

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

Barrel O’Fun Snack Foods Co., a
Minnesota corporation,

Court File No. _____ (___/___)

Plaintiff,

COMPLAINT

v.

Old Vienna, L.L.C.,

Defendant.

Plaintiff Barrel O’Fun Snack Foods Co., a Minnesota corporation (“Barrel O’Fun”) for its Complaint for declaratory relief, states and alleges as follows:

1. This action for declaratory judgment under 28 U.S.C. § 2201 and Rule 57 of the Federal Rules of Civil Procedure is brought for the purpose of determining a question of actual controversy between the parties as described below. Defendant Old Vienna, L.L.C. (“Defendant”) has demanded that Barrel O’Fun immediately cease use of its current packaging for its ENGINE CO. 51 brand 3 Alarm barbecue ripple potato chips (“ENGINE CO 51 ripple potato chips”), which Defendant claims infringes on its registered trademark RED HOT RIPLETS, (U.S. Reg. No. 2,423,085) and other intellectual property rights. Defendant made this demand in its counsel’s March 19, 2009 and March 23, 2009 letters to Barrel O’Fun, which alleged, among other things, that Barrel O’Fun intentionally infringed Defendant’s trademark, misappropriated Defendant’s packaging and seasoning and spice mixture for its chips. (True and correct

copies of Defendants' letters are attached hereto as Exhibits A & B.) Barrel O'Fun seeks a declaration, in advance of threatened commencement of suit by Defendant, that Defendant's claims are without merit and that Barrel O'Fun is not liable to Defendant for any alleged causes of action, including, but not limited to, trademark infringement, trade dress infringement and reverse engineering of its spice and seasoning formulation.

THE PARTIES

2. Plaintiff Barrel O'Fun is a Minnesota corporation with its principal place of business at 800 Fourth Street Northwest, Perham, Minnesota 56573. Barrel O'Fun has been a manufacturer and distributor of snack foods for approximately 36 years.

3. Defendant is, upon information and belief, an entity organized under the laws of Illinois with a principal place of business at 345 South Old Highway 141, Fenton, Missouri 63026. Upon information and belief, Defendant manufactures and distributes snack foods, including a brand of potato chips sold under the mark RED HOT RIPLETS.

JURISDICTION AND VENUE

4. This action for declaratory judgment is brought to determine rights under the Lanham Act, 15 U.S.C. § 1051 et seq. This Court has jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338.

5. Venue is appropriate in this district pursuant to 28 U.S.C. §§ 1391(b) and 1391(c) on the grounds that a substantial part of the events or omissions giving rise to the claim occurred in this district.

STATEMENT OF THE CASE

6. Upon information and belief, Defendant obtained a registration in the mark RED HOT RIPLETS from the U.S. Patent and Trademark Office on or about January 23, 2001 for “potato chips,” alleging first use in 1996. (U.S. Reg. No. 2,423,085.) The registration specifically disclaims the exclusive right to use “HOT” apart from the mark as shown. (*Id.*)

7. Defendant sells its RED HOT RIPLETS potato chips in a white package, with the words “Red Hot Riplets Hot Barbecue Flavored Ridged Potato Chips” in white/red letters on a yellow background. The package has “Old Vienna of St. Louis” written across the top in white letters on a red background. The top of the package also includes blue strips of sky and water, green trees and a blue paddlewheel boat design. The package states that the RED HOT RIPLETS product is “Made With Real St. Louis Hot Sauce” and is “The Flavor of America’s Heartland.” (A true and correct copy of a photograph of the packaging of Defendant’s Old Vienna potato chips and the packaging of Barrel O’Fun’s ENGINE CO. 51 ripple potato chips is attached hereto as Exhibit C).

8. Barrel O’Fun’s ENGINE CO. 51 ripple potato chips are sold in a package with a red brick and flames design in the background, with the words “Red Hot 3 Alarm Barbecue Ripple Potato Chips” in yellow/red letters and black letters on a white background. The brand ENGINE CO. 51 is written in black letters on a red background at the top of the package, over a stylized fire shield and tools bearing the number “51.” The ENGINE CO. 51 packaging does not claim the product is made with St. Louis hot sauce or that it is the “flavor of America’s Heartland.” (Exhibit C).

9. On or about March 19, 2009, Defendant's attorney sent a letter to Barrel O'Fun asserting, among other things, that Barrel O'Fun's ENGINE CO. 51 ripple potato chips packaging infringed on Defendant's RED HOT RIPLETS mark and that the ENGINE CO. 51 ripple potato chip packaging was "deceptively similar" to Defendant's RED HOT RIPLETS packaging. (Exhibit A). In the letter, Defendant's counsel demanded that Barrel O'Fun immediately cease using the words "Red Hot" and "Ripple" and all marketing and sale of the product using "the packaging design that mimics that of Old Vienna." (*Id.*)

10. On or about March 20, 2009, Barrel O'Fun responded to Defendant's March 19, 2009 letter, rejecting Defendant's claim of infringement and refusing to recall the product or cease current distribution. The letter also proposed a business resolution to the matter.

11. On or about March 23, 2009, Defendant's attorney sent a second letter to Barrel O'Fun, rejecting Barrel O'Fun's offer and demanding that Barrel O'Fun immediately cease using the current packaging for its ENGINE CO. 51 ripple potato chips, pull existing stock from retailers' shelves, and cease shipping of the ENGINE CO. 51 ripple potato chips as soon as possible. (Exhibit B.) The letter alleges that the ENGINE CO. 51 packaging "infringes on Old Vienna's federally registered and incontestable trademark RED HOT RIPLETS." (*Id.*) It also alleges that Barrel O'Fun "reversed-engineered the seasoning and spices contained in our client's brand of chips" and is using the seasoning mix for its ENGINE CO. 51 Ripple Potato Chips. (*Id.*) The letter specifically states:

The combination of use of Old Vienna's seasonings and spices along with the similar packaging and design of Barrel's potato chips is evidently intended to create actual confusion in the marketplace as a way of establishing a marketing base for your client's product at the expense of our client.

(Id.) The letter also demands an accounting of all of Barrel O'Fun's sales of the ENGINE CO. 51 ripple potato chips and a list of its customers "so that we may compute Old Vienna's damages." *(Id.)*

CAUSE OF ACTION FOR DECLARATION

12. Defendant incorporates the allegations of the previous paragraphs as though fully stated herein.

13. Defendant's conduct shows there is a substantial controversy between the parties regarding Barrel O'Fun's use of the ENGINE CO. 51 packaging, which has created adverse legal interests that are real and immediate.

14. In the Defendant's written correspondence, Defendant has alleged that Barrel O'Fun's packaging infringes on its RED HOT RIPLETS mark, and that Barrel O'Fun "reverse-engineered" Defendant's seasoning and spices to create confusion in the marketplace. Defendant also demanded information about sales of the ENGINE CO. 51 ripple potato chips to allow it to calculate its damages. These statements demonstrate an actual intention to sue Barrel O'Fun for its use of the ENGINE CO. 51 ripple potato chip packaging and to hold Barrel O'Fun liable for any infringement; therefore, an actual controversy exists among and between the parties to this action.

15. Resolution of this definite and concrete controversy requires a determination by the Court of whether Barrel O'Fun's use of the current packaging of the

ENGINE CO. 51 ripple potato chips violates Defendant's rights in its mark RED HOT RIPLETS and its trade dress.

16. Resolution of this definite and concrete controversy requires a determination by the Court of whether Defendant has any protectable interest in its claimed formula of spices and seasonings and whether Barrel O'Fun reversed engineered said formula.

17. If a declaration is not granted, Barrel O'Fun's rights will be adversely affected and Barrel O'Fun may sustain significant losses.

18. Barrel O'Fun has a valid interest in prompt resolution of this controversy in order to avoid the unnecessary and unwarranted expenditure of resources that will otherwise be caused by a prolonged dispute with Defendant, particularly if Barrel O'Fun is subsequently determined not to be liable for Defendant's alleged actions or other wrongdoing.

RELIEF REQUESTED

WHEREFORE, Plaintiff Barrel O'Fun Snack Foods Co. respectfully requests that this Court:

a. Declare that Barrel O'Fun's use of the terms "red", "hot" and "ripple" individually or collectively do not infringe Defendant's registered trademark RED HOT RIPLETS, (U.S. Reg. No. 2,423,085) or any other intellectual property rights Defendant may have.

b. Declare that Barrel O'Fun's use of the current packaging for its ENGINE CO. 51 ripple potato chips does not constitute trademark infringement, trade dress infringement or a violation of any of Defendant's intellectual property rights;

c. Declare that Barrel O'Fun is not and cannot be liable to Defendant for the use of its ENGINE CO. 51 packaging;

d. Declare that Barrel O'Fun may continue to use the seasoning and spices presently contained in ENGINE CO. 51 ripple potato chips, which are in fact formulated by a third-party;

e. Enter an appropriate order enjoining Defendant from commencing suit against Barrel O'Fun for any alleged violation of intellectual property rights based on Barrel O'Fun's use of the current packaging of its ENGINE CO. 51 ripple potato chips;

f. Enter an appropriate order enjoining Defendant from commencing suit against Barrel O'Fun for allegedly reverse engineering Defendant's seasoning and spices on Barrel O'Fun's ripple potato chips; and

g. Award such other relief as may be deemed just and proper.

Dated: March 24, 2009

s/ Norman M. Abramson

Norman M. Abramson (#241982)

Lori L. Wiese-Parks (# 131647)

Joy R. Anderson (#0388217)

Gray, Plant, Mooty, Mooty & Bennett, P.A.

500 IDS Center

80 South Eighth Street

Minneapolis, MN 55402-2100

Telephone: (612) 632-3000

Facsimile: (612) 632-4444

**ATTORNEYS FOR PLAINTIFF
BARREL O'FUN SNACK FOODS CO.**

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