

EXHIBIT 11

From: [Li, Yan-Xin](#)
To: [Afinogenova, Alina](#); [Sheh, Anthony](#); [Haunschild, Philip](#); [McLennan, Mark C.](#)
CC: [#KEModernaSpikevaxService](#); [Horstman, N. Kaye](#); "Arbutus MoFo"; [Parrado, Alvaro](#); [Elenberg, Falcia](#); [Komis, Jihad](#); [Genevant Team](#); [Berl, David](#); [Mahaffy, Shaun](#); [Harber, Adam](#); [Fletcher, Thomas](#); [Ryen, Jessica](#); ["NTan@mofo.com"](#); [Bolte, Erik](#); [*jshaw@shawkeller.com](#); ["kkeller@shawkeller.com"](#); ["nhoeschen@shawkeller.com"](#); ["EWiener@mofo.com"](#); ["began@mnat.com"](#); ["tmurray@morrisonichols.com"](#); ["jblumenfeld@morrisonichols.com"](#); [Hurst, James F.](#); [Carson, Patricia A.](#); [Wacker, Jeanna](#)
Subject: RE: Arbutus v. Moderna, 1-22-cv-00252 - Letter to Counsel (Batch Information) - HIGHLY CONFIDENTIAL OCEO
Date: Thursday, December 7, 2023 9:51:49 PM

Tony and Philip:

Further to your email of November 15 and the parties' meet and confer on November 17, we understand that Plaintiffs are seeking production of Moderna's contracts associated with batches manufactured outside the United States ("OUS") and sold to customers OUS. Plaintiffs proposed that Moderna produce these documents first for Plaintiffs to assess whether additional information about the OUS batches should be produced (e.g., COAs).

Plaintiffs appear to suggest that Moderna's OUS batches are a "sale" within the ambit of 35 U.S.C. § 271(a). We disagree. As the *Cal. Inst. of Tech. v. Broadcom Ltd.* court noted, there is no dispute that § 271(a) "appl[ies] only domestically," and the issue is whether "the relevant transactions [] were domestic or extraterritorial in nature." *Cal. Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 992 (Fed. Cir. 2022). Yet as your November 15 email concedes, OUS batches are manufactured OUS and sold to customers OUS—i.e., extraterritorial in nature. See 11/15/2023 P. Haunschild Email ("certain batches were simply manufactured abroad"). Plaintiffs have not identified any relevance or basis for seeking discovery of extraterritorial sales or activities. And indeed, the *Broadcom* court further noted that "the key question" is "whether there were such **substantial activities** in the United States," which there are not for Moderna's OUS batches. See *Broadcom*, 25 F.4th at 993 (discussing *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 831 F.3d 1369 (Fed. Cir. 2016), including how pricing and contracting negotiations in the United States alone **do not** constitute or transform those extraterritorial activities into a sale under § 271(a) (emphasis added)). In addition, the Federal Circuit noted that the place of signing a contract is only one of many factors to consider in determining the location of a "sale" under § 271(a). See *Carnegie Mellon Univ. v. Marvell Tech. Grp., Ltd.*, 807 F.3d 1283, 1309 (Fed. Cir. 2015). To hold otherwise would effectively extend the scope of § 271(a) to "confer a worldwide exclusive right to a U.S. patent holder, which is contrary to the statute and case law." *Halo*, 831 F.3d at 1379.

Batches that were manufactured OUS and sold to customers OUS are therefore beyond the scope of Plaintiffs' accusations of infringement. This is not because of "Moderna's own self-serving analysis," but rather precedential case law on this issue, including cases Plaintiffs identified. Moderna will not permit an unduly burdensome fishing expedition by Plaintiffs into its extraterritorial business.

Best regards,
 Yan-Xin

Yan-Xin Li

KIRKLAND & ELLIS LLP
 555 California Street, San Francisco, CA 94104
 T +1 415 439 1618
 F +1 415 439 1500

yanxin.li@kirkland.com

From: Afinogenova, Alina <alina.afinogenova@kirkland.com>
Sent: Tuesday, December 5, 2023 6:48 PM
To: Sheh, Anthony <ASheh@wc.com>; Haunschild, Philip <phaunschild@wc.com>; McLennan, Mark

C. <mark.mclennan@kirkland.com>

Cc: #KEModernaSpikevaxService <KEModernaSpikevaxService@kirkland.com>; Li, Yan-Xin <yanxin.li@kirkland.com>; Horstman, N. Kaye <kaye.horstman@kirkland.com>; 'Arbutus_MoFo' <Arbutus_MoFo@mofo.com>; Parrado, Alvaro <alvaro.parrado@kirkland.com>; Elenberg, Falcia <felenberg@wc.com>; Komis, Jihad <JKomis@wc.com>; Genevant Team <GenevantTeam@wc.com>; Berl, David <DBerl@wc.com>; Mahaffy, Shaun <SMahaffy@wc.com>; Harber, Adam <AHarber@wc.com>; Fletcher, Thomas <TFletcher@wc.com>; Ryen, Jessica <JRyen@wc.com>; 'NTan@mofo.com' <NTan@mofo.com>; Bolte, Erik <ebolte@wc.com>; *jshaw@shawkeller.com <jshaw@shawkeller.com>; 'kkeller@shawkeller.com' <kkeller@shawkeller.com>; 'nhoeschen@shawkeller.com' <nhoeschen@shawkeller.com>; 'EWiener@mofo.com' <EWiener@mofo.com>; 'began@mnat.com' <began@mnat.com>; 'tmurray@morrisonichols.com' <tmurray@morrisonichols.com>; 'jblumenfeld@morrisonichols.com' <jblumenfeld@morrisonichols.com>; Hurst, James F. <james.hurst@kirkland.com>; Carson, Patricia A. <patricia.carson@kirkland.com>; Wacker, Jeanna <jeanna.wacker@kirkland.com>
Subject: RE: Arbutus v. Moderna, 1-22-cv-00252 - Letter to Counsel (Batch Information) - HIGHLY CONFIDENTIAL OCEO

Tony,

In follow-up to our November 10 email relating to the production of samples from 400+ lots of expired drug product, we are continuing to work through the burdensome exercise of setting up the logistics to make said production, which we now expect to be in a position to do in January. We will provide an update with additional information as soon as we are able.

Regards,
Alina

Alina Afinogenova

KIRKLAND & ELLIS LLP

200 Clarendon Street, Boston, MA 02116

T +1 617 385 7526 **M** +1 917 324 5094

F +1 212 446 4900

alina.afinogenova@kirkland.com

From: Sheh, Anthony <ASheh@wc.com>

Sent: Wednesday, November 29, 2023 6:16 PM

To: Afinogenova, Alina <alina.afinogenova@kirkland.com>; Haunschild, Philip <phaunschild@wc.com>; McLennan, Mark C. <mark.mclennan@kirkland.com>

Cc: #KEModernaSpikevaxService <KEModernaSpikevaxService@kirkland.com>; Li, Yan-Xin <yanxin.li@kirkland.com>; Horstman, N. Kaye <kaye.horstman@kirkland.com>; 'Arbutus_MoFo' <Arbutus_MoFo@mofo.com>; Parrado, Alvaro <alvaro.parrado@kirkland.com>; Elenberg, Falcia <felenberg@wc.com>; Komis, Jihad <JKomis@wc.com>; Genevant Team <GenevantTeam@wc.com>; Berl, David <DBerl@wc.com>; Mahaffy, Shaun <SMahaffy@wc.com>;

Harber, Adam <AHarber@wc.com>; Fletcher, Thomas <TFletcher@wc.com>; Ryen, Jessica <JRyen@wc.com>; 'NTan@mofo.com' <NTan@mofo.com>; Bolte, Erik <ebolte@wc.com>; *jshaw@shawkeller.com <jshaw@shawkeller.com>; 'kkeller@shawkeller.com' <kkeller@shawkeller.com>; 'nhoeschen@shawkeller.com' <nhoeschen@shawkeller.com>; 'EWiener@mofo.com' <EWiener@mofo.com>; 'began@mnat.com' <began@mnat.com>; 'tmurray@morrisonichols.com' <tmurray@morrisonichols.com>; 'jblumenfeld@morrisonichols.com' <jblumenfeld@morrisonichols.com>; Hurst, James F. <james.hurst@kirkland.com>; Carson, Patricia A. <patricia.carson@kirkland.com>; Wacker, Jeanna <jeanna.wacker@kirkland.com>
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Mark,

Could you please let us know if Moderna has an update regarding our questions on sample shipping and storage? If there additional arrangements that need to be made, we'd like to start putting them in place. Thanks.

Best,
Tony

Anthony Sheh | Associate | Williams & Connolly LLP | (202) 434-5436 | [ycard](#)

From: Sheh, Anthony <ASheh@wc.com>
Sent: Monday, November 20, 2023 6:06 PM
To: Afinogenova, Alina <alina.afinogenova@kirkland.com>; Haunschild, Philip <phaunschild@wc.com>; McLennan, Mark C. <mark.mclennan@kirkland.com>
Cc: #KEModernaSpikevaxService <KEModernaSpikevaxService@kirkland.com>; Li, Yan-Xin <yanxin.li@kirkland.com>; Horstman, N. Kaye <kaye.horstman@kirkland.com>; 'Arbutus_MoFo' <Arbutus_MoFo@mofo.com>; Parrado, Alvaro <alvaro.parrado@kirkland.com>; Elenberg, Falcia <felenberg@wc.com>; Komis, Jihad <JKomis@wc.com>; Genevant Team <GenevantTeam@wc.com>; Berl, David <DBerl@wc.com>; Mahaffy, Shaun <SMahaffy@wc.com>; Harber, Adam <AHarber@wc.com>; Fletcher, Thomas <TFletcher@wc.com>; Ryen, Jessica <JRyen@wc.com>; 'NTan@mofo.com' <NTan@mofo.com>; Bolte, Erik <ebolte@wc.com>; *jshaw@shawkeller.com <jshaw@shawkeller.com>; 'kkeller@shawkeller.com' <kkeller@shawkeller.com>; 'nhoeschen@shawkeller.com' <nhoeschen@shawkeller.com>; 'EWiener@mofo.com' <EWiener@mofo.com>; 'began@mnat.com' <began@mnat.com>; 'tmurray@morrisonichols.com' <tmurray@morrisonichols.com>; 'jblumenfeld@morrisonichols.com' <jblumenfeld@morrisonichols.com>; Hurst, James F. <james.hurst@kirkland.com>; Carson, Patricia A. <patricia.carson@kirkland.com>; Wacker, Jeanna <jeanna.wacker@kirkland.com>
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Mark and Alina,

Further to Moderna's November 10 email and the meet-and-confer on November 17, Plaintiffs

understand that Moderna's production of the ~480 batches/lots referenced below does not resolve the parties' dispute as to the remaining batches, but we appreciate Moderna's efforts to narrow the scope of the parties' dispute. We understand that the ~480 batches Moderna is agreeing to produce are being transferred by a third-party to another location. We also understand that Moderna is not withholding samples as to post-complaint batches. We understand that Moderna is looking into whether there are post-complaint batches that are due to imminently expire and that the parties' should have ample time before expiry to address samples from Moderna's ongoing booster production.

Plaintiffs are willing to consider covering the cost for Moderna to ship the samples and/or for a courier. As discussed, please let us know an estimate of the shipping costs. Additionally, we'd appreciate information regarding storage conditions and the capacity needed to store the samples. Assuming that the conditions are as before [REDACTED] Plaintiffs currently have 90% capacity left in a 19.4 cubic feet (549 L) freezer with interior dimensions of 51.2 in x 23.1 in x 28.3 (H x W x D, 130.1 cm x 58.8 cm x 97.37 cm) and will acquire additional space if needed. The shipping address would be:

Triclinic Labs, Inc.
Attn: Sample Submission
2660 Schuyler Ave. Ste. A.
Lafayette, IN 47905

Plaintiffs understand that Moderna considers batches that were not manufactured or imported into the U.S. to be batches "not accused of infringement." As outlined in previous correspondence, Plaintiffs disagree that such batches are not accused. *See, e.g., E.g.*, D.I. 1 ¶¶ 50–54, 70, 89, 108, 130, 154. Plaintiffs understand that Moderna is investigating the scope of documents it is willing to produce concerning these batches, including its agreements with the relevant third-parties for sales of such batches (besides the U.S. Government, and whether located in the United States or abroad, and whether to a public or private entity), its communications with such third-parties concerning sales or offers to sell batches of the Accused Product, documents evidencing the location and timing of any negotiations or meetings regarding such sales, and Moderna's marketing and strategic plans regarding such sales. Such documents are responsive to at least Plaintiffs' RFPs 51, 53, 60, 64, 69, 74, 75, 81, and 83. Please confirm the scope of documents that Moderna will agree to produce by December 1, 2023.

Best,
Tony

Anthony Sheh | Associate | Williams & Connolly LLP | (202) 434-5436 | [vcard](#)

From: Afinogenova, Alina <alina.afinogenova@kirkland.com>

Sent: Thursday, November 16, 2023 11:07 AM

To: Haunschild, Philip <phaunschild@wc.com>; McLennan, Mark C.

<mark.mclennan@kirkland.com>; Sheh, Anthony <ASheh@wc.com>

Cc: #KEModernaSpikevaxService <KEModernaSpikevaxService@kirkland.com>; Li, Yan-Xin

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