

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

RA/wbc

Mailed: September 29, 2016

Opposition No. 91226144

OneMain Financial Holdings, LLC

v.

1 1 Main, LLC (formerly, Alibaba Group Holding Limited)¹

Wendy Boldt Cohen, Interlocutory Attorney:

On July 26, 2016, Applicant filed a proposed amendment to its application Serial No. 86141958, with Opposer's consent. It has come to the Board's attention that ESTTA, the Board's electronic system, granted Applicant's August 10, 2016, and September 9, 2016 motions to extend dates before an opportunity arose for consideration of the amendment filed by Applicant on July 26, 2016.

Applicant requests amendment to the identification of goods and services in classes 009, 016, 035, and 036; no changes are requested to the descriptions of services in classes 038, 041, 042, or 045:

IC 009: Scientific, nautical, photographic, optical, signaling, measuring, checking as in supervision, lifesaving apparatus and instruments, namely, telephones, punch clocks; time recording devices, namely, time clocks, scales and balances, graduated rulers, electronic pocket translators, neon signs, electronic notice boards, transparency projection apparatus, kilometer recorders in the nature of odometers for vehicles, telescopes; mechanisms for counter operated apparatus, namely, point-of-sale terminals, fire extinguishers; acoustic

¹ The Board notes Applicant's motion to change its named due to an assignment having been filed, the record has been updated to reflect the new name. Assignment was recorded under Reel 5698/Frame 0537.

sound alarms, namely, smoke and fire alarms; eyeglasses, batteries; exposed files, namely, exposed camera film; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electric wires, electric switches; electrolysis apparatus for electroplating purposes, electric welding apparatus, namely, torches; electrified fences, namely, electric fences; apparatus for recording, transmission or reproduction of sound or images; blank magnetic data carriers and recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; computer programs in the fields of business and e-commerce for use **in financial management, financial planning, business management**, customer relationship management (CRM), inventory management, sales force management, **planning and management of personal and business finances**, and marketing information management; **software for processing electronic payments to and from others; authentication software, namely, software for authenticating the identity of a payer.** ; computer software that may be downloaded from a global computer network for posting information, creating electronic product catalogs, responding to requests and placing and fulfilling orders for products, services and business opportunities via local and global computer networks, for use in document management, for searching, browsing and receiving transmissions of text, electronic documents, graphics and audiovisual information on local and remote area networks and global computer networks, on intranets, or on directories of information available on computer networks, for use in software development and web authoring, for use in exchanging information via global computer networks and online from a computer database and the internet, **for business use for financial management, financial planning**, business management, customer relationship management (CRM), inventory management, sales force management, **planning and management of personal and business finances**, and marketing information management, for data mining, for high-speed massive ecommerce data processing, and for data customization, all of the foregoing for use by third parties in connection with an interactive website in the field of e-commerce; downloadable electronic publications in the nature of magazines, articles, brochures, leaflets and datasheets containing information or instructions in the field of business and e-commerce; downloadable computer software to facilitate the electronic transmission of information, data, documents, voice, and images over the Internet; downloadable computer software which allows users to participate in web-based meetings and classes, and provides web-based access to data, documents, images and software applications through a web browser. downloadable computer software for accessing, viewing, and controlling remote computers and computer networks; Downloadable electronic publications in the nature of articles, papers, and instructional materials in the fields of telecommunications, the Internet, business and e-commerce training, business, sales, and marketing; computer software for use in the search and retrieval of computerized information from global information networks and network systems about hobbies, collectibles, auctions and products; computer peripherals; notebook computers; laptop computers; portable computers; handheld computers; personal digital assistants; personal portable media players; mobile telephones; smart phones; digital cameras; computer workstations comprising computers and computer monitors; servers, namely, computer servers; computer hardware for telecommunications; computer network adaptors, switches, routers and hubs; wireless and wired modems and communication cards and devices, namely, cable modems, computer fax modem cards, external modems, internal modems, modem cables, modems; laptop holders in the nature of protective sleeves and carrying cases, computer bags; fire-extinguishing apparatus; computer hardware and firmware for use in the field of business **for financial management**; computer software and

downloadable computer software for use in the field of business **for financial management and financial planning**; compact discs featuring music; computer programs and computer software for business for **financial management, financial planning**, business management, customer relationship management (CRM), inventory management, sales force management, planning and management of personal and business finances, and marketing information management, all in the field of e-commerce; digital music downloadable from the Internet;. telecommunications apparatus, namely, VOIP phones, network telephones, electronic facsimile machines, portable digital electronic device for sending and receiving electronic mails, and instant messaging communication tool in the nature of portable telecommunication instant messaging devices; mouse pads; mobile phone handsets; mobile phone accessories, namely, battery chargers, cases, covers, ear phones, headsets, and hands-free calling devices; downloadable computer game software, pictures, motion pictures, movies and music via the internet and wireless devices; alarm monitoring systems; security cameras; mobile radio and television broadcasting units, namely, transmitting and receiving apparatus for radio and television broadcasting and for long-distance transmission; television broadcasting equipment, namely, video cameras, film cameras, monitors, displays, audio monitors, audio recorders, video recorders, electronic switchers, cables, lighting, lenses, for audio and video signals, cables for the transmission of sounds and images, lights for use with video cameras and film cameras, camera lenses, camera tripods, camera cases, blank videotape, audio mixing boards, and video editing consoles; cameras; video cameras; headphones; ear pieces, namely, ear buds; speakers, namely, loud speakers; Global Positioning System (GPS) apparatus and equipment, namely, GPS systems; downloadable computer, electronic and video games programs and software via the Internet; liquid crystal displays for telecommunications and electronic equipment; set top box; remote control for radios, televisions, stereos, computers, video recorders, video game systems audio systems, and playback machines; data storage programs, namely, software used for the storage of electronic data and documents, data on hard discs, compact discs, tapes and optical discs; spectacles and sunglasses. **magnetically encoded bank credit, debit, cash and identification cards; automatic teller machines, cash dispensers**

IC 016: Newspapers; magazines, printed periodicals, and journals, in the field of business and e-commerce; paper, cardboard and goods made from these materials, not included in other classes, namely, computer paper and cardboard boxes; printed matter, namely, printed calendars, printed charts, newspapers, photographs, magazines, books, printed periodicals, newsletters, and brochures in the field of business, entrepreneurship, and e-commerce; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials, namely, easels, artists' brushes, pastels, pencils, pens, canvas panels, electrical wood burning pens, gesso, namely, plasters, and molds for modeling clays; paint brushes; Typewriters and office requisites, except furniture, namely, adhesive tape dispenser, correcting fluid for type, electric paper hole punch, paper drills, and perforators, fingerstalls, franking machines, envelope sealing machines, paper embossers, paper folding machines, and paper trimmers, rubber bands, and staplers; printed instructional and teaching material in the field of mathematics, science, literature, music, art, and writing; printed instructional and teaching material, namely, books and workbooks in the field of business and e-commerce; plastic materials for packaging, namely, plastic bags for packing and plastic bubble packs for packaging; printers' type; printing blocks; posters, printed cards, namely, business cards; circulars in the field of business and e-commerce; catalogs in the field of business and e-commerce; calendars; price tags; paper

price labels; carry bags, namely, paper bags, cardboard bags, and plastic bags for household use; printed telephone, electronic mail and web site directories. **cards in the form of debit cards, credit cards, charge cards and telephone calling cards not magnetically encoded;** marketing and promotional materials, namely, printed promotional materials of paper or cardboard; printed advertisements, namely, advertising pamphlets and advertising signs of paper and cardboard; user manuals in the field of business and e-commerce; packaging materials, namely, synthetic resin plastic bags for packaging, paper for packaging, cardboard packaging, and plastic bags and plastic bubble packs for packaging merchandise for shipping; facial tissues; handkerchiefs made of paper; paper mache figurines; paper party bags

IC 035: Advertising services; business management; business administration; providing office functions; **administration of customer loyalty programs and incentive award programs that provide discounts, coupons, rebates, vouchers and special offers for the goods of others;** advertising services provided via the Internet; production of television and radio advertisements; accountancy services; auctioneering; consultation relating to trade fairs; public opinion polling; data processing; provision of business information via global computer networks; advertising agency services; advertising services provided for others; database management; compilation of information into computer databases in the field of business and e-commerce; business consulting services in the field of in the field of ecommerce; business consulting services in the field of web based events, conferences, training programs, learning programs, and seminars; business consulting services in the field of delivering web-based knowledge; business consulting services in the field of online collaboration and collaboration technologies; business consulting services in the fields of sales and marketing; business management services, namely, business project management services; business management services in the nature of business project management services, namely, development, set up, staging, production, recording, monitoring and follow-up for web based events, conferences, training programs, learning programs, and seminars; market research and business consulting services in the field of business and e-commerce; business consultancy services relating to facilitating the transaction of business via local and global computer networks by locating and providing referrals for the delivery of a wide variety of business and consumer products and services. dissemination of business information of goods and services of others via local and global computer networks; business consultancy services in the field of global computer web sites where third parties can offer and source goods and services, place, determine the status of and fulfill trade leads and orders, enter into contracts and transact business; providing computerized online ordering services featuring a wide variety of general consumer, business, and industrial products and merchandise; advertising of goods and services of others via local and global computer networks; international import and export agency services; rental of advertising space on communication media; online trading services in which sellers post products to be auctioned and bidding is done via the Internet, and providing online business evaluation relating thereto; online retail store services featuring a wide variety of consumer goods of others; providing an online business directory of third party web sites to facilitate business transactions; business consultancy services in the field of operating an electronic marketplace for the buyers and sellers of goods and services on a global computer network; business assistance for others in the field of facilitating business transaction via local and global computer networks; corporate business management consultancy services; marketing and promotion services; publication of publicity materials; marketing services,

namely, providing videos to promote vacant premises; dissemination of advertising materials, updating of advertising materials, compilation of advertisements for use as web pages on the Internet; rental of advertising space; computer data processing. providing information concerning commercial sales, providing business information, providing a database of information pertaining to the promotional products industry; telephone answering service; auctioneering provided on the Internet; personnel management; provision of sales, business, advertising and promotional information through a global computer network and via the Internet; presentation of goods of others for retail purposes via the Internet; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site particularly specializing in the marketing of the sale of goods and services of others; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from retail. retail and wholesale store services featuring telephones, mobile phone handsets, mobile phone accessories, electronic and telecommunications goods, computer hardware and computer software, batteries, battery chargers, apparatus and instruments for recording, receiving, transmitting and reproducing data, information, pictures, images and sound, precious metals, jewelry, precious stones, printed matter, stationery and **magnetic and non magnetically encoded cards**, furniture, picture frames, household and kitchen utensils, glassware, porcelain and earthenware, textiles, clothing, footwear, headgear, laces and embroidery, buttons, ribbons, pins and needles, artificial flowers, carpets, rugs, games and electronic toys, chemicals used in industry, science, photography and agriculture, paints, varnishes and lacquers, personal hygiene products, soaps, perfumery, cosmetics, hair and body lotions, essential oils, cleaning and bleaching preparations, lubricants, fuels, candles, pharmaceutical, veterinary and sanitary preparations, ironmongery and small items of metal hardware, machines and machine tools, cutlery, razors and hand tools, computers, calculating machines, electrical, photographic, cinematographic and optical apparatus and instruments, spectacles and sun glasses, surgical and medical apparatus and instruments, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, vehicles, firearms, fireworks, silverware, horological and chronometric instruments, musical instruments, magazines, cards, paper and cardboard products, namely, computer paper, cardboard boxes and office stationery, pictures, typewriters and office requisites, packaging materials, rubber and plastics for manufacturing use, packing and insulating materials, leather and imitations of leather and goods made from these materials, handbags, purses, wallets, leather holders, bags, luggage, umbrellas, mirrors, ropes, string, nets, tents, yarns and threads for textile use, coat hangers, place mats. dressmaker's articles, bed and table covers, playthings and sporting articles, foodstuffs and beverages, meat, fish, poultry, preserved, dried and cooked fruits and vegetables, jams and fruits sauces, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, flour, bread and cakes, condiments, fresh fruit and vegetables, beer, mineral water, fruit juices and other non-alcoholic drinks, alcoholic beverages, floral products, tobacco, smokers' articles and matches; direct mail advertising services; buying and selling agency services, namely, purchasing a wide variety of consumer, business and industrial products and services for others; selection of goods and procurement of goods for individuals and businesses, namely, purchasing of a wide variety of consumer, business and industrial products and services for individuals and businesses; online ordering services featuring a

wide variety of consumer goods of others; retail department store services; retail supermarket services; secretarial services; provision of business statistical information; organization of exhibitions for commercial or advertising purposes; business assistance services, namely, compilation and rental of marketing mailing lists; business investigation; business administration consultation services in the field of processing of sales made on the Internet; business networking referral services and personnel placement; import-export agency services; arranging newspaper subscriptions for others; document reproduction; transcription, namely, conference call, message and stenographic transcription; rental of office equipment; customer relationship management; business management services relating to electronic commerce; business management and administration services relating to promotional sponsorship programs; accounting services; charitable services, namely, organizing and conducting volunteer programs and community service projects. providing a website on a global computer network by which third parties can offer goods and services, place and fulfill orders, enter into contracts and transact business

IC 036: Insurance services, namely, **multiple listing services for third party insurance agencies, and provision of shipping insurance; financial affairs and monetary affairs, namely, multiple listing services for third party financial analysis advisors; and online escrow service for exchange of goods and services; real estate affairs, namely, assessment and management of real estate, providing information in the field of real estate via the internet; clearing and reconciling financial transactions via a global computer network, namely, providing secure commercial transactions and payment options; online banking services and online financial planning services; credit card services; electronic payment, namely, electronic processing and transmission of bill payment data; underwriting insurance for financial transactions; electronic funds transfer services; transfer of funds by electronic means for others; transfer of electronic payments for others via the internet; financial services in the nature credit card and debit card payment processing services;** real estate management services, namely, management of leases and rental agreements; real estate rental and leasing services, namely, rental and leasing of rental property, commercial property, offices, vacation homes, condominiums, offices, apartments, and flats; leasing of real estate; real estate appraisal; **real estate valuation, real estate financing, real estate investment services;** real estate brokerage services; real estate agency services; housing agency services; actuarial services; real estate management and real estate consultancy services; rent collection; rental of office space; rental of apartments and flats; **provision of financial information via the Internet;** safety deposit box services, and issuing of travel vouchers services, namely, providing vouchers for payment of transportation expenses; **capital investments services; financial evaluation in the field of insurance, banking, and real estate. financial and financial asset management services; financial services, namely, debt settlement and providing electronic processing of credit card transactions and electronic payments provided by telecommunication means; financial consultancy and advisory services; home banking; banking services provided online from a computer databases or the Internet; securities brokerage services, stock exchange quotation services; stocks and bonds brokerage, financial analysis; debit card services, charge card services and check verification services; banking, savings account and investment banking services; financial clearing house services; credit card verification via global computer information network; electronic credit risk management services; electronic purchase payment and electronic bill payment services, namely, electronic payment services involving electronic processing and subsequent transmission of bill payment data; financial accounts debiting and crediting services, namely, providing credit and debit card payment**

processing services and lines of credit; electronic banking services via a global network; issuance of stored value cards, and charge cards and debit cards services; telephone credit cards services, namely, telephone calling cards services; providing finance and insurance information online from a computer database or Internet; collection agency for collection of unpaid gas and electricity fees; antique appraisal; art appraisal; jewelry appraisal; used car appraisal; charitable fund raising; rental of paper money and coin counting machines; rental of cash dispensers or automated-teller machines; online payment services, namely, electronic processing of credit card transactions and electronic payments via a global computer network; providing links to the web sites of others to facilitate e-commerce and real world business transactions, providing toll road, namely, highway toll collection services

Inasmuch as the amendment is limiting in nature as required by Trademark Rule 2.71(a), and because opposer consents thereto, the amendment is approved and entered. *See* Trademark Rule 2.133(a).

If the amendment resolves this proceeding, opposer is allowed until thirty days from the mailing date of this order to file a withdrawal of the opposition, failing which the opposition will go forward on the application as amended. *See* Trademark Rule 2.106(c).

If no response is filed, proceedings will be resumed and dates reset, as appropriate.

Proceedings are otherwise suspended.