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10 IN THE UNITED STATES DISTRICT COURT  
11 FOR THE CENTRAL DISTRICT OF CALIFORNIA  
12 WESTERN DIVISION

13 ONE-E-WAY, INC., a California  
14 corporation,

15 Plaintiff,

16 v.

17 APPLE INC., a California corporation,

18 Defendant.  
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Case No. 2:20-CV-06339-JSK-PD

**ONE-E-WAY'S FIRST  
AMENDED DISCLOSURE OF  
ASSERTED CLAIMS AND  
INFRINGEMENT  
CONTENTIONS AND  
ACCOMPANYING  
DOCUMENTS PURSUANT TO  
S.P.R. 2.1 AND 2.2**

Hon. John A. Kronstadt

1 Pursuant to this Court’s Standing Patent Rules (“S.P.R.”) 2.1 and 2.2 (Dkt.  
2 No. 10), Plaintiff One-E-Way, Inc. (“Plaintiff” or “One-E-Way”) hereby provides  
3 its first amended disclosure of asserted claims and infringement contentions and  
4 accompanying document production. In view of the limited discovery available to  
5 One-E-Way at this early stage of the proceeding, One-E-Way reserves the right to  
6 amend this disclosure in view of any relevant evidence subsequently obtained  
7 through discovery.

8 **I. DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT**  
9 **CONTENTIONS – S.P.R. 2.1**

10 **A. Asserted Claims – S.P.R. 2.1.1**

11 Based on currently available information, Plaintiff One-E-Way contends that  
12 Defendant Apple Inc. (“Defendant” or “Apple”) infringes the following claims of  
13 U.S. Patent Nos. 8,131,391 (“the ’391 patent”), 10,129,627 (“the ’627 patent”) and  
14 10,468,047 (“the ’047 patent”) (collectively, “the Asserted Patents”):

15  
16

Asserted Patent	Asserted Claims
'391	1, 3-6, 10
'627	1-6, 10-12
'047	1-6, 8-15, 17-20

17  
18  
19  
20

21 Each claim in the table above is alleged to be infringed under 35 U.S.C.  
22 § 271(a) and (b). These claims are collectively referred to as the “Asserted Claims.”  
23 One-E-Way reserves the right to amend or supplement this disclosure as information  
24 becomes available.

25 **B. Accused Instrumentalities – S.P.R. 2.1.2**

26 One-E-Way hereby identifies the following Apple products as products that  
27 practice the Asserted Claims. For all products identified herein, One-E-Way also  
28 identifies any prior or subsequent commercial iteration of the product if that product

1 was/is capable of wirelessly transmitting or receiving audio data using Bluetooth  
2 connectivity in the manner set forth in the S.P.R. 2.1.3 disclosure.

3 Apple

4 AirPods, AirPods Pro, HomePod, iPhone, iPad, iPod, and Apple Watch.<sup>1</sup>

5 Beats

6 Powerbeats Wireless Earphones, Powerbeats Pro Wireless Earphones,  
7 Powerbeats<sup>3</sup> Wireless Earphones, Beats Solo Pro Wireless Noise Cancelling  
8 Headphones, Beats Solo<sup>3</sup> Wireless Headphones, Beats Studio<sup>3</sup> Wireless  
9 Headphones, Beats<sup>X</sup> Wireless Earphones, and Beats Pill+ Portable Speaker.

10 To the best of One-E-Way's knowledge, and subject to discovery from Apple,  
11 One-E-Way discloses the products listed in Exhibit D as the accused  
12 instrumentalities identified in this section.

13 **C. Claim Charts – S.P.R. 2.1.3**

14 Attached as Exhibits A-C are claim charts showing where each limitation of  
15 each of the Asserted Claims is literally present within the accused devices.

16 **D. Priority Date of the Patents-in-Suit – S.P.R. 2.1.4**

17 Each Asserted Patent claims a priority date of December 21, 2001, the date of  
18 U.S. Patent Application No. 10/027,391, which is the common original parent  
19 application to the Asserted Patents.

20 The sole named inventor on the Asserted Patents, and the 10/027,391 original  
21 parent application, is C. Earl Woolfork. Mr. Woolfork conceived of the inventions  
22 of the Asserted Claims by at least June 25, 1999. The Asserted Claims were  
23 constructively reduced to practice by at least December 21, 2001, the date upon  
24 which the 10/027,391 original parent application was filed. Mr. Woolfork was  
25 diligent towards reducing the Asserted Claims to practice from at least June 25,  
26

27 \_\_\_\_\_  
28 <sup>1</sup> Although apparently not yet commercially available, One-E-Way also identifies Apple's AirPods Studio Headphones.

1 1999, until December 21, 2001, and the Asserted Claims are entitled to priority of  
2 invention as of at least June 25, 1999.

3 **E. Practicing the Claimed Invention – S.P.R. 2.1.5**

4 One-E-Way does not intend to rely on its own products practicing any of the  
5 Asserted Claims to prove infringement.

6 **F. Willful Infringement – S.P.R. 2.1.6**

7 Based on the limited discovery available to One-E-Way at this early stage of  
8 the proceedings, One-E-Way does not allege willful infringement at this time.

9 **II. ACCOMPANYING DOCUMENT PRODUCTION – S.P.R. 2.2**

10 **A. File Histories of the Asserted Patents – S.P.R. 2.2.1**

11 One-E-Way has produced the file histories of the Asserted Patents, along with  
12 the file histories of the other patents in the chain of priority of the Asserted Patents,  
13 at OEW\_APPLE-0000086-0008878.

14 **B. Documents Evidencing Ownership – S.P.R. 2.2.2**

15 One-E-Way has produced documents evidencing ownership of the Asserted  
16 Patents at OEW\_APPLE-0008879-8940.

17 **C. Documents Supporting Practicing the Claimed Invention – S.P.R. 2.2.3**

18 For the reasons stated in Section I.E above, One-E-Way has not produced any  
19 documents pursuant to S.P.R. 2.2.3.

20  
21 KNOBBE, MARTENS, OLSON & BEAR, LLP

22  
23 Dated: October 27, 2020

*/s/ Douglas G. Muehlhauser*

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Payson LeMeilleur

24  
25 Attorneys for Plaintiff  
26 ONE-E-WAY, INC.  
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## Exhibit A

### **One-E-Way's S.P.R. 2.1.3 Asserted Claim Chart For The '391 Patent**

One-E-Way hereby provides its S.P.R. 2.1.3 Asserted Claim Chart for One-E-Way's U.S. Patent No. 8,131,391. The claims of the '391 patent identified herein are claims 1, 3-6 and 10.

As used herein, "Accused Receiver Device" includes any of the following individual devices: Apple's AirPods, AirPods Pro and HomePod, and Apple's Powerbeats Wireless Earphones, Powerbeats Pro Wireless Earphones, Powerbeats<sup>3</sup> Wireless Earphones, Beats Solo Pro Wireless Noise Cancelling Headphones, Beats Solo<sup>3</sup> Wireless Headphones, Beats Studio<sup>3</sup> Wireless Headphones, Beats<sup>X</sup> Wireless Earphones, and Beats Pill+ Portable Speaker, as well as the products listed under Accused Receiver Products in Exhibit D.<sup>1</sup> Although not commercially available yet, One-E-Way expects, upon information and belief, that Apple's AirPods Studio Headphones will satisfy the same claims, in the same manner, as the Accused Receiver Devices discussed below.

As used herein, "Accused Transmitter Device" includes any of the following individual devices: Apple's iPhone, iPad, iPod and Apple Watch, as well as the products listed under Accused Transmitter Products in Exhibit D.

The following chart provides exemplary evidence of infringement. Additionally, for simplicity, One-E-Way relies on citations to Bluetooth specification 5.0. However, because of the backwards-compatibility of Bluetooth back to Bluetooth version 2.1, each citation to Bluetooth 5.0 should be understood to also refer to the corresponding sections in each Bluetooth specification from version 2.1 onward, such as Bluetooth specification 4.0, 4.1 and 4.2, as indicated more specifically in Exhibit E. One-E-Way also notes that Apple has yet to provide discovery, as the case is in the beginning stages. One-E-Way reserves the right to identify additional information learned through discovery that further confirms these infringement contentions.

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<sup>1</sup> For Claims 1, 3, 6 and 10, the term "Accused Receiver Device" does not include the Apple HomePod or Beats Pill devices.

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