

Protection of Package Design of Products

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1. Several options to protect the package design of products

The package design of a product is one of the most important factors in expanding a company's market share, especially in mature markets where consumers have discerning eyes. In Japan, we have several options to protect package design. One is protection under the Design Act. Once we have design registration for the package design under the Design Act, we have an exclusive right on the package design for 20 years. However, we cannot obtain the registration if the design has lost novelty. So, it is already too late when the product has been sold on the market (note: there is a 6 months grace period for lack of novelty).

Another option is protection under the Unfair Competition Prevention Act. An owner of the package design can apply for an injunction and/or claim damages if other parties are (i) creating confusion with the owner's products by using a package design that is identical with or similar to the owner's well-known package design, or (ii) using a package design that is identical with or similar to another person's famous package design. Protection under the Unfair Competition Prevention Act is effective without any advance procedure, such as requesting registration. However, the owner is likely to have a hard time proving that the competitor's product is "creating confusion" and that the owner's package design is "well-known", in case (i) above, or that the owner's package design is "famous", in case (ii) above.

2. Trademark registration for package design

The owner should consider using trademark registration to protect package design as another option. Firstly, the owner should consider obtaining three-dimensional trademark registration for package design. This option is useful when the features of the package are not only in its two-dimensional design, such as color pattern or figures, but also in its shape. Figure 1 and 2 are examples of the three-dimensional trademark registration for package design.



Figure 1: TM Reg. No. 4170258

for cosmetic



Figure 2: TM Reg. No. 4400363

for noodle

Secondly, the owner should consider obtaining trademark registration for design of the main surface of the package. The main surface is the most important element to catch consumers' eyes, and competitors or free riders can copy or borrow the design of the main surface. So, by focusing on the main surface, the owner can avoid counter arguments from the owner of the accused product claiming dissimilarity as a whole including other parts, such as side surface. Figure 3 and 4 are examples of the trademark registration for the design of main surface of the package.



Figure 3: TM Reg. No. 4713365
for pantiliner



Figure 4: TM Reg. No. 5043967
for chocolate

Thirdly, the owner should consider obtaining trademark registration for specific design elements of the package. Sometimes there are specific, eye-catching elements in the whole design of the package, and competitors or free riders can copy or borrow this element of design and transform it into a different design as a whole. So, by focusing on the specific element of design, the owner can avoid counter arguments from the owner of the accused product claiming dissimilarity as a whole design. Figure 5 and 6 are examples of the trademark registration for specific design elements of the package.



Figure 5: TM Reg. No. 4432695
for pharmaceutical



Figure 6: TM Reg. No. 1610616
for refreshing beverages

It is important to choose one of the above filing strategies, or to combine two or all of above filing strategies, according to the characteristics of the product, the possibility of a counterfeiter arising, etc.

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