

other. Any of them might be infringed without infringing any of the others. The trial of the validity of each, and of the infringement of each, must be separate from that of the others, upon distinct issues as to each. The facts may be proved by the same witnesses, but, if so, it will be on account of identity of persons in connection with the subject rather than because of the sameness of the issues involved in the subject. That they are used in the same system does not change the nature of the issues to be tried. They are distinct parts of the system. Each patent is for a distinct machine, or process, or manufacture, and must stand or fall as such; and the infringement of each must or may be a separate trespass. The bill apparently covers as many causes as there are patents, when it should cover but one. *Hayes v. Dayton*, 18 Blatchf. 420; S. C. 8. FED. REP. 702.

The demurrer is sustained and the bill adjudged insufficient.

UNTERMEYER v. JEANNOT and others.

(Circuit Court, S. D., New York. June 6, 1884.)

PATENT LAW—DESIGN—FIGURES IN RELIEF—PHOTOGRAPH.

The prominent claim in a patent design being figures in relief, a photograph of the design, since it does not show the relief, does not sufficiently describe the design in the absence of a minute description in the specifications.

In Equity.

Rowland Cox, for orator.

Birdseye, Cloyd & Bayless, for defendants.

WHEELER, J. This suit is brought upon design patent No. 12,485, dated September 20, 1881, and granted to the orator for a watch-case. The design consists in the representation of a locomotive engine and tender upon a railroad track, with ornamental plants in the foreground, the whole surrounded by a ring of dots and an ornamental border. There are two claims: one, for the engine and tender on the track, and ornamental plants; and the other, for the same, surrounded by the ring of dots and ornamental border. An accompanying photograph of a watch-case shows the style of locomotive, tender, and track, the form of the plants, the size and frequency of the dots, and the characteristics of the border; but none of these are described in the specification or claims, except by name. The engine and tender and some of the other parts are said to be shown in relief; and the alleged infringement shows the same in relief. There were watch-cases before having representations of locomotives and tenders on railroad tracks, surrounded by wreaths and ornamental borders and rings of dots, and engines with flowers in the foreground surrounded by scroll-work and borders, but none with such work in

relief, unless cases like the alleged infringement were made before, as the defendants' evidence tends to show. With these things in existence before, the orator could not have a valid patent for anything but his peculiar design as distinguished from the former designs. *Ry. Co. v. Sayles*, 97 U. S. 554. The alleged infringement has a line of fence-posts between the plants and railroad track; they are not surrounded by a row of dots, but are by an ornamental border. The design, therefore, is not exactly the orator's design. The form of the defendants' case, the view of the engine, and the workmanship are very much like the orator's. These similarities, in connection with the fact that the same parts in each are made in relief, bring the cases to near enough alike to lead a common observer, having the interest of a customer, to think they were the same when seen at different times. But the orator is not entitled to, and is not seeking, any relief on account of imitation of his goods or workmanship. Relief against infringement of his patent is all that he can properly or does ask here. If the photograph does not show parts in relief, the claims are neither of them for those parts in relief.

Miller v. Smith, 5 FED. REP. 359, is relied upon to show that representation in the photograph would be sufficient without description in the patent or claim. That case, as reported, however, does not appear to hold the photograph to be sufficient alone. The language of the opinion seems to imply that there was further description, and a claim accordingly.

The claims are the essential parts which the public are to look to and scrutinize to ascertain their rights, and must control. *Burns v. Meyer*, 100 U. S. 671. Taking out the raised features, and comparing the defendants' case with the orator's patent, instead of with the manufacture, and infringement will hardly appear. The design is not the orator's design, as patented, nor sufficiently like it to present the same substantial appearance to purchasers. The defendants, therefore, do not infringe.

Let there be a decree dismissing the bill of complaint, with costs.

NEW YORK GRAPE SUGAR CO. v. BUFFALO GRAPE SUGAR CO. and others.

SAME v. AMERICAN GRAPE SUGAR CO. and others.

(Circuit Court, N. D. New York. June 2, 1884.)

PATENT LAW—AMENDMENT OF BILL—ASSIGNED CLAIMS FOR DAMAGES.

The assignee of a patent, in an action against an alleged infringer, can move, before the signing of an interlocutory decree, to amend his bill so as to include the subject of assigned claims for damages and profits which were due to mesne assignors, the bill having been brought, answered and tried upon the theory that a recovery upon the assigned claims was sought.

Motion to Amend Bills.

E. N. Dickerson, for plaintiff.

George Harding and Franklin D. Locke, for defendants.

SHIPMAN, J. In these cases the plaintiff moved, before the signature of the interlocutory decree, to amend each bill by the insertion of averments that the assignment of the letters patent, which are the subject of the respective bills, also conveyed to the plaintiff and present owner the right of recovery for prior infringements of said letters, both in regard to profits and damages, during the previous life of the patents, and by the insertion of a prayer for an accounting for the infringement by the defendants of the letters patent from the date of the issuing of them, severally, and for the violation of the rights of the mesne assignors, and each of them. The motion has been argued solely upon the propriety of allowing the amendments, and not upon the effect of the allowance, if made, upon the decree. The counsel for the plaintiff asks for the amendments upon this ground. He admits that, as a general rule, an amendment which changes the character of the bill, or which introduces a new cause of action, ought not to be allowed, especially after the bill has been heard, (*The Tremolo Patent*, 23 Wall. 518;) but he says that these bills were brought, not only for an injunction and for an accounting in respect to the amount which the plaintiff, as an owner of the patent, should recover, but to recover the assigned claims for damages and profits; that the plaintiff supposed that the averments were sufficient; that all the equitable objections to a recovery for infringements prior to the plaintiff's purchase were set up in the answer; and that the defendants knew that a recovery upon the assigned claims was sought. I think that these positions are true. In view of the history of the case, it is not possible that the plaintiff brought its bills without intending to include, and supposing that it had included, the subject of the assigned claims for the damages and profits which were due to the mesne assignors, although I am clearly of opinion that the averments of the bills did not include such claims. It is also true that the defendants knew that a recovery for such claims was sought, and defended against them. Under these