ARTICLE

THE NEW CONFIDENTIALITY REGIME ATTACHED TO IN-HOUSE COUNSEL LEGAL OPINIONS: WHAT IMPACT ON PRELIMINARY INVESTIGATIVE MEASURES SUCH AS THE SEIZURE OF INFRINGING GOODS (“SAISIE-CONTREFAÇON”) OR MEASURE BASED ON ARTICLE 145 OF THE FRENCH CIVIL PROCEDURE CODE?

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DATA PRIVACY

The new Article 58-1 of the Law of December 31, 1971[1] , whose entry into force will be determined by decree, establishes a new confidentiality regime for in-house counsel legal opinions. What impact will this new regime have on preliminary investigative measures such as the seizure of infringing goods (“saisie-contrefaçon”) or measure based on article 145 of the French civil procedure code (“CPC”)? and how will it interact with the regime for the protection of trade secrets provided for in the French Commercial Code?

I. ***Implementation of the new regime in the context of seizure of infringing goods or measure based on article 145 CPC***

Legal opinions drafted by in-house counsels or, at their request and under their supervision, by a member of their team under their authority, are covered by confidentiality, subject to cumulative conditions relating to the author of the opinion[2] , the recipients[3] , and the content of the opinion [4] .

The new article provides that this new confidentiality regime may be invoked in particular during the execution of a preliminary investigative measure ordered in the context of a civil or commercial dispute, which mainly concerns seizure of infringing goods (the “saisie-contrefaçon” of the French intellectual property code)[5] and preliminary investigative measures based on art. 145 CPC***[6]*** . If confidentiality is invoked in this context, then the opinion may be seized, but only under certain conditions.

Firstly, the seizure can only be carried out by a bailiff appointed "*for this purpose by judicial decision*"[7] . If the infringement seizure applicant wishes to have legal opinions seized, they must therefore explicitly provide, in their ex-parte application for infringement seizure, for the bailiff to be authorized to seize such opinions. If the applicant has not done so; they may have to return to court to obtain this authorization. Can the applicant do so in the same application as those relating to the “saisie-contrefaçon” ? or must the applicant provide for a separate application specifically for the seizure of in-house legal opinions? It may also be asked whether such authorization can be granted by the Unified Patent Court in the context of an order to preserve evidence or for inspection[8] .

The seizure takes place "*in the presence of a representative of the company on the one hand, and the applicant or administrative authority on the other*[9] ." With regard to the "*company representative*," the judges will have to specify whether this term can refer to any employee of the company present during the operations or whether it must be the legal representative or one of his delegates.

With regard to the "*applicant*," the wording of the text is confusing: does it refer to the applicant himself or his lawyer? If it is the applicant for the preliminary investigative measure who must be present, this goes against case law, which prohibits the applicant for a saisie-contrefaçon or his agents from attending the operations, even if authorized by order[10] . With regard to the applicant's lawyer, it has been ruled that there is nothing in the law to prohibit him from being appointed as an expert to assist the bailiff carrying out the saisie-contrefaçon[11] , but in practice this does not happen. His presence would cause practical difficulties: would the lawyer have to be "on call," i.e., available to come to the scene of the seizure in the event that the seized party invoked

the protection of Article 58-1? Or could he be present from the start of the operations? The question will also arise as to whether this lawyer will be able to represent the applicant in the proceedings following the seizure. In any event, the application/order must specify the way the applicant will be summoned and ensuring his present (or of his lawyer) if confidentiality of in-house legal opinions is invoked.

Once seized, the legal opinion is immediately sealed by the bailiff, who draws up a report of these operations. Will this be a separate report from that of the seizure of infringing goods? In all cases, the seal is distinct from the sequestration provided for by the trade secret protection regime[12] . The seal and the report are kept in the bailiff's office. No sorting of the seized documents is carried out on site.

In this regard, one may wonder what will happen in the following situation: the order for seizure of infringing goods authorizes the bailiff to seize computer documents using keywords specified in the order; this keyword search leads the bailiff to seize a very large number of files, which he places in sequestration pending sorting operations. Such sorting operation then reveal that the seized documents contain an in-house legal opinion that is relevant to the infringement dispute... but the seized party did not claim confidentiality of such legal opinion "*at the time of the seizure*," as required by Article 58-1 III. A, because it had not noticed that this opinion was among the documents seized. In this case, can the seized pary claim confidentiality after the seizure, for example during the sorting process? Could it go so far as to invoke the nullity of the infringement seizure operations on the grounds of this unauthorized seizure of confidential opinions?

II. ***Interrelation between the new regime and that of trade secrets***

The new text organizes the legal procedure that will determine the fate of the sealed documents. Its terms and conditions differ from those provided for in the Commercial Code for the protection of trade secrets.

Under the trade secrets regime, it is up to the seized party to take summary proceedings to set aside the order within one month if it wishes to obtain protection for the documents placed in sequestration. Otherwise, the sequestration is lifted and the documents are transmitted to the applicant for the investigative measure[13] . Under the regime of Article 58-1, the logic is reversed: it is up to the applicant for the investigative measure to take action to challenge confidentiality in summary proceedings, within fifteen days, if they wish to have the seals broken and the documents disclosed. Otherwise, the documents are returned to the seized party—if they so request within fifteen days of the aforementioned contestation period[14] —or destroyed.

Under the rules governing trade secret, the judge may examine the documents alone and, if he deems it necessary, order an expert opinion and seek the opinion of the parties' representatives[15]. Under the regime of Article 58-1, the judge must open the seal *"in the presence of a representative of the company on the one hand, and the applicant or the administrative authority on the other."* Paragraph IV of the new article also provides that the company claiming protection must be assisted or represented by a lawyer "*in the legal proceedings referred to in III.*" The new text does not provide for such an obligation of representation by a lawyer for the applicant for the preliminary investigative measure. Nevertheless, if the summary proceedings take place before the president of the judicial court, which will be the case for summary proceedings under Article 58-1 following a seizure for infringement[16] , this obligation is provided for in Article 760 of the Code of Civil Procedure. If the summary proceedings take place before the president of the Commercial Court, the provisions of Article 853 of the Commercial Code will apply. During this hearing to unseal the documents, will the parties and lawyers present be able to access the documents? Or will only the judge be able to consult them without revealing their contents? This point remains unclear...

Whereas, under the trade secret regime, the judge may also decide to take the protective measures provided for in Article L. 153-1, and in particular restrict access to documents covered by trade secret to a limited number of persons within a “confidentiality club”, this type of measure is not explicitly provided for under the new regime.

After hearing the parties, the judge shall rule on the fate of the sealed documents[17] . He should normally allow them to be disclosed to the applicant if the documents do not meet the conditions of Article 58-1. According to the decision of the Constitutional Council, Article 58-1 must also be interpreted "*as allowing the president of the court to order, in [the context of a civil or commercial dispute], the lifting of confidentiality of a legal opinion when its purpose is to facilitate or encourage the commission of fraud against the law or the rights of a third party*"[18] . Will the judge hearing the case be able to use this wording from the Constitutional Council to lift the confidentiality of in-house legal opinions that would encourage the commission of an IP right infringement?

In civil and commercial matters, the new text does not provide for a specific appeal[19]. The common law of Article 490 of the CPC should therefore apply. For the time being, in the absence of any provision to the contrary, the appeal is not suspensive. It would be desirable for the decree to provide for the suspensive effect of the appeal, at least when the decision grants the request for disclosure, as provided for in Article R. 153-8 of the Commercial Code. Indeed, in the absence of suspensive effect, the disclosure of documents will take place and, if the appeal judgment overturns the first instance decision, it will not be possible to "backtrack."

III. ***Risks of litigation becoming more complex***

The trade secret protection regime had already complicated the implementation of preliminary investigative measures. Article 58-1 introduces an autonomous regime and therefore a new degree of complexity.

On the part of the seized party, in order to be able to invoke the new protection regime—and to respond to potential challenges from the applicant —it will be necessary to establish an internal procedure within the company to ensure compliance with the conditions set out in Article 58-1 I, in particular the traceability of in-house legal opinions, as confidentiality extends to successive versions of the same opinion[20].

On the part of the applicant for the investigative measure, it will be necessary – from the stage of the application – either to expressly exclude from the scope of the measure any seizure of legal opinions meeting the conditions of Article 58-1, in order to avoid its implementation, or, if such seizure is envisaged, provide that the bailiff will isolate, on the one hand, documents from the company's legal department that may be subject to the protection of Article 58-1, on the other hand, documents for which the protection of trade secrets (or any other secret protected by law) is alleged, and finally, documents for which no protection is alleged. It will then be up to the bailiff to clearly indicate in his report, for each document, which group it belongs to, as this will determine the further procedure for that document: sealing under the new Article 58-1 vs. sequestration under Article R.153-1 of the Commercial Code, the party to refer the matter to the judge (applicant for the measure vs. seized party), the time limit for bringing the matter before the judge (15 days vs. 1 month) and the consequences of failure to do so (return of the sealed items vs. lifting of the sequestration).

When, in the course of the same measure, the seized party invokes the provisions of Article 58-1 for certain documents and those of trade secrets for others, two parallel procedures may coexist. It is to be hoped that joinders will be ordered to prevent access to opinions from being authorized before a decision is made on the application to set aside the order. In addition, the question will also arise as to whether the seized party may, if it has not invoked the specific regime of Article 58-1, invoke trade secrets for these documents or whether it can invoke one and, subsidiarily, the other....

Conclusion

The new confidentiality regime for in-house legal opinions, combined with the existing system for protecting trade secrets, risks significantly complicating evidentiary proceedings and increasing the number of litigation incidents. The implementing decree must address the numerous ambiguities identified in this article. In any event, practitioners would be well advised to anticipate

difficulties ahead of seizure operations, and the first court decisions will be decisive in defining the precise contours of this new system.

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[1] resulting from Law No. 2026-122 of February 23, 2026, on the confidentiality of opinions with corporate lawyers, adopted by the National Assembly on first reading (T.A. 293) then by the Senate without amendment on January 14, 2026, and validated by the Constitutional Council (Decision No. 2026-900 DC of February 18, 2026).

[2] He must hold a master's degree in law or equivalent and provide evidence of training in specific ethical rules to be determined in accordance with the terms set by decree (Art. 58-1, I, 1° and 2° and Art. 2 of Law No. 2026-122 of Febr uary 23, 2026 on the confidentiality of opinions with corporate lawyers)

[3] it must be addressed to the legal representative, his or her delegate, or a management, administrative, or supervisory body of the employing company, to an entity providing advice to these bodies, to the bodies of the controlling company within the meaning of Article L. 233-3 of the Commercial Code, or to the bodies of controlled subsidiaries (Art. 58-1, I, 3°)

[4] it must constitute a personalized intellectual service aimed at providing an opinion or advice based on the application of a rule of law, it must bear the words "confidential – legal opinion – corporate lawyer," it must identify its author and be filed separately in the company's files and, where applicable, in the files of the recipient group company (Art. 58-1, I, 4° and 5°)

[5] Art. L. 332-1, L. 332-4, L. 343-1, L. 521-4, L. 615-5, L. 716-7, L. 622-7, L. 623-27-1 of the CPI

[6] Art. 145 of the CPC

[7] Law No. 71-1130 of December 31, 1971, future Art. 58-1, III, A

[8] Rules 192 et seq. of the Rules of Procedure of the Unified Patent Court

[9] when the measure is ordered in the context of administrative proceedings

[10] See, in particular, Cass. Com., April 28, 2004, No. 02-20.330; Cass. Com., July 8, 2008, No. 07-15.075; JCL Brevets, Fasc 4634, §75

[11] *Cass. com., April 18, 2000, No. 97-19.631;* see also Recueil Dalloz 2001, "Independence of the expert assisting the bailiff during a seizure of counterfeit goods"*;* however, annulment of infringement seizure reports when the lawyer did not decline his status (CA Rennes, ch. 2, Jan. 10, 2006, no. 04/01562; TGI Paris, Feb. 23, 1994: RD propr. intell. 1996, no. 64, p. 27)

[12] It should be noted that the Court of Cassation has specified that in order to protect trade secrets during a seizure for counterfeiting, the judge may only resort to the provisional sequestration procedure provided for in Article R.153-1 of the Commercial Code (Cass. Com., February 1, 2023, No. 21-22.225)

[13] Art. R. 153-1 of the Commercial Code

[14] Art. 58-1, III, E

[15] Art. L. 153-1 of the Commercial Code

[16] Such a measure may only be ordered by a judge of the judicial court. The summary proceedings for contesting Article 58-1 may therefore only be brought before the president of the judicial court in this case (Art. 58-1, III, B).

[17] Art. 58-1, III, D

[18] Decision No. 2026-900 DC of February 18, 2026, §19 and 20

[19] Whereas a specific appeal is provided for in paragraph V of the text for orders of the liberty and custody judge issued pursuant to III. B. paragraph 2.

[20] Art. 58-1 I last paragraph.
