

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

NORTHWESTERN UNIVERSITY,	)	
	)	
Plaintiff,	)	C.A. No. 24-1151-JCB-EGT
	)	
v.	)	<b>Jury Trial Demanded</b>
	)	
MODERNA, INC., MODERNATX, INC.,	)	
AND MODERNA US, INC.,	)	
	)	
Defendants.	)	

**NORTHWESTERN UNIVERSITY’S OPENING BRIEF IN SUPPORT OF ITS  
MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS**

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## **I. NATURE AND STAGE OF THE PROCEEDINGS**

Northwestern filed this patent infringement lawsuit on October 16, 2024. The Court denied Moderna's motion to dismiss except as to two theories of infringement. Moderna answered, and Northwestern moved to strike five of Moderna's affirmative defenses. Moderna responded by amending its answer. Northwestern then moved to dismiss or strike two counterclaims and four affirmative defenses in the amended answer and answered Moderna's counterclaims. Northwestern's motion is pending. *See* D.I. 38, 39. The pleadings are closed and fact discovery has begun. Northwestern now moves under Rule 12(c) for partial judgment on Moderna's 28 U.S.C. § 1498(a) defense (thirteenth defense) and counterclaim (Count VIII).

## **II. SUMMARY OF THE ARGUMENT**

In 1918, Congress enacted 28 U.S.C. § 1498(a) and waived sovereign immunity for patent owners to sue the United States in the Court of Federal Claims when their patented invention was "used or manufactured by or for the United States." When a government contractor (rather than the United States itself) infringes a patent, Congress waived immunity and shifted liability to the United States only when the contractor's conduct is "for the Government and with the authorization or consent of the Government." 28 U.S.C. § 1498(a). In that situation, the contractor's infringement "shall be construed as use or manufacture for the United States," *id.*, because it is "clothed with the authority of the eminent domain power" of the United States, *Decca Ltd. v. United States*, 640 F.2d 1156, 1167 (Ct. Cl. 1980).

Moderna invokes § 1498(a) in this case, alleging that the statute immunizes Moderna from liability for infringing Northwestern's patents in manufacturing and selling over 500 million doses of its COVID-19 vaccine, Spikevax. Those vaccines were manufactured and supplied under government contracts but only a small number of those doses went directly to the government. The

rest went to the American public. Of course, Northwestern does not seek damages for the doses that went directly to government employees. Section 1498(a) covers those.

But Moderna alleges that Northwestern's patent infringement claims based on *all* 500 million doses are barred under § 1498(a) and that Northwestern's only recourse is against the United States in the Court of Federal Claims. Moderna cannot carry its burden to show that the doses that went to the American public were "for the Government." 28 U.S.C. § 1498(a); *see Arbutus Biopharma Corp. v. Moderna, Inc.*, No. 1:22-cv-00252-JDW, 2026 WL 266389, at \*5 (D. Del. Feb. 2, 2026) (burden is on the defendant invoking § 1498(a) to show "that each of the two prongs of Section 1498(a) is met"). Another court in this district already rejected Moderna's defense on identical facts. This Court should do the same, for either of two reasons.

First, Moderna is collaterally estopped from relitigating its § 1498(a) defense. In *Arbutus*, the Court held that § 1498(a) does not bar direct infringement claims against Moderna for "vaccine doses that went to the general public" or indirect infringement claims for any doses under Moderna's government contracts. 2026 WL 266389, at \*6, \*13. The court then entered partial judgment against Moderna on that defense. Because the identical issue was fully litigated and decided against Moderna in *Arbutus*, Moderna cannot relitigate it here.

Second, even if Moderna were not estopped, its defense fails on the merits. The text, context, and history of § 1498(a) confirm that the statute's waiver of immunity only reaches a contractor's conduct when the government itself is the intended recipient or beneficiary. The government was not the intended recipient or beneficiary of the vaccine doses that went to the American public. The American people were. Nor does § 1498(a) bar Northwestern's indirect infringement claims. "Section 1498 expressly waives the Government's sovereign immunity only with respect to governmental direct infringement of a patent." *Decca*, 640 F.2d at 1169.

Liability for Moderna’s infringement of Northwestern’s patents lies with Moderna, not the United States. The Court should enter judgment on Moderna’s § 1498(a) defense and counterclaim in favor of Northwestern.

### III. STATEMENT OF THE FACTS

Northwestern has accused Moderna’s lipid nanoparticle platform in its mRNA vaccines—Spikevax (COVID-19), mNEXSPIKE (COVID-19), and mRESVIA (RSV)—of infringing Northwestern’s patents on lipid nanoparticles. Northwestern asserts claims for direct and indirect infringement of three patents (the ’686, ’155, and ’026 patents).<sup>1</sup> D.I. 1 at 33–35 (¶¶ 123–27), 37–39 (¶¶ 136–41), 40–43 (¶¶ 149–55).

#### A. Moderna’s Section 1498(a) Defense

Following the United States’ declaration that the Coronavirus outbreak was “a public health emergency, Moderna entered into numerous agreements with the U.S. Government regarding” its Spikevax vaccine.<sup>2</sup> D.I. 36 at 8 (¶ 21). Those agreements included a grant agreement “to support clinical development of the mRNA-1273 vaccine” (i.e., Spikevax) and “a series of advance purchase and supply agreements with the U.S. Government for” doses of Spikevax. *Id.* at 8–9 (¶¶ 21–22). One of those purchase and supply agreements was Contract No. W911QY20C0100 (the “C0100 Contract”). *Id.* at 8–9 (¶ 22). The C0100 Contract describes the scope of work as manufacturing “vaccine doses in support of the national emergency response to the Coronavirus Disease 2019 (COVID-19) for the *United States Government* (USG) and the *US population*.” D.I. 36-1 at 146 (Section C.1) (emphases added).

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<sup>1</sup> The Court dismissed Northwestern’s allegations that Moderna infringes the ’155 patent (referred to as “the method patent” in the Court’s decision) under 35 U.S.C. § 271(f). D.I. 24 at 3. The Court also dismissed two of Northwestern’s direct infringement theories for the ’155 patent, *id.* at 3, but did not dismiss Northwestern’s third theory that Moderna directly infringes the ’155 patent’s method when it tests the Accused Products, *id.* at 2 (citing D.I. 1 at 33 (¶ 124)).

<sup>2</sup> For purposes of this motion only, Northwestern accepts Moderna’s allegations as true.

Moderna raises an affirmative defense (thirteenth defense)<sup>3</sup> and counterclaim (Count VIII) based on the C0100 Contract and 28 U.S.C. § 1498(a). For its affirmative defense, Moderna alleges that “Northwestern’s claims based on Moderna’s manufacture and sale of COVID-19 vaccine (i.e., SPIKEVAX®) pursuant to the C0100 Contract are barred by 28 U.S.C. § 1498(a)” because Moderna’s manufacture and sale “was and continues to be for the benefit of the U.S. Government and with the U.S. Government’s authorization and consent.”<sup>4</sup> D.I. 36 at 84–85 (¶ 24). One way that Moderna alleges it “supplied COVID-19 vaccines to the U.S. Government [was] through the private market,” such as by supplying vaccines to the Centers for Medicare & Medicaid Services (“CMS”). *Id.* at 10 (¶ 24); *see id.* at 26 (¶ 95) (alleging that Moderna has sold vaccines to CMS “on the commercial market”). CMS is a “federal agency that provides health coverage to more than 160 million through Medicare, Medicaid, the Children’s Health Insurance Program, and the Health Insurance Marketplace.” *Id.* at 10 (¶ 24) (quoting CMS, *About Us*, <https://www.cms.gov/about-cms>). Moderna’s § 1498(a) counterclaim is based on the same factual allegations as its affirmative defense but seeks a declaratory judgment that “Northwestern has no claim against Moderna as to any use or manufacture of doses of SPIKEVAX®” supplied “pursuant to Moderna’s contracts with the U.S. Government.” *Id.* at 26–27 (¶¶ 99–102).

**B. Moderna’s Section 1498(a) Defense in *Arbutus***

Moderna litigated its § 1498(a) defense to judgment in another patent infringement case in this district. That case was brought by Arbutus Biopharma Corporation and Genevant Sciences

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<sup>3</sup> Northwestern only seeks judgment on the portion of Moderna’s thirteenth defense that relies on 28 U.S.C. § 1498(a). Northwestern’s motion does not concern the portions of this defense that allege that Northwestern’s claim for damages is limited under 35 U.S.C. §§ 286 and/or 287. D.I. 36 at 84 (¶ 22).

<sup>4</sup> Moderna has not raised § 1498(a) as a defense to Northwestern’s infringement claims based on mNEXSPIKE or mRESVIA or based on doses of Spikevax that Moderna manufactured and supplied outside of its government contracts.

GmbH (collectively, “Arbutus”) and concerned Moderna’s Spikevax vaccine. Moderna initially moved to dismiss Arbutus’s “infringement claims premised on Moderna’s sale and provision of COVID-19 vaccine doses to the United States Government” under § 1498(a). *Arbutus Biopharma Corp. v. Moderna, Inc.*, 638 F. Supp. 3d 397, 404 (D. Del. 2022). The Court denied Moderna’s motion, reasoning that Moderna failed to show that its infringement was done “for the Government” and with the “authorization and consent” of the government. *Id.* at 408–09. In its answer, Moderna asserted an affirmative defense that Arbutus’s “claims based on Moderna’s manufacture and sale of COVID-19 Vaccine pursuant to the C0100 Contract are barred by 28 U.S.C. § 1498(a).” Ex. 1, Moderna’s *Arbutus* Answer at 79 (¶¶ 11–12).

The Court in *Arbutus* resolved Moderna’s § 1498(a) defense at summary judgment. The undisputed facts showed that while Moderna sold 500,001,540 doses of Spikevax under the C0100 Contract, “[t]he overwhelming number went to members of the general public.” *Arbutus*, 2026 WL 266389, at \*3. A small number of those doses was given to government employees. *Id.* The Court used “traditional tools of statutory construction” to determine whether the meaning of the phrase “for the Government” in § 1498(a) covers the doses of Spikevax that went to the general public. *Id.* at \*5, \*7. The Court determined it did not: “for the Government” means “that the Government, as an entity, must be the intended recipient of the infringing product, as opposed to the public that the Government represents.” *Id.* at \*5. Therefore, the Court concluded that “Section 1498 does not apply to the [direct] infringement claims related to the vaccine doses that went to the general public.” *Id.* at \*6–7. Those doses were “for residents of the United States.” *Id.* But “for the vaccine doses that the Government acquired and distributed to its own employees,” those doses were “for the Government” and covered by § 1498(a). *Id.* The Court further concluded that

“Section 1498 does not apply to claims of indirect infringement,” even if those claims were based on “vaccine doses that the Government acquired and distributed to its employees.” *Id.* at \*6.

After the *Arbutus* Court entered an order consistent with its summary judgment decision, the parties settled and consented to judgment on all issues except that Moderna reserved its right to appeal the § 1498(a) issue. Ex. 2, *Arbutus* SJ Order at 2 (¶ 3(a)); Ex. 3, *Arbutus* Consent Judgment and Order at 3 (¶ 4). The Court then entered judgment against Moderna on its defense “with respect to the vaccines that did not go directly to United States Government employees.” Ex. 3, *Arbutus* Consent Judgment and Order at 3 (¶ 3(a)). Moderna has appealed that issue.

#### **IV. ARGUMENT**

Rule 12(c) allows judgment on the pleadings “[a]fter the pleadings are closed—but early enough not to delay trial.” In evaluating a Rule 12(c) motion, courts apply the same standard as a Rule 12(b)(6) motion. *Revell v. Port Auth. of N.Y. & N.J.*, 598 F.3d 128, 134 (3d Cir. 2010). That requires accepting “the truth of all factual allegations” in the pleading and drawing “all reasonable inferences in favor of the non-movant.” *Id.* A court may consider the pleading, attached exhibits, “matters of public record, as well as undisputedly authentic documents if the complainant’s claims are based upon these documents.” *Wolfington v. Reconstructive Orthopaedic Assocs. II PC*, 935 F.3d 187, 195 (3d Cir. 2019). “[T]he court may also take judicial notice of the factual record of a prior proceeding.” *Behar v. Fed. Ins. Co.*, No. 1:25-cv-00538-JLH-LDH, 2026 WL 296419, at \*3 (D. Del. Feb. 4, 2026); see *United States v. Webber*, 270 F. Supp. 286, 289–90 (D. Del. 1967) (“it is clear that a District Court may take judicial notice of the records of prior cases in its own court”).

##### **A. Collateral Estoppel Bars Moderna’s Section 1498(a) Defense and Counterclaim**

Moderna is estopped from relitigating an issue when, as here: “(1) the identical issue was previously adjudicated; (2) the issue was actually litigated; (3) the previous determination was

necessary to the decision; and (4) the party being precluded from relitigating the issue was fully represented in the prior action.”<sup>5</sup> *Henglein v. Colt Indus. Operating Corp.*, 260 F.3d 201, 209 (3d Cir. 2001) (quoting *Raytech Corp. v. White*, 54 F.3d 187, 190 (3d Cir. 1995)).

**1. The Same Section 1498(a) Issue Was Decided Against Moderna in *Arbutus***

The first factor asks if the issue to be precluded “is identical to the issue previously decided.” *PureWick Corp. v. Sage Prods., LLC*, No. 1:22-cv-00102-MN, 2023 WL 2734779, at \*3 (D. Del. Mar. 31, 2023). Here, it is. “Identity of the issue is established by showing that the same general legal rules govern both cases and that the facts of both cases are indistinguishable as measured by those rules.” *Id.* (quoting *Suppan v. Dadonna*, 203 F.3d 228, 233 (3d Cir. 2000)).

Moderna’s § 1498(a) defense and counterclaim in this case presents a pure legal question about the meaning of the phrase “for the Government” and § 1498(a)’s applicability to Moderna’s supply of Spikevax under government contracts. That identical issue was decided in *Arbutus*. Moderna’s ninth affirmative defense in that case alleged that Arbutus’s infringement “claims based on Moderna’s manufacture and sale of COVID-19 Vaccine pursuant to the C0100 Contract” were barred under 28 U.S.C. § 1498(a). Ex. 1, Moderna’s *Arbutus* Answer at 79 (¶¶ 11–12). The *Arbutus* Court decided that issue against Moderna, concluding that § 1498(a) does not bar (1) direct infringement claims for “vaccine doses that went to the general public” or (2) indirect infringement claims for all doses supplied under Moderna’s government contracts. *Arbutus*, 2026 WL 266389, at \*6–7.

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<sup>5</sup> Even though this is a patent case, Third Circuit law applies when evaluating issues of collateral estoppel. See *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617 F.3d 1296, 1311 (Fed. Cir. 2010). Federal Circuit law applies to “any aspects that may have special or unique application to patent cases.” *Aspex Eyewear, Inc. v. Zenni Optical Inc.*, 713 F.3d 1377, 1380 (Fed. Cir. 2013).

So how indistinguishable is Moderna’s § 1498(a) defense in *Arbutus* compared to its defense in this case? Virtually identical.

<i>Arbutus</i>	This Case
<p><b>Moderna’s ninth defense:</b><sup>6</sup> “Moderna’s manufacture and sale of COVID-19 Vaccine pursuant to the C0100 Contract was and continues to be for the benefit of the U.S. Government and with the U.S. Government’s authorization and consent under 28 U.S.C. § 1498(a).”</p>	<p><b>Moderna’s thirteenth defense:</b><sup>7</sup> “Moderna’s manufacture and sale of COVID-19 vaccine (i.e., SPIKEVAX®) pursuant to the C0100 Contract was and continues to be for the benefit of the U.S. Government and with the U.S. Government’s authorization and consent under 28 U.S.C. § 1498(a).”</p> <p><b>Moderna’s Count VIII:</b><sup>8</sup> “Moderna requests a judicial determination that Northwestern has no claim against Moderna to the extent that, pursuant to Moderna’s contracts with the U.S. government, certain use or manufacture of SPIKEVAX® was done for the U.S. Government and with the authorization or consent of the U.S. Government” under § 1498(a).</p>

For each defense or claim, Moderna alleges the same facts based on the same law: that Moderna entered into contracts with the government to manufacture and sell doses of Spikevax, that activity was done “for” the government and with the “authorization and consent” of the government, and that 28 U.S.C. § 1498(a) bars patent infringement claims against Moderna for Moderna’s manufacture and sale of those doses. *Compare* D.I. 36 at 26–27 (¶¶ 98–102), 84–85 (¶¶ 22–24) with Ex. 1, Moderna’s *Arbutus* Answer at 79 (¶¶ 11–12). The first collateral estoppel factor is met.

**2. Moderna’s Section 1498(a) Defense Was Actually Litigated in *Arbutus***

In evaluating whether the issue was actually litigated in the prior case, “the Court should evaluate the amount of effort spent on that issue through discovery” and leading up to resolution

<sup>6</sup> Ex. 1, Moderna’s *Arbutus* Answer at 79 (¶ 11).

<sup>7</sup> D.I. 36 at 84–85 (¶ 24).

<sup>8</sup> D.I. 36 at 26–27 (¶¶ 99, 102).

“to determine whether there has been ‘a true adversarial contest’ or something less involved and undeserving of preclusive effect.” *PureWick*, 2023 WL 2734779, at \*8.

Moderna vigorously litigated its § 1498(a) defense in *Arbutus*. It filed a motion to dismiss (denied) and a summary judgment motion (partially denied) on that issue. *See Arbutus*, 638 F. Supp. 3d at 410; *Arbutus*, 2026 WL 266389, at \*13. The parties took extensive fact discovery and submitted competing expert testimony on Moderna’s defense. *See, e.g.*, Ex. 4, Moderna’s *Arbutus* Statement of Undisputed Facts at 2–12; Ex. 5, Arbutus’s Counterstatement of Facts at 2–41, 102–06. Fact discovery on the § 1498(a) issue included document and email discovery on Moderna’s government contracts and distribution of vaccine doses under those contracts, and fact witness testimony from Moderna and the government. The United States filed a statement of interest, and multiple amici filed responses to the government’s statement and Moderna’s interpretation of § 1498(a). Ex. 6 (U.S. *Arbutus* Statement of Interest); Exs. 7–11 (amici briefs filed in *Arbutus*). The Court in *Arbutus* entered judgment against Moderna based on a full record. The second collateral estoppel factor is met. *See PureWick*, 2023 WL 2734779, at \*9–10 (factor met where judgment had been entered against defendant in a prior case on the same defense).

### **3. The Determination in *Arbutus* Was Necessary to the Court’s Summary Judgment Decision and Judgment**

The next factor asks whether the previous determination on Moderna’s § 1498(a) defense was necessary to the Court’s decision. “Because litigants are likely to view an issue that is necessary to the resolution of a case as important and to litigate it vigorously, it is fair to give such a determination preclusive effect.” *Jean Alexander Cosms., Inc. v. L’Oreal USA, Inc.*, 458 F.3d 244, 250 (3d Cir. 2006).

The *Arbutus* Court’s determination on § 1498(a)’s applicability to Moderna’s manufacture of Spikevax doses was necessary and central to the judgment in that case. The Court concluded

that “Section 1498 does not apply to the infringement claims related to the vaccine doses that went to the general public” or indirect infringement claims. *Arbutus*, 2026 WL 266389, at \*6–7. For those reasons, the Court granted partial summary judgment in favor of Arbutus and against Moderna “as to Defendants’ Section 1498 defense for the vaccines that did not go directly to United [sic] Government employees.” Ex. 2, *Arbutus* SJ Order at 2 (¶ 3(a)). Consistent with its ruling, the Court subsequently entered “judgment in Plaintiffs’ favor and against Defendants with respect to the vaccines that did not go directly to United States Government employees.” Ex. 3, *Arbutus* Consent Judgment and Order at 3 (¶ 3(a)). The third collateral estoppel factor is met.

#### **4. Moderna Was Fully Represented in *Arbutus***

The last factor asks whether Moderna “was fully represented in previously litigating the [§ 1498(a)] issue sought to be precluded here.” *PureWick*, 2023 WL 2734779, at \*10. It was. Moderna was represented by twenty-five lawyers from three law firms in *Arbutus*—Kirkland & Ellis LLP, Goodwin Procter LLP, and Morris, Nichols, Arsht & Tunnell LLP (also counsel in this case). And Moderna spent years litigating this issue, which included fact and expert discovery and multiple rounds of motion practice. The fourth collateral estoppel factor is met.

#### **B. Alternatively, Moderna’s Section 1498(a) Defense and Counterclaim Fail on the Merits**

If the Court determines that collateral estoppel does not apply, judgment on the pleadings is still proper. Applying § 1498(a) to Moderna’s conduct here stretches the statute beyond its text and purpose.<sup>9</sup> Section 1498(a) waives sovereign immunity for patent owners to bring infringement suits against the United States for a contractor’s “use or manufacture” of a patented invention and assumes liability of the contractor’s infringement only when the contractor’s infringement was “for the Government and with the authorization or consent of the Government.” 28 U.S.C.

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<sup>9</sup> For convenience, Northwestern has included 28 U.S.C. § 1498(a) as Appendix A.

§ 1498(a) (emphasis added); see *Richmond Screw Anchor Co. v. United States*, 275 U.S. 331, 343–44 (1928) (explaining that the statute “is more than a waiver of immunity and effects an assumption of liability by the government”). Vaccine doses manufactured by Moderna and administered to the American public were not for the *government*. Those vaccines were for the patients who received them. Northwestern’s claims against Moderna based on the doses that went to the general public are not barred by § 1498(a).<sup>10</sup> Nor does § 1498(a) bar Northwestern’s indirect infringement claims against Moderna. Section 1498(a) does not apply to indirect infringement claims. *Decca*, 640 F.2d at 1169. Judgment on Moderna’s § 1498(a) defense and counterclaim is appropriate.

**1. Section 1498(a) Does Not Bar Northwestern’s Direct Infringement Claims Against Moderna**

**a) “For the Government” Means the Government Was the Intended Recipient or Beneficiary**

“The starting point in every case involving construction of a statute is the language itself.” *Santa Fe Indus., Inc. v. Green*, 430 U.S. 462, 472 (1977) (citation modified). Since “Section 1498 waives the United States’ sovereign immunity from suit,” “it must be strictly construed in favor of the United States.” *Zoltek Corp. v. United States*, 672 F.3d 1309, 1318 (Fed. Cir. 2012); see *Lane v. Pena*, 518 U.S. 187, 192 (1996) (“[A] waiver of the Government’s sovereign immunity will be strictly construed, in terms of its scope, in favor of the sovereign.”); *Lehman v. Nakshian*, 453 U.S. 156, 161 (1981) (“[L]imitations and conditions upon which the Government consents to be sued must be strictly observed and exceptions thereto are not to be implied.” (quoting *Soriano v. United States*, 352 U.S. 270, 276 (1957))). Courts “may not enlarge the waiver beyond the purview of the statutory language” and should “discern the ‘unequivocally expressed’ intent of Congress, construing ambiguities in favor of immunity.” *United States v. Williams*, 514 U.S. 527, 531 (1995).

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<sup>10</sup> Northwestern agrees that § 1498(a) applies to the doses that were given to government employees and is not seeking damages from Moderna for those doses.

The text, history, and judicial interpretation of “for the Government” in § 1498(a) show that Congress did not unequivocally express its intent to waive sovereign immunity for, and assume liability of, a private party’s infringement of a patent in manufacturing vaccines that went to the American public.

**(1) The text of Section 1498(a)**

The plain language of § 1498(a) does not say that Congress has waived sovereign immunity for, and assumed liability of, all patent infringement by the United States’ contractors. The first paragraph of § 1498(a) provides that a patent owner may sue the “United States in the United States Court of Federal Claims” for “reasonable and entire compensation” when their patented invention “is used or manufactured by or for the United States.”

The second paragraph then clarifies when use or manufacture of a patent by a contractor shall be construed as “use or manufacture for the United States”:

For the purposes of this section, the use or manufacture of an invention described in and covered by a patent of the United States by a contractor, a subcontractor, or any person, firm, or corporation *for the Government* and with the authorization or consent of the Government, shall be construed as use or manufacture for the United States.

28 U.S.C. § 1498(a) (emphasis added).

The statute thus waives immunity for, and assumes liability of, a contractor’s infringement when that infringement is “*for the Government* and with the authorization or consent of the Government.” *Id.* (emphasis added). If the contractor’s use or manufacture was not “for the Government,” then the United States has not waived immunity and a patent owner’s recourse is against the contractor, not the government.

The meaning of “for the Government” is clear from the text of the statute. Waiver is limited to use or manufacture “*for the Government* and with the authorization or consent of the *Government.*” In this context, the preposition “for” is used to indicate the recipient or beneficiary.

The language requires that the government—not the public at large—is the intended recipient or beneficiary. Only that use or manufacture is “for the *United States*.”

The Court in *Arbutus* interpreted “for the Government” in the same way, explaining that “the Government, as an entity, must be the intended recipient of the infringing product, as opposed to the public that the Government represents.” *Arbutus*, 2026 WL 266389, at \*5. This is consistent with how the phrase “for the Government” would have been understood in 1942 when that language was added to the statute. *See* Act of October 31, 1942, ch. 634, 56 Stat. 1013, 1014 (1942). At that time, the word “for” “[i]ntroduc[ed] the intended recipient” or signaled “the purpose or result of benefiting or gratifying,” such as who benefits.<sup>11</sup> And the word “government” referred to “the system of polity in a state,” a “state,” “the United States,” or “the body of persons charged with the duty of governing.”<sup>12</sup> The statutory framework confirms this interpretation.

## (2) The statutory framework of Section 1498(a)

Section 1498(a)’s neighboring provisions waive sovereign immunity for other types of infringement and contain the same “for the Government” language. *See* 28 U.S.C. §§ 1498(b), (d). Sections 1498(b) and (d) provide that a copyright owner (§ 1498(b)) or owner of a certificate of plant variety protection (§ 1498(d)) may sue the United States for “reasonable and entire compensation” when their copyrighted work or certificate of plant variety protection is “infringed by the United States” or a contractor “acting *for the Government* and with the authorization or consent of the Government.” *Id.* § 1498(b) (emphasis added); *see id.* § 1498(d). Each subsection

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<sup>11</sup> Ex. 12, *For*, A New English Dictionary on Historical Principles at 410–11 (James A.H. Murray ed., Vol. IV, 1901) (also known as the “Oxford English Dictionary”); Ex. 13, *For*, The Oxford English Dictionary at 410–11 (Vol. IV, 1933).

<sup>12</sup> Ex. 14, *Government*, A Law Dictionary at 544–45 (Henry Campbell Black, 2d ed., 1910) (also known as “Black’s Law Dictionary”); Ex. 12, *Government*, A New English Dictionary on Historical Principles at 320–21 (James A.H. Murray ed., Vol. IV, 1901); *see* Ex. 15, *Government*, Webster’s Practical Dictionary at 165 (Noah Porter ed. 1910) (similar).

of § 1498 is consistent: it waives the United States’ sovereign immunity only when the United States itself, or someone acting with the authority of the United States and for its benefit, commits the infringement.

The broader statutory scheme confirms that Congress is specific and explicit when it waives sovereign immunity. Section 1498(a) appears in Chapter 91 of Title 28 of the U.S. Code, which governs the U.S. Court of Federal Claims. The chapter’s opening provision grants that court jurisdiction over claims against the United States based on the Constitution, Act of Congress or regulation, an express or implied contract with the United States, or for damages “in cases not sounding in tort.” 28 U.S.C. § 1491(a)(1). The sections that follow specify additional claims that may be brought against the United States pursuant to an Act of Congress based on an action by the United States or an action done for the United States (including for unsettled contractor accounts, *id.* § 1494, unjust convictions and imprisonment for federal offenses, *id.* § 1495, and damage to privately owned or leased oyster beds caused by federal dredging, *id.* § 1497). In each case, the waiver of sovereign immunity is precisely defined and tied to a specific act by the *government*. Section 1498(a) is not an exception. It fits that pattern. If Congress intended to waive immunity whenever a contractor used or manufactured a patented invention for the American population at large under a government contract, it would have said so. It did not.

### **(3) The legislative history of Section 1498(a)**

The legislative history confirms that Congress only intended to waive sovereign immunity for a *contractor’s* acts where the government itself is the intended recipient or beneficiary.

Congress enacted the precursor to § 1498(a) in 1910 to provide a way for patent owners to secure compensation from the United States for Takings Clause violations. *See* Act of June 25, 1910, ch. 423, 36 Stat. 851, 851–52 (1910); H.R. Rep. No. 61-1288, at 1, 3 (1910). Patents are property rights secured by the Takings Clause of the U.S. Constitution. *Cammeyer v. Newton*, 94

U.S. 225, 226 (1876). Once the United States grants a patent, it cannot appropriate or use the patented invention “without just compensation[] any more than it can appropriate or use without compensation land which has been patented to a private purchaser.” *James v. Campbell*, 104 U.S. 356, 357–58 (1881). But before 1910, a patent owner could not seek “just compensation” from the United States for infringing their patent because the United States had not waived sovereign immunity for such suits.<sup>13</sup> U.S. Const. amend. X; see *Schillinger v. United States*, 155 U.S. 163, 167–69 (1894). The 1910 Act rectified that problem and waived sovereign immunity when a patented invention was “used by the United States.” Act of June 25, 1910, ch. 423, 36 Stat. 851, 851–52 (1910).

But the 1910 Act did not waive sovereign immunity when a patented invention was “used by” a government contractor, rather than the United States itself. The Supreme Court confirmed this in *William Cramp & Sons Ship & Engine Building Co. v. International Curtis Marine Turbine Co.*, 246 U.S. 28 (1918). In *William Cramp*, the Cramp Company had contracted with the United States Navy during World War I to build torpedo boat destroyers for the Navy. *Id.* at 35. The Supreme Court held that the Cramp Company’s infringement was not “use[] by the United States” because the Cramp Company was not “an official of the United States.” *Id.* at 42–43 (citation modified). Congress responded by extending waiver of immunity when a patented invention was “used or manufactured by or for the United States” after receiving a letter from the Acting Secretary of the Navy. *Richmond*, 275 U.S. at 342 (emphasis added) (quoting Act of July 1, 1918, ch. 114, 40 Stat. 704, 705 (1918)). The Acting Secretary was concerned that the Supreme Court’s

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<sup>13</sup> If a patent owner’s claim was based on an express or implied contract, then their claim could proceed against the United States under contract law. *Schillinger v. United States*, 155 U.S. 163, 167–69 (1894). But “absent conduct by the United States from which a contract to license the patent could be inferred, a patent holder lacked a remedy for infringement by the United States.” *Zoltek*, 672 F.3d at 1315.

decision would affect the Navy’s ability to procure military supplies from its contractors during wartime. *Id.* at 342. Therefore, “[t]he intention and purpose of Congress in the act of 1918 was to stimulate contractors to furnish what was needed for the war, without fear of becoming liable themselves for” patent infringement. *Id.* at 345; *see* 65 Cong. Rec. 7948, 7960–61 (1918) (explaining that the amendment “would expedite the manufacture of war material” for the Navy).

In 1942, Congress further clarified when use or manufacture of a patented invention by a contractor constitutes “use or manufacture for the United States.” Act of October 31, 1942, ch. 634, 56 Stat. 1013, 1014 (1942) (codified as amended in 28 U.S.C. § 1498(a)); *see* S. Rep. No. 77-1640, at 5 (1942). The 1942 amendment added the following language, which appears in the second paragraph of § 1498(a) today:

[T]he use or manufacture of an invention described in and covered by a patent of the United States by a contractor . . . *for the Government* and with the authorization or consent of the Government, shall be construed as use or manufacture for the United States.

Act of October 31, 1942, ch. 634, 56 Stat. 1013, 1014 (1942) (emphasis added).

This history confirms that the “for the Government” qualifier is narrow and deliberate. Because a contractor’s activities under § 1498(a) are “clothed with the authority of the eminent domain power” of the United States, the United States has waived immunity and assumed liability only for conduct that rises to an exercise of that power—for example, manufacturing military supplies for the Navy. *Decca*, 640 F.2d at 1167. Nothing in § 1498(a)’s text or history shows that Congress unequivocally expressed its intent to extend waiver beyond conduct where the *government* itself was the intended recipient or beneficiary. *See Williams*, 514 U.S. at 531.

**b) The Government Was Not the Intended Recipient or Beneficiary of Vaccines That Went to the General Public**

Section 1498(a) does not apply to the Spikevax doses that went to the American public. The overwhelming number of the 500,001,540 Spikevax doses that Moderna supplied to the

government under the C0100 Contract “went to members of the general public” through the private marketplace to vaccinate the American public against COVID-19. *Arbutus*, 2026 WL 266389, at \*3; see D.I. 36 at 10 (¶ 24), 26 (¶ 95). A small number of vaccines went to government employees. *Arbutus*, 2026 WL 266389, at \*3. The C0100 Contract defined these two classes of recipients or beneficiaries of Moderna’s Spikevax vaccine: “for the *United States Government* (USG) and the *US population*.” D.I. 36-1 at 146 (Section C.1) (emphases added). While the doses that were “for the *United States Government*” are subject to § 1498(a), the doses “for . . . the *US population*” are not. The U.S. population was the intended recipient and beneficiary of those doses, not the government.

The Federal Circuit’s predecessor court addressed a similar situation in *Larson v. United States*, 26 Cl. Ct. 365 (1992). In that case, the court held that the use of infringing splints and casts by healthcare providers was not “for the Government” under § 1498(a), even though the government reimbursed the cost of the splints and casts under federal programs like Medicare and Medicaid. *Id.* at 367–69; see *Advanced Software Design Corp. v. Fed. Rsrv. Bank of St. Louis*, 583 F.3d 1371, 1378–79 (Fed. Cir. 2009) (citing *Larson* with approval); *Sevenson Env’t Servs., Inc. v. Shaw Env’t, Inc.*, 477 F.3d 1361, 1366 (Fed. Cir. 2007) (same). The *Larson* court explained that “[m]edical care is provided for the benefit of the patient, not the government” and rejected patentee’s argument that use was for the benefit of the government:

Any use of plaintiffs’ casts and splints was for the benefit and convenience of the patient and provider, with no benefit to the government. The fact that the government has an interest in the program generally, or funds or reimburses all or part of its costs, is too remote to make the government the program’s beneficiary for the purposes underlying § 1498.

*Larson*, 26 Cl. Ct. at 369. Since *Larson*, the Federal Circuit has reaffirmed that an “incidental benefit to the government is insufficient.” *IRIS Corp. v. Japan Airlines Corp.*, 769 F.3d 1359, 1362

(Fed. Cir. 2014) (quoting *Advanced Software*, 583 F.3d at 1378). The use or manufacture must “be done ‘for the benefit of the government.’” *Id.* (quoting *Advanced Software*, 583 F.3d at 1378).

This case is no different from *Larson*. The *Arbutus* Court recognized as much in analyzing the same C0100 Contract. *Arbutus*, 2026 WL 266389, at \*6 (“This case is indistinguishable from *Larson*.”) “Like the patients receiving splints and casts in *Larson*, the patients receiving Moderna’s mRNA vaccines were the beneficiaries.” *Id.* Moderna’s agreement with the government makes this clear. The C0100 Contract states that the government’s partnership with Moderna is to “ensure development of [a] promising vaccine” and “improve *patient care*, thereby mitigating the impact of COVID-19 on the nation and its *people*.” D.I. 36-1 at 146 (Section C.1.1.1) (emphases added). The fact that the government chose to subsidize the cost for the American people does not convert the government into the recipient or beneficiary of those doses. *Arbutus*, 2026 WL 266389, at \*6; *Larson*, 26 Cl. Ct. at 369. In this case, *Arbutus*, and *Larson*, the patients, not the government, are the recipients or beneficiaries.

Moderna’s manufacture of vaccines for private individuals is not the type of activity that is “clothed with the authority of the eminent domain” power of the United States and for which the United States has waived sovereign immunity and assumed liability. *Decca*, 640 F.2d at 1167. Interpreting § 1498(a) to cover Moderna’s infringement would convert every patent infringement lawsuit relating to drugs, medical devices, or other healthcare treatments involving a government contractor into a suit for compensation against the government for the exercise of its eminent domain power. The statute is not that broad. Northwestern’s direct infringement claims belong in this Court against Moderna, not in the Court of Federal Claims against the United States under § 1498(a). Moderna’s § 1498(a) defense and counterclaim fail.

**2. Section 1498(a) Does Not Bar Northwestern’s Indirect Infringement Claims**

Section 1498(a)’s waiver extends only to conduct that “use[s] or manufacture[s]” a patented invention—the same verbs that define direct infringement under 35 U.S.C. § 271(a). *See* 35 U.S.C. § 271(a) (“whoever without authority *makes, uses, . . .* any patented invention, within the United States . . . infringes the patent.” (emphasis added)). The statute says nothing about actively inducing infringement (§ 271(b)), contributory infringement (§ 271(c)), or supplying components for combination outside the United States (§ 271(f)). Because waivers of sovereign immunity must be strictly construed “and exceptions thereto are not to be implied,” *Lehman*, 453 U.S. at 161 (quoting *Soriano*, 352 U.S. at 276), Congress’s silence is dispositive.

As the Federal Circuit’s predecessor court held, “Section 1498 expressly waives the Government’s sovereign immunity only with respect to governmental direct infringement of a patent.” *Decca*, 640 F.2d at 1169. The *Arbutus* court agreed. *Arbutus*, 2026 WL 266389, at \*6 (“Section 1498 does not apply to claims of indirect infringement.”). As a result, Northwestern’s indirect infringement claims under §§ 271(b), (c), and (f) are not barred under § 1498(a). Moderna (not the United States) is liable for any active inducement or contributory infringement of Northwestern’s patents.

**V. CONCLUSION**

For the foregoing reasons, the Court should grant partial judgment on the pleadings in favor of Northwestern on Moderna’s § 1498(a) defense (thirteenth defense) and counterclaim (Count VIII).

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