

## Daifuku Co., Ltd. and Daifuku America Corp. v. Murata Machinery, Ltd.: Denying Institution IPR2015-00084,87

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*Takeaway: In order to conclude that an improvement is not more than the predictable use of prior art elements according to their established function, a petitioner must make more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination, and requires a showing of motivation to combine.*

In its [Decision](#), the Board denied institution of *inter partes* review of claims 6-14 of the '153 Patent. The '153 Patent discloses an Automated Material Handling System ("AMHS") that includes an overhead hoist to load and unload work-in-process ("WIP") parts, such as semiconductor wafers stored in cassette pods, for transport between various workstations during a semiconductor manufacturing process.

The Board began with claim construction, stating that terms are given their broadest reasonable interpretation in light of the patent specification. The first term construed was "the translating stage being configured to laterally translate the gripper from a first position proximate to the overhead transport vehicle to a second position proximate to the at least one storage bin." Patent Owner argued that the lateral movement of the gripper should be limited to movement "without rotation or angular displacement," but the Board disagreed. The Board then construed "the translating stage is configured to move the gripper portion laterally from a first position proximate to the overhead hoist transport vehicle past the outer peripheral border of the one of the plurality of storage bins to a second position proximate to the one of the plurality of storage bins" consistently with the construction of the first term.

The Board then turned to whether claims 6, 7, 9-11, and 14 are obvious over JPAP 216 and JPAP 237. The Board agreed with Patent Owner that JPAP 216 does not disclose an overhead vehicle that can move articles vertically to a processing station because Petitioner's only evidence was the declaration of its expert, which was conclusory. The Board also did not credit the "design problem" premise for Petitioner's "finite possibilities" test as articulated in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The Board stated that in order to conclude that an improvement is not more than the predictable use of prior art elements according to their established function, Petitioner must make more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination, and requires a showing of motivation to combine. The Board found that Petitioner had not done so, and had not explained why one of ordinary skill in the art would have been motivated to combine the references.

Petitioner's remaining grounds challenged claims 8, 12, and 13 based on the combination of JPAP 216, JPAP 237, and either Slutsky or JPAP 050. The Board found that the additional references do not cure the deficiencies of the combination of JPAP 216 and JPAP 237 stated above.

***Daifuku Co., Ltd. and Daifuku America Corp. v. Murata Machinery, Ltd., IPR2015-00084; IPR2014-00087***

***Paper 10: Decision Denying Institution of Inter Partes Review***

***Dated: May 4, 2015***

***Patents 7, 771,153 B2; 5,165,927 B2***

***Before: Ken B. Barrett, Barry L. Grossman, and Brian P. Murphy***

***Written by: Murphy***

***Related Proceedings: Murata Machinery USA, Inc. v. Daifuku Co., Ltd., No. 2:13-cv-00886 (D. Utah); IPR2015-00083; IPR2015-00085; IPR2015-00087; U.S. Patent Application Nos. 10/682,809, 13/492,341, 14/080,590***

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