



# IP NEWS QUARTERLY



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## COLOR TRADEMARKS

### Introduction

The cellular telephone company T-Mobile (via their parent company Deutsche Telekom) recently sent a cease and desist letter to the insurance company Lemonade for their use of the color magenta, claiming the use of magenta is protected by T-Mobile's trademark. Subsequently, Lemonade filed to invalidate T-Mobile's claim of exclusive use of the color magenta in the European Union. This issue of IP News Quarterly will provide a brief history of color trademarks in the United States, and then examine T-Mobile's color trademark and litigation record.

### History of Color Trademarks

In the United States, a color can be trademarked in connection with a good or service within a specific field. The color cannot have a specific function, such as an amber medicine bottle designed to block light that degrades the medicine, or the pink of an antacid such as "Pepto-Bismol," as Bismuth Subsalicylate, the active ingredient, is what gives the antacid its distinctive pink color. In light of these limitations, in order to obtain a trademark on a color, the applicant must show that the color associated with the product does not serve any function, but does designate the applicant's good or service over other similar goods and services. This showing of distinctiveness is typically completed through consumer surveys or other similar means of evaluating the public's views.

In 1906, the Supreme Court decided that an applicant could not receive a trademark on color alone. However, in 1946 the Lanham Act was passed, which greatly increased the protection and scope of trademarks, and opened the door for color trademarks. After this, a number of trademarks were granted for marks whose distinguishing feature was the color, but it was not until 1987 that the first color trademark in the US was issued. This trademark was obtained by Owens-Corning Fiberglas Corporation (registration number 1,439,132) for pink colored fibreglass insulation. While initially denied by the United States Trademark Trial and Appeal Board, the Federal Circuit overturned this decision in 1985 *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1128 (Fed. Cir. 1985). In this case, Owens-Corning relied upon their "think pink" advertising campaign and their use of pink insulation since the 1950s, and additionally proved that the pink coloring did not offer any functional benefit, but was merely ornamental.

However, subsequent court decisions contradicted the Owens-Corning decision, using mainly the "color depletion theory," or the idea that since there are a limited number of colors, giving a color trademark is anti-competitive as it depletes or limits the number of products possible in a given field. Thus, it was not until 1995 in the US Supreme Court case *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995) that it was officially solidified that color trademarks were allowed. Similar to the Owens-Corning case, Qualitex Company had been using a shade of green-gold in press pads since the 1950s, and sued a competitor, Jacobson Products, after they started using a similar color. In order to strengthen their lawsuit, Qualitex obtained a registration on their gold-green cleaning pads in 1991 (registration number 1,633,711). While initially winning the suit in the District Court, the Ninth Circuit Court of Appeals overturned the victory, as they believed that a color trademark was invalid. As mentioned above, the Supreme Court reverted back to the original decision, granting a victory to Qualitex and codifying the principle that color trademarks were valid within the above-discussed limitations.

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### Did You Know?

Likely the most distinctive and longstanding color trademark is "Pantone 1837" or "Tiffany Blue," which has been in use by Tiffany & Co. since 1845, although not officially registered in the United States until 2000 (registration number 2,359,351). Initially used for the cover color of their annual "blue book" catalog in 1845, Tiffany later expanded this color's use to shopping bags, advertisements, jewelry boxes, hotel suites, and even briefly, in 2018, on taxis in New York City. In 2001, Tiffany & Co. started working with Pantone to standardize their robin's-egg blue color, which was titled "Pantone 1837" after the founding date of Tiffany & Co.

Other notable color marks include Tiffany Blue, Target Red, John Deere Green, and UPS Brown. Some of these even have Pantone colors named after them.

### **T-Mobile's Litigation Record**

T-Mobile has a number of trademarks featuring the magenta in the United States (registration numbers 3,037,885 and 4,787,781, and application numbers 87/390,932 and 88/030,291), as well as others worldwide, and has a history of defending its use of magenta, with mixed success. In 2013, T-Mobile sued Aio Wireless over the use of a plum color, alleging this was similar to magenta and infringed on their trademark. In 2014, the courts sided with T-Mobile and blocked Aio from using "large blocks or swaths of Pantone 676C and confusingly similar shades in its advertising, marketing, and store design" (*T-Mobile US, Inc. v. AIO Wireless LLC*, 991 F. Supp. 2d 888, 931 (S.D. Tex. 2014)). However, in Denmark, T-Mobile lost their case against the cell carrier Telia, as the courts determined that the companies did not have a similar market and that the color Telia used was different enough from T-Mobile's trademarked magenta. Similarly, T-Mobile has had various degrees of success with claims of infringement of the magenta color. For example, the smartwatch company OXY modified their accused material, while others refused to remove the material or even fought back against T-Mobile's claims.

As previously mentioned, the insurance company Lemonade is fighting back against T-Mobile's claims, filing to invalidate T-Mobile's color trademark in the European Union Intellectual Property Office. While they did change their website's color from pink to red in German markets, they have pointed out that T-Mobile uses a different, slightly brighter, color than what is trademarked, and that both of these colors are different from the pink that Lemonade uses. Additionally, Lemonade asserts that it has been using pink since its founding in 2015. In its defense, T-Mobile claims that it has businesses beyond just wireless service and wants to ensure a lack of confusion by customers when viewing the color magenta. Although likely a poor argument, T-Mobile does offer insurance plans on phones and cyber-security, which they may be able to use in their favor to show that they have competing markets.

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### **The Value of a Color Trademark**

While not for everyone, color marks can be useful marketing tools and can set products or services apart from their competitors. However, obtaining a color mark can be costly and difficult as one needs to prove non-functionality and acquired distinctiveness in addition to the typical trademark requirements. If you think a color trademark would help your company, the trademark attorneys at IP Attorneys Group can help guide you through this process.



Learn more about us at  
[www.ipattorneysgroup.com](http://www.ipattorneysgroup.com)



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