

“Do I Need A License To Make This Toy?”

By David Ehrlich

Successful toys are very often miniature recreations of persons or objects in the real world or from an entertainment property. Whether or not the toy maker needs permission (a license) to make that recreation depends on several factors. These include the nature of the real world property, what kind of intellectual rights are involved (such as trademark or copyright), the nature of the toy, practice in the trade (in other words, do toy makers typically get licenses for that kind of toy), consumer perception (whether consumers assume that type of toy is usually licensed) and law already developed in prior infringement cases. A review of these factors allows us to state some general rules for certain types of toys.

1. Action figures and dolls:

Yes, a license is needed for action figures and dolls based on living persons, such as movie stars and athletes, since the law forbids the commercial use of the name or image of a real person without that person's prior permission (usually prior written permission). The law on the use of names and images of dead celebrities is too complicated to summarize in a short article, and differs from state to state in the United States.

Yes, a license from the copyright or trademark owner is also usually needed for action figures and dolls based on literary or entertainment characters that are still protected by copyright or whose names and images have been protected vigorously as trademarks. Examples of such characters are book, movie, cartoon, comic book and anime characters. For older characters, such as Tarzan or Peter Rabbit, the character name can be protected indefinitely, as a trademark, even if the character itself goes into the public domain when the copyright in the original book – where the character was first introduced – expires. You usually also need a license for other types of toys based on literary or entertainment properties, such as the Dukes of Hazzard car (which is the subject of a famous infringement case), the animals and vehicles from the Star Wars movies, and the Hogwarts castle building from the Harry Potter movies.

No, you usually do not need a license for generic or public domain figures, such as a realistic depiction of an animal, a teddy bear, a warrior, an older monster, such as a vampire, or a fairytale character, so long as your particular rendition of the character is original, and you have not closely copied someone else's toy or artwork.

2. Models of vehicles and buildings:

Yes, you probably do need a license for models or toy versions of current or recent cars, trucks, tractors, trains, and aircraft, especially if the toy or model bears the manufacturer's make or model designation, such as Ford Mustang for a car. Vehicle manufacturers now often request that toy companies take licenses and pay royalties for making these kinds of toys. Also, so long as the toy or model is recognizably a copy of

a particular famous vehicle, it may not be a defense that the toy or model does not use the manufacturer's trademark make or model names.

No, you probably do not need a license for toy versions or models of U.S. Navy ships, U.S. Army tanks, historic ships, NASA spacecraft, historic aircraft (such as planes from World War I or World War II) and old cars, trucks and tractors (such as the Model T Ford). The practice in the trade has been not to get permission to make these sorts of toys or models.

After many companies have made models or toys of older vehicles without licenses, it becomes almost impossible for a party claiming rights, such as the original manufacturer of the real article, to satisfy the test of trademark or trade dress infringement, that is, that the ordinary consumer thinks that the product is licensed or approved by the manufacturer of the real thing.

No, you probably do not need a license for models or toy versions of real-world landmark structures or buildings, such as the Empire State Building or the Statute of Liberty. Souvenir versions of these items have long been marketed without licenses. The case law generally has rejected claims by owners of famous buildings and structures, and has held that consumers are not confused and do not believe that those owners authorized the toys and models.

These are general guidelines only. It is always prudent to consult your attorney in specific cases.

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