



Nov 18, 2024

**Categories:**

[Gibbons](#)

[Pharmaceuticals](#)

**Authors:**

[Christopher H. Strate](#)

[Christine A. Gaddis](#)

## District of Delaware Court Dismisses, with Prejudice, Claims Withdrawn Pursuant to Case Narrowing Order

---

In *Exeltis USA Inc. v. Lupin Ltd.*, the United States District Court for the District of Delaware recently ruled, over the plaintiffs' objection, that claims dismissed by the plaintiffs in response to the District Court's case narrowing order were dismissed with prejudice.

*Exeltis* is a Hatch-Waxman litigation involving patents covering Exeltis's SLYND® product. During the case, the court entered a case narrowing order that required the plaintiffs to reduce the number of asserted claims and the defendants to reduce the number of invalidity defenses. The parties complied with the order, and the plaintiffs then won at trial. Following trial, the plaintiffs argued that the claims dismissed pursuant to the court's case narrowing order should be without prejudice based on "fundamental fairness." The court disagreed, finding that fundamental fairness was best supported by the certainty that came with a dismissal with prejudice.

This ruling appears to have created a split within the District of Delaware. In *Ferring Pharms. Inc. v. Fresenius Kabi USA, LLC*, 645 F. Supp. 3d 335 (D. Del. 2022), another Delaware Court held that claims withdrawn pursuant to the court's case narrowing order were dismissed without prejudice.

In light of the court's ruling in *Exeltis*, plaintiffs in Hatch-Waxman cases in the District of Delaware should be aware of the risk that the court could dismiss patent claims dismissed or withdrawn pursuant to a case narrowing order with prejudice. Thus, it would be prudent for the plaintiffs to get the court's and/or defendant's agreement early in the case that any patents and claims not asserted because of the court's case narrowing order will be dismissed without prejudice. Plaintiffs should also ensure that any case narrowing order provides them with the opportunity to add additional claims if they can show that such additional claims raise non-duplicative

issues of validity or infringement as the Federal Circuit has articulated in *In re Katz*, 639 F.3d 1303 (Fed. Cir. 2010) with respect to requirements for case narrowing provisions.

© 2026 FBT Gibbons LLP. May be considered attorney advertising in some jurisdictions.