IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE PATENT TRIAL AND APPEAL BOARD

McCLINTON ENERGY GROUP, LLC, JAYCAR ENERGY GROUP LLC, SURF FRAC WELLHEAD EQUIPMENT CO., MOTOR MILLS SNUBBING LLC, STAN KEELING, AND TONY D. McCLINTON Petitioners

V.

MAGNUM OIL TOOLS INTERNATIONAL, LTD.
Patent Owner

Inter Partes Review No. IPR2014-00993 Patent No. 8,459,346

PATENT OWNER'S PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107



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7.2	Lehr does not disclose a body adapted to receive a ball that restricts
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7.5	Lehr does not disclose an insert having a bore only partially formed
	therethrough or a blocked passageway that restricts fluid flow in
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7.6	Lehr does not disclose the one or more shearable threads are disposed
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7.7	Lehr does not disclose one or more shearable threads adapted to
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TABLE OF AUTHORITIES

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