To APAA Anti-Counterfeit Committee

APAA JAPAN SPECIAL TOPIC REPORT 2026

Japanese Group Anti-Counterfeiting Study Committee

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Executive Summary

This response sets out the views of the Japanese Group on each of the questions concerning the APAA Anti-Counterfeiting Committee's 2026 Special Topic, "Protection of Product Shapes," from the perspective of Japanese law and practice.

In Japan, product shapes may be protected under multiple, overlapping legal regimes, primarily: (i) the Design Law, (ii) the Trademark Law (three-dimensional trademarks), (iii) the Copyright Law, and (iv) the Unfair Competition Prevention Law ("UCPL").

The Japanese Group's responses to each question are set out below.

1. Whether such product shapes/configurations are protected under copyright law, unfair competition laws and/or passing-off doctrines

(1) Protection under Copyright Law

Under Japanese Copyright Law, the protection of product shapes is generally discussed in the context of the protection of "works of applied art." The Copyright Law defines a "work" as "a production in which thoughts or sentiments are expressed in a creative way and which falls within the literary, academic, artistic or musical domain" (Article 2(1)(i) of the Copyright Law), and further provides that "works of art" include "works of artistic craftsmanship" (Article 2(2) of the Copyright Law).

Since the Copyright Law contains no specific provision concerning applied art, there has been debate as to whether works of applied art other than "works of artistic craftsmanship" may also qualify for protection as works of art.
At present, the prevailing approach in Japanese case law is to recognize that works of applied art other than "works of artistic craftsmanship" may, under certain circumstances, be protected as "works of art." However, many court decisions have denied copyright infringement with respect to the shapes of products that have practical utility and are capable of mass production, either on the ground that such shapes do not qualify as copyrightable works or, even where copyrightability is recognized, on the ground that the accused product is not sufficiently similar to the copyrighted work.

(2) Protection under the Unfair Competition Prevention Law

Japan does not recognize the common law doctrine of passing off. However, the Unfair Competition Prevention Law ("USPL") performs substantially the same function. The principal provisions relevant to the protection of product shapes/configurations are as follows:

(a) Imitation of the Shape/Configuration of Goods (Article 2(1)(iii) of the USPL)

The USPL prohibits the act of assigning, leasing, displaying for the purpose of assignment or lease, exporting, importing, or providing through a telecommunications line goods that imitate the shape/configuration of another person's goods (excluding any configuration that is indispensable for ensuring the function of the goods).

Under the USPL, the "shape/configuration of goods" means the external and internal shape of goods, as well as any pattern, color, gloss, and texture combined with such shape, that can be perceived by consumers through their senses in the ordinary course of use of the goods (Article 2(4)). The term "imitate" means creating goods having a shape/configuration substantially identical to that of another person's goods in reliance on the shape/configuration of such other person's goods (Article 2(5)).

The period of protection is limited to three years from the date on which the goods were first sold in Japan (Article 19(1)(vi)(a)). A shape/configuration that is indispensable for ensuring the function of the goods is excluded from protection.

There is no requirement that the shape/configuration be novel, well known, or have source-identifying function. Accordingly, even in the absence of design or trademark rights, remedies such as injunctive relief may be available against slavish copies, i.e., substantially identical imitations. However, even if the shape/configuration of goods closely resembles that of another person's goods, an independently created

shape/configuration is not subject to this provision. Nor does the mere use of goods embodying an imitated shape/configuration fall within the scope of protection.

(b) Acts Causing Confusion with a Well-Known Indication of Goods or Business (Article 2(1)(i) of the UCPL)

This provision prohibits the use of an indication identical or similar to another person's well-known indication of goods or business where such use is likely to cause confusion. According to many court decisions, for the shape/configuration of goods to qualify as an "indication of goods or business," the following requirements must be satisfied: (i) the shape/configuration must objectively possess distinctive features that clearly distinguish it from other goods of the same kind ("inherent distinctiveness"); and (ii) through long-term exclusive use by a particular business operator, or through factors such as extremely extensive advertising or exceptionally strong sales, the goods having such shape/configuration must have become widely recognized among consumers as originating from that particular business operator ("well-known status").

There is no uniform standard for determining whether the well-known status requirement is satisfied. However, sales over several decades, or substantial sales volumes even over a period of only several years, are generally regarded as factors supporting a finding that the shape/configuration is well known.

A shape/configuration that is technically indispensable, in the sense that no alternative shape/configuration is available to achieve the technical function or utility of the goods, does not qualify as an "indication of goods or business."

(c) Unauthorized Use of a Famous Indication (Article 2(1)(ii) of the UCPL)

The UCPL prohibits the use of an indication identical or similar to another person's famous indication of goods or business. Unlike the acts causing confusion with a well-known indication described above, likelihood of confusion is not required. Protection is afforded from the perspective of preventing free-riding and dilution. In the Hermès "Birkin" case discussed below, the court found that the conduct at issue fell within both Article 2(1)(i) and Article 2(1)(ii) of the UCPL.

2 Whether such product shapes/configurations are enforceable on the grounds of (i) copyright infringement, and/or (ii) unfair competition and/or passing off, through administrative, civil, or criminal action

- **(1) Enforcement Based on Copyright Infringement**
  • **Civil remedies:** The copyright owner may seek injunctive relief (Article 112 of the Copyright Law), damages (Article 709 of the Civil Code and the provisions on the presumption of the amount of damages under Article 114 of the Copyright Law), restitution of unjust enrichment, and measures for the restoration of reputation (Article 115 of the Copyright Law).

  • **Criminal penalties:** Copyright infringement is punishable by imprisonment for up to 10 years, a fine of up to JPY 10 million, or both. A corporation may be subject to a fine of up to JPY 300 million (Article 119 of the Copyright Law).

  • **Border enforcement:** Goods infringing copyright constitute goods prohibited from export and import under Article 69-2(1)(iii) and Article 69-11(1)(ix) of the Customs Law, respectively, and may therefore be subject to suspension of export or import by Japan Customs.

(2) Enforcement under the Unfair Competition Prevention Law

- **Civil:** A party may seek injunctive relief (Article 3 of the UCPL), damages (Articles 4 and 5 of the UCPL, including provisions on the presumption of the amount of damages), and measures to restore business reputation (Article 14 of the UCPL).

- **Criminal:** Criminal penalties prescribed in Article 21 of the UCPL may be imposed. However, criminal penalties are applied only in a limited number of cases involving product shape/configurations. In practice, criminal charges for trademark infringement (Articles 78 and 78-2 of the Trademark Law) are more commonly pursued (see the Hermès three-dimensional trademark criminal case discussed below).

- **Administrative (Border Enforcement):** Goods falling within Article 2(1)(i) through (iii) of the UCPL constitute goods prohibited from export or import under Article 69-2(1)(iv) and Article 69-11(1)(x) of the Customs Law. A right

holder may file an application with the Director-General of Customs to suspend the importation of such goods (Article 69-13 of the Customs Law).

Japan does not have an independent doctrine of passing off, nor does the UCPL itself establish an independent administrative enforcement authority. Border enforcement measures under the Customs Law effectively serve as a means of administrative enforcement.

3. Whether there are any precedents concerning the matters described in item 2 above

There are numerous court decisions in Japan concerning the protection of product shape/configurations. The principal civil cases are as follows.

1. Copyright Law

(1) Case Concerning the Copyrightability of the Design of a Children's Chair (Supreme Court Judgment of April 24, 2026)

In this judgment, the Supreme Court held that:

"Where the shape/configuration or other features of the whole or part of a mass-produced utilitarian article can conceptually be perceived, separately from features derived from its function, as a creative expression of thoughts or sentiments, the whole or relevant part of such mass-produced utilitarian article should be regarded as a work falling within the artistic domain under Article 2(1)(i) of the Copyright Law."

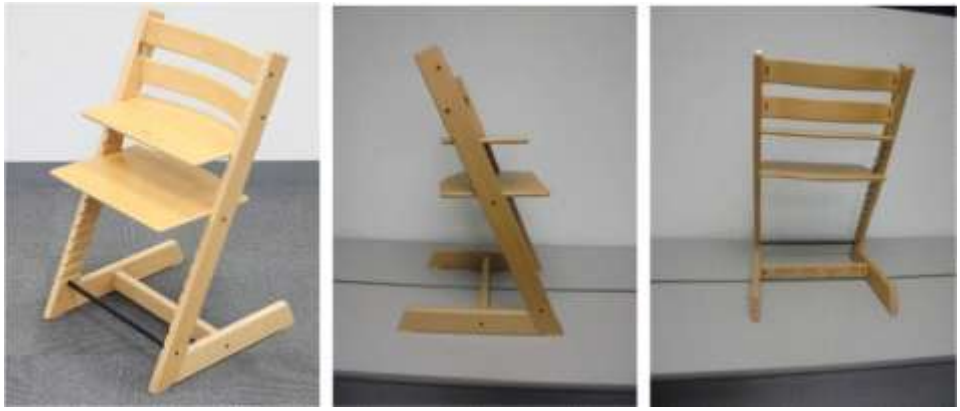
The Supreme Court then held that:

"The shape/configuration and other features of the whole or parts of the chair at issue can only be perceived as features derived from its function as a children's chair, and cannot be perceived, separately from such functional features, as a creative expression

of thoughts or sentiments. Accordingly, the chair at issue cannot be regarded as a copyrightable work.”

The Supreme Court therefore denied the copyrightability of the chair and dismissed the claims for damages and other relief.

(Plaintiff’s product)



(Defendant’s product)





The Supreme Court gave, among others, the following reasons for reaching this conclusion:

- Japan has the Design Law, which protects the shapes and other features of mass-produced utilitarian products that create an aesthetic impression through visual perception;
- with respect to the shapes/configurations and other features of mass-produced utilitarian products, a design right arises only upon the filing of an application for design registration, examination in accordance with the prescribed procedures, and registration of the design;
- the owner of a design right has the exclusive right, as a business, to work the registered design and designs similar thereto, and the term of a design right is, in principle, 25 years from the filing date of the application for design registration;
- under the Copyright Law, by contrast, copyright arises without any registration or other formalities, its effect extends to acts other than those conducted as a business, and its term of protection is, in principle, from the creation of the work until 70 years after the death of the author. In addition to copyright, the author also enjoys moral rights;
- if the shapes/configurations and other features of mass-produced utilitarian products were broadly protected under the Copyright Law in addition to the Design Law, such products could potentially receive broader and longer-lasting protection under the Copyright Law without the need to incur the costs and take the steps required to obtain design registration, which could undermine the significance of the Design Law;
- if copyright protection were broadly extended to the shapes/configurations and other features of mass-produced utilitarian products, moral rights could complicate the legal relationships involved and impede the use of such products. It could also prevent the free use of such shapes/configurations and other features for a long period even after the expiration of the relevant design rights, thereby potentially frustrating the purpose of the Design Law to contribute to industrial development;
- the shapes/configurations and other features of mass-produced utilitarian products are ordinarily determined subject to certain constraints arising from

the functions necessary to achieve their practical purposes and therefore generally cannot be conceptually perceived separately from their function-derived shapes/configuration. However, some products may include, for example, ornamentation on their surfaces that goes beyond mere patterns or surface treatment, where the shape/configuration or other features of such added elements are unrelated to function and can conceptually be perceived as a painting or sculpture distinct from the function-derived configuration;

- in such cases, it can be said that a "work of art" (Article 10(1)(iv) of the Copyright Law) has simply been added to the mass-produced utilitarian product, and it is therefore natural that the added element should be protected under the Copyright Law;
- some mass-produced utilitarian products may, for example, be perceived as sculptures when viewed as a whole. In such cases, although the shape/configuration and other features of the product as a whole or of a part thereof may be related to its utilitarian function, they may nevertheless be conceptually perceived as a sculpture or other artistic expression distinct from the function-derived shapes/configuration. Because such shapes /configurations and other features permit a creative expression of thoughts or sentiments to be perceived separately from the function-derived shape/configuration, they are analogous to the above-mentioned cases in which a "work of art" is simply added to a utilitarian product, and it is therefore appropriate to afford them protection under the Copyright Law; and
- shapes/configurations and other features of this kind may be regarded as exceptional among those of mass-produced utilitarian products, which are ordinarily subject to certain functional constraints. Accordingly, extending copyright protection to such exceptional shapes/configurations and features is unlikely to give rise to the adverse consequences described above.

(Supplementary Note)

The shape/configuration of this chair has been registered as a three-dimensional trademark based on a finding that it had acquired distinctiveness through use (Trademark Registration No. 6769295).



By contrast, in Europe, the shape/configuration of the chair has been recognized as eligible for copyright protection, while protection as a trademark has generally been denied. This stands in contrast to the approach taken in Japan.

(2) Case Concerning the Copyrightability of the Design of a Lighting Shade (Tokyo District Court Judgment of January 29, 2020)

The plaintiff's work was a lighting shade. The Tokyo District Court found that the plaintiff's work possessed a high degree of creativity comparable to that of a work of artistic craftsmanship and had aesthetic qualities that made the work as a whole an object of aesthetic appreciation. The Court therefore held that it constituted a work of art and recognized the copyrightability of its design.

However, the Court denied copyright infringement, holding as follows:

"The plaintiff's work and the defendant's work differ in their structures and shapes that are important to the essential features of the plaintiff's work. The defendant's work does not create the soft, richly shaded impression of a flower found in nature; rather, it has a more three-dimensional appearance, emits light evenly and uniformly, and produces a dazzling, crystal-like brilliance. Nor does its overall outline have the rounded, ball-like shape of an umbel; instead, it gives a spiky impression with an uneven contour. Accordingly, the essential features of the plaintiff's work cannot be directly perceived from the defendant's work."

On this basis, the Court concluded that there was no copyright infringement.

(Plaintiff's work)



(Defendant's work)



The Court held:

"The stuffed toy at issue is a stuffed doll made by cutting and sewing together fabrics of several different colors and patterns, filling the interior with cotton or similar stuffing, and forming the face and body of a fish. Its shape and facial expression are found to be almost identical to those depicted in the original illustration at issue, and there is no evidence sufficient to overturn this finding. Based on these facts, it is appropriate to find that the stuffed toy at issue was produced by relying on and adapting the original illustration at issue."

(Original Illustration at Issue)



(Stuffed Toy at Issue)



2. Article 2(1)(iii) of the UCPL (Imitation of the Configuration of Goods)

(1) Saxophone Strap Case (Intellectual Property High Court Judgment of January 24, 2019)

The Intellectual Property High Court held, among other things, that the shape/configuration of the plaintiff's goods could not be regarded as a "shape/configuration indispensable for ensuring the function of the goods" (the proviso to Article 2(1)(iii) of the UCPL), nor could it be regarded as a commonplace shape/configuration.

The Court further held that, in light of the purpose of Article 2(1)(iii) of the UCPL, the "shape/configuration of goods" protected under that provision refers to the shape/configuration of the goods as a whole.

Comparing the plaintiff's goods with the defendant's goods, the Court found that the differences between them had little impact on their overall configurations and, when the goods were viewed as a whole, amounted only to minor differences. The Court therefore concluded that the shape/configurations of the two goods were substantially identical.

Furthermore, in view of the respective dates on which the plaintiff's and defendant's goods were first sold, as well as the prior relationship between the appellant and the appellee, the Court found that the defendant's goods had been created in reliance on the plaintiff's goods. Accordingly, the Court held that the defendant's goods3 constituted an imitation of the shape/configuration of the plaintiff's goods and granted an injunction against the sale of the defendant's goods, ordered its disposal, and awarded damages.

（Plaintiff’s goods）　　(Defendant’s goods)



(2) Passbook Case and Long Wallet Shape/Configuration Imitation Case (Osaka District Court Judgment of December 4, 2023)

With respect to the passbook case, the Court found that Plaintiff’s goods 1 and Defendant’s goods 1 shared substantially the same external shape/configuration, including their overall size and shape, the shape and position of the front outer pocket, and the placement of the zipper, as well as most aspects of their internal configuration, and that the overall impressions of the two goods were extremely similar. The differences between them, including the presence or absence of a rear pocket and the number and arrangement of the smaller pockets, were merely minor differences. The Court therefore held that the shapes/configurations of the two products were substantially identical.

With respect to the long wallet, the Court found that the shapes/configurations of the two goods were common in all respects and therefore held that they were substantially identical.

The Court also found that Defendant's goods had been created in reliance on Plaintiff's goods, taking into account such circumstances as the fact that Plaintiff's goods had been offered for sale on publicly accessible e-commerce websites and that Defendant's goods had been launched approximately four to eight months after Plaintiff's goods. Accordingly, the Court upheld the claim for damages.

(Plaintiff's goods Passbook case)



（正面）



（背面）



（内部）

(Defendant's goods 1 Passbook case)



（正面）



（背面）



（ケース内部）

(Plaintiff’s goods 2 Long wallet)



（正面）



（背面）



（内部１）



（内部２）

(Defendant’s goods 2 Long wallet)



（正面）



（背面）



（財布の内部：ファスナーを閉じた状態）



（財布の内部：ファスナーを開けた状態）

(3) Blouse and Shirt Shape/Configuration Imitation Case (Osaka District Court Judgment of January 19, 2017)

The Court held as follows:

“In addition to the fact that the configuration of Defendant’s goods 1 is substantially identical to that of Plaintiff’s goods1, Defendant’s goods 1 was first sold approximately one year after Plaintiff’s goods 1, and the defendant has neither alleged nor established that it independently created the configuration of Defendant’s Product 1. In light of these circumstances, it is reasonable to find that the configuration of Defendant’s Product 1 was created in reliance on Plaintiff’s goods 1. Accordingly, Defendant’s goods 1 should be regarded as a product imitating Plaintiff’s goods 1.”

The Court further held:

“Plaintiff’s goods 3 and Defendant’s goods 3 share the following features in their shapes/configurations: (i) in addition to the repetition of black and white horizontal stripes throughout the products, both products employ substantially the same distinctive repeating pattern consisting of the first, second, and third horizontal stripe sections; (ii) a large apple motif of a similar design is applied to the front of both products in substantially the same manner; and (iii) rhinestones are arranged in the same pattern around the apple motif so as to outline it. Thus, the shapes/configurations of the two goods, when viewed from the front, are substantially

identical in these distinctive features. Their shapes/configurations are also substantially identical when viewed from the rear. Accordingly, the overall configurations of the two goods closely resemble each other and are substantially identical.

… [omitted] …

In addition to the fact that the shapes and configurations of Defendant's goods 3 and Plaintiff's goods 3 are substantially identical, Defendant's goods 3 was first sold approximately one year after Plaintiff's goods 3, and the defendant has neither alleged nor established that it independently created the shape/configuration of Defendant's goods 3. In light of these circumstances, it is reasonable to find that the shape/configuration of Defendant's goods 3 was created in reliance on Plaintiff's goods 3. Accordingly, Defendant's goods 3 should be regarded as goods imitating Plaintiff's goods 3."

On this basis, the Court granted an injunction against the manufacture and sale, among other acts, of Defendant's goods 1 and 3, ordered the disposal of those goods , and awarded damages.

(Plaintiff's goods 1)



（Defendant's goods 1）



（Plaintiff's goods 3）



(Defendant's goods 3)



2. Article 2(1)(i) of the UCPL (Acts Causing Confusion with a Well-Known Indication of Goods or Business)

(1) BAO BAO ISSEY MIYAKE' Case (Tokyo District Court Judgement on June 18, 2019**)**

The Tokyo District Court found that the distinctive features of the of the Plaintiff's goods are combination of the following elements:

i. Depending on the luggage's shape inside, boundary parts of the pieces, which are components of the bags, are bent to give various angles, and the bags' appearance changes three-dimensionally according to the baggage.

ii. In order to have the above appearance, plain mesh fabric or soft woven fabric is used for the bags

iii. The triangular pieces with a certain level of hard texture reminiscent like tiles are placed and are spread at the same interval of about 2mm to 3mm.

The District Court found that the configuration having all the above distinctive features has been considered to be well-known as the "indication of goods, etc"

among consumers around the year of 2017, through promotion, advertisement, media reports and increasing sales performance for the Plaintiff's goods for a long time.

Additionally, the District Court found that since the Defendant's goods have all the above distinctive features of the Plaintiff's goods, the configuration of Defendant's Goods would be considered entirely similar to the configuration of the Plaintiff's Goods, even though the shape of each piece like tiles of the Defendant's goods are different from the Plaintiff's goods, taking the following factors into consideration:

a) Depending on the luggage's shape inside, the appearance of Plaintiff's goods and Defendant's goods changes three-dimensionally and variously, because boundary parts of the pieces like tiles are bent to give various angles;

b) Consumers can see the various appearance of the Plaintiff's goods, into which luggage is put in many shops, magazines, etc., and

c) The shape/condifuration of each piece like tiles of them is not sufficiently distinguishable from each other.

Plaintiff's goods	Defendant's goods
	

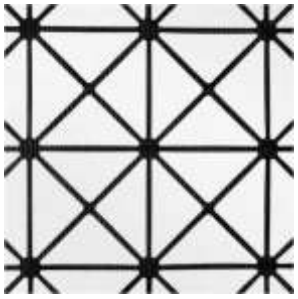
(Supplementary note)

The plaintiff had already owned a three-dimensional trademark (Trademark Registration No. 5763495) and a two-dimensional trademark (Trademark Registration No. 5763494) prior to filing the lawsuit, but did not assert any claims based on its trademark rights in this action.

Three-dimensional trademark (Trademark Registration No. 5763495)



Two-dimensional trademark (Trademark Registration No. 5763494)



(2) **Unit Shelf Case (**IP High Court Judgement on March 29, 2018) [Original judgement (Tokyo District Court Judgement on August 31, 2017)]

Plaintiff's goods	Defendant's goods
	

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The Tokyo District Court found that the characteristics of the of the Plaintiff's goods is combination of the following elements:

i) Vertical frames and horizontal frames installed at both sides
ii) The vertical frames comprised of bundled two thin bars
iii) installation of shelf boards
iv) X-crossing bars installed at back side
v) The X-crossing bars and horizontal frames both of which are thin
vi) Appearance like a skeleton comprised only of the above elements

The District Court found that the configuration of the Plaintiff's goods has been considered to be distinguishable from the other goods of the same kind around the year of 2004, taking into consideration that there seem not to have been any other goods of the same kind having the shape/ configuration of the Plaintiff's goods around the year of 2008.

Additionally, the District Court found that the Plaintiff's goods which have the characteristic shape/configuration have been sold and advertised for more than five (5) years exclusively and very extensively, etc., and consequently, the shape/configuration of the Plaintiff's goods became well-known as the "indication of goods, etc" as source of the goods among the Japanese consumers around the year of 2004.

Based on the above fact-findings, etc., the District Court granted the Plaintiff's demand holding that the configuration of the Plaintiff's Goods falls under the "Indication of Goods, etc." under the Article 2.1.1 of the Unfair Competition Prevention Law.
The IP High Court maintained the District Court Judgement, although the Defendant took an appeal against the District Court Judgement.

(3) Cartier Watch Case (Tokyo District Court Judgment of July 28, 2004)

Plaintiff's goods	Defendant's goods

The Court held that the shape/configurations of the Plaintiff's goods qualified as an "indication of goods or business," stating:

"As described above, the Plaintiff's goods have distinctive features in terms of (i) the shape/configuration of the crown protector and (ii) the shape/configuration of the case and bezel, together with the large size of the case. The combination of these features gives the overall shape/configuration of the Plaintiff's goods a distinctive character of its own. In light of this distinctiveness, the sales performance of the Plaintiff's goods,

and the extent to which they have been featured in magazines and other media, the combination of these two distinctive features can be regarded as an 'indication of goods or business' identifying the Plaintiff as the source of the Plaintiff's goods."

With respect to the well-known status of the shape/configuration, the Court further held:

"With respect to Panerai goods equipped with a crown protector, including the Plaintiff's goods, the following circumstances are relevant: (i) sales volume and sales revenue doubled year-on-year during the first three years after sales commenced in Japan and continued to increase thereafter; (ii) industry surveys of watch retailers identified the goods as exhibiting particularly significant growth in sales volume; (iii) the number of magazine articles and advertisements featuring the goods increased year by year after their launch, and by 2001 the products were widely featured not only in specialist watch magazines but also in men's general-interest magazines, men's fashion magazines, and women's fashion magazines; (iv) when the Panerai goods were featured in magazines, photographs of the relevant goods were published in a manner that made the shape/configuration at issue visually recognizable; and (v) the majority of Panerai goods had the shape/configuration at issue. In light of these circumstances, the above-mentioned distinctive shape/configuration of the Plaintiff's goods had become widely recognized among consumers by around 2002 and had therefore acquired the status of a well-known indication of goods or business."

The Court also found:

"The distinctive shape/configuration of the Plaintiff's goods consists of the combination of the above-mentioned shape/configuration of the crown protector, the shapes/configurations of the case and bezel, and the large size of the case. Since the Defendant's goods incorporate these distinctive features of the Plaintiff's goods, the Defendant's goods are similar to the Plaintiff's goods."

The Court further held:

"Given that the Defendant's goods incorporate the distinctive shape/configuration of the Plaintiff's goods and are similar to them, there is a likelihood that consumers may be confused as to the source of the Plaintiff's goods and the Defendant's goods."

On this basis, the Court concluded that an injunction against the sale and other disposition of the Defendant's goods, as well as their disposal, was warranted.

3. Article 2(1)(ii) of the UCPL (Unauthorized Use of a Famous Indication)

- **Hermès Birkin Case (Intellectual Property High Court Judgment of December 17, 2020 (Original Judgment: Tokyo District Court Judgment of June 3, 2020))**

Plaintiff's mark (= Plaintiff's goods)	Defendant's goods
	

The court of first instance held that "the defendant's sale of the Defendant's goods constitutes an act of unfair competition under Article 2(1)(ii) of the UCPL, as it involves the sale of goods bearing an indication of goods or business similar to the plaintiff's famous indication of goods or business."

On appeal, the Intellectual Property High Court found that, by 2009, the configuration of the Plaintiff's goods had become famous as an indication identifying the plaintiff as their source and thus constituted the plaintiff's famous indication of goods or business. The Court further found that the configuration of the Defendant's goods was similar to that of the Plaintiff's goods and was likely to cause confusion with the configuration of the Plaintiff's goods. Accordingly, the Court held that the defendant's conduct constituted unfair competition under both Article 2(1)(i) and Article 2(1)(ii) of the UCPL.

4. Whether and how customs authorities and e-commerce platforms in each jurisdiction can address counterfeiting involving such product shapes/configurations;

(1) Customs Authorities

Goods that infringe design rights, trademark rights, copyrights, or other intellectual property rights, as well as goods falling within Article 2(1)(i) through (iii) of the UCPL, are subject to import and export enforcement by Japan Customs.

An application for suspension of import or export may be filed with any Customs office by trademark or copyright owners; persons who, by virtue of a well-known or famous indication of goods or business, are recognized by traders or consumers as the manufacturer of the relevant goods or as the operator of the relevant business; or persons who have themselves developed and commercialized the goods and placed them on the market. The applicant must submit an application form, documents evidencing the relevant rights, materials showing prima facie evidence of infringement, and information enabling Customs to distinguish infringing goods from genuine goods. In the case of goods falling within Article 2(1)(i) through (iii) of the UCPL, a written opinion from the Minister of Economy, Trade and Industry is required.

As an example, an application for suspension of import based on Trademark Registration No. 5763494 and other trademark registrations owned by the plaintiff in the above-mentioned BAO BAO case was accepted and published by Japan Customs, and the importation of imitation-design bags was in fact suspended (Ministry of Finance, “Press Release,” March 4, 2016).

(2) E-commerce platforms

Major e-commerce platforms in Japan, including Amazon, Rakuten Ichiba, Yahoo! Shopping, and Mercari, have established procedures for reporting and removing listings that infringe intellectual property rights (notice-and-takedown procedures). In general, infringement of design rights, trademark rights, and copyrights may be reported, whereas Yahoo! is the only platform that expressly identifies violations of the UCPL as a basis for reporting.

A report is generally submitted through the relevant platform’s web form, together with the URL of the listing in question, information concerning the relevant rights, the grounds for alleging infringement, and comparative materials. Based on their respective terms of use and policies, the platforms may remove listings, cancel transactions, or restrict users’ accounts. It should be noted, however, that the submission of a report does not necessarily result in removal of the listing.

Even where a platform does not expressly provide for the removal of listings on the basis of Article 2(1)(i), (ii), or (iii) of the UCPL, it may still be possible to submit a takedown request. If the platform declines to take action, the right holder may

consider filing a petition with a court for a preliminary injunction against the seller seeking, among other things, to enjoin the listing or sale of the goods. The same applies where a platform declines to remove a listing despite a request based on infringement of a design right, trademark right, or copyright.

It should also be noted that where a party submits a takedown request to a platform on the grounds of infringement of a design right, trademark right, or copyright, or on the grounds that the listing constitutes an act falling within Article 2(1)(i), (ii), or (iii) of the UCPL, and the listing is subsequently removed or otherwise suspended, there is a risk that the reporting party may later face a claim for damages for "making or circulating a false allegation" under Article 2(1)(xxi) of the UCPL if a court judgment or other subsequent determination establishes that the takedown request lacked an objective and reasonable basis.

5. What strategic approaches can be taken to protect shapes/configurations once the product has already been commercialized in this manner

(1) Short-term Measures

Confirm the date on which the product was first made public. If less than one year has elapsed since that date, immediately consider filing a design application by invoking the exception to loss of novelty.

Preserve evidence of the date on which sales commenced, physical samples of the product, advertisements, sales materials, and other relevant evidence in preparation for seeking protection against imitation of the configuration of goods under Article 2(1)(iii) of the UCPL.

If imitation products are already on the market, conduct test purchases and take other appropriate measures to preserve evidence.

(2) Medium- to Long-Term Measures

- Consistently use the product configuration and promote the shape itself as a distinctive brand feature in advertising and other promotional activities, with a

view to establishing acquired distinctiveness through use and ultimately obtaining registration as a three-dimensional trademark.

- For improved or derivative designs, ensure sufficient differences from existing products and obtain new design rights.
- For future products, establish an internal process under which, as a general rule, applications for design registration are filed **before public disclosure**.
- Rather than relying separately on copyright, the UCPL, trademark rights, or design rights, adopt a layered protection strategy that combines multiple forms of protection over the lifecycle of the product.

6. Whether there may be difficulties even in enforcing trademark rights relating to a three-dimensional mark or design rights against imitation of product shapes/configurations assuming that right holder can obtain these rights.

(1) Challenges in Enforcing Three-Dimensional Trademark Rights

(i) Whether the allegedly infringing configuration is being "used as a trademark" may become an issue

Even where a three-dimensional trademark has been registered, the mere adoption by a third party of a similar product configuration does not necessarily constitute trademark infringement.

As a general rule, for trademark infringement to be established, the alleged infringer's use of the mark must constitute use as an indication of the source of goods or services, i.e., use as a trademark.

In cases involving product configurations, an alleged infringer may argue, for example, that:

- the configuration was adopted solely to achieve the functional purpose of the product;
- the configuration was adopted solely for design or aesthetic reasons; or
- its own word mark or logo is clearly displayed on the product, and the product shape is not being used as an indication of source.

Accordingly, even where a three-dimensional trademark has been registered, depending on how the configuration is used on the allegedly infringing product, whether such use constitutes use as a trademark may become an issue in enforcement.

(ii) Similarity between the registered three-dimensional trademark and the allegedly infringing product may become an issue

Since the scope of a trademark right extends to the use of marks identical or similar to the registered trademark, it is necessary to determine whether the shape/configuration of the allegedly infringing product is similar to the registered three-dimensional trademark.

In the case of product shapes/configuration, differences may exist in such features as:

- the overall outline of the product;
- the shape of distinctive parts;
- the arrangement of individual components;
- dimensions and proportions;
- surface decoration; and
- word marks or logos appearing on the allegedly infringing product.

Accordingly, the extent to which modifications to a product shape/configuration still fall within the scope of similarity to the registered three-dimensional trademark may become an issue.

In particular, where a registered three-dimensional trademark includes words, figurative elements, or other features, enforcement against a product that imitates only the three-dimensional shape/configuration may be difficult if the distinctiveness of the registered trademark is considered to derive primarily from those word or figurative elements rather than from the three-dimensional shape/configuration itself.

For this reason, from a long-term perspective, it is important to accumulate evidence demonstrating that the product shape/configuration itself is recognized as an indication of source.

(iii) The scope of protection and enforcement may be limited for functional shape/configurations

A product shape/configuration typically incorporates a combination of:

- features dictated by technical functions;
- features necessary for the use of the product;
- common or commonplace shapes;
- aesthetic or decorative features; and
- distinctive features characteristic of the brand.

It would not be appropriate for the three-dimensional trademark system to allow a particular business operator to obtain a perpetual monopoly over the functional features of a product. Accordingly, a shape/configuration consisting primarily of functional features may not only be difficult to register in the first place, but, even if registered, may also be subject to limitations on the scope of protection that can be asserted in enforcement.

(2) Challenges in Enforcing Design Rights

(i) Similarity between the registered design and the allegedly infringing design is the primary issue

The scope of a design right extends to the registered design and designs similar thereto.

Accordingly, infringement is relatively straightforward in the case of an exact copy. However, similarity to the registered design may become disputed where an imitator makes design modifications such as:

- changing part of the outline;
- changing the dimensions or proportions of distinctive features;
- changing surface patterns;
- changing the arrangement of components; or
- adding or removing certain components.

The scope of similarity of a registered design is limited to articles that are identical or similar to the article to which the registered design pertains. Where the registered design is a design for a part of an article, the commonality of the use and function of the relevant parts is also taken into consideration.

For example, if the allegedly infringing product is a “toy automobile,” while the article to which the registered design pertains is an “automobile,” the allegedly infringing product may fall outside the scope of similarity of the registered design, and therefore outside the scope of the design right.

Similarly, where the registered design is a partial design, even if the relevant portion of the allegedly infringing product has a configuration similar to that of the corresponding portion of the registered design, the allegedly infringing product may fall outside the scope of similarity, and thus outside the scope of the design right, if the relevant portions differ in their functions or uses.

(ii) The scope of protection may be narrow in light of prior designs

Among the features of a registered design, configurations that were already commonly used before the filing date or features found in prior designs are less likely to be given significant weight as distinctive features unique to the registered design.

For example, even where a registered design and an allegedly infringing product share many features, if those common features consist primarily of:

- shapes commonly used in the relevant product field;
- shapes found in prior designs; or
- shapes required by functional considerations,

while the differences between them relate to features distinctive to the registered design, the two designs may be found dissimilar even if their overall appearances are similar to some extent.

Accordingly, the mere fact that a design right has been obtained does not confer a broad monopoly over product configurations across an entire product category.

(iii) Functional configurations may also become an issue in determining design similarity

With respect to a product configuration, features that are inevitably determined or substantially constrained by technical or functional considerations may be accorded less weight as creative features of the design.

Accordingly, where the similarities between the registered design and the allegedly infringing product exist primarily in functional features, while their decorative or optional features differ, enforcement of the design right may be difficult.

(iv) The practical scope of protection may be affected by the drawings or photographs submitted with the application

The scope of a design right is interpreted on the basis of the registered design.

Accordingly, where only the design of the product as a whole has been registered, it may be difficult to establish similarity if an alleged infringer retains the product's distinctive features while modifying other parts.

From this perspective, for future products, it is important to build a design portfolio that anticipates attempts by imitators to design around the registered design by filing applications covering a combination of:

- the design of the product as a whole;
- partial designs covering distinctive features; and
- multiple design variations.