

infringed it. They contend that Adams was not the first inventor, but was anticipated by Louis Sterne, three patents to whom were introduced in evidence. Sterne's first patent is one granted in England, in 1866, for "improvements in buffers, draw-springs, and bearing springs," the specification of which describes the invention as consisting in introducing, between disks of hard India rubber or ebonite, alternate rings of soft India rubber, and uniting the rings to the disks during the process of vulcanization or otherwise; and states that "instead of the disks being made of hard India rubber or ebonite they may be made of brass, iron coated with brass, by means of the galvanic process or by other means, or they may be made of any other suitable metal or hard material." Of the two other patents of Sterne, the one for pneumatic springs made of alternate metal plates and rubber rings, forming an air chamber, was patented in the United States on February 23, 1869; the other, for driving-belts made of parallel strips of metal and of rubber, was patented in England on June 2, 1868, and in the United States on August 3, 1869. According to the description in either specification the rubber is chemically united with the metal during the process of vulcanization, and the metal plates or strips are first ground or scoured until their surfaces are perfectly free from scale or oxidized matter, and then "placed in a bath prepared to deposit the necessary precipitation of copper and zinc by the electro-metallurgical process." Each of Sterne's three patents speaks only of brass, a compound of copper and zinc, as the metal to be deposited; and the complainants contend that even a very thin film of brass would, by reason of securing a less perfect adherence, differ from the invention of Adams, in which the film is of a single metal. But it is unnecessary to consider that point, because it is quite clear that neither of the Sterne patents contemplates or points out the necessity of making the film very thin, or gives any directions by which a person of competent skill would be led to make the film so thin as to produce the result described in and obtained by the patent of Adams. A patent is not invalidated by statements in an earlier publication, unless those statements are full and definite enough to inform those skilled in the art how to put in practice the invention now patented. *Betts v. Menzies*, 10 H. L. Cas. 117; *Neilson v. Betts*, L. R. 5 H. L. 1; *Seymour v. Osborne*, 11 Wall. 516, 555; *Cawood Patent*, 94 U. S. 695, 703, 704; *United Nickel Co. v. Anthes*, Holmes, 155; *Same v. Manchester Brass Co.* 16 Blatchf. 68.

Decree for the complainants.

FOSTER v. GOLDSCHMIDT and others.

Circuit Court, S. D. New York. July 17, 1884.)

1. PATENT—LICENSE—BREACH OF CONDITION—COMPLAINANT AT FAULT—EQUITY.

In an action growing out of the alleged failure of the defendant to act up to the terms of a license, granted him by the complainant, to sell a protected article, if the complainant refuses to fulfill any of his obligations in matters of substance, under the license, a court of equity will not interfere to assist him in compelling the defendant to observe the obligations upon his part.

2. SAME—CONDITION TO PROSECUTE INFRINGERS—HOW IT IS EXECUTED.

One of the conditions of a license being that the complainant should prosecute all unlicensed persons who should sell imitations of the article licensed, if the action of the complainant was such that it resulted, practically, in stopping infringements, he fulfilled the spirit and meaning of his obligation to the defendant to use reasonable diligence in prosecuting unlicensed sellers.

3. SAME—OLD AND NEW LICENSE—ELECTION—ESTOPPEL.

A condition in a license being that if any license should be thereafter granted under the patent, the terms and conditions of which should be more liberal to the licensee than those "herein contained," the defendants were to be entitled to receive the benefits of the additional advantages; if, upon such a case arising, the complainant gave the defendants the option of deciding whether they should have a new license or keep the old one, and the defendants elected to refuse the new license, they cannot be heard afterwards to allege that its terms were more advantageous to them. They cannot, instead of accepting the new license, *cum onere*, insist on determining what part they will accept and what part reject.

4. SAME—PROMISE IN THE ALTERNATIVE.

A promise in the alternative puts the alternative in the election of the promisor, unless there is something to take it out of the general rule.

5. SAME—AMBIGUOUS DOCUMENT—RULE OF CONSTRUCTION.

When both parties have acted upon a certain construction of an ambiguous document, that construction, if in itself admissible, will be adopted by the court.

In Equity.

Livingstone Gifford, for complainant.

Marsh, Wilson & Wallis, for defendants.

WALLACE, J. This case has been heard upon the pleadings, which set out copiously matters of evidence in support of the allegations. The bill of complaint is filed to restrain the defendants from selling gloves bearing lacing studs and lacings, which have not been applied to the gloves by the complainant, in violation of an agreement made between defendants and the complainant, June 6, 1876, whereby the complainant licensed the defendants to use certain patented hooks and lacings for gloves when applied to the gloves by complainant.

The conditions of the license agreement, so far as they are material to the present suit, are as follows: The complainant, in consideration of the payment of certain royalties by defendants, allows the defendants to sell gloves containing the patented invention, provided the gloves have had their lacing studs or hooks and lacings applied by the complainant. Article 3 of the agreement provides that whenever defendants desire to have gloves finished by the application of lacing studs or hooks and lacings, at least 60 days before the work of