

O-411-13

**Trade Marks Act 1994**

**In the matter of an application for Trade Mark Registration No. 2653570**

**Yukigassen**

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1. On 21 February 2013 Cousins Entertainment Ltd ('the applicant') applied to register trade mark application number 2653570, consisting of the word mark 'YUKIGASSEN', for the following goods and services:
  - Class 9 Computer software, computer software for facilitating online services for data retrieval, upload, download, access and management, computer software for the uploading, downloading, posting, accessing, tagging, displaying, streaming, logging, sharing, linking, or otherwise providing electronic media or information via a computer and communication network, electronic publications (downloadable) provided online from computer databases or the internet, compact discs, CD-ROM's and DVD's, mouse mats and pads, parts and fittings for the aforesaid goods.
  - Class 16 Printed matter, printed publications, leaflets, brochures, magazines and journals, periodical publications, newspapers, books, newsletters, guides, manuals, printed programmes, stationery, diaries, calendars, notebooks, address books, writing implements, pens and pencils.
  - Class 35 Personnel management services, evaluation of personnel and personnel requirements, team building services, business management and organisation consultancy services, business efficiency services, business research services, psychological testing for the selection of personnel, business appraisal services, advisory, consultancy and information services relating to the aforesaid.
  - Class 41 Education and training services, organising and conducting classes, workshops, lectures, seminars, symposiums, conferences and exhibitions, organisation, production and presentation of films, shows and documentaries, photo sharing and video sharing services, publishing and electronic publishing services, providing electronic publications (not downloadable), advisory, consultancy and information services relating to all the aforesaid.
2. On 11 March 2013 the Intellectual Property Office ('IPO') issued its examination report. The examiner raised objection under section 3(1)(b) and (c) on the basis that YUKIGASSEN is a Japanese word meaning 'snow battle'. Apparently this is a sport taking the form of a team or collective snowball fight (although the projectiles are not necessarily made of snow itself), and is described as such in the WIKIPEDIA online encyclopaedia. The entry from WIKIPEDIA is attached to this statement of grounds.
3. From this, the examiner stated the word 'YUKIGASSEN', when used in relation to the goods and services intended for protection, would denote 'subject matter'. As such, it

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would designate a characteristic of those goods and services and thus render the application objectionable under section 3(1)(c).

4. As part of the examination process, the examiner also produced some internet hits including a BBC online news report dated 11 May 2000 (also attached to this statement of grounds), showing that the term *is* recognised in the UK.
5. The attorney for the applicant, Mr Andrew Murch of Hallmark IP Ltd, contested the objection and the matter came before me at an ex parte hearing on 23 May 2013.
6. In support of the application, Mr Murch relied in correspondence and at the hearing on the principles expressed at paragraphs 24-26 of the Judgment of the Court of Justice of the European Union ('CJEU') in Case C-421/04 *Matratzen Concord AG v Hukla Germany SA* [2006] ETMR ('*Matratzen*') which reads as follows:

*24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779 at [29]; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619 at [77]; and Case C-218/01 *Henkel* [2004] ECR I-1725 at [50]).*

*25. It is possible that, because of linguistic, cultural, social and economic differences between the Member States, a trade mark which is devoid of distinctive character or descriptive of the goods or services concerned in one Member State is not so in another Member State (see, by way of analogy, concerning the misleading nature of a trade mark, Case C-313/94 *Graffione* [1996] ECR I-6039 at [22]).*

*26. Consequently, Art. 3(1)(b) and (c) of the Directive does not preclude the registration in a Member State, as a national trade mark, of a term borrowed from the language of another Member State in which it is devoid of distinctive character or descriptive of the goods or services in respect of which registration is sought, unless the relevant parties in the Member State in which registration is sought are capable of identifying the meaning of the term.*

7. Mr Murch also referred to the Registry's Examination Practice Guide (sometimes referred to as the 'Work Manual', inasmuch as it expands on the *Matratzen* principle in relation to foreign language signs, and which states in relevant part:

*"Following the European Court of Justice's (ECJ) judgment in [*Matratzen*], there are no grounds for refusing registration of trade marks on the basis that they are relevantly descriptive or non-distinctive in a language which is unlikely to be understood by the relevant trade in the UK or by the relevant average UK consumer of the goods/services in question.*

*Consequently, the registrar will only object to the registration of word marks which are likely to be recognised as a description of a characteristic of the goods or services (or otherwise be descriptive of the goods/services) in the application. The relevant trade in the UK consists of those in the UK who trade in the goods or services in question. A pharmacist may recognise the descriptive meaning of a Latin name even though an average consumer of pharmaceuticals may not. Similarly, a trader in wines is likely to have a better understanding of French wine descriptions than the average end consumer of those goods. Further, traders in computing goods and services are likely to be more aware of the names used elsewhere to designate characteristics of new products, even if the product is not yet available on the UK market.*

*1. The Most Commonly Understood European Languages*

*In general, the most widely understood European languages in the UK are French, Spanish, Italian and German. The majority of UK consumers cannot be assumed to be fluent in any of these languages, but most of them will have an appreciation of some of the more common words from these languages, particularly common French words. So it may be assumed that the meaning of 'Biscuit pour Chien' (dog biscuits) will be known to the average UK customer for dog biscuits. Similarly, it may be assumed that traders in and/or average UK consumers of cosmetics (who will be accustomed to seeing French descriptions on the packaging of cosmetics) will know the meaning of 'lait' (milk) and will be able to decipher the meaning of 'Lait hydratant' as being moisturising milk (or similar)."*

8. The attorney submitted that 'YUKIGASSEN' would not be a recognisable word for many (most, even) consumers in the UK; that there is no substantial Japanese community here in the UK; and that the word would, accordingly, be considered entirely fanciful and registrable. In submission at the hearing, Mr Murch submitted that the *quantity* of hits produced by the examiner was very low, illustrating a lack of recognition in the UK. Finally, he advised me of an informal survey he had conducted on his way to the hearing, which supported his argument that the general public are not, by and large, aware of the term. This is not something I can take into account in this decision, as no formal methodology or even written account of the survey has been provided. Nonetheless, I am prepared to concede for the purposes of my decision below that many (most, even) average consumers in the UK may well *not currently* be familiar with the word 'YUKIGASSEN'.

**Decision**

9. Section 3(1)(b) and (c) of the Act reads:

*"3. - (1) The following shall not be registered –*

*(a) ...*

*(b) trade marks which are devoid of any distinctive character,*

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*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

*(d) ...*

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

10. There are now a number of judgments from the CJEU which deal with the scope of Article 3(1) (c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1) (c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1) (c) of the UK Act. The following main guiding principles which are relevant to this case are noted below.

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (see *Wm Wrigley Jr & Company v OHIM*, Case 191/01P ('*Doublemint*') paragraph 30).
- Thus, Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Wm Wrigley Jr & Company v OHIM*, paragraph 31).
- The phrase 'may serve in trade' includes within its scope the possibility of future use even if, at the material date of application, words or terms are not in descriptive use in trade. Support for this can be found in, e.g. CJEU Case C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boot und Segelzubehor Walter Huber and others* in relation to geographical names, and also BL O/341/06 '*Moo Juice*', a decision of the Appointed Person in relation to words which in one language or culture may be descriptive in trade but in another, not.
- Section 3(1) (c) of the Act excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question.
- To assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties. That is to say, those in trade and/or amongst average consumers of the said goods or services are taken to be reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for - see *Matratzen*, paragraph 24.

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- There must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics - see CJEU Judgment C-468/01 P to C-472/01 P '*Tabs*' at paragraph 39, and General Court Judgment T-222/02 '*Robotunits*' at paragraph 34.
- The assessment of a sign for registrability must accordingly be made with reference to each discrete category of goods or services covered by an application for registration: see Case C-239/05 *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ECR I-1455 at paragraphs 30 to 38; and Case C-282/09 P *CFCMCEE v OHIM* [2010] ECR I-00000 at paragraphs 37 to 44.
- Assessment of any objection taken under section 3(1)(b) and (c) must be stringent and fact based.
- 'Subject matter' can be the subject of a section 3(1)(c) objection, based on such subject matter being a characteristic of the goods and services. Support for this can be found in the case of, e.g. BL O/313/11 '*Flying Scotsman*', a decision of the Appointed Person at paragraph 16.

### Application of legal principles

11. In correspondence and at the *ex parte* hearing, I did not understand Mr Murch to contest the *meaning* of 'YUKIGASSEN', as it is described in WIKIPEDIA. Whilst such a source may not in all circumstances be the most authoritative, I have no reason in this case not to accept its factual content. In other words, 'YUKIGASSEN' (transliterated into English as 'snow battle') describes a recognised Japanese sport involving either snowballs or projectiles which resemble snowballs. Also, I have no reason to doubt that the sport has been adopted in other countries to describe the same or a very similar activity.
12. The issue for Mr Murch was that the term is very unlikely to be known here in the UK, and that that absence of knowledge must render the sign applied for as being acceptable, based upon the *Matratzen* principle.
13. Despite the fact that *Matratzen* refers to consumer perception across the European Community, I accept the principle that signs which may *not* be registrable as trade marks in other countries (in this case, clearly Japan, and potentially Australia, Canada, USA, Sweden, Finland and Norway) may be registered in the UK on the basis that they would have no recognised meaning in our culture and language. But this is also plainly subject to the futurity principle identified in the case law above.
14. Firstly, I need to identify the average consumer in this case. For those goods specified in classes 9 and 19 it will be the general public. However, for the services listed in classes 35 and 41, the average consumer is likely to be businesses and the corporate

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sector. I should add that my identification of the average consumer in this case does not, in my opinion, impact on my analysis of the case thus far.

15. As to that question of futurity, there are several factors which in my opinion operate in this case:
- The sport has already been reported on by name by the BBC, a public service broadcaster.
  - Elements of Eastern culture (by which I mean more specifically *Japanese* culture) are frequently adopted in the UK, more so these days than perhaps in the past, and include, for example food (Sushi), martial arts (Karate), comics and animation (Manga) and medicine.
  - The impact of global television and other media forms such as 'YouTube' which provide coverage of content which several years ago may have been considered to be of only limited localised interest.
  - In this specific case, 'YUKIGASSEN' is the transliterated name given to the sport itself; it is not, as in the case of *Matratzen*, a name given to an item of goods in another language.
  - As the name given to the sport itself, if it is to be played in any form in the UK it is likely to adopt that name rather than any other name which may be a local variant. It is significant in this case that the name 'YUKIGASSEN' is specifically used in those countries where, according to WIKIPEDIA, tournaments are played.
  - It is not a random or informal game, by which I mean a game such as 'capture the flag', which may have many variants and no commonly accepted rules of play. In contrast, 'YUKIGASSEN' has established rules of play, such as, for example, the number of players, the court size/dimensions, and attire to be worn (as confirmed in WIKIPEDIA). It also has a governing body in Japan - the Japan Yukigassen Federation.
  - In my opinion, it would be wrong in this case to limit potential knowledge of the sport to countries where tournaments exist, i.e. Japan, Finland, Sweden, Norway, Australia, USA and Canada. Even though tournaments or formal competition may never exist in the UK, this would not of itself prevent consumers in the UK being aware of the name.
  - In connection with the above, it seems key to the sport that it is essentially fun-based, whilst at the same time engendering team spirit of the kind that businesses these days often seek to acquire at events such as corporate away days and so forth. It is not the case then that the sport would never be one that would be likely to take hold in a corporate, motivational environment such as that covered by the services of the application.

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- It would be wrong to assume that the UK climate and the lack of regular snowfall may of itself prevent the sport from taking a hold in the UK. It is perfectly plausible that, with the use of artificial snow facilities, a traditional 'snow battle' could be accommodated, but it is also plausible that in the UK 'adaptations' could be made which make up for complete lack of snow itself, although these may be outside the scope of the established governing body in Japan. In any event, I should stress that the test for me is not *viability of the sport in this country but whether the sign could designate characteristics of the goods or services*.
  - The sport appears to be comparatively new, with tournaments outside Japan only starting in 2005.
16. At the same time, there may be factors which operate in favour of Mr Murch's position, notably:
- If the sport is to be recognised in the UK, then there is precious little hard evidence that it is so far.
  - According to WIKIPEDIA, tournaments have been held outside Japan since 2005. Thus far, such tournaments have *not* taken place in the UK; if the sport was to take a hold, it would have done so by now.
  - Although not established by objective data such as survey evidence, I accept that Many (most, even) in the UK are currently unfamiliar with the term. If the best that can be produced is a single BBC report going back some years, then this is arguably an unsafe basis of refusal.
  - There is not in the UK an established Japanese community, such that may uphold the culture and traditions of its 'mother' country or culture.
17. I have sought to balance these factors which in a case involving futurity will never be easy. I reiterate, the test is not about the sport's viability or potential popularity in this country but whether the word 'YUKIGASSEN' could designate a characteristic of the goods and services. The factors that weigh especially heavily with me are that it YUKIGASSEN is an established name of a sport with apparently formal governance structures in place. The sport has moreover been adopted in other countries, including the US already. Further, that media interest (including the internet) here in the UK could instantly transform the name of the sport into a recognised term. This is the kind of sport which, for example, could easily feature on a satellite channel or even on main network TV on a magazine show such as THE ONE SHOW. Finally, the sport looks fun to play and to watch; everyone has at some point thrown snowballs and can therefore identify with the adaptation of such an activity into a team based sport. Weighing all these factors, I conclude that this is a sign which could plausibly designate a characteristic of the goods and services, if not now then at some time in the future.
18. The only remaining task I need to do is to consider which if any of the goods or services escape objection. In this regard I have set out the guiding legal principles



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above, namely that goods or services in respect of which the term may be regarded as optional subject matter are vulnerable, and that I am entitled to provide general reasoning in relation to groups of goods and services.

19. If I take the view that 'YUKIGASSEN' describes a sport, and this is likely to be known and appreciated, as regards the goods of classes 9 and 16, such a term could relate to 'subject matter' in respect of those goods which convey or carry information. In respect of goods which do not, such as, e.g. writing instruments, pens and instruments in class 16, then, in my view, the term would simply act as a promotional descriptor in relation to the sport which is being promoted. As regards the services in classes 35 and 41, the term would comprise, again, subject matter. That is to say, the particular activity, course, appraisal, event or test would take the form of YUKIGASSEN. As I have already said, I believe this sport would be very suited to a corporate motivational environment, intended to engender team spirit whilst at the same time having fun.
20. Since refusal arises under section 3(1)(c), the sign is automatically also devoid of distinctive character for the purposes of section 3(1)(b). Having said that, in this case the sign is only devoid of distinctive character by virtue of designating a characteristic of the goods/services and for no other or additional reasons. Accordingly, I provide no additional reasons for refusal particular to section 3(1)(b).
21. I have considered all the papers on file and submissions made and, for the reasons given above, the application is refused in its entirety under sections 3(1)(c) and (b) of the Act.

Dated this 17<sup>th</sup> day of October 2013

Edward Smith  
Acting for the Registrar

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## Anyone for Yukigassen?



The Baywatch team came from Finland

**By Robert Stern in Norway**

While most of the Western world is enjoying plum blossom, birdsong and the first chance of the year to slap on some sunscreen, in Norway, one small town is still buried under three metre snowdrifts.

Winter in Vardo, at the northernmost tip of Norway, is harsh. The sun disappears altogether for two months, minus 10C constitutes a nice day, and the town's only tree is muffled beneath swathes of protective wadding.

The end of winter is a long time coming, but when the days start to lengthen, and the temperature finally starts to creep above zero, Vardo celebrates with an international snowball fight competition. It's a tradition that only dates back to 1997, but no one in town doubts it's here to stay.

### From karaoke to Kemijervi

It all started in 1996, after a sake-fueled night of karaoke in the northern Japanese town of Sobetsu.

The mayor told his fellow-mayors of Vardo and the Finnish town of Kemijervi, sister towns connected by their extreme northern latitude, about a sport his town had invented, and they all agreed it could become the next great Japanese export.

Yukigassen is basically a formal team version

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of a snowball fight, played on a volleyball court-sized pitch dotted with protective ice-walls. You win either by eliminating your opponents by hitting them with snowballs, or by capturing a flag in the middle of your opponents' court.



Opponents are eliminated by hitting them with a snowball

Imagine an Arctic hybrid of paintball and kabbadi and you won't be far wrong. Goofy maybe, but people take it seriously, and Sobetsu is po-faced about its long-term ambition to make yukigassen an Olympic sport.

Since the Japanese first introduced yukigassen to Vardo in 1997, the locals have become completely besotted, and their enthusiasm is beginning to spread to the rest of Norway.

More than a dozen teams were turned away this year, with 30 teams qualifying for the 4th Norwegian National Championships.

These included four from Finland, and one from as far south as Haugesund, west of Oslo (if you don't think that's far, take another look at the map - Vardo is the same distance from Oslo as Oslo is from Milan).



Yodelling pirates make up just one of the elaborately costumed teams

All of Vardo's population of 2,700 turns out for the two-day championships, from the opening parade and ceremony - this year including a minute's silence for their fellow yukigassen players in Sobetsu, evacuated because a neighbouring volcano has turned active - to the keenly-contested final.

They cheer the extravagantly-costumed teams, including yodelling pirates, an improbably-breasted Baywatch team from Finland, even a team of fatigues-clad Americans from the local Nato radar spy station - whose exuberance rapidly turns to evasion when asked what they're doing there.

But amid the party atmosphere, outside the hospitality tent sponsored by the local brewery, there is also some serious sporting competition to be found, combining athleticism with cunning teamwork and tactics.

For the record, the High School Dropouts won.

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# Yukigassen

From Wikipedia, the free encyclopedia

**Yukigassen** (雪合戦) is a snowball fighting-competition from Japan. Today there are annual tournaments in Sobetsu, Hokkaidō in Japan, Kemijärvi in Finland, Vardø in Norway, Mount Buller, Victoria in Australia, Luleå in Sweden in Anchorage, Alaska, and Jasper, Alberta and Saskatoon, Saskatchewan in Canada.

The word **Yukigassen** consists of the Japanese words **yuki** (snow) and **kassen** (battle). Hence Yukigassen means **snow(ball) battle**.

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## Short description of the game

Yukigassen is a game between two teams with seven players each. The game is played on a court with certain measurements, and the winner is determined through rules made by the Japan Yukigassen Federation.<sup>[1]</sup> It is similar to capture the flag; players are eliminated when hit with snowballs. Players wear special yukigassen helmets with face shields, and a set number of snowballs (90) are made in advance.<sup>[2]</sup>

## Tournaments

World Championship in Sobetsu, Hokkaidō, Japan  
European Championship in Kemijärvi, Finland  
Swedish Championship in Luleå, Norrbotten, Sweden (Luleå University of Technology)  
Nordic Championship in Vardø, Finnmark, Norway  
Mount Buller, Victoria, Australia  
Anchorage, Alaska, USA  
Jasper, Alberta, Canada  
Saskatoon, Saskatchewan, Canada

## Medal winners

### 2012

Here is a list of medal winners in the third Swedish championship, held in Luleå in 2012

Gold Medal I & Co

Silver medal KREwasion Invation

Bronze medal Team LTU/Backyard Porsön

### 2011

Here is a list of medal winners in the second Swedish championship, held in Luleå in 2011

Gold Medal Team LTU/Backyard Porsön

Silver medal Cockroaches/Exchange Students Team

Bronze medal I & Co

### 2010

Here is a list of medal winners in the first Swedish Championship, held in Luleå in 2010

Gold Medal Team LTU/Backyard Porsön

Silver medal I & Co

Bronze medal Gefle Snow Warriors

### 2007

Here is a list of the medal winners in the European Nordic Tournament in Vardø in 2007

Gold Medal Hiawatha (Norwegian)

Silver medal IL Tempo Gigante (Norwegian)

Bronze medal KP 55 (Finnish)

### 2006

Here is a list of the medal winners in the Nordic Tournament in Vardø in 2006:

Gold: Lapin Peurat (Finnish)

Silver: KP 55 (Finnish)

Bronze: Små Rasmus etterkommere (Norwegia

## 2005

Here is a list of the medal winners in the Nordic Tournament in Vardø in 2005:

Gold: Små Rasmus etterkommere (Norwegian)

Silver: Hiawatha (Norwegian)

Bronze: KP 55 (Finnish)

## See also

Snowball fight

## References

- ↑ http://www.yukigassen.jp/english/index.html
- ↑ http://yukigassenfinlandinenglish.blogspot.se/p/rules.html

## External links

Showa-Shinzan International Yukigassen (Japan)

(http://www.yukigassen.jp/english/index.html)

Yukigassen Nordic Championship (Norway) (http://www.yukigassen.no)

European Championship (Finland) (http://www.yukigassenfi.aazilla.com/)

Swedish Yukigassen Official Association (http://www.yukigassen.se)

Yukigassen Canadian Championship (http://www.snowbattle.ca)

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