

ESTTA Tracking number: **ESTTA1392633**

Filing date: **10/30/2024**

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

Proceeding no.	92084642
Party	Plaintiff Traditional Medicinals, Inc.
Correspondence address	JEREMY JOHNSON TRADITIONAL MEDICINALS INC 1400 VALLEY HOUSE DRIVE SUITE 120 ROHNERT PARK, CA 94928 UNITED STATES Primary email: jjohnson@tradmed.com Secondary email(s): jpeterson@tradmed.com, galbers@tradmed.com 707-664-5874
Submission	Answer to Counterclaim
Filer's name	Jeremy Johnson
Filer's email	jjohnson@tradmed.com, jpeterson@tradmed.com, galbers@tradmed.com
Signature	/Jeremy Johnson/
Date	10/30/2024
Attachments	ANSWER TO COUNTERCLAIM_Cancellation No. 92084642.pdf(181861 bytes)

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

In re: Registration No: 7281671
For the Mark: SMOOTH TEAS

TRADITIONAL MEDICINALS, INC.)	Cancellation No. 92084642
Petitioner,)	
)	
v.)	
)	ANSWER TO
SMOOTH TEAS, LLC)	COUNTERCLAIMS
Registrant.)	
_____)	

Petitioner Traditional Medicinals Inc. (“Petitioner”) hereby answers the Counterclaims for Partial Cancellation of Petitioner’s Registrations (the “Counterclaim”) filed by Registrant Smooth Teas, LLC (“Registrant”) as follows:

1. Petitioner admits that it is the owner of the following renewed and incontestable registrations on the Principal Register (the SMOOTH MOVE “Marks” or “Registrations”):

Reg. Number	Reg. Date	Trademark	IC	Goods / Services Statement
1258223	11/22/1983	SMOOTH MOVE	005	Herbal Teas for Use as a Laxative.
2520275	12/18/2001	SMOOTH MOVE	005 and 030	Medicinal herb teas (005); Herb tea for food purposes (030).
3344362	12/27/2007	SMOOTH MOVE	005	Dietary supplements; Herbal supplements; Nutritional supplements.

Petitioner denies that these Registrations are the only rights asserted in its Petition for Cancellation.

2. Petitioner denies that its Registrations cause any harm or damage to Registrant. Petitioner further denies that Registrant is entitled to any relief.

Counterclaim No. 1

3. Paragraph 3 merely repeats each and every allegation set forth in the preceding paragraphs of Registrant's Counterclaims and requires no answer. To the extent that answer is required, Registrant repeats its answers to the preceding paragraphs.

4. Denied as written. Petitioner *is* the owner of U.S. Registration No. 2,520,275 for the mark SMOOTH MOVE for use with "medicinal herb teas" in IC Class 005 and "herb teas for food purposes" in IC 030. Petitioner also claims common law rights to the mark SMOOTH MOVE which it has used on tea products since 1974 and rights pertaining to its position as the #1 bestselling laxative tea in the United States.

5. Denied as written. U.S. Registration No. 2,520,275 did issue on December 18, 2001, is currently in active status, and has been issued for more than three years.

6. Petitioner admits that specimens of use submitted to the U.S. Patent and Trademark Office in connection with the application that matured to U.S. Registration No. 2,520,275 show the word "laxative" on the goods and/or the goods' packaging.

7. Denied as written. Petitioner formulates its products consistent with the requirements of the U.S. Food and Drug Administration. Petitioner does not make any claims to diagnose, treat, cure, or prevent any disease.

8. Denied as written. Petitioner markets its products consistent with the requirements of the U.S. Food and Drug Administration. Petitioner does not make any claims to diagnose, treat, cure, or prevent any disease.

9. Admitted.

10. Admitted.

11. Admitted.

12. Admitted.

13. Denied as written. The image included in paragraph 13 does not show all labeling used with Petitioner's SMOOTH MOVE tea products.

14. Denied.

15. Denied.

16. Denied.

17. Denied.

18. Denied.

19. Denied.

20. Denied.

21. Denied.

22. Denied.

23. Denied.

24. Denied.

25. Denied.

Counterclaim No. 2

26. Paragraph 26 merely repeats each and every allegation set forth in the preceding paragraphs of Registrant's Counterclaims and requires no answer. To the extent that answer is required, Registrant repeats its answers to the preceding paragraphs.

27. Denied.

28. Denied.

29. Denied.

30. Paragraph 30 states Registrant's request and requires no answer. If answer is required, Petitioner denies that Registrant is entitled to the requested equitable remedy.

31. Denied.

32. Denied.

33. Paragraph 33 states Registrant's request and requires no answer. If answer is required, Petitioner denies that Registrant is entitled to the requested equitable remedy.

34. Denied.

35. Denied.

Counterclaim No. 3

36. Paragraph 36 merely repeats each and every allegation set forth in the preceding paragraphs of Registrant's Counterclaims and requires no answer. To the extent that answer is required, Registrant repeats its answers to the preceding paragraphs.

37. Denied as written. Petitioner *is* the owner of U.S. Registration No. 3,344,362 for the mark SMOOTH MOVE for "Dietary supplements; herbal supplements; nutritional supplements" in IC 005. Petitioner also claims common law rights to the mark SMOOTH MOVE which it has used on tea products since 1974 and rights pertaining to its position as the #1 bestselling laxative tea in the United States.

38. Denied as written. Registration No. 3,344,362 did issue on November 15, 2017 and is currently in active status.

39. Admitted.

40. Admitted.

41. Denied.

42. Denied.

43. Denied.

44. Paragraph 44 states Registrant's request and requires no answer. If answer is required, Petitioner denies that Registrant is entitled to the requested equitable remedy.

45. Denied.

46. Denied.

Petitioner's Affirmative Defenses & Amplifications

1. Petitioner affirmatively pleads reliance upon the decisions of the USPTO to accept Petitioner's submitted specimens of use in Class 030.

2. Petitioner affirmatively pleads that, in the absence of the USPTO as a party to this action, Registrant is estopped from challenging classification decisions made by the Office with respect to Petitioner's goods.

3. In addition to the federal registrations asserted in ¶6 of its Petition for Cancellation, Petitioner relies upon selling goods with the SMOOTH MOVE Mark in classes 005 and 030 for the past 50 years, the fact that sales of Petitioner's SMOOTH MOVE tea product have grown to become the #1 bestselling laxative tea in the United States, the support of Petitioner's SMOOTH MOVE products by significant advertising and promotional investment, the prominence of Petitioner's SMOOTH MOVE tea products throughout the marketplace and public sphere, and the fame of Petitioner's SMOOTH MOVE products – in sum, all of Petitioner's common law and statutory rights in and to the mark SMOOTH MOVE.

4. Petitioner intends to renew its standing objections at trial or by summary judgment.

5. Petitioner's goods sold under its SMOOTH MOVE mark fully comply with the Food and Drug Act ("FDA") which classifies dietary supplements as food. *See* 21 U.S.C. § 321 (ff).

Registrant cannot use the Trademark Act to impose a classification of Petitioner's goods contrary to the FDA.

WHEREFORE, Petitioner prays that Registrant's Counterclaims be dismissed with prejudice and that Petitioner's Registrations Nos. 2,520,275 and 3,344,362 remain on the Principal Register without modification.

Dated this 29th day of October, 2024.

TRADITIONAL MEDICINALS, INC.

/Jeremy M Johnson/
Jeremy Johnson, Esq.
CA Bar # 266647
1400 Valley House Drive, Suite 120
Rohnert Park, CA 94928
Phone: 800-543-4372 / 707.823.8911
Email: jjohnson@tradmed.com

*Attorney for Petitioner,
Traditional Medicinals, Inc.*

CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that a true and correct copy of the foregoing Answer to Counterclaims has been served on counsel of record for Registrant, Smooth Teas, LLC via e-mail to:

Sergiy M. Sivochek
Sivochek IP Law Center
12450 Magnolia Blvd. #4071, Valley Village, CA 91607
docket@sivochek.com and sivochek@sivochek.com

This 29th day of October 2024.

/Jeremy M. Johnson/