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Legal Framework for Protecting Product Design and Combating Counterfeits

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Legal Framework for Protecting Product Design and Combating Counterfeits

By [Shigehiro Kawase](#)

[Isshiki & Partners](#)

1 Introduction

Product design is more than the external appearance of a product. It is a critical element of product development because it creates consumer appeal and strengthens a brand’s competitive power. Yet despite the substantial investment typically required to develop a product design, imitation is often easily accomplished. To effectively counter such imitation, it is essential to understand how product designs can be legally protected.

This article provides an overview of the key legal frameworks in Japan relevant to product design protection and anti-counterfeiting—namely, the Design Act, the Trademark Act, the Copyright Act, and the Unfair Competition Prevention Act.¹ It explains the scope and effect of protection under each regime and briefly summarizes the advantages and disadvantages of each legal approach.

2 Overview of Relevant Laws

2.1 Design Act

(1) Overview

The Design Act is a statute that protects “designs” — meaning the shape, patterns, or colors of articles, or a combination thereof — as intellectual property. When a product design is filed with the Japan Patent Office as a design and subsequently registered, that product design becomes protected by a design right.

Examples of Registered Designs



Design Registration No. 1574793²



Design Registration No. 1411571³



Design Registration No. 1507942⁴

¹ English translations of these Acts are available on the Japanese Law Translation website maintained by the Japanese government.

² Designs related to Nintendo Co., Ltd.’s Nintendo Switch.

³ Designs related to Suntory Holdings Limited’s oolong tea PET bottles.

⁴ Designs related to industrial robots manufactured by DENSO WAVE Incorporated.

(2) Effect of Design Registration

When a design right is registered, the holder of the design right “has the exclusive right to practice the registered design and designs similar thereto in the course of trade” (Design Act, Article 23). As a result, if a third party commercially practices the registered design or a similar design—such as by manufacturing, using, transferring, etc., an article embodying the design (Design Act, Article 2(2))—the design right holder may seek an injunction against such manufacture or other acts (Design Act, Article 37(1)) and may also claim damages (Civil Code, Article 709).

(3) Advantages and Disadvantages of Protection Under the Design Act

A. Advantages

- (i) Once a design right is registered, the filed design is protected for up to 25 years from the filing date. During this period, the design right holder may exclusively use the registered design and any similar designs.
- (ii) Compared to registering a product design as a trademark, design registration is easier because the design is not required to function as an indicator of source.
- (iii) Claims and proof of infringement are relatively straightforward for the following reasons:
 - Unlike protection under copyright law or under the Unfair Competition Prevention Act for “imitation of product configuration,” it is not necessary to prove that the accused product was created by “copying” (i.e., relying on) the registered design.
 - Unlike protection under the Unfair Competition Prevention Act for acts causing confusion or misappropriation of well-known indications, it is not necessary to prove that the design is well-known or famous.

B. Disadvantages

- (i) Filing a design application and maintaining a design right entail costs.
- (ii) As a rule, only designs that are new at the time of filing may be registered (Design Act, Article 3(1)). Because a design application must be filed before the product is placed on the market, design protection cannot be limited only to products that later become popular.
- (iii) Because it generally takes about seven months from filing to registration, the system is not well-suited for protecting product designs in fields with short life cycles—such as fashion—where designs are strongly influenced by temporary trends. Even for products with long life cycles, such as automobiles, enforcement against counterfeit products is not possible until the design right is officially registered.
- (iv) Because the scope of protection can be relatively narrow, it may be necessary to file and register related designs in order to protect variations that are similar to the registered design.

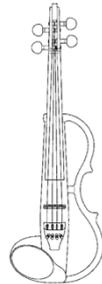
2.2 Trademark Act

(1) Overview

The Trademark Act protects “trademarks”—indications that function to identify the source of goods or services—as intellectual property. Trademarks eligible for protection include not only words and logos, but also

three-dimensional shapes and colors (Trademark Act, Article 2(4)(i)). Thus, when a product design is recognized as indicating the source of goods or services, it may be filed and registered as a trademark; upon registration, that product design is protected as a trademark right.

Examples of Registered Trademarks



Registration No. 5922528⁵



Registration No. 6757445⁶

(2) Effect of Trademark Registration

Once a trademark is registered, the trademark owner “has the exclusive right to use the registered trademark for the designated goods or designated services” (Trademark Act, Article 25). As a result, when a third party uses the registered trademark on the designated goods or services (such as by affixing the mark to goods; Trademark Act, Article 2(3)), the trademark owner may seek an injunction against such use (Trademark Act, Article 36(1)) and may also claim damages (Civil Code, Article 709).

(3) Advantages and Disadvantages of Protection Under the Trademark Act

A. Advantages

- (i) Trademark rights may be renewed indefinitely, allowing the holder to monopolize the product design for the designated goods on a near-permanent basis.
- (ii) Because novelty is not required for trademark registration, a product design may be registered even after the product has already been introduced to the market.

B. Disadvantages

- (i) Filing a trademark application and maintaining a trademark right entail costs.
- (ii) Under case law, “where the shape of goods is adopted for the purpose of contributing to the function or aesthetic appeal of the goods, such shape will, absent special circumstances, fall under Article 3(1)(iii) of the Trademark Act as consisting solely of a mark used in a customary manner for the shape of the goods” (IP High Court, April 21, 2011, Hanrei Times No. 1349, p. 187). Accordingly, unless the design has acquired source-identifying distinctiveness through uniqueness or continuous use (Trademark Act, Article 3(2)), registration as a trademark is unlikely.

⁵ Designs related to Yamaha Corporation’s Silent Violin.

⁶ Designs related to LIFE GUARD products by Cheerio Japan Co., Ltd.

Cases involving Article 3(1)(iii) and Article 3(2)



Registration No. 6312530⁷ (Registered)



Trademark Application 2018-133223⁸ (Rejected)

- (iii) Product designs that consist of (or naturally include) three-dimensional shapes, colors, or sounds that goods inherently possess cannot be registered as trademarks (Trademark Act, Article 4(1)(xviii); Enforcement Order, Article 1-2).
- (iv) Because it generally takes about eight months from filing to registration, the system is not well-suited for protecting designs in fields with short life cycles—such as fashion—where designs are heavily influenced by temporary trends. Even for products with long life cycles, such as automobiles, enforcement against counterfeits is not possible until registration is complete.
- (v) If the accused product uses the design in a manner that “does not enable consumers to recognize the goods or services as those of a particular business” (i.e., not a trademark use), the trademark right does not extend to such use (Trademark Act, Article 26(1)(vi)). Therefore, when a design is used both as a product design and as a trademark, the trademark owner must assert and prove that the design is also being used as a trademark. This creates a higher threshold for establishing infringement.

2.3 Copyright Act

(1) Overview

The Copyright Act protects intellectual property in works that creatively express thoughts or emotions. When a product design qualifies as a “work” under Article 10 of the Copyright Act, that product design becomes eligible for copyright protection.

(2) Effect of Copyright

Once copyright arises, the copyright holder enjoys various exclusive rights, including the right of reproduction

⁷ Designs related to Godzilla. These were filed as three-dimensional trademarks. In the IP High Court decision of October 30, 2024 (Reiwa 6 (Gyo-Ke) No. 10047), the court held that although the applied-for trademark fell under Article 3(1)(iii) of the Trademark Act, Article 3(2) applied, and registration was therefore allowed.

⁸ The design of Hermès’ packaging boxes. This was filed as a color-combination mark. In the IP High Court decision of March 11, 2024 (Reiwa 5 (Gyo-Ke) No. 10095), the court held that Article 3(2) of the Trademark Act did not apply, and registration was therefore not permitted.

(Copyright Act, Articles 18 et seq.). As a result, if a third party uses the copyrighted work without authorization—such as by reproducing or adapting it—the copyright holder may seek an injunction against such use (Copyright Act, Article 112(1)) and may also claim damages (Civil Code, Article 709).

(3) Advantages and Disadvantages of Protection Under the Copyright Act

A. Advantages

- (i) Copyright arises automatically at the moment the work is created (Copyright Act, Article 17(2)). No registration or other formalities are required.
- (ii) Copyright protection lasts for 70 years after the author’s death (or, in the case of a corporate work, 70 years after publication), allowing the copyright holder to monopolize the product design for an extended period.

B. Disadvantages

- (i) Product designs often fall within the category of applied art. Copyright protection is generally limited to cases where the portion capable of aesthetic appreciation can be identified “separately from the functional configuration necessary to achieve a utilitarian purpose.”

Examples of Court Decisions



Design held copyrightable⁹



Design held not copyrightable¹⁰

- (ii) Unlike under the Design Act, it is necessary to prove that the accused product was created by relying on (i.e., copying) the copyrighted work. Asserting and proving such reliance can present a significant evidentiary hurdle.

⁹ Regarding the illustrated portion of a T-shirt, the Tokyo District Court held that the aesthetic characteristics of the illustration remain unchanged when the garment is worn, and that such characteristics can be appreciated separately from the functional elements necessary to achieve the utilitarian purpose of clothing. The court thus recognized copyright protection (Tokyo District Court, Sept. 29, 2023, Reiwa 3 (Wa) No. 10991). Flat designs such as illustrations tend to have a weaker connection to practical functionality and therefore are more likely to be protected by copyright.

¹⁰ Regarding a slide shaped like an octopus, the IP High Court held that the overall configuration was necessary to achieve the utilitarian purpose of a slide, and that any separable elements were commonplace. Accordingly, copyright protection was denied (IP High Court, Dec. 8, 2021, Reiwa 3 (Ne) No. 10044). Three-dimensional product shapes are generally more difficult to protect by copyright because of their strong link to practical functionality.

2.4 Unfair Competition Prevention Act – Acts of Imitating Product Configuration

(1) Overview

The Unfair Competition Prevention Act provides that transferring or otherwise dealing in goods that imitate the configuration of another person’s goods constitutes an act of unfair competition (acts of imitating product configuration; Article 2(1)(iii)). Under the Act, the “configuration of goods” refers to the external and internal shapes of goods, as well as patterns, colors, luster, and texture that are perceptible to consumers during normal use (Article 2(4)). The configuration must (i) not be indispensable for securing the function of the goods and (ii) not be a configuration that is commonplace as the overall configuration of the goods (see, e.g., Tokyo District Court, Oct. 18, 2023, Reiwa 3 (Wa) No. 25324). A product design satisfying these requirements qualifies as a “configuration of goods” and may be protected under the Unfair Competition Prevention Act.

Examples of Designs Protected under Article 2(1)(iii)



Women’s dress¹¹



Saxophone strap¹²

(2) Effect of Protection Under the Unfair Competition Prevention Act

If a product design qualifies as a “configuration of goods,” and a third party transfers or otherwise deals in goods that imitate that configuration, the right holder may seek an injunction against such acts (Article 3(1)) and may also claim damages (Article 4).

(3) Advantages and Disadvantages of Protection for Acts of Imitating Product Configuration

A. Advantages

- (i) Protection is available without any registration or other formal procedures.
- (ii) Because protection attaches once the product is placed on the market, the system is suitable for protecting product designs in industries with short life cycles—such as fashion—that are highly sensitive to temporary trends. It can also serve as interim protection until a design registration under the Design Act is completed.

B. Disadvantages

- (i) The protection period is limited to three years from the commencement of sales in Japan (Article

¹¹ Tokyo District Court, Oct. 18, 2023, Reiwa 3 (Wa) No. 25324.

¹² IP High Court, Jan. 24, 2019, Heisei 30 (Ne) No. 10038.

19(6)(i)). For products that are model-changed versions of an existing product, the three-year period is generally counted from the date the original product was first sold, unless the model change involves a feature that would attract consumer attention.

- (ii) Unlike under the Design Act, it is necessary to prove that the accused product was created by relying on (i.e., copying) the configuration of the original goods. This can create a significant evidentiary hurdle in asserting and proving infringement.

2.5 Unfair Competition Prevention Act – Acts Causing Confusion and Misappropriation of Well-Known Indications

(1) Overview

The Unfair Competition Prevention Act prohibits (i) acts that cause confusion with another person's goods or services through the use of another's well-known indication (acts causing confusion; Article 2(1)(i)), and (ii) acts that use another's famous indication (acts of misappropriating well-known indications; Article 2(1)(ii)). Although the configuration of a product is not inherently intended to serve as a source identifier, a product design may qualify as a "goods or business indication" if, through continuous use or other circumstances, it comes to indicate a particular source. In such cases, the product design may be protected under the Act.

(2) Effect of Protection

If an act causing confusion or an act of misappropriating a well-known indication is committed, the right holder may seek an injunction against such use (Article 3(1)) and may also claim damages (Article 4).

(3) Advantages and Disadvantages of Protection Under the Unfair Competition Prevention Act (Acts Causing Confusion and Misappropriation of Well-Known Indications)

A. Advantages

- (i) Protection is available without any registration or other formal procedures.
- (ii) Because novelty is not required, product design protection may be obtained even after the product has been placed on the market.
- (iii) As long as the indication is well-known or famous, protection can continue indefinitely.
- (iv) The scope of protection may be broader than that under the Design Act because the existence of prior registered designs does not narrow the scope of the right.

B. Disadvantages

- (i) Because these provisions primarily protect source-identifying indications, protection for product configurations is limited to designs that possess objectively distinctive features enabling consumers to recognize the goods as originating from a particular source (see, e.g., IP High Court, July 27, 2016, Hanrei Times No. 1432, p. 126).

Examples of Cases where Distinctiveness was at issue



*Boot design (distinctiveness affirmed)*¹³



*High-heel design (distinctiveness denied)*¹⁴

- (ii) Because it is necessary to assert and prove that the indication is well-known or famous, the evidentiary burden is higher compared to other legal frameworks.

3 Conclusion

As discussed above, product design protection and anti-counterfeiting measures in Japan may be pursued under various legal frameworks, including the Design Act, the Trademark Act, the Copyright Act, and the Unfair Competition Prevention Act. Each framework, however, has advantages and disadvantages in terms of the requirements for protection.

Which law or combination of laws should be used depends on the nature of the product and the business strategy. For example, for products with short life cycles, it may be more efficient to rely on the Unfair Competition Prevention Act (acts of imitating product configuration) rather than incurring the cost of filing a design application. For products expected to remain popular over a long period, filing a design application may be appropriate. For products that are strongly tied to brand image and are expected to require longer-term protection, trademark registration may be considered.

It is also important to consider strategic combinations of these laws—for instance, enforcing rights under Article 2(1)(iii) of the Unfair Competition Prevention Act until a design registration is granted, or enhancing the notoriety or fame of a product design during the period in which protection under the Design Act or Copyright Act is available, and then seeking trademark registration thereafter.

¹³ Concerning the DR. MARTENS boot configuration, the IP High Court found that several elements—such as the yellow welt stitching—had “special remarkable distinctiveness” as a goods indication (IP High Court, Dec. 26, 2022, Reiwa 4 (Ne) No. 10051).

¹⁴ Regarding the red outsole of Christian Louboutin high heels, the Tokyo District Court held that it lacked special remarkable distinctiveness as a goods indication (Tokyo District Court, Mar. 11, 2022, Heisei 31 (Wa) No. 11108). The IP High Court did not rule on distinctiveness in the appeal (IP High Court, Dec. 26, 2022, Reiwa 4 (Ne) No. 10051).

It is hoped that this article will serve as a useful reference in developing strategies for product design protection and anti-counterfeiting measures.

Summary of Legal Frameworks

Law	Advantages	Disadvantages
Design Act	<ul style="list-style-type: none"> • Protection for up to 25 years from the filing date • No requirement of source-identifying distinctiveness • Infringement claims and proof are relatively straightforward 	<ul style="list-style-type: none"> • Costs for filing and maintaining rights • Design must be new at the time of filing • Time required until registration • Scope of protection may be relatively narrow
Trademark Act	<ul style="list-style-type: none"> • Potential for perpetual protection through renewal • Novelty not required 	<ul style="list-style-type: none"> • Costs for filing and maintaining rights • Must possess source-identifying distinctiveness • Time required until registration
Copyright Act	<ul style="list-style-type: none"> • No registration required • Protection for 70 years 	<ul style="list-style-type: none"> • Only limited categories of designs are protectable • Higher evidentiary burden for proving copying
Unfair Competition Prevention Act (Imitation of Product Configuration)	<ul style="list-style-type: none"> • No registration required • Protection available immediately upon sale 	<ul style="list-style-type: none"> • Short protection period (3 years) • Higher evidentiary burden for proving copying
Unfair Competition Prevention Act (Acts Causing Confusion / Misappropriation of Well-Known Indications)	<ul style="list-style-type: none"> • No registration required • Novelty not required • Potential for perpetual protection 	<ul style="list-style-type: none"> • Design must have distinctive (“special remarkable”) features • Must prove the design is well-known or famous

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About the Authors and Firm



Shigehiro Kawase

Attorney (Japan)

shigehiro.kawase@isshiki-law.com

Shigehiro Kawase

After beginning his career as a systems engineer at a leading Japanese electronics manufacturer, Shigehiro qualified as an attorney and gained experience at law firms handling intellectual property matters and venture-related legal work. He later joined Isshiki & Partners as an associate. His practice includes representing clients in technology disputes involving software and systems, as well as in brand-related conflicts, fashion design disputes, and a broad range of other civil matters.

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