

Advisory Committee on Enforcement

Eighteenth Session
Geneva, June 2 to 4, 2026

EFFORTS AND CHALLENGES IN ENFORCING DESIGN RIGHTS AGAINST INFRINGEMENT

*Contribution prepared by Ms. Konno Chikako, Director, Overseas Business Support Office, International Cooperation Division, Japan Patent Office (JPO), Tokyo, Japan**

ABSTRACT

With the expansion of cross-border e-commerce, the influx of infringing goods from overseas has increased, making it difficult to implement effective border measures while relying solely on trademarks. In order to counteract the effects of infringing goods, design rights must also be leveraged. This paper draws attention to the significance of border measures based on design rights, examines institutional and practical challenges, and presents various initiatives in Japan, including legal reforms, improvements to the import suspension application system and enhanced cooperation between the Japan Patent Office (JPO) and Japanese customs (including personnel exchanges, support for design infringement determinations and awareness-raising activities).

* The views expressed in this document are those of the author and not necessarily those of the Secretariat or of the Member States of WIPO.

I. IMPORTANCE OF BORDER MEASURES FOR DESIGN RIGHTS

THE IMPORTANCE OF PROTECTION THROUGH MULTIPLE INTELLECTUAL PROPERTY RIGHTS

1. In Japan, many companies produce functional, high-quality products, and the importance of using multiple intellectual property (IP) rights, such as trademarks, design rights and patent rights, in order to ensure comprehensive protection, is being increasingly recognized. The acquisition of design rights has become a key strategy in order to avoid trademark infringement. Therefore, it is essential to promote the use of combined IP rights and to ensure enforcement against both trademark and design infringement (“IP MIX”).

THE IMPORTANCE OF PROTECTION THROUGH MULTIPLE IP RIGHTS

2. The following table sets out instances of IP infringements faced by Japanese companies, according to the type of IP and the mode (online or offline), as captured in the annual IP activity survey. The most infringed IP rights online are trademarks, copyright, and designs, and the most infringed offline are trademarks, patented inventions/utility models, and designs. This indicates that damage caused by IP infringement is widely recognized, not only in the realm of trademark rights, but also in other legal domains. The way in which goods are sold, i.e., online or offline, is also revealed as a key factor.

IP rights affected by infringement (sample size: 569)

	Trademark	Design	Patent/Utility Models	Copyright	Trade Secrets/ Know-how	Others	No Damage due to Infringement
Online	362	113	79	148	8	31	112
Offline	293	123	141	70	12	26	108

JPO “Intellectual Property Activity Survey Report for FY2024” (April 2025)

3. The growth of cross-border e-commerce has lowered barriers to buying foreign products. According to a survey by the Ministry of Economy, Trade and Industry (FY2023 E-Commerce Market Survey), the global cross-border e-commerce market, estimated at 785 billion United States dollars in 2021, is projected to reach 7.938 trillion United States dollars by 2030. The average annual growth rate is at approximately 26.2 per cent, showing a steady upward trend¹. The survey defines cross-border e-commerce as “all purchases from sellers or providers outside the consumer’s country of residence”.

4. The growth of cross-border e-commerce has made it easier for foreign businesses to sell small quantities of infringing goods directly to individuals in Japan. The diversification of transaction types between foreign sellers and domestic buyers has facilitated the sale of both genuine and infringing products across borders. As a result, special attention should be paid to the distribution of infringing goods in business-to-consumer (B2C) transactions.

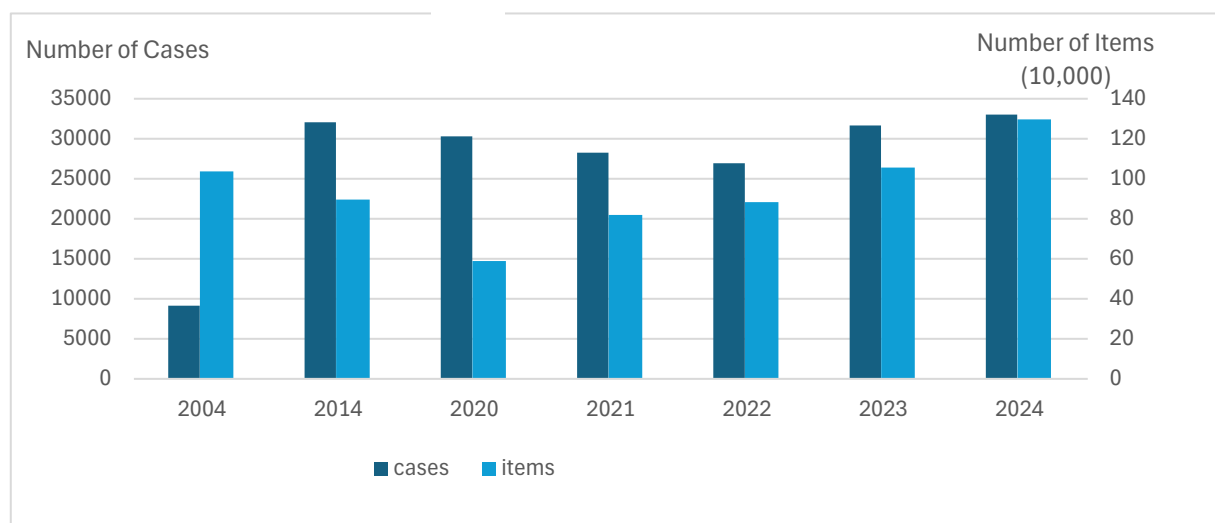
5. In this context, it is important for rights holders to understand where infringing goods are manufactured and distributed. Moreover, a system should be established to enable suspension at customs, whether in the exporting or the importing country.

¹ https://www.meti.go.jp/english/press/2024/0925_002.html.

INFLUX OF INFRINGING GOODS INTO JAPAN

6. In 2024, the seizure of goods that infringed on IP rights by Japanese customs showed that the number of import seizures in 2024 was 33,019, setting a record since the first time such data were published in 1987. This reflects a total of 1,297,113 items seized by Japanese customs during the reporting period.

SEIZURE OF GOODS THAT INFRINGED ON IP RIGHTS BY JAPANESE CUSTOMS



SEIZURE OF GOODS THAT INFRINGED ON IP RIGHTS BY JAPANESE CUSTOMS IN CY2024²

7. In terms of import seizures by type of IP right, goods infringing on trademarks had the largest share at 31,212 cases (93.6 per cent), followed by goods infringing on copyright at 1,380 cases (4.1 percent) and goods infringing on designs at 348 cases (1.5 percent). The number of seized items reflected the same order: items infringing on trademarks totaled 443,887 (34.2 per cent); items infringing on copyright totaled 317,293 (24.5 percent); and items infringing on design rights totaled 298,131 (23 per cent).

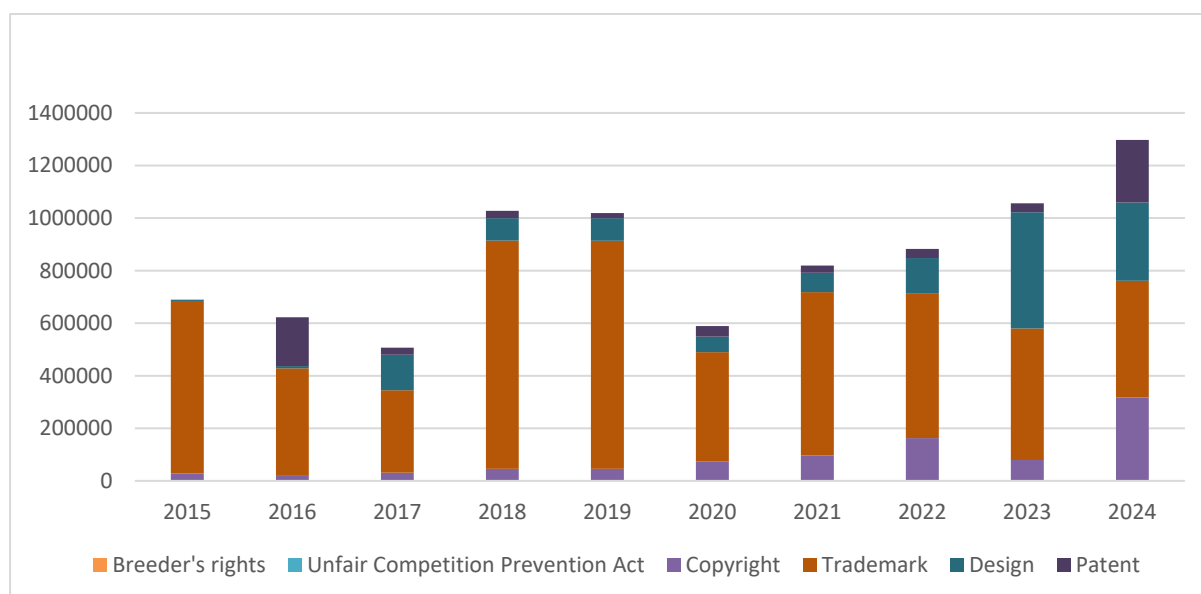
SUSPENSIONS BASED SOLELY ON TRADEMARK RIGHTS ARE INSUFFICIENT

8. Infringement methods have become more sophisticated. For instance, some products are imported without logos, which are added later, prior to domestic sale. To enable seizure of such items at the border, suspensions based on rights other than trademarks are needed. As shown below, seizures by Japan Customs shows a rise in seizures of items infringing design rights. Tokyo customs reported that in 2015, nearly all items seized for trademark violations had brand logos. However, by 2023, about 70 per cent of seized items had no logo, which raised concerns³. This suggests that IP infringement cannot be easily identified across a growing number of infringing items.

² https://www.mof.go.jp/policy/customs_tariff/trade/safe_society/chiteki/cy2024/index.html.

³ https://www.customs.go.jp/tokyo/yun/tokyo_chizai_R5_1.pdf.

IMPORT SEIZURE RECORDS BY IP TYPE (BASED ON NUMBER OF ITEMS)



Data from “Seizures of IP Infringing Goods at Customs”⁴, Ministry of Finance

9. Since the importation of products without logos does not constitute trademark infringement (as mentioned above), rights holders must utilize multiple IP rights, and not only trademarks, to effectively protect their brands and designs.

II. ISSUES RELATED TO THE ENFORCEMENT OF DESIGN RIGHTS

AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS

10. As mentioned above, border enforcement based on trademark rights is insufficient. However, while Article 51 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) obliges Members to adopt procedures under which customs authorities may, upon application by the rights holder, suspend the release of counterfeit trademark goods and pirated copyright goods, this obligation does not extend to goods that infringe on design rights.

THE CHALLENGE OF BORDER ENFORCEMENT FOR DESIGN RIGHTS

11. Some countries include items infringing design and patent rights in import suspensions. However, since design infringement is harder to determine than trademark infringement, the suspension system based on design rights may not work effectively in all the countries where it's available. Due to constraints such as limited human resources, actual import suspensions tend to focus on goods that infringe on trademarks, making it difficult to target items that infringe on design rights. This should be recognized as an operational challenge within the system.

12. From the perspective of rights holders, the ability to file applications for suspension of imports for a broad range of IP rights, including design rights, is expected to help curb the distribution of infringing goods.

⁴ https://www.mof.go.jp/policy/customs_tariff/trade/safe_society/chiteki/index.html.

EFFORTS BY JAPAN TO STRENGTHEN THE ENFORCEMENT OF DESIGN RIGHTS

13. The spread of infringing goods results in lost foreign markets and a damaged brand image for Japanese companies. Recognizing that active countermeasures are essential for proper IP protection, Japanese customs and the JPO have implemented various initiatives to combat infringing goods infringing both domestically and internationally.

14. The JPO established the International Intellectual Property Protection Forum (IIPPF), a public-private partnership, to enhance collaboration with domestic and international government agencies and to promote IP protection. As part of its anti-infringement efforts, the JPO gathers information on domestic and foreign infringement activities involving Japanese rights holders and uses it to develop effective strategies from the perspective of the rights holders.

15. Japanese customs have strengthened border enforcement against IP-infringing goods, and support enforcement efforts abroad through capacity-building and training on border enforcement in developing countries, together with awareness-raising at the national level. While both agencies engage in activities related to awareness-raising, the Ministry of Finance (overseeing Japanese customs) and JPO are working to enhance cooperation and improve enforcement against infringing goods.

APPLICATIONS FOR SUSPENSIONS AT JAPANESE CUSTOMS

16. The Customs Act stipulates that any goods that infringe on patent rights, utility model rights, design rights, trademark rights, copyright and neighboring rights, layout design rights, or breeder's rights are prohibited from importation, as are goods that violate the Unfair Competition Prevention Act. This regulation covers a broader scope of IP rights for seizure than those specified in the TRIPS Agreement.

17. At Japanese customs in 2024, over 60 per cent of valid import suspension applications related to trademark rights, representing the largest share, followed by design rights at 18 per cent. Applications based on design, copyright and patent rights are also being used, and as awareness-raising efforts regarding the suspension system are bearing fruit.

NUMBER OF VALID APPLICATIONS FOR SUSPENSIONS (IMPORTS)

	2022		2023		2024	
	Cases	Percentage	Cases	Percentage	Cases	Percentage
Patent Rights	34	4.7%	34	4.6%	36	4.6%
Utility Model Rights	0	0.0%	0	0.0%	0	0.0%
Design Rights	124	17.3%	127	17.3%	144	18.4%
Trademark Rights	454	63.4%	477	64.8%	503	64.4%
Copyright	93	13.0%	90	12.2%	92	11.8%
Neighboring Rights	6	0.8%	4	0.5%	1	0.1%
Breeder's Rights	1	0.1%	1	0.1%	2	0.3%
Goods Violating the Unfair Competition Prevention Act	4	0.6%	3	0.4%	3	0.4%
Total	716		736		781	

Created from the Ministry of Finance website⁵

⁵ https://www.mof.go.jp/policy/customs_tariff/trade/safe_society/chiteki/index.htm.

REVISIONS TO THE SYSTEM AIMED AT STRENGTHENING ENFORCEMENT AGAINST GOODS THAT INFRINGE ON DESIGN RIGHTS

18. With the growth of cross-border e-commerce, cases of foreign businesses mailing small quantities of infringing goods to individuals in Japan have increased. Previously, goods imported by individuals for personal use were not subject to customs border enforcement, as importation for personal use was not considered infringement. However, amendments to the Trademark Act, Design Act, and Customs Act in October 2022 allow for enforcement against goods infringing design rights or trademarks, even if sent for personal use. Cooperation between Japan Customs and the JPO was evident during this amendment process.

19. Additionally, for goods subject to verification procedures⁶ based on an application for suspension⁷, simplified procedures⁸ were introduced in 2007 in relation to certain rights, such as trademarks. Initially, design rights were not included in these simplified procedures. However, the rise in seizures of goods that infringe on designs, which was driven by cross-border online transactions, led to the October 2023 amendment to the Order for Enforcement of the Customs Act, adding design rights to its scope. Under the simplified procedure, customs officers are allowed to determine infringement without requesting evidence from either the rights holder or the importer if the importer does not express an intention to contest the case. This reduces procedural steps and lessens the burden on customs officers. Moreover, it also benefits rights holders, as they are no longer required to submit evidence unless the importer indicates a willingness to dispute the case, thereby eliminating the burden of preparing documentation. This has reduced the burden on customs officials for certification and allowed better resource allocation for border enforcement. It has also eased the burden on rights holders when submitting opinions during verification procedures.

INITIATIVES TO STRENGTHEN BORDER ENFORCEMENT THROUGH COLLABORATION WITH THE RELEVANT MINISTRIES AND ORGANIZATIONS

20. Determining design rights infringement, which involves assessing similarity based on product maturity, requires specialized knowledge; products with high maturity are characterized by a large number of similar items that converge around specific shapes. In Japan, the JPO and Japanese customs signed a memorandum on anti-infringement cooperation. The JPO supports customs in determining design rights infringement through personnel exchanges and training, thereby helping to enhance their expertise.

21. JPO design examiners are seconded to Japanese customs as part of such personnel exchanges. When Japanese customs determines whether suspected goods fall under registered designs or a similar scope, these examiners harness their expertise from design examinations, including similarity standards, to support decisions without the need for complex interactions with the JPO. Since import suspensions are powerful measures, examiners also help to provide clarity on the applications of rights holders, in order to ensure fairness and avoid undue disadvantages to importers.

22. In Japan, a system exists to hear opinions from relevant authorities and IP experts to support customs decisions during verification procedures. For example, the Director General of

⁶ Verification procedures involve a decision by Japanese customs as to whether or not the suspected goods constitute IP rights infringement.

⁷ Rights holders submit applications for a suspension requesting that Japanese customs initiate verification procedures in the event that it detects imported/exported goods suspected of infringing on IP rights.

⁸ In the event that verification procedures are initiated based on applications for suspension, and the importer does not submit any written objections to Japanese customs about the “Notification of Initiation” during the designated period in the procedure, Japanese customs makes a decision related to infringement based on the information in the applications for suspension without asking for any further opinions or evidence from the concerned parties.

Customs may consult the JPO Commissioner to determine whether the suspected goods infringe on a design right. These opinions can be used to determine similarity in design infringement cases during certification.

23. The JPO sends instructors to training sessions on IP laws for customs officials, thereby helping to enhance their IP rights-related knowledge.

24. Through these initiatives, the JPO and Japanese customs are collaborating to strengthen enforcement against infringing goods in the country.

AWARENESS AND OUTREACH ACTIVITIES, INCLUDING THE USE OF APPLICATIONS FOR SUSPENSION

25. To ensure effective border enforcement, utilizing suspension applications by rights holders is essential. Therefore, relevant ministries and organizations, including the Japan Tariff Association⁹, are collaborating to promote the suspension system.

26. As part of this initiative, the JPO held a beginner-level seminar on measures against infringement under the FY2025 activities of the IIPPF, titled “Customs Applications for Suspension System”. Japanese customs officials served as instructors, providing an overview of border enforcement such as actions against design-infringing goods, and explaining detailed suspension application procedures.

27. The JPO believes that through the IIPPF, a unique initiative for combating infringing goods, there is significant potential to continue raising awareness and disseminating effective information among IIPPF member companies with regard to countermeasures such as border enforcement against infringing goods.

III. CONCLUSION

With the expansion of cross-border e-commerce and the diversification of methods to evade trademark infringement, relying solely on trademark rights is no longer sufficient. Rather, protection through multiple IP rights, including design rights, is necessary. Since determining design infringement is more complex than trademark infringement, Japanese customs and the JPO are collaborating to strengthen border enforcement based on design rights. The overarching goal is to curb the circulation of infringing goods by working with relevant ministries and organizations, with a view to maintaining business competitiveness.

[End of contribution]

⁹ The Japan Tariff Association is a Public Interest Incorporated Foundation established to contribute to the development of the customs system and customs administration.