

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

ARBUTUS BIOPHARMA CORPORATION )  
and GENEVANT SCIENCES GmbH, )  
 )  
Plaintiffs, )  
 )  
v. ) C.A. No. 22-252-MSG  
 )  
MODERNA, INC. and MODERNATX, INC., ) **HIGHLY CONFIDENTIAL –**  
 ) **OUTSIDE COUNSEL’S EYES ONLY -**  
Defendants. ) **FILED UNDER SEAL**

**LETTER BRIEF TO THE HONORABLE MITCHELL S. GOLDBERG REGARDING  
PLAINTIFFS’ MOTION TO COMPEL**

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Dated: April 23, 2024

Dear Judge Goldberg:

Plaintiffs return to the Court to renew their motion for a targeted search of Moderna CEO Stéphane Bancel’s documents. D.I. 133. The Court previously denied Plaintiffs’ motion without prejudice to re-raise the request if Moderna’s subsequent document production indicated there was a need for information from Bancel that was not “redundant.” D.I. 142 at 6:23-8:5. Moderna’s production has confirmed that Bancel is a key source of significant relevant information that is not redundant of other discovery. Bancel was directly—and uniquely—involved in some of the most important areas of this case. Nevertheless, Moderna has refused to negotiate over *any* search of Bancel’s documents, despite Plaintiffs’ good-faith proposal of a narrow, targeted set of search terms for Bancel. Ex. A, April 8, 2024 Genevant Proposal.

**Plaintiffs are entitled to a reasonable search of Bancel’s documents.** Courts routinely approve requests seeking documents from senior executives where those executives were directly involved in the disputed issues and are thus “likely to possess unique, relevant information.” *E.g., In re Facebook, Inc. Consumer Priv. User Profile Litig.*, 2021 WL 10282213, at \*2 (N.D. Cal. Nov. 14, 2021). Here, the evidence obtained in discovery shows that Bancel had unique involvement in a series of relevant issues, demonstrating that far from being redundant, Bancel is the *only* source for critical information. That distinguishes this case from the authority Moderna previously cited, D.I. 134, which provided only cases where the CEO was either uninvolved or had no unique involvement.

**Bancel was directly and uniquely involved in Government negotiations relevant to damages.** Moderna’s document production has confirmed, consistent with public reports, that Bancel has unique, first-hand knowledge of Moderna’s negotiations with the U.S. Government. Bancel was in direct communication with several senior Government officials about the Government’s partnership with Moderna, including with respect to contractual and funding issues, throughout 2020.

These direct communications began at the outset of the pandemic, when Bancel testified that he personally “immediately reached out to the U.S. Government” in December 2019 about the Wuhan outbreak. Ex. B, U.S. Senate Hr’g Tr. 21:22–22:4 (Mar. 22, 2023). From the limited discovery available to Plaintiffs, there are repeated references Bancel’s regular, one-on-one communication with Government officials throughout 2020. For example, in February 2020, Bancel forwarded an email from [REDACTED]

[REDACTED] Ex. C. In May, Bancel asked colleagues for [REDACTED]

[REDACTED] Ex. D. A June email produced by the Government includes an from an NIH official referencing [REDACTED]

[REDACTED] Ex. E. In July, a Moderna email shows [REDACTED]

[REDACTED] Ex. F. These documents provide insight into Bancel’s role in Government negotiations, but they do not disclose the content of his communications with the Government—that would require a search of Bancel’s documents.

Bancel testified under oath to his involvement in Government pricing negotiations, telling Congress “in the letter I wrote to the Government, when we started discussing about procuring the vaccine in September of 2020, we proposed a discount.” Ex. B, Tr. 54:5-8. Bancel also testified to discussing vaccine pricing with Moderna’s Board. Ex. B, Tr. 82:12–83:12 (“[W]e started to discuss with the Government toward the end of the summer 2020 about purchasing vaccine . . . [and] we started to discuss with our Board. And it became very clear, like, a five-minute discussion at a Board meeting, that we had to find a way to give the money back to the U.S. Government.”).

Moderna’s negotiations with the Government are important evidence concerning *e.g.*, damages.<sup>1</sup> The Government’s willingness to pay Moderna enormous sums, along with pressure from the Government to produce the vaccine quickly, would have been significant considerations in the hypothetical negotiation. And Bancel was directly involved in at least these issues: the price the Government would pay, Ex. B, Tr. 54:5-8, and “timelines” for manufacturing the vaccine, Ex. C.

Although Moderna has produced thousands of documents about its interactions with the U.S. Government in 2020 through lower-level custodians, there are strikingly few documents addressing these key aspects of the negotiations. Indeed, Moderna has not even produced the letter Bancel told Congress about. Given his direct communications with the Government, Bancel’s documents are essential to understanding the full picture of Moderna’s negotiations.

**Bancel was directly and uniquely involved in Moderna’s effort to license the patented technology.** Genevant’s own documents show that Bancel led Moderna’s repeated efforts to license Plaintiffs’ technology. As early as October 2013, Bancel discussed the possibility of a collaboration with Ian MacLachlan, Arbutus-predecessor Tekmira’s Chief Scientific Officer. Ex. G at 7. Bancel then engaged in a series of one-on-one communications with Mark Murray (CEO of Tekmira) as early as 2014, in which he shared proposals and discussed the structure of a potential deal. *E.g.*, Exs. H–J.

The direct involvement of Moderna’s CEO in its attempt to procure the very intellectual property at issue in this suit goes directly to Moderna’s willfulness. It shows that at the highest level, Moderna was familiar with Plaintiffs’ intellectual property, ultimately chose not to license it, and instead simply took it. Moderna’s failure to produce many of its communications with Plaintiffs about a license to the patented technology is remarkable. While Plaintiffs obviously have copies of their actual communications with Bancel, his corresponding internal communications—which would reveal Moderna’s thinking about Plaintiffs, their technology, and its value—are missing.

**Bancel was directly and uniquely involved in Moderna’s negotiations with other licensing counter-parties.** Moderna’s communications with counter-parties to its executed license agreements are relevant to damages, including the comparability of Moderna’s other patent licenses to the license that would result from a hypothetical negotiation. Some of these negotiations also go to Moderna’s willfulness, such as its negotiations with Acuitas, which tried to sublicense Plaintiffs’ technology to Moderna. Despite the importance of these communications, Plaintiffs have failed to produce many of the communications that led up to

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<sup>1</sup> Moderna also directly put its relationship with the Government at issue with its § 1498 defense.

these licenses. Bancel's direct involvement in these licensing negotiations makes it clear that a search of his emails is necessary.

For example, one of the few documents Moderna has produced from the Acuitas negotiations shows that Bancel was personally involved—a February 2014 meeting agenda disclosing a one-on-one meeting with Acuitas CEO (and former Tekmira employee) Tom Madden and Bancel's participation in a lengthy meeting about Acuitas's capabilities. Whether or not Bancel was involved in every meeting with Acuitas, the agenda shows unique engagement without any other Moderna employees.

Without a search of Bancel's emails, it is impossible to identify all of the license negotiations in which he personally participated. But Plaintiffs have reason to believe Bancel personally engaged in discussions with licensing partners. *E.g.*, Ex. K (reflecting Bancel's one-on-one meeting with potential licensor's CEO and a subsequent follow up meeting).<sup>2</sup> And Bancel personally signed many of the license agreements Moderna contends are relevant. *See, e.g.*, Exs. L–Q (agreements with Acuitas, Alexion, AstraZeneca, Chiesi, Merck, and Vertex).

**The Court should order a targeted search of Bancel's documents.** The evidence of Bancel's involvement in these key areas means a targeted search of his documents is more than proportional. Indeed, Moderna has never provided any specificity around its generalized burden claims, or any search term hit report. The volume of other discovery Moderna produced in the case does not excuse address the need for the requested documents. Even after that Moderna's production, critical gaps remain in areas of Bancel's unique purview. Moderna also has relied on the Delaware Standard's presumptive default of 10 custodians, but that limit is not absolute. Ex. R, Oral Order D.I. 247, *United States v. Gilead Sciences, Inc.*, No. 19-CV-2103 (D. Del. December 21, 2021) (granting limited search of 11th custodian); *Frontier Commc'ns Corp. v. Google Inc.*, 2014 WL 12606321, at \*3-4 (D. Del. Feb. 3, 2014). Based on principles of proportionality, there is no reason that default should apply in a multi-billion-dollar patent litigation involving Moderna's sole product the same way it applies in a \$75,000 contract dispute. Plaintiffs have proposed targeted search terms that would impose little burden (particularly if Moderna's contentions about Bancel's involvement are true). *See* Ex. A.

Nor can Moderna rely on Bancel's position as CEO to avoid document discovery. The apex doctrine affecting depositions "is not a protective shield that prohibits document discovery from high-ranking officials." *L.A. All. v. City of Los Angeles*, 2023 WL 5505037, at \*5–6 (C.D. Cal. Aug. 2, 2023) (collecting cases). An additional document production does not impose a significant burden, nor is that burden heightened because the custodian is a CEO. *Dyson, Inc. v. Sharkninja Operating LLC*, 2016 WL 1613489, at \*2 (N.D. Ill. Apr. 22, 2016). Indeed, Plaintiffs have produced documents from *three* of current or former CEOs of Plaintiffs or their related entities, and Moderna will be deposing all three. Plaintiffs respectfully ask the Court to order Moderna to conduct these targeted searches and produce Bancel's documents within three weeks of the order.

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<sup>2</sup> This communication involves a potential license, but evidences Bancel's involvement in executed licenses as well. Plaintiffs proposed search terms only for executed licenses.

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