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Bloomer Vs. Mcquewan

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Decided On : 1852

Appeal No. : 55 U.S. 539

Appellant : Bloomer

Respondent : Mcquewan

Judgement :

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Bloomer v. McQuewan

55 U.S. (14 How.) 539

APPEAL FROM THE CIRCUIT COURT OF THE UNITED

STATES FOR THE WESTERN DISTRICT OF PENNSYLVANIA

SYLLABUS

The patent for Woodworth's planing machine was extended from 1842 to 1843, by the Board of commissioners.

Under that extension, this Court decided, in *Wilson v. Rousseau,* 4 How. 688, that an assignee had a right to continue the use of the machine which he then had.

In 1845, Congress, by a special act, extended the time still further from 1849 to 1856. Under that extension, an assignee has still the same right.

By the cases of *Evans v. Eaton,* 3 Wheat. 548, and *Wilson v. Rousseau,* 4 How. 688, these two propositions are settled, *viz.:*

1. That a special act of Congress in favor of a patentee extending the time beyond that originally limited must be considered as engrafted on the general law.

2. That under the general law in force when this special act of Congress was passed, a party who had purchased the right to use a planing machine during the period to which the patent was first limited was entitled to continue to use it during the extension authorized by that law unless there is something in the law itself to forbid it.

But there is nothing in the act of Congress passed in 1845 forbidding such use, and therefore the assignee has the right.

MR. JUSTICE CURTIS, having been of counsel, did not sit on the trial of this cause, and MR. JUSTICE WAYNE was absent.

This appeal was a bill filed by Bloomer, who claimed under Wilson,, the assignee of Woodworth's planing machine. The whole of

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Wilson's title is set forth in the report of the case of *Wilson v. Rousseau,* 4 How. 646, as is also the Act of Congress passed on 26 February, 1845, 4 How. 45 U. S. 662 , extending the patent for seven years from 27 December, 1849.

McQuewan claimed, through two mesne assignments from Woodworth and Strong, by virtue of a license granted on 8 November, 1833.

The bill and answer covered a great deal of ground which needs not be noticed in this report.

Amongst other averments was this -- that the license conveyed no right to use the machine during the extension for seven years from 1849 under the act of Congress passed in 1845, and the decision of the court being in favor of the defendants below upon this point, it is unnecessary to state all the points and arguments upon other matters.

The court below were divided in opinion, and the bill was of course dismissed. Bloomer appealed to this Court.

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MR. CHIEF JUSTICE TANEY delivered the opinion of the Court.

The bill in this case was filed by the appellants on 6 July, 1850, in the Circuit Court of the United States for the Western District of Pennsylvania to obtain an injunction restraining the appellees from the use of two of Woodworth's planing machines in the City of Pittsburgh. The term for which Woodworth's patent was originally granted expired in 1842, but it was extended seven years by the board established by the 18th section of the act of 1836. And afterwards, by the Act of Congress of February 26, 1845, this patent was extended for seven years more, commencing on 27 December, 1849, at which time the previous extension would have terminated.

It appears from the pleadings and evidence in the case that,

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shortly after the passage of the Act of Congress of 1845, William Woodworth, the administrator of the patentee, in whose name the certificate of extension was directed to be issued, assigned all his right to James G. Wilson, from whom the appellant purchased the exclusive right to construct and use this machine and to vend to others the right to construct and use it in a large district of country

described in the grant. Pittsburgh, in which the machines in question are used, is included within these limits. And the right which the appellant purchased was regularly transferred to him by Wilson by an instrument of writing duly recorded in the Patent Office.

In the year 1833, during the term for which the patent was originally granted, the defendants purchased the right to construct and use a certain number of these machines within the limits of the City of Pittsburgh and Alleghany County, and the right to do so was regularly transferred to them by different assignments deriving their title from the original patentee. The two machines mentioned in the bill were constructed and used by the respondents soon after the purchase was made, and the appellees continued to use them up to the time when this bill was filed. And the question is whether their right to use them terminated with the first extension or still continues under the extension granted by the act of 1845.

The circuit court decided that the right of the appellees still continued, and upon that ground dismissed the appellant's bill. And the case is now before us upon an appeal from that decree.

In determining this question, we must take into consideration not only the special act under which the appellant now claims a monopoly, but also the general laws of Congress in relation to patents for useful improvements and the special acts which have from time to time been passed in favor of the particular patentees. They are statutes *in pari materia,* and all relate to the same subject and must be construed together. It was so held in the case of *Evans v. Eaton,* 3 Wheat. 518, where the Court said that the special act of Congress in favor of Oliver Evans granting him a new patent for fourteen years for his improvements in manufacturing flour and meal was engrafted on the general act for the promotion of useful arts, and the patent issued in pursuance of both. The rule applies with more force in the present case, for this is not the grant of a new patent, but an enlargement of the time for which a patent previously extended under the act of 1836 should continue in force.

Indeed this rule of construction is necessary to give effect to the special act under which the appellant claims the monopoly. For this law does not define the rights or

privileges which the patent shall confer nor prescribe the remedy to which he shall

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be entitled if his rights are infringed. It merely extends the duration of the patent, and nothing more. And we are necessarily referred, therefore, to the general law upon the subject to ascertain the rights to which the patent entitled him and also the remedy which the law affords him if these rights are invaded.

Now the act of 1836 in express terms gives the benefit of the extension authorized by that law to the assignees and grantees of the right to use the thing patented to the extent of their respective interests therein. And under this provision it was decided, in the case of *Wilson v. Rousseau,* 4 How. 688, that the party who had purchased and was using this planing machine during the original term for which the patent was granted had a right to continue the use during the extension. And the distinction is there taken between the grant of the right to make and vend the machine and the grant of the right to use it.

The distinction is a plain one. The franchise which the patent grants consists altogether in the right to exclude everyone from making, using, or vending the thing patented without the permission of the patentee. This is all that he obtains by the patent. And when he sells the exclusive privilege of making or vending it for use in a particular place, the purchaser buys a portion of the franchise which the patent confers. He obtains a share in the monopoly, and that monopoly is derived from and exercised under the protection of the United States. And the interest he acquires necessarily terminates at the time limited for its continuance by the law which created it. The patentee cannot sell it for a longer time. And the purchaser buys with reference to that period, the time for which exclusive privilege is to endure being one of the chief elements of its value. He therefore has no just claim to share in a further monopoly subsequently acquired by the patentee. He does not purchase or pay for it.

But the purchaser of the implement or machine for the purpose of using it in the ordinary pursuits of life stands on different ground. In using it, he exercises no

rights created by the act of Congress, nor does he derive title to it by virtue of the franchise or exclusive privilege granted to the patentee. The inventor might lawfully sell it to him, whether he had a patent or not, if no other patentee stood in his way. And when the machine passes to the hands of the purchaser, it is no longer within the limits of the monopoly. It passes outside of it, and is no longer under the protection of the act of Congress. And if his right to the implement or machine is infringed, he must seek redress in the courts of the state according to the laws of the state, and not in the courts of the United States nor under

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the law of Congress granting the patent. The implement or machine becomes his private individual property, not protected by the laws of the United States, but by the laws of the state in which it is situated. Contracts in relation to it are regulated by the laws of the state and are subject to state jurisdiction. It was so decided in this Court in the case of *Wilson v. Sanford,* 10 How. 99. Like other individual property, it is then subject to state taxation, and from the great number of patented articles now in use, they no doubt, in some of the states, form no inconsiderable portion of its taxable property.

Moreover, the value of the implement or machine in the hands of the purchaser for use does not in any degree depend on the time for which the exclusive privilege is granted to the patentee, nor upon the exclusion of others from its use. For example, in the various patented articles used in agriculture, in milling, in manufactures of different kinds, in steam engines, or for household or other purposes, the value to the purchaser is not enhanced by the continuance of the monopoly. It is of no importance to him whether it endures for a year or twenty-eight years. He does not look to the duration of the exclusive privilege, but to the usefulness of the thing he buys and the advantages he will derive from its use. He buys the article for the purpose of using it as long as it is fit for use and found to be profitable. And in the case before us, the respondents derive no advantage from the extension of the patent, because the patentee may place around them as many planing machines as he pleases, so as to reduce the profits of those which they own to their just value in an open and fair competition.

It is doubtless upon these principles that the act of 1836 draws the distinction between the assignee of a share in the monopoly and the purchase of one or more machines, to be used in the ordinary pursuits of business. And that distinction is clearly pointed out and maintained in the case of *Wilson v. Rousseau,* before referred to.

Upon the authority, therefore, of the cases of *Evans v. Eaton* and *Wilson v. Rousseau,* these two propositions may be regarded as settled by judicial decision:

1. That a special act of Congress in favor of a patentee, extending the time beyond that originally limited, must be considered as engrafted on the general law, and

2. That under the general law in force when this special act of Congress was passed, a party who had purchased the right to use a planing machine during the period to which the patent was first limited was entitled to continue to use it during the extension authorized by that law.

Applying these rules to the case before us, the respondents

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must be entitled to continue the use of their planing machines during the time for which the patent is extended by the special act of Congress unless there is something in the language of the law requiring a different construction.

But there is nothing in the law to justify the distinction claimed in this respect on behalf of the patentee. Its language is plain and unambiguous. It does not even grant a new patent, as in the case of *Oliver Evans.* It merely extends the time of the monopoly to which the patentee was entitled under the general law of 1836. It gives no new rights or privileges, to be superadded to those he then enjoyed, except as to the time they should endure. The patent, such as it then was, is continued for seven years longer than the period before limited. And this is the whole and only provision contained in this special act. In order, therefore, to determine the rights of the patentee during the extended term, we are necessarily referred to the general law, and compelled to inquire what they were before this

special act operated upon them, and continued them. Indeed the court has been obliged to recur to the act of 1836 in every stage of this suit to guide it in deciding upon the rights of the parties, and the mode of proceeding in which they are to be tried. It is necessarily referred to in order to determine whether the patent under which the complainant claims was issued by lawful authority, and in the form prescribed by law; it was necessary to refer to it in the circuit court in order to determine whether the patentee was entitled to the patent, as the original inventor, that fact being disputed in the circuit court; also, for the notices to which he was entitled in the trial of that question, and for the forum in which he was authorized to sue for an infringement of his rights. And the rights of the appellant to bring the case before the court for adjudication is derived altogether from the provisions of the general law. For there is no evidence in the record to show that the machines are worth two thousand dollars, and no appeal therefore would lie from the decision of the circuit court, but for the special provision in relation to patent cases in the act of 1836. And while it is admitted that this special act is so engrafted on the general law as to entitle the patentee to all the rights and privileges which that law has provided, for the benefit and protection of inventors, it can hardly be maintained that the one in favor of the purchaser of a machine is by construction to be excepted from it, when there are no words in the special act to indicate that such was the intention of Congress.

This construction is confirmed by the various special acts which have been passed from time to time in favor of particular inventors granting them new patents after the first had expired

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or extending the time for which they were originally granted. Many of these acts have been referred to in the argument, some of which contain express provisions, protecting the rights of the purchaser under the first term, and others contain no provision on the subject, and merely grant a new patent, or, as in the case before the court, extend the duration of the old one. And in several instances, special laws in favor of different inventors have been passed within a short time of each other, in one of which the rights of the previous purchaser are expressly reserved,

and in the other there is no provision on the subject. And the Act of March 3, 1845, authorizing the patent of William Gale for an improvement in the manufacture of silver spoons and forks to be extended, was passed only a few days after the act in favor of Woodworth, and Gale's patent is subjected in express terms to the conditions and restrictions in the act of 1836, and consequently protects previous purchasers from a new demand.

In has been contended, on behalf of the appellant that the insertion of these restrictions in one special law and the omission of them in another shows that, in the latter, Congress did not intend to exempt the purchaser from the necessity of obtaining a new license from the patentee. And that Congress might well suppose that one inventor had stronger claims upon the public than another, and might on that account give him larger privileges on the renewal.

But this argument only looks to one side of the question -- that is, to the interest and claims of the inventor. There is another and numerous class of persons who have purchased patented articles and paid for them the full price which the patentee demanded, and we are bound to suppose that their interests and their rights would not be overlooked or disregarded by Congress. And still less that any distinction would be drawn between those who purchased one description of patented machines and those who purchased another. For example, the act granting a new patent to Blanchard in 1834 for cutting or turning irregular forms saves the rights of those who had bought under the original patent. And we ought not to presume, without plain words to require it, that while Congress acknowledged the justice of such claims in the case of Blanchard, they intended to disregard them in the case of Woodworth. Nor can it be said that the policy of Congress has changed in this respect after 1834, when Blanchard's patent was renewed. For, as we have already said, the same protection is given to purchasers in the special law, authorizing the renewal of Gale's patent, which was passed a few days after the law of which we are speaking.

The fair inference from all of these special laws is this that

Congress has constantly recognized the rights of those who purchase for use a patented implement or machine, that in these various special laws the patentee and purchasers of different inventions were intended to be placed on the same ground, and that the relative rights of both parties under the extension, by special act of Congress, were intended to be the same as they were when the extension was granted under the general law of 1836. It would seem that in some cases, the attention of the legislature was more particularly called to the subject, and the rights of the purchaser recognized and cautiously guarded. And when the provision is omitted, the just presumption is that Congress legislated on the principle decided by this Court in *Evans v. Eaton,* and regarded the special law as engrafted on the general one, and subject to all of its restrictions and provisions, except only as to the time the patent should endure. Time is the only thing upon which they legislate. And any other construction would make the legislation of Congress on these various special laws inconsistent with itself, and impute to it the intention of dealing out a different measure of justice to purchasers of different kinds of implements and machines, protecting some of them and disregarding the equal and just claims of others.

And if such could be the interpretation of this law, the power of Congress to pass it would be open to serious objections. For it can hardly be maintained that Congress could lawfully deprive a citizen of the use of his property after he had purchased the absolute and unlimited right from the inventor, and when that property was no longer held under the protection and control of the general government, but under the protection of the state, and on that account subject to state taxation.

The 5th Amendment to the Constitution of the United States declares that no person shall be deprived of life, liberty, or property without due process of law.

The right to construct and use these planing machines had been purchased and paid for without any limitation as to the time for which they were to be used. They were the property of the respondents. Their only value consists in their use. And a special act of Congress, passed afterwards, depriving the appellees of the right to use them certainly could not be regarded as due process of law.

Congress undoubtedly had power to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

But it does not follow that Congress may, from time to time, as often as it thinks proper, authorize an inventor to recall

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rights which he had granted to others, or reinvest in him rights of property which he had before conveyed for a valuable and fair consideration.

But we forbear to pursue this inquiry, because we are of opinion that this special act of Congress does not and was not intended to interfere with rights of property before acquired, but that it leaves them as they stood during the extension under the general law. And in this view of the subject, the appellant was not entitled to the injunction he sought to obtain, and the circuit court were right in dismissing the bill.

As the decision on this point disposes of the case, it is unnecessary to examine the other grounds of defense taken by the appellees.

The decree of the circuit court must be

Affirmed.

MR. JUSTICE Mc LEAN and MR. JUSTICE NELSON dissented.

MR. JUSTICE Mc LEAN.

Woodworth's patent bears date the 27th of December, 1828, and runs for fourteen years. On the 29th of July, 1830, the patentees conveyed to Isaac Collins and Barzillai C. Smith the right to construct, use, and vend to others the planing machine invented within several states, including Pennsylvania, except the City of Philadelphia. On the 19th of May, 1832, Collins and Smith transferred to James Barnet the right to construct and use, during the residue of the aforesaid term of

fourteen years, fifty planing machines within Pittsburgh and Alleghany County, for which he agreed to pay four thousand dollars. Barnet agreed not to construct or run more than fifty machines during the term aforesaid, and Collins and Smith bound themselves not to license during the term, nor to construct or use themselves during the term or allow others to do so in the limits of Pittsburgh and Alleghany County.

On the 27th of December, 1842, the patent expired, but it was renewed and extended for seven years under the act of 1836. This extension expired in 1849, but Congress, on the 26th of February, 1845, passed an act which provided that "the said letters patent be, and the same is hereby, extended for the term of seven years, from and after the twenty-seventh day of December, 1849."

The patentee, by deed dated 14 March, 1845, and also by a further deed dated 9 July, 1845, conveyed to James E. Wilson all his interest as administrator in the letters patent under the extension by the act of Congress. And Wilson, on 4 June, 1847, for the consideration of twenty-five thousand dollars, gave to Bloomer, the plaintiff, a license to

construct and use and vend to others to construct and use, during the two extensions,

"all that part of Pennsylvania lying west of the Alleghany Mountains, excepting Alleghany County, for the first extension, which expires on the 27th day of December, 1849, and the States of Virginia, Maryland, Kentucky, and Missouri, excepting certain parts of each state."

The defendants continued to run their machines during the residue of the fourteen years for which the patent was granted and during the first extension, and the complainant filed his bill to enjoin the defendants from running their machines under the second extension by the act of Congress.

The contract of the defendants was entered into 19 May, 1831, and under it Barnet had a right "to construct and use during the residue of the aforesaid term of fourteen years, fifty planing machines," &c.; The patent expired on 27 of December in 1842. The contract of defendants was made 19 May, 1832, leaving about nine years and six months for the patent to run, and this was the time limited by the contract, and for which the consideration of four thousand dollars was paid. This was not left to construction from the life of the patent, but the contract expressly declared the right was purchased "for the residue of the aforesaid term of fourteen years."

This term was enjoyed by the defendants, and under the decision of this Court in the case of *Wilson v. Rousseau,* 4 How. 646, the seven years' extension under the act of 1836 was also enjoyed by the defendants. This construction of the act of 1836, in my judgment, was not authorized, and was not within the intention of the law as was expressed at the time. That extension having expired, another extension is claimed under the act of Congress. This claim is set up to an injunction bill filed by the complainant, who is the assignee of the patent for a part of Pennsylvania and other states. And by the decision of four of my brethren just delivered the defendants are to enjoy this extension, making fourteen years beyond their control. This would seem to imply that under the act of 1836 and under the act of 1845, the assignees were the favored objects of Congress. But this is not the case. The patentee who made the invention and through whose ingenuity, labor, and expense, a great benefit has been conferred on the public, in justice is entitled to remuneration, and that only was the ground of extension, whether under the law of 1836 or the special act of 1845.

This as well as the former decision was influenced by the consideration that the owners of the machines are, in equity, entitled to run them so long as the exclusive right of the patent

shall be continued. It is said that the machines are property, and that no act of Congress should deprive the owners of the use of their property. But in this view

the property of the patentee seems not to be taken into the account. He is the meritorious claimant for protection. The assignee for a specific time rests upon his contract. He has conferred no benefit on society. His investment was made with an exclusive reference to his own advantage. He has no more claims upon the public sympathy than he who rents a mill, a farm, or engages in a business open to all who expect a profit by it.

But the hardship is supposed to exist in the fact that, to use the right, a planing machine must be constructed at an expense of some four or five hundred dollars, and this will be lost to the occupier if by an extension he shall not be permitted to run his machine. The answer is, when he entered into the contract he knew, or is presumed to have known, that the patent might be extended under the law of 1836 or by special act, and if he desired an interest under the renewed patent, he should have provided for it in his contract. Having failed to do this, it would seem to be unjust that, under a contract to run the machine less than ten years, he should be entitled to run it sixteen years. The consideration paid was limited to the term specified in the contract. But it is answered that the assignee expected to run his machine after the termination of the contract on which the exclusive right would end and become vested in the public.

Let us examine this plea and it will be found that a great fallacy prevails on this subject. A right that is common is no more valuable to one person than another, as all may use it. The injury, then, consists, so far as the licensee is concerned, in the reduction of the value of his machine by the extension of the exclusive right in the patentee to the exclusion of the assignee. It is true this deprives him of the monopoly which his contract secured to him. But he has enjoyed this to the extent of his contract, and for which he has paid the stipulated consideration. Now his only equitable plea to run his machine during the renewed patent arises alone from the supposed difference in the value of his machine, under the renewal, without a license, and where the right becomes vested in the public.

If there had been no renewal, the licensee might run his machine, and any other person might run one. It is a fact known to every observing individual, when a new business is set up, as a planing machine, supposed to be very profitable generally,

a competition is excited which reduces the profit below a reasonable compensation for the labor and expense of the business. If the monopoly continued, as enjoyed under the contract, the consideration paid for the monopoly would be added

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to the profits, which would make them large. But when the monopoly ceases, the profits, if not destroyed, are reduced by competition at least as low if not below the ordinary profit of capital employed in other investments.

If the business of the county or city required the number of planing machines in operation, the licensee could sell his machine at a reasonable reduction for the time it had run. The machines of the defendant had run, probably, from twelve to fifteen years. A considerable reduction would be expected by the purchaser, as a machine could not be expected to last more than twenty years. But suppose it can be used thirty, then one-half of the value must be deducted for the wear of the machine fifteen years, which would reduce it to some two hundred and fifty or three hundred dollars.

But suppose the exclusive right should be continued in the patentee by an extension of it seven years. Then if the machines were not more numerous than the public required, they would be wanted by their owners or by others disposed to engage in the business. And I hazard nothing in saying that after deducting the compensation from the profits paid for the exclusive right, they would be larger than could be hoped for where the right was common. Under such circumstances, I can entertain no doubt that a machine would sell for more money under the extension of the patent than where the right goes to the public.

The idea that to refuse the use of a machine under the extension of a patent is an unjust interference with property, I think, is unfounded. There is no interference with the property in the machine. The owner may sell it to anyone who has a license to use it. It is not the property in the machine that is complained of, but because the right to run it longer than the contract provided for is not given. The

licensee has used the franchise, as long as he purchased and paid for it, and can he in justice claim more than his contract. The extension of the right to use, while the extended patent continues, does a wrong to the patentee by taking his property without compensation and giving it to the licensee. The franchise is property, and it can no more be transferred to another without compensation or contract than any other property. It would seem that this description of property is not governed by contract. That a contract to use the franchise ten years does not mean what is expressed, but may mean a right for twenty years or any other term to which the patent may be extended.

Every man who has sense enough to make a contract takes into his estimate the contingency of a loss, to some extent, in going out of the business. He fixes his own time for the

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contract, and if he wishes to provide for the contingency arising from the renewal of a patent, he can embrace it in his contract for a stipulated compensation.

It may be true that unless the contrary appear, when the patentee sells a planing machine, a right to use it may be applied. But the right to construct and the right to use are distinct. Some purchase of the patentee the right to construct the machine, others to use it. This planing machine cannot be compared to a plough, or any other article which may be considered the product of the patent. The machine is the instrument through which the plank is planed. The plank is the product, and may be sold in the market as other property. But the planing machine cannot be used without a license. The law protects the franchise by prohibiting the use of the machine without a license. When Barnet purchased the franchise for the fifty machines, he did not buy the machines for a term as long as the machines could run, but for nine years and six months. The contract neither expressly nor impliedly extended beyond that term.

In this view, I think that I am not mistaken, and if I am not, the license is not injured a dollar by the termination of his right to run his machine as fixed in his contract.

But on whom is the injury inflicted by extending the contract of the licensee with the patentee, and that without compensation? In the present case, the patentee has been injured, by the use of the fifty machines, at least four thousand dollars, the amount agreed to be paid for the right to run them less than ten years. And must not the property of the patentee be taken into the account, as well as the imagined rights of the licensee?

The patentee is justly considered a public benefactor. He has conferred a great benefit upon the world, and he is entitled under our laws to at least a compensation for his expense, ingenuity, and labor.

That the patentee is the only one whose interests are regarded as the ground of extending the patent in the act of 1836 is clear. Now suppose the patentee has assigned the whole of the patent without receiving such a compensation as the law authorizes; there can be no doubt he is entitled on that ground to a renewal of the patent, and yet, under the decision now given, his assignees would receive all the benefits of the renewal. Should not this fact cause doubts whether the rule of construction of the statute can be a sound one which defeats its avowed object? If this be the consequence of the assignment of the entire interest by the patentee, any partial assignment must produce the same result, though to a more limited extent. A principle which will not bear this test is not sound.

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The act of 1845, extending this patent, annexed no conditions. The exclusive right was extended to the administrator of Woodworth for seven years, from the 27th of December, 1849. But the decision now given in effect declares this exclusive right is not given. Indeed, the object of Congress must be defeated if the machines, in operation at the time of the passage of the act, are to be continued without compensation. It is presumed there are few places where planing machines were not constructed before 1849, the time the renewal took effect, if the public required them. On this supposition, the extension of the patent can be of little or no benefit to the heirs of the patentee. Congress could have granted the act only upon the

ground to remunerate the heirs of the inventor.

There seems to be a great mistake as to the profits of this patent. It was a valuable patent, but, as in all other cases, its value excited the rapacity of men who seek to enrich themselves by taking the property of others. The records of the courts show that piracies were committed on this patent in every part of the country, and that to sustain it much expenditure and labor have been required. It is stated that the sum of near two hundred thousand dollars has been thus expended to establish this patent. Congress have extended many patents; in some instances conditions have been imposed, in others, the franchise has been extended unconditionally. Now where the patent is extended by act of Congress without conditions, I am unable to perceive how the court can impose conditions. Such an act would be legislation, and not construction.

By the Act of the 15th February, 1847, the patent of Thomas Blanchard for cutting irregular forms out of wood, brass, or iron was extended for fourteen years from the 20th of January, 1848:

"Provided that such extension shall enure to the use and benefit of the said Thomas Blanchard, his executors and administrators and to no other persons whomsoever, except that a *bona fide* assignee of the invention, by virtue of an assignment from the patentee heretofore made, shall have the benefit of this act, upon just, reasonable, and equitable terms, according to his interest therein. And if the said Thomas Blanchard, his executors or administrators, cannot agree with such assignee, the terms shall be ascertained and determined by the Circuit Court of the United States for the district in which such assignee resides, to be decreed upon a bill to be filed by such assignee for that purpose. And provided further that no assignee shall have the benefit of this act unless he shall, within ninety days from its passage, agree with the said Thomas Blanchard as to the consideration upon which he is to have it, or file his bill,"

&c.;

Everyone must perceive the justice and propriety of this act; under the decision now given, the assignee of Blanchard would have had the benefit of the extension without paying for it. This act, extending Blanchard's patent, was passed two years after the decision of this Court in *Wilson v. Rousseau,* which, under the act of 1836, gave the benefit of the extension to the assignee. This must have been known to Congress, and yet they deemed a special provision in behalf of the assignee necessary. This act and several others of a similar character cannot fail to convince everyone that Congress did not suppose that the courts have power to annex a condition to a legislative grant.

In the case of *Evans v. Jordan and Morehead,* 9 Cranch 199, this Court held that the Act of January, 1808, for the relief of Oliver Evans does not authorize those who erected their machinery between the expiration of their old patents and the issuing of the new one to use it after the issuing of the latter.

The above act extended the patent fourteen years,

"provided that no person who may have heretofore paid the said Oliver Evans for license to use the said improvements shall be obliged to renew said license or be subject to damages for not renewing the same, and provided also that no person who shall have used the said improvements or have erected the same for use before the issuing of the said patent shall be liable to damages therefor."

This was a much stronger case for equitable considerations than the one before us. Evans' patent had expired. His improvements were free to the public, and they were adopted by the defendants before he made application to Congress for a renewal of his patent. I will cite the reasoning of the supreme court on that case. "The language," it said,

"of this last proviso is so precise and so entirely free from all ambiguity that it is difficult for any course of reasoning to shed light upon its meaning. It protects against any claim for damages which Evans might make those who have used his improvements or who may have erected them for use prior to the issuing of his patent under this law. The protection is limited to acts done prior to another act

thereafter to be performed, to-wit, the issuing of the patent. To extend it by construction to acts which might be done subsequent to the issuing of the patent would be to make, not to interpret, the law. . . . The injustice of denying to the defendants the use of machinery which they had erected after the expiration of Evans' first patent and prior to the passage of this law has been strongly urged as a reason why the words of this proviso should be so construed as to have a prospective operation. But it should be recollected that

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the right of the plaintiff to recover damages for using his improvement after the issuing of his patent, under this law although it had been erected prior thereto, arises not under this law, but under the general law of 21 February, 1793. The provisos in this law profess to protect, against the operation of the general law, three classes of persons -- those who had paid Evans for a license prior to the passage of the law, those who may have used his improvements, and those who may have erected them for use before the issuing of the patent."

And the Court said:

"The legislature might have proceeded still further, by providing a shield for persons standing in the situation of these defendants. It is believed that the reasonableness of such a provision could have been questioned by no one. But the legislature has not thought proper to extend the protection of these provisos beyond the issuing of the patent under that law, and this Court would transgress the limits of the judicial power by an attempt to supply, by construction, this supposed omission of the legislature. The argument founded upon the hardship of this and similar cases would be entitled to great weight if the words of this proviso were obscure and open to construction. But considerations of this nature can never sanction a construction at variance with the manifest meaning of the legislature, expressed in plain and an unambiguous language."

The above views do not conflict with the opinion of the Court in *Evans v. Eaton,* 3 Wheat. 454. In that case, the Court said:

"Some doubts have been entertained respecting the jurisdiction of the courts of the United States, as both the plaintiff and defendants are citizens of the same state. The fifth section of the act to promote the progress of useful arts, which gives to every patentee a right to sue in a circuit court of the United States in case his rights be violated, is repealed by the third section of the act of 1800, which gives the action in the circuit court of the United States where a patent is granted 'pursuant' to that act or to the act for the promotion of useful arts. This patent, it has been said, is granted not in pursuance of either of those acts, but in pursuance of the act 'for the relief of Oliver Evans.' But this Court is of opinion that the act for the relief of Oliver Evans is engrafted on the general act for the promotion of useful arts, and that the patent is issued in pursuance of both. The jurisdiction of the court is therefore sustained."

There can be no question that the special law extending the grant, as to its validity, is subject to the general patent law. The right was intended to be exclusive if it be established that Evans was the original inventor of the improvements claimed and such improvements were stated with the necessary precision.

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And also that it came under the class of cases on which suit could be brought in the courts of the United States without regard to the citizenship of the parties. But it could not have been intended to apply to any contract subsequent to the patent, and it could only be held to embrace those general provisions of the patent law which relate to the validity of the patent. Under the act of Congress, a specification was necessarily filed, and it seems to be the practice to issue a patent under the act. This, it appears to me, is unnecessary, as the grant in the act is sufficient. But the schedule is necessary to show the nature and extent of the claim, and these must be sustained on those principles which apply to patents generally.

To give any other construction to the above remarks of the court would be in direct contradiction to the language used and the principle decided in the case above cited from Cranch. In fact, the remark that the relief of Evans was engrafted on the general law was made in reference to the jurisdiction of the court, and cannot be

extended beyond that and other questions in relation to the validity of the patent.

This argument of the Court in *Evans v. Jordan* applies with all its force and authority to the case before us, and I need only say it was the language of Marshall, of Story, of Washington, and of the other judges of the Court except Judge Todd, who appears to have been absent. I can add nothing to the weight of the argument, but I will proceed to name the judges of this Court who have given opinions opposed to the decision of this case by four of my brethren.

MR. JUSTICE WAYNE, being sick, did not sit in the case. In *Wilson v. Rousseau,* he held that under the act of 1836, the licensee had no right to run his machine under the extended patent.

MR. JUSTICE CURTIS, having, as counsel, given an opinion opposed to the right of the defendants, did not sit in the case. MR. JUSTICE Thompson and MR. JUSTICE Story had both given opinions against the right of the assignee, unless under a special assignment. This was the opinion of MR. JUSTICE Woodbury, as expressed in the case of *Wilson v. Rousseau.* MR. JUSTICE McKinley gave an opinion against the right of the assignee under the act of 1845, extending Woodworth's patent. The same decision has been frequently given, by the Justices of this bench, in the second and seventh circuits.

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 shall arise in my circuit, for the consideration and decision of a full bench.

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ORDER

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Western District of Pennsylvania, and was argued by counsel. On consideration whereof, it is now here ordered, adjudged,

and decreed by this Court that the decree of the said circuit court in this cause be and the same is hereby affirmed with costs.

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