IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT
OF TEXAS AUSTIN DIVISION

CARBYNE BIOMETRICS, LLC, Plaintiff, v. APPLE INC., Defendant.	Civil Action No. 1:23-cv-00324 JURY TRIAL DEMANDED

DEFENDANT APPLE'S REPLY CLAIM CONSTRUCTION BRIEF

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Ex.	Description	Abbreviation
A	U.S. Patent No. 9,972,010 (’010 patent)	’010 patent
B	U.S. Patent No. 10,713,656 (’656 patent)	’656 patent
C	U.S. Patent No. 11,526,886 (’886 patent)	’886 patent
D	U.S. Patent No. 10,929,512 (’512 patent)	’512 patent
E	U.S. Patent No. 11,475,105 (’105 patent)	’105 patent
F	U.S. Patent No. 11,514,138 (’138 patent)	’138 patent
G	U.S. Patent Application No. 16/893,237 File Wrapper	’886 File History
H	Webster’s New World Dictionary® of Computer Terms (5th Ed. 1994)	
I	Jargon an Informal Dictionary of Computer Terms (1993)	
J	Dictionary of Computer and Internet Terms (8th Ed. 2003)	
K	*Samsung Electronics Co., Ltd. et al v. RightQuestion, LLC*, IPR2022-00251, Paper 11 (Patent Owner Preliminary Response) (PTAB Mar. 14, 2022)	
L	*Samsung Electronics Co., Ltd. et al v. RightQuestion, LLC*, IPR2022-00251, Paper 1 (Petition for IPR) (PTAB Dec. 1, 2021)	
M	*RightQuestion, LLC v. Samsung Electronics Co., Ltd. et al*, Case No. 2-21-cv-238, Dkt. 39 (Joint Claim Construction Statement) (E.D. Tex. Jan. 14, 2022)	
N	October 2, 2023 email from Cross to Burks and October 3, 2023 email from Burks to Cross	
O	Carbyne’s Response to Apple’s Motion to Transfer (ECF No. 50)	

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I. INTRODUCTION

Carbyne urges the Court not to construe a single disputed term across any of the six asserted patents, and to instead leave disputed issues of claim construction unresolved. None of Carbyne's arguments against claim construction has merit. Instead, those arguments prove that there are disputes that need to be resolved.

II. DISPUTED TERMS FOR CONSTRUCTION

A. "configured to" ('010 claim 1; '656 claim 1; '886 claim 1; '512 claims 1, 6, 11, 15, 21; '105 claims 1, 9; '138 claim 1)

Apple's Proposed Construction	Carbyne's Proposed Construction
Plain & Ordinary Meaning, which requires not merely being capable of being configured but rather actually being configured	P&O: No construction necessary

Carbyne's shifting positions about the meaning of "configured to" confirm that the parties dispute the meaning of this term and that construction is therefore necessary.

There is no merit to Carbyne's argument that no construction is necessary because the parties agree that "the plain meaning of 'configured to' requires more than being 'capable of' being configured." Resp. Br. 5. Carbyne's Response is silent as to what "more" is required, and whether that "more" is something less than, or different from, Apple's proposed construction. Apple's construction, in contrast, states what "more" is required—actual configuration—consistent with this Court's recent decision. *See Q Techs. Inc. v. Neutron Holdings, Inc.*, No. W-21-CV-00321-ADA, slip op. at 3 (W.D. Tex. May 24, 2022), ECF No. 39 (construing "configured to" as requiring "actually being configured" to perform the recited function). Moreover, in meet-and-confer, Carbyne stated that it disagrees with Apple's proposed construction, insisting that it created an "impasse as to how 'configured to' is properly construed." Ex. N (10/3/23 email from Burks to Cross). Accordingly, there is a dispute.

That dispute, and the need for construction, is crystallized by Carbyne's Response brief. Despite first asserting that the plain and ordinary meaning of "configured to" requires more than mere capability of being configured, Carbyne reverses course when discussing the term's use in the context of certain claim language. For example, claims 1 and 11 of the '886 patent recite "one or more processors ***configured to***: ***render***, in one or more interfaces, ***a virtual likeness of a face*** associated with an account holder, wherein the virtual likeness of the face was selected by the account holder as part of an enrollment." Despite that use of the words "configured to," Carbyne asserts that these claims require only capability, not actual configuration. Specifically, Carbyne argues that "a POSITA would understand that ***infringement occurs when a device able to render a virtual likeness is manufactured***"; that "***infringement occurs as soon as a device is manufactured that*** functions in the described manner—that is, the device ***is able to render the selected virtual likeness***"; and that "***the patent claims the system's capability to receive and react to the selected virtual likeness*** by rendering that virtual likeness." Resp. Br. 6-8 (emphasis added). Carbyne's shifting interpretation and application of "configured to," which seesaws from argument to argument, underscores the need for a construction—and for Apple's construction in particular.

The parties' dispute, and the resulting need for construction, is reinforced by other arguments that Carbyne has made. For example, claim 1 of the '512 patent requires that the claimed "first" and "second" processors be "configured to" perform certain functions, such as "establish a secure connection with the external resource," "receive a biometric input from a sensor," "access a record stored in a secure storage," "perform a cryptographic operation," "facilitate a login of the user to the external resource," and "perform a secure backup of the record to a storage service." '512 (Ex. D) at 10:63-11:29. Carbyne argues, however, that Apple

infringes the purportedly "novel hardware configurations" of claim 1 of the '512 patent merely by "including an Application Processor (first processor) and Secure Enclave Processor (second processor)" in the accused products. *See* Ex. O (Carbyne's Response to Apple's Motion to Transfer, ECF No. 50), at 2). That argument would require, at best, construing "configured to" to recite a mere capability of being configured a particular way. Again, Carbyne's constantly shifting positions about the plain and ordinary meaning of "configured to" underscore the need for the Court to construe this term, and to adopt Apple's construction.

Carbyne's cited cases (Resp. Br. 5-6) are inapposite and do not resolve the need for construction here. In *Ahern*, the court determined that there was "no dispute to resolve" about the meaning of "configured to" because plaintiff agreed that more than mere capability was required and, unlike here, had "never taken a contrary position." *Ahern Rentals, Inc. v. EquipmentShare.com, Inc.*, No. 20-cv-00333, 2021 WL 4891379, at *10 (E.D. Tex. Oct. 19, 2021). In *Koninklijke*, the court adopted "plain and ordinary meaning" of "configured for" because defendant's proposed construction, which is different from Apple's proposed construction here, sought to "introduce various limitations without adequate support in the intrinsic record." Claim Construction Order at 33-37, *Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson*, No. 2-22-cv-282 (E.D. Tex. Oct. 13, 2023), ECF No. 176. Carbyne has not alleged, and could not allege, that Apple's proposed construction suffers from that problem. Moreover, the court in *Koninklijke* gave no indication that plaintiff was taking contrary positions about the claim term's meaning. And in *Impinj*, the court adopted plain and ordinary meaning for "configured to" where, again, there was no suggestion that plaintiff was taking contrary positions, and where defendant's proposed construction was "made or designed to perform a specific function." Claim Construction Order at 5, *Impinj, Inc. v. NXP USA, Inc.*,

No. 21-cv-00530-ADA (W.D. Tex. Feb. 10, 2022), ECF No. 56. Moreover, that construction—"made or designed to perform a specific function"—is very different from Apple's proposed construction here and could be read to imply an intent requirement. *Solocron Media, LLC v. Verizon Commc'ns, Inc.*, No. 13-CV-1059, 2015 WL 1011310, at *12 (E.D. Tex. Mar. 5, 2015) (rejecting defendant's proposed construction of "configured to" as "specifically designed and set up to perform the claimed function," because that construction could "suggest[] that the intent of a designer must be established," and instead adopting "plain meaning, 'which the [c]ourt understands to require not merely being capable of being configured but rather being actually configured.'" (citation omitted)).

Finally, Carbyne's argument that Apple's construction would "confuse the jury" is wrong on its face and lacks any evidentiary support. Resp. Br. 6. Given that courts have adopted the same or similar construction as Apple's (*see, e.g.*, *Q Techs. Inc.*, slip op. at 3; *Solocron Media*, 2015 WL 1011310, at *12; *Huawei Techs. Co. v. Verizon Commc'ns, Inc.*, No. 20-cv-00030, 2021 WL 150442, at *17-20 (E.D. Tex. Jan. 15, 2021); *Perdiem Co, LLC v. IndusTrack LLC*, No. 15-cv-727, 2016 WL 3633627, at *41 (E.D. Tex. July 7, 2016)); *see also* Opening Br. 6-8), if such a construction caused jury confusion, presumably Carbyne would be able to cite evidence of that fact. But it does not. In any event, Carbyne's argument that Apple's proposed construction is circular (Resp. Br. 6) could only be a valid attack if Carbyne agrees with Apple that "configured to" does not include merely "capable of." But as this is precisely what Carbyne disputes, Apple's construction provides necessary clarification that the claimed device must in fact do what the claim language states—be configured—and not something different. Carbyne also criticizes Apple's construction for including a "negative example" (*id.*), but Carbyne fails both to explain how that clarification would cause confusion and to address those decisions that

have embraced that same or similar "negative example" as necessary and appropriate claim construction—such as those decisions cited earlier in this paragraph. Finally, Carbyne advances the argument that Apple's proposed construction "injects unexplained levels of configuration that are relative to each other and mutually exclusive," (*id.*), but provides no explanation what that means, or how or why Apple's construction allegedly does that. Carbyne's failure to explain itself is especially notable given that other courts have construed "configured to" in the way that Apple proposes. S*ee* Opening Br. 6-8. None of Carbyne's arguments against Apple's proposed construction holds up to scrutiny.

For the forgoing reasons, it is necessary to construe "configured to" as not merely being capable of being configured, but rather actually being configured. Apple's proposed construction should be adopted.

B. "wherein the virtual likeness of the face was selected by the account holder as part of an enrollment" ('886 claims 1, 11)

Apple's Proposed Construction	Carbyne's Proposed Construction
Indefinite as a mixed system/method claim	P&O: No construction necessary

Claims 1 and 11 of the '886 patent purport to be directed to an apparatus ("device" or "computer program product"), but also recite a step that must be performed by the account holder. As such, the claims mix apparatus and method requirements, rendering them indefinite. Opening Br. 8-10.

Carbyne argues that the claims are not indefinite because "a POSITA would understand that infringement occurs when a device ***able to*** render a virtual likeness is manufactured" (Resp. Br. 6 (emphasis added))—but that interpretation is plainly incorrect. The claims are not directed to a capability. Claim 1 recites "one or more processors ***configured to***" perform the steps of the claim language, including "render, in one or more interfaces, a virtual likeness of a face

associated with an account holder, wherein the virtual likeness of the face was selected by the account holder as part of an enrollment." '886 (Ex. C) at 14:2-7 (emphasis added). The claim thus requires that a processor be configured to display a particular image, and that the image was selected by an account holder. Indeed, Carbyne admits elsewhere in its brief that "configured to" requires ***more than*** mere capability. *See supra.* According to Carbyne, however, the claim should be construed to encompass any "device" or "computer program product" containing any ***programmable*** processor that is "able to render a virtual likeness"—regardless of how that processor is configured when that claimed "device" or "computer program product" is made or sold, and regardless of whether an account holder ever selects a virtual likeness or does so as part of an enrollment, as claimed.

That the user action here is recited in the passive voice (Resp. Br. 8) is immaterial. *See, e.g.*, *e-Watch Inc. v. Apple, Inc.*, No. 13-CV-1061, 2015 WL 1387947, at *4-7 (E.D. Tex. Mar. 25, 2015) (finding purported apparatus claims reciting "movement by the user" invalid because they "require a step to be performed" despite being phrased in the passive voice). Carbyne cites no case for the proposition that whether user action is claimed in the passive versus active voice matters to the *IPXL* analysis, or otherwise provides any explanation why the tense matters. Indeed, as in *e-Watch*, Carbyne's interpretation here "would require the [c]ourt to redraft the claims and read the words [requiring the specified action by the account holder] out of the claims," which "would be improper." *eWatch*, 2015 WL 1387947, at *6. Here, the limitation makes clear what the step is (selecting the virtual likeness of the face), who performs that step ("the account holder"), and when ("as part of an enrollment"). Those specified user actions render the claims indefinite under *IPXL*. *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005).

Carbyne's attempt to draw parallels to *Mastermine* falls flat. Resp. Br. 8. *Mastermine* involved a claim directed to a system capable of operating in a specified way when a software application (a "reporting module") "receives from the user a selection" of one or more fields and "generates a database query as a function of the user selected database fields." *Mastermine Software Inc. v. Microsoft Corp.*, 874 F.3d 1307, 1315-16 (Fed. Cir. 2017). Thus, the claim was directed to what the software application does—receives information from a particular source and generates a query based on that information. As the court there noted, the claims referenced a user selection "but d[id] not [actually] claim the user's act of selection." *Id.* at 1316. The opposite is true here. The claims here require a selection by the account holder, and that the selection be at a particular time (enrollment). Further, while the claims in *Mastermine* "represent permissible functional language used to describe capabilities of the" software module (receiving information from a particular source), the claim requirement here—"the virtual likeness of the face was selected by the account holder as part of an enrollment"—does not describe a configuration of the processor of the '886 patent claims. That the account holder selected the virtual likeness as part of enrollment is not a permissible step but a required step that is in addition to the processor being "configured to" (not merely able to) render the virtual likeness.

Indeed, *Mastermine* distinguishes *IPXL Holdings* and *Katz* based on the fact that "the claims . . . do not claim activities performed by the user"—unlike here. *Mastermine*, 874 F.3d at 1316. And, as noted in *Beneficial Innovations*, "[t]he question of whether claim language is indefinite for improperly mixing claim forms turns on whether the language used is directed at user actions or system capabilities." *Beneficial Innovations, Inc. v. Advance Publ'ns, Inc.*, No. 11-cv-229, 2014 WL 186301, at *2 (E.D. Tex. Jan. 14, 2014). Here, as in *Katz*, the Court should reject Carbyne's attempts to recast this method step directed to user action as some functional

capability. *In re Katz Interactive Call Processing Pat. Litig.*, 639 F.3d 1303, 1318 (Fed. Cir. 2011).

Finally, Carbyne's attempt to distinguish *H-W Technology* falls flat. *See* Opening Br. 9-10. As in *H-W Technology*, the selecting step "is claimed and required for infringement." *See id.*; *H-W Tech., L.C. v. Overstock.com, Inc.*, 758 F.3d 1329, 1335-36 (Fed. Cir. 2014). Selection of a likeness by an account holder at enrollment does not "describe a structure by reciting its capabilities," as Carbyne argues, Resp. Br. 7 (citation omitted), but recites user activity. Further, *H-W Technology* is not "Apple's only claim-construction case," as Carbyne claims. Resp. Br. 8; *see* Opening Br. 9-10 (citing *H-W Tech.*, 758 F.3d at 1335-36; *In re Katz*, 639 F.3d at 1318; and *IPXL*, 430 F.3d at 1384.) Not surprisingly, Carbyne fails to address the similarity of the claim language here as in *H-W Tech.*, *Katz*, and *IPXL*. *See, e.g.*, *H-W Tech.*, 758 F.3d at 1335-36 (finding claim reciting "wherein said user selects . . ." indefinite (citation omitted)); *In re Katz*, 639 F.3d at 1318 (finding claim reciting "wherein . . . callers digitally enter data" and "wherein . . . callers provide . . . data" indefinite (citation omitted)); *IPXL*, 430 F.3d at 1384 (finding claim reciting "wherein . . . the user uses" indefinite).

For these reasons, the Court should find this limitation indefinite.

C. "captur[e/ing] a set of biometric information, wherein capturing the set of biometric information comprises capturing, using a camera, a set of images" ('886 claims 1, 6, 11)

Apple's Proposed Construction	Carbyne's Proposed Construction
"captur[e/ing] a set of biometric information, wherein capturing the set of biometric information comprises capturing, using a camera, a set of photographs"	P&O: No construction necessary

Contrary to Carbyne's assertion, the intrinsic evidence supports Apple's construction. Indeed, the prosecution history, which confirms "the aliveness check as recited in the

specification is constrained to 'taking multiple photographs in rapid succession,'" compels Apple's construction. Ex. G ('886 File History), at 19-20 (9/2/21 Office Action pp. 4-5). And Carbyne does not dispute that "taking multiple photographs" is the ***only*** way that the specification discloses using a camera to capture a set of biometric information for the purpose of determining whether the user is alive—which is the claimed use of the captured biometric information. '886 (Ex. C) at 8:67-9:1; Opening Br. 10-11. Nor does Carbyne dispute that a POSITA, reading the claims in light of the prosecution history and specification, would have understood that "capturing the set of biometric information comprises capturing, using a camera, a set of images" refers to capturing a set of photographs.

Carbyne's attempt to recast the prosecution history as expanding the scope of this limitation (Resp. Br. 10-11) is unavailing. As Carbyne notes, during prosecution, applicant withdrew as-filed claims 4 and 12, which recited "wherein the second portion of the set of captured biometric information comprises one or more photographs of the user," (Ex. G ('886 File History), at 34-35 (12/2/21 Amendment B pp.3-4)) and amended the independent claims to instead add "captur[e/ing] a set of biometric information, wherein capturing the set of biometric information comprises capturing, using a camera, a set of images," (*id.* at 62-64 (5/23/22 Amendment C pp. 2-4)). But Carbyne ignores other prosecution events. During prosecution, in rejecting then pending claims that purported to claim determining a user is alive by way of biometric information that was not limited to photographs, the Examiner stated that the "specification teaches only that 'taking multiple photographs in rapid succession' is used for confirming that the object being photographed is alive" and that "the aliveness check as recited in the specification is constrained to 'taking multiple photographs in rapid succession.'" *Id.* at 19-20 (9/2/21 Office Action pp. 4-5). Applicant acquiesced to these findings by amending its

pending claims as follows, to limit the captured biometric information for checking whether user is alive to "one or more photographs":

> wherein the first portion of the set of captured biometric information comprises ~~is associated with~~ at least one of a fingerprint[[,]] and an audio sample, and wherein the second portion of the set of captured biometric information comprises one or more photographs ~~a photograph~~ of the user.

Id. at 34-35 (12/2/21 Amendment B pp. 3-4). In view of applicant's acquiescence to the Examiner's findings, the prosecution history compels the conclusion that a POSITA would have understood that the claim language at issue means "captur[e/ing] a set of biometric information, wherein capturing the set of biometric information comprises capturing, using a camera, a set of photographs."

Unable to rebut the intrinsic evidence supporting Apple's construction, Carbyne is left to argue that the term "set of images," divorced from the rest of the claim language, is broader than "set of photographs." Resp. Br. 10. But the issue is not what the words "set of images" means in a vacuum; the issue is what the term "captur[e/ing] a set of biometric information, wherein capturing the set of biometric information comprises capturing, using a camera, a set of images" means in the context of the claims and intrinsic record, where (i) the "set of images" is used in the claims to determine if a user is alive, (ii) applicant acquiesced to the Examiner's statement that "the aliveness check as recited in the specification is constrained to 'taking multiple photographs in rapid succession,'" and (iii) the specification and prosecution history disclose one—and only one—way in which that aliveness check occurs: through the use of photographs. Opening Br. 10-11.

That dependent claims 4 and 9 recite "wherein the image comprises at least one of a photograph or an avatar" (Resp. Br. 10) does not change that analysis. Apple's argument has never been, as Carbyne incorrectly suggests, that the terms "image" and "photograph" are

interchangeable. As the specification explains, the "image" ***received from the account holder during enrollment*** "may be a photograph, an avatar, or other representation [of the account holder]" because it is used only to increase the "[f]eelings of guilt for engaging in fraudulent transactions by . . . emphasizing the victim's identity" by, for example, displaying the image during checkout time. *See, e.g.*, '886 (Ex. C) at 5:27-29, 5:39-48, 6:15-17. Here, in contrast, the "image" under consideration for purposes of claim construction is the ***biometric information captured using a camera to determine whether a user is alive***. An avatar is plainly not captured biometric information, and the specification teaches only capturing "multiple photographs in rapid succession" for purpose of determining whether a user is alive. *Id.* at 8:65-9:4. Carbyne does not argue—nor could it for the reasons above—that the "set of images" in the independent claims is the antecedent basis for "the image" claimed in claims 4 and 9, which "comprises at least one of a photograph or an avatar." *Id.* at 14:34-35, 15:1-2. Accordingly, that the term "the image" in claims 4 and 9 includes avatars has no bearing on the claim construction analysis of the disputed term.

For the reasons above, and as set forth in Apple's opening brief, Apple's construction should be adopted.

D. "restricted interface" ('512 claims 1, 6, 11, 15, 21; '105 claims 9, 11, 28, 30; '138 claims 11, 23)

Apple's Proposed Construction	Carbyne's Proposed Construction
"a physical or software interface with limited accessibility"	P&O: No construction necessary

Carbyne agrees that the term "restricted interface" ***includes*** "a physical or software interface with limited accessibility," but argues that Apple's proposed construction somehow ***limits*** the full scope of the claim term. Resp. Br. 12-13. Nowhere, however, does Carbyne explain how Apple's construction is limiting. That is, Carbyne fails to identify or explain what

Apple's construction purportedly excludes that would otherwise fall within the "plain and ordinary" meaning of this term. That failure is telling. Apple's construction does not limit the claim term, but instead captures the full scope of it.

Apple seeks construction for three reasons. *See* Opening Br. 13-14. First, as discussed above, the parties dispute the scope of this term. *See* Resp. Br. 12-13. Second, Carbyne's predecessor-in-interest is on record as having contended both that certain types of interfaces are not within the scope of "restricted interface" and that express construction was necessary—making construction necessary here, too. *See* IPR2022-00251, Dkt. 11 ("'512 IPR Preliminary Response") at 38 ("Indeed, Petitioner's 'expert' does not even opine on whether a POSITA would have viewed a local interface, data bus, or another network as a restricted interface."). Third, the Board denied institution in part because "neither Petitioner nor its expert provide[d] any express construction for what a 'restricted interface' is in the context of the '512 patent." *See* IPR2022-00251, Dkt. 17 ("'512 IPR Decision") at 24. That holding reinforces the point that "restricted interface" is not merely a term of art readily understood, but one that requires construction.

The Board's statement in its institution decision also contradicts Carbyne's argument here that no construction is necessary because the "[term] is readily understood by a POSITA and easy to explain to jurors." Resp. Br. 12. Moreover, whether a term is readily understood is not the test for whether a term requires construction. Instead, as the Federal Circuit has held, it is "[w]hen the parties present a fundamental dispute regarding the scope of a claim term" that it becomes "the court's duty to resolve it." *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008). Here, Carbyne argues that Apple's proposed construction is too "limiting." Resp. Br. 9-11. Thus, there is a fundamental dispute as to the term's scope, so

construction is required.

Carbyne's argument that Apple's proposed construction is improperly narrow highlights why construction is necessary in other ways, too. Between Carbyne and its predecessor, Right Question, the owners of the Authentication Patents have argued both that structures such as a "local interface, data bus, or another network" are outside of the scope of "restricted interface," but also that "a physical or software interface with limited accessibility" does not capture the full scope of a "restricted interface." Not once, however, has Carbyne (or RightQuestion) articulated why either argument is true. And Carbyne has not provided a single example of a restricted interface that is not "a physical or software interface with limited accessibility." Instead, by invoking some ambiguous plain meaning, Carbyne instead attempts to treat this claim term like the proverbial nose of wax, so that Carbyne can twist and turn its meaning at will.

Apple's proposed construction is the plain and ordinary meaning of "restricted interface" as evidenced by the multitude of dictionaries and the added description in the later-filed '105 patent that the applicant felt was necessary to add to the continuation-in-part. Opening Br. 14-15. Notably, Carbyne identifies no fault with the proposed construction other than its conclusory and unsupported supposition that it is overly narrow. Without any evidence or argument to the contrary, the Court should construe "restricted interface" as "a physical or software interface with limited accessibility."

III. CONCLUSION

For the foregoing reasons, Apple respectfully requests that the Court adopt its proposed constructions.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that, on November 8, 2023, a true-and-correct copy of the foregoing document was served with the Court's CM/ECF system on all counsel of record.

/s/ Melissa R. Smith
Melissa R. Smith