EASTMAN v. BODFISH.

Case No. 4,255.

{1 Story, 528;[1] 2 Robb, Pat. Cas. 72.}

Circuit Court, D. Maine. May Term, 1841.

EXTENSION OF PATENT—INFRINGEMENT—PLEADING—SEPARATE COUNTS FOR CLAIM UNDER EXTENSION AND ORIGINAL PATENT.

1. Where a patent for the circular saw clapboard machine expired by lapse of time on the 15th of March, 1834, and congress by the act of 3d of March, 1835, c. 86, renewed it to A for the space of seven years, from the time when it expired, and the declaration in the writ, which was dated on the 13th of January, 1838, recited the original patent and the subsequent act of congress, and then stated generally a violation of the patent right for a long time, to wit, for the space of three years and eight months, next preceding the date of the writ; It was *held,* that if the plaintiff intended to claim under the old patent, he should have filed a distinct and independent count; and that he had restricted himself to proof of a violation of the patent right during the space of the said three years and eight months, specified in the declaration.

{Cited in Lepage Co. v. Russia Cement Co., 51 Fed. 949.}

2. Whenever time is material, whether in matters of contract, or of tort, the plaintiff is strictly bound by the time specified in the declaration.

Case for infringement of a patent right "for a new and useful invention called the circular saw clapboard machine." The cause was tried upon the general issue. The original patent was granted to the plaintiff, Eastman, and one Josiah Jaquith, as the original inventors, on the 16th of March, 1820. The patent expired by lapse of time; and congress by the act of 3d of March, 1835, c. 86 {6 Stat. 613}, Jaquith being then dead, granted to the plaintiff, as survivor, the full and exclusive right and liberty of making, constructing, and vending to others, to be used, the same invention for the term of seven years, from the 15th of March, 1834, when the original patent expired. The declaration was founded upon the act of 1835 (chapter 68), and after reciting the original patent and the act of congress of 1835, and the new patent granted under the same, alleged as a breach, that the defendant "unlawfully, against the will of the plaintiff, and without any permission or license of the plaintiff, in infringement of the right and privilege secured to the plaintiff by the letters patent, &c., did make, construct, and use and vend to others to be used, the said saw and useful invention and continue the use thereof for a long time previous to the date of the writ, to wit, for the space of three years and eight months next preceding the date thereof." The writ was dated the 13th of January, 1838.

Mr. Deblois, for plaintiff, contended, that he was entitled under the allegations in the declaration, to go into evidence to establish, a violation of the patent by the defendant, under the original patent which had expired, as well as under that of the act of 1835.

Fox & Codman, a contrâ, insisted, that the plaintiff could not go into evidence of any such violation of the original patent; but was confined to the time, since the grant of the

patent under the act of 1835; and at all events, that the breach itself tied up the inquiry to the period of three years and eight months before the date of the writ.

STORY, Circuit Justice. I have no doubt whatsoever in the present case. By the frame of the declaration, the right of action is exclusively founded upon the act of 1835; and there is nothing in the declaration, which points to any breach under the old patent, which expired on the 15th of March, 1834. In short, I cannot understand, that the declaration purports to found any claim under the old patent, but the latter is merely recited as introductory to the right and title under the act of 1835, and the violation thereof. If the plaintiff intended to have made any claim under the old patent, he should have filed a distinct and independent count. Moreover, I am of opinion in this case, that the plaintiff has by the breach, as stated in the declaration, tied himself up to a violation of the patent right within three years and eight months before the date of the writ; that is, before the 13th of January, 1838. In cases under the patent laws, I conceive, that the plaintiff is confined to giving evidence of the making, constructing, or using the invention in violation of his patent right during the period, which he specifies in his declaration. If It were otherwise, the recovery in the suit would be no bar to another action for any anterior breach, since it could not judicially appear, that any damages had been recovered for any such anterior breach; and the form of the declaration itself, specifying the term, would repel any presumption to the contrary. Besides, the length of time of the use is, or at least may be, a very material ingredient in the ascertainment and assessment of the damages by the jury; and the plaintiff ought to give notice by his declaration of the term of the user, for which he seeks damages. It is by no means true, that the specification of time is in all cases immaterial to be proved, as laid in the declaration. Wherever time is material, not only in matters of contract, but in matters of tort, the plaintiff is strictly bound by that time. Now, in trespass with an allegation of a continuando, or diversis diebus, if the plaintiff insists upon proving repeated acts of trespass, he will not be allowed to give evidence thereof, unless committed within the time specified. 1 Chit. Pl. (3d Ed.) p. 258; 1 Wms. Saund. p. 24, note 1; Brook v. Bishop, 2 Ld. Raym. 823; Monckton v. Pashley, Id. 974, 976; Com. Dig. "Pleader," C, 19; 2 Starkie, Ev. (2d Lond. Ed.) 210. In truth, the usual mode of declaring in actions for an infringement of a patent is, to allege, that the defendant on such a day (naming it) "and on divers other days and times between that day and the day of the commencement of the suit (or exhibiting the bill) did unlawfully, &c. make and sell and use, &c." 2 Chit. Pl. (3d Ed.) pp. 356, 357; Phil. Pat. (Ed. 1837) p. 522. The District Judge concurred in this opinion.

Mem. The cause afterwards proceeded before the jury, who found a verdict for the defendant.

[1] {Reported by William W. Story, Esq.}