



Samantha C. Kernahan

Associate Counsel

samantha.kernahan@dlapiper.com

Edmonton

T: +1 780 429 6806

F: +1 780 670 4331

Calgary

T: +1 403 776 8826

Samantha Kernahan combines seasoned expertise in intellectual property law and corporate/commercial law to provide her clients with multi-faceted advice.

Samantha has extensive experience in the protection and commercialization of intellectual property and information technology procurement. She regularly advises clients on intellectual property licensing programs, enterprise software acquisition, data management and infringement actions arising from copyright and trademark assets.

Samantha's practice further encompasses information technology service agreements, cloud-computing contracts, e-commerce implementation and compliance, data security and privacy, brand management strategy, compliance with anti-spam legislation, post-secondary technology transfer, domain names, trade secrets and contest compliance.

Samantha also maintains a broad corporate/commercial practice where she advises clients on a wide range of business law matters, including incorporations, franchise agreements and compliance, mergers and acquisitions, corporate organizations and restructurings, secured lending, corporate governance and risk management, public procurement (supply chain management) as well as commercial leasing and commercial real estate transactions.

LANGUAGES SPOKEN

- English

EXPERIENCE

Procurement of information technology services and software

- Drafted custom Learning Management System ("LMS") Development and Management Agreement in support of new hosted solution business model. Client (private clearinghouse for training, certification and records management for industrial work forces) and software vendor partnered to move the delivery of client's core services online with shared management responsibilities. Further drafted cross licenses, software escrow and service level agreements in support of new business model.
- Represented a number of Alberta's large residential property management companies in negotiations with MRI Software, LLC

RELATED SERVICES

- Intellectual Property and Technology
- Technology Transactions and Strategic Sourcing
- Corporate

LANGUAGES SPOKEN

English

(leading vendor of enterprise software solutions for the property management market). Majority of matters have been for MRI's hosted (SaaS) services but have also negotiated for MRI's licensed software and professional services in support of same.

- Represented post-secondary institution in negotiations with IBM/Oracle for Enterprise Resource Planning ("ERP") platform delivery and implementation.
- Represented association of medical professionals in negotiation and drafting of agreement with software vendor to deliver and host secure messaging service.
- Delivered series of webinars on procurement of information technology services.

Technology consulting & commercialization

- Represented client who invested in technology development, manufacture and distribution in and from Brasov, Romania. Leading academic in field of specific industrial application had retired to home country of Romania. Worked with Romanian legal counsel to incorporate wholly-owned Romanian subsidiary which in turn secured academic's expertise to oversee design and manufacture of specialized equipment. Location qualified for European Union investment incentives. Matter included Exclusive License and Distribution Agreements for European Union and North America.
- Regularly advise clients on technology transfer and sponsored research issues involving post-secondary research institutions. Draft agreements and facilitate incorporations to support same.
- Currently advising a client who holds exclusive license rights from technology owner in Spain to establish legal structure for non-exclusive downline licenses for marketing and distribution in North America.

Copyright, Trade-marks, domain names and anti-spam compliance

- Advised post-secondary institutions within "opt-out" group of institutions against position of Access Copyright in regulatory matter regarding tariff for post-secondary use of copyright materials.
- Advised post-secondary institutions on scope of fair dealing in Canada following changes to *Copyright Act* and Supreme Court of Canada 'copyright penology'.
- Advised on and drafted submissions for both Applicant and Opponent in various trade-mark opposition proceedings.
- Advised on and drafted submissions to commercial arbitration body with jurisdiction over .CA domain name disputes.
- Advised range of clients on compliance issues following enactment of Canada's Anti-Spam Law ("CASL") in 2014.

Corporate acquisitions and secured finance

- Recently acted for client in share sale (\$11 Million purchase price) within waste management and recycling industry.
- Recently acted for client who secured private equity to finance construction of research and manufacturing facility for industrial chemicals.
- Advised and acted for various clients who assumed debt financing to further technology commercialization.

Public procurement

- Advised and acted for incumbent provider of services to Alberta government ministry who challenged government's award of the most recent RFP by judicial review.
- Co-lead on project to advise Alberta government ministry on Qualification Based Selection under applicable procurement rules and agreements.
- Acted as legal counsel to association charged with promotion of indigenous businesses within context of northern territorial procurement of goods and services.

Governance and compliance

- Recently advised professional sports league on privacy compliance and general online issues following team expansion into Canada.
- Advise and act for Alberta Charter Schools subject to the *School Act* with respect to legislative and common law compliance in the course of school operations.

CREDENTIALS

Admissions

- Alberta, 2001

Professional Qualifications

- Registered Canadian Trademark Agent

Education

- LL.B., University of Sydney, 1999
- B.A. (Honours), University of Alberta, 1996

Memberships

- Member, Canadian Bar Association
- Member, Law Society of Alberta
- Member, Intellectual Property Institute of Canada

Community Involvement

- Member, Women on Boards Committee, 2015 - present
- Member, Women's Legal Forum, 2013 - present
- Co-Chair, Alberta Health Services Patient Family Advisory Group, 2011–2012
- Public Member (Interim), Health Quality Council of Alberta Patient/Family Safety Advisory Panel, 2011
- Past President and Volunteer, Suit Yourself: The Edmonton Wardrobe for Women in Need Association, 2005 - present

INSIGHTS

Events

SPEAKING ENGAGEMENTS

- Presenter, "10 Simple Rules to Protect Your Intellectual Property: Do's and Don'ts for Business Leaders," Female Tech Founders, Funders and Fortifiers Breakfast series, Alberta Innovates, October 16, 2019.

NEWS

DLA Piper Canada significantly expands Startups, Emerging Companies and Technology practice

16 MAR 2020

With the addition of six new lawyers to our Vancouver office since the beginning of 2020, DLA Piper Canada has significantly expanded upon its capabilities in the Startups, Emerging Companies and Technology practice.
