

1 Douglas G. Muehlhauser (SBN 179495)
2 doug.muehlhauser@knobbe.com
3 Payson LeMeilleur (SBN 205690)
4 payson.lemeilleur@knobbe.com
5 KNOBBE, MARTENS, OLSON & BEAR, LLP
6 2040 Main Street, Fourteenth Floor
7 Irvine, CA 92614
8 Telephone: 949-760-0404
9 Facsimile: 949-760-9502

6 Attorneys for Plaintiff
7 ONE-E-WAY, INC.

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.

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

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

Hon. John A. Kronstadt

19
20
21
22
23
24
25
26
27
28

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 disclosure of asserted claims and infringement contentions and accompanying
4 document production. In view of the limited discovery available to One-E-Way at
5 this early stage of the proceeding, One-E-Way reserves the right to amend this
6 disclosure in view of any relevant evidence subsequently obtained through
7 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	16 Asserted Claims
17 ’391	1, 3-6, 10
18 ’627	1-6, 10-12
19 ’047	1-6, 8-15, 17-20

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.¹

5 Beats

6 Powerbeats Wireless Earphones, Powerbeats Pro Wireless Earphones,
7 Powerbeats³ Wireless Earphones, Beats Solo Pro Wireless Noise Cancelling
8 Headphones, Beats Solo³ Wireless Headphones, Beats Studio³ Wireless
9 Headphones, Beats^X Wireless Earphones, and Beats Pill+ Portable Speaker.

10 **C. Claim Charts – S.P.R. 2.1.3**

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

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

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

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

25 ///

26
27 _____
28 ¹ Although apparently not yet commercially available, One-E-Way also identifies Apple's
AirPods Studio Headphones.

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

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

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

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

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

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

9 One-E-Way has produced the file histories of the Asserted Patents, along with
10 the file histories of the other patents in the chain of priority of the Asserted Patents,
11 at OEW_APPLE-0000086-0008878.

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

13 One-E-Way has produced documents evidencing ownership of the Asserted
14 Patents at OEW_APPLE-0008879-8940.

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

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

18

19

KNOBBE, MARTENS, OLSON & BEAR, LLP

20

21 Dated: September 15, 2020 /s/ Douglas G. Muehlhauser

22

Douglas G. Muehlhauser
Payson LeMeilleur

23

Attorneys for Plaintiff
ONE-E-WAY, INC.

24

25

26

27

28

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, Powerbeats³ Wireless Earphones, Beats Solo Pro Wireless Noise Cancelling Headphones, Beats Solo³ Wireless Headphones, Beats Studio³ Wireless Headphones, Beats^X Wireless Earphones, and Beats Pill+ Portable Speaker.¹ 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.

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. 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.

¹ For Claims 1, 3, 6 and 10, the term "Accused Receiver Device" does not include the Apple HomePod or Beats Pill+ Portable Speaker.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.