for less than the sum to which he appears entitled by the allegations in the body of the declaration.

Taking in the present case the certificate of the judge below as correct, the amount in controversy—that is, the debt alleged in the original declaration—did not exceed one thousand dollars; the jurisdiction is not therefore acquired by this court from the amendment in the amount of the damages claimed. The writ of error is

DISMISSED.

BLOOMER *v.* MILLINGER.

1. A grant of a right by a patentee to make and use, and vend to others to be used, a patented machine, within a term for which it has been granted, will give the purchaser of machines from such grantee the right to use the *machine patented* as long as the machine itself lasts; nor will this right to use a machine cease because an extension of the patent, not provided for when the patentee made his grant, has since been allowed, and the machine sold has lasted and is used by the purchaser within the term of time covered by this extension; the rule being distinguishable from that applied to the assignee of the right to *make and vend* the thing patented, who holds a portion of the franchise which the patent confers, and whose right of course terminates with the term of the patent, unless there is a stipulation to the contrary.
2. *Bloomer* v. *McQuewan* (14 Howard, 539), and *Chaffee* v. *The Boston Belting Co.* (22 Id., 217), approved.
3. How far parol proof may be introduced to show verbal agreements of the parties at the time when deeds were executed, and so to prove mistake or fraud in not executing what it was understood should be executed. The question raised on argument, but not decided by the court.

BLOOMER, the appellant here, filed a bill in equity in the Circuit Court for the Western District of Pennsylvania. He set forth in it that he was owner of the exclusive right to make and use, and vend to others to be used, within the county of Alleghany, in Pennsylvania, the patented planing machine of Woodworth; that subsequently *to the 27th December*, 1849, and about the 1st January, 1850, the respondent, Millinger, had put in operation in that county, three of these machines, and was continuing to use them without any law-

ful authority. The prayer was for an account, and for an injunction against the use of these three machines.

The case, as appearing by the bill and answer, was thus:

On the 27th December, 1828, letters patent were granted to Woodworth for an improved planing machine for fourteen years, that is to say, up to 27th December, 1842.

On the 16th November, 1842 (Woodworth himself being dead, but his estate being represented by an administrator), an extension of the patent was granted by the *Commissioner* or *Board of Commissioners of Patents*, for the term of *seven* years from the expiration of the original patent; that is to say, *from the 27th December*, 1842, *to the 27th of December*, 1849.

On the 2d June, 1843, the administrator of Woodworth, by deed (called, in the argument, Exhibit A), reciting "the extension of said letters patent for the term of *seven years* from and after the expiration of said patent," sold and conveyed to one *William* Lippincott, his heirs and assigns, the right to construct and use, and vend to others to construct and use, "during the *said* extension," the patented machine, within the county of Alleghany, in the State of Pennsylvania; covenanting that such right should be exclusive throughout the limits specified, during the "term aforesaid."

On the 26th February, 1845, *Congress*, by act, granted an extension of the patent for the term of *seven years from the expiration of the extension granted by the commissioner;* and on the 14th of March following, the administrator sold and conveyed his interest in the "letters patent and the franchises thereby granted and secured," for "the said term of *seven years created and extended by Congress*," to one Wilson; a second deed—not specially important in the case, but to the same effect exactly, that is to say, for the term of seven years created and extended by the said *act of Congress*—being made July 9, 1845, and after the patent had been surrendered for a defective specification.

Wilson was thus invested with the interest under the second or Congressional extension, but with nothing more.

In this state of things, *William Lippincott*, still holding his right under the deed of 2d June, 1843 (called Exhibit A), for

Alleghany County, under the extension granted by the *commissioner*, conveyed *it*, on the 10th April, 1846, to James Lippincott and one Millinger, the present defendant; and by a second instrument (called Exhibit B), dated three days afterwards (13th April, 1846), the *administrator*, reciting that in consequence of the surrender and renewal of the patent, doubts had arisen as to rights given by instruments executed prior to the reissue, licensed and empowered this same Lippincott and Millinger "to construct and use exclusively the patented machine in the county of Alleghany, ... and also within said territory to license and empower any other person or persons to construct and use machines *for the term of time for which the patent was extended by the Board of Commissioners hereinbefore referred to; being for the term of seven years and no longer from and after the expiration of the original term of fourteen years.*" The deed declared that the administrator intended thereby "to confirm . . . . all right, title, and interest to construct and use, and the right to license others to construct and use said machines," which had been granted *by the indenture of 2d June*, 1843 (Exhibit A), and concludes thus: "No other, or greater, or other, or further grant or conveyance is hereby made, &c., than was granted by the indenture aforesaid, and upon the same terms and conditions."

Lippincott and Millinger were thus vested with the right for Alleghany County under the commissioner's extension, in such way as given by the deeds already mentioned.

On the 24th June, 1847, the administrator granted to *Bloomer* (the complainant) his "full consent, permission, and license to construct and use, and vend to others to construct and use," the patented invention "during *the two* extensions," within that part of Pennsylvania, west of the Alleghany Mountains, "excepting Alleghany County, for the first extension;" this "first extension" being that which had been previously granted to Lippincott and Millinger, the respondent in this suit. And on the 2d September, 1847, this same Lippincott and Millinger, by indorsement upon the administrator's deed of 13th April, 1846, conveying it *to them*, conveyed

to him, Bloomer aforesaid, whatever rights in the patent they held; Bloomer, however, stipulating that he would in no way interfere with certain machines mentioned in the transfer as belonging, &c., one to A., and one to B., &c., "nor interfere in any manner with the use of the *three* machines now erected, and in operation and use by the said *Millinger;* but the right, title, and use of the machines of the persons hereinbefore named, shall remain and be in them or their assigns for and during the time limited by the *written instruments.*"

In addition to this deed indorsed—from Lippincott and Millinger to Bloomer, of 2d September, 1847—these same parties, Lippincott and Millinger, executed on the 10*th January*, 1848, still another deed to Bloomer, by which they assigned to him "all their right, title, and interest in and to the said planing patents . . . . within said county of Alleghany, as fully as the same is vested in us by force of the several hereinbefore recited conveyances,* and giving to the said Bloomer and his assigns full power and authority to construct and use, and vend to others to construct and use, said patent as aforesaid, within said county . . . . for and during the full end and term of time unexpired and yet to come of said extension of said patent, to wit, until the 27th day of December, 1849."

And on the same day, Bloomer, the complainant, executed a deed, giving to Millinger, the respondent, "his full consent, and permission, and license to construct and use, and vend to others to construct and use, *during the first extension herein set forth*, to wit, from the 27*th day of December*, 1842, *until the* 27*th day of December*, 1849, the right to use the said renewed patent, and to vend to others to use *three* planing machines upon the principle, plan, and description of the said renewed patent and amended specifications, within the county of Alleghany." *How far Millinger had accepted this deed was not so plain.*

* These were the deeds of June 2, 1843 (Exhibit A), that of 10th April, 1846, and that of 13th April, 1846 (Exhibit B).

In addition to the defence, as already indicated, from the pleadings, Millinger, the respondent, by his answer, averred and offered to prove that when the reassignment of 10th January, 1848, from Lippincott and himself to Bloomer, was executed, Bloomer agreed that he would execute to Millinger "a deed of assignment of the right to the said extension, so far as regarded the three machines," and "the said deed of assignment from the said Bloomer"—Millinger's answer went on to say—"was to be executed by the two parties, and was to be so worded as that respondent should have all the rights and privileges, and was to stand precisely in the position as to the rights, enjoyments, and privileges, as respected the patent right to said three machines, as if the assignment from respondent and Lippincott had never been made, and so as to place the respondent in the same situation as he would have stood under the assignment of the 2d of June, 1843, or by any other agreement between the parties, and to all the benefit of any renewals to which respondent would have been entitled under the assignment of said extension by the Commissioner of Patents, on the 2d of June, 1843, or any other agreement between the parties;" that the plaintiff, in fulfilment of the verbal agreement, did execute a deed, left it at the place of business of the respondent, and that he refused to accept or sign the same, because it did not carry out the alleged agreement.

Some parol evidence was taken on behalf of the respondent, to substantiate these allegations. But the complainant's general right, and the use of the three machines by the respondent, Millinger, *after the expiration of the term of extension granted by the commissioner*, was not denied.

The court below dismissed the bill; and on appeal here, two principal questions—in substance these—were made:

1. Whether, under the deeds of June 23d, 1843 (Exhibit A), conveying to the assignor of Millinger, in such strict terms, a right to the extension of the patent for but *seven years*, and the deeds of 10th and 13th April, 1846 (Exhibit B), by which this right was conveyed, in such like terms, to Millinger—taken in connection with Bloomer's stipulation

of 13th April, 1846, and his deed of 10th January, 1848, that Millinger should use his three machines during the said term for which the patent had been extended by the commissioner —Millinger could use his machines after the expiration of that term, and during the new term for which an extension had been granted by Congress.

2. If he could not do so under the deeds as set forth in the pleadings, he could introduce parol evidence to show what he alleged in his answer and offered to prove, as to the license intended to have been executed by Bloomer on the 10th January, 1848.

Messrs. Seward, Norton, and Blatchford, for the appellant, Bloomer:

1. The intent with which the agreement was made is but a convertible term for its legal operation, and that legal operation is to be affixed by the law to the language used by the parties, irrespective of the intent with which they used such language. The inquiry never arises upon the evidence —"what did the parties intend to do?"—if the written agreement which they made is susceptible of legal interpretation. The conclusion is, that they intended just what the law interpreting their agreement says that they have done. If this rule be so, it excludes from the consideration of the court the parol evidence introduced by the respondent, and leaves for the adjudication of the court, the single question of law, viz.: "Has the respondent, under these instruments, either by their proper interpretation or by operation of general law, the right to continue to use, *during the extension of the patent by Congress*, the three machines which he constructed and was lawfully in use of during the extension by the *commissioners?*"

2. The fact that the subject of the contract is a right in or an interest under a patent, does not take the case out of the law applicable to the law of contracts generally. The owner of a patent may make any agreement with regard to its enjoyment that he may make in regard to any other species of property. It is competent, therefore, for the owner of a pa-

tent right to carve out of his entire monopoly such fractional interest therein, either as to absolute right, or as to territorial extent, or as to duration of right, as he may see fit.

Applying this principle, it appears that the respondent never acquired, by voluntary grant from any of the owners of either the original or extended patent, any right to continue to use the thing patented during the extension of the patent *by Congress*. If there be language which can define the intent of the grantor to be, that he parts with a right under his patent for a specified number of years only, that language will be found in both of the instruments under which the respondent was rightfully in use of his three machines during the first extension of the patent. In Exhibit A, the first instrument (that of 2d June, 1843), by the administrator to William Lippincott, the respondent's assignor, the grant was of a "right and license to construct, use, and vend to others to construct and use, *during the said extension of the aforesaid patent*," that extension being the one granted by the commissioners, and which expired on the 27th of December, 1849.

In the confirmatory instrument to the respondent, of the 13th of April, 1846 (known as Exhibit B), which was intended to convey the right under the amended specification attached to the reissued patent, the language is, "doth license and empower . . . *for the term of time for which the patent was extended by the Board of Commissioners hereinbefore referred to, being for the term of seven years, and no longer, from the expiration of the original term of fourteen years.*"

Probably *Bloomer* v. *McQuewan*,* decided by this court, will be relied on to support an opposite view. But we submit—*first*, that that case is inapplicable, and *second*, that it is not, under the circumstances of its decision, a binding authority.

1. The act of Congress places the case in the position in which it would have been had the patent been originally granted for twenty-eight years. If it had been so granted,

* 14 Howard, 550.

what right would the respondent have acquired by virtue of Exhibits A and B, executed respectively in 1843 and 1846? Clearly, the beneficial enjoyment of the patent for the period therein specified, expiring on the 27th of December, 1849, and nothing other or beyond. If he acquired any other or further right, he must have acquired it by virtue of some general law, and not by virtue of the contract, or of the act extending the patent. The respondent did not know, in 1843, when the first license was granted, that the patent would be extended by act of Congress, but he knew that it might be. He did know, in 1846, when the second license was executed, that the patent had been extended; and he accepted an instrument on that date, which expressed, by the use of proper language, the intention of the grantor to terminate the right granted, on the 27th day of December, 1849.

The respondent never occupied, during the first term of the patent, the position of the defendant in *Bloomer* v. *McQuewan*,—that is, he was not an "assignee," or "grantee," during the *original* term of the patent, of the right to use the thing patented.

By the Patent Act of 1836 (§ 18), it is provided, that the benefit of the renewal by the commissioner shall extend "to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein." In *Wilson* v. *Rousseau*,* it was the opinion of a majority of this court that, without this provision, "all rights of assignees or grantees, whether in a share of the patent, or to a specific portion of the territory held under it, terminate at the end of the fourteen years, and become reinvested in the patentee by the new grant." And, in construing this very act of 1845, Nelson, J., said in one case:† "If the extension for the second term had been absolute, that is, if there had been no reservation in the general act of 1836 in favor of assignees, as there is not in the special act of 1845, the court would not have entertained a doubt that the exclusive right to the invention during the second term would have been vested in

* 4 Howard, 646.

† Gibson *v.* Gifford, 1 Blatchford, 529.

the administrator." So, also, in another case,* where the assignments were similar to Exhibits A and B, he held that the defendant had no right to continue to use the machines under the extension by act of Congress. This view has been confirmed in other circuits.†

II. But it is submitted that *Bloomer* v. *McQuewan* should be re-examined. The opinion of the court in that case was pronounced by the present chief justice, and was concurred in by Justices Catron, Daniel, and Grier. Justices Nelson and McLean dissented. Justices Wayne and Curtis did not sit. So that the decision was really that of less than half of the court, there having been one vacancy by the death of Justice McKinley. Justice McLean, at the close of his dissenting opinion, says: "Sustained by the authority of seven justices of this court, and by an argument of the Supreme Court above cited, which I think is unanswerable, I shall deem it to be my duty to bring the same question now decided, when it arises in my circuit, for the consideration and decision of a full bench." It cannot be presumptuous to ask the court to give to the question a new investigation, in order that it may be submitted "for the consideration and decision of a *full bench.*"

The counsel then examined the decision on principle and authority.

Mr. Justice CLIFFORD, after stating the case, delivered the opinion of the court:

Counsel of the complainant concede that the machines

* Gibson *v.* Cook, 2 Blatchford, 144.

† In Bloomer *v.* Stolley, 5 McLean, 158, McLean, J., held that the defendant in that case acquired no right, under the act of Congress extending Woodworth's patent, to continue to use the machine which he had rightfully used during the second term of the patent. In Mason *v.* Talman (decided in Rhode Island, July, 1850), Woodbury and Pitman, JJ., followed the decision of Nelson and McLean, JJ., upon this point. The point was similarly decided by McKinley and McCaleb, JJ., in Bloomer *v.* Vaught (in Louisiana, February, 1850), by Ware, J., in Woodworth *v.* Barber (in Maine, April, 1850), and by Sprague, J., in Woodworth *v.* Curtis (in Massachusetts, January, 1850).

were constructed and put in operation by the consent and license of the assignees of the patentees, and that the respondent had the full right to continue to use and operate the same throughout the entire period of the extension granted by the Commissioner of Patents. But they deny that he had any right to continue to use or operate them under the second extension, which was granted by the act of Congress. All of those machines were constructed and put in operation before the act of Congress was passed, and of course under an authority founded upon the patent as it existed at the time the authority was conferred. Regarding the transaction in that point of view, the argument is, that the respondent could not lawfully continue to use and operate the machines under the extension granted by Congress, inasmuch as such a use of the invention was not in the contemplation of the parties when the respondent was authorized to construct them and put them in operation.

Two principal defences were set up by the respondent in the court below.

First, he insisted that inasmuch as he constructed the machines and put them in operation under the authority of the patentee or his assigns, with the right to continue to use and operate them during the entire term of the patent as it was then granted, he cannot now be deprived of the right to use the property which he was thus induced to purchase, and which he in that manner lawfully acquired.

Secondly, he insisted that the complainant, at the time the respondent transferred to him the right he acquired under the assignment to him of the 10th of April, 1846, agreed that he, the complainant, would execute to him, the respondent, a deed of assignment of the right to the extension in question, so far as respects the three machines now in controversy; and he insisted that parol proofs were admissible and sufficient to establish the fact of such an agreement. On the other hand, the complainant denies that any such agreement was ever made, and he also insists that parol proofs are not admissible to establish such a theory.

Confessedly, the latter question is one of difficulty, under

the circumstances, but it is wholly unnecessary to decide it in this case, as the respondent was and is clearly entitled to judgment upon the other ground. He constructed his machines, or caused them to be constructed, under the authority of the patentee or his assigns, and consequently must be regarded in the same light as a grantee or assignee under those who had the legal control of the patent. Builders of machines under such circumstances, have the same rights as grantees or assignees.

When the respondent had purchased the right to construct the machines and operate them during the lifetime of the patent as then existing, and had actually constructed the machines under such authority, and put them in operation, he had then acquired full dominion over the property of the machines, and an absolute and unrestricted right to use and operate them until they were worn out.

Patentees acquire the exclusive right to make and use, and vend to others to be used, their patented inventions for the period of time specified in the patent, but when they have made and vended to others to be used one or more of the things patented, to that extent they have parted with their exclusive right. They are entitled to but one royalty for a patented machine, and consequently when a patentee has himself constructed the machine and sold it, or authorized another to construct and sell it, or to construct and use and operate it, and the consideration has been paid to him for the right, he has then to that extent parted with his monopoly, and ceased to have any interest whatever in the machine so sold or so authorized to be constructed and operated. Where such circumstances appear, the owner of the machine, whether he built it or purchased it, if he has also acquired the right to use and operate it during the lifetime of the patent, may continue to use it until it is worn out, in spite of any and every extension subsequently obtained by the patentee or his assigns.

Provision is made by the eighteenth section of the act of the 4th of July, 1836, for the extension of patents beyond the time of their limitation. By the latter clause of that section

the benefit of such renewal is expressly extended to assignees and grantees, of the right to use the thing patented, to the extent of their respective interests therein. 5 *Stat. at Large*, 125. Under that provision it has repeatedly been held by this court that a party who had purchased and was using a patented machine, during the original term for which the patent was granted, had a right to continue to use the same during the extension. *Wilson* v. *Rousseau*, 4 How., 646. Founded as that rule is upon the distinction between the grant of the right to make and vend the machine, and the grant of the right to use it, the justice of the case will always be obvious, if that distinction is kept in view and the rule itself is properly applied.

Purchasers of the exclusive privilege of making or vending the patented machine in a specified place, hold a portion of the franchise which the patent confers, and of course the interest which they acquire terminates at the time limited for its continuance by the law which created it, unless it is expressly stipulated to the contrary. But the purchaser of the implement or machine, for the purpose of using it in the ordinary pursuits of life, stands on different ground. Such certainly were the views of this court in the case of *Bloomer* v. *McQuewan*, 14 How., 549, where the whole subject was very fully considered. Attention is drawn to the fact that there was considerable diversity of opinion among the judges in disposing of that case, but the circumstance is entitled to no weight in this case, because the court has since unanimously affirmed the same rule. *Chaffee* v. *The Boston Belting Co.*, 22 How., 223. In the case last mentioned the court say, that when the patented machine rightfully passes from the patentee to the purchaser, or from any other person by him authorized to convey it, the machine is no longer within the limits of the monopoly. By a valid sale and purchase the patented machine becomes the private individual property of the purchaser, and is no longer specially protected by the laws of the United States, but by the laws of the State in which it is situated. Hence it is obvious, say the court, that if a person legally acquires a title to that which is the

subject of letters patent, he may continue to use it until it is worn out, or he may repair it or improve upon it as he pleases, in the same manner as if dealing with property of any other kind. *Webbs. Pat. Cases*, 413, *note p.*

Considering that the question has been several times decided by this court, we do not think it necessary to pursue the investigation. The decree of the Circuit Court is therefore .

AFFIRMED WITH COSTS.

UNITED STATES *v.* AUGUISOLA.

Where no suspicion, from the absence of the usual preliminary documentary evidence in the archives of the former government, arises as to the genuineness of a Mexican grant produced, the general rule is, that objections to the sufficiency of proof of its execution must be taken in the court below. They cannot be taken in this court for the first time.

The tribunals of the United States, in passing upon the rights of the inhabitants of California to the property they claim under grants from the Spanish and Mexican governments, must be governed by the stipulations of the treaty, the law of nations, the laws, usages, and customs of the former government, the principles of equity, and the decisions of the Supreme Court, so far as they are applicable. They are not required to exact a strict compliance with every legal formality.

The United States v. *Johnson* (*ante*, p. 326) approved.

THIS was an appeal by the United States from a decree of the District Court for the Southern District of California, confirming to one Auguisola a tract of land in California.

After the cession of California to the United States, Auguisola, who deraigned title from two persons (Lopez and Arrellanes) exhibiting a grant that purported to be from the Mexican governor, Micheltorena, laid his claim before the board of commissioners, which the act of Congress of March 3, 1851, appointed to examine and decide on all claims to lands in California purporting to be derived from Mexican grants. He here produced from the archives of the Surveyor-General of California a petition from the grantees; the petition being accompanied by a map of the land desired;