

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

jh/gcp

Mailed: September 23, 2009

Opposition No. 91191016

Intellectual Reserve, Inc.

v.

Kendal M. Sheets

George C. Pologeorgis, Interlocutory Attorney:

On August 27, 2009, the Board issued an order acknowledging applicant's filing of its answer to the notice of opposition and counterclaim to cancel opposer's pleaded registrations Nos. 3239919, 2883572, 2766231, 2913694, 1524555 and 1527447. It has come to the Board's attention, however, that applicant only filed the required fees in support of its counterclaim with respect to opposer's pleaded Registration Nos. 3239919 and 2883572.

Applicant is referred to Trademark Rule 2.111 regarding the application of fees in a cancellation proceeding involving multiple registrations and/or multiple classes. The fees submitted by applicant have been applied against Registration Nos. 3239919 (Classes 41 and 42) and 2883572 (Classes 9 and 16).

To the extent applicant wishes to proceed in seeking to cancel all six of opposer's pleaded registrations identified in its counterclaim, applicant would have to submit an additional filing fee in the amount of \$2,100.

Accordingly, applicant/counterclaim plaintiff is allowed until **FIFTEEN (15) DAYS** from the mailing date of this order to submit the supplemental fees for the remaining registrations, i.e., Registration Nos. 2766231, 2913694, 1524555 and 1527447, failing which the counterclaim will only proceed with regard to opposer's pleaded Registration Nos. 3239919 and 2883572.

As a final matter, the Board notes that the allegations set forth in applicant's counterclaim also concern opposer's pleaded application for the mark MORMON.ORG. Applicant is advised that a counterclaim may only be asserted against a pleaded registration, not a pleaded pending application. See *Pyttronic Industries Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 n.2 (TTAB 1990) (counterclaim to cancel "any registration which might issue in the future from pleaded application" stricken as improper), and *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983) (counterclaim to "refuse any application filed by petitioner" was improper). Indeed, the Board does not have jurisdiction to entertain a claim against opposer's pleaded application. See Sections 17 and 20 of the Trademark Act, 15 U.S.C. §§ 1067 and 1070.

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Proceedings are otherwise suspended pending applicant's response to the instant order.