



Neutral Citation Number: [2024] EWHC 1507 (IPEC)

Case No: IP-2023-000051

**IN THE HIGH COURT OF JUSTICE**  
**BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES**  
**INTELLECTUAL PROPERTY ENTERPRISE COURT (ChD)**

Rolls Building  
Fetter Lane  
London, EC4A 1NL

18 June 2024

**Before :**

**MICHAEL TAPPIN KC**  
**(sitting as a Deputy Judge of the High Court)**

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**Between :**

**SERAPHINE LIMITED**

**Claimant**

**- and -**

**MAMARELLA GMBH**

**Defendant**

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**Ben Lewy (instructed by Fox Williams LLP) for the Claimant**  
**Sonder & Clay Legal Ltd for the Defendant**

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**Approved Judgment**

I direct that no official shorthand note shall be taken of this judgment and that copies of this version as handed down may be treated as authentic.

This judgment was handed down remotely at 10.30 am on 18 June 2024 by circulation to the parties' representatives by email.

## **The Deputy Judge:**

1. On 1 March 2024 I gave judgment ([2024] EWHC 425 (IPEC)) on various applications that came before me for hearing on 24 February 2024. In my judgment, I held that the Claimant (“Seraphine”) was entitled to serve these proceedings, as originally pleaded, out of the jurisdiction without the court’s permission and so rejected the application by the Defendant (“Mamarella”) for service to be set aside and a declaration that the court had no jurisdiction. I also, for the reasons explained in my judgment, refused Seraphine permission to amend its case in the manner then proposed, to introduce further alleged design rights and further allegedly infringing garments. Following the hearing, and in accordance with my directions, Seraphine provided Mamarella with a revised draft Amended Particulars of Claim. Mamarella agreed that the revised draft was in accordance with my judgment and the Amended Particulars of Claim were served on 28 March 2024.
2. As I recorded in paragraph 39 of my judgment:

“As mentioned above, Mamarella had applications to stay these proceedings (if its primary applications failed) pending proceedings in Germany, and in particular those in Munich. Faced with authority to the effect that a party who had agreed to an English jurisdiction clause required overwhelming reasons for a stay on forum non conveniens grounds, and that such reasons could not include factors that were foreseeable at the time the agreement was entered into, Mr Harbottle withdrew Mamarella’s application for a stay on the basis of forum non conveniens. He initially persisted in seeking a stay on case management grounds, but eventually agreed that, given that the Munich proceedings were coming to an oral hearing on 18 March 2024, with judgment expected relatively soon thereafter, the more sensible course was simply to give directions for a defence at a time expected to be after the outcome of the Munich proceedings, with liberty to restore the application for a stay.”
3. Accordingly, I ordered Mamarella’s stay applications to be adjourned generally with liberty to apply to restore them unless and until Mamarella filed a Defence (which I ordered to be filed by 24 May 2024). Mamarella did not file a Defence by 24 May 2024 (nor has it since done so). Instead, on that date it issued the current application seeking a stay of the current proceedings pending the decision of the Munich court in the proceedings before it. This is my judgment on that application, which I have, as requested, dealt with on the papers with the benefit of short submissions from Mr Levy for Seraphine as well as evidence in a series of witness statements (the last of which was dated 13 June 2024) from the parties’ solicitors, Mr Clay (whose firm took over representation of Mamarella in March 2024) and Mr Bennett for Seraphine.
4. As can be seen from my judgment of 1 March 2024, at that time it was expected that there would be a judgment from the Munich court relatively soon after the oral hearing on 18 March 2024. For that reason, the parties agreed that it was sensible and pragmatic to delay the Defence in these proceedings until a date by which it was expected that judgment of the Munich court would have been received.
5. However, my understanding (based on the evidence of Mr Clay and Mr Bennett, both of whom rely on what they have been told by their clients’ respective German lawyers) is that at the hearing on 18 March 2024 the Munich court indicated that its preliminary assessment was that the remaining claims of Mamarella were not admissible as then

formulated, but gave Mamarella the chance to reformulate those claims. As I understand it, Mamarella applied to amend its claims on 2 April 2024, and the relevant reformulated claim is for a declaration that Mamarella has not, through its advertising or sale of 30 identified products, infringed any unregistered Community design rights of Seraphine, and that Seraphine is not entitled to make any unfair competition claim in that regard.

6. It is important to note that the 30 garments referred to in the Munich proceedings include four which are relied on by Seraphine in the current proceedings; each is alleged to be an infringement of an unregistered Community design right alleged to belong to Seraphine. Those four garments have been referred to as the “Overlap Garments”. However, in these proceedings Seraphine also relies on four other unregistered Community design rights alleged to belong to it which are said to have been infringed by four Mamarella garments which are not in issue in the Munich proceedings.
7. The Munich court has now appointed an oral hearing for 18 November 2024. The evidence of Mr Clay (based on what he has been told by Mamarella’s German lawyer) is that that hearing is likely to be the last oral hearing in those proceedings, and that the Munich court will probably hand down judgment, dealing with the issue of whether the Overlap Garments infringe Seraphine’s unregistered Community design rights, within 4 to 8 weeks thereafter. Mr Bennett says (based on what he has been told by Seraphine’s German lawyer) that it is possible that the Munich court will consider Mamarella’s amended claims to be inadmissible, in which case no judgment on the merits would be delivered. Mr Clay responds by saying that Mamarella’s German lawyer has told him that is very unlikely because at the 18 March 2024 hearing the judge explained the problem and gave guidance as to how to overcome it, and that Mamarella has followed that guidance in amending its claims. Overall, therefore, it appears likely that the Munich court will give a judgment on the merits at the end of 2024 or very early in 2025, but the possibility that a judgment on the merits will not be delivered at that time cannot be excluded.
8. There is then the question of what the impact of that judgment will be on the current proceedings. Mr Clay asserts that a decision in Mamarella’s favour (or, indeed, against Mamarella) in the Munich proceedings will give rise to a *res judicata*, while Mr Bennett asserts that the issues in the two proceedings are different. I do not feel able, on the limited materials before me, and without the benefit of argument, to determine at this stage whether any judgment of the Munich court will give rise to a *res judicata* in these proceedings. In my judgment, any assessment of the impact of a judgment of the Munich court is best decided after such a judgment is delivered and with the benefit of argument and any necessary evidence from German lawyers.
9. Against that background, I am asked by Mamarella to stay these proceedings on case management grounds pending judgment by the Munich court. Mr Clay says that it is not in the parties’ interests for these proceedings to continue while the Munich court is considering the issues before it. He says that the parties will have to spend time, money and effort (including on disclosure and evidence) dealing with the issues of subsistence of the unregistered Community design rights relied on by Seraphine in respect of the Overlap Garments and of infringement of those rights by the Overlap Garments, and that the parties will not be properly compensated for any wasted costs given the costs regime that applies in IPEC. He says that these proceedings can be better dealt with in

accordance with the overriding objective by staying them until the Munich judgment is delivered. He also points out that there is no urgency about these proceedings as any unregistered Community design rights have now expired.

10. Mr Bennett points out that these proceedings were commenced almost exactly a year ago, and served (at the latest) in October 2023, but have still not proceeded as far as a Defence because of applications made by Mamarella. He says that the delay in the Munich proceedings can be laid at Mamarella's door, and that it should not be allowed to string out these proceedings further than it has already done by relying on that delay. He also says that the existence of the Munich proceedings cannot provide a reason to stay these proceedings save in respect of the Overlap Garments. He therefore proposes that Mamarella should serve its Defence in relation to the garments other than the Overlap Garments within 14 days and have a further 28 days to serve a supplementary annex to the Defence addressing the Overlap Garments. Mr Clay responds by saying that if a complete stay is not ordered, Mamarella's fallback position is that there should be a stay in relation to the Overlap Garments, that Mamarella should serve its Defence in relation to the other garments within 14 days and have permission to amend its Defence to deal with the Overlap Garments within 14 days after the Munich court's judgment is delivered.
11. In my judgment, the best way to manage these proceedings having regard to the overriding objective is not to order a stay, either generally or in relation to the Overlap Garments. In my judgment Mamarella should now serve its Defence. It is clear from the first witness statement of Mr Clay that as at 24 May 2024 preparations for service of that Defence were well advanced; he says that by that date over eighty pieces of potential prior art relating to the eight garments in issue had been identified. There is no reason why Mamarella should not serve its Defence in respect of the garments which are not in issue in the Munich proceedings. Further, given that Mamarella's position is that the issues in respect of the Overlap Garments are the same as in the Munich proceedings, Mamarella must be in a position to serve its Defence in relation to those garments, as it was ready for an oral hearing in Munich in March 2024. If Mamarella wishes to advance a case that the judgment of the Munich court will give rise to a *res judicata*, then it should plead that case in its Defence.
12. Once the pleadings are closed and the full nature of the case can be seen, then a case management conference will need to be fixed. It is likely now that it will take place in the early autumn. At that case management conference, the court will need, with the parties' assistance, to consider what directions to trial are appropriate, having regard amongst other factors to the nature and timing of the proceedings in the Munich court. For example, it may, taking into account the limited time available at trial in IPEC, be appropriate for the number of alleged design rights and infringements thereof to be considered at trial (and to be the subject of evidence and any disclosure) to be limited. If so, various factors may come into play in deciding which alleged design rights and infringements are to be considered at trial. Those may include the complexity of the issues of subsistence and infringement in respect of each alleged design right, the amount of disclosure and evidence that would be needed to address them, the commercial importance of the particular design and garment to the parties, and whether or not the issues in relation to the design and garment are likely to be determined by the Munich court. It is at that stage that Mamarella's concerns about the expenditure of

time, money and effort on matters that are also being litigated in Munich can be best addressed.

13. For these reasons I shall dismiss Mamarella's application. I am not attracted by the idea of splitting the Defence so that it deals initially with the non-Overlap Garments and is then supplemented by an annex addressing the Overlap Garments. For the reasons I have explained above, Mamarella must now be in a position to serve its Defence to the whole of the claim. I shall direct that it should serve its Defence by 3 July 2024, which will make the Reply due by 31 July 2024. I would ask the parties to seek to agree an order to reflect this judgment; if they are unable to do so I shall deal with any residual dispute on the papers.