

Package design protection in Japan

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Introduction

Industrial design registrations

Trademark registrations

Comment

Introduction

When used consistently, package designs can act as brand symbols and identifiers. As such, they are increasingly valuable to brand owners. However, if a package design is used or imitated by third parties, its value to the brand will decrease and may even disappear. Brand owners should therefore protect their package designs in order to prevent third-party use or imitation. This update introduces ways to obtain and enjoy legal protection for package designs in Japan based on the most recent practice, which can enable brand owners to maintain and even increase the value of their brand.

The simplest way to protect a package design is to obtain an industrial design or trademark registration, the advantages and disadvantages of which are as follows.

| | Advantages | Disadvantages |
|--|--|---|
| Industrial design registrations | <ul style="list-style-type: none"> • Distinctiveness/non-descriptiveness not required • Protection extends to manufacture • No legal obligation to use design | <ul style="list-style-type: none"> • Novelty of designs required (disclosed designs not protected) • Limited time protection |
| Trademark registrations | <ul style="list-style-type: none"> • Novelty of designs not required • Permanent protection in case of renewal | <ul style="list-style-type: none"> • Three-dimensional (3D) designs, in particular, may be considered non-distinctive • Legal obligation to use designs as trademarks (non-use will lead to cancellation) |

Industrial design registrations

Package designs with configuration features

Confectionery packaging

The following confectionery package designs were registered as industrial designs by the same registrant.



Registered Design 1494832



Registered Design 1476252

Registered Design 1494832 is specified by drawings represented by solid lines. Registered Design 1476252 is specified by photographs. The latter indicates the product design used in the market.

The Japan Patent Office (JPO) found that the earlier registered design (1494832) was not similar to the later registered design (1476252).

It could be argued that the scope of the registration was not sufficiently broad. However, the configuration of Registered Design 1476252 is identical to that of Registered Design 1494832, with additional elements (eg, letters and colours). As such, under the Design Act, the protection afforded to Registered Design 1494832 extended to Registered Design 1476252.

The same registrant also obtained an industrial design registration for the following package design.



Registered Design 1495118

Registered Design 1495118 is registered in Japan as a related design of Registered Design 1494832, which means that the two designs are considered to be similar. Under the Design Act, protection of a registered design extends to other identical or similar designs.

When obtaining an industrial design registration for a related design, the scope of the similarity of the registered design must be clear and definite.

In light of the above, the registrant obtained sufficiently broad protection for its package design.

PET bottles

The following polyethylene terephthalate (PET) bottle design was registered as an industrial design.

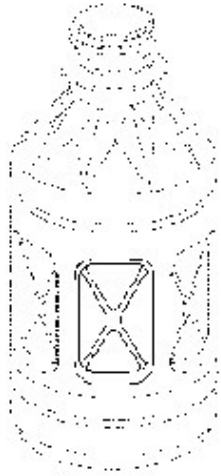


Registered Design 1522612

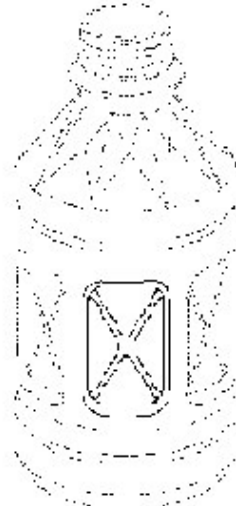
The registrant held that the vertically long rectangle segments featuring an X shape were the dominant elements of the design. In order to protect the segments adequately, the registrant also obtained the following industrial design registrations.



Registered Design
1524964



Registered Design
1525275



Registered Design
1525277



Registered Design
1525276

The registrant claimed the elements represented by solid lines and disclaimed those represented by dotted lines. The protection provided by the registrations extends to PET bottles that have identical or similar vertically long rectangle segments featuring an X shape, as represented in the drawings, even if the bottle shapes are different.

The four registered designs were registered in Japan as related designs. This means that the JPO considered all four designs to be similar, even though the shape of the rectangle segments (represented by solid lines) of Registered Designs 1524964 and 1525275 are slightly different to the corresponding segments of Registered Designs 1525277 and 1525276.

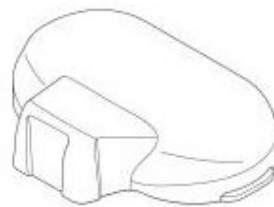
In light of the above, the registrant obtained sufficiently broad protection for its package design.

Bottle caps

If part of a package or bottle (eg, its cap) has essential design features, the design for that part can be registered as an industrial design. For example, the following packaging parts were registered as industrial designs.



Registered Design 1491573



Registered Design 1548716

The protection of a registered design pertaining to part of a package or bottle extends to other parts of similar or identical design, as well as the package or bottle that includes the parts.

Registered designs with essential graphical features

In Japan, package designs with essential graphical features are registrable, even if the package's configuration is common.

The following images are examples of registered designs for packages with graphical features.



Registered Design 1509479



Registered Design 1541833



Registered Design 1554230



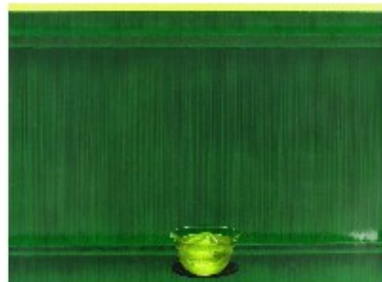
Registered Design 1554505

The industrial design registrations pertaining to the cans (Registered Designs 1554230 and 1554505) were registered as related designs. The scope of similarity between the two designs is clear and definite.

Designs for labels to be affixed to packaging bottles can also be registered as industrial designs. Examples are as follows.



Registered Design 1548716



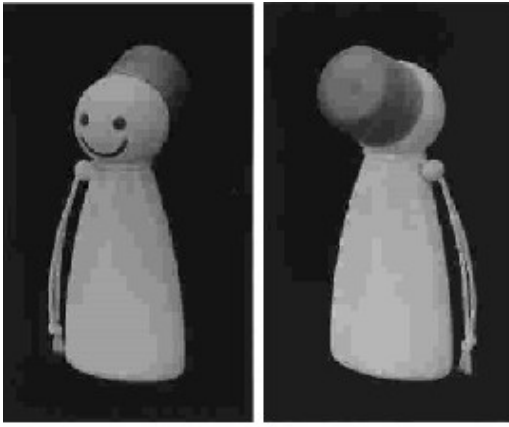
Registered Design 1422990

The protection afforded to a label that is registered as an industrial design extends to other labels of similar or identical design, as well as to the package to which the labels of similar or identical design are affixed.

Under the Design Act, only graphical elements cannot be registered as industrial designs (eg, logos and surface patterns).

Trademark registrations

It is also possible to obtain protection for a package design by way of a 3D trademark. Japan's 3D registration system was established on April 1 1997; however, for several years after it was established, the standards of judgement concerning the distinctiveness of 3D trademarks were strict. It was therefore extremely difficult to register 3D shapes that contained no distinctive elements (eg, characters or devices) as 3D trademarks, unless acquired distinctiveness through extensive use could be demonstrated. For example, the following package designs, which appear to have distinctive elements, were rejected on examination or appeal as mere indications of common product or packaging shapes, as the applicants failed to prove that the shapes had acquired distinctiveness through extensive use in the market.



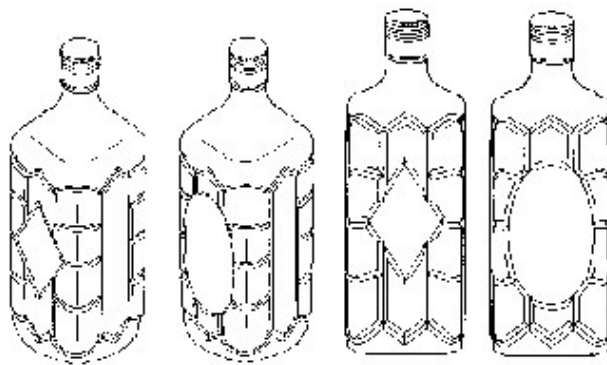
Application H09-102039
 Application date: April 1 1997
 Designated goods: waterproofing chemicals for leather shoes in Class 1



Application H09-170665
 Application date: October 27 1997
 Designated goods: chocolate in Class 30



Application 2000-10934
 Application date: January 21 2000
 Designated goods: regional wine (among other things) in Class 33



Application H09-191566
 Application date: April 1 1997
 Designated goods: whiskey in Class 33

As was the case for the above rejected applications, when the shape of a package design which is the subject of a 3D trademark application is deemed not to go beyond the scope of the shape of the goods or packaging, the application will be rejected due to non-distinctiveness.

It is relatively easy to register a package design with distinctive elements or devices as a 3D trademark. However, even if such a registration is obtained, it is unclear whether:

- the object of substantial protection is only the distinctive elements or devices; or
- the package design itself can be protected.

The registration may be meaningful in terms of an implied warning against a potential third-party trademark application for a package design similar to the registrant's package design. However, it may be impossible to exercise rights against a similar package design that contains different elements or devices (or does not contain any). Therefore, from the viewpoint of eliminating the shape of a similar package design, registration of only a 3D shape as a 3D trademark is desirable.

Judgement criteria for distinctiveness of 3D trademarks: recent trends

To provide a basic understanding of the criteria for judging the distinctiveness of a 3D trademark, in April 2016 the JPO published the Trademark Examination Manual, which reads as follows:

"Basic Concept

(1) When it is recognized that the three-dimensional shape is adopted for the purpose of contributing to the function or aesthetic sensation of goods, etc., unless there are special circumstances, it is judged that it will not go beyond the scope of the shape of the product, etc.

(2) Even if the three-dimensional shape is characterized by being changed from an ordinary shape or by being decorated or the like, as long as the consumers can presume that such changes or decorations have been made for the purposes of function or aesthetic sensation, the three-dimensional shape is recognized as being adopted for the purpose of contributing to the function or aesthetic sensation of goods, etc., and unless there are special circumstances, it is considered merely the shape of the goods itself."

As package designs are usually adopted for the purpose of contributing to a product's function or aesthetic, when this basic concept is interpreted literally, the above examples of rejected applications seem reasonable.

However, in recent examination practice, an increasing number of 3D trademarks with no distinctive elements or devices, for which acquired distinctiveness was not argued or granted, have been registered. This is arguably because the JPO intends to harmonise its practice with that of the EU Intellectual Property Office, which has granted 3D trademarks for many package designs. For example, the JPO granted 3D trademarks for the following designs, which include no distinctive elements or devices, without requiring proof of their acquired distinctiveness.



Registration 5461410

Registration date: January 6 2012

Designated goods: carbonated beverages (among other things) in Class 32



International Registration 1225398

International registration date: October 30 2015

Designated goods: oil and grease for industrial use (among other things) in Class 4



Registration 5822945

Registration date: January 29 2016

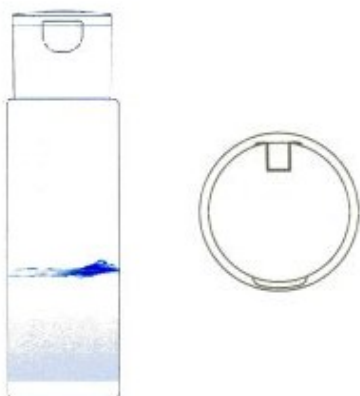
Designated goods: pharmaceutical preparations and other preparations for destroying vermin, fungicides and herbicides in Class 5



Registration 5787425

Registration date: October 21 2013

Designated goods: jewellery (among other things) in Classes 14 and 35



Registration 5882710

Registration date: September 16 2016

Designated goods: breath freshener (among other things) in Class 3



Registration 5894206

Registration date: November 4 2016

Designated goods: haircare products (among other things) in Class 3

The above package designs are decorative, but the purpose of this was arguably to contribute to their function or aesthetic. If this was the case, in accordance with the basic concept included in the Trademark Examination Manual, these 3D trademarks should have been rejected due to non-distinctiveness. However, they were registered as distinctive trademarks.

If it is possible to register only the 3D shape of a package design that includes no distinctive elements or devices as a 3D trademark, the trademark can be used to eliminate identical or similar third-party package designs. Therefore, where package designs are distinct to some extent and distinguishable from those of third parties, 3D trademark applications may be worth considering.

Further, package designs can be protected by a position or colour mark. There are few examples of examination for such marks, but the distinctiveness test is considered to be strict.

Comment

In the case of a novel package design, registrants should first consider filing for an industrial design registration, which is an effective measure to prevent third-party use. Further, where no similar third-party package designs exist, an industrial design registration can raise awareness of the 3D shape of the registrant's package design. When the shape of the package design becomes known to some extent and the registrant can prove that it has acquired distinctiveness, the registrant can file an application for a 3D mark even if the package design has no distinctive elements or devices.

Recently, the hurdle of distinctiveness that must be overcome to register a 3D trademark appears to have been lowered slightly. As such, it may be worth a registrant immediately filing a 3D trademark application for the shape of its package design (even if it has no distinctive characters or devices), without waiting until it is widely recognised in the market. This is recommended not only so that the registrant can exercise its trademark right, but also so that it can defend the use of its package design (taking into account the above-mentioned JPO trend of requiring a lower level of distinctiveness for the registration of a shape with no distinctive elements or devices as a 3D trademark).

The scope of a trademark right is, in principle, bound to the scope of the designated goods or services. Applications for 3D trademarks relating to package designs are usually filed for the goods contained in the packages. As such, it is often difficult to exercise a 3D trademark right against a party that manufactures or sells a package that is identical or similar to the registered design. In this regard, if a registrant has obtained an industrial design registration for its package design, it may be able to exercise its right against the party that manufactures the package.

In addition, in the case of a customs injunction, trademark registrations seem to be more effective than design registrations. This is because a customs official can easily judge the scope of a right pertaining to a trademark registration, as opposed to that of a design registration. Conversely, in the case of infringement litigation regarding a package design, a design registration may be more effective as it does not cause any doubt from a distinctiveness viewpoint. Therefore, although it should be determined on a case-by-case basis, it is generally advisable that brand owners consider both design and trademark protection, in order to ensure that their package design has the highest level of protection available.

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