

## 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

circumstances, I think that, the allowance of the amendments being within the power of the court, it is its duty to allow them; and that to refuse the allowance would be an improper precedent. The question will hereafter arise as to the propriety of a decree for an account of the profits, or an assessment of the damages which accrued before the purchase of the patents.

The motion is granted.

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**REAY v. BERLIN & JONES ENVELOPE CO.**

(*Circuit Court, S. D. New York. June 10, 1884.*)

**PATENT—IMPROVEMENT IN ENVELOPE-MAKING MACHINE.**

Claim in the patent being for improvement in envelope-machine in respect to the table over the conveyor, whereby the blanks are held in place while being carried by the conveyor to the creasing box, the alleged infringer may continue the use of the machine, the table and conveyor being changed, such use not being inconsistent with the claimant's rights.

**In Equity.**

*Arthur v. Briesen*, for orator.

*Stephen D. Law*, for defendant.

**WHEELER, J.** The second claim of the orator's patent for improvements on envelope machines is for the arrangement of the table over the conveyor so that the blanks are held even and in place by the table while being carried by the conveyor to the creasing box. The defendant was enjoined not to use several machines having this arrangement, made in violation of that claim of the patent. 19 FED. REP. 310. The table and conveyor were changed and the use continued. These proceedings are instituted against that use as a contempt of the injunction. The question is whether that claim covers any more of the machine than the table and conveyor. The defendant was in good faith advised that it did not, and continued the use in the assertion of supposed rights without intending to violate any order of the court. The orator claims that the claim covers the parts which operate in connection with the conveyor and table. The creasing box was old. The blank is made ready to be taken by the conveyor in the defendant's machines by contrivances different from the orator's. The blanks, when ready, were to be taken to the creasing box. This claim was for the arrangement of mechanism to accomplish that object. When the blank reaches the creasing box another operation upon it begins. The table and conveyor finish with each blank when it arrives there, and have nothing to do with the next operation upon it, which is to crease it. The arrangement of the table over the conveyor, to steady the blank while on the conveyor, affects nothing but the work-