & Technology
- Data Privacy, Cybersecurity & Digital Assets

Industries

- Advertising, Media & Brands
- Life Sciences

Publications & Speaking Engagements

Publications

- Author, "Trademarks, Video Games and the First Amendment: Balancing Freedom of Artistic Expression with Trademark Rights," Squire Patton Boggs Intellectual Property Update, May 2009.
- Author, "Whether Paid Keyword Search Advertising Constitutes Trademark Infringement Opens Rifts Among US Courts," Squire Patton Boggs Intellectual Property Update, Spring 2008.

Speaking Engagements

- Presenter, "Interpreting US SEC 2011 Cybersecurity Risk," American Bar Association 2016 Annual Meeting, August 4, 2016.
- Presenter, "The EU General Data Protection Regulation: Preparing For Substantial Changes On The Horizon," presented before the Irish American Bar Association, May 4, 2016.
- Presenter, "Protecting your Brand: How to Clear and Register your Trademark," at the firm's CLE Day for in-house and outside counsel, January 17, 2013.
- Presenter, "Mobile Application Distribution and Licensing," UK Trade & Investment delegation, June 18, 2012.

- Presenter, "Trademarks 101: What You Need to Know About Trademark Prosecution," Bar Association of San Francisco, 2010.
- Presenter, "Intellectual Property Issues Between Joint Venture Parties," University of California, Davis for Petróleo Brasileiro S.A., October 24, 2008.
- Presenter, "Key Issues in International Licensing: Perspectives from Around the Globe," Association of Corporate Counsel, San Francisco Bay Area Chapter, September 22, 2008.
- Presenter, "Protecting Your Brand," CEA Industry Forum, October 2007.
- Presenter, "Intellectual Property Issues in Corporate Transactions," Bay Area General Counsel Group, August 2006.
- Presenter, "Advertising on the Internet: What Every Lawyer Should Know," in connection with Continuing Education of the Bar, California.

About our firm

One of the world's strongest integrated law firms, providing insight at the point where law, business and government meet. We deliver commercially focused business solutions by combining our legal, lobbying and political capabilities and invaluable connections on the ground to a diverse mix of clients, from long-established leading corporations to emerging businesses, startup visionaries and sovereign nations. More than 1,500 lawyers in over 40 offices across four continents provide unrivaled access to expertise.