

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF NEW YORK**

**TOPDOWN LICENSING LLC,**

Plaintiff,

v.

**KORG U.S.A. INC.,**

Defendant.

**Civil Action No. 21-CV-2431**

**ORIGINAL COMPLAINT**

**JURY TRIAL DEMANDED**

**ORIGINAL COMPLAINT**

Plaintiff Topdown Licensing LLC (“Topdown”) files this complaint against Korg U.S.A. Inc. (“Defendant”), for infringement of U.S. Patent Nos. 8,178,773 (“the ‘773 Patent”) (attached hereto as Exhibit A) and 7,858,870 (“the ‘870 Patent”) (attached hereto as Exhibit B) (collectively, the “Asserted Patents”) alleging, based on its own knowledge as to itself and its own actions, and based on information and belief as to all other matters, as follows:

**PARTIES**

1. Topdown is a limited liability company formed under the laws of the State of Texas, with a principal place of business at 6001 W Palmer Ln, Ste 370 #1071, Austin, TX 78727.

2. Defendant is a company organized and existing under the laws of the state of Delaware with its principal place of business 316 South Service Road, Melville, N.Y. 11747. Defendant conducts business in and is doing business in New York and in this District and elsewhere in the United States, including, without limitation, using, promoting, offering to sell, importing and/or selling Kaoss DJ controller with Serato DJ intro software (collectively “Accused Product”), and enabling end-user purchasers to use such devices in this District. Upon information and belief, Defendant may be served at the above address.

**JURISDICTION AND VENUE**

3. This is an action for infringement of a United States patent arising under 35 U.S.C. §§ 271, 281, and 284–85, among others. This Court has subject matter jurisdiction of the action under 28 U.S.C. §§ 1331 and 1338(a).

4. Venue is proper in this district under 28 U.S.C. §§ 1400(b). Defendant has a place of business within this judicial district and has committed the acts complained of therein.

5. Defendant is subject to this Court’s specific and general personal jurisdiction under due process and/or the New York Long Arm Statute due at least to Defendant’s substantial business in this forum, including: (i) at least a portion of the infringements alleged herein; and (ii) regularly doing or soliciting business, engaging in other persistent courses of conduct, and/or deriving substantial revenue from goods and services provided to individuals in New York and in this district.

**U.S. PATENT NO. 8,178,773**

6. U.S. Patent No. 8,178,773, titled “System and Methods for the Creation and Performance of Enriched Musical Composition,” teaches a system which provides for associating content with one or more triggers and provides user interfaces for causing content to be presented to an audience.

7. On May 15, 2012, the ’773 Patent was duly and legally issued by the United States Patent and Trademark Office.

8. In the prior art, the goal of a performer is to “accurately and consistently reproduce the content”. ’773 Patent at 3:5-6. In contrast, the ’773 Patent allowed the performer “the freedom to innovate and create new and unique performances using the same program.” *Id.* at 3:7-10. “For example, the performer can control the timing with which some or all content segments are

presented to the audience, can transpose content, and otherwise control the performance.” *Id.* at 3:9-13. This is accomplished through triggers which “will cause the content selected by the composer as background content to be presented.” *Id.* at 3:13-24.

9. This functionality was at least unconventional as of the priority date of the invention. For example, even in 2014 the functionality disclosed in the ’773 Patent was considered unconventional. *See, e.g., Musical Meshworks: From Networked Performance to Cultures of Exchange* available at <https://dl.acm.org/doi/pdf/10.1145/2598510.2598583> (describing similar functionality to that claimed as unconventional); *See also* Declaration of Bencar, attached hereto as Exhibit C.

10. Topdown is the owner of the ’773 Patent with all substantive rights in and to that patent, including the sole and exclusive right to prosecute this action and enforce the ’773 patent against infringers, and to collect damages for all relevant times.

11. The ’773 Patent is valid and enforceable under United States Patent laws.

**U.S. PATENT NO. 7,858,870**

12. U.S. Patent No. 7,858,870, titled “System and Methods for the Creation and Performance of Sensor Stimulating Content,” teaches a system which provides for associating content with one or more triggers and provides user interfaces for causing content to be presented to an audience.

13. On December 28, 2010, the ’870 Patent was duly and legally issued by the United States Patent and Trademark Office.

14. Topdown is the owner of the '870 Patent with all substantive rights in and to that patent, including the sole and exclusive right to prosecute this action and enforce the '870 patent against infringers, and to collect damages for all relevant times.

15. The '870 Patent is valid and enforceable under United States Patent laws

**COUNT I – INFRINGEMENT OF U.S. PATENT NO. 8,178,773**

16. Defendant makes, uses, imports, provides, supplies, distributes, sells and/or offers for sale the Accused Product, including, for example, at least the Kaoss DJ controller with Serato DJ intro software, which infringe one or more claims of the '773 Patent when placed into operation.



[https://www.korg.com/us/products/dj/kaoss\\_dj/download.php](https://www.korg.com/us/products/dj/kaoss_dj/download.php)

17. By doing so, Defendant and its end users have directly infringed (literally and/or under the doctrine of equivalents) at least Claim 1 of the '773 Patent. Defendant's infringement in this regard is ongoing.

18. For example, when placed into operation by Defendant and its end users the Accused Product infringe claim 1 of the '773 Patent. When used, the Accused Product comprise a music instrument configured to allow a user to compose interactive musical sounds, comprising: a plurality of triggers (e.g., hardware triggers on turntable such as knobs, buttons, sliders, etc. and software triggers through companion app) configured to be controlled by a user; a processor (e.g., a processor of a user's smartphone or tablet enabled with the Serato DJ intro software) configured to be controlled by a graphical user interface ("GUI") (e.g., Defendant and its end users install and use the Serato DJ intro software which includes a GUI,); a controller (e.g., the Kaoss DJ controller) responsive to the plurality of triggers (e.g., hardware triggers on turntable such as knobs, buttons, sliders, etc.), and configured to generate control signals (e.g., control signal generated corresponding to associated functionalities of triggers) as a function of the triggers (e.g., hardware/software trigger such as knobs, buttons, sliders, sync button, etc.) selected by the user; a plurality of music (e.g., one or more music tracks, beats), wherein each said music program is mapped and composed into related components (e.g., one or more music tracks are mapped to a particular deck and different parts of said tracks can be mapped to cue points) and configured to play sympathetic sounds in real time (e.g., the beat sync functionality provides the smooth mix between one or more music tracks and/or its cues in order to generate sympathetic sound in real time) the processor configured to generate an electronic signal (e.g., instructions to produce sound according to music tracks and triggers) as a function of the controller control signals (e.g., control signal generated by Kaoss DJ controller cross feeder movement to match beat structure) and the related components of the plurality of mapped and composed music programs (e.g., one or more cue points such as hot cue); and at least one sound generator (e.g., speakers or headphones connected with the Kaoss DJ controller) configured to generate the sympathetic sounds as a

function of the related components of the mapped and composed music programs (e.g. one or more music tracks are mapped to a particular deck or cue points, and the transition FX and/or sync functionality creates a smooth mix between one or more music tracks or cues in order to generate sympathetic sound). *See* Ex. A-1, Figs. 1-12.

19. Topdown has been damaged as a result of the infringing conduct by Defendant alleged above. Thus, Defendant is liable to Topdown in an amount that adequately compensates Topdown for such infringements, which, by law, cannot be less than a reasonable royalty, together with interest and costs as fixed by this Court under 35 U.S.C. § 284.

20. Topdown and/or its predecessors-in-interest have satisfied all statutory obligations required to collect pre-filing damages for the full period allowed by law for infringement of the '773 Patent.

**COUNT II – INFRINGEMENT OF U.S. PATENT NO. 7,858,870**

21. Defendant makes, uses, imports, provides, supplies, distributes, sells and/or offers for sale the Accused Product, including, for example, at least the Kaoss DJ controller with Serato DJ intro software, which infringe one or more claims of the '870 Patent when placed into operation by Defendant or its end users.



[https://www.korg.com/us/products/dj/kaoss\\_dj/download.php](https://www.korg.com/us/products/dj/kaoss_dj/download.php)

22. By doing so, Defendant and its end users have directly infringed (literally and/or under the doctrine of equivalents) at least Claim 18 of the '870 Patent. Defendant's infringement in this regard is ongoing.

23. Defendant and its end users have infringed claim 18 of the '870 Patent by using, importing, providing, supplying, distributing, selling or offering for sale the the Kaoss DJ controller with Serato DJ intro software. For example, the Accused product and companion software when placed into operation by Defendant or its end users is a music instrument configured to allow a user to compose musical sounds (e.g., composing sounds by mixing music and cue point selection), comprising: a plurality of triggers (e.g., hardware triggers on turntable such as knobs, buttons, sliders, etc. and software triggers); a control module responsive to the plurality of triggers (e.g., in the case of hardware triggers on the turntable such as knobs, buttons, sliders, etc., the accused product will utilize a combination of hardware and software to detect and respond to user initiation of a trigger; in the case of software triggers made through the companion app, the user device, such as a phone or tablet, will utilize both software and hardware to detect and respond to

user initiated software triggers); a plurality of music programs (e.g., one or more music tracks, or beats), the control module (e.g., controller board of the accused product) configured to generate electronic signals (e.g., instructions to produce sound according to music tracks and triggers) as a function of the plurality of music programs (e.g., ., one or more music tracks, beats) and the plurality of triggers (e.g., hardware triggers on turntable such as knobs, buttons, sliders, etc. and software triggers through companion app), wherein each said music program (e.g., one or more music tracks, beats) comprises sound elements comprising a subset of a predetermined musical composition (e.g., various music tracks beats, and one or more cue points within said tracks will be combined to create a musical composition as a whole); and a sound generator (e.g., speakers or headphones connected to the Kaoss controller) configured to generate synchronized sympathetic audible musical sounds as a function of the electronic signals (e.g. instructions to produce sound according to music tracks and triggers). *See* Ex. B-1, Figs. 1-12.

24. Topdown has been damaged as a result of the infringing conduct by Defendant alleged above. Thus, Defendant is liable to Topdown in an amount that adequately compensates Topdown for such infringements, which, by law, cannot be less than a reasonable royalty, together with interest and costs as fixed by this Court under 35 U.S.C. § 284.

25. Topdown and/or its predecessors-in-interest have satisfied all statutory obligations required to collect pre-filing damages for the full period allowed by law for infringement of the '773 Patent.

### **COUNT III – INDUCED INFRINGEMENT**

26. Defendant has been and/or currently is an active inducer of infringement of the Asserted Patents under 35 U.S.C. § 271(b).

27. Defendant has had knowledge of the Asserted Patents and that the Kaoss DJ

controller with Serato DJ intro software infringe since at least the filing of this complaint.

28. Defendant has continued to provide the Kaoss DJ controller and instructions to use the companion Serato DJ intro software to its customers and, on information and belief, instructions to use the Accused Instrumentalities in an infringing manner while being on notice of the Asserted Patents and Defendant's infringement. Therefore, Defendant has known of the Asserted Patents and of its own infringing acts since at least the filing of this complaint.

29. Defendant knowingly and intentionally encourages and aids at least its end-user customers to directly infringe the Asserted Patents.

KAOSS DJ

## Preparations

The KAOSS DJ Controller can quickly connect to your computer using a single USB cable. Once connected, the KAOSS DJ can be used as both a custom control surface for effectively using the Serato DJ Intro software, and as an integrated USB digital audio interface. The sliders, buttons, touch wheels, and the dual-axis X-Y touchpad offer effortless performance software control, as well as the ability to apply KAOSS effects directly to the software audio. To get started, you will need to download and install the Serato DJ Intro software.

### 1. Downloading and Installing the Korg ASIO Audio Driver

If you use the audio driver that is built into Windows, you might notice some latency, or delay, in the audio output. To improve the audio response time, you can use "Korg 4ch Audio driver," a low-latency ASIO driver.

#### Downloading and installing the driver

Download the Korg 4-Channel Audio Driver installer from the Korg website. The downloaded file will include the installation instructions.

### 2. Downloading and Installing Serato DJ Intro

In order to use Serato DJ Intro, download the software from the Serato Corporation website and install it. Serato DJ Intro is DJ software made by the Serato Audio Research.

#### Installing Serato DJ Intro (Windows)

1. Access the download page (<https://serato.com/dj-intro/downloads>) and click "Download Serato DJ Intro."
2. If you already have a Serato.com ID, enter your email address and password to log on, and then proceed to step 5.
3. If you do not yet have a Serato.com ID, enter your email address and click Continue to proceed to the registration screen. Once you have entered the necessary information as directed, please and click Continue, an email will be sent to the address you have entered.
4. In the email you receive, click "Verify" to complete your Serato.com registration.
5. Select "KORG KAOSS DJ" as the controller that you're using, and then click Continue to automatically download a Zip file containing the installer. (If the download does not start automatically, click "start the download manually.")
6. Decompress the downloaded Zip file, and start the installer. Proceed as directed to install Serato DJ Intro.

<https://www.korg.com/us/support/download/manual/0/439/2020/>

30. Defendant's end-user customers directly infringe at least one or more claims of the Asserted Patents by using the Accused Product and the companion software in their intended manner to infringe. Defendant induces such infringement by providing the Accused Product and

the companion software and instructions to enable and facilitate infringement, knowing of, or being willfully blind to the existence of, the Asserted Patents. On information and belief, Defendant specifically intends that its actions will result in infringement of one or more claims of the Asserted Patents, or subjectively believe that their actions will result in infringement of the Asserted Patents.

31. Defendant's infringement of the Asserted Patents is exceptional and entitles Topdown to attorneys' fees and costs incurred in prosecuting this action under 35 U.S.C. § 285.

32. Topdown is in compliance with any applicable marking and/or notice provisions of 35 U.S.C. § 287 with respect to the Asserted Patents.

33. Topdown is entitled to recover from Defendant all damages that Topdown has sustained as a result of Defendant's infringement of the Asserted Patents, including, without limitation, a reasonable royalty.

### **PRAYER FOR RELIEF**

WHEREFORE, Topdown respectfully requests:

A. That judgment be entered that Defendant has infringed at least one or more claims of the '773 and '870 Patents, directly and/or indirectly, literally and/or under the doctrine of equivalents;

B. An award of damages sufficient to compensate Topdown for Defendant's infringement under 35 U.S.C. § 284, including an enhancement of damages on account of Defendant's willful infringement;

C. That the case be found exceptional under 35 U.S.C. § 285 and that Topdown be awarded its reasonable attorneys' fees;

D. Costs and expenses in this action;

- E. An award of prejudgment and post-judgment interest; and
- F. Such other and further relief as the Court may deem just and proper.

**DEMAND FOR JURY TRIAL**

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Topdown respectfully demands a trial by jury on all issues triable by jury.

Dated: April 30, 2021

Respectfully submitted,

*/s/Nicholas Loaknauth*  
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